

**KONINKLIJKE PHILIPS ELECTRONICS LTD. V.**  
**REMINGTON CONSUMERS PRODUCTS LTD.**

**COURT:** European Court of Justice

**CITATION:** C-299/99, [2004] ALL ER (D) 301

**FACTS**

- Plaintiff was the registered proprietor of the following shape mark:



- The petitioner is Philip Electronics. In 1966, Philips developed a new type of three-headed rotary electric shaver orchestrated in a triangular shape. The three-headed shape was registered as a trademark in the year 1985. The Defendant started to sell a shaver with three rotating heads shaped similarly to the registered trademark in 1995. Philips asserted that Remington had infringed its trademark by using its characteristics of the shaver with 3 sharpened pieces in an equilateral triangle which made confusion in the minds of the customer by confusing it as a product of Philips. Remington denies that this is trademark infringement and argued that only because the mark has gained a different character in light of the fact that Philips created the shaver, the trademark law does not permit him to register such marks. The enlistment of such mark should not be permitted because it is important to acquire a fundamental result and registration in this way is invalid.

## **ISSUE**

We are already aware of the facts of the case as mentioned above, so based on the facts of the case, it is quite clear about the issue of the case, the issue is:

- Whether the shape of the mark should be necessary to obtain a fundamental specialized result?

## **RULE**

The case was heard in The High Court of Justice of England and Wales, Chancery Division, ordered revocation on the ground that the mark was:

- The difference between the goods of the plaintiff and that of others is not visible
- Lacks distinctive character
- Mark consisted exclusively of a sign which served in trade to place the intended purpose of the goods; and
- Was necessary to obtain a technical result

On appeal of the Plaintiff, the Court of Appeal referred decided to stay proceedings and referred certain questions to the European Court of Justice for determination<sup>1</sup>.

1. Is there a category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of Council Directive which is also excluded from registration by Article 3(1)(a) of the directive?
2. Is the shape of the object only capable of distinguishing as according to Article 2 if it contains some changeable addition to the shape of the object?
3. Where a trader has been the only supplier of particular goods to the market is extensive use of a sign which consists of the shape of those goods and which does not include any changeable addition which is enough to give the sign a distinctive character for the purposes of Article 3(3) in circumstances where as a result of that use a considerable proportion of the relevant trade and customers  
a) associate the shape with that proprietor;

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<sup>1</sup> <https://www.mondaq.com/germany/trademark/17536/philips-vs-remington-the-modern-face-of-trademarks-ii>

- b) believe that goods of that shape come from that particular proprietor and there is an absence of a statement to the contrary?
4. (a) Can the restriction imposed by the words if it consists exclusively of the shape of goods which is necessary to achieve a technical result appearing in Article 3(1)(e)(ii) can be beaten by establishing that other shapes can obtain the same result or
- (b) is the shape unregistrable if it is shown that the essential features of the shape are attributable only to the technical result or
- (c) is there any test appropriate for determining whether the restriction applies, if yes, which?

On appeal of the Plaintiff, the Court of Appeal decided to stay proceedings and referred certain questions to the European Court of Justice for determination<sup>2</sup>.

1. In responding to the first question, the European Court of Justice very clearly stated that there is no category of marks which is not excluded from registration by Article 3(1)(b),(c) and (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods from the proprietor of the mark from those of other undertakings. In its reasoning, the European Court of Justice highlights the essential function of a trademark, namely to guarantee the identity of the origin of the marked product to the consumer by enabling him, without any possibility of confusion, to distinguish the product from that of others which have other origin and to offer a guarantee that all the goods or service in possession or displaying it have been created under the control of a single undertaking which is responsible for their quality. Concerning the wording of Article 3(1)(a) and the structure of the Directive, the European Court of Justice then comes to the only logical conclusion that a sign which is incapable of distinguishing cannot have a distinctive character.
2. By its second question, the court seeks to discover whether the definition of a trademark as set out in Article 2 of the Directive means, as regards the requirement of the capability to distinguish, that they must contain some arbitrary element, such as an exaggeration with no functional purpose. Here again, the European Court of Justice comes to a clear conclusion in finding that the shape of the product in respect of

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<sup>2</sup> <https://www.mondaq.com/germany/trademark/17536/philips-vs-remington-the-modern-face-of-trademarks-ii>

which the sign is registered does not require any changeable addition which has no functional purpose. The shape in question must simply be capable of distinguishing the product of the proprietor of the trademark from those of other undertakings.

3. For the third question, the European Court of Justice states that if a shape is refused registration according to Article 3 (1)(e) of the Directive, it can under no circumstances be registered by Article 3(3). With equal clarity, the European Court of Justice holds that a trademark which is refused registration under Article 3(1)(b)(c) or (d) may acquire a distinctive character which it did not have initially and thus may be registered according to Article 3(3) of the Directive. According to the ECJ, the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for.
4. The fourth question put forward by the referring court to the European Court of Justice touched upon the core of the issue contentious between the parties. The objective of the question is to find an answer whether Article 3(1)(e), second indent, of the Directive, must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable if it is established that the essential functional features of the shape are attributable only to the technical result. Furthermore, clarification is sought as to the question of whether the ground for refusal or invalidity can be overcome by establishing that other shapes obtain the same technical result.

### **ANALYSIS**

The trademark law secures a proprietor from others using his mark and to keep the goodwill and unique identity of his business intact. Shapes that give specialized results should be openly accessible to all. If the shape has obtained distinctive character over the years by its utilization it can be permitted to be enrolled. But in this case, as we saw the shape used by Philip did not show any distinctive characteristic. The shape used by Philip was important to get the particular result attached to the successful use of the product which is to trim the hair in a particular way. Thus, if a person needs to register their shape then it is a basic essential that there should be some distinctiveness attached to it and which is not important or part of some useful reason.

### **CONCLUSION**

As we saw the whole case and also the basic arguments from both sides we can conclude that Philip had not obtained a particular distinct character even though it was the proprietor that introduced the particular shape concerning that product. The courts were right in holding that they couldn't register it as it was a shape that is attached and connected with the important functioning for an important reason and thus, the registration of this shape was invalid. Hence the decision by the court that Remington has not infringed the trademark of Philip was right.



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