



## Study Question

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**Registrability of 3D trademarks**

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### I. Current law and practice

***Please answer the below questions with regard to your Group's current law and practice.***

**1** Are 3D Shapes\* registrable as a trademark? Please answer YES or NO.

*If you have answered NO, please skip Questions 2 to 9 and proceed to Question 10.*

*\*This Study Question focuses on signs consisting of 3D shapes comprising solely the three-dimensional shape of goods or packaging without any addition (3D Shapes). (see further para. 12 of the Study Guidelines).*

Yes

(Explanation is Optional)

**2** Can a 3D Shape be inherently distinctive? If YES, what test is applied in order to establish if it is inherently distinctive?

Yes

What test is applied in order to establish if it is inherently distinctive?

A 3D Shape can be inherently distinctive. However, the threshold set by statutory and case law is rather high.

Art. 2 let. a and let. b of the Swiss Trademark Act (hereinafter "TMA") excludes from trademark protection:

a. signs that are in the public domain, except where they have become established as a trade mark through use for the goods or services for which they are being claimed.

*b. shapes that constitute the nature of the goods themselves or shapes of the goods or their packaging that are technically necessary.*

It is well established in the doctrine and is also generally applied by the courts that the test starts with let. b. As a matter of fact, if there is already an absolute ground for refusal according to let. b, there is no necessity to examine the 3D Shape pursuant to let. a. On the other hand, if a form is not excluded from protection under let. b, the protectability has further to be examined under let. a.

Consequently, in a first step one must determine whether:

- the 3D Shape constitutes the *nature of the good* as such (*referral to answer to Question 4*);
- or if the 3D Shape of the goods or its packaging is *technically necessary* (*referral to answer to Question 5*).

Statutory law excludes from trademark protection any shapes that constitute the nature of the goods themselves or shapes of the goods or their packaging that are technically necessary (art. 2 let. b TMA). A 3D Shape is considered to constitute the *nature* of the goods if all of its pertinent elements present in this shape correspond to what the relevant public is expecting from such goods in terms of its functional or aesthetic properties.

This provision is a reflection of the general principle according to which signs that are in the public domain are not inherently distinctive. However, as opposed to other signs that lack inherent distinctiveness, shapes falling under the aforementioned provision are considered to be absolutely essential so that they must be kept freely available and cannot acquire distinctiveness.

It remains unclear in which cases a 3D Shape or its pertinent elements may be considered *aesthetically necessary* so as to represent the nature of the goods. It is, however, the understanding of the Swiss Federal Supreme Court that forms representing the nature of goods are considered to be *aesthetically necessary* if they cannot be changed or replaced without changing the specific characteristics of the goods themselves (cf. Michael Noth, in: Noth/Bühler/Thouvenin (eds.), Kommentar zum Markenschutzgesetz (MSchG), 2<sup>nd</sup> ed., Bern 2017, Art. 2 let. b TMA para. 36).

A 3D Shape is considered to be *technically necessary* if there are:

- either *no alternative shapes at all* to achieve the essential technical function of the goods,
- or if the applicant's competitors cannot be reasonably expected to use possible alternative shapes because doing so would result in higher costs of production, in less practical or less solid goods.

In a second step one must determine whether the relevant public may perceive of the 3D Shape as an identifier for a particular source.

The Swiss Federal Supreme Court requires that in order for the 3D Shape to be inherently distinctive it must sufficiently differ from the shapes the relevant public is accustomed to or may expect with regard to the specific kind of goods. In assessing whether there is a sufficient degree of difference, one has to take into account the variety of shapes of goods of this specific kind already on the market.

Generally speaking, the *degree* of difference required depends on the variety of shapes already on the market for the goods in question. The larger the variety of shapes of goods already on the market, the stronger the 3D Shape must differ from such already existing shapes in order to be found inherently distinctive.

Besides, the Swiss Federal Supreme Court and the legal doctrine distinguish the following categories of 3D Shapes that have a functional aspect without being technically necessary within the meaning of art. 2 let. b TMA as outlined above (cf. BGE 129 III 514 – LEGO; Michael Noth, in: Noth/Bühler/Thouvenin (eds.), Kommentar zum Markenschutzgesetz (MSchG), 2<sup>nd</sup> ed., Bern 2017, Art. 2 let. b TMA para. 60 et seqq.):

- 3D Shapes where the shape is *determined* by the technical function. Such shapes are basically considered not to be inherently distinctive unless they display "originality". The use of the term "originality" by the Supreme Court in this context has encountered criticism in legal literature. In fact, it is not clear whether the "originality" requirement represents a separate criteria or whether it merely denotes a specific quantitative aspect relating to the degree of difference between the 3D Shape and the shapes of goods already on the market. In any case, 3D Shapes falling into this category may only be considered to be inherently registrable in rather exceptional cases.
- 3D Shapes where the *shape is influenced but not determined by the technical function*. This group includes shapes that are technically useful but not technically determined or even necessary.

Hence the threshold to pass the inherent distinctiveness test is particularly high with regard to 3D Shapes that include a strong

functional aspect and are claimed as trademarks for goods or packagings in a field where there is already a large variety of shapes on the market.

**3 Can a 3D Shape acquire distinctiveness? If YES, what test is applied in order to establish if it has acquired distinctiveness?**

Yes

What test is applied in order to establish if it has acquired distinctiveness?

There is no specific test. The Swiss Federal Institute of Intellectual Property (hereinafter "IPI") or court is free in the assessment of the evidence provided and no fixed evidence requirements apply. In other words, all evidence that is capable of proving acquired distinctiveness is permitted (Federal Administrative Court decision B-5120/2014, consid. 6.1.2 – Implant element). However, in most cases demoscopic surveys need to be submitted.

Generally, it is required that a particular sign in the public domain - or in this case a particular 3D Shape - has become distinctive and is understood by a significant portion of the relevant consumers in all parts of Switzerland as an individualising indication of particular products of a particular undertaking (Swiss Federal Supreme Court decision BGE 130 III 328, 332 – Watch band). This can be established *indirectly* by providing, for example evidence of significant profits generated over many years due to a specific sign, (or 3D Shape) or intensive advertising efforts over many years (BGE 130 III 328, 332 – Watch band. As a rule of thumb, the IPI requires in registration proceedings that a sign or 3D Shape has been used for at least ten consecutive years prior to the trademark application in order for acquired distinctiveness to be applicable at all, cf. IPI Guidelines, dated 01.01.2017, div 5, para. 11.2.5). It can also be established *directly* by providing demoscopic surveys conducted with the relevant consumers (BGE 130 III 328, 332 – Watch band). The mere fact that a 3D Shape is well-known, however, does not necessarily mean that it has acquired distinctiveness (Federal Administrative Court B-6629/2011, cons. 9.3 – ASV). Only if a 3D Shape is recognised and understood as a trademark on a standalone basis, can such a 3D Shape acquire distinctiveness (BGE 130 III 328, 332 – Watch band).

The threshold for 3D Shapes to acquire distinctiveness is generally the same for word and for figurative elements (BGE 130 III 328, 335 – Watch band). The long-time use of a common form of a good is generally perceived to a lesser extent as a trademark as opposed to a word or a figurative element (BGE 130 III 328 334 et seq.). In particular and according to the Federal Supreme Court's long-standing case law, the public perceives the design of goods primarily as the design of the goods itself rather than as an indication of commercial origin (e.g. BGE 134 III 547, 553 – Panton II) – even after many years of use (BGE 130 III 328, 335 – Watch band). Therefore, in many cases it may be required to provide direct evidence; for example by providing demoscopic surveys (cf. IPI Guidelines of 1 January 2017, div 5, para. 11.3.2; BGE 130 III 325, 335 – Watch band). The Swiss Federal Supreme Court has described the value of two thirds (i.e. 66%) of the relevant consumers as a sufficient guideline for the assumption of acquired distinctiveness (BGE 128 III 441, 444 – Appenzeller); in another decision, however, which concerned the question of a notorious trademark, it considered a value of at least 50% as sufficient (BGE 130 III 267, 283 – Tripp Trapp). The provided demoscopic surveys are nonetheless not binding on the competent authority or court (Federal Administrative Court B-5653/2015, cons. 8.2 - Havana Club).

The more common/usual a 3D Shape is in connection with the claimed goods, the higher the threshold for it to acquire distinctiveness (BGE 130 III 328, 333 – Watch band). Excluded from trademark protection, however, are 3D Shapes that constitute the nature of the goods themselves or 3D Shapes of the goods or their packaging that are technically necessary (see below question 4) and forms which are considered to correspond to a requirement of availability. The latter question was left open in the "Smarties-decision" by the Swiss Federal Supreme Court (BGE 131 III 121).

Unlike in civil court proceedings (for example a cancellation action) where acquired distinctiveness must be fully established/proven (BGE 130 III 478, 480 – Lernstudio), it is sufficient in registration proceedings if the applicant can provide *prima facie* evidence that the 3D Shape has acquired distinctiveness (BGE 130 III 328, 332 - Watch band).

**4 Will a 3D Shape be refused registration, or is a 3D Trademark\* liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test is applied.**

*\*3D Shapes registered as trademarks (see also para. 14 of the Study Guidelines)*

Yes

Please describe what test is applied.

According to art. 2 let. b TMA a 3D Trademark is refused registration as it lacks distinctiveness if it consists exclusively of the shape or other characteristic resulting from the nature of the goods themselves. Accordingly, a registered trademark could be declared invalid on the same basis.

A 3D Shape is considered to constitute the *nature* of the good if all its pertinent elements present in this shape correspond to what the relevant public is expecting from such a good in terms of its functional or aesthetic properties.

It remains unclear in what cases a 3D Shape or its pertinent elements may be considered *aesthetically* necessary so as to represent the nature of a good. However, according to the Swiss Federal Supreme Court that forms, representing the nature of goods, are considered to be aesthetically necessary if they cannot be changed or replaced without changing the specific characteristics of the good itself (cf. BGE 129 III 514, 520 – LEGO; MICHAEL NOTH, in: Noth/Bühler/Thouvenin (eds.), Kommentar zum Markenschutzgesetz (MSchG), 2nd ed., Bern 2017, Art. 2 let. b TMA para. 36). Also in a decision having the Lindt chocolate spheres ("Lindor") as subject matter (decision 4A\_129/2007 of 18 July 2007, cons. 3.2.3), the Swiss Federal Supreme Court stated that these Lindor spheres, i.e. the form of their "wrapped-form" or packaging corresponds to the nature of the goods themselves.

5

**Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test is applied.**

Yes

Please describe what test is applied.

According to article 2 let. b TMA it is not possible to register a shape which is technically necessary. Accordingly, a registered trademark could be declared invalid on the same basis.

A form is considered to be "technically necessary" if there is no alternative design available to achieve the same technical result. If alternative designs exist, but they are less practical, less solid or cause higher production costs, then the criterion of technical necessity is already met. In the courts' view, even very small differences in production costs may be regarded as economically unreasonable considering that the registration of a 3D Trademark grants to trademark owners a time-unlimited monopoly. Such monopoly should be granted only if competitors, in view of the existing equivalent alternatives, suffer no disadvantages at all.

In 2012, the Swiss Federal Supreme Court decided that the shape of Lego bricks does not enjoy trade mark protection in Switzerland (decision 4A\_20/2012 of 3 July 2012). The brick shape was considered technically necessary and therefore excluded from trade mark protection under Art. 2 let. b TMA. This judgment (and an older decision concerning the Lego bricks: BGE 129 III 514, dated 2 July 2003) illustrates the practical difficulty of registering shape marks even in cases where alternative shapes exist.

6

**Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test is applied.**

Yes

Please describe what test is applied.

The TMA does not contain a similar specific provision. It does not explicitly mention that a 3D Trademark consisting exclusively of a shape, or another characteristic which gives substantial value to the goods, shall be invalid.

While some argue that the value could qualify as a relevant part of the nature/characteristics of a good (covered by Art. 2 let. b TMA), this would not be correct in the Group's view and Art. 2 let. b TMA should not be applied even to cases where the 3D Shape consists exclusively of the shape or another characteristic which gives substantial value to the goods.

Otherwise, shapes (for example furniture or watches) for which the design is especially important, and as a result adds substantial value to the goods, could no longer be registered as trademarks. Furthermore, Article 4(1)(e) EU Trademark Directive and Art. 2 let. b TMA are conceptually different. While Article 4(1)(e) EU Trademark Directive still permits acquired distinctiveness, this would not be possible under Art. 2 let. b TMA (cf. Michael Noth, in: Noth/Bühler/Thouvenin (eds.), Kommentar zum Markenschutzgesetz (MSchG), 2<sup>nd</sup> ed., Bern 2017, Art. 2 let. b TMA para. 39).

In any case, the IPI applies a similar test when determining whether a 3D Trademark is inherently distinctive or not under Art. 2 let. a TMA. As already explained above (see answer to Question 2), the design of a shape is generally deemed to be aimed at meeting functional and esthetical criteria. A shape will only be considered as inherently distinctive if it serves as a source indicator in addition to its functional and aesthetical characteristics (IPI Guidelines of 1 January 2017, para. 4.12.3, p. 142). If the shape is mainly based on esthetical considerations it will be considered to be purely decorative and not distinctive. Consequently, a shape is only inherently distinctive, if the relevant public sees aspects of a source indicator in the shape, and not only functional and esthetical aspects (IPI Guidelines of 1 January 2017, para. 4.12.5.1, p. 145).

Consequently, Art. 2 let. b TMA should not apply to cases where a 3D Shape consists exclusively of the shape, or another characteristic, which gives substantial value to the goods. However, such registration of shapes may still be refused by the IPI based on Art. 2 let. a TMA to the extent that the relevant public does not see aspects of a source indicator in the shape (cf. answer to Question 2 above).

**7 Is there any other ground of absolute refusal or invalidity specific to 3D Shapes or 3D Trademarks available under your Group's current law?**

Yes

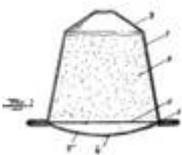
Please Explain

The criteria for assessing the distinctive character of 3D Trademarks/Shapes are no different from those applicable to other trademark categories (recently: Federal Administrative Court, B-7547/2015 dated 13 November 2017, cons 6.1.5.1). However, 3D Trademarks that consist of the shape of the product itself or the shape of its packaging are usually not perceived by the consumers as indicators of origin but merely as the form of the product (or the packaging) itself. In light of this it is more difficult to establish (inherent or acquired) distinctiveness (Swiss Federal Supreme Court, BGE 130 III 328, cons 3.5; Federal Administrative Court, B-498/2008 dated 23 October 2008, cons 2.1).

It is often argued against trademark protection of 3D shapes that the shape in question is functional and might undermine patent protection.

For example, a dispute between Nestlé and Ethical Coffee arose when the latter launched adaptable coffee capsules that resembled those of Nestlé. In this context, the Swiss Supreme Court held *obiter dictum* that granting Nestlé protection for the capsule by way of a 3D Trademark, which could be renewed indefinitely, could undermine the objectives of the limited duration of patents (Swiss Federal Supreme Court, 4A\_36/2012, cons 2.3; see Arnold F. Rusch, AJP/PJA 2017, p. 920, p. 921 and Lorenza Ferrari Hofer, AJP/PJA, 2013, p. 592, p. 594).

In a nutshell, in 1990, Nestlé filed a patent application for a “closed cartridge for making a beverage” represented by the following drawing:



This patent application was accepted and published (EP0554469). In 2000, Nestlé filed the following application for a 3D Trademark in Switzerland, covering products of class 30:



This trademark was accepted by the IPI as having acquired distinctiveness (“marque imposée”; “durchgesetzte Marke”) (Swiss trademark n° 486889).

The case was then remanded to the cantonal court, which, on interim measures, decided that Nestlé’s 3D Trademark was technically necessary, and thus could not be protected (Civil Court of Canton Vaud, CM11.036478, 75/2014/XMD, cons. III.c).

In another preliminary proceedings re coffee capsules, however, the St. Gallen Commercial Court, after having heard technical expert's opinion, affirmed that the respective 3D trademark is valid (Commercial Court St. Gallen, in: sic! 2013, p. 759 – Nespresso IV).

In any event, a closer look reveals that notably EP0554469 claims patent protection for a “*method of extracting* closed cartridges with filters (...)” and a “closed cartridge *with filter*, containing a substance for the preparation of a beverage, in particular roasted and ground coffee, said cartridge having substantially the shape of a truncated cone with a lower face provided with *a line of weakness, characterized in that said line of weakness determines a reduced tear zone*” (emphasis added). Notably the “method of extracting closed cartridges”, the “cartridge with filter” and the “line of weakness” inventions are not subject of the 3D trademark. Besides, the aim of patent and of trademark law differs fundamentally. While trademark law protects the distinctive character of a shape, patent law refers to a technical invention. Since the technical solution in question can be used for closed cartridges with a different shape, the *teaching of the patent is available* to third parties and will not be undermined by trademark protection, even if a specific shape of a capsule is protected as a 3D mark. According to the LEGO landmark decision, competitors can be required to chose a different shape, as long as there are technically equivalent alternatives and even if the shape in question is technically conditioned. Thus, there is, in the Swiss Groups view, no need for additional grounds of absolute refusal or invalidity.

**If you have answered NO to each of Questions 4, 5, 6 and 7 proceed to Question 10.**

**If you have answered YES to any one of Questions 4, 5, 6, or 7, please answer Questions 8 and 9 in relation to the relevant refusal / invalidity ground(s).**

**8** Do the refusal / invalidity grounds referred to in Questions 4, 5, 6 and/or 7, to the extent available in your Group's jurisdiction, operate independently from one another or may they also apply in combination? For example, do they apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

Refusal/invalidity grounds operate independently from one another in Switzerland. For example, if a shape is dictated both by technical necessity and results from the nature of the goods, it would be sufficient for either one of these exclusion grounds to apply to prevent the registration of or invalidate a 3D Trademark.

Refusal/invalidity grounds must be realized in full. Only partially realized exclusion grounds may not be cumulated to refuse the registration of or invalidate a 3D Trademark. In other words, if a shape is only in parts technically necessary, it cannot be invalidated by an additional finding that it also partially results from the nature of the goods.

**9** Which, if any, of the refusal / invalidity grounds referred to in Questions 4, 5, 6 and 7, to the extent available in your Group's jurisdiction, can be overcome by acquired distinctiveness?

According to Swiss law, only

1. shapes that constitute the *nature of the goods* themselves, and
2. shapes of the goods or their packaging that are *technically necessary*,

are absolutely excluded from trademark protection. Other shapes in the public domain, notably technically conditioned shapes, can be protected as trademarks if they have acquired distinctiveness (BGE 129 III 514 cons. 2.4.3 – LEGO). The same applies – to the extent that they belong to the public domain – to shapes which give substantial value to the goods, even though this categorization does not exist under Swiss law.

## II. Policy considerations and proposals for improvements of your current law

**10** Could any of the following aspects of your Group's current law be improved? If YES, please explain.

**0.a** Registrability (or lack thereof) of 3D Shapes

Yes

Please Explain

As an overall remark it can be stated that, in general, the registrability of 3D Shapes should be improved, meaning that the threshold regarding the distinctiveness of a sign should be lowered and the perception of the consumers should be interpreted more pragmatically (see remarks below regarding perception of consumers). The main focus should be on how the 3D Shape is *perceived* and on the question as to whether the consumer can assign the Shape to a certain company / brand. This function of a trademark results also from the wording of the definition of trademark protection according to Art. 1 TMA: "A trademark is a sign *capable* of distinguishing the goods or services of one undertaking from those of other undertakings". It is still the general view that consumers do rather not perceive 3D Shapes/Trademarks as indicators of origin. This is, however, a perception that might have changed over the years and it may be realistic to suggest that consumers are able to identify a certain form not only as design as such but are also able to recognize the underlying brand.

Furthermore, it would be a welcome development if the IPI and/or the courts were to work out clear principles with regard to the evaluation of the overall impression. It seems that the overall impression is a rather neglected criterion.

**0.b** The test applied, if any, in relation to the registrability (based on inherent and/or acquired distinctiveness) referred to in Question 10(a)

Yes

Please Explain

With respect to the tests applied for the establishment of inherent or acquired distinctiveness within the registration process, please refer to the answers to Questions 2 and 3.

The text of the law itself, meaning the basis of the test is still reasonable. However, the test, i.e. the approach of the IPI / the courts in relation to the inherent and/or acquired distinctiveness should be modernized. Companies and branding experts play around with forms and packaging and often, the seemingly most simple forms are actually the most recognizable. Thus, it is wrong to think that the design of the form of a product, i.e. the form of a product and/or a packaging only serves an esthetic purpose. It should be taken into consideration that 3D Shapes / the form of a product are well perceived as indicators of origin and therefore fulfil the very purpose of a trademark. This is especially true with regard to the test based on the acquired distinctiveness.

The assumption on which the prevailing case law is based, in particular that 3D Shapes are in general less suitable than word-marks to serve as trademarks, should be reconsidered. Today, the variety of forms and shapes and the availability of technical means of inventing new shapes has advanced dramatically since the TMA came into force in the nineties.

**0.c** The refusal / invalidity grounds, if any, referred to in Questions 4 to 7 (and potential combination thereof)

Yes

Please Explain

It can cause confusion that the technical necessity is tested pursuant to Art. 2 let. b TMA and the technically required form of a product (forms which are determined by the purpose of use without being technically necessary) is taken into consideration when examining the attribution to the public domain according to Art. 2 let. a TMA.

**0.d** The possibility or lack thereof to overcome these refusal / invalidity grounds by acquired distinctiveness.

Yes

Please Explain

The general perception that the consumer would not understand / recognize the shape of a good or a packaging as indication of origin is somehow outdated. Brands and companies also play with the design of the packaging and the forms of the goods; this should be taken into consideration by the IPI. Thus, the statement of the Swiss Federal Supreme Court that the design of products and/or its packages is aimed at functional or aesthetic criteria (BGE 134 III 547, cons. 2.3.4) should possibly be reformulated in order to better overcome the hurdle of "acquired distinctiveness". In this regard, aesthetics should not affect the brand function itself – the fact that a 3D Shape is considered aesthetic does not make it banal or simple. The Federal Supreme Court seems to dissent: In BGE137 III 403 of 23 May 2011 ("Wave-Packaging") it states that the fact that the packaging has won several design-awards and is considered as being aesthetic and carefully designed would not have any (positive) influence on the distinctiveness and the interpretation as indicator of origin (BGE 137 III 403 cons. 3.3.7).

**11** Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

Yes

Please Explain

The ground for refusal that a shape should not be simple or banal can in certain cases lead to unnecessary and strange applications. Some companies try to design surprising packages and product-forms which, however, do not make sense with respect to the actual purpose of a trademark as indicator or the origin of the product.

An older case from the Federal Administrative Court (chocolate Santa Claus from Lindt, decision of 21 March 2007, B-7393/2006) shows that also forms, which are typical for a brand and for a company but not particularly distinctive and/or aesthetic – according to the Swiss Court – do not qualify as indicators of origin. Although from a practical point of view, they are clearly recognizable as a form from the "Lindt" company. In that regard, the Courts and the IPI could preferably take on a more practical view, i.e. interpretation of the law and reliance on the experience and/or perception of branding-/marketing specialists who indicate that the distinctiveness of design and features can very well serve the purpose of an indicator of origin.

### III. Proposals for harmonisation

**Please consult with relevant in-house / industry members of your Group in responding to Part III.**

**12** Does your Group consider that harmonisation in any or all areas described in the response to Question 10 or 11 above is desirable? Please answer YES or NO.

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.*

Yes

Please Explain

**13** Does your Group consider that 3D Shapes should be registrable as a trademark? Please answer YES or NO.

Yes

Please Explain

The Group is of the opinion that any type of sign deserves trademark protection as long as it is able to distinguish products and services from one undertaking from those of another, i.e. signs which in abstracto are able to be distinguished.

Trademark legislations should foresee specific grounds for refusal of registration of 3D Trademarks, which would exclude shapes

that constitute the nature of the goods themselves or shapes of the goods or their packaging that are technically necessary. A sign considered invalid under this specific grounds should also not be capable of achieving acquired distinctiveness through use. Accordingly, registration for 3D Trademarks should generally exclude shapes that consist exclusively of technically necessary elements.

Moreover, 3D Trademarks shall not belong to the public domain. This concerns simple and banal shapes, for instance cubes or spheres. In order to be considered distinctive, the shape has to distinguish itself from the standard and common set of shapes. In other words, the shapes must stand out from the common and expected shapes and accordingly will be remembered by the consumer. The basis for comparison has to be the differentiation from simple and banal shapes. If existing forms were to be considered, this would be equivalent to applying relative grounds for refusal.

Applying the principle of differentiation from simple and banal shapes is not always helpful. A shape might not be simple or banal and still not be considered as distinctive. A possible approach on which to base the assessment of the main functions of a trademark might be, (i) the function to identify the goods and (ii) the function to indicate the origin of the goods.

In order to fulfill the requirement of being able to identify the goods, "individuality" and "originality" might be sufficient, but this would not be sufficient to act as an indicator of origin. In essence, the consumer must be able to identify in the shape a sign for goods of a specific undertaking and link it to it.

The criterion regarding consumers being used to seeing an indication of origin in a shape is not to be pursued as the risk arises that only shapes for which a habit with the consumer has been created will be regarded as distinctive. Last but not least it is not clear how this criterion relates to acquired distinctiveness.

14

**Should it be possible for a 3D Shape to be inherently distinctive? If YES, what test should be applied in order to establish if it is inherently distinctive?**

Yes

What test should be applied in order to establish if it is inherently distinctive?

For determining the distinctiveness of a 3D Shape the following evaluation criteria may be considered:

1. There should be a clear distinction between the distinctiveness in fact (equal to factual distinctiveness) and the normative distinctiveness in the interest of a free competition.
2. In the event that an inherent factual distinctiveness were to be admitted, the trademark law protection and the registration of a 3D Shape should not be refused based on normative grounds, except for, as set out below (div 17), the necessity for competitors to use the 3D Shape in order to obtain a technical result in connection with the goods applied for and/or another necessity for competitors to use the 3D Shape for their respective goods with which a trademark protection of the 3D Shape would interfere.
3. Generally, the inherent factual distinctiveness should be assessed according to the same criteria as other categories of trademarks. In particular there should be no presumption that 3D Shapes have less inherent factual distinctiveness than other kinds of trademarks.
4. The assessment of the inherent distinctiveness in fact should be made by taking into account the overall impression of the sign and should be made with a view to the goods and services applied for.
5. In a sector of commerce where consumers are not used to consider a 3D Shape an indication of origin, a variety of different forms is an indication against the inherent factual distinctiveness of a 3D Shape as an indication of origin.
6. In sectors of commerce where the consumers are used to 3D Shapes as indicators of origin, there should be a presumption for the inherent factual distinctiveness of a 3D Shape. As a result, trademark protection should only be denied for lack of inherent factual distinctiveness if there is a previous use of a nearly identical 3D Shape in the respective sector of commerce.
7. It should not be considered an indication against the inherent distinctiveness that one or several elements of the 3D Shape have

already been used in the respective sector of commerce, as long as no previous use of the entire 3D Shape can be ascertained.

8. A previous use of a 3D Shape in the respective sector of commerce of only some months and/or with very low quantities should not be considered to influence the perception of the consumers and therefore, should not have any impact on the assessment of the inherent factual distinctiveness.
9. 3D Shapes of packaging should be assessed according to the same criteria as 3D shapes of goods.
10. The aesthetic character of the 3D Shape or of a part of it should not exclude the inherent factual and normative distinctiveness.
11. Parts of 3D Shapes should be capable of trademark protection and registration, even if the respective part of a good does not constitute separately marketable goods; on the other hand, a part of the 3D Shape would have to have factual and normative distinctiveness for the goods applied for.

These criteria shall ensure trademark protection for 3D Trademarks and 3D Shapes are based on objective elements which are determined based on the appreciation of the addressees.

**15** Should it be possible for a 3D Shape to acquire distinctiveness? If YES, what test should be applied in order to establish if it has acquired distinctiveness?

Yes

What test should be applied in order to establish if it has acquired distinctiveness?

A strict test to be applied in order to establish if a 3D Shape has acquired distinctiveness does not appear to be practical. In particular, it is established case law that all circumstances must be taken into account to establish an answer to this question. The above mentioned criteria (see question 3) that have been developed by Swiss case law provide a reasonable basis on which to answer this question. With an increasing amount of case law based on these criteria, trademark owners will be better able to predict legal decisions.

For the benefit of trademark owners, however, it would be desirable if the presumption of the Swiss Federal Supreme Court, according to which the public perceives the design of a good primarily as the design of the good itself rather than as an indication of commercial origin (e.g. BGE 134 III 547, 553 – Pantan II), was abandoned. In particular, it would be beneficial to trademark owners if 3D Shapes were to be treated in the same way as other trademark categories (i.e. word and figurative trademarks), especially in areas of business in which consumers are used to 3D Shapes as an indication of commercial origin (e.g. design furniture). The aforementioned restrictive presumption of the Swiss Federal Supreme Court is one of the main reasons why there have been relatively few trademark applications in Switzerland for 3D Shapes (cf. Flury, in: Zuberbühler/Münch/Schweizer/ Schwenninger [ed.], Markenrechtliche Entscheide / Fallgruppe I: Unterscheidungskraft, Freihaltebedürfnis und Verkehrsdurchsetzung / Welche Anforderungen gelten für den Nachweis der Verkehrsdurchsetzung einer Form mit Gemeingutcharakter, die als Marke beansprucht wird? – Kommentar zu BGE 130 III 328 (SWATCH-Uhrenarmband), 37-42, 41 et seq.).

**16** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

See above Question 4. Anyway, if such 3D Shape lacks distinctiveness there is no need to apply another test than distinctiveness / descriptiveness.

**17** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

See above answer to Question 5.

**18** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test should be applied.

No

(Explanation is Optional)

Whether the shape or another characteristic gives substantial value to the goods should not be taken into account when determining registrability. See above answer to Question 6.

**19** Should there be any other absolute refusal or invalidity ground specific to 3D Shapes or 3D Trademarks? If YES, please explain briefly.

No

(Explanation is Optional)

No other absolute grounds for refusal or invalidity of 3D Shapes should be added. As stated above, the protection of 3D Shapes is already rarely granted. Thus, no other grounds are needed but more 3D Shapes should be allowed to be registered as trademarks (within the aforementioned pragmatic criteria).

***If you have answered NO to each of Questions 16, 17, 18 and 19, please skip Questions 20 and 21 and proceed to Question 22.***

***If you have answered YES to any one of Questions 16, 17, 18 or 19, please answer Questions 20 and 21 in relation to the relevant refusal / invalidity ground(s).***

**20** Should the refusal / invalidity grounds referred to in Questions 16, 17, 18 and/or 19 operate independently from one another or should it also be possible to apply them in combination? For example, should they also apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

The purpose of tests or determining criteria is to achieve a consistent result and to grant trademark protection of 3D Trademarks and 3D Shapes that are able to indicate the origin of a product. Distinctiveness of design and features can very well serve the purpose of an indicator of origin, and any test capable of determining distinctiveness shall apply. Legal certainty requires that refusal/invalidity grounds should be realized in full. Consequently, combinations of partially realized refusal/invalidity grounds should not be considered.

**21 Which, if any, of the refusal / invalidity grounds referred to in Questions 16, 17, 18 and 19 should (and thus may) be overcome by acquired distinctiveness?**

None. In particular banal and simple signs belonging to the public domain should not acquire distinctiveness and thereby overcome the refusal/invalidity grounds referred to in Questions 16-19, but shall remain excluded from trademark protection.

**22 Please comment on any additional issues concerning the registrability of 3D Trademarks and the refusal / invalidity grounds mentioned above that are within the scope of this Study Question (as described in paragraphs 11 to 13 of the Study Guidelines), and that you consider relevant to this Study Question**

It has proven difficult to register forms that could be considered "banal" and/or aesthetically necessary but which in reality fulfill the very purpose of a trademark. Brands and companies should not be forced to invent bizarre or ugly shapes and forms only because this increases the chance of a successful registration. The IPI and the courts should be more flexible in assessing the question of whether a 3D Trademark or 3D Shape is able to serve as an indicator of origin. This, however, under the condition that there is no refusal/invalidity ground applicable referred to in Questions 16 to 19.

**23 Please indicate which industry sector views are included in your Group's answers to Part III.**

Views from the pharmaceutical industry and the media sector.