

3D Trademarks assessment, a Saudi perspective

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What is it?

Three-dimensional trademarks or more commonly 3D trademarks fall into the non-conventional set of marks. Non-conventional trademarks, also known as non-traditional trademarks, comprise visible marks (e.g. holograms, colors, shapes, positions), or non-visible marks (e.g. sounds, textures, tastes, scents). You identify a product or service from a particular company by their trademark. In some cases, the unique shape or product package can be registered as a 3D trademark. 3D trademarks do protect 3D shapes of goods or their packaging. Application for a 3D trademark should be assessed according to various factors, including its inherent distinctiveness or its acquired distinctiveness.

Meaning that it is in fact the unique shape of a product or its packaging that is highly recognizable by the consumers that makes it worthy of registration. Examples of some of the most famous 3D trademarks include the packaging of the Toblerone chocolate bar, and the famous Coca Cola bottle, whose owners have successfully obtained protection for their product's shape or packaging due to their unique and distinctive characteristics. On the other hand, brand owners like Jaguar, Land Rover and Nestle (Kit Kat) failed to secure 3D trademark protection, as their products' shape were not distinctive enough to be granted trademark protection.

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How 3D trademarks are assessed:

To find out if a 3D trademark is registrable requires an assessment of whether the trademark or shape significantly departs from the norm of the sector and thereby fulfils its essential original function. This requires an assessment of whether there is anything unusual about the shape such that the relevant consumer would notice it and remember it, and then, if there is such individuality, an assessment as to whether the consumer would think of the shape as indicative of source, rather than being merely functional or decorative.

Essentially, the function of a trademark is to distinguish the products or services from one business to another. A trademark in itself must therefore contain a distinctive component, as lack of distinctiveness would increase the likelihood of public confusion. This discussion becomes even more complex when considering a three-dimensional trademark.

3D shapes should be refused registration as trademarks, if they consist exclusively of shapes that result from the nature of the goods stated in the application or registration. For example, the Kit Kat chocolate bar cited above has been refused registration due to lack of inherent distinctiveness. However, on the contrary, 3D Shapes should not be refused registration as trademarks, on the ground that they consist

exclusively of shapes that give substantial value to the goods, e.g. the Toblerone chocolate bar which unique shape gives substantial value to the goods.

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3D trademarks in Saudi Arabia

Presently there is no standard approach in respect of three-dimensional trademarks, some 3D trademarks consisting of shapes of bracelets and bottles have been successfully registered. However, based on our extensive regional practice, we can easily confirm that Saudi Trade Mark Office has a more conservative approach when it comes to assessing 3D trademarks compared to its neighbouring countries. Indeed, in Saudi Arabia, there is a strict interpretation of the Law and of the criteria of distinctiveness, such that if the 3D shape lacks inherent distinctiveness, the Trade Mark Office automatically considers that the shape results from the function of the goods it represents. Even in the cases where the brand owner is capable of demonstrating that the product shape acquired distinctiveness, sometimes the evidence is not considered and trademarks are refused registration.

On another hand, we see that this strict interpretation aims to balance the rights as some brand owners prefer registering 3D trademarks to avoid protecting their product shape by industrial design. As trademarks are capable of renewal forever while industrial designs are only registered for a limited period of 10 years at maximum and require that the product is novel. The criteria of novelty is often not met when brands have already launched their products in the market and only seek IP protection when the product meets commercial success.

For further information, please contact [Manel Ben Said](#)