

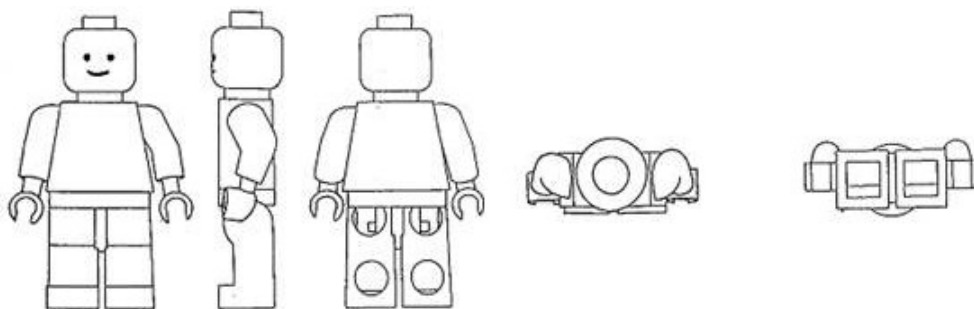
General Court: Lego manikin is a valid trademark
European Union - Squire Patton Boggs LLP

Cancellation
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Non-traditional marks

June 25 2015

In *Best-Lock (Europe) Ltd Inc v Office for Harmonisation in the Internal Market* (OHIM) (Case T-396/14), the General Court has upheld the decision of the Fourth Board of Appeal of OHIM, repeating, among other things, the legal principle that Article 7(1)(e)(ii) of the [Community Trademark Regulation](#) (207/2009) does not “preclude goods consisting of shapes” from obtaining trademark protection; rather, it prohibits those shapes which consist of elements that are limited to technical functions. The General Court agreed with the board that the Lego figure is a valid trademark, despite the fact that it includes technical elements which enable the figure to be joined to the Lego toy bricks.

On April 1 1996 [Lego Juris A/S](#) applied for the registration of the three-dimensional Community trademark (CTM) depicted below, representing a manikin. The mark was filed in, among others, Class 28 of the [Nice Classification](#) for “games and playthings; decorations for Christmas trees”, and was registered on April 18 2000.



On October 17 2011 [Best-Lock \(Europe\) Ltd Inc](#) filed an application seeking a declaration of invalidity of the mark on the basis of Article 52(1)(a), in conjunction with Article 7(1)(e)(i) and (ii). Both the Cancellation Division and the Board of Appeal of OHIM rejected Best-Lock’s application. In its appeal before the General Court, Best-Lock repeated its plea in law.

Formally, Best-Lock relied largely on the arguments and annexes submitted in the course of the invalidity proceedings before OHIM, by making general references thereto, without going into further detail. The General Court reiterated the legal principle that “in order to guarantee legal certainty and sound administration of justice, it is necessary that the basic legal and factual particulars on which it is based be indicated, at least in summary form, coherently and intelligibly”. It followed that, to the extent that Best-Lock relied on arguments and documents by way of reference, the action was found inadmissible.

With regard to Article 7(1)(e)(ii), the General Court also rejected Best-Lock’s complaint as unfounded. Best-Lock claimed that the figure consisted exclusively of the shape of goods necessary to obtain a technical result. In its assessment, the General Court reverted to the legislature’s underlying assumption that “any shape of goods is, to a certain extent, functional”. It would therefore be “inappropriate to refuse to register a shape of goods as a trademark solely on the ground that it has functional characteristics”. Those shapes of goods which incorporate a single or several technical solutions should not to be registered if they would actually impede the use of such technical solutions.

The General Court noted, in line with the board’s view, that it was thus necessary to determine the essential characteristics of the shape mark, and whether they perform a technical function. On the substance, the General Court agreed with the Board of Appeal that the shape represents a figure having human resemblance because it consists of a head, body, arms and legs. As those features are necessary in order for the figure to have that appearance, those elements constitute the essential characteristics. However, they do not serve any technical function because they simply confer human traits on the figure. Additional features of the figure are the protrusion on its head, as well as holes under its feet and inside the backs of its legs. While those elements have a technical function, namely to allow the figure to be joined to Lego’s interlocking building blocks, the General Court agreed with the board’s findings that those coupling elements are not among the essential characteristics. The shape of the figure would be maintained even if those elements were disregarded. Best-Lock had neglected to mention “what technical result a toy figure might be supposed to achieve”.

As to Best-Lock’s claim that the assessments made regarding a red Lego brick should be applied equally

to the present case, the General Court concluded that the contested figure had nothing in common with the Lego brick, except for the fact that it was a toy product manufactured by the same company.

The General Court concluded that, even though the figure had certain technical qualities, those non-essential characteristics had no influence on the application of Article 7(1)(e)(ii), because the mark's essential characteristics did not have a technical function.

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