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General Court confirms invalidity of trademark consisting of 2D depiction of shape of goods that performs a technical function

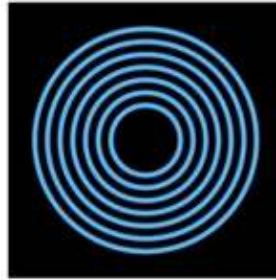
European Union - [Hoogenraad & Haak, Advertising + IP Advocaten](#)

- **Wallmax sought declaration of invalidity of figurative mark depicting a black square containing seven concentric blue circles for goods in Class 17**
- **The Board of Appeal upheld the application for a declaration of invalidity, finding that the mark consisted of the main characteristic of a sealing module**
- **The General Court agreed with the board that the mark was a two-dimensional depiction of the leading surface of a sealing module**

In [Roxtec AB v European Union Intellectual Property Office](#) (EUIPO) (Case T-261/18), the General Court has reviewed the application of the absolute ground for refusal for signs that consist of the shape of goods which is necessary to obtain a technical result in relation to a figurative trademark consisting of the two-dimensional depiction of a product.

Background

Roxtec ('the applicant') develops and markets sealing modules. The technology used for the sealing modules was protected by a patent until 2010. In 2015 the applicant registered a figurative trademark depicting a black square containing seven concentric blue circles for goods in Class 17: "Cable and pipe penetration seals, made from plastic or rubber".



Roxtec's trademark



Roxtec's sealing module with removable layers

In 2016 Wallmax - which is also active in the market for sealing modules - applied for a declaration of invalidity of the trademark.

The Cancellation Division rejected the application for a declaration of invalidity. It concluded that the registration of the trademark was not likely to impair the ability of competitors to use the same or a similar technology. Therefore, the trademark should not be cancelled under Article 7(1)(e)(ii) of Regulation 207/2009 (now Regulation 2017/1001), which contains the absolute ground for refusal for signs that exclusively consist of "the shape (or another characteristic) of goods which is necessary to obtain a technical result".

The Board of Appeal concluded differently and annulled the decision of the Cancellation Division. The board found that the trademark consisted of the main characteristic of the sealing module - namely, an exact depiction of the concentric removable layers of the sealing module. Thus, the board concluded that the registration of the trademark was likely to unduly impair the ability of competitors to market sealing modules consisting of concentric removable layers.

General Court decision

The applicant brought an action against the decision of the Board of Appeal before the General Court. The applicant raised one plea based on three arguments:

- the trademark does not describe the product in question (sealing module), but merely alludes to it;
- the board had failed to correctly determine (all) the essential characteristics of the trademark; and
- the characteristics that are necessary and indispensable for the product to function are not incorporated in the trademark.

The court dismissed all three arguments. With regard to the first argument, the applicant was reminded that Article 7(1)(e)(ii) does not specify what shapes fall within the scope of that provision. No distinction is made between three and two-dimensional shapes, or a two-dimensional depiction of a three-dimensional shape. The court concluded that the trademark consisted of the shape of the product at issue, in the form of a two-dimensional depiction of the leading surface of the sealing module.

With regard to the second argument, the court recalled that, in order to assess the functionality of a shape, it is first necessary to determine the essential characteristics of the mark, and then to ascertain whether all of the essential characteristics perform a technical function. The applicant claimed that the combination of colours had acquired distinctiveness and had to be qualified as an essential characteristic. The court set the argument aside, stating that the essential characteristics of a shape need to be determined objectively and that the perception of the public is not decisive. Therefore, the distinctive character acquired through the use of a sign is not relevant for determining the essential characteristics.

The applicant also claimed that the colour combination was a major non-functional element of the mark. It follows from case law that Article 7(1)(e)(ii) does not apply if a shape consists of a major non-functional element that plays an important role in the shape. The court stated the colour combination was only a minor arbitrary element, because the applicant had not demonstrated that it was an essential characteristic. The court confirmed the conclusion of the board that, based on (among other things) the description of the expired patent, it was established that only the concentric circles were the essential characteristics of the sign.

With regard to the third argument, Article 7(1)(e)(ii) does not require that all the characteristics that are necessary for the product to function be included in the sign. It is sufficient that the essential characteristics of the shape combine the characteristics that are technically causal of the intended technical result. In this case, the concentric circles were the essential characteristics that performed a technical function that was causal for the technical result.

The court thus rejected the applicant's arguments alleging infringement of Article 7(1)(e)(ii) and dismissed the action. The trademark remains invalid, as declared by the board.

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