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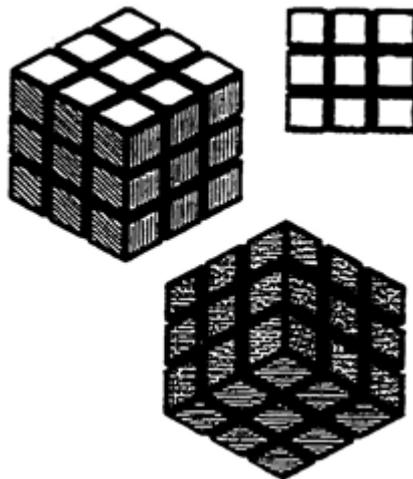
Luxembourg, 25 May 2016

Advocate General's Opinion in Case C-30/15 P  
Simba Toys GmbH & Co. KG v European Union Intellectual Property Office  
(EUIPO)

## **Advocate General Szpunar considers that the EU trade mark representing the shape of a Rubik's Cube must be declared invalid**

*The essential characteristics of the contested sign – the shape of a cube and the grid structure – are necessary to perform the technical function inherent in the product concerned*

At the request of Seven Towns, a UK company which manages, in particular, intellectual-property rights relating to the 'Rubik's Cube', the European Union Intellectual Property Office (EUIPO) registered, in 1999, the shape of that cube as a three-dimensional Community trade mark in respect of 'three-dimensional puzzles'.



In 2006, Simba Toys, a German toy-manufacturing company, applied to EUIPO to have the three-dimensional mark cancelled, in particular on the ground that it involves a technical solution consisting of a rotating capability, whereas such a solution may be protected only by patent and not as a trade mark. As EUIPO dismissed that application, Simba Toys brought an action before the General Court in which it sought annulment of EUIPO's decision.

By judgment of 25 November 2014,<sup>1</sup> the General Court dismissed the action brought by Simba Toys. In particular, it held that the graphic representation of the shape of a Rubik's Cube did not involve any technical function such as to preclude it from being protected as a trade mark, and that it could therefore be registered as an EU trade mark.

Simba Toys has appealed against that judgment to the Court of Justice.

<sup>1</sup> Case [T-450/09](#) Simba Toys v OHIM – Seven Towns (Shape of a cube with surfaces having a grid structure); see Press Release No. [158/14](#).

In today's Opinion, **Advocate General Maciej Szpunar proposes that the Court of Justice should set aside the judgment of the General Court and annul the decision of EUIPO.**

The Advocate General stresses in particular that, in accordance with the EU trade mark regulation,<sup>2</sup> shapes with essential characteristics which are inherent in the generic function or functions of the goods concerned must be denied registration. Reserving such characteristics to a single economic operator would, he points out, make it difficult for competing undertakings to give their goods a shape which would be suited for the use for which those goods are intended.

The Advocate General then goes on to address the ground of appeal based on the provision in that regulation which states that signs which consist 'exclusively' of the shape of goods which is 'necessary' to obtain a technical result cannot be registered.<sup>3</sup> He points out that a sign consisting of the shape of a product that, without the inclusion of significant non-functional elements, merely performs a technical function cannot be registered as a trade mark, since such a registration would unduly impair the opportunity for competitors to place on the market goods the shapes of which incorporate the same technical solution.

The Advocate General notes that, when analysing the functional elements of a given shape, the competent authority is not required to restrict itself to information arising from the graphic representation but must, where necessary, also take account of other essential information.

In the view of the Advocate General, the General Court, while it identified the essential characteristics of the sign, failed to assess those characteristics in the light of the technical function inherent in the product concerned. Although the General Court, in the judgment under appeal, emphasised that it is necessary to assess whether the characteristics of the shape 'perform the technical function of the goods concerned', none of the further grounds of that judgment defines what technical function the goods concerned perform or analyses the relationship between that function and the characteristics of the shape represented. That assumption leads to the paradoxical conclusion that the graphic representations of the contested mark do not make it possible to determine whether the shape in question involves any technical function or, if so, what that technical function might be.

The Advocate General finds that, in order to carry out a proper analysis of the functional features of the shape, the General Court ought first to have taken account of the function of the product concerned, namely the three-dimensional puzzle, that is to say, a brain-teaser consisting of a logical arrangement of movable elements. The General Court, in his view, also erred in concluding that the analysis of the shape concerned from the point of view of its functional features ought to be based solely on an examination of the graphic representation in respect of which registration had been applied for.

In the Advocate General's view, the line of reasoning according to which the scope of protection resulting from registration of a mark covers every type of puzzle with a similar shape, regardless of the principles by which it functions, and thus, in regard to the shape at issue in the present case, may potentially cover every three-dimensional puzzle the elements of which make up the shape of a '3x3x3' cube, is contrary to the public interest because it makes it possible for the proprietor to extend its monopoly to the characteristics of goods which perform not only the function of the shape in question but also other, similar functions.

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**NOTE:** An appeal, on a point or points of law only, may be brought before the Court of Justice against a judgment or order of the General Court. In principle, the appeal does not have suspensive effect. If the appeal is admissible and well founded, the Court of Justice sets aside the judgment of the General Court. Where the state of the proceedings so permits, the Court of Justice may itself give final judgment in the case. Otherwise, it refers the case back to the General Court, which is bound by the decision given by the Court of Justice on the appeal

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<sup>2</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the EU trade mark (OJ 2009 L 78, p. 1).

<sup>3</sup> Article 7(1)(e)(ii).

**NOTE:** The Advocate General's Opinion is not binding on the Court of Justice. It is the role of the Advocates General to propose to the Court, in complete independence, a legal solution to the cases for which they are responsible. The Judges of the Court are now beginning their deliberations in this case. Judgment will be given at a later date.

**NOTE:** EU trade marks are valid throughout the EU and co-exist with national trade marks. Applications for registration of an EU trade mark are sent to EUIPO. Actions against its decisions may be brought before the General Court.

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*Unofficial document for media use, not binding on the Court of Justice.*

The [full text](#) of the Opinion is published on the CURIA website on the day of delivery.

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