



What is the threshold for establishing acquired distinctiveness of shape marks under Article 3(1)(e) Trade Mark Directive?

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Guiding principles on acquired distinctiveness (1)

- Does the average consumer identify goods as originating from a particular undertaking because of the trade mark (*Windsurfing*)
- Such identification must be as a result of the use of a mark as a trade mark (*Philips*)
- Use of the mark can be as part of or in conjunction with a registered trade mark if the average consumer perceives the product designated exclusively by the mark as originating from a given undertaking (*Nestlé v Mars*)

Guiding principles on acquired distinctiveness (2)

- Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape (*Mag*)
- Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character (*Freixenet*)

Société des produits Nestlé SA v Cadbury UK Ltd

[2017] E.T.M.R. 31

The evidence

- **Survey 1:** rejected due to leading questions and invented speculation
- **Survey 2:** *“...I think it is safe to conclude that at least half the respondents gave answers which probably meant that they thought that the shape shown to them was the product known as KIT KAT”*
- 4 finger Kit Kat one of most popular chocolate products on the market and had been on the market for 75 years
- Substantial sums spent on promotion

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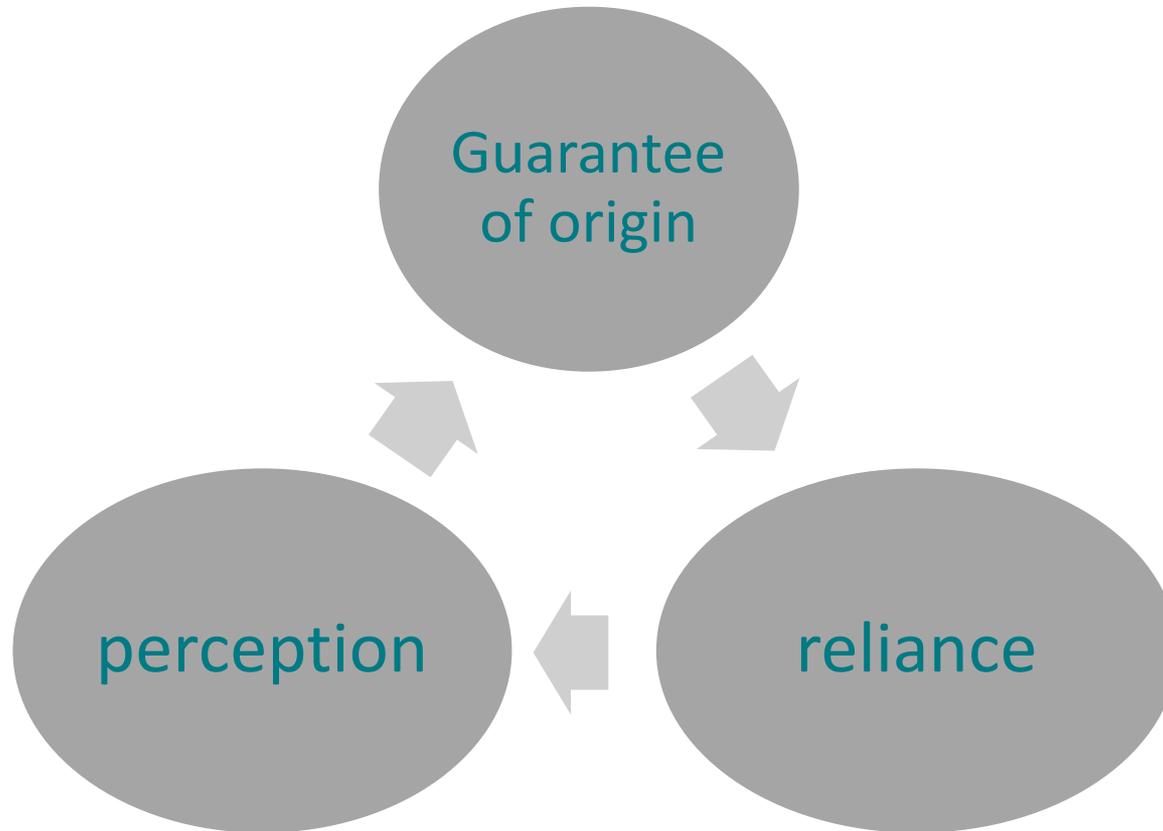
Recognition
&
Association

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No acquired distinctiveness

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The EUIPO

The London Taxi Corporation Ltd (t/a The London Taxi Company) v Frazer Nash Research Ltd & Anr [2017] EWCA Civ 175

Inherent distinctiveness

- The average consumer includes any class of consumer to whom the guarantee of origin is directed and who would be likely to rely on it, for example, in making a decision to buy or use the goods
- The LTC features are no more than a variant on the standard design features of a car

Inherent distinctiveness

The London Taxi Corporation Ltd (t/a The London Taxi Company) v Frazer Nash Research Ltd & Anr [2017] EWCA Civ 175

Acquired distinctiveness

- The identity of the manufacturer was a matter of indifference to consumers (users of taxi services) but they did know that the shapes of the taxis could be relied on to indicate that the vehicle is a licensed London taxi
- LTC had not established that taxi drivers would perceive the shape, as opposed to LTC's 'conventional' marks as an indication of origin

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