

EU: How to acquire distinctiveness in 28 countries.

In a decision of 15 December 2016 the EU General Court ruled (case no. T-112/13 – KitKat) that proving acquired distinctiveness in the vast majority of the EU member states is not sufficient to prove acquired distinctiveness of a sign for the purpose of getting it registered as a EU trademark.

In the underlying case, Société des produits Nestlé SA had applied to register the shape of the four-finger “KitKat” chocolate/wafer bar as a three-dimensional EU trademark in 2002. Upon an initial objection, the trademark had been registered in 2006. In 2007, Cadbury Schweppes plc (meanwhile Mondelez UK Holdings & Services Ltd) had applied for the invalidation of the trademark for lacking distinctiveness.

As the shape of a product is usually not inherently distinctive, the question became decisive whether the shape of the wafer bar had acquired distinctiveness through use and recognition as a trademark.

According to Art. 165(1) and (4) of Reg. No. 207/2009 evidence of acquired distinctiveness had to be provided only for the Member States that were members of the EU at the date of filing the application for registration of the trademark concerned. When Nestlé had filed the trademark application in March 2002, the EU consisted of the 15 member states only.

Nestlé submitted market surveys conducted in France, Italy, Spain, UK, Germany, Austria, the Netherlands, Denmark, Sweden and Finland. In 2002, the population of these countries represented 90% of the EU population. The surveys revealed an unassisted recognition rate of 30% to 88% which equaled to an overall recognition rate of 48.6% of the EU population.

No surveys were submitted for Belgium, Luxemburg, Ireland, Greece and Portugal, and the Board of Appeal considered that no acquired distinctiveness had been established in these countries.

As a rule, the distinctive character acquired through use of a trademark must be demonstrated in the part of the EU where the trademark was inherently devoid of such character. For non-traditional trademarks this is assumed to be case for the entire EU. In principle, this would have led to the conclusion that the lacking evidence of acquired distinctiveness in Belgium, Luxemburg, Ireland, Greece and Portugal would have excluded a registration of the shape of the “KitKat” bar as a trademark. In an earlier decision of the Court of Justice of the EU (dec. of 24 May 2012, case no. C-98/11 - Lindt), the CJEU had clarified that it would be unreasonable to require proof of acquired distinctiveness for each individual Member State of the EU. Instead, such proof should be required only to a “sufficient” extent. In addition and according to a decision of the General Court of the EU (dec. of 28 October 2009, case no. T-139/08 – John Deere), it is not necessary that the same type of evidence is provided in respect of each Member State.

Insofar, evidence for 15 out of 27 Member States had been considered as not sufficient by the General Court (dec. of 21 April 2015, case no. T-360/12 – design of Louis Vuitton pattern), and evidence for 4 out of 28 Member States was certainly not sufficient (dec. of 16 March 2016, case no. T-363/15 – shape of Työhönvalmennus game box with wooden blocks). Still, it had been the practice of the EUIPO to extrapolate, in case of homogenous markets, the evidence submitted for certain EU Member State to the others. Such an extrapolation is of course possible only among homogenous markets as a lack of recognition of a sign as a trademark in one part of the EU cannot be offset by a higher level of recognition

in another part of the EU – as the General Court points out in the “KitKat” decision of 15 December 2016. Therefore, in the event that the evidence for acquired distinctiveness leaves parts of the EU as “blank spots”, it cannot be concluded that distinctiveness has been acquired *throughout* the EU, even if the blank spot is, in terms of size, not a substantial part of the EU or consists of only one Member State. However, for political reasons it is not possible to disregard a Member State for being unsubstantial. But without being expressly mentioned, the range of recognition from 30% to 88% suggested a rather heterogeneous market.

The decision shows once more, how difficult and expensive it is to prove an acquired distinctiveness for a EU trademark. For many small and middle size undertakings it will hardly be possible at all.

If you have any questions or if you require more detailed information, please do not hesitate to contact us.

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