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General Court: shape of Guerlain lipstick may be registered as 3D mark

European Union - [CASALONGA](#)

- The EUIPO found that Guerlain's mark, which consisted of the shape of a lipstick, lacked distinctive character
- The court disagreed, finding that Guerlain's shape was unusual for a lipstick
- The relevant public would be surprised by this shape and would perceive it as deviating significantly from the norms and customs of the sector

On 14 July 2021 the General Court issued its decision in [Guerlain v European Union Intellectual Property Office](#) (EUIPO) (Case T-488/20), which concerned a three-dimensional (3D) trademark consisting of the shape of a lipstick.

Background

The applicant, Guerlain, filed an EU trademark application for the following 3D mark in Class 3 in connection with "lipsticks":



The applicant claimed acquired distinctiveness through use pursuant to Article 7(3) of Regulation 2017/1001.

The EUIPO rejected the application under Article 7(1)(b) on the ground of a lack of distinctive character. It was noted that the alternative claim based on Article 7(3) of the regulation would be examined once the decision had become final.

The applicant filed an appeal against the examiner's decision, which was dismissed by the First Board of Appeal. The board considered that the usual lipsticks present on the market were not significantly different from the sign in question. In this respect, it was noted that they were all cylindrical in shape and that consumers are used to oval-shaped containers.

Further, the Board of Appeal considered that, even assuming that the shape applied for was different from all other types of lipstick on the market, it was usual to find multiple different shapes in that sector. It also noted that the specific characteristics of the mark did not allow it to be distinguished in a significant way from the other shapes usually present on the market, so that the mark would be perceived as a variant of those shapes. In light of the above, it was concluded that, taken as a whole, the mark in question would not diverge sufficiently from the norms or customs of the sector.

The applicant filed an appeal before the General Court, relying on a single plea. The applicant alleged infringement of Article 7(1)(b) of the regulation, arguing that the Board of Appeal had wrongly considered that the mark applied for was devoid of any distinctive character.

Decision

The General Court stressed that the concept of 'distinctiveness' and that of 'novelty' or 'originality' are different. Indeed, the fact that the specialised press considered the applicant's trademark to be revolutionary was not relevant for assessing its distinctiveness. Under the relevant case law, a 3D sign consisting of the shape of a product must differ substantially from the norm or customs in the relevant sector.

In this respect, the court reviewed the part of the Board of Appeal's decision relating to these market norms or customs and concluded that, while cylindrical shapes are the most commonly used, they are not the only shapes used for this type of product on the market. Therefore, the norms and customs of the sector cannot be reduced to what is statistically the most widespread shape, but must include all shapes that the consumer is used to seeing on the market.

Therefore, the court held that the fact that a certain sector is characterised by the presence of various different shapes does not mean that a new possible shape will necessarily be perceived as one of them.

In light of the above, the court analysed the images examined by the Board of Appeal and concluded that the applicant's shape was unusual for a lipstick, since it resembles the hull of a boat or a baby carriage:



The court concluded that the mark applied for differed from any other shape on the market and that the relevant public, with a medium to high level of attention, would be surprised by the shape of the lipstick and would perceive it as a deviation from the norms and customs of the sector. As such, it held that the First Board of Appeal was incorrect in finding that such shape did not have sufficient distinctive character and, consequently, annulled the board's decision.

Comment

This decision should be welcomed as it provides a precedent for entities seeking to protect 3D trademarks, which have historically been very difficult to register with the EUIPO.

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