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The Guerlain judgment on everyone's lips...

Guerlain almost had its G lipstick case rejected as a three-dimensional trademark, but the judges of the General Court of the European Union were more flexible in their assessment of its distinctiveness than the European Union Intellectual Property Office.

The shape of the lipstick, comparable to a ship's hull or baby carriage, was considered sufficiently arbitrary, as the General Court of the European Union considered this shape unusual, easily memorable and uncommon on the market. It also found that the rounded contours of the tube prevented it from being positioned vertically as is customary, a clarification related to the use of the product that may nevertheless be surprising.

In order to constitute a valid trademark, the sign which is the subject of the trademark application must satisfy several negative criteria:

- Not be contrary to public policy and morality,
- not be likely to mislead the public and thus be deceptive,
- not be customary, generic or descriptive, which would deprive it of any distinctive character.

The question of the availability of the sign will not be discussed in this article as it is not verified by the office with which the trademark application is filed.

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Regarding the distinctive character, its interpretation by the competent offices and courts is evolving, especially as far as three-dimensional trademarks are concerned, it being recalled in this respect that the shapes of products and their packaging can be registered. However, it is still necessary to demonstrate the arbitrary character of the trademark for which the application is filed, i.e., the fact that it does not result from the shape imposed by the nature of the product or its function. This is quite logical because the trademark must not prevent the marketing of products of the same nature in their usual shape.

It is in the same spirit that the Court of Justice of the European Union, in the so-called Philips judgment^[1], rejected the theory of the multiplicity of shapes in the field of three-dimensional trademarks which validated a trademark as soon as the function of the product in question could be achieved by other shapes. The Lego trademark bore the consequences of this theory as it was later refused registration of bricks as a three-dimensional trademark^[2]. In that specific case, the presence of arbitrary elements was deemed insufficient in that they were minor compared to the functional element.

Since the trademark has the incredible advantage of being covered by a right that can be perpetual, since its ten-year protection can be renewed indefinitely, offices are careful to ensure that patent or design and model rights are not misused for its benefit.

As such, the EUIPO examiner, and then Board of Appeal, had not been convinced of the distinctive character of the three-dimensional trademark consisting of the shape of the case of Guerlain's G lipstick, described at the time of the application in 2018 as *"an unprecedented shape of a ship's hull or a baby's carriage"*.

As a result, they dismissed the application based on Article 7(1)(b) of Regulation EU 2017/1001 of the European Parliament and of the Council of June 14, 2017 on the European Union Trade Mark (EUMR), on the ground that the trademark applied for did not distinguish itself in a meaningful way from other products in the same market sector.

However, the General Court of the European Union annulled the decision of the Board of Appeal and ruled that the lipstick tube in question had an uncommon, fanciful and unusual shape that satisfied the distinctiveness criterion for three-dimensional trademarks^[3].

In this respect, the General Court of the European Union recalled (in paragraph 40 of the judgment) that the criteria of novelty and originality are not to be taken into account in assessing distinctiveness.

The originality criterion is traditionally used in copyright matters, with reference, in the French conception, to the stamp of the author's personality. The novelty criterion is, on the other hand, the one specific to patents.

In the case at hand, the EUIPO's Board of Appeal had limited itself to finding that there was no significant divergence from the norms and customs of the sector. Yet, according to the General Court of the European Union, a trademark does not need to reach a *"certain level of linguistic or artistic creativity or imagination"*. Rather, it is a matter of taking into account the reaction of the relevant public so that it is able to clearly identify the origin of the products or services offered by the trademark.

As such, the aesthetic aspect of a product would not be a criterion that necessarily implies distinctiveness. On the other hand, this criterion could be part of a set of indicators which, taken as a whole, could lead to the characterization of distinctiveness. Namely, the assessment of this aesthetic aspect (systematically rejected in matters of copyrights and technical inventions) should not be studied from the point of view of attractiveness, but in relation to the visual effect that it produces on the relevant public.

The General Court of the European Union noted that the existence of a wide variety of shapes in the lipstick sector does not imply that every new shape or variant is automatically devoid of distinctive character. In this respect, the judges seem to bring the assessment of the distinctiveness of a three-dimensional trademark closer to that of novelty in the field of designs and models. The more models there are on the market, the more difficult it is to establish the level of novelty: in this case, even the smallest differences can be taken into account in the assessment of the novelty of the products that incorporate the design or model. On the other hand, designs and models incorporated into products that are less diversified in their shape in the relevant market will have to reach a higher threshold of difference compared to claimed prior arts. This practice seems to have influenced the assessment of distinctiveness for the purpose of registering a three-dimensional trademark, with the potential consequence of undermining the autonomy of the legal regimes between the various intellectual property rights.

In the case at hand, the General Court of the European Union assessed *in concreto* the various characteristics of the lipstick tube in question and concluded that the shape of the Guerlain lipstick tube was “*unusual*” and “*uncommon*”. As such, it used a criterion based on the “*uncommon*” shape of the lipstick tube compared to the customs of the sector. It will still be necessary to demonstrate that the characteristics of the product are effectively uncommon compared to the norm or sector of the relevant products in order to register it as a trademark.

Contrary to the strict interpretation of applicable texts by the EUIPO, the General Court of the European Union also took into account the reach of the product. The shape of a ship’s hull is considered “*uncommon*” compared to the lipsticks already on the market (which are generally cylindrical). This effect is reinforced by the presence of a small oval embossed shape (“*uncommon protuberance for such a product*”) and exclusively rounded contours, preventing the product from being positioned vertically on the shelf, contrary to standard practice. This specificity led judges to find that the relevant public will be “*surprised by this easily memorable shape and will perceive it as significantly diverging from the norm and habits of the lipstick sector*”.

While the outcome may seem appropriate, taking into account the positioning of the product covered by the trademark when it is sold to the public raises questions because the use, or at least the presumed use, of the product becomes decisive. However, the seller of the said product could use a medium that would allow Guerlain’s G lipstick to be positioned upright on the shelf, like any other lipsticks. If such a presentation were to be demonstrated in the event of litigation, could it influence the trademark application and thus ultimately the protection granted? Beyond the substance, the question of proof arises.

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[1] CJEU, June 18, 2002, C-299/99

[2] CJEU, September 14, 2010, C-48/09

[3] GCEU, July 14, 2021, T-488/20

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