

Intellectual Property and Information Technology Update

March 2010

Lego bricks, washing tablets and vacuum cleaners - the weird and wonderful world of 3 dimensional shape trade marks!

The Trade Marks Act 1994 ("the Act") states that the shape of goods can be registered as a UK trade mark. Unfortunately, that is not the end of the story, because of a number of other restrictions contained within the Act relating to shape marks.

For example, to be capable of registration the shape must enable consumers, when seeing the shape, to think only of one trader's goods and to distinguish the goods of that trader from those of other traders. By way of illustration, when seeing the highly distinctive and unusual shape of a Dyson vacuum cleaner, consumers know straight away that the vacuum cleaner is a 'Dyson' - they don't need to see the name 'Dyson' printed on the vacuum cleaner before they recognise it as a 'Dyson' product. They have been educated, through advertising and promotional activities, to see the distinctive shape and appearance of a Dyson vacuum cleaner as indicating the trade source of the goods in question.

However, not all shapes do this. Take the shape and appearance of your typical, average washing machine tablet. Can you tell one brand of washing machine tablet from another, based only on its shape and appearance? Probably not. You need to see the name of the brand of the washing machine tablet (e.g. Ariel, Calgon, Bold, etc.) printed on the box in which they are sold, before you know the trade source of the tablet.

In addition, if the shape of the goods in question is, for example, necessary to obtain a technical result, then both the Act and Community trade mark law states that the shape cannot be registered as a trade mark. This

provision is of particular importance in connection with the ongoing, European-wide battle by the owners of the famous LEGO brick, who are trying to maintain their Community registered trade mark for the shape of a typical LEGO brick. To date, their efforts have been unsuccessful. In particular, the Community trade mark authorities have held that the 'essential characteristics' of the shape of a LEGO brick perform a technical function (i.e. they enable the brick to connect to other bricks) and thus the shape cannot be registered as a trade mark. If they could register the shape then arguably it would grant them a monopoly on a technical solution, thus preventing competitors from freely offering for sale products incorporating such a technical solution in competition with the owners of LEGO. Trade mark law does not permit this.

Further, if the shape of the goods gives substantial value to the goods (i.e. if the visual appearance of the goods is eye catching and this leads consumers to want to purchase the goods, for example, a visually distinctive and appealing piece of furniture, or a table lamp), then the shape cannot be registered as a trade mark. Otherwise, the owner would have a perpetual monopoly on selling goods that looked that way - and that is not something that the law allows.

In conclusion, obtaining registered trade mark protection for the 3-D shape and appearance of goods is possible, but there a number of hurdles that first have to be overcome - and not all shapes are able to do so. In particular, if the shape of the goods appears the way it does in order to perform some technical function (e.g. to

enable it to connection to something else), or the shape is commonplace and is the norm for goods of that nature (i.e. it does not depart significantly from the customs of the relevant sector) then the shape will not be capable of registration as a trade mark.

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