

Case C-299/99

Koninklijke Philips Electronics NV

v

Remington Consumer Products Ltd

(Reference for a preliminary ruling from the Court of Appeal
(England and Wales) (Civil Division))

(Approximation of laws — Trade marks — Directive 89/104/EEC —
Articles 3(1) and (3), 5(1) and 6(1)(b) — Signs capable of being trade marks —
Signs consisting exclusively of the shape of the product)

Opinion of Advocate General Ruiz-Jarabo Colomer delivered on 23 January
2001 I- 5478
Judgment of the Court, 18 June 2002 I- 5490

Summary of the Judgment

1. *Approximation of laws — Trade marks — Directive 89/104 — Where registration of a trade mark may be refused or the trade mark declared invalid — Trade mark devoid of distinctive character — Relation between the provisions of Article 3(1)(b), (c) and (d) and 3(3), on the one hand, and Article 3(1)(a), on the other (Council Directive 89/104, Art. 3(1)(a), (b), (c) and (d) and Art. 3(3))*

2. *Approximation of laws — Trade marks — Directive 89/104 — Signs capable of constituting a trade mark — Determination whether a trade mark has a distinctive character — Criteria — Capricious addition — Criterion not necessary*
(Council Directive 89/104, Art. 2)
3. *Approximation of laws — Trade marks — Directive 89/104 — Where registration of a trade mark may be refused or the trade mark declared invalid — Trade mark devoid of distinctive character — Distinctive character acquired by use — Meaning — Criteria*
(Council Directive 89/104, Art. 3(3))
4. *Approximation of laws — Trade marks — Directive 89/104 — Where registration of a trade mark may be refused or the trade mark declared invalid — Sign consisting of the shape of the product necessary to obtain a technical result — Meaning — Existence of other shapes which allow the same technical result to be obtained — Not relevant to the ground for refusal*
(Council Directive 89/104, Art. 3(1)(e))

1. There is no category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of Directive 89/104 to approximate the laws of the Member States relating to trade marks which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.

(see para. 40, operative part,
para. 1)

respect of which the sign is registered does not require any capricious addition, such as an embellishment which has no functional purpose. The criteria for assessing the distinctive character of three-dimensional trade marks are no different from those to be applied to other categories of trade mark and the shape in question must simply be capable of distinguishing the product of the proprietor of the trade mark from those of other undertakings and thus of fulfilling its essential purpose of guaranteeing the origin of the product.

(see paras 48–50, operative part,
para. 2)

2. In order to be capable of distinguishing an article for the purposes of Article 2 of Directive 89/104 to approximate the laws of the Member States relating to trade marks, the shape of the article in

3. Where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods

may be sufficient to give the sign a distinctive character for the purposes of Article 3(3) of Directive 89/104 to approximate the laws of the Member States relating to trade marks, in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with that trader and no other undertaking or believes that goods of that shape come from that trader. However, it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of specific and reliable data, that 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, are taken into account and that the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark as a trade mark.

(see para. 65, operative part,
para. 3)

4. Article 3(1)(e), second indent, of Directive 89/104 to approximate the laws of the Member States relating to trade marks must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.

(see para. 84, operative part,
para. 4)