



## General Court maintains strict approach to assessment of distinctive character

Categories : [Distinctiveness](#), [Trademark](#)

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On 5 February 2020 the General Court issued its decision in [Hickies Inc v European Union Intellectual Property Office](#) (EUIPO) (Case T?573/18).

### Background

On 5 July 2017 Hickies Inc ('the applicant') filed an application for the following three-dimensional (3D) trademark for goods in Class 26, including "shoe laces":

The EUIPO examiner rejected the application on the grounds that it was devoid of any distinctive character. The applicant appealed to the Board of Appeal, which partially confirmed the decision for all products except “shoe eyelets” and “shoe hooks”. The applicant formed an appeal before the General Court.

## Decision

The court first recalled that the criteria for assessing the distinctive character of a sign are the same regardless of the type of mark, including 3D signs. In order to have distinctive character, the sign must allow to identify the commercial origin of the products for which registration is sought. The only distinction with regard to 3D signs lies in the fact that the average consumer is not accustomed to presuming the origin of a product on the basis of its shape; therefore, distinctiveness may be more difficult to establish.

Nevertheless, the court stated that, according to case law, a shape mark should not refer to the shape of the product in order for it to have distinctive character: the more the shape resembles the product, the less distinctive it is. Therefore, the fact that a shape is a variant of a common shape for that type of product is

not sufficient to demonstrate the distinctive character of that mark: the difference must be sufficiently significant from the point of view of the relevant consumer.

In the present case, the court considered that the relevant consumer had an average degree of attention - contrary to what was claimed by the applicant, which considered that consumers possess a higher degree of attention in the domain of footwear. As such, the applicant considered that consumers would not perceive the 3D mark as a shoe-fastening system due to its novel character (in other words, it would not be recognised by the relevant public as such shape did not previously exist).

In order to render its decision, the court considered first shoe laces, and then the other goods covered by the application.

The court, considering the definition of ‘shoe laces’, concluding that they are intended to “bring both sides of the upper of a shoe closer together and to keep them attached”. Neither the materials used, nor the type of fastening system, enter into consideration: only the characteristic of maintaining both sides of a shoe attached must be taken into account. The court thus refuted the argument of the applicant, according to which the action of *tying* a shoelace was an essential characteristic in the determination of distinctiveness, as the mark did not depict such action. Consequently, the court found that the mark was not distinctive in relation to “shoe laces”, as it did not allow for the identification of the commercial origin of the goods.

Regarding the rest of the products covered, the court considered that the same assessment

applied as these products designated a system for fastening shoes. Indeed, these goods were simply variants of a shoe-fastening system. Therefore, the sign was devoid of distinctive character for these goods as well.

Finally, the court confirmed that, even though the sign could be used for goods other than those covered by the mark, this could not be taken into account in the determination of the distinctive character of the mark. Only the goods or services covered must be considered.

In light of the above, the court rejected the appeal for all the goods applied for.

## **Comment**

From a practical standpoint, the decision serves as a reminder that new evidence should not be submitted for the first time at the final stage of the proceedings, as it is not the court's function to assess facts in light of newly-submitted materials. Parties should keep this in mind when progressing through proceedings before the EUIPO and the court.

With regard to the substance of the case, the decision highlights that a 3D mark must be represented in a manner that is far removed from the products covered to avoid being considered as descriptive. The decision follows the general case law of the court, which continues to adopt a strict position concerning the examination and determination of distinctive character.

Therefore, applicants would be advised to file their trademark applications in broader terms and without specifying in great detail the products covered. This would avoid possible complications and challenges by the EUIPO arising from a highly specific wording.

Finally, it should be borne in mind that, in similar cases, a design application may be a better option than a 3D trademark application, as there would be no analysis of the distinctive character and such application would be more difficult to challenge on the basis of a design.