

# Acquired Distinctiveness through Use regarding Three Dimensional Trademarks

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# Acquired distinctiveness

## Article 7(3) EUTMR

1. Legal framework
2. Relevant point in time / Relevant public / What do we have to prove and where?
3. Evidence
  - Standard of proof
  - Means of evidence
  - General rules of assessment
  - Common mistakes in the presentation of evidence
4. Case law examples



# Legal Framework

Article 7(3) EUTMR is an exception to the rule of Article 7(1)(b), (c) , (d) EUTMR  
*‘Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.’*

Article 7(3) requires a claim by the applicant

*‘The application may include a claim that the sign has acquired distinctive character through use within the meaning of Article 7(3) ..., as well as an indication of whether this claim is meant as a principal or subsidiary one. Such claim may also be made within the period referred to in Article 42(2)...’*

- In the **application** or in the **first reply** to the objection; not possible for the first time in appeal proceedings
- Two types : **Principal** claim → One single decision **Subsidiary** claim → Two separate decisions



# Relevant Point in Time

## Examination:

- EUTM applications: **Filing date** (Priority date)
- International Registrations (IR): **Registration date** (Designation date of EU)

## Cancellation:

- If a trade mark has acquired distinctive character **after registration** it may not be declared invalid, Article 59(2) EUTMR).



# What do we have to prove?

The EUTM applicant must submit evidence that enables the Office to find that at least a significant proportion of the relevant ... public identifies the products or services ... as originating from a particular undertaking because of the trade mark .

(T-262/04, Briquet à Pierre, EU:T:2005:463, § 61 and the case-law cited therein).

- The burden of proof is on the applicant.
- The evidence must show use as a trade mark (not descriptive use).
- Evidence must be submitted for each of the goods and services claimed.



# Where do we have to prove?

- Acquired distinctiveness must be established **throughout the territory** in which the trade mark did not ab initio have distinctive character. (C-25/05 P)
- A **significant proportion of the relevant public** (actual and prospective consumers of the goods/services)
- In **all the relevant territories** and in respect of **each of the goods and services**.  
Possibly in the whole EU (e.g. in case of purely figurative or 3D marks).





# Standard of proof

- Article 7(3) EUTMR is an exception. → The required standard of proof is high and the assessment is strict.
- The evidence must be presented in a **structured manner** (Art 55 EUTMDR) and must be **clear and convincing**. The applicant must clearly establish all the facts necessary to safely conclude that the mark has been used as a badge of origin to an extent that it has created a link with the goods or services in the mind of the relevant public.
- According to Case-law there are no fixed percentages of market penetration or of recognition by the relevant public (judgment of 19/06/2014, C-217/13 and C-218/13, Oberbank e.a., EU:C:2014:2012, § 48).



# General Rules of Assessment





The Office must make an **overall assessment** of all the evidence submitted , weighing up each indication against the others , e.g.

- **Market share** held by the mark with regard to the relevant goods or services
- **Extent of use** of the mark (intensity, geographical reach, duration)
- **Investment** in promoting the mark for the relevant goods or services
- **Proportion of the relevant public** who actually, because of the mark, identifies the goods or services as originating from a particular undertaking

(C-108/97 and C-109/97, Chiemsee, EU:C:1999:230, § 31; T-378/07, Représentation d'un tracteur en rouge, noir et gris, § 32)



# General mistakes in the evidence

- The evidence is not properly structured .  Clear and convincing
- The date of use cannot be identified.  Relevant point in time
- No link to the relevant territories / goods and services.  Relevant public
- The evidence filed only corroborative evidence. Consumer recognition 



# Case law examples



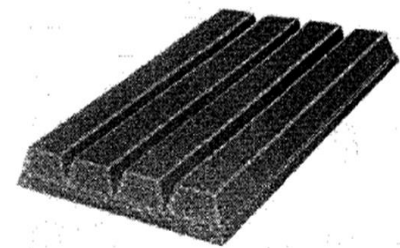
C 98/11 P, Hase EU:C:2012:307

SHAPE OF A 4-FINGER CHOCOLATE BAR C-84/17

P, C-85/17 P and C-95/17 P, EU:C:2018:596



19/10/2022, T-275/21 , Louis Vuitton Malletier v  
EUIPO - Wisniewski (Représentation d'un motif à  
damier II





- Proving acquired distinctiveness in the whole EU :
- “It would be unreasonable to require proof of acquired distinctiveness for each individual Member State.”
- Relevant evidence in relation to cross-border markets.
- Physical stores → online presence and online advertising on the internet and/or social media, and/or shops in popular tourist areas or airports, T-275/21)
- Evidence from non-EU states irrelevant, except for  
conclusions to be drawn about use within the EU





# CP9 EUIPN: minimum threshold for distinctiveness of shape marks when the shape itself is non-distinctive

If a non-distinctive shape contains an element that is distinctive on its own, it will suffice to render the sign as a whole distinctive



**Distinctive**





Class 32 Bottled drinking water



Class 28 Playing balls



Class 32  
Beverages



Class 16 Pencil boxes



Class 32  
Bottled  
drinking water



Class 32  
Bottled  
drinking water

## 01 – DISTINCTIVE

The **use of less contrasting colours** can still be sufficient to allow an element to be identified as distinctive in the representation and result in a distinctive sign.

## 02 - NON-DISTINCTIVE

When the element **cannot clearly be identified as distinctive** in the representation due to a lack of contrast, the element will have no impact on the assessment of the distinctiveness of the sign as the consumer will not be able to immediately identify such element and ultimately to distinguish the sign from others.

## 03 – DISTINCTIVE

The effect of engraving/embossing/debossing **may also influence the identification of the element** and the overall assessment of the distinctiveness of the sign.

## 04 - NON-DISTINCTIVE

In principle, the fact of engraving/embossing/debossing **a non-distinctive element on a non-distinctive shape** is not in itself sufficient to render a sign distinctive.



Class 7 Wind turbine



Class 7 Electric door opener



Class 9 Memory card



Class 20 Chairs



Class 16 Pencils



Class 9 Mobile phone cases

### **DISTINCTIVE**

This particular colour arrangement is unusual in the market and simple enough to create a memorable overall impression for the specialised consumer to recall as a means of identification, and is not perceived as decorative.

### **NON-DISTINCTIVE**

Consumers will not perceive the addition or use of a single colour or combination of colour as an indication of origin. Use of colour on this type of goods is common on the market, provides information on the nature of the goods in question or conveys exclusively a decorative message.



# General Rules of Assessment

It is possible to prove acquired distinctiveness of a sign that has been **used together with other trade marks** provided that the relevant consumer attributes to the sign in question the function of identification

(T 75/08, I, EU:T:2009:374, § 43; 28/10/2009, T 137/08, Green/Yellow, EU:T:2009:417, § 46).

**But**

The trade mark applicant must prove that that the mark alone, as opposed to any other trade mark that may also be present, identifies the particular undertaking from which the goods originate.

(C 215/14, Nestlé KIT KAT, EU:C:2015:604, § 66; T 411/14, Shape of a bottle (3D), EU:T:2016:94, § 76; T 363/15, LAATIKON MUOTO (3D), EU:T:2016:149, § 51).



# THANK YOU