

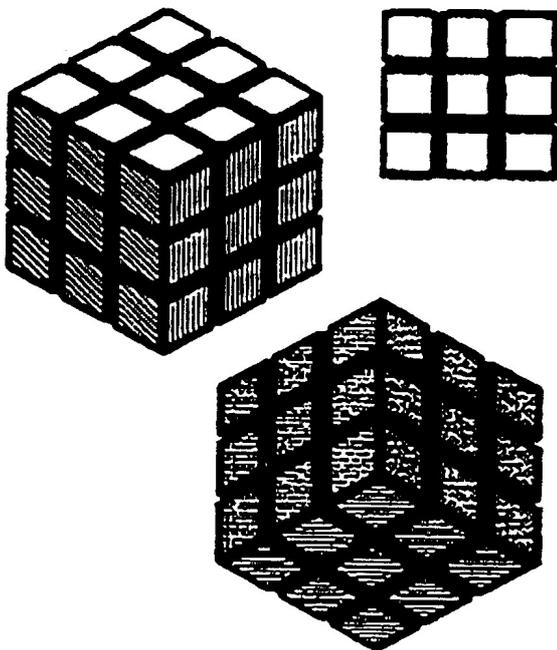
ECJ cancels Rubik's Cube registration
European Union - NJORD

Design
Examination/opposition

January 03 2017

In *Simba Toys GmbH & Co KG v European Union Intellectual Property Office (EUIPO)* (C-30/15 P, November 10 2016), the European Court of Justice (ECJ) (First Chamber) held that the EU General Court had erred in taking the view that the essential characteristics of the shape of the product at issue did not perform a technical function.

The subject matter originated in 1996 when Seven Towns Ltd filed an application for registration of an EU trademark for the following three-dimensional mark:



This was registered for “three dimensional puzzles” in 1999.

The dispute started in 2006 when Simba Toys filed a request for a declaration of invalidity of the contested mark on the grounds that it was registered in contravention of Article 7(1)(e)(ii) of EU Trademark Regulation 40/94 which prohibits registration of marks “which consist exclusively of ... the shape of goods which is necessary to obtain a technical result”. Both the EUIPO Cancellation Division and the EUIPO Board of Appeal rejected the cancellation application in its entirety.

Simba Toys appealed to the EU General Court which also rejected the cancellation application. The court took the view that inferring with the existence of an internal rotating mechanism from the graphic representations of that mark would not have been consistent with the requirement that any inference must be drawn as objectively as possible from the shape in question, as represented graphically and with sufficient certainty.

On final appeal to the ECJ, however, Simba Toys was successful. Consistent with the advocate general's opinion, the ECJ dismissed the EU General Court's method of assessing whether essential characteristics of a shape consist exclusively of the shape of goods which is necessary to obtain a technical result. The ECJ concluded that in order to analyse the functionality of a sign for the purposes of Article 7(1)(e)(ii) the essential characteristics of a shape must be assessed in the light of the technical function of the actual goods concerned, and not just the graphic representation. The EU General Court should have defined the technical function of the actual goods at issue, namely a three-dimensional puzzle known as a ‘Rubik's Cube’, and it should have taken this into account when assessing the functionality of the essential characteristics of the mark. The ECJ concluded that the EU General Court interpreted the criteria for assessing Article 7(1)(e)(ii) too narrowly. The fact that the registration did not cover “rotating three dimensional puzzles” but only “three dimensional puzzles” did not save the EU trademark holder as it was

not permitted hide a technical result in a broad goods description.

The ECJ could have referred the matter back to the EU General Court but instead utilised its power pursuant to Article 61 of the Statute of the Court of Justice of the European Union and cancelled the registration of the 3D puzzle at issue, pursuant to Article 7(1)(e)(ii) of the EU Trademark Regulation.

Comment

This case is interesting because it explicitly approves of producing the actual goods in a cancellation action. This can also mean that the actual goods can be filed in evidence in actions concerning registered Community designs.

Peter Olson, NJORD, Copenhagen

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.