

Protecting “Service” Dress in Europe

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Unlike US trade mark law, European law treats in principle all marks equally by applying the same criteria for assessing the inherent distinctive character of signs eligible for registration, regardless of whether the subject-matter is classified as covering conventional signs, ie verbal marks, or unconventional signs, ie product configurations, product packaging, colours, scents, sounds, etc. All marks are in general capable of being automatically registered without evidence of prior successful use amounting to acquired distinctive character. But whilst the criteria may be the same, the Court of Justice of the European Union (CJEU) has established the normative presumption that the average consumer doesn't react the same to different categories of marks such that, in the case of unconventional or three-dimensional marks which aren't independent of the appearance of the product, the consumer is unlikely to attribute any message about commercial source absent a verbal or figurative mark. For a such non-verbal marks to enable the consumer to rely on it as source-indicator, the non-verbal mark must depart significantly from the custom or the norm in the sector concerned. Many argue that the effect of this approach has led to an (almost) automatic refusal of a large number of marks constituting, in one form or another, aspects of the broader concept of trade dress as that concept exists in US law. This has engendered the heightened criticism that European law lacks consistency and does in fact impose stricter distinctiveness standards as regards non-verbal marks.

Yet many consider it desirable that the law should properly follow the European legislator's intention to allow for the protection of inherently distinctive trade dress to address, for instance, the increasing problem of supermarket look-alikes. However, this apparently narrow view of trade dress in Europe may be about to change. In a recent reference involving Apple Inc's application to register as a national mark a two-dimensional depiction of Apple's flagship retail store, the CJEU decided that Article 2 Trade Marks Directive (TMD) allows in principle such a registration without the need to characterise it as 'packaging' and without the need for the application to contain further, more detailed information as to the size and proportions of the proposed retail store. Oddly, this is same legal provision according to which non-visual marks are imposed more rigorous criteria for graphical representation or, even if represented graphically, are refused registration for disclosing non-specific subject-matter which represent a mere idea or concept capable of taking on a multitude of different forms and contrary to competition. Further, judging by the cursory treatment of the possibility of applying one or two of the many public interest considerations embedded in the refusal grounds under Article 3 TMD, it is likely that the referring national court will allow the Apple application.

This Article will use the Apple reference as a starting point from which to re-assess the CJEU's case-law in order to correct the mistaken belief that European law discriminates against non-verbal marks. Secondly, it will offer a more nuanced view of the way the law in this context has been developed which is not completely different from that of verbal marks. And thirdly, based upon central principles developed in US law, it will offer a framework from which trade dress, including the 'service' dress in the Apple case, should be carefully

analysed to be compatible with the underlying purpose of European law.