

EUIPO maintains 3D wine bottle registrations in unusual decision on distinctive character

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- The EUIPO Cancellation Division held that black verbal elements on gold/pink wine bottles – particularly the word “SENSI” – were sufficient to make the 3D sign as a whole distinctive
- Assessment of distinctiveness of a 3D mark must be based on the overall impression of the combination of the shape and the elements to which it extends, in relation to the goods in question, including verbal and/or figurative elements
- The ruling indicates that when the size of the verbal element included in a 3D trademark is big enough to be clearly identified as distinctive and has a sufficient impact on the overall impression of the sign, it makes the 3D sign as a whole distinctive

On 19 July 2024, the Cancellation Division of the EUIPO issued twin decisions on the application for cancellation on the basis of absolute grounds of invalidity pursuant to Article 59(1)(a), read in conjunction with Articles 7(1)(a), (b) and (e)(iii) of the EU Trademark Regulation, in relation to the following two 3D trademarks registered in Class 33 (wine):

EU Trademark 17,477,324



EU Trademark 17,477,407



Decision

Three absolute grounds of invalidity

1) Signs of which an EU trademark may consist

With regard to the first ground for cancellation, the EUIPO specified that the 3D signs at issue both have the abstract capacity to constitute an indication of origin and to be represented clearly and precisely in the trademark register, thus complying with the registrability requirements under Article 7(1)(a) of the EU Trademark Regulation.

2) Signs which consist exclusively of the shape which gives substantial value to the good

The EUIPO clarified that the fact that the wine bottles at issue were also registered as a design was irrelevant to the assessment of the validity of the two trademarks, since, in principle, the same shape can be registered as both a design and a trademark.

Furthermore, the EUIPO reasoned that the shape of the wine bottles and their pink/golden brushed-effect colouring did not possess the artistic value or unique design needed to confer substantial value to the product within the meaning of Article 7(1)(e)(iii) of the EU Trademark Regulation.

3) Signs which lack distinctive character

The main point of interest of this decision appears to be the EUIPO's reasoning on distinctive character pursuant to Article 7(1)(b) of the EU Trademark Regulation.

The Cancellation Division held that the shape of the trademarks at issue is certainly standard and lacking in distinctiveness; it is known as "collio" and has been used for decades by Italian wineries to bottle sparkling wines in particular.

According to the EUIPO, even the pink/golden brush-effect colouring does not appear to constitute an element that would be clearly perceived by the public as an indication of the product's origin, but rather as a decoration of the product itself.

However, the EUIPO reasoned that, in the overall assessment of distinctiveness, the verbal elements visible on the labels should be considered as well – in particular, the word "SENSI", which is clearly visible by virtue of:

- its size (albeit small compared to the entire bottle); and
- the black colouring, which creates a striking contrast to the remaining elements, which are reproduced in light pink/golden variants.

The EUIPO concluded that the presence of such verbal elements, clearly identifiable by the consumer, would therefore be sufficient to make the sign as a whole distinctive.

The Cancellation Division thus rejected the application for cancellation of the two 3D trademarks.

Comment

The reasoning of the Cancellation Division on distinctive character of 3D trademarks raises some perplexities.

It is a well-established principle of EU case law that the assessment of distinctiveness of a shape, as reaffirmed by the EUIPO in this case, must be carried out considering the shape as a whole and not on its individual elements (see General Court in the well-known “Perrier” bottle case T-305/02). However, it is not clear how the EUIPO deduced from this principle that the overall impression of a 3D mark must also include the verbal elements affixed to the product having the shape for which protection is sought.

While it is true that verbal elements, if used consistently in conjunction with a shape, may play a role in making such a shape acquire distinctiveness for consumers over time, it is rather questionable whether verbal elements may be the determining factor in assessing the distinctiveness and consequent registrability as a trademark of an otherwise standard and common shape with respect to certain products.

It will therefore be interesting to follow the development of this case if the decision is appealed.

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