



## Study Question

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**Registrability of 3D trademarks**

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### I. Current law and practice

**Please answer the below questions with regard to your Group's current law and practice.**

**1** Are 3D Shapes\* registrable as a trademark? Please answer YES or NO.

*If you have answered NO, please skip Questions 2 to 9 and proceed to Question 10.*

*\*This Study Question focuses on signs consisting of 3D shapes comprising solely the three-dimensional shape of goods or packaging without any addition (3D Shapes). (see further para. 12 of the Study Guidelines).*

Yes

(Explanation is Optional)

**2** Can a 3D Shape be inherently distinctive? If YES, what test is applied in order to establish if it is inherently distinctive?

Yes

What test is applied in order to establish if it is inherently distinctive?

Yes, but in practice it is very difficult to establish inherent distinctiveness. The Hungarian practice follows the European practice laid down in Linde/Winward/Rado<sup>[1]</sup> and Henkel<sup>[2]</sup> cases. The criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trademarks. However, the relevant public's perception is not necessarily the same. Only a trademark, which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character.

### Footnotes

1. [Preliminary ruling of the Court in joined cases C-53/01, C-54/01 and C-55/01 Linde AG, Winward Industries Inc. and Rado Uhren AG of 8 April 2003.](#)
2. [Preliminary ruling of the Court \(Sixth Chamber\) in case No. C-218/01 Henkel of 12 February 2004.](#)

3

**Can a 3D Shape acquire distinctiveness? If YES, what test is applied in order to establish if it has acquired distinctiveness?**

Yes

What test is applied in order to establish if it has acquired distinctiveness?

Yes, unless absolute refusal grounds apply. Acquired distinctiveness is adjudged on the basis of general rules, no special test is applied to 3D shapes.

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**Will a 3D Shape be refused registration, or is a 3D Trademark\* liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test is applied.**

**\*3D Shapes registered as trademarks (see also para. 14 of the Study Guidelines)**

Yes

Please describe what test is applied.

Yes. The Hungarian practice rarely uses this provision for refusing protection. We are aware of only one case, where the refusal was based on the shape resulting from the nature of the good as separate legal ground (the case of the "Lindt Easter bunny"). [1] According to the Metropolitan Court of Appeal, the notion of 'the shape resulting from the nature of the good' means a shape which is considered natural by the consumer with regard to the nature of the respective goods.

#### Footnotes

1. [Case no. Hungarian IP Office A882978/5, Metropolitan Court 1.Pk.22.687/2009/3., Metropolitan Court of Appeal 8.Pkf.25.149/2010/3., Supreme Court Pfv.IV.21.096/2010/3.\)](#)

5

**Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test is applied.**

Yes

Please describe what test is applied.

Yes. The Hungarian IP Office and the Courts interpret this ground for refusal on the basis of the Philips/Remington case. [1] Namely, the sign consisting exclusively of the shape of a product is unregistrable if it is established that the essential functional features of that shape are attributable only to the technical result. However, the Hungarian courts seem to interpret Philips/Remington differently in relation to the issue of alternative shape. The Metropolitan Court of Appeal remarked in the LEGO case [2] that the Philips/Remington judgement does not mean that alternative shapes cannot be referred to at all. The Hungarian first instance court examined the elements of the respective patent and of the trademark in detail and established that certain essential elements of the trademarks are not exclusively necessary to achieve a technical function. The second instance court considered this analysis redundant and stated that even the Philips/Remington judgment does not fully exclude the examination of alternative shapes.

#### Footnotes

1. [Preliminary ruling of the Court in case No. C-299/99 Philips v. Remington of 18 June 2002.](#)
2. [Resolution of the Metropolitan Court of Appeal in Lego case no. 8.Pkf.25.201/2007/9.](#)

**6 Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test is applied.**

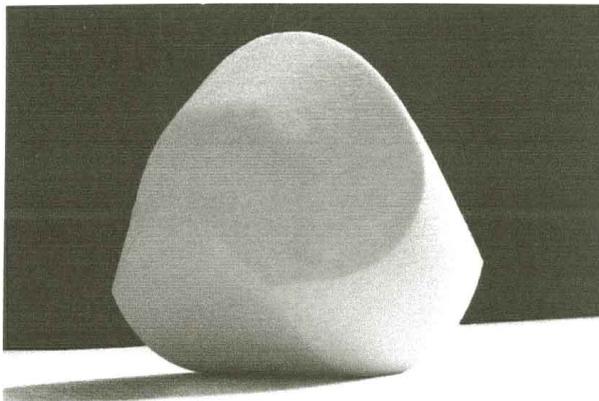
Yes

Please describe what test is applied.

Yes. The Hungarian practice rarely uses this provision for refusing protection, as well. We are not aware of any uniform test regarding this ground for refusal. In some cases the Hungarian IP Office requested the applicant to provide a response in connection with this ground for refusal when the applied sign contained considerable ornamental elements (see below the statue [\[1\]](#) and column head [\[2\]](#) cases). [\[3\]](#)



In another case [\[4\]](#) the applicant intended to register the shape of the famous Hungarian invention called 'Gömböc', which is a convex three-dimensional homogeneous body which, when resting on a flat surface, has just one stable and one unstable point of equilibrium. The Hungarian IP Office established that the design of the 3D object is eye-catching and due to this extraordinary shape the 3D mark shall be refused for ornamental objects since the shape gives substantial value to the goods. The Metropolitan Court dissented with the IP Office and established that the circumstance, that the consumers consider the shape of 'Gömböc' as a solution of a mathematical problem, gives substantial value to the goods. The Metropolitan Court of Appeal dissented with the Metropolitan Court and accepted the reasoning of the IP Office.



## Footnotes

1. [Application no. M1300053](#)
2. [Application no. M1203434](#)
3. [The applicants successfully overcome the ground for refusal and these trademarks are under protection at the moment. We are not aware of the reasoning of the applicants.](#)
4. [Application no. M1500325, case pending before the Hungarian Supreme Court](#)

**7** Is there any other ground of absolute refusal or invalidity specific to 3D Shapes or 3D Trademarks available under your Group's current law?

No

(Explanation is Optional)

**If you have answered NO to each of Questions 4, 5, 6 and 7 proceed to Question 10.**

**If you have answered YES to any one of Questions 4, 5, 6, or 7, please answer Questions 8 and 9 in relation to the relevant refusal / invalidity ground(s).**

**8** Do the refusal / invalidity grounds referred to in Questions 4, 5, 6 and/or 7, to the extent available in your Group's jurisdiction, operate independently from one another or may they also apply in combination? For example, do they apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

These refusal / invalidity grounds operate independently from one another.

**9** Which, if any, of the refusal / invalidity grounds referred to in Questions 4, 5, 6 and 7, to the extent available in your Group's jurisdiction, can be overcome by acquired distinctiveness?

The refusal/invalidity grounds referred in Questions 4, 5, 6 cannot be overcome by acquired distinctiveness.

## II. Policy considerations and proposals for improvements of your current law

**10** Could any of the following aspects of your Group's current law be improved? If YES, please explain.

**10.a** Registrability (or lack thereof) of 3D Shapes

Yes

Please Explain

Distinctive character shall be the most important and in most cases the only relevant requirement for protection or absolute ground for refusal

in connection with three-dimensional trademarks.

**0.b** The test applied, if any, in relation to the registrability (based on inherent and/or acquired distinctiveness) referred to in Question 10(a)

Yes

Please Explain

Stricter legal practice is needed for assessing distinctiveness compared to traditional signs. However, contrary to the suggestion of the Max Planck Study, the applicant should have the opportunity to prove inherent distinctiveness.

For assessing inherent distinctiveness, the evolvement of a more complex legal practice than the current would be necessary, i.e. a practice that covers all aspects of the case, takes into account the characteristics of the product sector concerned and that is differentiated by product sectors.

**0.c** The refusal / invalidity grounds, if any, referred to in Questions 4 to 7 (and potential combination thereof)

Yes

Please Explain

The shape, or other characteristic, resulting from the nature of the goods, as a special ground for refusal shall be deleted from the European trademark law.

Significant changes are necessary in the practice of technical functionality as a special ground for refusal, primarily the introduction of examination of alternative shapes and providing the taking of evidence by experts, whereas in general the ground for refusal should be handled as a very narrow exception.

The shape, or other characteristic, which gives substantial value of the goods, as special ground for refusal shall be deleted from the European trademark law.

**0.d** The possibility or lack thereof to overcome these refusal / invalidity grounds by acquired distinctiveness.

**11** Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

Yes

Please Explain

The scope of protection of three-dimensional signs under trademark protection should be narrower to eliminate competition law concerns, similarly to the protection of signs with weak distinctive character.

### III. Proposals for harmonisation

***Please consult with relevant in-house / industry members of your Group in responding to Part III.***

**12** Does your Group consider that harmonisation in any or all areas described in the response to Question 10 or 11 above is desirable? Please answer YES or NO.

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.*

Yes

Please Explain

**13** Does your Group consider that 3D Shapes should be registrable as a trademark? Please answer YES or NO.

Yes

Please Explain

**14** Should it be possible for a 3D Shape to be inherently distinctive? If YES, what test should be applied in order to establish if it is inherently distinctive?

Yes

What test should be applied in order to establish if it is inherently distinctive?

See our Answer to Question 10.

**15** Should it be possible for a 3D Shape to acquire distinctiveness? If YES, what test should be applied in order to establish if it has acquired distinctiveness?

Yes

What test should be applied in order to establish if it has acquired distinctiveness?

We suggest reducing and unifying the territorial requirements and the necessary level of acquired distinctiveness in the EU.

**16** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

See our Answer to Question 10.c.

**17** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

See our Answer to Question 10.c.

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**Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test should be applied.**

Yes

Please describe what test should be applied.

See our Answer to Question 10.c.

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**Should there be any other absolute refusal or invalidity ground specific to 3D Shapes or 3D Trademarks? If YES, please explain briefly.**

No

(Explanation is Optional)

***If you have answered NO to each of Questions 16, 17, 18 and 19, please skip Questions 20 and 21 and proceed to Question 22.***

***If you have answered YES to any one of Questions 16, 17, 18 or 19, please answer Questions 20 and 21 in relation to the relevant refusal / invalidity ground(s).***

20

**Should the refusal / invalidity grounds referred to in Questions 16, 17, 18 and/or 19 operate independently from one another or should it also be possible to apply them in combination? For example, should they also apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?**

The refusal / invalidity grounds referred in Questions 16, 17, 18 should operate independently.

21

**Which, if any, of the refusal / invalidity grounds referred to in Questions 16, 17, 18 and 19 should (and thus may) be overcome by acquired distinctiveness?**

See our Answer to Question 10.

22

**Please comment on any additional issues concerning the registrability of 3D Trademarks and the refusal / invalidity grounds mentioned above that are within the scope of this Study Question (as described in paragraphs 11 to 13 of the Study Guidelines), and that you consider relevant to this Study Question**

See our Answer to Question 11.

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**Please indicate which industry sector views are included in your Group's answers to Part III.**

In parts 'II. *Policy considerations and proposals for improvements of your current law*' and 'III. *Proposals for harmonisation*' of the present Questionnaire, the answers are based on Dr. Péter Lukácsi's doctoral (PhD) dissertation titled "Trademark – Competition – Public Domain: Trademark Protection of Three Dimensional Signs", 2017, Eötvös Loránd University, Faculty of Law.