

Case C-237/19

Request for a preliminary ruling

Date lodged:

19 March 2019

Referring court:

Kúria (Supreme Court, Hungary)

Date of the decision to refer:

6 February 2019

Applicant:

Gömböc Kutató, Szolgáltató és Kerreskedelmi Kft.

Defendant:

Szellemi Tulajdon Nemzeti Hivatala (National Intellectual Property Office)

Decision

of the Kúria (Supreme Court, Hungary)

sitting as court of cassation

[...]

Applicant:

Gömböc Kutató, Szolgáltató és Kerreskedelmi Kft. ([...] Budapest [...])

...

Subject matter of the proceedings:

Amendment of the decision of the Szellemi Tulajdon Nemzeti Hivatala (National Intellectual Property Office, Hungary; ‘the Office’), in which the registration of a trade mark is refused.

Appellant in the appeal on a point of law:

The applicant

...

Operative part

The Kúria (Supreme Court, Hungary) refers the following questions to the Court of Justice of the European Union for a preliminary ruling:

(1) Is Article 3(1)(e)(ii) of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks to be interpreted as meaning that, for signs which consist exclusively of the shape of goods,

- (a) it can only be examined if the shape is necessary to obtain the technical result sought on the basis of the graphic representation contained in the register, or
- (b) can the perception of the relevant public also be taken into account?

In other words, can it be taken into account that the relevant public is aware that the shape for which registration is sought is necessary in order to obtain the technical result sought?

(2) Is Article 3(1)(e)(iii) of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks to be interpreted as meaning that the ground for refusal is applicable to those signs which consist exclusively of the shape of goods and in respect of which it can be determined whether the shape gives substantial value to the goods, bearing in mind the perception or knowledge that the buyer has of the goods represented graphically?

(3) Is Article 3(1)(e)(iii) of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks to be interpreted as meaning that the ground for refusal is applicable to signs which consist exclusively of a shape

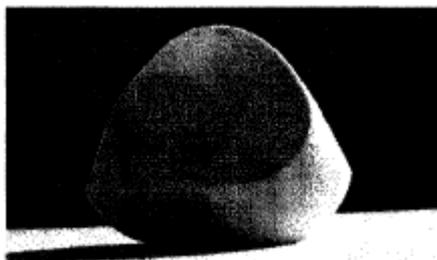
- (a) that, by virtue of its individual character, already enjoys the protection conferred on designs, or
- (b) whose aesthetic appearance alone gives the goods any kind of value?

... [procedural aspects of national law]

Grounds

Subject matter of the proceedings and relevant facts

1. On 5 February 2015, the applicant sought to register as a trade mark a three-dimensional sign for the following goods: ‘decorative items’ in Class 14, ‘decorative items made of glass and earthenware’ in Class 21 and ‘toys’ in Class 28.



2. In its decision, the Office refused to register the trade mark on the basis of Article 2(2)(b), second and third indents, of a védjegyek és a földrajzi árujelzők oltalmáról szóló 1997. évi XI. törvény (Law No XI of 1997 on the protection of trade marks and geographical indications; ‘the Law on Trade Marks’). According to the reasons for this decision, the sign for which registration is sought represents a homogeneous body consisting of two planes of symmetry perpendicular to each other, seven smooth faces, and edges separating those faces. This formal design represents the applicant’s product known as a ‘Gömböc’, a convex and monostatic body manufactured using a homogeneous material that has just one stable and one unstable equilibrium point, i.e. a total of two equilibrium points, the formal design of which means that the body always returns to its position of balance. The characteristics and function of this formal design have become known to the average consumer via the product website and the wide dissemination of the goods by the press. This knowledge could therefore be taken into account when assessing the registrability of the trade mark. The sign for which registration is sought therefore represents a three-dimensional body which, due to its external design and the homogeneous material used, always returns to its position of balance; the overall formal design of the body constituting the sign serves to achieve the technical objective that the body always rights itself.
3. When examining the ground for refusal provided for in the second indent of Article 2(2)(b) of the Law on Trade Marks,^{*} the Office stated that the overall formal design of the three-dimensional body allows it to function as a toy whose purpose is always to return to its stable position of balance. All elements of the

^{*} [TN: The wording of the second indent of Article 2(2)(b) of the Hungarian Law on Trade Marks is identical to the Hungarian wording of Article 3(1)(e)(ii) of Directive 2008/95, the interpretation of which is requested in the first question. In both cases, it is established that the registration of signs which consist exclusively of ‘the shape of goods which is necessary to obtain *the* technical result *sought*’ shall be refused. However, the Spanish version of Article 3(1)(e)(ii) of Directive 2008/95 employs (as do the French, English, German, Portuguese and Italian language versions) the formula ‘the shape of goods which is necessary to obtain *a* technical result’.]

sign are designed to exclusively achieve the technical result sought, i.e. they fulfil a technical function. Therefore, with regard to toys in Class 28, the informed and reasonable consumer does not perceive the sign for which registration is sought as a reference to the commercial origin of the goods, but as a shape necessary to achieve the technical result sought by the body known as a ‘Gömböc’. Registration of the three-dimensional sign would limit the choices of competitors when applying the technical solution, which is sufficient to apply the ground for refusal examined. The protection thus conferred on the trade mark would also create an unjustified widespread monopoly as it would prevent the marketing of bodies with a similar shape that could create a risk of confusion.

4. With regard to decorative items in Classes 14 and 21, the third indent of Article 2(2)(b) of the Law on Trade Marks constitutes the obstacle to registration, according to which the registration of signs which consist exclusively of the shape that gives substantial value to the goods shall be refused. The three-dimensional shape of the sign forms an attractive and striking design, which is the essential element in the marketing of the goods in question. Consumers buy decorative items mainly because of their special formal design. In principle, registration of three-dimensional decorative items as a trade mark cannot be excluded, although, when their striking design represents the formal appearance, there are reasons to conclude that the value of the goods lies in that formal design.
5. In its application for amendment, the applicant invited the court of first instance to request a preliminary ruling from the Court of Justice in order to interpret the grounds for refusal applied. In essence, the applicant requested that the decision be annulled and that the Office be ordered to continue the proceedings. According to the applicant, the Office had wrongly examined the conditions of registrability of the product known as ‘Gömböc’ and had taken into account properties that are not visible in the representation of the three-dimensional sign. In the context of examining the grounds for refusal, the existence of an effective causal link between the shape for which registration is sought and its functionality can be examined, but not the perception and deductions of consumers in that regard.
6. As it considered that the application for amendment raised an important legal question of principle, the Office, on the basis of Article 77(1) of the Law on Trade Marks, submitted a written statement in which it considered that the applicant’s request for a preliminary ruling was justified.
7. That court of first instance issued a decision dismissing the application for amendment.
8. Said court of first instance, with regard to the toys included in the list in Class 28, when examining the ground for refusal provided for in the second indent of Article 2(2)(b) of the Law on Trade Marks, stated that the representation consisting of a single perspective did not fully reveal the shape of the body. According to the printed image accompanying the application for registration, the sign is a representation of a three-dimensional body shown from a single

perspective in a realistic black and white photograph. The outline of the three-dimensional sign is reminiscent of a mitre and its surface consists of three (or perhaps four) faces separated by edges and corners, without any drawings or inscriptions. The sign shows the shape of the product known as a 'Gömböc' from a single perspective. However, the Office had wrongly identified the subject matter of the application as being the shape of the known goods. The body that appears in the printed image entails more extensive protection, including, as a special case, the goods known as a 'Gömböc'. However, the sign is not characterised by its material structure or its homogeneity, as those characteristics are not reflected graphically.

9. In response to the questions proposed by the applicant in its request for a preliminary ruling, the court of first instance stated as follows:
10. With regard to toys, when examining the technical result sought, it is not necessary to examine how the relevant public perceives the relationship between the shape of the goods and said result, but whether that relationship objectively exists. In this particular case, the technical result sought by the shape of the product is the return to the only stable position (righting). In this respect, the result of examining the relationship between the technical result and the shape should not be regarded as a value judgment of the public, but as a technical fact. The ground for refusal of registration can also apply when the intended technical result can equally be achieved by using a different shape. The characteristic relating to the material structure does not form part of the sign to be registered as it is not represented graphically. Moreover, the application of the ground for refusal in question does not depend on the shape deemed necessary also having to be sufficient to achieve the technical result sought. This is jointly ensured by the material and its shape. In the absence of any change in the shape, the material of any product can be modified in such a way that the technical result sought can no longer be obtained. For this reason, it is generally true that the shape of the product is a necessary but not sufficient condition to achieve that result, because the appropriate material also needs to be selected. Therefore, if, in order to apply the ground for refusal in question, it were possible to assess the characteristics relating to the material structure of the product, that ground for refusal would be devoid of content.
11. With regard to decorative items, the court of first instance did not share the Office's view that the aesthetic characteristics give substantial value to the shape of the sign at issue. According to the court of first instance, on the one hand, the value of the 'Gömböc' lies in the fact that it is the first of a series of tangible bodies derived from the sphere that are simultaneously convex, homogeneous and mono-monostatic; on the other hand, the value of the goods is due to the fact that it provides an empirical response to scientific questions in the field of mathematics. The characteristic and unique shape of the 'Gömböc' embodies those values, regardless of the assessment warranted by the shape in terms of aesthetics. The public is not looking for the product to be a beautiful object of

design, but a tangible expression of mathematics, which is why they want to possess it as a decorative item.

12. The court of second instance, which heard the case due to the appeal lodged by the applicant, upheld the decision of the court of first instance.
13. According to the court of second instance, there were no grounds for examining, with regard to other grounds for refusal, whether the trade mark sought for the goods in question could be registered. It is clear from the printed image accompanying the application for registration that the protection sought refers to a three-dimensional sign. The illustration shows a body from a single perspective; from this angle, an object whose shape is delimited by three (or possibly four) smooth faces, separated by edges and corners, can be distinguished. The method of representation does not provide any information about the configuration of the parts of the body that are not visible in the illustration, and it also cannot be unequivocally determined whether the three-dimensional figure is symmetrical or asymmetrical. In such a situation, it is not possible to compare the applicant's product known as a 'Gömböc' with the sign, and the characteristic relating to the fact that it is self-righting also cannot be taken into account. In any case, the body with a homogeneous material structure, developed by calculation and mathematical experiment, has the ability to return to the position of balance, but the material structure is not graphically represented in the printed image.
14. The way in which the sign at issue is represented does not in any way indicate that any kind of functionality can be associated with the body, nor can this be inferred from the list of goods. The applicant did not limit this list in terms of toys in Class 28, so it is not possible to know what function the given shape has to fulfil. In this particular case, neither the printed image nor the list of goods provides information on how the toy whose shape is to be registered can be played with or how it can be used to play. Furthermore, the decorative items in Classes 14 and 21 do not, by definition, pursue any technical result, as they only serve to embellish their surroundings, which reduces their usefulness.
15. In view of the above findings, the court of second instance considers that, with regard to the ground for refusal on the basis of which the registration of signs which consist exclusively of the shape that gives substantial value to the goods will be refused, the registration requirements should be examined uniformly for the whole list of goods. Since no concealed technical properties can be associated with the three-dimensional body represented in the printed image and since the product known as a 'Gömböc' cannot be identified with said body, its importance to the history of science cannot be assessed. The special formal design of the three-dimensional body, which is unusually refined and hypnotic, provides the value of the product. It can therefore be said that the shape gives substantial value to the goods and therefore the registration of said three-dimensional sign should be refused. In view of the individual character, the exclusivity conferred by the protection of designs obtained for the external appearance cannot be covered by another form of protection. The general interest objective pursued by the ground

for refusal is met if signs which have characteristics that typically correspond to another form of protection are excluded from the registration of trade marks.

16. The applicant lodged an appeal on points of law against the final decision, in which it again requested a preliminary ruling from the Court of Justice. According to the applicant in its appeal, the court of second instance infringed an essential procedural requirement by examining the ground for refusal provided for in Article 2(2)(b), third indent, of the Law on Trade Marks with regard to toys. The procedure followed before the Office was not intended to examine whether, in the case of toys, the shape gives substantial value to the goods and the Office could not therefore give its opinion on this ground for refusal. It follows from the reasoning of the court of second instance, according to which the public buys a decorative item for its external appearance, which is, by itself, sufficient to apply the ground for refusal, that the shape of decorative items is a priori excluded from registration as a trade mark. Contrary to the case-law of the Court of Justice, the court of second instance did not examine the existence of grounds for refusal for each product on the list and on the basis of the criteria applied by the Court, and its assertions are not based on evidence, but rather on assumptions. The importance of the ‘Gömböc’ as an object does not lie in its artistic function, but rather is determined by scientific and mathematical criteria. Therefore, it is not the three-dimensional shape of the toy, for which registration is sought, that makes it exceptional. The public does not buy this for its external appearance, but rather because it wants to own the symbol of one of the greatest mathematical discoveries of our time. With regard to decorative items, in this particular case it is not the shape that gives substantial value to the goods, but rather the mathematical discovery of which it has become a symbol. Therefore, with regard to toys and decorative items, the shape for which registration is sought does not give substantial value to the goods. The court of second instance, invoking the defence of the public interest, categorically refuses to register as a trade mark those shapes protected as designs, although there is no legal basis to exclude parallel protection.

Relevant national legislation

17. Law No XI of 1997 on the protection of trade marks and geographical indications (Law on Trade Marks), in the version in force at the time when the application for registration of the trade mark was submitted (5 February 2015).
18. Article 1 of the Law on Trade Marks provides as follows:
- ‘1. A trade mark may consist of any signs capable of being represented graphically, provided that they are capable of distinguishing certain goods or services from other goods or services.

2. In particular, a trade mark may consist of the following signs:

...

(d) flat or three-dimensional figures, including the shape of the product or its presentation.’

19. Article 2 of the Law on Trade Marks:

‘1. Signs not complying with Article 1 shall not be registered.

2. The following shall not be registered:

...

(b) signs which consist exclusively of

- the shape which results from the nature of the goods themselves, or
- the shape of goods which is necessary to obtain the technical result sought, or
- the shape which gives substantial value to the goods.’

20. Transposition of EU law.

Article 122 of the Law on Trade Marks:

‘1. This Law transposes the following acts of EU law into Hungarian law:

- (a) Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights.
- (b) Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks.’

Case-law of the Court of Justice of the European Union

- 21. In accordance with the judgment of 18 September 2014, *Hauck GmbH & Co. KG v Stokke A/S and Others*, C-205/13, EU:C:2014:2233, the immediate aim of the prohibition on registering purely functional shapes or shapes which give substantial value to the goods, set out in Article 3(1)(e)(ii) and (iii) of the Directive, is to prevent the exclusive and permanent right which a trade mark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods (paragraphs 19 and 31).
- 22. In the judgment of 18 June 2002, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, C-299/99, EU:C:2002:377, the Court of Justice held that the rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 3(1)(e) 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 products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark (paragraph 78). As regards signs consisting exclusively of the shape of the product necessary to obtain a technical result, that provision is intended to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product (paragraph 79). This ground for refusal of registration also reflects the legitimate aim of not allowing individuals to use registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions (paragraph 82). The existence of that ground for refusal constitutes an obstacle to registration even if the technical result in question can be achieved by other shapes (paragraph 83).

23. According to the judgment of 15 February 2007, *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*, C-239/05, EU:C:2007:99, where registration of a mark is sought in respect of various goods or services, the competent authority must check, in relation to each of those goods or services, that none of the grounds for refusal listed in Article 3(1) of the Directive applies to the mark and may reach different conclusions depending upon the goods or services in question (paragraph 32). In other cases, the Court of Justice has also provided guidance in the sense that the three grounds for refusal of registration set out in Article 3(1)(e) of the Directive operate independently of one another and must be applied independently of the others, and in the sense that, if any one of the criteria listed is satisfied, a sign consisting exclusively of the shape of the product or of a graphic representation of that shape cannot be registered as a trade mark (*Hauck GmbH & Co. KG v Stokke A/S and Others*, paragraphs 39 and 40, and judgment of 8 April 2003, *Linde AG, Winward Industries Inc. and Rado Uhren AG*, C-53/01 to C-55/01, EU:C:2003:206, paragraph 44).
24. In the judgment of 10 November 2016, *Simba Toys GmbH & Co. KG v EUIPO and Others*, C-30/15 P, EU:C:2016:849, the Court of Justice set aside the judgment of the General Court on the basis that it had incorrectly applied the grounds for refusal set out in Article 7(1)(e) of Council Regulation (EC) No 40/94, which correspond to the grounds for refusal set out in Article 3(1)(e) of the Directive. According to that judgment, the sign at issue consisted of the shape of actual goods and not of an abstract shape, which is why the General Court should have defined the technical function of the actual goods at issue and should have taken this into account when assessing the functionality of the essential characteristics of that sign (paragraph 47). It follows from the case-law of the Court of Justice that, when examining the functional characteristics of a sign, the competent authority may carry out a detailed examination that takes into account material relevant to identifying appropriately the essential characteristics of that

sign, in addition to the graphic representation and any descriptions filed at the time of application for registration (paragraph 49). In other cases (C-299/99 and C-337/12 P to C-340/12 P), the competent authorities would not have been able to analyse the shape concerned solely on the basis of its graphic representation without using additional information on the actual goods (paragraph 50).

25. In the judgment of 6 March 2014, *Pi-Design and others v Yoshida Metal Industry Co. Ltd*, C-337/12 P to C-340/12 P, EU:C:2016:849, the Court of Justice rejected the argument according to which the examination of the functional characteristics of the shape must be limited to the graphic representation for which registration is sought and cannot take account of the actual shape of the goods concerned, and set aside the judgment of the General Court (paragraphs 52 and 61).
26. According to the judgment in *Hauck GmbH & Co. KG v Stokke A/S and Others*, Article 3(1)(e) of the Directive, in contrast to the situation referred to in Article 3(1)(b), does not impose an obligation to necessarily take account of the perception of the target public of the goods or services (paragraph 33). The presumed perception of the sign by the average consumer is not a decisive element when applying the ground for refusal set out in Article 3(1)(e)(iii) of the Directive, but may, at most, be a relevant criterion of assessment for the competent authority in identifying the essential characteristics of that sign (paragraph 34 and judgment of 14 September 2010, *Lego Juris A/S v OHIM*, C-48/09, EU:C:2010:516, paragraph 76). Thus, other assessment criteria may also be taken into account, such as 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 goods in question (paragraph 35).

The need to refer questions for a preliminary ruling

27. With regard to the grounds for refusal in question, in particular with regard to three-dimensional shapes, the case-law of the Court of Justice, even where this is known, is not yet sufficiently developed or comprehensive to prevent questions of legal interpretation from arising that require further clarification. The doubts that may arise in applying the law are as follows:
 - When applying the ground for refusal set out in Article 3(1)(e)(ii) of the Directive, is there an obligation to limit the assessment solely to the information shown in the graphic representation or should/may additional information also be taken into account?
 - When applying the ground for refusal set out in Article 3(1)(e), in particular subparagraphs (ii) and (iii), of the Directive, in the case of a sign which consists of the shape of an actual product, what importance should be attributed to the perception of the relevant public and to the information available to the relevant public?

- When applying the ground for refusal set out in Article 3(1)(e)(iii) of the Directive, what importance should be attributed to the existing parallel protection and to the nature of the product that incorporates the shape?

The questions asked constitute a problem in the application of the law and have not yet been answered comprehensively by the Court of Justice in its guiding principles.

The first question

28. The three-dimensional sign for which registration is sought for toys in Class 28 is a realistic photographic image of the product known as a ‘Gömböc’. The product is a convex, homogeneous and mono-monostatic body that has a total of two equilibrium points, specifically one stable and one unstable. The formal design of the body and the characteristic relating to the material structure (made of homogeneous material) ensure that the body always finds its position of balance and rights itself. The technical result sought is the ability of the three-dimensional figure to return to its position of balance. Therefore, the product represented graphically exclusively consists of the shape of the product which is necessary to produce the technical result sought. However, this technical result cannot be determined from the graphic representation of the shape of the product appearing in the printed image accompanying the application for registration.
29. The applicant’s product known as a ‘Gömböc’ can be recognised in the sign. According to the applicant’s initial statement, it was seeking protection for the shape of the product. Several publications have publicised the creation of the ‘Gömböc’, the product has been widely covered in the press and it is also presented on a website that provides information specifically aimed at the public (www.gomboc.eu). Therefore, the relevant public (interested in the goods) knows that the special formal design and the homogeneous material structure of the Gömböc ensure that the object always finds its position of balance. When assessing the function, the Office considered that it was justified to take into account the knowledge thus acquired. The court of first instance held that, based on the graphic representation of the sign, the technical result sought can be determined by means of the shape, regardless of the fact that this is not sufficient by itself to achieve that result, because another characteristic not shown in the graphic representation is also necessary for that purpose. However, according to the restrictive interpretation of the court of second instance, only the graphic representation should and can be used; in this specific case, based on the way in which the product is represented and on its realistic photographic image shown from a single perspective, the function that constitutes the characteristic property of the represented object — namely, that it always rights itself — cannot be determined, so the technical result sought cannot be examined.
30. According to the case-law of the Court of Justice, when applying Article 3(1)(e) of the Directive, the perception of the sign attributed to the average consumer does

not necessarily have to be taken into account, but may, at most, be a relevant criterion of assessment (*Hauck GmbH & Co. KG v Stokke A/S and Others*, paragraphs 33 and 34). Furthermore, in the case of a sign which consists of the shape of an actual product, where the shape at issue cannot be assessed solely on the basis of its graphic representation, it has been deemed justified to use additional information concerning the actual product in order to examine the functional characteristics (Case C-30/15 P).

31. In the case of the shape of a product that has become widely known as the empirical response to a theoretical problem in a branch of science, it may be necessary to assess the knowledge that the relevant public has of the product when determining the characteristics of the sign. This possibility can also be justified by the fact that, in this case, the graphic representation only shows the three-dimensional figure from one perspective, which is why its overall formal design cannot be seen. Therefore, the extent of the trade mark protection acquired in this way would be too broad, as, in addition to the ‘Gömböc’, it would also extend to products where only one of the profiles is identical or similar to the object represented graphically in the printed image.
32. The aim of this question is to determine whether,
 - (a) in the case of a sign which consists exclusively of the shape of a product, the question as to whether the shape is necessary to obtain the technical result sought can be examined only on the basis of the characteristics that can be determined from the graphic representation appearing in the register, or whether,
 - (b) where the technical result sought cannot be determined from the graphic representation, but the relevant public knows that, in order to obtain that result, the represented shape is necessary, together with another property that is not represented graphically (the characteristic relating to the structure of the material), that perception of consumers can be taken into account when examining the ground for refusal.

The second question

33. In the case of the decorative items in Classes 14 and 21, the court of first instance, based on the relevant public’s knowledge of the product, stated that the mathematical discovery through which it responds to historical questions of science gives a substantial value to the product, and that the product represented in the sign has become the tangible symbol of that discovery.
34. The aim of the question is to clarify, also with regard to the interpretation of Article 3(1)(e)(iii) of the Directive, whether, when examining the application of the ground for refusal, the purchaser’s knowledge of the product represented graphically can be taken into account. In other words, where the sign consists exclusively of the shape of the product, can the ground for refusal be applied

where it can only be determined whether the shape gives substantial value to the product based on the relevant public's knowledge.

The third question

35. With regard to paragraph (a):

All forms of industrial property protection complement each other in a useful manner, and the same product can also simultaneously enjoy various types of protection. However, as the Court of Justice has held in its decisions, registration as a trade mark cannot have the function of conferring on the proprietor an exclusive right of unlimited duration, by avoiding the limited duration of the monopoly conferred by patents, utility models or designs.

The three-dimensional figure represented by the sign at issue already enjoys the protection conferred on designs. This type of protection can be granted to products which, in addition to meeting other requirements, have individual character. In the case of decorative items, the individual shape created by their designer, as an aesthetic feature, a priori gives substantial value to the product.

The question aims to clarify whether, in the case of goods whose sole function is decorative (decorative items), the shape of a product that already enjoys the protection conferred on designs, on the basis of the previously declared individual character, cannot a priori be registered as a trade mark.

36. With regard to paragraph (b):

In the case of decorative items, their sole function is decorative; the shape of the goods, as an aesthetic feature, can by itself give substantial value to the goods, which is why the goods are purchased by the buyer. The aim of the question is to determine whether the ground for refusal in question can be applied in relation to goods whose shape solely relates to an aesthetic appearance and a decorative function; in other words, whether, as far as decorative items are concerned, the registration of the three-dimensional shapes for which protection is sought must necessarily be refused.

Budapest, 6 February 2019

...

[Signatures]