

Packaging protection through 3D trademarks: how it is possible to manage distinctiveness issues of shape mark

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The packaging of the products is nowadays more and more important, being a factor that would dictate the choice of the consumers during the purchase decision. It is part of the marketing strategies and so recipient of investments of the companies, becoming an asset that plays a part in distinguishing the products in the market and enabling customers to recognize the goods or services as originating from a certain company.

The packaging could be protected through different IP tools.

One choice, which would be the one that – potentially – would provide a perpetual protection, is going through the trademark filing and, in particular, the filing of a shape mark.

Article 3(3)(c) EUTMIR defines shape marks as trademarks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The term 'extending to' means that these marks cover not only shapes per se but also shapes that contain word or figurative elements such as logos or labels.

EUIPO is rather strict in the examination of such type of mark because even if Article 7(1)(b) EUTMR does not distinguish between different types of trademarks in determining whether a trademark is capable of distinguishing the goods or services of one undertaking from those of other, and so no stricter criteria are applied in determining the distinctive character of these marks, it would be more difficult to evaluate such aspect, because shape marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark. So, frequently, the Office would rise objection in relation to the lack of distinctive character of these types of marks.

Considering the above, when there is the intention to protect a packaging through the shape mark, it is useful to take into consideration the provisions of the Common Practice 9 (CP9) released in April 2020 which resulted from the work and legal reflections of the Convergence Programme organized by the EUIPO. This is because CP9 gives common principles regarding the distinctiveness of shape marks containing verbal and/or figurative elements when the shape is not distinctive in itself, with the aim of establishing a minimum threshold for distinctiveness of these marks. As you will see below, there are some key points that could be considered when defining a strategy of protection of a packaging through the trademark regulations, which would help to manage distinctiveness issues.

The scope of the CP9 is the assessment of the overall inherent distinctiveness of shape marks consisting of a non-distinctive shape of the goods themselves, packaging or containers, and other elements to which the shape mark extends, within absolute grounds examination.

The steps to follow in the examination of the distinctive character of shape marks should be the following:

- 1) The Office should identify all the elements to which the shape mark extends, which are:

- verbal and figurative elements,
- colors (single and color combinations) and,
- a combination of the above.

Then, assess their inherent distinctiveness, which should include an assessment of the following factors:

- size/proportion of the elements with respect to the shape;
 - contrast of the element with respect to the shape;
 - position of the element on the shape.
- 2) After assessing the inherent distinctiveness of all the elements, it should be assessed the distinctiveness of the sign based on the overall impression of the combination of the shape and the elements to which it extends, in relation to the goods in question, and considering the consumer's perception which can be influenced by specific market realities.

The key elements and factors stated in the CP9 to consider when determining if the threshold of distinctiveness is met, are summarized as follows:

- if a non-distinctive shape contains an element that is distinctive on its own, it will suffice to render the sign as a whole distinctive. The size and proportion of the verbal/figurative elements, their contrast with respect to the shape, and their actual position on it, are all factors which may affect the perception of the sign when assessing its distinctiveness;
- regarding colors, it must be considered the general interest in not unduly restricting the availability of colors for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought. So, the mere fact of adding a single color to the shape of a good in the absence of any other distinctive verbal or figurative element would not render the sign inherently distinctive. On the other side, a particular arrangement of colors which is uncommon for the goods and creates an overall memorable impression can render the sign as a whole distinctive;
- The combination of a non-distinctive shape with elements which are considered devoid of distinctive character could render the sign distinctive as a whole if they create a distinctive overall impression as the consumer will perceive their particular combination as an indication of commercial origin.

[Here](#) you can find the full text of the CP9 together with many different examples:

To develop an effective strategy to protect a packaging THINX takes a global approach coordinating the different tools of protection offered by the European regulations, as well as the practices and common principles that have been developed in the context of cooperation, like the Convergence Programme. These become essential to prevent, for example, a rejection based on lack of distinctiveness or to manage the risk connected with the practice of the Office.