

NEWS

The Three-dimensional Marks, why is it difficult for them to be registered?

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The Three-dimensional Marks, why is it difficult for them to be registered?

The three-dimensional marks are a type of marks, little known, used and applied for registration by companies in our country.

They are perhaps not very requested not only in Peru but also in other countries, because in order to get to access the registry they need to go through several filters before succeeding, and this makes businessmen have no incentive to apply for this type of signs.

As the name implies, three-dimensional marks are three-dimensional forms of the products, their packaging or wrappings that are distinguished from those of other competitors in the market. According to our legislation, in article 134 paragraph f) of Decision 486 of the Andean Community, the aforementioned signs, that is to say, the shape of the products, their containers or wrappings can constitute trademarks, as well as the words, the images, the sounds, etc.

In doctrine, all those signs that constitute a three-dimensional mark are taken into account. The definition by Fernández Novoa is recurrently cited by the Court of Justice of the Andean Community and in the resolutions of the Specialized Chamber on Intellectual Property of Indecopi, according to which it states that the three-dimensional mark is "that constituted by particular forms of the containers, recipients, packaging, or other arrangement of the products or by their shape."¹

Based on this definition, a clear example of a three-dimensional mark is Hershey's kisses chocolate. As it can be seen, the product itself has a particular, special and distinctive shape, which is a kind of chocolate drop or tear, a form that no other product of this genre possesses. This three-dimensional mark is registered in several countries as in Mexico, a country where it is difficult to obtain the registration of this type of signs.

According to Carlos A. Cornejo Guerrero, "in general, the National and Andean Doctrine and Jurisprudence define the three-dimensional mark as that mark constituted by the particular or arbitrary form of the product or its packaging; it is understood that it is a body with volume, which as such, occupies the three dimensions of space: height, width and depth."²

As it can be seen, these definitions mention the shape of the products or their packaging, but they do not mention the other forms that are beyond these and that can also become three-dimensional marks.

That is why, according to Cornejo Guerrero, the aforementioned definition would be biased, since it does not include, for example, the three-dimensional shapes that distinguish products, but which are not the shape thereof and does not include the definition of the three-dimensional shapes that distinguish services. In this sense, the author proposes a broader definition to describe the three-dimensional mark, noting that it is "that three-dimensional form that serves to identify and differentiate products or services from their similar in the market. It may consist of particular forms of the products, their containers, wrappings, packages or recipients in general; in three-dimensional forms that distinguish products, but that do not consist in the form thereof, or in three-dimensional forms apt to distinguish services from their similar in the market."³

An example of a three-dimensional mark that distinguishes a product, in this case vehicles, but that for obvious reasons does not consist of the shape thereof, or its packaging or wrapping, is the three-dimensional star of three points of Mercedes Benz.

In relation to three-dimensional marks that distinguish services, we have for example a trademark in the United States that consists of the three-dimensional shape of an octopus holding several cleaning devices in its tentacles⁴, which distinguishes car wash services.



Image taken from the website

<http://functionasamark.com/3dmarkstradedress.html>

Now, three-dimensional marks, as well as any other distinctive sign, in order to be registrable must comply with the condition of being distinctive, it is clear that the signs lacking distinctiveness cannot access to registration.

But in addition to this condition, three-dimensional marks, unlike traditional ones, must meet other requirements:

- They should not consist exclusively in the usual forms of the products or their packaging;
- They should not consist of forms or characteristics imposed by the nature or function of the product or service in question;
- They should not consist exclusively of forms or elements that provide a functional or technical advantage to the product or service to which they apply.

By allowing the registration of marks consisting exclusively of this type of form, a market access barrier would be created for competitors who wish to use these forms to distinguish their products or services.

Likewise, there are relative prohibitions for the registration of three-dimensional marks and that these should not be confusingly similar to other distinctive signs registered or previously applied for.

We will mention some cases in Peru in which the applied for signs were rejected for not fulfilling any of the requirements established by law.

For example, a case in which the sign was rejected for lack of distinctiveness and for constituting a usual form of the products it sought to distinguish, is the case of the mark formed by the following three-dimensional form



, applied for in 2012 by Crocs, Inc. of Peru, for distinguishing "*clothing, footwear, headwear*" of class 25 of the International Classification.

Through Resolution No. 5115-2013/CSD-INDECOPI, the Direction of Distinctive Signs denied ex-officio the registration of the applied for sign due to lack of distinctive aptitude. It was determined that the three-dimensional shaping the applied for sign did not show particularities that would allow associating it with a specific business origin, nor did it show further denominative or figurative elements that could grant it distinctiveness. In face of this rejection, the company Crocs, Inc. appealed, stating, among other things, that:

- The applied for sign shows unique characteristics in its configuration that allow it to fulfill its identifying function in relation to the products intended to be distinguished.
- The three-dimensional figure of footwear, shows a particular configuration, where the upper covers the instep of a single piece, with a support strap and without a heel. The contour of the shoe forms a broad upper that decreases slightly in its proportion until it forms the tip of the inner side of the shoe.

On the other hand, the Specialized Chamber on Intellectual Property of Indecopi, through Resolution No. 0192-2014 / TPI-INDECOPI⁶, confirmed the decision of first instance, indicating that in the market of products of class 25, specifically of footwear, there were three-dimensional forms that resemble the one included in the applied for sign, that is, that there were footwear forms of various holders that are common and usual in the market, so that being that form usual, did not correspond.

The decision highlighted that the shape and/or figure of a footwear constituted a weak sign in relation to said products, so that the coexistence of signs containing the same form and/or figure or similar form should be allowed, provided that they have differentiating elements.

Additionally, the Chamber noted that the sole in the applied for sign had a simple shape without characteristic details that allow it to be associated with a specific business origin, as it lacked of its own elements that would provide it with a sufficient distinctive force.

On the other hand, we have a case in which the sign was rejected for lack of distinctiveness, but also for providing a functional or technical advantage to the products it sought to distinguish it, is the case of the mark constituted by the



three-dimensional shape, according to the model , applied for by Chemmer Enterprise

Co., Ltd. of Taiwan, for distinguishing "*adhesives for use in industry*" of class 1 of the Official Nomenclature.

This sign was rejected by the Commission of Distinctive Signs through Resolution No. 2268-2015/CSD-INDECOPI on the grounds that the applied for sign was not capable of being the means by which the products that it wishes to distinguish from the others offered in the market.

The Specialized Chamber on Intellectual Property, through Resolution No. 3112-2016/TPI-INDECOPI confirmed the resolution of the first instance, stating the following:

"In this regard, the applied for sign consist of an adhesive applicator cap that shows determined characteristics, which are not sufficient for the consumer to identify a specific business origin. Likewise, the three-dimensional figure that forms the applied for sign has on the side protruding edges (like fins) that will facilitate the opening of the products that it pretends to distinguish (*adhesives for use in industry*), which constitutes a functional or technical characteristic thereof (...)"¹

In this way, the Chamber concludes that the applied for three-dimensional form is within the prohibitions set forth in paragraphs b) and d) of Article 135 of Decision 486, therefore it is not appropriate to grant its registration.

When talking about fulfilling the condition that three-dimensional forms should not consist exclusively in forms or elements that provide a functional or technical advantage to the product or service to which they are applied, what is prevented is the registration of this type of three-dimensional forms as marks that would lead to unlimited protection over time, when in fact they could be registered as invention patents or utility models, whose protection is rather limited.

Thus, we could cite more examples of three-dimensional forms that were rejected as trademarks because they incurred in some cause of non-registrability.

As we see it represents a difficult task for any applicant to obtain the registration of three-dimensional forms as trademarks, since they must comply with the aforementioned requirements, there are many cases in which the registration of these signs is denied due to lack of distinctiveness, because, as commented, they must have peculiarities with particular characteristics that allow their differentiation in the market.

It may seem that the examiners in our country have strict criteria and reject outright the signs requested, but we see that, in other countries, including those in Europe, such is the case of the Intellectual Property Office of the European Union (EUIPO), there are quite rigid positions and criteria on the registration of this type of distinctive signs.

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¹ Fernández Novoa. Fundamentos de Derecho de Marcas. Madrid, 1984.

² Cornejo Guerrero, Carlos A. La marca tridimensional.