



Store Design Capable of Trade Mark Registration

The decision of the CJEU as to whether a representation of the layout of a retail store, in this instance a flag-ship Apple® store, was capable of registration as a trade mark was delivered in July (Case -421/13 Apple Inc. vs. Deutches Patent and Markenmat (DPMA)). The mark applied for is below:



The CJEU ruled on a series of questions from the German Federal Patent Court (GFPC), after the DPMA refused registration of the Apple design (applied for in relation to retail and related product demonstration services in class 35) on grounds that the sign would not indicate origin to the consumer, and was thus incapable of registration as a trade mark. The GFPC asked the Court to determine whether a single design representation of a store layout, without indications of layout dimensions, was a clear and precise graphical representation (as required by Sieckmann); whether such a sign was capable of trade mark registration for related services; and that, if so, was it because the design of the layout of a store, for services, was akin to the packaging of a product, that the sign could be said to fall within the scope of the term “packaging” which is listed as a type of sign for which a trade mark may consist in Article 2 of the EU Trade Marks Directive 2008/95.

The Court found that a trade mark that consists of a representation of a retail store, depicted by a design but without indications of layout dimensions, was a sufficiently clear and precise graphical representation to be acceptable for trade mark registration, and that such a sign could be capable of distinguishing one trader's products over those of others. However, that sign must also have distinctive character to be acceptable for registration. It commented that a store design that is a significant departure from the norm in the economic sector concerned would be the kind of store design that could indicate origin to the consumer. The Court felt it was not necessary to consider the GFPC's question as to whether such a sign (for services) was akin to packaging (for goods), pointing out that Article 2 of the EU Trade Marks Directive also listed ‘design’ in the types of sign for which a trade mark may consist. Finally, it found that “product

demonstration services”, of the kind designed to entice a purchaser to buy goods, could constitute “services” within the meaning of Article 2 of the Directive.

The decision of the CJEU will be encouraging to retailers seeking to protect their unique store layout as a trade mark, though it is also clear obtaining registration will not be easy. To get it, retailers will need to prove that their store design has distinctive character, which is likely to mean demonstrating it is both a significant departure from the norm in the sector concerned, and distinctive as a result of the use made of it. This significant evidential burden is likely to mean only a few retailers will succeed with registration of their store layouts as trade marks within the EU. However, the decision as a whole is a useful reminder, as we move to a revised European Trade Mark Law, that virtually any sign, capable of being represented in a way that is clear, precise, easily-accessible and intelligible, is also capable of registration as a trade mark - so long as it also has distinctive character.

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