

7. ECTA Case Law Reports

Did You Know That the Haribo Gummy Bear Has Chest Hair? The EUIPO Recognises the Distinctiveness of a Gummy Bear Figurative Mark

ON 11 OCTOBER 2023, THE FOURTH BOARD OF APPEAL OF THE EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO), IN CASE R 872/2023-4, CONFIRMED THE DISTINCTIVENESS OF A FIGURATIVE MARK REPRESENTING A GUMMY BEAR FOR A WIDE VARIETY OF GOODS, INCLUDING CLASSES 9, 14, 16, 28, 20, 21, 24, 25, 26, 27 AND 28:



BACKGROUND

Rigo Trading S.A, owner of the IP rights in the famous German sweets company HARIBO filed an application for an international registration under the Madrid Protocol for a figurative mark representing a gummy bear, on the basis of its earlier Benelux trade mark. The application covered a wide range of goods in several classes of the Nice Classification, including for example magnets in Class 9, jewellery in Class 14, cases in Class 18, mirrors in Class 20, containers in Class 21, clothing accessories and hair ornaments in Class 26 and inflatable floats in Class 28. Sweets and specifically gummy bears have not been applied for.

The EUIPO Examiner refused the application partially, arguing that the mark was not to be registered on the basis of Art. 7(1)(b) of the EUTMR because it lacked distinctiveness

for a large part of the goods claimed. It is stated that the shape of a gummy bear or a figurative depiction of the same are commonly used for decorative, artistic or aesthetic purposes. The features of the sign do not depart significantly from the norm of how gummy bears appear. The Examiner supported his view by different examples from the internet, where a gummy bear form or graphic was used for a part of the goods in question. However, the Examiner approved distinctiveness for e.g. belts, and playground and video games equipment. Once the decision has become final, the proceedings should be resumed for the examination of the subsidiary claim based upon Art.7(3) EUTMR and Art. 2(2) EUTMIR.

The decision was appealed. Rigo Trading S.A argued that the mark did have distinctive elements which distinguished it from competing gummy bear products. The mark applied for is characterised by the following distinctive elements:

- it has pointed and straightforward tapering extremities;
- a nose tapering forward, ears tapering diagonally upwards from the head;
- a happy smiling mouth and the chest hairs indicated by oval notches.

Candy and sweets from competitors of gummy bears look different. The first version of a fruit gum product in the shape of stylised bears was invented by HARIBO in the year 1978 and has since then become a famous and iconic device element. A

consumer survey carried out in Germany in 2019 in relation to the white version of the HARIBO Goldbear resulted in the sign having a reputation of 92.6 percent in the relevant trade circles. Furthermore, 74.5 percent of the trade circles perceived the sign as a source identifier, 73.1 percent being able to identify HARIBO as the source. It is also common practice when licensing goods of famous confectionery and snacks or drinks, for manufacturers to use animal logos on merchandised goods. Moreover, there are other comparable figurative trade marks used as indicators of origin on the market e.g. the well-known Lacoste crocodile and Batman emblem as registered figurative marks which use animals or geometric shapes.

THE BOA DECISION

The Fourth Board of Appeal concluded that the mark diverges sufficiently from the norm or custom in the corresponding sectors for it to retain a minimum degree of distinctive character. It is therefore registrable with respect to the contested goods.

Although the sign for which protection is sought was filed as a figurative (2D) mark, it cannot be excluded that it is perceived as a three-dimensional shape. The case-law developed in the context of three-dimensional marks consisting of the appearance of the product may therefore be applicable in this case. It is noted that average consumers are not in the habit of making assumptions about the origin of



products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. It may therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark.

The Haribo bear includes distinct characteristics, such as the position of the ears or the nose, its smile etc., which will create a visual impact on the relevant consumers displaying an average degree of attention with regard to the contested goods. The sign also conveys the impression of consisting of a material – gum – which is not the usual material the claimed goods are made of. Further the Board noted that the public would know that gummy bears are generally not larger than 2cm (apparently this is for ease of consumption), which is smaller than most of the contested goods. The sign departs significantly from the norm or from the customs of the sector concerned in order for the public to perceive it as a distinctive sign for the contested goods. Regarding the Examiner's consideration that for some of the contested goods, the sign at issue would be perceived as a mere decorative element, and therefore incapable of identifying the origin of those goods or services, it must be recalled that, as stated by the General Court, there is nothing to prevent a distinctive sign from also serving other purposes, in particular a decorative purpose. The fact that gummy bears have been used on a number of

occasions already is irrelevant, as originality and novelty are not relevant criteria when assessing the distinctive character of a mark.

COMMENT

Even if the Fourth Board of Appeal noted that average consumers do not typically see the shape of goods or their packaging as denoting their origin in the absence of any graphic or word elements, and it is therefore more difficult to establish distinctiveness for three-dimensional marks, trade marks should not be rejected as lacking distinctiveness just because similar signs have been used decoratively on unrelated products in the past. Trade marks can serve a dual purpose as decorative elements and source identifiers.

This ruling emphasises that a minimum degree of distinctiveness is required for the protection of figurative trade marks, without any requirement of originality or artistic merit. In the light of the existing jurisdiction regarding other types of marks, such as word marks, the finding is correct: This gummy bear with his chest hair and the specific appearance is something special and therefore distinctive. It can serve as a trade mark.

Even if HARIBO invented the gummy bear and it has become an iconic device element, at this stage of the proceedings, the fact that 73.1 percent of the trade circles being able to identify HARIBO as the source of the sign, is not of relevance. For the question of registrability as a figurative trade mark,

Art. 7(3) EUTMR was subsidiary. However, in Germany the characteristics of the HARIBO bear have already been enforced successfully against competitors, as they are protected due to their high competitive originality (e.g. OLG Köln, decision of 20 October 2020, file 6 U 19/20 - *Gummibärchen*).«



AUTHOR: **Birgit Reiter**

Attorney at Law

KUHNEN & WACKER IP Law Firm

Birgit.Reiter@kuhnen-wacker.com

ECTA Publications Committee

VERIFIER: **Nicole Ockl**

Group Director IP Legal, Domains & Licenses

TUI Group

Nicole.Ockl@tui.com

ECTA Professional Affairs and Membership Committee