

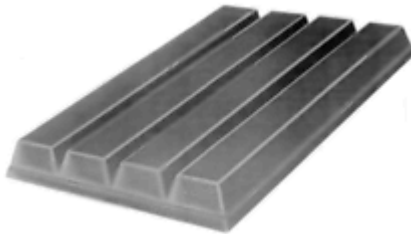
## **Product Shape and Distinctiveness**

A recent decision of the UK High Court concluded that the shape of KIT KAT chocolate bar was not registrable as a trademark.

### **The Facts**

#### **The Application**

Société des Produits Nestlé SA ("Nestlé") applied to register the three-dimensional shape of the KIT Kat chocolate bar. The applied-for mark ("Mark") is set out below:



The Trade Mark corresponds to the shape of Nestlé's four-finger KIT KAT product shown below:



#### **The Opposition**

Cadbury UK Ltd ("Cadbury") opposed the application on the grounds that the Mark was not distinctive. Nestlé responded by asserting that the Mark had become distinctive at the relevant date by virtue of acquired distinctiveness.

The hearing officer concluded the applicant had shown recognition of the Mark amongst a significant proportion of the relevant public for chocolate confectionery but not that consumers relied on the shape to identify the origin of the goods. The key factors were:

- i) There was no evidence that the shape of the product has been featured in the Nestlé's promotions for its goods for many years prior to the date of the application;
- ii) The product was sold in an opaque wrapper and the wrapper did not show the shape of the goods;
- iii) There is no evidence – and it did not seem likely – that consumers used the shape of the goods post purchase in order to check that they had chosen the product from their intended trade source.

As a result it seemed likely that consumers rely only on the word mark KIT KAT and the other word and the pictorial marks used in relation to the goods in order to identify the trade origin of the goods. They associated the shape with KIT KAT (and therefore with Nestlé), but no more than that.

Since it was necessary to show that consumers relied on the shape mark in order to distinguish the trade source of the goods at issue, the claim of acquired distinctiveness failed.

### **The Appeal**

Nestlé appealed from the decision to the U.K. High Court. The court decided that it was necessary to seek clarification of the law from the Court of Justice of the European Union in order to determine the appeal. Eventually the judge determined that in order to demonstrate that a trademark has acquired distinctive character, the applicant must prove that, at the relevant date, a significant proportion of the relevant class of consumers

perceive the goods as originating from a particular undertaking *because of* the mark in question (as opposed to any other trademark which may also be present).

When this approach was applied the judge agreed with the hearing officer's decision and dismissed the appeal.<sup>1</sup>

### **The Canadian Position**

The Canadian position is similar. There is no question that colour and shape can help to distinguish the products of one manufacturer from another. Shape and colour can also be powerful influences on consumer behaviour.

But showing that product appearance or get-up has become distinctive is not easy to do. There are sound public policy concerns that arise from an expansive recognition of distinctiveness in the area of non-functional product design. The concerns arise from the fact that trade owner in such cases will have an unrestricted monopoly relating to the use of the design.

It is not fatal to a trademark registration that consumers may use other means than the mark for identifying the product with a sole source. However, there must be sufficient evidence to show that the trademark is recognized on its own. A trademark based on get-up cannot acquire its distinctiveness by virtue of its use in combination with a distinctive wordmark.

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<sup>1</sup> [2016] EWHC 50 (U.K. Ch.)

## **Comment**

There have been a number of Canadian cases involving the shape of pharmaceutical pills or pharmaceutical dispensers which have denied trademark protection to applicants for similar reasons.

**John McKeown**

**Goldman Sloan Nash & Haber LLP**

480 University Avenue, Suite 1600

Toronto, Ontario M5G 1V2

Direct Line: (416) 597-3371

Fax: (416) 597-3370

Email: [mckeown@gsnh.com](mailto:mckeown@gsnh.com)

*These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.*