

Shape Marks – From Past Decisions to Gömböc (C-237/19). What's Next?

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Abstract

When it comes to shape marks under EU trade mark law, two absolute grounds for refusal or invalidity are worthy of notice. These absolute grounds refer to signs which exclusively consist of the shape which is necessary to obtain a technical result or give substantial value to the goods.

While shape marks constantly face hurdles on their way to protection, in the past years, the above mentioned absolute grounds for refusal, were not under the courts' spotlight. Previously, several landmark cases interpreted and analysed these absolute grounds for refusal and underlined the relationship between various IP rights (i.e. Philips shaver case, LEGO brick case, Hauck case). Nevertheless, uncertainties remained. The new reference to the CJEU for a preliminary ruling - the Gömböc case (C-237/19), is expected to shed further light onto the practical application of these two absolute grounds for refusal.

In short, in this referral the CJEU will have to interpret whether the assessment of the technical result ground for refusal can only be conducted by examining the graphic representation contained in the register. Further, the CJEU's task will be to clarify whether the consumer's knowledge and perception about Gömböc are relevant in the assessment of these absolute grounds for refusal. Finally, the CJEU will have to analyse whether the substantial value ground for refusal is applicable to signs which consist exclusively of a shape protected by a design or whose aesthetic appearance alone gives the goods any kind of value.

This contribution reviews relevant EU case law on these two grounds for refusal, while trying to interpret the questions and issues arisen in the Gömböc case.