

KITKAT CAN'T GET A BREAK IN COURT OF APPEAL

- ▶ KitKat loses Court of Appeal case to register its four-fingered bar as 3D trade mark
- ▶ Court of Appeal ruled it had not acquired distinctiveness
- ▶ Should brand owners think twice about registering 3D trade marks?

What's it about?

As many readers will be aware, Nestlé applied to register its four-fingered KitKat chocolate bar as a 3D trade mark in the UK (class 30). Cadbury opposed the application, on the basis that the trade mark lacked distinctive character. Trade marks which are devoid of any distinctive character cannot be protected as registered trade marks. Nestlé counter argued that the trade mark had acquired a distinctive character but the IPO and High Court failed to accept its argument. Nestlé therefore appealed to the Court of Appeal.

Nestlé fared no better in the Court of Appeal who, in dismissing the appeal, stated that Nestlé had been unable to establish acquired distinctiveness so as to show that reliance had been placed upon the mark as an indicator of origin. The Court of Appeal was unconvinced that consumers would perceive the origin of the 3D shape as coming from Nestlé, without the already-trademarked KitKat logo embossed on the chocolate. The Court of Appeal stated that the survey results presented by Nestlé as evidence reflected a mere recognition and association with KitKat and the four-fingered shape was not itself indicative to consumers as a 'badge of origin'.

Why does it matter?

It has long been evident that it is challenging to register 3D shapes as trade marks. Whilst product designers may be able to assist their case by demonstrating the importance of their shape in advertising (as Coca-Cola successfully did with its bottle shape), the courts often find that consumers do not tend to distinguish goods by the shape of the product but instead from the brand signs affixed thereto.

Now what?

Product designers should be mindful of the difficulties in protecting 3D shapes as trade marks when formulating their brand management and advertising strategies.

[*Société Des Produits Nestlé v Cadbury UK Ltd \[2017\] EWCA Civ 358*](#)

For further information on this or any other IP related matter please contact [Lucinda Pike](#) on 020 7160 3316.