Is South African trademark law out of shape? A comparative analysis of shape marks, in light of the recent SCA and CJEU Kit Kat decisions

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1. Introduction

Intellectual property law is inherently linked with innovation as it serves to incentivise authors and inventors to create new works that ultimately stimulate economic growth. Trademark protection has become especially relevant over recent years, as an increasing number of applications have been brought for the protection of non-traditional trademarks. The protection of shapes as trademarks – which are considered to be non-traditional forms of trademark – has gradually been incorporated into trademark legislation and treaties worldwide. Therefore, as shape marks are a relatively new area of intellectual property law, it is both interesting and useful to compare the South African approach to their protection with that of other jurisdictions. The recent Kit Kat trademark proceedings in South Africa, the United Kingdom ("UK") and Europe have provided a unique opportunity to establish whether South African law, in respect of shape marks, is consistent with the approach adopted in Europe. This article will show that South Africa and the European Union ("EU") (and, in turn, the UK) share similar legislative provisions with regard to shape marks. Furthermore, both South Africa and the UK share a similar history in relation to the Kit Kat four-finger confectionary icon. Despite this, it will be shown that there were significant differences between the South African Kit Kat judgment and the Kit Kat proceedings in the UK and the EU. This article will use the different Kit Kat proceedings as a measure to determine whether South African trademark law has fallen out of step with the European legal position, which, arguably, represents a significant perspective.

2. Background to shape marks

The primary function, or purpose, of a trademark in South Africa, as well as other jurisdictions, such as the UK and the EU, is that it must act as a "badge of origin" or guarantee of origin. In essence, the "badge of origin" concept requires that a trademark – be it a device mark, word mark or shape mark – should indicate the commercial origin of the goods or services bearing such mark to a consumer. The secondary function of a trademark is its distinguishing function: the trademark must serve to distinguish the goods and services of one source from that of another. While these trademark functions are relatively easy to satisfy when it comes to word marks, such as "Coca-Cola" or "Apple", shape marks have proved to be more problematic. For example, it has been accepted in various jurisdictions that the shape of the Jeep grille, Coca-Cola's "curvaceous" (or contour) bottle and the shape of the Hershey Kiss successfully function as badges of origin, and, therefore, are entitled to trademark protection. However, applications to obtain trademark protection for the shapes of the golden Lindt Bunny and Magnum ice-cream waffles have failed. It is, therefore, important to understand the various considerations behind the registration of shape marks in particular, as well as the relevant case law and legislation that determine whether a shape may be registered as a trademark.

Registering a trademark in the form of a shape has been a particularly contentious issue in case law, with a wealth of jurisprudence on the matter. According to Kur, this may be due to the fact that the registration of a shape mark is not easily reconciled with the structure and purpose of intellectual property law. This is because trademarks, unlike other forms of protection offered by intellectual property law, provide protection without a fixed limit in time. The idea behind this time-limit exception is that a trademark serves to identify the commercial origin of goods, rather than to grant a monopoly of rights and interfere with competition. Essentially, trademark protection allows any competitor to produce an identical good to that of the trademark holder, as long as they make use of a different source indicator. A problem therefore arises when a shape is validly registered as a trademark, as such registration may grant the holder "eternal protection" over the market exclusivity of a particular shape. This exclusive protection over a shape could clearly have anti-competitive implications. Conversely, if certain shapes or containers were not capable of receiving trademark protection, consumers may be misled as to the origin of a good and potentially suffer prejudice. In order to balance these considerations sufficiently, the registration of shape marks should only be allowed when it can be shown that the shape genuinely fulfils the trademark function. As a result, it has become necessary for the legislature and the courts, both locally and internationally, to establish a specific approach in respect of shape marks.

Trademark law is inherently territorial, meaning that in order to receive protection in a certain territory, the trademark must be registered in accordance with the local law of that territory. However, South African trademark law is largely based upon, and harmonised with, international trademark standards, particularly those provided for in the UK and Europe. This position gives rise to the following question: if the law in South Africa is substantially consistent with that of the UK and Europe, why did the registration of the Kit Kat shape occur with relative ease in South Africa, as compared to the Kit Kat proceedings in the UK and the decision of the Court of Justice for the European Union ("CJEU")? While the four-finger wafer shape mark remains on the South African trade mark register, the effect of the recent decision of the CJEU, and the subsequent judgment of the High Court of Justice of England and Wales ("UK High Court"), was to reject the Kit Kat shape mark application in the UK. There is, of course, the possibility that the UK High Court's decision will be appealed, but an important question remains: has South Africa fallen out of step with trademark standards elsewhere, or does this decision simply demonstrate that South African trademark law has developed in a different direction to its European and UK counterparts, yet still with equal legal validity?

3. The South African Kit Kat proceedings: Nestle's lucky break

3.1 The South African Kit Kat proceedings

In 2014, the South African Supreme Court of Appeal ("SCA") held that the Kit Kat four-finger wafer shape was to remain a valid trademark on the South African trade mark register. The relevant proceedings were between Nestlé South Africa ("Nestlé") and Iffco South Africa ("Iffco") Ltd ("Iffco"), who compete on an international level in the sale of chocolates. These proceedings involved a number of disputes between the parties, with the application for the expungement of Nestlé's shape mark being the most important issue for the purposes of this article. Before analysing this case, it is necessary to briefly consider the relevant South African legislation and case law on shape marks.
3.2 South African shape mark legislation and case law

3.2.1 A shape as a trademark

Prior to the South African Trade Marks Act 194 of 1993 ("Trade Marks Act"), it was accepted that while "containers" for goods could be registered as trademarks, the shape of a good itself could not serve as a badge of origin. However, this position was changed with the coming into effect of the Trade Marks Act. Following the approach advanced by the European Council, the new South African trademark legislation made provision for the registrability of a shape as a trademark. While not always consistent in the wording of its provisions, South African legislation is now substantially the same as its European and UK counterparts with regard to the recognition of shapes as trademarks. The definition of "trade mark" in section 1 of the Trade Marks Act specifically refers to a "mark" that is used or proposed to be used in relation to goods or services, with the purpose of distinguishing such goods or services from the same kind of goods or services connected with any other person in the course of trade. The Trade Marks Act then expressly goes on to state that a "shape" is capable of being considered a mark for the purposes of the definition of a "trade mark". The legislature has therefore recognised that a shape may validly be registered as a trademark, as long as the further statutory requirements are complied with. The first statutory requirement is that the mark – or shape, for the purposes of this article – must be able to be represented graphically. This requirement is relatively unproblematic, as any sufficient three-dimensional sketch of the shape will suffice. However, the further statutory requirements for trademarks contained in the Trade Marks Act, and discussed in more detail below, serve as considerable challenges to shape marks in particular.

3.2.2 A shape as a badge of origin

The second requirement for the registration of a trademark is referred to in both sections 1 and 9 of the Trade Marks Act, namely, that the mark must be "capable of distinguishing". This requirement is reflective of the secondary function of a trademark. According to section 10(2)(d) of the Trade Marks Act, the distinguishing requirement may be met if the mark is inherently capable of distinguishing on the date of application, or if it has become capable of distinguishing through prior use. Section 10(2) of the Trade Marks Act is reflective of European precedent, by specifically precluding the registration of a mark that is not distinctive.

When assessing the distinctiveness of a shape mark, South African courts have reiterated that the test is no different from that applied to any other type of mark. However, given their nature, shape marks do not, practically, undergo a more rigorous testing process by the courts. Case law has shown that special considerations are taken into account by the courts when assessing the distinctiveness of shape marks. For example, the SCA has held that while shape marks do not – from a legal perspective – differ from any other form of trademark, they should be considered in a different manner. According to Harms JA, with reference to English case law, this is due to the fact that shapes (and containers) are usually regarded by consumers as being functional or decorative, rather than serving as a badge of origin.

Additionally, it has been accepted by courts that a shape mark will not be a source indicator simply because the shape is "fancy" or "new and visually distinctive". Furthermore, registration of a shape mark will also fail if the shape resembles the shape most likely to be taken by the type of product in question. This leaves a shape mark in a very unique position, which was well phrased by Kur: is the shape too common, too splendid, or just right? Accordingly, for a shape mark to be considered "capable of distinguishing", there are very specific criteria that have to be met. These criteria are significantly different from the criteria for the registration of a shape mark. The registration of a shape mark is possible under the Trade Marks Act, the burden will be on the party attempting to register the mark to show that the shape genuinely fulfils the functions of a trademark. However, it is important to note that simply fulfilling the trademark function will not guarantee the successful registration of a shape mark. The Trade Marks Act specifically lists a number of instances where the registration of a shape mark will be prohibited, which are of particular importance for the purposes of this article.

3.2.3 The Kit Kat bar: an innovative shape, or simply a technical result?

Section 10(5) of the Trade Marks Act – again following European precedent – specifically excludes the registration of any shape that is necessary to "obtain a specific technical result", or where the shape of the good results from the nature of the good itself. Furthermore, section 10(5) of the Trade Marks Act precludes a registration of a shape where such registration may "limit the development of art or industry". These provisions seek to prevent trademark protection being used to obtain a monopoly on the technical solutions or the functional characteristics of a product. In other words, these prohibitions serve to acknowledge the potential anti-competitive outcome of allowing a monopoly of rights over certain types of shapes, and are, therefore, reflective of the policy considerations, as referred to above.

While section 10 of the Trade Marks Act refers to several other prohibitions against the registration of a trademark, it is section 10(5) that was the primary consideration in the South African Kit Kat case. From the above analysis of South African law, it is clear that there were two important hurdles for Nestlé to overcome in order to acquire trademark protection over the Kit Kat shape: the shape had to be sufficiently distinctive so that it could be said to be "capable of distinguishing", and the shape must not have been a necessary consequence of any technical result. Despite the aforementioned hurdles, policy considerations and the general approach adopted by South African courts when addressing the registration of a shape mark, it will be seen below that the validity of the Kit Kat shape mark was recently confirmed by the SCA.

3.3 Kit Kat proceedings in South Africa: the problem, the argument and the verdict

3.3.1 The application for expungement

In the South African Kit Kat proceedings, Iffco relied on section 10(5) of the Trade Marks Act in its application to expunge Nestlé’s shape mark over its four-finger wafer chocolate bar. Section 10(5), as discussed above, may be used to remove any mark from the register which, inter alia, consists exclusively of a shape necessary to obtain a specific technical result, or where the shape results from the nature of the goods itself. The primary legal question, in this regard, could be isolated to whether the trapezoidal shape of the Nestlé four-finger wafer shape trademark was necessary to obtain a technical result.

The fact that chocolate bars must take a trapezoidal shape was not in dispute. This is due to the fact that such a shape is necessary in order to release a chocolate bar from its mould during production. What was in dispute was whether the additional elements of the four-finger wafer shape mark were entirely technical requirements, or whether they were distinctive additions.

3.3.2 The legal arguments and their reliance on international Kit Kat decisions

Both parties to the proceedings relied upon arguments raised in the UK, where the matter of the registrability of the Kit Kat shape mark was also in dispute. These arguments, and the response of the SCA to these arguments, are especially relevant for the purposes of this article. This is because it facilitates a meaningful comparison between the responses of the South African, UK and European courts to the same legal facts and
In support of its application, Nestlé relied on the findings of the Second Board of Appeal of the Office for Harmonisation in the Internal Market ("OHIM"), in the case of Société des Produits Nestlé SA v Cadbury Holdings Ltd (11 December 2012). In response to the question of whether the Kit Kat shape was exclusively the consequence of a technical result, the OHIM concluded that certain attributes of the chocolate bar existed independently of any technical function. These attributes included the rectangular base upon which the wafer fingers were aligned and the presence of the partition of the bar into four portions. While it was concluded that these features were relatively banal, they were still considered by the OHIM to exist independently of any technical reason, and to serve as a badge of origin for the product.

Iffco, in turn, relied on the opposition proceedings in the aforementioned UK case. In that case, the UK’s Intellectual Property Officer ("IPO") found, *inter alia*, that the rectangular shape resulted from the nature of the moulded bars, that the breaking grooves (or partitions) were necessary to achieve a technical result, and that the number of breaking grooves and fingers were determined by the desired portion size. It is important to note that unlike the UK proceedings, these arguments were raised in the South African court in the context of an application for the enhancement of an already existing registration of the Kit Kat shape mark. The court, as observed above, adopted a relatively stricter approach in this case, which was consistent with either the CJEU or the Advocate General, the court deciding whether the Kit Kat shape should be allowed to be registered. In contrast, the SCA had to decide whether the Kit Kat shape mark should remain on the register in response to the above arguments, in light of section 10(5) of the Trade Marks Act.

3.3.3 Judgment: South Africa’s oldest chocolate bar prevails

In response to the arguments cited above, the SCA decided in favour of Nestlé by concluding that the four-finger wafer shape was distinctive and not only attributable to a technical result. The SCA disagreed with the findings of the IPO, concluding that the four-finger shape is based on aesthetic rather than technical considerations. This conclusion is particularly significant in light of the CJEU decision, which will be discussed below. Additionally, the SCA held that portion size was not solely determined by the number of fingers, but also by the size or weight of the fingers. In contrast to the IPO’s conclusions about the breaking grooves, the SCA found that while such grooves were necessary to break the chocolate, the shape of the fingers and dimensions of the groove were not determined solely by technical considerations. Additionally, in considering the policy considerations applicable to a trademark application, the SCA concluded that Nestlé would not be granted a monopoly over trapezoidal-shaped chocolate bars as a result of the Kit Kat shape mark remaining on the Trade Marks Register.

Furthermore, the question of whether the Kit Kat shape served as a badge of origin was relatively unproblematic in this case. The SCA emphasised the fact that Nestlé had marketed and sold the Kit Kat chocolate bar in South Africa for 50 years, and that extensive use had been made of this shape for promotion and advertising purposes. To this extent, and with reference to two consumer surveys, the court concluded that the ordinary consumer was able to recognise the shape of the Kit Kat chocolate bar, and associate such shape with Nestlé and the Kit Kat brand. As will be illustrated below, this stands in stark contrast with the standard for distinctiveness required by the CJEU, and subsequently applied by the UK High Court.

In conclusion, the SCA upheld the registration of the Kit Kat shape mark, and, subsequently, found that Iffco infringed the shape mark through the sale and promotion of its four-finger "Break" chocolate bar.

4. Kit Kat abroad: from the UK to the CJEU, and back

4.1 Shape mark legislation in the UK and the EU

According to Anderson and Nordemann, any reference to "European trademark law" is an oversimplification, as the UK and European trademark systems both continue to co-exist alongside one another. However, the basic goal of the harmonisation of laws within the EU is to facilitate the creation of a single common marketplace. In light of the above, the Community Trade Mark Regulations ("CTMR"), and the Trade Mark Directive ("TMD"), of the EU both find full application within the UK.

As stated above, the legislation pertaining to shape marks in the UK, Europe and South Africa are substantially alike. Similar to the South African legislation, section 1 of the United Kingdom Trade Marks Act of 1994 ("UK Trade Marks Act") expressly includes a "shape", in its definition of "trade marks", as being capable of being registered as a trademark. Comparably, article 4 of the CTMR and article 2 of the TMD expressly refer to shapes as capable of being registered as trademarks.

Furthermore, the requirements for the registration of a shape trademark are listed in article 7 of the CTMR, namely, that the mark must be distinctive and absent of any descriptive characteristic. These provisions are comparably very similar to their South African counterparts as the legislation in both jurisdictions makes express provision for shape marks, provided that they are distinctive or "capable of distinguishing."

With regard to prohibitions against registration, the trademark legislation of South Africa, the UK and the European community remain substantially the same. The UK Trade Marks Act precludes the registration of a trademark that lacks a distinctive character, similar to article 3(1)(b) of the TMD, which precludes the registration of a trademark devoid of any distinctive character. However, article 3(3) of the TMD, as well as article 3(2) of the UK Trade Marks Act, provide that distinctive character may be acquired as a result of prior use. Additionally, each jurisdiction – including article 3(3) of the TMD – specifically precludes the registration of a trademark where the shape of the mark is the result of the nature of the goods, or where the shape is necessary to obtain a technical result. More specifically, articles 3(1)(e)(i) and (ii) of the TMD state that a trademark shall not be registered if it consists exclusively of the shape resulting from the nature of the goods themselves, or if the shape is necessary to obtain a technical result. It was on these specific provisions, as well as article 3(3) of the TMD (as described above), that Cadbury based its opposition to the registration of the Kit Kat shape mark in the UK.

4.2 The UK Kit Kat question

The Kit Kat chocolate bar may, arguably, be regarded as one of the most iconic British treats. The renowned chocolate bar entered the UK market in 1935, under the ownership of Rowtree & Co Ltd, which was eventually acquired by Nestlé in 1988. Since the introduction of this chocolate bar into the market in 1935, the shape of the bar has remained substantially unchanged, with the exception of its size. On 8 July 2010, Nestlé sought to register the four-finger wafer shape of the Kit Kat as a trademark in the UK.

It is important to note that it was the actual shape of the bar itself that was sought to be registered, independent of the words "Kit Kat" embossed thereon. While the Trade Mark Registry of the UK IPO initially accepted the Kit Kat application, Cadbury subsequently filed a notice of opposition to the application. In doing so, Cadbury relied on provisions of the UK Trade Marks Act which transcribe articles 3(1)(b), 3(1)(e) (i), 3(1)(e)(ii) and article 3(3) of the TMD, as described above.

In 2013, the IPO found that the Kit Kat shape mark was devoid of distinctive character, and that distinctive character had not subsequently been acquired through prior use. The IPO examiner found that the Kit Kat shape consisted of three essential features: the first feature is the basic circular shape of the bar, the examiner found resulted from the nature of the goods themselves, thus precluding registration except in respect of "cakes" or "pastries." The second feature identified was the presence, position and depth of the grooves running along the length of the bar. In the examiner’s view, the examiner took the view that the grooves were not necessary to obtain a technical result. The third feature, namely the number of grooves and the width of the bar that determine the number of "fingers", was also found to be necessary to obtain a technical result. These features will cumulatively be referred to as the "three essential features."
drafting article 3 of the TMD. 54 This is due to the fact that a sign, or mark, that is refused registration under article 3(1)(e) of the TMD may never be registered, and the issue of acquired distinctiveness is, therefore, irrelevant. 55 Accordingly, it must first be established whether the mark consists of an essential feature. 56 In order to determine whether an enquiry into "acquired distinctiveness" is necessary. This article will therefore adhere to the sequence followed by the CJEU.

In order to attract the appropriate level of significance to the findings of the CJEU, it is important to understand the procedural and legal implications of a preliminary hearing by the CJEU. Essentially, the national court of any Member State of the EU may refer questions on the interpretation of a European legal instrument to the CJEU. Unlike a procedure seeking recourse against a European legal instrument, this procedure allows national courts to present questions on the application of European law. The aim of this is to ensure that national courts understand and apply European law correctly. The decision by the CJEU in a preliminary hearing is binding on the national court that initiated the reference, as well as all other national courts within the Member States of the EU. However, it is important to note that the decision by the CJEU is limited only to the questions of law referred to it by the national court, but it does not make any factual determination relating to the particular case pending before the national court. 57

4.3 Findings of the Advocate General and the CJEU

4.3.1 The second question

The UK High Court, in its second question, essentially asked whether article 3(1)(e) of the TMD must be interpreted as precluding the registration of a trade mark which mark consists of three essential features: one resulting from the nature of the goods and the other two which are necessary to obtain a technical result. 58 As stated above, these features refer to the rectangular shape of the bar, the presence, position and depth of the grooves of the bar, as well as the number of grooves that – alongside the width of the bar – determine the number of chocolate "fingers". 59 The Advocate General reiterated that while the shape of a product may be capable of fulfilling the functions of a trademark, the public interest considerations underlying the grounds for refusal must be considered. 60 Relying on case law, the CJEU agreed with the Advocate General that the rationale behind these provisions is to prevent the proprietor of a good from obtaining a monopoly on technical solutions or functional characteristics. 61 Furthermore, such provisions aim to prevent a proprietor from obtaining a permanent and exclusive right to the shape of a good through a trademark, which would otherwise be subject to a limited period of protection by the EU legislature under another form of intellectual property right. 62

In considering the interpretation of this provision, the CJEU accepted that each ground listed in article 3(1)(e) exists independently from each other, and must be applied accordingly. 63 While the grounds listed cannot be applied in combination, there is nothing preventing the grounds from being present cumulatively. 64 Consequently, it is irrelevant whether the application could be denied on the basis of more than one ground. 65 By analogy with the CJEU’s interpretation of the shape mark in London Pride, where the shape of the goods is necessary to obtain a technical result, or where the shape gives substantial value to the goods – as long as one particular ground is fully applicable. 65 Should any of these grounds be present, the shape cannot be registered as a trademark. 65

In light of the above, both the Advocate General and the CJEU agreed that, in answer to the second question, the TMD must be interpreted as precluding the registration of a shape mark where such a shape consists of the three essential features, one resulting from the nature of the goods and the other two being necessary to obtain a technical result. 65 In light of public-interest considerations, however, such preclusion may only take place where one or more of the three grounds are “fully” applicable. 65

The CJEU’s interpretation of article 3(1)(e) of the TMD, essentially, means that a national court must preclude the registration of the shape mark if any one of the three essential features of the Kit Kat shape “fully” satisfies one of the statutory grounds for exclusion. This interpretation would require a national court to determine – should the issue arise – whether any of the essential features of the Kit Kat chocolate bar fall within the statutory exclusions. The shape must – with no discretion – be denied registration if any one of the statutory grounds for the registration of a shape mark applies fully to any one of the three essential features.

4.3.2 The third question

While this question came third in the sequence of questions referred by the UK High Court, as mentioned above, it was dealt with as the second question by the CJEU. This question pertained to whether the exclusion of the registration of a shape on the ground that it is necessary to obtain a technical result – as contained within article 3(1)(e)(ii) of the TMD – refers solely to the way the goods function, or whether it also includes the way the goods are manufactured. 66 It is important to note that, unlike the other two questions, the conclusions reached by the Advocate General and the CJEU were not consistent in relation to this question.

The Advocate General concluded that article 3(1)(e)(ii) of the TMD precludes the registration of a shape which is necessary to obtain a technical result in the way the goods function, as well as with regard to the way in which they are manufactured. 67 This conclusion was reached despite acknowledging that a literal interpretation of the provision expressly precludes the manufacturing process from its scope of application. 67 The Advocate General provided specific reasons for this finding, and in doing so, specifically referred to the example of the four-finger Kit Kat wafer bar. Essentially, it was observed that a final technical result – in other words, the way the goods function – might in certain instances only be obtained as a result of a special manufacturing process. For example, the grooves between the wafer fingers of a Kit Kat bar enable consumers to separate the chocolate fingers with ease, prior to consumption. While this may be regarded as a desired technical result, the actual angle of the grooves and the sides of the product are determined by a specific manufacturing moulding process. 68 In light of this reasoning, and the policy considerations of preventing a proprietor from obtaining a monopoly over the technical solutions of a product, 69 the Advocate General concluded that the scope of article 3(1)(e)(ii) of the TMD includes both the final technical result and the manufacturing process. In summary, the Advocate General was of the opinion that this provision of the TMD should be interpreted as precluding the registration of any shape as a trademark where such shape is necessary to obtain a technical result, either in the way the goods function for the end-user, or the manner in which the goods are manufactured. 68

The CJEU, however, did not follow the interpretation of the Advocate General. Instead, by focusing on the literal interpretation of the provision, the CJEU noted that the provision expressly refers to, and is therefore limited by, the phrase “technical result”, without mentioning the manufacturing process. 69 Consequently, in light of the words of the provision itself, the scope of the section does not extend to the manufacturing process. According to the CJEU, this interpretation of the provision is reinforced by case law, which has held that the registration
of a shape may be refused on the grounds of "technical result", even where such result may be achieved by other shapes, and, in turn, other manufacturing processes. Furthermore, the CJEU referred to the practical implications of this provision, noting that it is the way in which the goods function – rather than their manufacturing process – that is important from the perspective of the consumer. In light of the above, the Advocate General and the CJEU reached different conclusions, with the CJEU concluding that the scope of article 3(1)(e)(ii) of the TMD does not include the manufacturing process of a good.

The different conclusions drawn by the Advocate General and the CJEU are particularly interesting for the purposes of the UK Kit Kat shape application. This is due to the fact that, in the opinion of the Advocate General, specific factual reference was made to the shape of the goods of the Kit Kat fingers. The Advocate General specifically included the manufacturing process as a ground for refusal of a shape mark, and then proceeded to explain how the Kit Kat shape achieved a technical result through the manufacturing process. It, therefore, logically follows that the Advocate General would recommend that the Kit Kat shape be precluded from registration, on the basis that the manufacturing process used falls within the "technical result" prohibition. However, following the legal interpretation of the CJEU, a national court must interpret the TMD reference to "technical result" as referring only to the end-use of the good, rather than also including the manufacturing process. While this interpretation has now been clarified in European law, the question remains as to whether the South African position on the matter has been determined, and, if so, what that position entails. Accordingly, the South African position in this regard is both problematic and ambiguous, and as a result, it will be addressed, in more detail, further on in this article.

4.3.3 The first question

The first question related to article 3(3) of the TMD, which states that a trademark may acquire a distinctive character through prior use. The question referred to by the UK High Court essentially asked whether it was sufficient, for the purposes of this provision, that the relevant class of persons distinguished the goods or services exclusively by that shape, as opposed to any other mark which may also be present (or a combination of such marks), or whether it was sufficient to show that a significant proportion of the relevant class recognise that shape and associate it with the goods of the applicant. In other words, the question was whether a shape must be used independently in order to acquire distinctive character, or whether the acquisition of distinctive character may be as a result of the use of the shape in combination with a registered trademark (for example, a word mark). For practical purposes, the question would be whether it was sufficient that the Kit Kat four-finger wafer shape, along with the "Kit Kat" logo – which was embossed on the fingers of the chocolate bar - had acquired distinctiveness, or whether the shape, on its own, had acquired distinctiveness through prior use.

In response to this question, the Advocate General and the CJEU reiterated the essential function of a trademark, namely, to guarantee the identity of the origin of the good to the consumer, without the possibility of confusion, so that the good may be distinguished from that of another origin. Therefore, not only must a trademark be used to distinguish goods from one proprietor from another, but also to guarantee that all goods associated with that particular mark have the same origin. Similar to South African law, the test for distinctiveness is whether the mark will distinguish the product from those of other undertakings in the eyes of an average consumer who is reasonably observant, but who is neither conducting an analytical examination nor paying particular attention.

In response to this enquiry, Nestlé had submitted that a trademark does not need to have been used independently in order to acquire a distinctive character. Accordingly, it was argued that the combined use of the shape and another registered trademark was sufficient for the purposes of the average consumer test, namely, that it was sufficient that consumers recognised the Kit Kat shape with the "Kit Kat" word mark emblazoned upon it – rather than the shape alone – for the purposes of the distinctiveness enquiry.

The Advocate General disagreed with this interpretation, and stated that the acquisition of a distinctive character must be as a result of the use of the shape "as a trade mark". The Advocate General interpreted this as meaning that it had to be shown that the shape, independently, had been used to indicate the origin of a good to the relevant class of person. While a shape mark may have acquired distinctive character when used in conjunction with another registered trademark (such as the Kit Kat shape and logo in conjunction, as described above), the Advocate General was of the opinion that the shape itself must be capable of fulfilling the trademark function independently, in order to receive trademark protection. This position is reinforced by previous case law, which stated that documentary evidence of the use of the overall mark is not sufficient; rather, it is the element sought to be registered that must be shown to be capable of distinguishing.

This interpretation was also followed by the CJEU. Accordingly, the CJEU concluded that while the acquisition of a distinctive character may result from the use of two marks in conjunction, it is important that the relevant class of persons perceive the mark applied for – namely, the shape mark – as designating the origin of the goods as being from a specific undertaking. Therefore, in application to the Kit Kat set of facts, while it was sufficient that the shape of the bar had been used alongside another registered trademark, it had to be shown that the shape alone served to identify the chocolate as originating from a particular source.

In light of this interpretation, the onus was on Nestlé to show that the shape of the Kit Kat chocolate bar was independently (and not because of use in combination with another registered mark) capable of fulfilling the "average consumer" test as described above. This interpretation clearly posed an additional hurdle for Nestlé as consumer surveys were required to establish the distinctiveness of the shape apart from the word mark. In the subsequent UK High Court decision, the court held that Nestlé had not discharged its onus of proving the distinctiveness of the shape of the Kit Kat chocolate bar, as it had not proved that it was relied upon by the average consumer as designating the trade origin of such products.

It is, thus, clear that while the distinctiveness of the Kit Kat bar proved to be a contentious issue in the UK proceedings, the South African SCA did not consider the acquired distinctiveness of the shape of the chocolate bar to be problematic. Instead, the SCA appeared willing to conclude that the Kit Kat shape was distinctive, which is interesting in light of the similarities in both the history of the chocolate bar, as well as the legislative provisions in both jurisdictions. This raises an important question: what are the main differences in the judgments by the CJEU and the SCA, and why do they exist?

5. Same facts, same law, different result. What are the implications for South African trademark law?

A comparison between the Kit Kat application in the UK, the preliminary hearing in the CJEU, the subsequent UK High Court decision, and the application for expungement in the SCA, is not only interesting, but is an important way to establish the compatibility and growth of South African trademark law with developments elsewhere. Essentially, South Africa, the EU and the UK share similar legislative provisions. Furthermore, both South Africa and the UK share a common history of the Kit Kat four-finger confectionery icon. This raises the question of why the registration of the Kit Kat shape was accepted with relative ease by South African courts, yet significant legal issues were raised in the UK Kit Kat proceedings. More importantly, why did certain statutory provisions require significant legal consideration and interpretation by the CJEU, when the corresponding provisions appear not to have been subjected to the same scrutiny by the South African court, despite the similarity in both facts and in law?

As has been illustrated above, while the statutory provisions in the UK and South Africa are substantially the same, the judicial approaches to shape marks appear to be inconsistent. As stated above, it has also been shown that both jurisdictions share the same policy considerations and practical approach to shape marks in general. It, therefore, would logically follow that an application brought before both courts, on the
Trademark protection has become especially relevant over recent years, as an increasing number of goods and services are protected by trade marks. 

In order to balance these considerations sufficiently, the registration Section 10(5), as discussed above, may be used to remove any mark from the register which, subsequent to the registration, has ceased to have the characteristics of a trade mark. The need for this is not uncommon. For example, in [2015] CJEU para 60. Societe des Produits SA v Cadbury UK Ltd, the Advocate General held that the Kit Kat shape could not be registered as a trade mark because it is capable of being used without it ceasing to be such a mark. 

Max Planck Institute for Intellectual Property, Competition and Tax Law found, in the context of the Kit Kat case, which has been described as the locus classicus for discussion of shape marks, that the Kit Kat shape could have been used as a shape mark without losing its distinctiveness. 

However, applications to obtain trademark protection for the shapes of the golden Lindt Bunny and Maglite torches have been refused registration on the basis that it has not acquired distinctiveness, it is difficult to imagine many other goods that would satisfy the test of such distinctiveness. 

This conclusion was reached by the South African courts in the case of Beecham. 

This case, which has been described as the locus classicus for discussion of shape marks, has been the subject of much discussion in the academic literature. 

In the Beecham case, the court refused the trademark registration of the bi-convex, oval shape of a tablet. This was on the basis that the shape was necessary to obtain a technical result, and, thus, in violation of section 10(5) of the Trade Marks Act. In determining whether the bi-convex shape was necessary to obtain a technical result, the court considered the end-use of the tablet, namely, the shape of the tablet in relation to its ease of swallowing. The court referred to medical documentation showing that patients experience problems with swallowing round tablets, and often required medical assistance after swallowing tablets of that shape. In light of these findings, the bi-convex tablet shape was shown to be the most effective way for patients to safely and easily swallow tablets. The fact that any other type of shape could obtain the same result was irrelevant for the purposes of an enquiry. This line of reasoning appears to be consistent with the judgment of the CJEU, which limited the scope of the "technical result" enquire to the end-use of the good. 

5.2 Technical result in one jurisdiction, but not the other

5. Technical result in one jurisdiction, but not the other? 

5. Same facts, same law, different result. What are the implications for South African trademark law? 

The Kit Kat chocolate bar may, arguably, be regarded as one of the most iconic British treats. The renowned chocolate bar entered the UK market in 1935. 

The Kit Kat shape mark is comprised of the shape of the chocolate "fingers". The Advocate General specifically included the manufacturing process as a ground for refusal of a shape mark, pursuant to section 10(5) of the Trade Marks Act, arguing that the shape mark was not "technical" because, on the evidence before it, the consumer would not necessarily associate the shape with the purpose of the shape mark. According to the Advocate General, the consumer would associate the shape mark with the manufacturing process. 

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5.2 Technical result in one jurisdiction, but not the other?
Trademark protection has become especially relevant over recent years, as an increasing number of people in the UK associated the shape of the chocolate bar with the Kit Kat brand. Despite this considerable number, the application was refused by the examiner, who reasoned that the shape was too common, too characteristic, or overused. The reason for this was that the Kit Kat shape mark application in question failed where any of the grounds for refusal are fully satisfied by an essential feature of the shape. This, arguably, stands in stark contrast to the SCA decision. In the SCA decision, the court held that the Kit Kat shape did not fall foul of the 'technical result' provision, due to the presence of other additional features that did not consist of a technical result. The court clearly placed an emphasis on the word "exclusively" within the provision. In other words, while some of the features of the Kit Kat bar may be attributed to a technical result, the presence of other non-technical features prevented section 10(5) from being applicable. In contrast to this, the SCA would, arguably, deny the same application as long as the "technical result" exclusion applies fully to at least one of the essential features. In light of this interpretation of the CJEU judgment, the presence of any other non-technical features would be irrelevant, as long as at least one feature falls foul of the article 3(1)(e) provision. The focus of the SCA, therefore, is on the word "exclusively" within section 10(5), whereas the focus of the CJEU is whether any of the features of a shape mark consist exclusively of a shape necessary to obtain a technical result.

It is clear from the above that the application of the "technical result" exclusion is considerably stricter under European law than South African law. For example, the SCA accepted that the Kit Kat bar did indeed consist of elements necessary to obtain a technical result. However, the presence of other non-technical features precluded the application of this provision. Had the interpretation of the CJEU been adopted, the application would, arguably, have been rejected on the basis that at least one of the grounds in article 3(1)(e) – namely, the "technical result" exclusion – fully applied to that shape.

The fact that other features are present, which do not fall foul of the article 3(1)(e) prohibition, is, therefore, irrelevant under the approach of the CJEU. Consequently, while the wording of the provision is substantially the same in each jurisdiction, the diverging legal interpretation and application of the provision may lead to significantly different outcomes.

5.3 Is it easier to be distinctive in South Africa?

When Nestlé brought an application to have the shape of the Kit Kat chocolate bar registered in the UK, it provided a survey suggesting that 90% of people in the UK associated the shape of the chocolate bar with the Kit Kat brand. Despite this considerable number, the application was refused by the examiner, who reasoned that the shape was too common, too characteristic, or overused. The reason for this was that the Kit Kat shape mark application in question failed where any of the grounds for refusal are fully satisfied by an essential feature of the shape. This, arguably, stands in stark contrast to the SCA decision. In the SCA decision, the court held that the Kit Kat shape did not fall foul of the 'technical result' provision, due to the presence of other additional features that did not consist of a technical result. The court clearly placed an emphasis on the word "exclusively" within the provision. In other words, while some of the features of the Kit Kat bar may be attributed to a technical result, the presence of other non-technical features prevented section 10(5) from being applicable. In contrast to this, the SCA would, arguably, deny the same application as long as the "technical result" exclusion applies fully to at least one of the essential features. In light of this interpretation of the CJEU judgment, the presence of any other non-technical features would be irrelevant, as long as at least one feature falls foul of the article 3(1)(e) provision. The focus of the SCA, therefore, is on the word "exclusively" within section 10(5), whereas the focus of the CJEU is whether any of the features of a shape mark consist exclusively of a shape necessary to obtain a technical result.

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The different approaches, as adopted by the SCA and the CJEU, have obvious implications: whereas the Kit Kat shape mark was readily accepted as being distinctive by the SCA (based on mere association), it is very clear that the issue posed a more significant hurdle for Nestlé in the UK High Court. It is clear that the approach to the distinctiveness of shape marks adopted by the UK High Court was, comparatively, stricter than that adopted by the SCA. As a result, the CJEU judgment, arguably, sets the bar high for successful registrations of shape marks in Europe. Having said that, if a chocolate bar as iconic and traditional as the Kit Kat four-finger wafer shape is
6. Conclusion

It is generally accepted that shape marks are a problematic form of trademark. As a relatively new area of intellectual property law, it appears that jurisdictions such as South Africa, the UK and the EU have developed a substantially similar approach to this type of mark. As a result of similar legislation, it is clear that the judicial approach to shape marks has remained consistent, which is illustrated by the constant referencing of foreign case law in the majority of shape mark cases. It would, therefore, be expected that the South African judicial approach to shape marks would continue to develop in line with the law in the UK and the EU. However, the recent SCA judgment on the Kit Kat shape has exposed a new kind of controversy: it has revealed possible substantial differences between the application of shape-mark law in South Africa and Europe. While the validity of the Kit Kat shape as a trademark was accepted with relative ease by South African courts, significant legal issues were presented to the CJEU in the Kit Kat case. This highlights important differences between the SCA and CJEU judgments. For example, the SCA appears to have accepted a lower standard for the distinctiveness enquiry. In doing so, the SCA judgment conflicts with established principles of South African trademark law, for example, the principle that extensive use is not sufficient to attain distinctiveness. Additionally, the SCA accepted that the "average consumer" test could be satisfied through evidence that consumers recognised the Kit Kat shape and associated it with Nestle, rather than requiring consumers to rely on the shape as a badge of origin.

This finding stands in stark contrast to that of the CJEU and the UK High Court.

Furthermore, the South African Kit Kat judgment failed to address important matters of legal interpretation, such as the scope of the "technical result" exception in section 10(5). The failure of the SCA to address this issue, combined with the ambiguity created by the Beecham case, has the potential to cause significant problems and discrepancies in future shape-mark cases. Additionally, it was illustrated that while the CJEU interpreted the grounds of exclusion in articles 3(1)(e)(i) and (ii) of the TMD as being able to be present cumulatively (although only one ground needs to be fully satisfied to exclude a trademark application), the SCA, in contrast, placed an emphasis on the word "exclusively" in section 10(5). This, as seen above, may lead to a different legal result, even if given the same set of facts. As a whole, the SCA Kit Kat decision has created the impression that it is easier to register a shape mark in South Africa, when compared to Europe and the UK. Furthermore, in light of the superficial approach of the SCA to the Kit Kat proceedings in matters such as distinctiveness, it appears that the SCA judgment lacks the necessary level of legal cogency. Accordingly, while the legislation, policy considerations and facts of the case in each jurisdiction remain substantially the same, it is clear that the approach of the SCA in the Kit Kat case is, indeed, out of step with the position in the UK and Europe.

Summary

This article examines the recent litigation concerning the shape of the Kit Kat chocolate bar in South Africa, Europe and the UK in order to determine whether the South African legal position relating to shapes as trademarks differs from that in Europe and the UK, given the fact that the respective legislation is substantially similar. The Kit Kat shape-mark cases provided a unique opportunity to determine if South African law in this area differs as it concerned the same basic set of facts. Given the legislative similarities, it would be logical to assume that a consistent result would follow. However, despite the legislative similarities, the SCA decision in the Kit Kat case appears to be inconsistent with the European and UK decisions. The first area of possible difference is the scope of the "technical result" exclusion from registrability as a trademark. While South Africa may consider the exclusion of a registration on the basis of a technical effect in relation to both the manufacturing process and the end-use of a good, only technical effects concerning the end-use are relevant in Europe and the UK. Second, the SCA held that the "technical result" exclusion only applies if the shape consists "exclusively" of a shape necessary to obtain a technical result, and, thus, will not apply if a shape has both functional and non-functional features. In contrast, in Europe and the UK a registration will be denied if any of the "technical result" exclusions apply to any feature, even if there may also be a non-functional element. Finally, the SCA appears to have adopted a lower standard for distinctiveness. It was sufficient if the average consumer recognised the Kit Kat shape and associated it with Nestle. However, in Europe and the UK the shape will only be distinctive if the consumers rely on the shape as a badge of origin.

* This article reflects the law as at the date of submission to the journal (March 2016).

4. S 1 of the Trade Marks Act.
8. 7.
10. 2.
11. As indicated below, the decisions of the CJEU concerning questions of law are binding on the national courts of Member States of the European Union, but the national courts determine the outcome of cases based on the application of the law to the facts of the particular case.
16. S 1 of the Trade Marks Act.
17. S 1. For completeness, it should be noted that the requirement that the mark be represented graphically has now been removed in the European Union (Directive 2015/2436/EU of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks). However, this does not affect the legal analysis in this article.
22. Para 15.

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Trademark protection has become especially relevant over recent years, as an increasing number of pharmaceutical companies are seeking to protect their product shapes as trademarks. According to legal precedents such as Societe des Produits SA v Cadbury UK Ltd [2015] CJEU para 82, a shape mark to be considered "capable of distinguishing" must meet very specific criteria. These criteria are derived from case law such as Societe des Produits SA v Cadbury UK Ltd [2015] CJEU para 14.

Kit Kat chocolate bar is a well-known example of a shape mark. Despite its iconic status and widespread recognition, the shape of the Kit Kat bar has been challenged for trademark registration. The CJEU agreed, concluding that the shape of the Kit Kat bar was capable of distinguishing products from different manufacturers. Two questions were examined:

1. **The first question** related to whether the Kit Kat bar’s rectangular shape was exclusively necessary to achieve a technical result. The CJEU concluded that it was necessary to prevent the bar from falling apart.

2. **The second question** concerned whether the Kit Kat bar’s packaging with its distinctive grooves and fingers was similarly necessary. The CJEU concluded that while these features were not necessary to achieve a technical result, they were important to distinguish the Kit Kat bar from competitors.

Kraft Foods (Coca-Cola) sought to register the Kit Kat shape as a trademark. However, the CJEU ruled that the shape of the Kit Kat bar was capable of distinguishing it from other similar形状s. This decision was based on the CJEU's interpretation of the “technical result” provision of article 3(1)(e) of the Trade Marks Directive (TMD).

For practical purposes, the question would be whether it was sufficient that the Kit Kat bar’s shape and packaging features facilitated its functionality and uniqueness. The CJEU emphasized that "technical result" does not refer to mere functionality, but to the essential features needed to achieve a specific purpose. The Kit Kat bar's unique shape and packaging are considered distinctive, as they set it apart from competitors.

The CJEU's decision has implications for the interpretation of "technical result" in other jurisdictions. While South African law has a similar provision, there is ambiguity in the interpretation of "technical result." The SCA (Supreme Court of Appeal) decision in the Kit Kat case appears to be inconsistent with the European and UK views. The South African approach is argued to be narrower than the European one, as the CJEU accepts a broader scope.

As stated above, these features refer to the rectangular shape of the bar, the presence, position and arrangement of the fingers, and the coating on the tablet. It is important to note that it was the actual shape of the bar itself that was sought to be registered, independent of the words "Kit Kat."
Trademark protection has become especially relevant over recent years, as an increasing number of this may be due to the fact that the registration of a shape mark is not easily reconciled with the structure and Comparative Law


This requirement is relatively unproblematic, as any sufficient three-dimensional Beecham Societe des Produits SA v Cadbury UK Ltd Societe des Produits SA v Cadbury UK Ltd According to Ismail, the consequence of this discrepancy, should it reflect a new approach, is relatively simple: there

It, therefore, appears that this is another consideration that the SCA appears not to have taken into account in the

This position is reinforced by previous case law, which stated that documentary

In determining whether the KitKat chocolate bar registered in the UK, it provided a survey suggesting that When Nestlé brought an application to have the shape of the KitKat chocolate bar registered in the UK, it provided a survey suggesting that

However, as discussed above, this has not been the case with the

African trademark law with developments elsewhere. Essentially, South Africa, the EU and the UK share similar legislative provisions.

A comparison between the

shape as a trademark where such shape is necessary to obtain a technical result, either in the way the goods function for the end-user, or the

shape was necessary to obtain a technical result, and, thus, in violation of section 10(5) of the Trade Marks Act.

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It is generally accepted that shape marks are a problematic form of trademark. As a relatively new area of intellectual property law, it appears

cases, has the potential to cause significant problems and discrepancies in future shape-mark cases. Additionally, it was illustrated that while the

It is, thus, clear that while the distinctiveness of the KitKat bar proved to be a contentious issue in the UK proceedings, the South African

As stated above, the legislation pertaining to shape marks in the UK, Europe and South Africa are substantially alike. Similar to the South

brand.