

European Copyright Society

Trade mark protection of public domain works
A comment on the request for an advisory opinion of the EFTA Court
**Case E-05/16 - Norwegian Board of Appeal for Industrial Property
Rights – appeal from the municipality of Oslo**

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Drafting Committee :

Prof. Lionel Bently, University of Cambridge, United Kingdom
Prof. Estelle Derclaye, University of Nottingham, United Kingdom
Prof. Graeme B. Dinwoodie, University of Oxford, United Kingdom
Prof. Séverine Dusollier, SciencesPo Paris, France
Prof. Marco Ricolfi, Turin Law School, Italy
Prof. Martin Senftleben, VU University Amsterdam, Netherlands

Signatories :

Prof. Lionel Bently, Professor, University of Cambridge, United Kingdom
Prof. Valérie-Laure Benabou, Professor, University Aix-Marseille, France
Prof. Estelle Derclaye, Professor of Intellectual Property Law, University of Nottingham, United Kingdom
Prof. Graeme B. Dinwoodie, Director, Oxford Intellectual Property Research Centre (OIPRC), University of Oxford, United Kingdom
Prof. Thomas Dreier, Director, Institute for Information and Economic Law, Karlsruhe Institute of Technology (KIT), Germany
Prof. Séverine Dusollier, Professor, School of Law, SciencesPo Paris, France
Prof. Christophe Geiger, Director, Centre d'Etudes Internationales de la Propriété Intellectuelle (CEIPI), University of Strasbourg, France
Prof. Jonathan Griffiths, Queen Mary University of London, United Kingdom
Prof. Reto Hilty, Director, Max Planck Institute for Innovation and Competition, Munich, Germany
Prof. P. Bernt Hugenholtz, Director, Institute for Information Law, University of Amsterdam, Netherlands
Prof. Marie-Christine Janssens, Professor Intellectual Property Law, University of Leuven, Belgium
Prof. Martin Kretschmer, Professor of Intellectual Property Law, University of Glasgow, and Director, CREATE, United Kingdom
Prof. Axel Metzger, Professor of Civil and Intellectual Property Law, Humboldt-Universität Berlin
Prof. Alexander Peukert, Goethe-Universität Frankfurt am Main, Germany
Prof. Marco Ricolfi, Chair of Intellectual Property, Turin Law School, Italy
Prof. Martin Senftleben, Professor of Intellectual Property, VU University Amsterdam, Netherlands
Prof. Alain Strowel, Professor, Saint-Louis University and UCLouvain, Belgium
Prof. Michel Vivant, Professor, School of Law, Sciences-Po, Paris, France
Prof. Raquel Xalabarder, Chair on Intellectual Property, Universitat Oberta de Catalunya, Barcelona, Spain

1. Introduction

The European Copyright Society (ECS) was founded in January 2012 with the aim of creating a platform for critical and independent scholarly thinking on European Copyright Law¹. Its members are renowned scholars and academics from various countries of the European Union, seeking to promote their views of the overall public interest. The Society is not funded, nor has been instructed, by any particular stakeholders.

This ECS opinion relates to a case pending before the EFTA Court, concerning application to register as trade marks the works of the Norwegian artist Gustav Vigeland. After his works fell into the public domain in January 2014, the Municipality of Oslo filed approximately 90 applications for registration as trade marks of signs consisting of visual works and sculptures by Vigeland. The Norwegian Patent Office refused most of the applications on the ground of lack of distinctiveness. The Norwegian Board of Appeal for Industrial Property Rights, before which appeal was filed, decided to request an Advisory Opinion before the EFTA Court. The key question asked of the Court is whether a work that is in the public domain under copyright law is eligible for trade mark protection. (More information on the case can be found at : www.eftacourt.int).

The ECS considers it necessary to comment on this trade mark case because the registration of a work of authorship in which copyright protection has expired could create an undesirable overlap of protection and thus give rise to what the US Supreme Court has called “mutant copyrights”.² This would disrupt the objectives and balance of copyright protection.

2. Starting Principles

It is generally accepted that it is desirable to protect copyright’s public domain and thus to preserve the freedom that we all enjoy to use of works in the public domain.

However, the cumulation of different forms of intellectual property protection is in general not problematic, as the different rights may pertain to different intangible subject-matter (even in the same artefact) or pursue different legitimate objectives. Courts have been willing to recognise cumulation in many cases in the past.

But, in some cases, cumulation may distort competition or may lead to a situation in which protection in one area of intellectual property law undermines the rationales and objectives of protection in another. This may be called ‘dysfunctional cumulation.’ When dealing with dysfunctional cumulation, one must remember that intellectual property rights are co-equal bodies of law that ought to be read in ways that reconcile and best effectuate their respective purposes.

¹ For more information on ECS : <https://europeancopyrightsociety.org/>.

² *Dastar v. Twentieth Century Fox*, 539 U.S. 23 (2003).

The overlap between copyright and trade mark laws has occurred mainly because of the expansion of their respective subject-matters and of the scope of trade mark law (which now protects against dilution and serves additional trade mark functions). As a result, trade mark law now sometimes provides protection which is effectively similar to that achieved by copyright law.

It is a forlorn task to seek to allocate hybrid copyright/trade mark subject-matter exclusively to one regime of protection or the other when the trade mark and the copyright work come into existence simultaneously (e.g. a logo or music especially composed to be a trade mark).

However, where a copyright work has clearly evolved in the cultural domain and has particular cultural and/or artistic significance, the grant of trade mark protection for such a symbol could lead to dysfunctional cumulation.

Both EU legislation and EU case law clearly provide for several safeguards against dysfunctional cumulation in relation to the copyright/trade mark overlap:

- (1) The **function of trade mark** is increasingly referred to in CJEU case law as a means of imposing proper boundaries on the grant and scope of trade mark protection.³ As regards the grant and maintenance of rights, use of a sign sufficient to maintain trade mark rights (or sufficient to acquire them, where distinctiveness is based on use) has to be use of the sign *as a mark* (i.e. to indicate the origin of products or services) rather than use of the sign for its expressive and creative value. Therefore, it should not be possible to register a sign with cultural value (and thus to perpetuate the now expired copyright protection through trade mark law) unless the sign indicates the origin of goods.
- (2) The basic **requirement of distinctive character** means that if a copyright work would be unlikely to be perceived as a mark it should not be protected. This would be the case, for example, if the work would mainly be perceived as a work of art and not as an indication of commercial origin. The CJEU and national courts have held that names⁴ and depictions⁵ of famous people are less likely to be distinctive. Linked to this, is the need to keep some signs free to use for all (art. 3(1) of the trade mark directive (now art. 4(1)(e) of the recast directive)).
- (3) Trade mark law recognises a number of **exclusions from registration** regardless of any purported distinctiveness of the sign in question, such as the optional exclusion of signs

³ See namely CJEU, *Arsenal v. Reed*, C-206/01, [2002] ECR I-10273; *L'Oréal Bellure*, C-487/07, [2009] ECR I-05185; *Google*, C-236/08, C-237/08, C-238/08, [2010] ECR I-02417; *Interflora*, C-323/09, [2011] ECR I-08625 (all on the harm to the function of trade mark as a factor for infringement); *Pie Optiek*, C-376/11 (notion of licensee eligible to a registration of a .eu domain name); *Leno Merken*, C-149/11 (notion of genuine use in the EU); *Leidseplein*, C-65/12.

⁴ CJEU, *Ruiz-Picasso v OHIM*, C-361/04 P [2006] ECR I-00643.

⁵ See e.g. *Marlene Dietrich-Bildnis*, German federal court of Justice (2008) GRUR 1093; *Mona Lisa*, German Federal patents court (1998) GRUR 1021.

of high symbolic value, which could be understood to include works of art which have this particular status (art. 4(3)(b) of the 2015 recast trade mark directive on this, see answer to questions 1 to 3) and the functionality doctrine (art. 3(1)(e) of the 2008 trade mark directive, on this, see below answers to questions 4 and 5)

- (4) Trade mark law contains **limits on the scope of protection**, such as the need for adverse effect on the functions of marks, the express exemptions found in Article 12 of the 2015 Trade Mark Directive and Regulation (which recital 21 explains as incorporating concerns such as freedom of expression), and the open-ended defence of “due cause”, which has been used to protect freedom of art (art. 5(2) trade mark directive).⁶
- (5) The Court of Justice has emphasised that copyright law should not be applied in such a way that it circumvents the exhaustion of a trade mark right.⁷

These principles of trade mark law suggest that overreach/overprotection resulting from the copyright/trade mark overlap should be resolved within trade mark law wherever possible without resorting to the application of an external norm. It is arguable that a robust application of the basic principles of trade mark law, as sketched above, should be sufficient to protect the public domain without resort to Art 3(1)(f). However, there may also be reason to fear that courts may face difficulties in using these doctrines effectively and consistently, so that in certain cases it may turn out that resort to the absolute ground of public policy may be required.

The EFTA court should therefore apply these trade mark law principles in answering the questions before it. On this basis, we would answer the referred questions as below.

3. Proposed Answers to Referred Questions

1. *May trade mark registration of copyright works, for which the protection period has expired, under certain circumstances, conflict with the prohibition in Article 3(1)(f) of the Trade Marks Directive on registering trade marks that are contrary to ‘public policy or ... accepted principles of morality’?*

Article 3(1)(f) of the Trade Mark Directive sets forth the absolute ground for refusal of trade marks that are ‘contrary to public policy or to accepted principles of morality.’ In international law, Article 6^{quinquies} B (3) Paris Convention also reflects this ground for refusal.

From the outset, it is to be noted that the test for refusal on the basis of a conflict with public order or morality has traditionally been based on an assessment of the extent to which the sign

⁶ see e.g. *Milka* case, German Federal Court of Justice, 3 Feb. 2005 (2005) GRUR 583.

⁷ See ECJ, *Dior v. Evora*, C-337/95, [1997] ECR I-06013.

for which protection is sought would – in itself - be deemed offensive by a sufficiently broad section of the public. As the Grand Board of Appeal of OHIM pointed out,

‘the Office should not refuse to register a trade mark which is only likely to offend a small minority of exceptionally puritanical citizens. Similarly, it should not allow a trade mark on the register simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable.’⁸

Seeking to find a middle ground between these two poles, the Grand Board concluded that the sign had to be assessed ‘by reference to the standards and values of ordinary citizens who fall between those two extremes.’⁹ These guidelines indicate clearly that the focus has traditionally been on the offensive character of the sign as such, or the offensive character of the use of a particular sign in respect of objectionable goods or services.¹⁰

The exclusion on the ground of public order was also applied to signs of symbolic value in the decision of the General Court in *Couture Tech Ltd*. In that case, trade mark protection was sought for a figurative sign representing the coat of arms of the former Soviet Union.¹¹ The application had been rejected by OHIM on the ground that, in Latvia and Hungary, the registration of official symbols of the former USSR would conflict with public policy. Confirming this decision, the General Court pointed out that, in the assessment of a sign’s offensive character, national circumstances which were likely to influence the perception of a mark by the relevant public were relevant.¹² It was obvious that the mark applied for would be considered offensive by a substantial part of the public in Hungary and Latvia. As a result, the application for registration had to be refused.¹³

Following this traditional approach to the exclusion of signs that are contrary to public order or morality, signs of cultural significance (such as signs based on Gustav Vigeland’s creations) would only be refused where a cultural sign is placed in an objectionable context, for instance, because of the goods or services involved. An attempt to register a sign derived from Pablo Picasso’s famous painting ‘Guernica’ for the sale of weapons might be an example of such a case, in which the goods concerned contradict the meaning of the affected cultural sign. The room for invoking the absolute ground for refusal with regard to cultural signs is thus quite limited under the traditional approach.

Not surprisingly, courts have been hesitant to apply the public order/morality exclusion in cases of signs of cultural significance in the past. The *Mona Lisa* decision of the German Federal Patent Court serves as an example. The case concerned an attempt to register the famous

⁸ BoA, 6 July 2006, R 495/2005-G, *Jebaraj Kenneth trading as Screw You v. OHIM (SCREW YOU)*, para. 21.

⁹ BoA, *ibid.*

¹⁰ BoA, *ibid.*, para. 30. See also BoA, 25 March 2003, R 111/2002-4, *Dick Lexic Ltd. v. OHIM (DICK & FANNY)*.

¹¹ Gen. Court, 20 September 2011, *Couture Tech Ltd v. OHIM T-232/10*, (Soviet coat of arms), EU:T:2011:498.

¹² *Ibid.*, para. 36 and 53.

¹³ The same would apply to Nazi symbols or to the insignia of terrorist organisations; see EUIPO Examination Guidelines Part B Section 4, 2.7.1.1, No. 1 and 2, with reference to the list set up by the EU of list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory and the prohibition of the use of Nazi symbols in German and Austrian criminal law.

Leonardo da Vinci painting as a trade mark. Rejecting the application, the German Federal Patent Court held that the applicant had failed to establish the requisite distinctiveness. Because the painting was frequently used by third parties in advertising, the public would regard the Mona Lisa as a mere advertising instrument rather than as an indication of source.¹⁴ The Court also held that, because of its frequent use in advertising, the painting had become customary in established trade practices.¹⁵ However, the Court was unwilling to accept the further argument that registration of the Mona Lisa was contrary to public policy or accepted principles of morality. In the Court's view, the appropriation of the Mona Lisa on the basis of trade mark law would not violate the principle that cultural expressions should remain freely available for the public after the expiry of copyright protection.¹⁶

This German decision sheds light on the difficulty of applying the public order/morality exclusion to signs of cultural significance. The invocation of this absolute ground for refusal in such cases would require a broadening of its scope. Instead of asking whether the sign, or the relation between the sign and the goods or services is – in itself - offensive, the conflict with public order or morality would have to be derived from the fact that an attempt is made to employ trade mark protection as a vehicle to re-appropriate a sign that has entered the public domain. The potential conflict with public order/morality would have to be identified as arising where the commercial use of a cultural sign (which is inherent in trade mark protection) might blur or even erode its genuine cultural meaning. Alternatively, the norms of copyright law, which provide only for a limited term of protection, could be regarded as forming an important element of public policy and, as a result, any attempt to make inroads into the public domain by acquiring trade mark rights might be regarded as contrary to public order. Two opinions of CJEU Advocates General support the public interest argument against the registration of certain signs in order to perpetuate exclusive rights of patent or of copyright beyond the appropriate term.¹⁷ In the *Shield Mark* case, the Advocate General found it “difficult to accept (...) that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys”.¹⁸

¹⁴ German Federal Patent Court, 25 November 1997, case 24 W (pat) 188/96, *Mona Lisa*, *Gewerblicher Rechtsschutz und Urheberrecht* 1998, p. 1022.

¹⁵ German Federal Patent Court, *ibid.*, p. 1023. For case comments, see Senftleben, *supra* note 6, p. 102-104; Assaf 2009, 5; A. Ohly, “Von einem Indianerhäuptling, einer Himmelscheibe, einer Jeans und dem Lächeln der Mona Lisa – Überlegungen zum Verhältnis zwischen Urheber- und Kennzeichenrecht”, in: L. Pahlow/J. Eisfeld (eds.), *Grundlagen und Grundfragen des Geistigen Eigentums, Festgabe für Diethelm Klippel zum 65. Geburtstag*, Tübingen: Mohr Siebeck 2008, p. 203; F. Klinkert/F. Schwab, “Markenrechtlicher Raubbau an gemeinfreien Werken – ein richtungsweisendes „Machtwort“ durch den Mona Lisa-Beschluss des Bundespatentgerichts?”, *Gewerblicher Rechtsschutz und Urheberrecht* 1999, p. 1067; W. Nordemann, “Mona Lisa als Marke”, *Wettbewerb in Recht und Praxis* 1997, p. 389.

¹⁶ German Federal Patent Court, 25 November 1997, case 24 W (pat) 188/96, *Mona Lisa*, *Gewerblicher Rechtsschutz und Urheberrecht* 1998, p. 1021 (1023).

¹⁷ Opinion of the Advocate General Ruiz-Jarabo Colomer, *Phillips*, C-299/99; Opinion of the Advocate General Ruiz-Jarabo Colomer, *Shield Mark BV*, C-283/01, para. 31.

¹⁸ Opinion of the Advocate General Ruiz-Jarabo Colomer, *Shield Mark BV*, C-283/01, para. 52.

Save for these references to the public interest, the public order/morality exclusion has not yet been understood in this broader sense. As the German *Mona Lisa* decision shows, courts seem to assume that potential problems arising from the registration of cultural signs as trade marks can be solved on the basis of other checks and balances within the trade mark system, such as the basic requirement of distinctive character.

This assumption may not always be correct. Taking the *Mona Lisa* decision as an example, it may be said that the exclusion of the *Mona Lisa* registration because of a lack of distinctive character following from the painting's widespread use in advertising is a weak safeguard against the sign's misappropriation in a commercial context because non-distinctive, descriptive and generic signs can acquire the required distinctive character as a result of use in trade. The decision of the German Federal Patent Court thus raises the possibility that the obstacle to registration may be overcome through intensive use of the sign in product marketing and advertising. Once consumers have been taught to perceive the *Mona Lisa* as a source identifier referring to the applicant's enterprise, registration of the famous painting would become possible. Exclusion of registration based on a conflict with public policy and principles of morality would be more robust. The demonstration of distinctive character acquired through use would not be sufficient to surmount this hurdle to registration. In contrast to a refusal based on lack of distinctiveness, the rejection of a trade mark application on the ground that it is contrary to public policy and principles of morality would thus exclude trade mark protection altogether – irrespective of whether the painting is distinctive or not. The risk of the removal of a painting such as the *Mona Lisa* would thus also be eliminated permanently.

In the *Vigeland* case, concerns about the commercial exploitation and redefinition of signs of cultural significance in a trade context would appear to be less pressing because the application for trade mark registration has been filed by a cultural heritage institution and not by a commercial undertaking. However, even in such a case, the question remains whether the registration of signs of cultural significance, such as *Vigeland's* works, is a desirable development. The grant of trade mark rights in *Vigeland's* creations might form part of an art custodianship initiative aiming to preserve his works rather than serving to erode their genuine cultural meaning. Nonetheless, it is doubtful whether cultural heritage institutions should be encouraged to spend part of their budget on the acquisition and maintenance of trade mark rights – instead of investing these financial resources more appropriately. Moreover, it is doubtful whether cultural heritage institutions would be capable of competing with commercial players if the acquisition of trade mark rights to cultural material becomes a widespread practice.

Furthermore, the registration of signs of cultural significance for products or services that are directly related to the cultural domain may seriously impede the free use of works which ought to be in the public domain. For example, the registration of the title of a book for the class of products including books, theatre plays and films, would render meaningless the freedom to use public domain works in new forms of exploitation.

2. *If question 1 is answered in the affirmative, will it have an impact on the assessment that the copyright work is well-known and of great cultural value?*

See the answer to Question 1 above. Following a traditional approach to the absolute ground for refusal based on public order or morality, the great cultural value of a copyright work would not have much influence on the decision.

If the outlined broader approach is taken, it may be said that signs of great cultural value are particularly vulnerable when it comes to attempts to derive commercial benefit from the positive connotations that are already attached to such a sign. In that case, the fame or great value of a copyright work could constitute a factor supporting the application of the public order/morality exclusion.

3. *If question 1 is answered in the affirmative, may factors or criteria other than those mentioned in question 2 have a bearing on the assessment, and, if so, which ones?*

As already indicated, trade mark law does not specifically deal with cultural concerns, such as the erosion of a sign's cultural meaning in the context of commercial exploitation. Against this background, it could make sense to apply the absolute ground for refusal based on public order or morality as a starting point to include these concerns in the registration analysis. Relevant questions could be:

- * the extent to which use as a trade mark is likely to blur the genuine cultural meaning of the sign concerned and diminish its value in the context of use for cultural purposes;
- * the extent to which the trade mark right would prevent free availability, communication, adaptation and new uses of the public domain work
- * the extent to which registration would give the applicant an unfair competitive advantage because he could avail himself of positive connotations and associations which the sign already has because of its particular cultural value.

4. *Is Article 3(1)(e)(iii) of Directive 2008/95/EC applicable to two-dimensional representations of sculptures?*

Article 3(1)(e) TMD does not define the signs which must be considered "shapes" within the meaning of that provision. As a starting point, it should be considered that the General Court noted that the parallel provision of Article 7(1)(e) CTMR 'makes no distinction between three-

dimensional shapes, two-dimensional shapes, or two-dimensional representations of three-dimensional shapes. Hence, it must be held that Article 7(1)(e) of Regulation No 207/2009 may therefore apply to two-dimensional shapes'.¹⁹ This view is supported by the rationale underlying the grounds for refusal [and invalidity] in Article 3(1)(e). The provision deals *inter alia* with issues which may arise from the cumulation of different forms of protection under trade mark law and other intellectual property rights.

Under EU trade mark law, cumulation of trade mark protection with other forms of intellectual property protection is not inherently objectionable. Many figurative and sound trade marks are also protected by copyright law. In cases of merchandising, this is normally assumed to be unproblematic. Provisions in the current EU Directive can be understood to support this proposition. For example, Article 4(4)(c) TMD (now: Article 5(4)(b) of the 2015/2436 TMD) assumes that a sign protected by intellectual property rights may be registered as a trade mark by a party other than the holder of a prior and conflicting intellectual property right over the sign, provided that the latter consents to registration by the former. A necessary implication of this provision is that a sign may be registered as a trade mark and, at the same time, form the subject matter of other systems of intellectual property protection.

However, other provisions of EU trade mark law indicate that cumulation may become problematic under specific circumstances. In connection with the ground of refusal under Article 7(1)(e)(ii) TMR, it was held that “when the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution. In the system of intellectual property rights developed in the European Union, technical solutions are capable of protection only for a limited period, so that subsequently they may be freely used by all economic operators.”²⁰ In a similar vein and with specific reference to two-dimensional shapes, the General Court has held that “it follows from the case-law that the rationale of the ground for refusal in Article 7(1)(e)(ii) of Regulation No 207/2009 is to prevent trade-mark protection from granting its proprietor a monopoly over technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 7(1)(e) of Regulation No 207/2009 is thus intended to prevent the protection conferred by the trade-mark right from being extended beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale goods incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark”.²¹

This ECJ case law dealt with the ground of refusal under the second indent, (ii), of Articles 7(1)(e) TMR and 3(1)(e) TMD. Other cases refer to the ground of refusal under the third indent, (iii), of the same provisions.²² In one case, the existence of the substantial value of the shape

¹⁹ Gen. Court, 8 May 2012, *Yoshida Metal Industry Co. Ltd.*, T-331/10, para. 24

²⁰ CJEU, 14 September 2010, *Lego Juris A/S v OHIM and Mega Brands Inc.*, C-48/09 P., [2010] ECR I-08403.

²¹ in Gen. Court, *Yoshida Metal Industry Co. Ltd.*, T-331/10; See also ECJ, 8 April 2003, *Linde, Winward, Rado*, C-53 to 55/01, [2003] ECR I-0316, para. 72.

²² See ECJ, 20 September 2007, *Benetton Group v G-Star International BV*, C-371/06, [2007] ECR I-07709, para. 28. and Gen. Court, 6 October 2011, *Bang Olufsen A/S v OHIM*, T-508/08.

was established on several grounds: “the shape for which registration was sought reveals a very specific design and the applicant itself admits, at paragraph 92 of the application in particular, that that design is an essential element of its branding and increases the appeal of the product at issue, that is to say, its value”.²³ In a more recent decision, the CJEU makes it clear that one of the aims of Article 3(1)(e)(iii) is to prevent the exclusive and permanent right conferred by a trade mark from serving indefinitely to extend the life of rights which the EU legislature has sought to restrict to limited periods and that the concept of “shape which gives substantial value to the goods” in this connection includes shapes which perform an “aesthetic function” or, in other words, shapes which have an “artistic” or “ornamental” value (while not being necessarily limited to such shapes).²⁴

As the rationale underlying the third indent of Article 3(1)(e) is parallel to the one underlying the second indent, it would appear that, in principle, the notion of “shape” adopted by the two provisions should be the same. This conclusion seems to be followed by national case law, which has applied the domestic provision corresponding to the third indent to cases where the shape was two-dimensional rather than three-dimensional.²⁵

²³ Gen. Court, 6 October 2011, *Bang Olufsen A/S v OHIM*, T-508/08, para. 74.

²⁴ CJEU, 18 September 2014, *Hauck GmbH v Stokke AS*, C-205/13, paras 31 and 32

²⁵ See in this connection Trib. Torino 13 January 2009, *Cosci F.lli di Franco and Sergio & C. s.a.s. v Bottega Veneta International s.r.l.*, in *Giur. it.* 2009, 1967 ss. with comment by C. Mezzetti, *Brevi note sugli impedimenti alla registrazione dei marchi di forma*, case «Bottega Veneta» (which actually concerned a pattern of intertwined leather strips which might have been considered a three-dimensional shape; however, the Tribunal considered them two-dimensional for the purpose of assessing the ground of invalidity as the pattern formed the surface of the product, a bag). The same approach was adopted earlier by Cass. 23 November 2001, n. 14863, *Etro s.p.a. v Ministero dell'Industria, del Commercio e dell'Artigianato – Ufficio Italiano Brevetti*, in *Giur. ann. dir. ind.* 4334, case «Etro» and by Cass. 29 May 1999, n. 5243, *Burberrys LTD v Geconf 2000 s.p.a.*, in *Dir. Ind.*, 2000, 117 ss.; in *Foro it.*, 2000, I, 3298 ss. and in *Riv. dir. ind.*, 2000, II, 3 ss. with comment by I. Calboli, *Affermazioni e contraddizioni nella ricerca di uno “spazio reale” per i marchi di forma*, case «Burberry».

5. *Is Article 3(1)(c) of Directive 2008/95/EC applicable as legal authority for refusing trade marks that are two or three-dimensional representations of the shape or appearance of the goods?*

The language of Article 3(1)(c) TMD, which concerns “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services”, would at first glance appear to suggest that the corresponding ground of refusal or invalidity concerns language or semantic symbols, as suggested by reference to “signs and indications” which “designate” the relevant characteristics.

However, the case law has been quick to recognize that not only linguistic or semantic expression may be “descriptive” in the meaning of the provision. Indeed, a three-dimensional shape which conforms to the idea or to a generalized representation that the relevant public may have of the goods for which registration is sought may be as much descriptive of those goods as the linguistic expression describing them in words. Thus, for example, while the expression “wrist-watch” is not registrable as a trade mark for products such as wrist-watches as it is an expression that should remain free for general use by all businesses, the same principle applies to a three-dimensional shape which represents a product in a manner which conforms to the relevant public’s impression of the configuration of the product in question. More specifically, the ECJ has held that “In regard to Article 3(1)(c) of the Directive in particular, there is nothing in principle to stop that provision applying to an application for a three-dimensional shape of product trade mark. The reference to trade marks which consist exclusively of signs or indications which may serve to designate characteristics of the goods or service other than those expressly referred to in that provision is sufficiently broad to cover a wide variety of trade marks, including three-dimensional shape of product trade marks.”²⁶

This holding is not limited to three-dimensional shapes. In fact, the third case decided by the ECJ concerned not a three-dimensional mark as such but the graphic representation of a three-dimensional shape. The reasoning was the same. The need to preserve competitors’ freedom to use a sign which is descriptive of common or standardized features of an article applies whether those features are described by language, by a three-dimensional shape or by the graphic representation of that shape.

Therefore, it would appear that the question should be answered in the affirmative at least in principle.²⁷ Whether the ground would then apply under the specific circumstances of the case is a different question which in any event falls entirely within the jurisdiction of the domestic remitting court. The outcome would depend on the specific goods for which the trade mark application is made. This is an issue on which no information is available. If the application

²⁶ ECJ, 8 April 2003, *Linde AG, Winward Industries Inc. and Rado Uhren AG*, C-53/01 to C-55/01, [2003] ECR I-0316.

²⁷ For the same conclusion see ECJ, 4 October 2007, *Naipes Heraclio Fournier v OHIM*, C-311/05 P and Gen. Court, 11 May 2005, *Naipes Heraclio Fournier SA v OHIM and France Cartes SAS*, T-160/02 to 162/02.

concerns Vigeland's works specifically, as may well be the case because trade marks may be registered for goods including works (publication, articles, books), or services including activities relating to those works (exhibitions, conference, seminars), the descriptive character would be rather clear. It cannot, however, be ruled out altogether that a two-dimensional or three-dimensional representation of a specific work by Vigeland may not be subject to this ground of refusal if the goods applied for were unrelated to artistic works (e.g. registration for products such as electronic software, for example).

6. *If question 5 is answered in the affirmative, is Article 3(1)(b) and (c) of Directive 2008/95/EC to be understood to mean that the national registration authority, in assessing trade marks that consist of two or three-dimensional representations of the shape or appearance of the goods, must apply the assessment criterion of whether the design in question departs significantly from the norm or customs of the business sector, or may the grounds for refusal be that such a mark is descriptive of the shape or appearance of the goods?*

If question 5 were answered in the affirmative, Question 6 would become moot. The different grounds for refusal and invalidity are independent. A sign falling under sub c) of Article 3(1) TMD would automatically be held to be devoid of distinctive character.²⁸ The question would arise, though, in the event that the sign is not found descriptive under sub c) of Article 3(1) TMD. In that event, the shape would indeed have to depart significantly from the norms of the business sector;²⁹ but again the application of this principle would depend on the goods for which the application has been made.

²⁸ ECJ 12 February 2004, *Koninklijke KPN Netherland NV and Benelux-Markenbureau*, C-363/99, [2004] ECR I-01619, para. 85.

²⁹ Gen. Court, 14 December 2011, *Louis Vuitton Malletier v OHIM and Friis Group International ApS*, T-237/10, paras 18 and 19.