

SHAPE MARKS

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SHAPE MARKS

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1. **INTRODUCTION**

The shape marks covered by this chapter includes two-dimensional and three-dimensional shape marks.

2. RELEVANT LEGISLATION

Trade Marks Act [Cap. 332, 2005 Ed.]

Absolute grounds for refusal of registration

7. —(1) The following shall not be registered:

- (a) signs which do not satisfy the definition of a trade mark in Section 2(1);
- (b) trade marks which are devoid of any distinctive character;

(c) 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, the time of production of goods or of rendering of services, or other characteristics of goods or services; and

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of —

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

Trade Marks Rules

Application for registration

15. An application for the registration of a trade mark shall be made on Form TM 4 (referred to in this Part as the application form) and shall contain a clear indication of the nature of the mark.

16. — (4) Where the Registrar reasonably believes that the representation provided by the applicant does not sufficiently show the particulars of the mark or does not allow all features of the mark to be properly examined, the Registrar may, by notice in writing, require the applicant to provide, within such time as the Registrar may specify in the notice, any or all of the following:

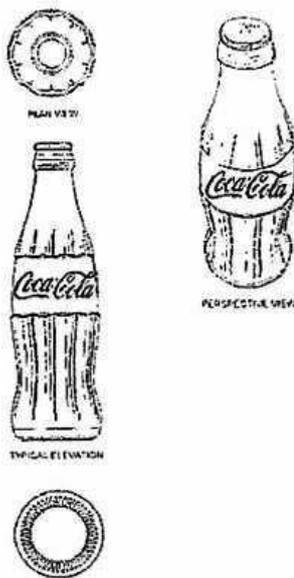
- (a) another representation of the mark consisting of a single view of the mark or of several different views of the mark;
- (b) a description of the mark expressed in words;
- (c) such other information as the Registrar may require.

(6) The Registrar may at any time, if dissatisfied with any representation of a trade mark, require another representation satisfactory to him to be filed before proceeding with the application, and the applicant shall substitute the representation by filing with the Registrar Form TM 27.

3. REPRESENTATION AND DESCRIPTION OF SHAPE MARKS

The representation of a shape trade mark (referred herein as “shape mark”) should where practicable, be in the form of a perspective or isometric drawing that shows clearly all the features of the shape mark.

See example below:

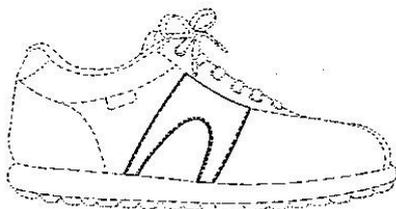


Trade mark number: T0806389H

Description of Particular Feature(s) of the mark: The mark consists of the 3-dimensional shape of a bottle with words "Coca-Cola" appearing thereon as shown in the representation on the form of application.

The parts of the configuration claimed to constitute the shape mark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines.

See example below:



Trade mark number: T0719222H

Description of Particular Feature(s) of the mark: The trade mark consists of a three-dimensional shape of a bridge-shaped arch design applied to the left and right sides of a shoe, as shown in the representation on the notification of international registration. The shape of a shoe, which is represented by a dotted pattern does not form part of the trade mark.

(See Chapter on “What is a trade mark?” for more details on how shape marks should be graphically represented.)

3.1 Description of the mark

An applicant should ensure that there is no discrepancy between the description and the graphical representation of the shape mark. The relationship between the description and graphical representation of the shape mark must be clearly spelled out, for example by including a **cross reference** to the graphical representation in the description. It is important to note that such a description is an integral part of the graphical representation of the shape mark.

If a description is supplied after filing, then care should be taken to ensure that the description is exactly in accordance with the shape mark as filed. Any difference between the graphical representation and description would affect the identity of the shape mark and, therefore, would not be allowable.

The Examiner will usually require that the description includes words such as “... as shown in the representation on the application” to qualify that the description is limited by reference to the drawing or graphical representation.

3.2 Indication on the application form

If the applicant is seeking protection for a shape mark, he should tick the appropriate box on the application form. Rule 15 of the Trade Marks Rules (“**Rules**”) states that an application for the registration of a trade mark shall be made on Form TM4 and shall contain a clear indication of the nature of the mark.

This indication, together with the graphical representation and description, will indicate clearly that the applicant is applying for a shape mark.

4. SECTION 7(3) OBJECTIONS APPLICABLE TO 2-DIMENSIONAL AND 3-DIMENSIONAL SHAPE MARKS

Section 7(3) objections can be raised for 2-dimensional and 3-dimensional graphical representations so long as the indication and description on the application form indicate that the applicant is applying for a shape mark. This was the approach taken in *Philips v Remington* [1998] R.P.C. 283. The sign in question was a picture of the head of a three-headed shaver and it was found objectionable under an equivalent of our Section 7(3)(b) – that the sign was of a shape which was necessary to obtain a technical result and shall be refused registration.

5. **THE TEST FOR REGISTERING SHAPE MARKS**

As a general guide, the following should be considered when examining shape marks:

Step 1

The examiner must consider whether any grounds of refusal under Section 7(3) of the Trade Marks Act (“Act”) apply. If so, such grounds of refusal under Section 7(3) of the Act cannot be overcome through evidence of acquired distinctiveness under Section 7(2) of the Act.

Step 2

The examiner must ensure that the criteria for distinctiveness of the shape itself have been met, otherwise the grounds of refusal under Section 7(1) of the Act will apply.

Under Step 2, the ultimate question is whether the shape is so materially different from basic, common or expected shapes, such that it enables a consumer to identify the goods just by their shape and to buy the same item again if he has had a positive experience with the goods.

Generally, the distinctive character of a trade mark must be judged in light of the goods or services for which the trade mark is registered. This applies not only to word marks, but also to unconventional marks such as shapes, packaging and colours. Whether a trade mark is distinctive depends on how it is perceived by the relevant public. The relevant customers are reasonably well-informed, observant and circumspect of the goods or services in question. In most cases, they will perceive a trade mark as a whole product without paying attention to detail. Therefore, in order to decide whether a sign is distinctive, the overall impression must be studied.

Where protection is sought for a mark which consists of the shape of the goods claimed, the test for distinctiveness of such a mark is no different than that of the test for “ordinary” marks such as word or figurative marks.

However, while the same criteria of distinctiveness apply, it may be more difficult to establish that a shape mark has distinctive character in the eyes of the relevant public, compared to a word or figurative mark. This difference stems from the fact that shape marks usually represent a feature of the appearance of the good itself, and is therefore unable to serve as an identifier of source to the average consumer. This is not the case with word or figurative trade marks, since such marks consist of signs that generally do not represent descriptive features of the claimed goods.

To determine whether a shape (for which registration is sought) is capable of distinguishing one trader’s goods/services from the goods/services of all others, an applicant must consider whether the shape is one which other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use on or in connection with their goods.

(More detailed explanation of what is involved in each of the two steps is set out in the two sections following this.)

6. EXAMINATION UNDER SECTION 7(3) OF THE ACT

In examining the registrability of shape marks, the first hurdle will be whether the shape for which registration is sought falls afoul of Section 7(3) of the Act.

Sections 7(3)(a), (b) and (c) must be assessed independently. They cannot be collapsed into a single hybrid objection.

It must be noted that if the sign falls under any of the categories in Section 7(3), the sign cannot be registered as a trade mark since proof of acquired distinctive character will not overcome the refusal.

6.1 Section 7(3)(a) - Shapes resulting from the nature of the goods

Rationale

This ground prevents the registration of shapes that result from the nature of the goods claimed. It is not concerned with preventing the registration of marks consisting of the shapes of the goods themselves as shapes of distinctively shaped goods can function as a trade mark.

Application

The nature of the goods refers to their essential qualities or innate characteristics. For example, a sign consisting of the shape of a banana for bananas would be a shape which results from the nature of the goods themselves. So too, would a shape of a toothbrush for toothbrushes.

The shape of a rabbit, when applied on frozen cabbages, will not fall foul of Section 7(3)(a) of the Act as the shape of the mark cannot be said to result from the nature of the goods themselves.

To assess whether a shape is one which results from the nature of the goods, the Registrar will look at the goods in respect of which the trade mark seeks to be protected for to determine their nature, and consider the following:

- (i) The extent to which the shape is regarded as the “normal” shape of the goods;
- (ii) Where the goods have a “uniform” shape, whether the shape is a variation from the “uniform” shape; if so, the shape may not be objectionable on the ground that it results from the nature of the goods;
- (iii) Where the goods come naturally in a range of shapes, then any one of the usual shapes will be open to objections.

However, it is important to bear in mind that there may be more than one such basic shape, or several usual variations (for e.g., door handles may be round or lever style). To this extent, depending on the shape and claimed goods for which protection is sought, there may be some overlap between Section 7(3)(a) and Section 7(3)(b) of the Act.

With reference to *Societe Des Produits Nestlé SA v Petra Foods Ltd [2014] SGHC 252* (“*Nestlé*”), the following shapes would be excluded from registration under Section 7(3)(a) of the Act:

- (i) “Natural” products which have no substitute;
- (ii) “Regulated” products (the shape of which is prescribed by legal standards);
- (iii) Shapes consisting exclusively of characteristics ordinarily attributed to the goods in question;
- (iv) Shapes with essential characteristics which are inherent to the generic function or functions of the goods.

Other Examples

- A shape of a lemon as a proposed trade mark for lemons would not be acceptable because the sign would consist exclusively of a shape which results from the nature of the goods themselves – lemons.
- If the goods were lemon juice, then the shape of a lemon should not fall foul of Section 7(3)(a) of the Act. Likewise if the proposed mark was a yellow plastic container in the shape of a lemon, the shape may not be objected to on the ground that it results from the nature of the goods. However, even if a shape mark does not fall foul of Section 7(3)(a) of the Act, it may still attract other absolute grounds of objection under Section 7.

Where the specification is wide, “the goods” refer to any of the goods in respect of which the mark is sought to be registered. Thus, a shape of a banana for “fruit” would be just as objectionable as a shape of a banana for “bananas”.

Although the natural shapes of the goods in question cannot be registered, if the shape has been the subject of substantial design input, then this objection no longer applies.

Overlap with other grounds of refusal

There is some overlap between an objection under Section 7(3)(a) and the objections on the grounds that the mark is devoid of distinctive character (under Section 7(1)(b) of the Act) or that the mark exclusively designates the intended purpose or a characteristic of the goods (under Section 7(1)(c) of the Act). For example, where the trade mark is a shape of a lemon for “lemons”, obviously, objections can also be taken that the mark is descriptive and thus, not distinctive of the goods in question.

6.2 Section 7(3)(b) - Shapes that are necessary to obtain a technical result

Rationale

The purpose of this provision is to exclude shapes which are merely functional in the sense

that they are motivated by and are the result of technical considerations. In other words, it is to prevent a trade mark monopoly on technical solutions or functional characteristics, which a user is likely to seek in the products of competitors, from being granted to the proprietor. It is in the public interest to allow a shape, whose essential characteristics perform a technical function, to be freely used by all, and to prevent such shapes from being reserved to only one undertaking (see paragraphs 78 and 80 of *Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (“*Philips (ECJ)*”).

Application

In assessing whether the shape of the goods is necessary to obtain a technical result, one must consider the mark *as a whole* (as held in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2004] EWHC 2327 (Ch)* (“*Philips (UKCA)*”). Prior to ascertaining whether the mark consists exclusively of a shape of the goods that is necessary to obtain a technical result, the Registrar will first identify the mark’s essential features. Thereafter, the Registrar will ascertain whether *all* these features perform the technical function of the goods concerned (similar to the steps taken in *Case C-48/09 Lego Juris A/S v OHIM* (“*Lego*”) and *Nestlé*).

1. Determining the essential features of a shape mark

“Essential features” refer to the *most* important elements of a shape mark *to be registered as a trade mark* (see *Nestlé*). The identification of such features is determined on a case-by-case basis (e.g., taking into account the characteristics of the claimed goods and the perception of the average relevant consumer).

The identification is to be determined from the *overall visual impression* produced by the shape mark. The presumed perception or level of scrutiny of the average relevant consumer in relation to the claimed goods is a relevant, although not decisive, consideration in identifying the essential features. In *Nestlé*, the “rectangular slab shape” of the claimed shapes (Nestle’s 2-

Finger  and 4-Finger  marks), in relation to chocolate confectionery, is considered as an essential feature as it is said to be “especially pronounced” when viewed from above by the average relevant consumer. However, the “plinth” of the claimed shape is not considered as an essential feature as the average consumer is unlikely to visually pay attention to or scrutinise this feature.

It is important to note that not every functional element which contributes to the overall impression of the shape will be considered as an essential feature. During the identification process in relation to the essential features, the technical functions resulting from *any* part of the shape mark are irrelevant. It is only after the essential feature(s) of the shape mark has been identified, that the question as to whether the feature as a physical form or shape is necessary to obtain a technical result is to be examined.

2. Determining whether the essential features of a shape are functional

A sign consisting exclusively of the shape of the goods is unregistrable under this provision if the essential features of that shape are functional, or attributable only to the technical result (as decided in *Philips (ECJ)*).

The essential feature can be regarded as *functional* if:

- It is essential to the use or purpose of the goods. For example, the feature of a handle and blade assembly for a knife, necessary for the functioning of the knife.
- It is needed to achieve a particular technical result. For example, the vanes featured in a shape mark of a fan which will create a particular air flow pattern.
- It is a feature which has an engineering advantage, resulting in superior performance. For example, a new invented device for slicing bananas that is easier to use than existing devices.
- It is essential to the efficient manufacture of the goods. For example, a spherical shape of a sweet that allows for speedy manufacturing and packaging required for commercial production.

In assessing an application against Section 7(3)(b) of the Act, the Registrar will consider what the nature of a “technical result” is likely to be for the claimed goods. The term should be interpreted broadly and, besides the more obvious types of technical functions, includes shapes which, for example:

- Fit with another article;
- Give the most strength;
- Use the least material; or
- Facilitate convenient storage or transportation.

The fact that there are other shapes which allow the same technical result to be obtained cannot be used to overcome a ground for refusal under Section 7(3)(b) of the Act. In *Nestlé*, the “breaking grooves” appearing in the shape mark resembling a chocolate bar were ruled as functional in nature. Although the presence of a “breaking groove” may not be necessary to break a chocolate bar down for consumption, it is still deemed as a functional feature as it is a more efficient method that allows for a cleaner, easier and more aesthetically pleasing break of a chocolate bar.

Shapes which are the subject of a claim in a patent application are not exempted from an objection under Section 7(3)(b) of the Act. The functional claims made about the shape are *prima facie* evidence that those aspects of the shape are necessary to achieve a technical result. In *Lego*, the European Court of Justice affirmed that the technical functionality of the characteristics of a shape may be assessed by, among other grounds, taking into account the

documents relating to previous patents describing the functional element of the shape concerned, and noted that the Grand Board of Appeal of OHIM and the General Court had indeed taken such documents into consideration with regard to the registrability of the Lego brick.

If the shape of the trade mark is essentially functional with a technical advantage that has yet to become commonplace, its utility should remain open for all to use, and an objection under Section 7(3)(b) should be raised. An example could be a new shape of a can opener which is easier to use than those currently on the market.

3. Aesthetic features or non-functional features in the shape

The fact that a shape consists of certain aesthetic or non-functional features does not prevent the operation of Section 7(3)(b) objection if they are not the essential features (i.e. most important elements of the shape) or they are merely part of the essential features, the totality of which is to perform a function attributable to a technical result. In *Philips (UKCA)*, the court agreed with Rimer J's observation that the "clover leaf" feature of the three-headed shaver was not an essential feature of the shape mark.

Trivial embellishments are unlikely to be sufficient to overcome an objection under Section 7(3)(b) of the Act. For example, a knife with a handle engraved with simple stripes is still deemed objectionable as the stripes are minor arbitrary elements in the three-dimensional sign. It does not alter the conclusion that the sign consists exclusively of the shape of goods which is necessary to obtain a technical result.

However, the ground for refusal under Section 7(3)(b) of the Act is not applicable if the shape of the goods at issue incorporates a major non-functional element, such as an imaginative element which plays an important role in the shape.

Overlap with other grounds of refusal

Overlap with Section 7(3)(a) of the Act

A shape which is necessary to obtain a technical result may be regarded as resulting from the nature of the goods, or a shape which results from the nature of the goods may be regarded as being necessary to obtain a certain technical result. The partial overlap in the 2 sections is mentioned by the Court of Justice of the European Union (CJEU) in *Hauck GmbH & Co KG v Stokke A/S, Stokke Nederland BV, Peter Opsvik and Peter Opsvik A/S*, where the key difference is said to depend on the perspective one asks the question:

- Determining whether the shape results from the nature of the goods: If the generic function of a good is X, would it be "natural" for the shape of such a good to possess an essential feature Y?
- Determining whether the shape is necessary to obtain a technical result: If a good possesses a natural essential feature Y, would the essential feature enable a *specific* good to perform a technical function X?

The partial overlap is illustrated with an example in *Nestlé*, where an essential feature, which is an *obvious* technical solution for the efficient manufacture of a *specific* good, may be expected to be commonplace among similar types of goods and for the goods to adopt a similar form, and hence suggested to be the “general or inherent nature of the shape” of the goods concerned.

Overlap with Section 7(1) of the Act

A shape which is necessary to obtain a technical result may likely indicate the intended purpose of the goods, or it may be customary in the trade and therefore, non-distinctive. Thus, the grounds under Section 7(1)(b) (that the shape is devoid of distinctive character), Section 7(1)(c) (that the shape exclusively designates the intended purpose or a characteristic of the goods) and Section 7(1)(d) (that the shape is a shape that is customary in the bona fide and established practices of the relevant trade) may also apply to refuse a registration of the shape mark, in addition to an objection under Section 7(3)(b) of the Act.

For example, in *Philips (UKCA)*, Remington raised the equivalent of Sections 7(1)(b) or (c) of the Act as grounds of invalidation of the Philips shape mark, in addition to Section 7(3)(b). However, in that case, the UK Court of Appeal, while taking the view that invalidation was made out under the equivalent of Section 7(3)(b), determined that the stylized presentation of the shaving head had distinctive character.

4. Request for additional information where a section 7(3)(b) objection may be contemplated

With reference to the circular “Examination Practice with respect to Shape Marks” ([Circular No. 2/2017, dated 24 Feb 2017](#)), the Registry may request, by way of an Office Action, for additional information for trade mark applications comprising shape marks where a section 7(3)(b) objection may be contemplated. Specifically, the applicant may be requested to:

- (i) State the essential feature(s) of the shape mark; and
- (ii) Provide relevant information on whether the essential feature(s) would be necessary to obtain a technical result.

6.3 Section 7(3)(c) - Shapes which give substantial value to the goods

Rationale

The purpose of this provision is to exclude “aesthetic-type shapes” (i.e., shapes which have eye appeal or are purchased primarily because of the eye appeal) from registration. This prevents conferring on the applicant the exclusive and permanent right (which a trade mark confers) from serving to extend the life of other rights which the legislature has sought to make subject to ‘limited periods’, such as design rights.

Application

A three-dimensional shape falls afoul of Section 7(3)(c) of the Act, if the shape, as a shape,

adds substantial value to the good and influences the purchase of the good.

In other words, in determining whether Section 7(3)(c) of the Act applies, the value of a good attributable to other factors such as goodwill and reputation, scent, use of quality materials and durability are to be excluded.

As held in *Nestlé*, the following should be taken into consideration when assessing whether the value is substantial:

- The public’s perception of the shape of the product;
- The nature of the category of goods concerned;
- The artistic value of the shape in question;
- Its dissimilarity from other shapes in common use on the market concerned;
- A substantial price difference in relation to similar products; and
- The development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.

The decision whether a shape gives substantial value requires a comparison between the shape sought to be registered and shapes of equivalent articles. It is only if the shape has, in relative terms, substantial value that it will be excluded from registration.

Additionally, bearing in mind that something of aesthetic value is a matter of personal taste, whether a shape gives substantial value to the goods is dependent on whether there is a significant section of the public to whom the inherent qualities of the shape appeal strongly to, so as to contribute substantially to the value of the goods in their eyes.

In *Dualit Ltd. v. Rowlett Catering Ltd, UK Trade Marks Opposition Decision (0/186/98)* (“*Dualit*”), the tribunal held that there was survey evidence to show that the aesthetics of the three-dimensional toaster mark appealed to the potential consumers of those products. There was also evidence that the aesthetic appeal of the mark on the goods allowed applicants to charge a premium for the toasters. This therefore resulted in a refusal of registration under Section 3(2)(c) of the UK Trade Marks Act (the equivalent of Section 7(3)(c) of the Act).

In *Bang & Oflusen A/S v OHIM (Case T-508/08)*, the European Court of Justice found that

the shape sought for registration (, as a whole, created a striking design which could be remembered easily. The applicant in that case had also admitted that the design was an essential element of its branding and increased the appeal of the product and its value. Further, evidence submitted on the applicant’s behalf, namely extracts from distributors’ websites and on-line auction or second-hand websites, emphasised the aesthetic characteristics of the shape and that the shape was to be perceived as a kind of pure, slender, timeless sculpture for music

reproduction. The mark was therefore refused for registration under Article 3(1)(e)(iii) of the EU Council Directive (the equivalent of Section 7(3)(c) of the Act).

7. EXAMINATION UNDER SECTION 7(1) OF THE ACT

7.1 Whether the shape is devoid of distinctive character

Even if a shape mark is not objectionable under Section 7(3) of the Act, it is still necessary to ascertain whether the mark is to be refused registration under one or more of the absolute grounds for refusal under Section 7(1).

The European Court of Justice in *Philips (ECJ)* has affirmed that there is no special category of marks which even though distinctive in fact are nonetheless incapable of distinguishing as a matter of law. This means that there is no need to consider whether the shape mark is objectionable under Section 7(1)(a) as a shape mark can, by itself, function as a trade mark. What needs to be considered is whether the shape mark is objectionable under Sections 7(1)(b) to (d).

With respect to the absolute grounds of refusal, there is no distinction between the different categories of trade marks. The criteria for assessing the distinctive character of shape marks are thus no different from those to be applied to other categories of marks. As such, in order to be capable of distinguishing the goods, the shape of an article in respect of which a sign is registered does not require any capricious addition e.g., an embellishment which has no functional purpose.

The test is simply, whether the mark serves to identify the goods in respect of which registration is applied for as originating from a particular source, and thus, is capable of distinguishing the goods and services of one trader from goods and services of other traders. The distinctiveness of a trade mark must be assessed by reference to first, the goods or services in respect of which registration is sought and second, by reference to the perception of the relevant consumers of the goods or services.

It is relevant to look at the presumed expectations of the average consumer of the category of goods or services in question, and assume that such a consumer is reasonably well informed and reasonably observant and circumspect.

Judicial authority has indicated that it may in practice be more difficult to establish distinctiveness in relation to a shape of product mark than a word or figurative trade mark. But whilst that may explain why such a mark is refused registration, it does not mean that it cannot acquire distinctive character following the use that has been made of it and thus registered as a trade mark.

As the perception of the average consumer is a relevant question, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a figurative mark consisting of a faithful representation of the product itself as it is in relation to a word mark or a figurative or three dimensional mark not faithfully representing the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.

It should also be noted that, based on practical experience and established branding practices,

consumers will not rely on the outline or shape of a good or its container in order to determine its origin without having been exposed to that outline or shape for a sufficiently long period to have learned to recognise it ‘at a glance’ without even needing to look for a verbal or graphic sign.

Shape marks that represent the goods themselves and are claiming protection in closely related service classes will be objectionable under Section 7(1)(b) and (c) as they are inseparably linked. For example, the shape of a table for retail services relating to furniture, parts and fittings is, therefore, objectionable.

7.1.1 Use of shape by monopoly suppliers

In cases where the applicant is the only supplier of those goods, the apparent monopoly over the shape of the goods does not automatically render the shape distinctive for trade mark registration.

Nevertheless, use of the shape of the goods before the date of filing of the trade mark application for the shape may be sufficient to establish that the shape mark has acquired distinctive character under Section 7(2) if as a result of such use, a substantial portion of the average consumers associate the goods claimed under the shape mark as originating from the applicant and no other.

Whether there is a monopoly in place over the shape mark is irrelevant to the consideration of distinctiveness.

7.1.2 Shapes which are common to the trade

Any shape which is commonplace for the goods concerned is likely to be legitimately used by other traders.

Therefore, prima facie registration of such shapes is unlikely to be accepted and it may be necessary for the applicant to supply evidence of use demonstrating that the shape, at the date of filing, has acquired distinctive character and is able to distinguish the applicant's goods from those of other traders.

In such situations, it will be the responsibility of the applicant to convincingly show that the shape mark has acquired a secondary meaning and has come to identify the goods of the applicant to the exclusion of other third parties.

The conclusion that something is common to the trade should only be reached after research reveals that the shape, or some minor variation of it, is commonly used within the relevant market. A shape mark hence has to be sufficiently different from a “common shape” so as to permit an average consumer, “without conducting an analytical or comparative examination or paying particular attention, to distinguish the goods concerned from those of other traders”. A common shape is defined as:

- the norm or customary shape in the sector concerned; or

- a shape likely to be taken by the good concerned.

Examples of these types of shapes are standard water bottles for water; a cylindrical mug shape with a standard handle for tea mugs and egg shaped Easter chocolates.

In other words, the shape must not be exclusively descriptive, must stand out from the crowd and, in the case of new product developments, must not be a shape likely to be taken for the good concerned. Comparative evidence should be provided by the applicant to show that the shape applied for is indeed outside the norm and customs of the trade.

A shape that is a 'variant' of a common shape of that type of good, or a simple departure from the norm or customs of the sector is not sufficient - the departure must be significant. Novelty or originality is not relevant in assessing the distinctive character of a mark. For a shape mark to be prima facie distinctive, it must differ substantially from the basic shapes commonly used in the trade of the goods in question, and not look like a mere variant of those shapes.

For instance, toys in Class 28 already feature a great variety of commonplace shapes. In this class, it is unlikely that a simple shape such as an animal or toy car will be registrable unless there is considerable additional get up (e.g., clothing) of the sort not normally found in the marketplace. The get up as a whole would need to be most unusual.

Example 7.1.2.1

In the matter of Singapore Trade Mark Application No. T0618780H in the name of Societe des Produits Nestle S.A.



Class 30: Flavours for nutritional purposes

In the above case, the Registrar observed that goods in the nature of the Applicant's goods were typically sold under various container shapes from plain to complex detail. These containers could be designed for functional purposes or made more attractive.

In view of the fact that a consumer was accustomed to being confronted with many shapes of containers, this means that a prima facie registrable shape must at least be relatively unusual in order for it to stand out from the crowd and be seen as a badge of origin.

The Registrar considered the mark as not being particularly unusual such that the average consumer would see it as a badge of origin. It has the basic configuration of a bottle with a lid or a cap – this is nothing unusual.

Drawing from the example above, no plain bottle is marketed in its naked form without any additional feature. They can only be found on the market with additional elements such as labels bearing word or figurative marks. The average general consumer **is confronted with an increased sophistication and diversity of packaging in the field of the goods applied for**. The relevant consumer has become accustomed to this amount of variety and familiar with the packaging function of these different bottles. Therefore, the sign applied for will not be perceived by the relevant public as a badge of origin but rather as the packaging of the particular goods.

It is to be noted that even if the shape is not used by other competitors on the market, it may on its own be insufficient to give the shape mark the minimum distinctive character required. This is because the average consumer, who does not make a study of the market, will not know in advance that only one undertaking markets a given good in a certain type of shape or packaging whilst its competitors use other types for that good. Confronted with a multitude of shapes or packaging of various brands, the consumer will refer, rather, to a word mark or logo in order to identify the undertaking of origin of this product.

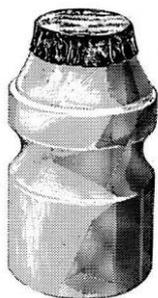
7.2 Uniqueness is not the same as distinctiveness

The test for distinctiveness of a mark is whether the average consumer will assume that all goods that come in that shape belong to the same undertaking, and not whether the shape is “unusual”, “memorable”, “recognisable on being seen a second time”, eye catching or highly decorative per se.

To illustrate, the shapes of decorative items such as ornaments or jewellery are unlikely to have inherent distinctive character and be acceptable *prima facie* because it is normal within these trades to provide unusual and imaginative creations for jewellery. Such creations may not automatically perform the function as an identifier of source.

Example 7.2.1

Yakult (Bottle Shape) Trade Mark Application, Kabushiki Kaisha Yakult Honsha v Registrar of Trade Marks [2001] R.P.C. 39



Class 29: Jellies, jams; eggs, milk and other dairy products, including yoghurt and yoghurt preparations; edible oils and fats; preserves, pickles; and meat, fish, poultry and game preparations and extracts.

Class 32: Non alcoholic drinks; syrups and other preparations for making beverages.

The UK High Court held that the fact that a container is unusual or attractive per se does not mean that it will be taken by the public as an indication of origin. Instead, the court had to consider whether the shape of the bottle alone could convey trade mark significance to the average customer. The court ultimately decided that the average consumer of the applicant's goods would likely conclude that the design in the application was nothing more than the shape of a bottle. The mark was therefore refused.

7.3 Mere product recognition is not sufficient

In relation to marks consisting of product shapes, it is not enough to prove that the public recognise them as the product of a particular manufacturer.

It has to be proved that consumers rely upon that shape alone as an indication of trade origin, particularly to buy the goods.

Example 7.3.1

Societe de Produits Nestle SA v Unilever plc [2002] EWHC 2709



Class 29: Ice cream products.

The tribunal held that although the products bearing the above mark had considerable recognition, the evidence did not prove that an average consumer would rely on the appearance alone to identify the goods as originating from a specific trader.

8. OVERCOMING ABSOLUTE GROUNDS: ACQUIRED DISTINCTIVENESS

8.1 Whether the shape mark has acquired distinctiveness by virtue of use

Notwithstanding that the mark may fall afoul of the grounds in Sections 7(1)(b), (c) and (d) of the Act, it is still acceptable for registration if it has acquired distinctiveness by virtue of the use made of it, as prescribed under Section 7(2) of the Act.

8.2 Factors for assessment

In assessing the acquired distinctiveness of a mark, the following may be taken into account:

- (i) The market share held by the mark;
- (ii) How intensive, geographically widespread and long standing use of the mark has been;
- (iii) The amount invested by the undertaking in promoting the mark;
- (iv) The proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking;
- (v) Statements from chambers of commerce and industry or other trade and professional associations.

If on the basis of those factors, the Registrar finds that the relevant class of persons, or at least a significant proportion thereof, identify goods originating from a particular undertaking because of the trade mark on the basis of acquired distinctiveness, the requirement for registering the mark is satisfied (see *Windsurfing Chiemsee Productions v Boots (Case C-108/97)*).

8.3 Nature of evidence

To prove that a shape mark has acquired distinctive character as a result of prior use, it will need to be promoted as something apart from the goods.

To lend more weight, the evidence of use should show how the applicant has referred, promoted or demonstrated to potential consumers that the shape as claimed serves as a trade mark.

The evidence showing prior use of the mark should also not deviate from the mark as represented in the application. In other words, if the shape mark is filed without any accompanying material such as word marks and/or figurative signs, whereas the evidence show otherwise, the claim of acquired distinctiveness of the shape itself would not be established.

8.4 The test: Reliance, not recognition

Again, the test of acquired distinctiveness has to take into account all the circumstances in which the average consumer may perceive that mark.

The distinctive character of a mark consisting in the shape of a product even that acquired by the use made of it must be assessed in the light of the presumed expectations of an average consumer of the category of goods or services in question who is reasonably well informed and reasonably observant and circumspect.

The essential consideration is that the relevant class of persons of the product identifies the shape mark as originating from a given undertaking as a result of the use of the mark as a trade mark and as a result of the nature and the effect of it - which makes it capable of distinguishing the product concerned from those of other undertakings.

In other words, mere association of a mark with a particular manufacturer or mere use of it is not enough. It must be established that a significant proportion of the relevant class of persons *rely upon the shape mark* (as opposed to any other trade marks which may be present) to get goods from the same trader as before. Registration would then be permissible because the shape would have acquired a distinctive character *in the trade mark sense* (see *Nestlé*).

For more information on the requirements to prove acquired distinctive character, please refer to Chapter 6 of the Work Manual on “Evidence of distinctiveness acquired through use”.

9. SHAPE OF PACKAGING OR ASPECT OF PACKAGING

Under Section 2(1) of the Act, the definition of a "sign" that can constitute a trade mark, includes, “*any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof*”.

Where registration of the shape of the packaging is sought, the same absolute grounds considerations under Section 7 of the Act applicable to the shape of goods will equally apply to the shape of the packaging of goods.

See example below:

Sign	Decision
 <p><u>Singapore application number:</u> T1114222A</p> <p><u>Description:</u> The mark consists of an aspect of packaging of the goods, namely, of a blue can and red cap, depicting the device of a carburetor, as shown in the representation on the form of application.</p> <p><u>Class 03</u> Cleaning and degreasing preparations for carburetors and chokes.</p>	<p>The representation is that of an aerosol can depicted in a manner that does not depart significantly from the norm or customs of the sector.</p> <p>It has no particular and clearly identifiable element that allows it to be distinguished from the usual ones available on the market and gives it the function of indicating its commercial origin.</p> <p>The device of the carburetor is also descriptive of which the subject goods are intended for.</p>

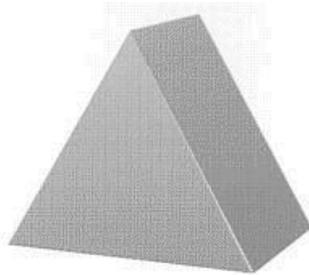
The aspect of packaging may include the container in which the goods are sold or the outer packaging which covers the container. Shape is just one aspect of packaging. There may be other aspects, such as colours, markings, physical indentations or devices on the packaging for which registration is sought.

9.1 Where it is not clear whether the trade mark is the shape of packaging or the shape of the goods

Where it is not clear whether the trade mark is the shape of packaging or the shape of the goods, the mark will be assessed on the basis that it is both. For unusual shapes of containers, even if it is accepted that the sign is different to a degree which renders it visually distinguishable from other such signs in use in the relevant market, the question to be determined is whether it is distinctively different so as to be likely to be perceived and remembered by the average consumer as a badge of origin.

Example 9.1.1

In the Matter of the request by Kraft Jacobs Suchard SA for protection in the United Kingdom of International Trade Mark No. 711078 (O-106-03)



Class 30: Chocolates and products containing chocolate.

In order to determine if the mark consisted of the shape of the claimed goods and/or the shape of their packaging, the tribunal felt that it was necessary to treat the request for registration as a two-fold request for the protection in respect of: (i) the shape of the specified goods, and (ii) the shape of their packaging. Ultimately, the tribunal had to decide if the mark was distinctive as both a shape of the claimed goods and the shape of their packaging. The tribunal refused registration on the ground that the mark was devoid of distinctive character, regardless of whether it was viewed either as a representation of the shape of the specified goods or their packaging.

9.2 Where the goods possesses no shape on their own

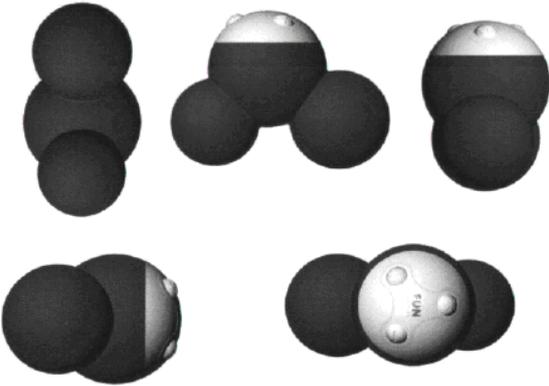
Goods such as granules, powder or liquid lack a shape on their own because of their physical nature. These goods do not possess an intrinsic shape, and must be packaged in order to be marketed. The packaging imposes its shape on the good, and in such circumstances, it is necessary to *assimilate* the packaging to the shape of the goods, so that the packaging constitutes the shape of the goods within the meaning of Section 7(3) of the Act (see *Henkel KGaA v Deutsches Patent- und Markenamt (Case C-218/01)*). Appropriate assessment of the packaging under Section 7(3) and Section 7(1) of the Act will be undertaken accordingly.

10. INDISTINCTIVE SHAPE WITH DISTINCTIVE ELEMENTS

A wholly indistinctive or standard shape may be acceptable on the basis that other (non-shape) distinctive elements are used in combination with the shape.

However, it must be immediately apparent in the representation that the distinctive elements make up an essential or prominent part of the mark and not form a *de minimis* portion of the indistinctive shape. If the distinctive elements merely form a *de minimis* portion of the indistinctive shape, then such elements will not endow distinctiveness upon that shape.

The description for the mark must also be tailored accordingly.

Acceptable	Not acceptable
<p data-bbox="188 741 783 813">Distinctive elements forming a prominent part of indistinctive shape</p>  <p data-bbox="188 1597 775 1632">Community Trade Mark number: 001698885</p>	<p data-bbox="812 741 1407 813">Distinctive elements forming a <i>de minimis</i> portion of indistinctive shape</p>  <p data-bbox="812 1597 1407 1675">Judgment of 18/01/2013, T-137/12, 'Shape of a vibrator'.</p>