

The Protection of Non-Traditional Marks – Critical Perspectives

Prof. Dr. Irene Calboli

Professor, Texas A&M University School of Law

Academic Fellow, School of Law, University of Geneva

Visiting Professor, Faculty of Law, National University of Singapore

Prof. Dr. Martin Senftleben

Professor, Vrije Universiteit Amsterdam, Faculty of Law

Visiting Professor, IP Research Institute, Xiamen University

Of Counsel, Bird & Bird, The Hague

edited by
IRENE
CALBOLI
MARTIN
SENFTLEBEN

the
protection of
non-traditional
trademarks

critical perspectives

OXFORD

What are non-traditional trademarks?

Why non-traditional trademarks?

The potentials of non-traditional trademarks

The potential problems of non-traditional trademarks

What are non-traditional trademarks?

Shapes, Colours, Sounds, Smells, Video Clips,
Gestures, Holograms . . .



Mashable MUST READS SOCIAL MEDIA TECH BUSINESS ENTERTAINMENT US & WORLD WATERCOOLER MORE

SAMSUNG GALAXY S5 with Ultra Power Saving Mode and replaceable battery Check it out

Business FOLLOW MASHABLE 1.9k 2.7m FOLLOW 3.7m FOLLOW 4.8k

Apple Store


Apple Store Design Gets Trademark Approval

1.0k SHARES

Share on Facebook Share on Twitter

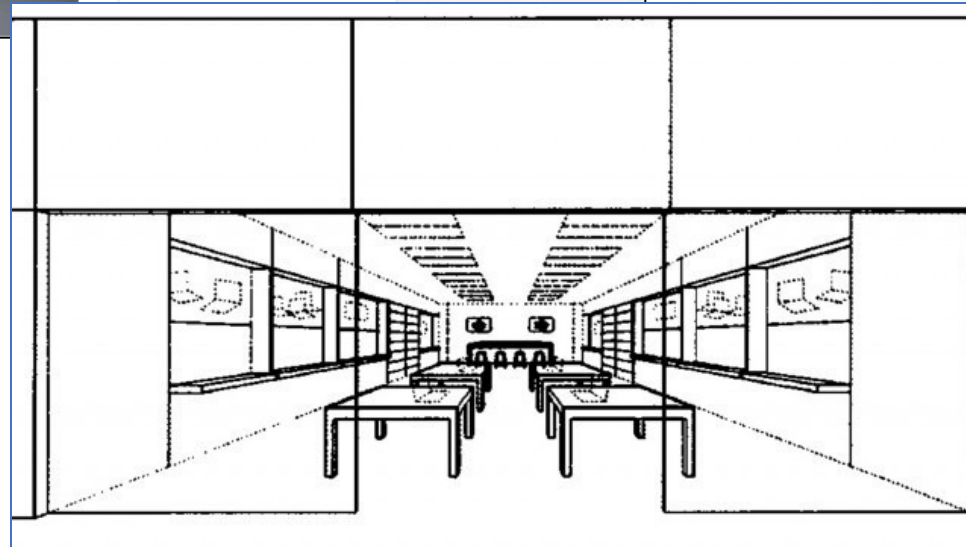
Ads by Google

- [Design - Ideas Wanted](#) - We Help Turn Ideas into Products No Cost Consultation - Start Today! [www.design.com](#)
- [Patent Your Idea](#) - Want to Profit from Your Idea? Patent It Before Someone Else Does! [www.patentyouridea.com](#)
- [Dashboard Best Practices](#) - Avoid Common Mistakes & Create Better Dashboards. Learn More! [logansayko.com/Dashboards](#)



What's Hot

- CHRIS B. GAZA & IZRAEL
Goodbye to Gaza: A Place of Hope Despite the Bombs
521 SHARES
- WATERCOOLER
If Jeff Goldblum Shows Up at Your Wedding, Expect Dinosaurs
877 SHARES







Tripp Trapp®

STOKKE®

United States of America

United States Patent and Trademark Office



Reg. No. 4,903,968
 Registered Feb. 23, 2016
 Int. Cl.: 28

TRADEMARK
 PRINCIPAL REGISTER

LEGO JURIS A/S (DENMARK CORPORATION)
 KOLDINGVEJ 2
 BILLUND DK-7190, DENMARK

FOR: TOY FIGURES; PLAY FIGURES; POSITIONABLE TOY FIGURES; MODELED PLASTIC TOY FIGURINES; THREE DIMENSIONAL POSITIONABLE TOY FIGURES SOLD AS A UNIT WITH OTHER TOYS; CONSTRUCTION TOYS; TOY CONSTRUCTION SETS, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

OWNER OF ERPN CMNTY TM OFC REG. NO. 000050450, DATED 4-18-2000, EXPIRES 4-1-2016.

OWNER OF U.S. REG. NO. 4,520,327.

THE MARK CONSISTS OF THE THREE-DIMENSIONAL CONFIGURATION OF A TOY FIGURE FEATURING A CYLINDRICAL HEAD, ON TOP OF A CYLINDRICAL NECK, ON TOP OF A TRAPEZOIDAL TORSO OF UNIFORM THICKNESS, WITH FLAT SIDES AND A FLAT BACK, WHERE ARMS ARE MOUNTED SLIGHTLY BELOW THE UPPER SURFACE OF THE TORSO, ON TOP OF A RECTANGULAR PLATE, ON TOP OF LEGS WHICH BULGE FRONTWARDS AT THE TOP AND ARE OTHERWISE RECTANGULAR WITH UNIFORM THICKNESS, ON TOP OF FLAT SQUARE FEET.

SEC. 2(F).

SER. NO. 86-537,461, FILED 2-17-2015.

ELLEN B. AWRICH, EXAMINING ATTORNEY



Nichelle K. Lee
 Director of the United States
 Patent and Trademark Office



BBC Sign in News Sport Weather Shop Earth Travel More Search

NEWS

Home Video World US & Canada UK Business Tech Science Magazine Entertainment & Arts Health More

Europe France Election 2017

ADVERTISEMENT

LOVE ORGANIC? AQUA CARPATICA Experience WATERLOVE

Europe court rules Lego figures are 'protected shape'

16 June 2015 | Europe Share

ADVERTISEMENT

Expedia DAILY DEALS

Lego registered the trademark in 2000 but it has been challenged by its competitors

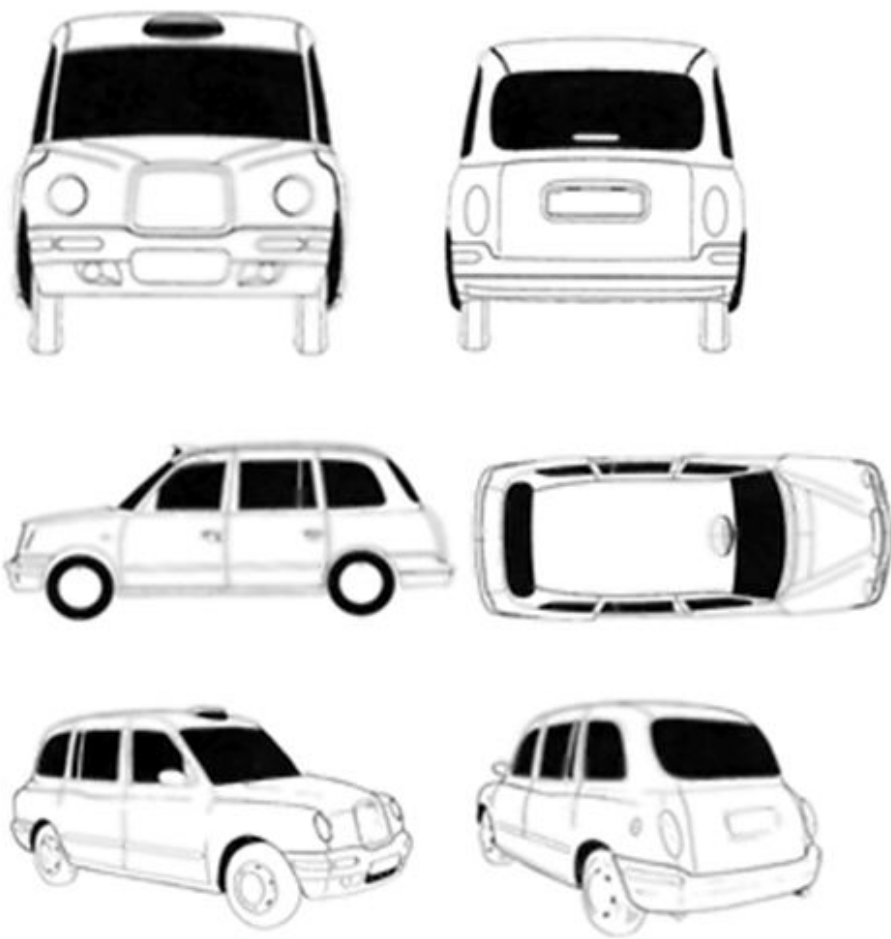
The shape of Lego's figures is a protected trademark and therefore cannot be copied, an EU court has ruled.

Competitor Best Lock, who makes similar toys, had challenged Lego's attempt to protect the shape of its human figures.

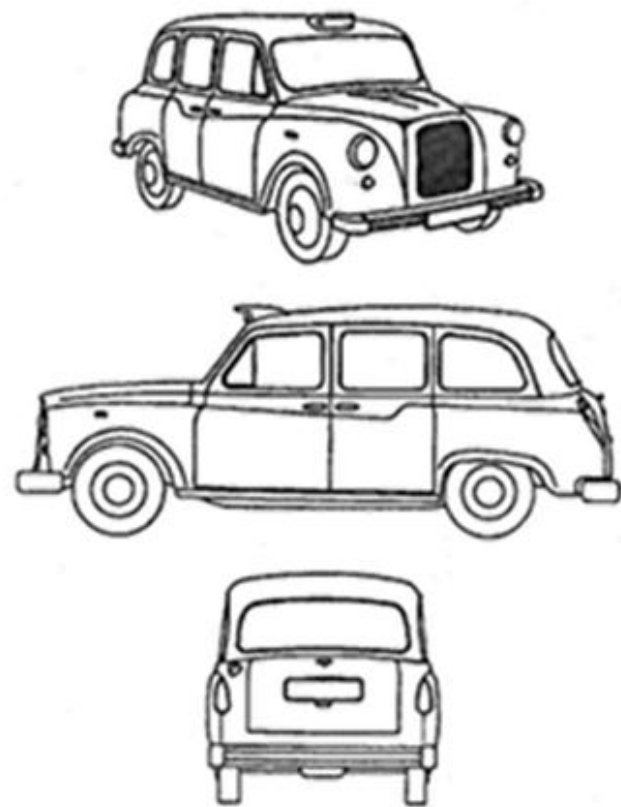
But the appeal was dismissed on Tuesday by the General Court of the European

- #### Top Stories
- UK PM: We must leave EU single market
Theresa May sets out UK hopes for Brexit talks, warning that "no deal is better than a bad deal".
45 minutes ago
 - Putin: Trump memos 'utter nonsense'
40 minutes ago
 - 'Wrong Ivanka' hits back at Trump
7 hours ago





LTC's UKTM



LTC's EUTM

Gucci's Repeating GG
Pattern/Diamond Motif Trade Dress



Guess's Quattro G Pattern





WALT DISNEY
ANIMATION STUDIOS



United States of America

United States Patent and Trademark Office

NON-VISUAL PLAY-DOH SCENT MARK

Reg. No. 5,467,089

Registered May 15, 2018

Int. Cl.: 28

Trademark

Principal Register

Hasbro, Inc. (RHODE ISLAND CORPORATION)
1027 Newport Avenue
Pawtucket, RHODE ISLAND 02862

CLASS 28: Toy modeling compounds

FIRST USE 9-12-1955; IN COMMERCE 9-12-1955

The mark is a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough

SEC.2(F)

SER. NO. 87-335,817, FILED 02-14-2017



Andrei Iancu
Director of the United States
Patent and Trademark Office

© Microsoft | Translator Privacy | Legal
 Translator Help
 Microsoft® is not responsible for the content below
 Powered by Microsoft® Translator

Translate URL: <http://www.markenblog.de/2011/10/04/farb/> German (Auto-Detected) English Views

Translated 100% Mouse over text to see original This page differs from the original Go to original page

MarkenBlog

BRAND LEGAL HODGEPODGE


HOME IMPRINT NEWS IN BRIEF TRADEMARK SEARCH

Search on this blog... Go

Brand color: Red (HKS 13)


Like 0 Tweet 3 Share 2

Posted by [Stefan Fuhrken](#) October 4, 2011



Register number: 30211120
 Status: Registered
 Type: color mark
 Enforced
 Collective mark

Filing date 07.02.2002
 Registration date July 11, 2007
 Owner: German Sparkassen - und Giroverband EV.
 Source: Patent



Most read

- So, there we have the salad!
- Eagle brand reloaded
- The Eagle should go away - deletion requests against German brands
- #Helmgate - hopefully no #tattoogate
- LG Düsseldorf: Unfounded trademark cease and desist letter

Looking for is: Archive

The brand of the year 2013
 End of the world (30%, 102 votes)

We are the people (26%, 88 votes)

Knud (25%, 84 votes)

GroKo (7%, 22 votes)

Select Month

A year before

- 2013-08-05: MontagMarken of 31 KW
- 2013-08-05: "We are the city" - Leipzig makes it like Apple
- 2013-08-05: The number of the day



OUR STORY

THE FINEST VODKA IS UNTOUCHED. NATURALLY SMOOTH.

Highest quality potatoes and rye corn is distilled four times into a neutral grain spirit and blended with pristine water from Newfoundland, Canada. The liquid is then filtered seven times, of which three are through layers of some precious crystals known as herkimer diamonds.

THE CRYSTAL HEAD BOTTLE WAS DESIGNED WITH A PURE SPIRIT IN MIND.

Dan Aykroyd and John Alexander wanted to craft a vessel worthy of one of the world's purest vodkas. A symbol of life, reflecting power and enlightenment, to hold their award-winning white spirit of super-natural purity.

Crystal Head contains no additives. No glycerol, citrus oils or sugars. Nothing is added to enhance or mask the taste.

NOTHING BUT PURE SPIRIT.



USE YOUR HEAD... DRINK RESPONSIBLY

United States of America

United States Patent and Trademark Office



Reg. No. 4,043,730
Registered Oct. 25, 2011
Int. Cl.: 33

GLOBEFILL INCORPORATED (CANADA CORPORATION)
309 ALFRED STREET
KINGSTON, ONTARIO, CANADA K7L3S4

FOR: ALCOHOLIC BEVERAGES, NAMELY, VODKA, IN CLASS 33 (U.S. CLS. 47 AND 49).
FIRST USE 9-0-2008; IN COMMERCE 9-0-2008.

TRADEMARK
PRINCIPAL REGISTER

THE MARK CONSISTS OF A CONFIGURATION OF A DOTTLE IN THE SHAPE OF A SKULL. THE BOTTLE CAP IS SHOWN IN DOTTED LINES AND IS NOT A PART OF THE MARK.

SER. NO. 77-967,530, FILED 3-24-2010.
SARA BENJAMIN, EXAMINING ATTORNEY



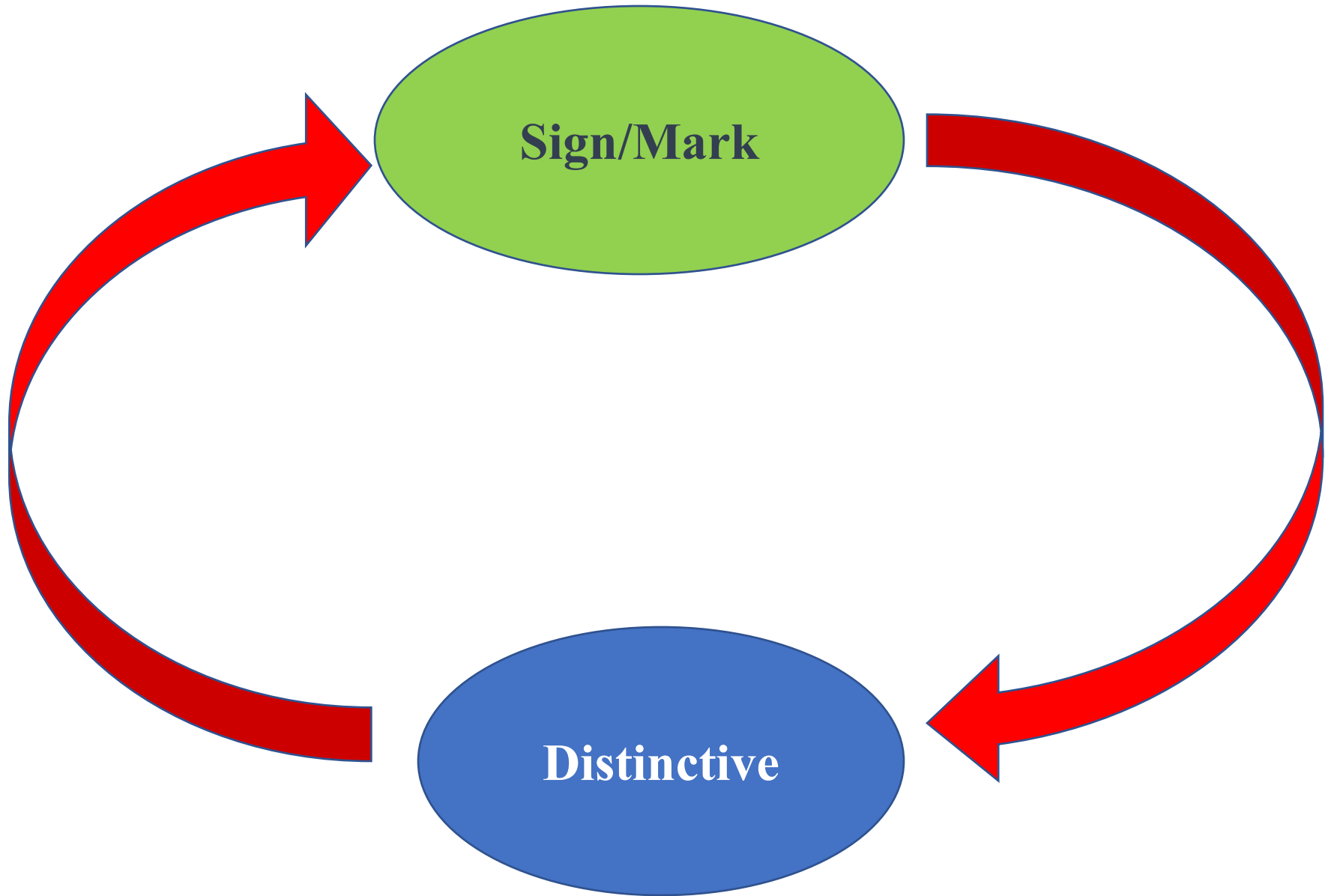
15K-0003

Why non-traditional trademarks?

Very broad definition of what type of signs can be protected as trademarks

Low threshold of the concept of trademark distinctiveness

Advantages of trademark protection



Sign/Mark

Distinctive

TRIPs Art. 15: Any sign ... capable of distinguishing [products], ***shall*** be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, ***shall*** be eligible for registration as trademarks. ... *Members may require, as a condition of registration, that signs be visually perceptible.*

Singapore Treaty on Trademarks (WIPO) allows (even though it does not impose) for the registration of non-conventional marks such as holograms, scent marks, sound marks, motion marks and three-dimensional (“3D”) marks.

What Can Be Protected as a Mark?

EU Trade Mark Directive *Article 3 (2015)*

Signs of which a trade mark may consist

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are **capable of:**

- (a) **distinguishing** the goods or services of one undertaking from those of other undertakings; and
- (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

What Can Be Protected as a Mark?

EU Trade Mark Directive *Article 3*

Signs of which a trade mark may consist

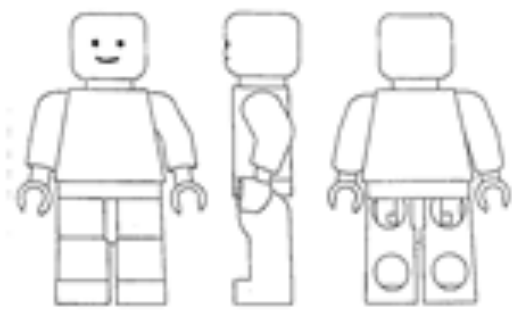
A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- (a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

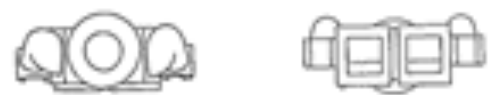
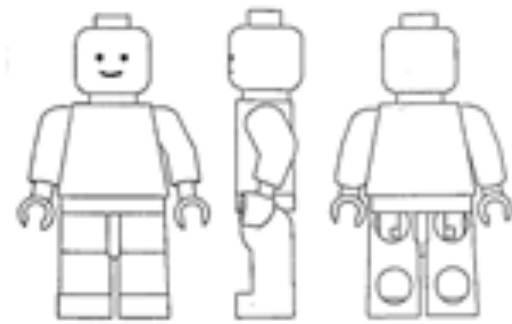
EU Trade Mark Directive *Article 2*

Signs of which a trade mark may consist

A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.



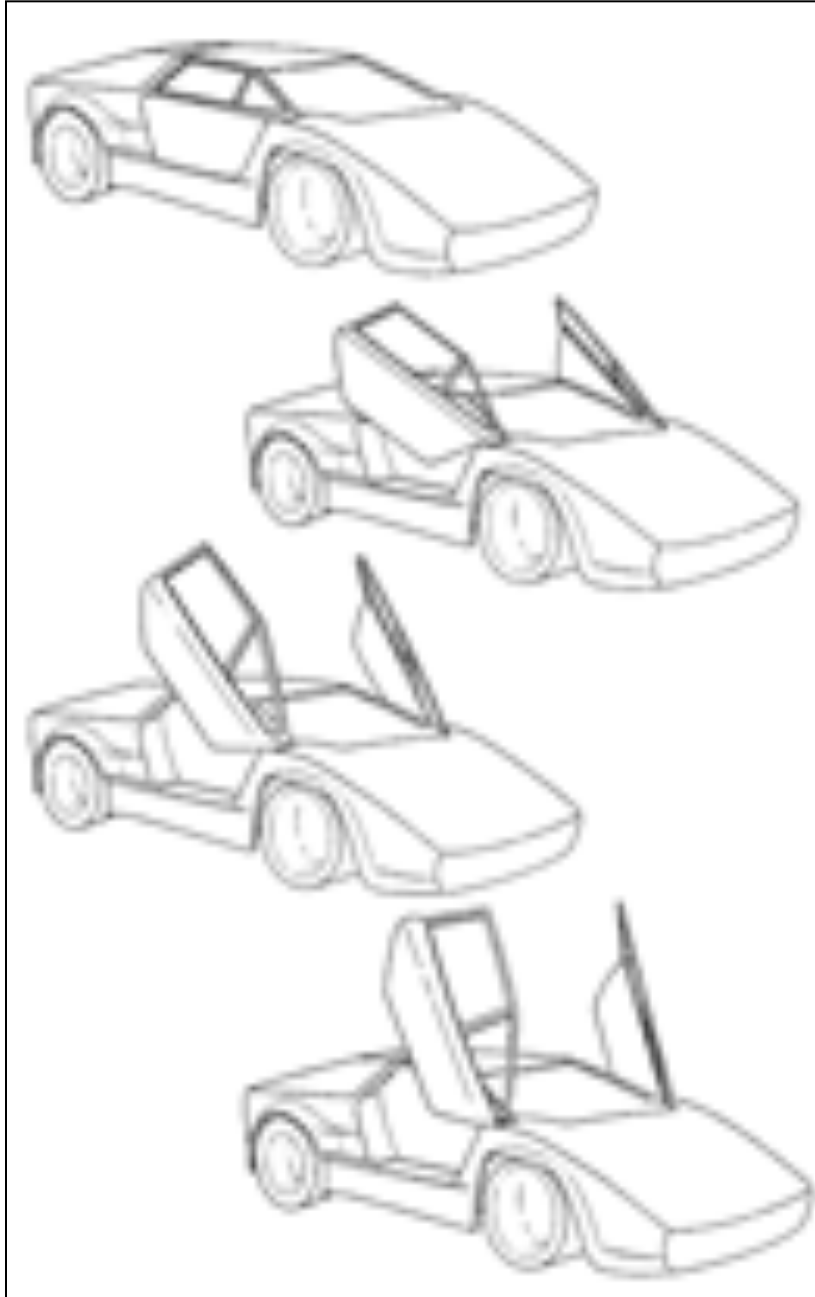
CTM-50518



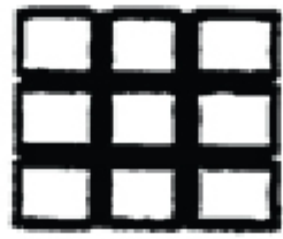
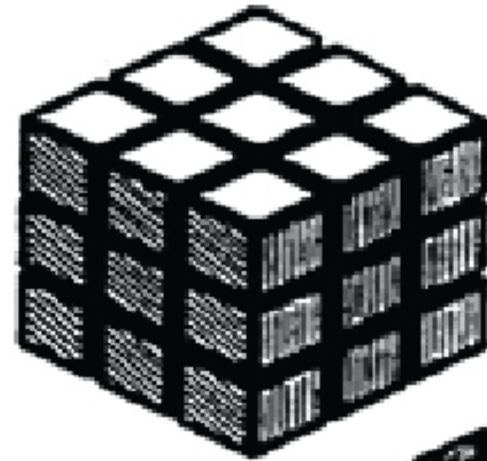
CTM-50450



C-421/13, *Apple Inc. v Deutsches Patent- und Markenamt*

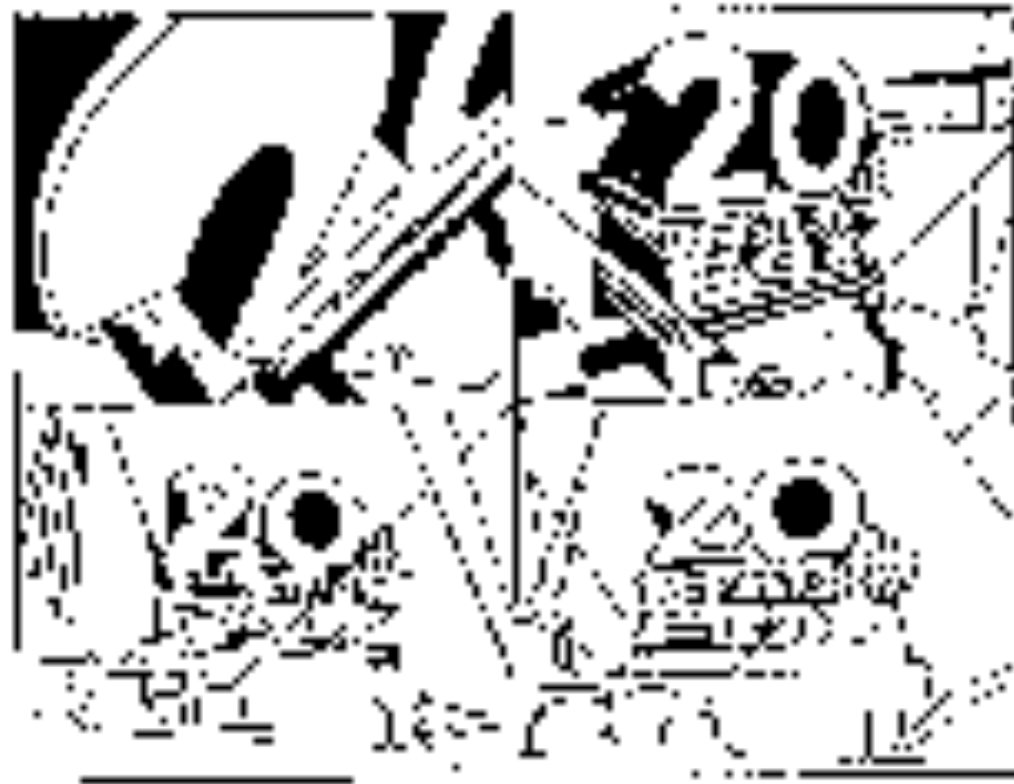


Lamborghini
moving image
for car doors
opening and
turning upward.



What Can Be Protected as a Mark?

- Lanham Act (15 U.S.C. §1127):
 - Trademarks: [any] word, name, symbol, or device, or any combination thereof, used in commerce to **identify** and **distinguish** “products” and to indicate source
- Restatement (Third) of Unfair Competition (1995):
 - “A trademark is a word, name, symbol, device, or other designation ... that is **distinctive** of a person’s goods or service and that is used in a manner that identifies those goods and distinguishes them from th[ose] of others ...”



USPTO TM 1.928.424: computer generated sequence showing the central element from several angles as though a camera is moving around the structure. The drawing represents four “stills” from the sequence.



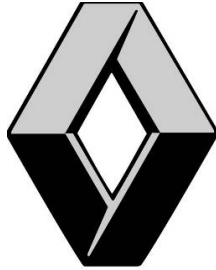
USPTO TM 1.975.999; moving image of a flash of light from which rays of light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by a lady on a pedestal. The word “COLUMBIA” appears across the top running through the torch and then a circular rainbow appears in the sky encircling the lady.





- Most signs are capable to be registered and be protected as trademarks as long as they are **distinctive, not functional**, and the **markholder has priority based on use or registration**
 - Words, including descriptive words and popular phrases
 - Names, including the names of historical figures
 - Symbols
 - Colors, including single colors
 - Product packaging
 - Product configurations
 - Retail store designs and restaurant décor
 - Look and feel of a website
 - Other non-traditional marks such as sounds, scents, tastes, textures, holograms, and movements
 - Artistic works currently or formerly protected by copyright
 - Designs currently or formerly protected by patent

Figurative Trademark



Word Trademark

ADIDAS

PHILIPS

JUST DO IT

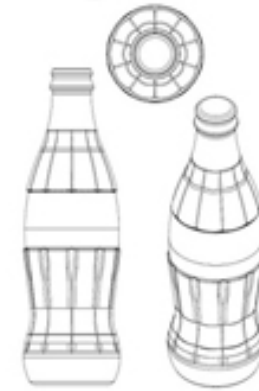
VOLVO

Combined Trademark





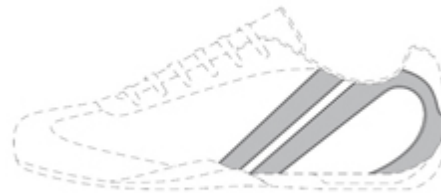
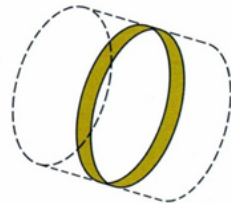
Shape Mark



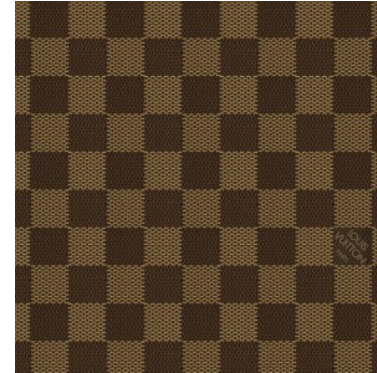
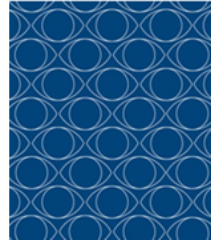
Shape Mark containing word elements



Position mark



Pattern mark



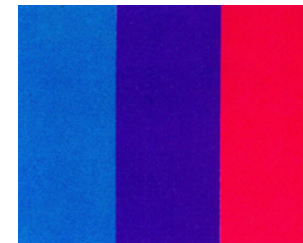
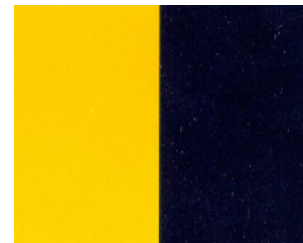
Color (single) mark



PANTONE
1837



Colour (combination) mark

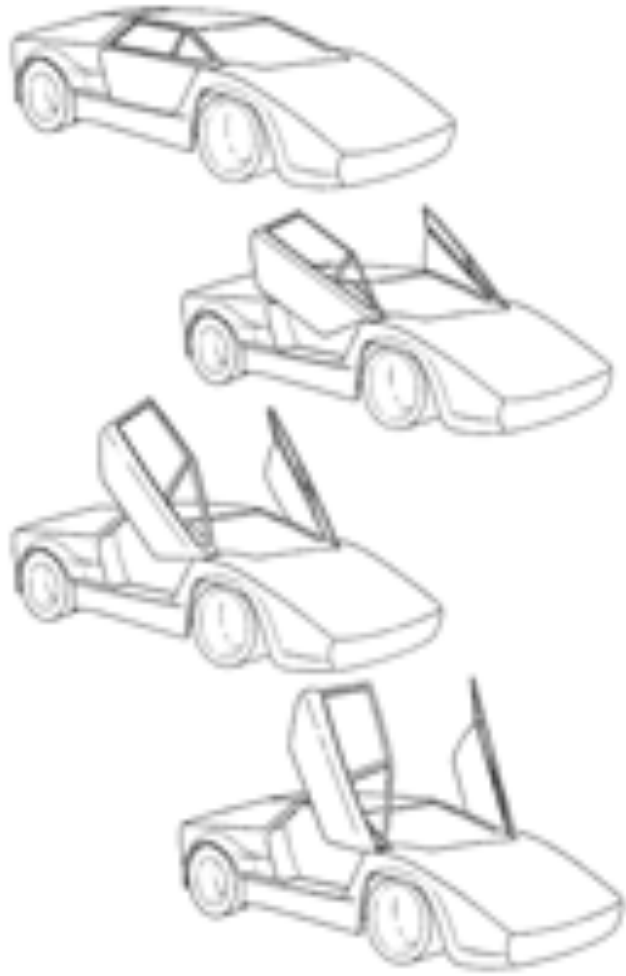


Advantages of trademark protection

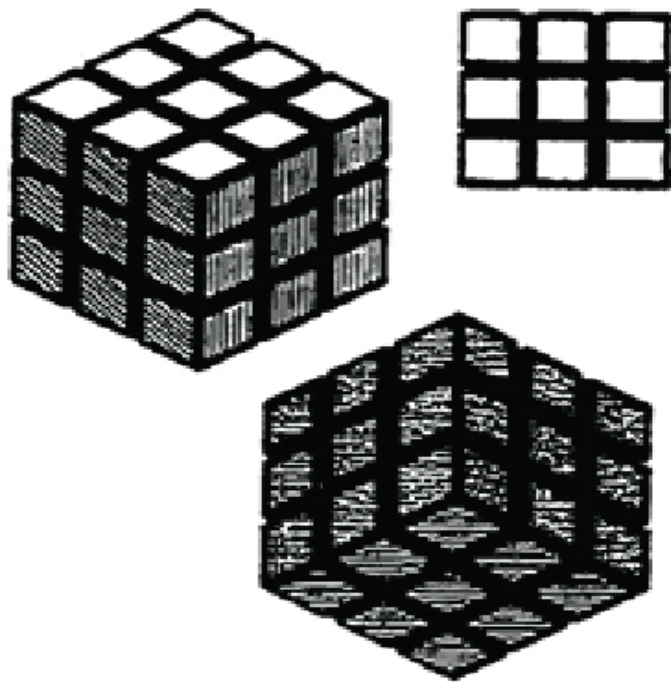
Potentially perpetually protection (as long as the signs are in use)

Additional layer of protection in addition to other forms of IP protection

Are Non-Traditional Marks Necessary?



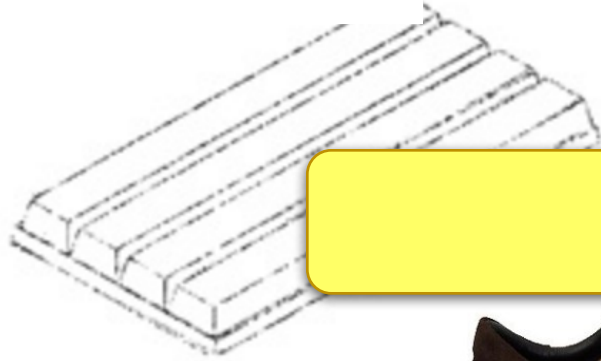
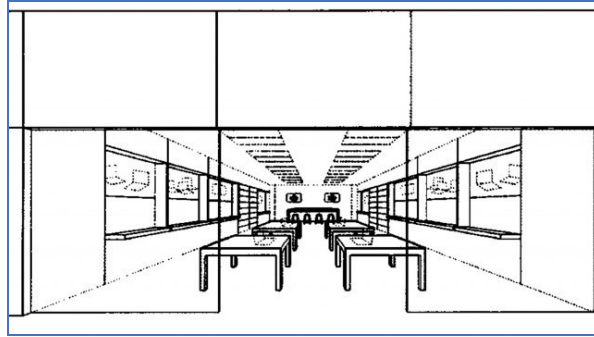
Are Non-Traditional Marks Necessary?



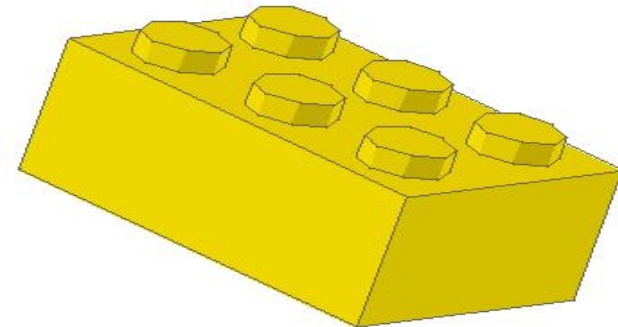


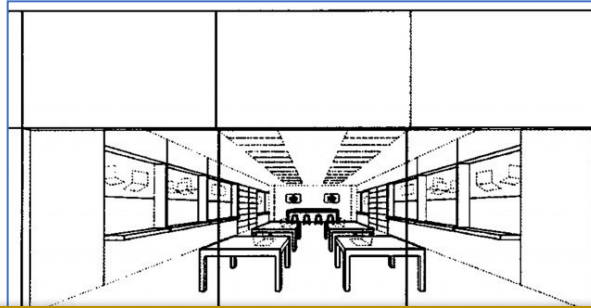
Are Non-Traditional Marks, marks in the “traditional” sense of the term “mark” as distinctive sign in the course of trade?



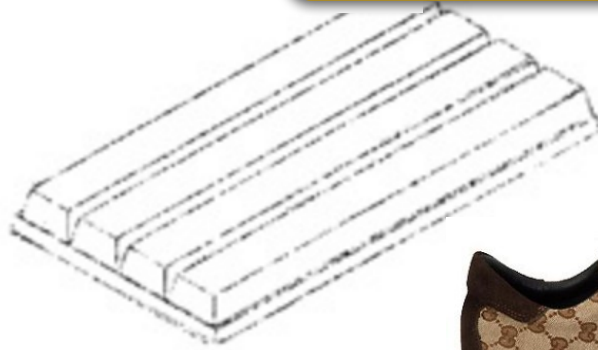


Distinctive?

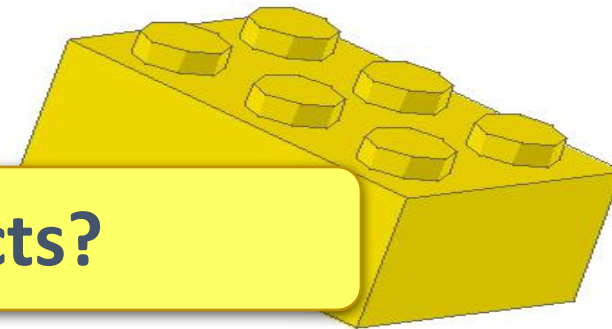




Distinctive Signs of Trade?



Distinctive Designs?



Distinctive Products?



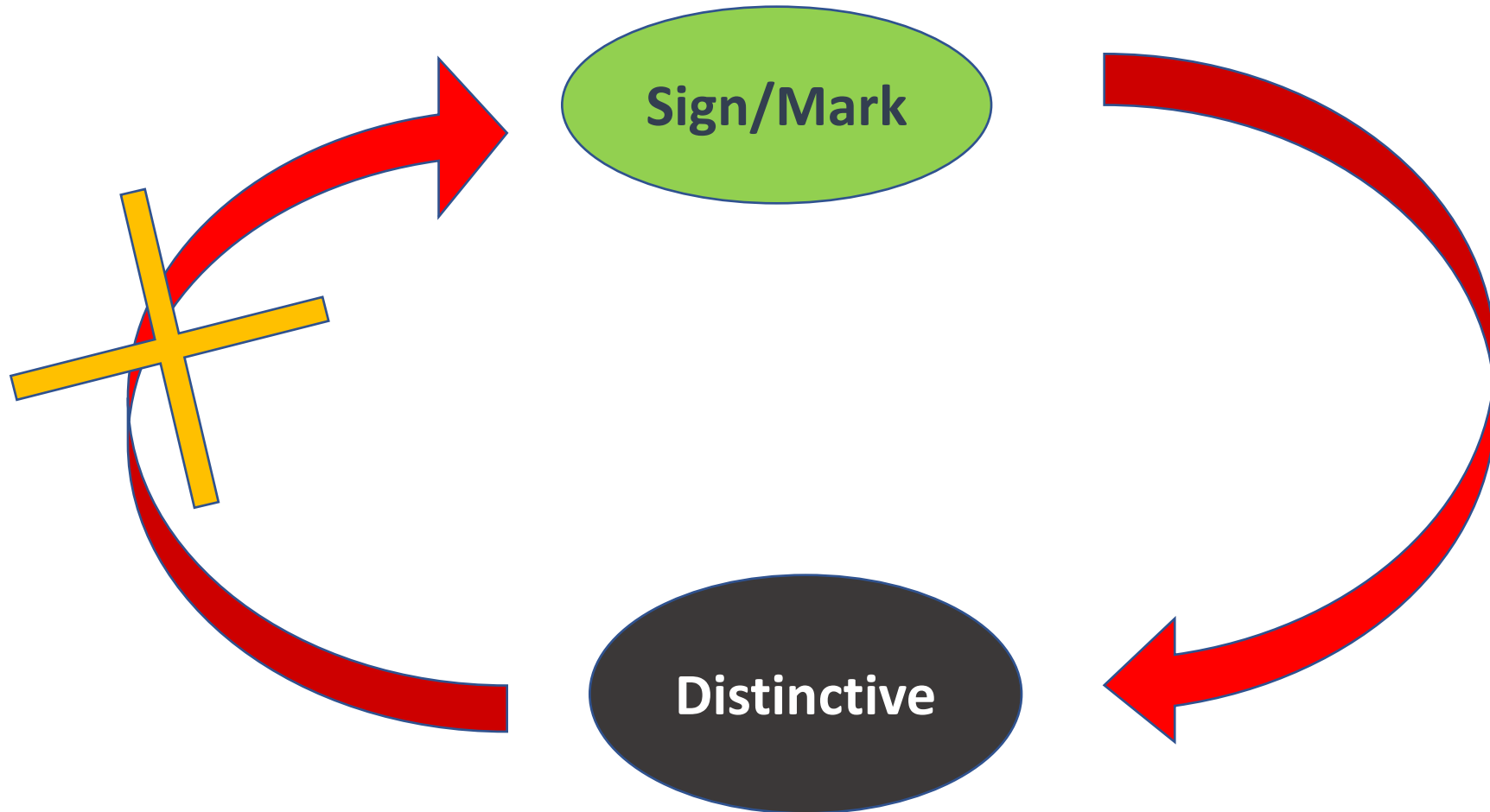
Distinctive Signs of Trade?

Distinctive Designs?

Distinctive Products?



Limitations to Protectable Subject Matter



Absolute Grounds in the EU (art 4 TMD)

no registration for signs that comprise of a shape, or another characteristics

- Resulting from the nature of the goods
- That is necessary to obtain a technical result
 - Utilitarian functionality
- That gives substantial value to the goods
 - “A sort of” aesthetic functionality



What Cannot Be a “Mark” in the US

- Lanham Act § 2(e)(5)
 - No trademark ... shall be refused registration ... unless it –
 - (e) Consists of a mark which, ... (5) **comprises any matter that, as a whole, is functional**
- BUT the Lanham Act does not define what is a “functional mark”
- The interpretation of what is “functional” in the context of trademark rests primarily within the courts
- The doctrine of functionality started primarily as a judicial doctrine
 - Utilitarian Functionality
 - Aesthetic Functionality

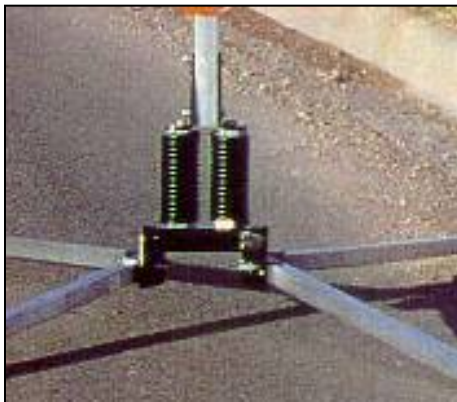
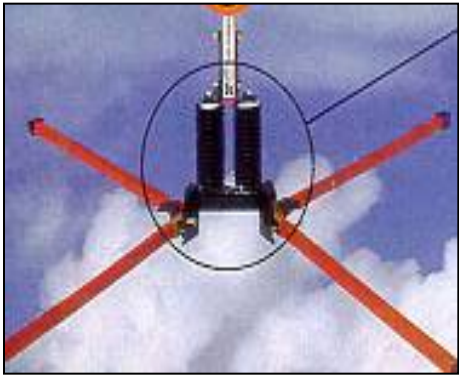
Utilitarian Functionality in US

- *Inwood Laboratories Inc. v. Ives Laboratories*, 436 US 844 (1982)
 - A “product feature is functional if it is essential to the **use** or **purpose** of the article or if it affects the **cost** or **quality** of the article” (utilitarian functionality)
- Factors to consider to assess utilitarian functionality (*In Re Morton Norwich Products Inc.*, 671 F2d 1332 (Fed. Cir. 1982)
 - **Existence** of a **utility patent** which discloses the **utilitarian advantage** of the design
 - Whether the **originator** of the **design** promotes the **utilitarian advantages** of the product through advertising
 - Whether there are **alternative designs available**
 - Whether the **design** is **more economical** than an **alternative** design



Utilitarian Functionality

TrafFix Devices, Inc. v. MDI Inc., 532 U.S. 23 (2001)



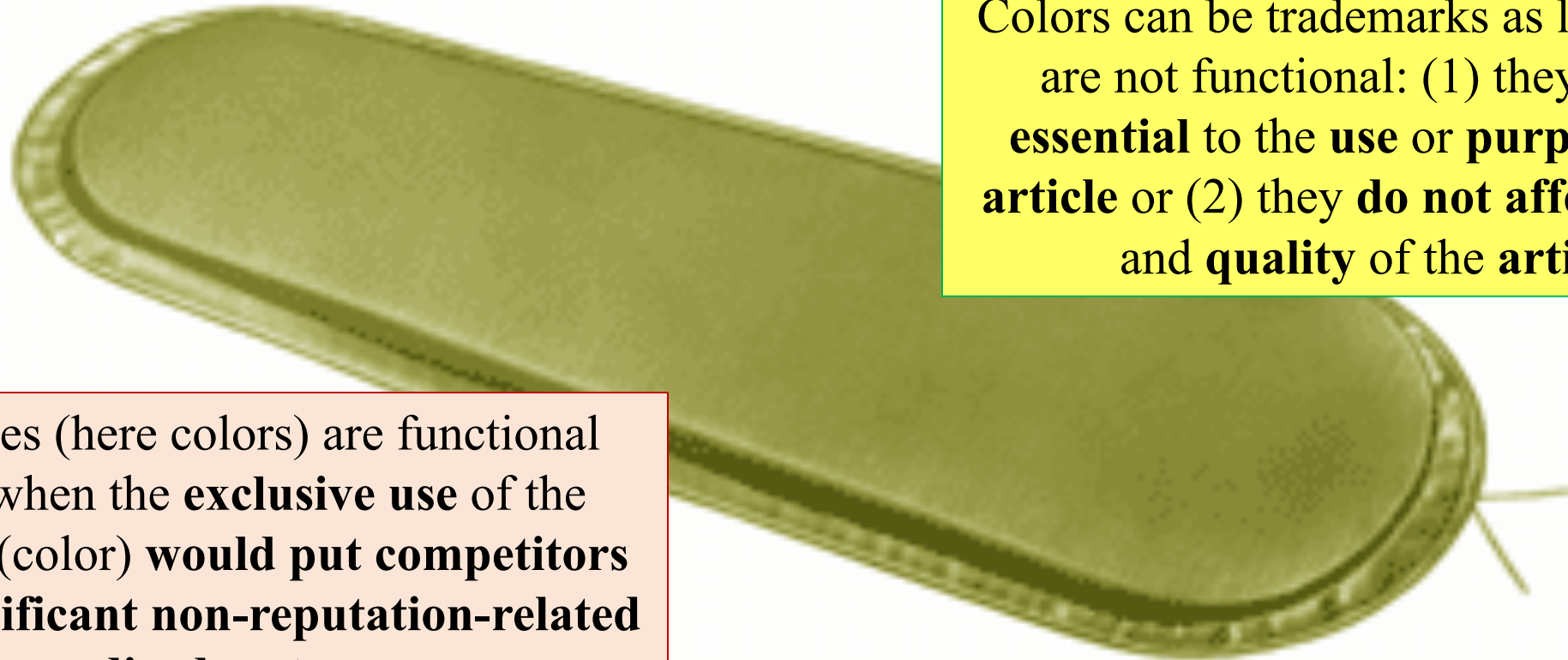
A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise ... **one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.”**

Aesthetic Functionality in US

- The Restatement (Third) of Unfair Competition (1995) S.17, cmt (c) confirmed the doctrine (possibly narrowing its scope):
 - “A design is functional because of its aesthetic value **only if it confers a significant benefit that cannot practically be duplicated by the use of alternative designs.**”
- BUT, there is still no clarity on:
 - How to separate utilitarian and aesthetic functionality
 - Whether every design feature should comply with both parts of the *Qualitex* test:
 - **Essential to the product/affect the quality and price**
 - **Would put competitors at a significant non-reputation-related disadvantage**

Aesthetic Functionality: the Evolution

Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995)



Colors can be trademarks as long as they are not functional: (1) they are **not essential** to the **use** or **purpose** of the **article** or (2) they **do not affect** the **cost** and **quality** of the **article**”

Features (here colors) are functional only when the **exclusive use** of the feature (color) **would put competitors** at a **significant non-reputation-related disadvantage**

Problems with Aesthetic Functionality

- Is the use of the mark below affecting the product quality and price?
- Is the use of the mark below putting competitors at a significant non-reputation-related disadvantage?

BMW is the source, but could an “extreme” interpretation of the doctrine justify a finding of aesthetic functionality?



Inconsistencies in Judicial Decisions on Non-Traditional Trademarks

Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc., 696 F.3d
206 (2d Cir. 2012)



Christian
Louboutin



YSL

Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc., 696 F.3d

206 (2d Cir. 2012)

- Louboutin produces high-end footwear, which nearly always features a bright-red lacquered outsole
- Louboutin applied for and received a trademark for the red sole in 2008
- In 2011, YSL released a series of shoes in a monochrome theme utilizing various color, including red. Louboutin filed an action in district court alleging numerous claims under the Lanham Act including infringement and trademark dilution.
- Louboutin also asked for a preliminary injunction preventing YSL from marketing the red monochrome shoes or any other shoe resembling Louboutin's red sole



Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc., 696 F.3d
206 (2d Cir. 2012)

- The district court held against Louboutin, denying the injunction and holding that in the fashion industry, “single-color marks are inherently ‘functional’ and that any such registered trademark would likely be held invalid.”
- Louboutin appealed to the Second Circuit.
- The Court of Appeals concluded that the red sole mark merited protection because it has acquired distinctiveness (it symbolized the Louboutin brand and distinguished from competitors). But the court narrowed the Louboutin’s trademark to situations when the red sole is matched with a contrasting upper (“When the red sole is a distinctive symbol”).



DC: The use of red outsoles serves non-trademark functions other than as a source identifier, and affects the cost and quality of the shoe; awarding one designer a monopoly on the color red would impermissibly hinder competition.

2d Cir.: *Qualitex* held that single color can operate as a trademark upon a showing of secondary meaning.



Christian Louboutin v. Van Dalen Footwear BV (Brussels Court of Appeal, 18
November 2014, 2014/AR/843)



Christian
Louboutin

Christian Louboutin v. Van Dalen Footwear BV (Brussels Court of Appeal, 18

November 2014, 2014/AR/843)

- Louboutin had brought the case against Van Dalen Footwear BV, a Netherlands-based shoe company, for allegedly infringing its registered trademark in the Benelux region. However, the Belgian court granted the counterclaim and ruled that the red sole could not be trademarked under European law.
- The decision was primarily based on the judge's determination that the trademark constituted a shape mark, rather than a color mark. A shape mark cannot be registered under European trademark law if it gives substantial value to goods, a provision which exists to prevent a company monopolizing a technical, functional or aesthetic quality. In this case, as the red sole was held to be a shape mark which gave substantial value to Louboutin shoes, the trademark was declared invalid.
- The Brussels District Court declared the trademark void in Belgium, Netherlands and Luxembourg.

BREAKING: CJEU rules that Louboutin red sole mark does NOT fall within absolute ground for refusal

👤 Eleonora Rosati Tuesday, June 12, 2018 - absolute grounds, CJEU, Louboutin C-163/16, red sole mark, shapes, substantial value, trade marks

Is the Louboutin red sole mark a valid trade mark or not? At last - the moment all IP aficionados were waiting for has come!

The Court of Justice of the European Union (CJEU) has just issued its much-awaited judgment in *Louboutin C-163/16*, ruling that **a mark consisting of a colour applied to the sole of a shoe is NOT covered by the prohibition of the registration of shapes**. Such a mark does not consist 'exclusively of the shape'.

The question that the Rechtbank Den Haag referred to the CJEU was the following:



The Louboutin mark

“ *Is the notion of ‘shape’ within the meaning of Article 3(1)(e)(iii) of [the 2008 Trade Mark Directive, ie the absolute ground for refusal concerning signs consisting exclusively of “the shape which gives substantial value to the goods”] (‘Form’, ‘vorm’ and ‘forme’ in the German, Dutch and French language versions of the Trade Marks Directive respectively) limited to the three dimensional properties of the goods, such as their contours, measurements and volume (expressed three-dimensionally), or does it include other (non three-dimensional) properties of the goods, such as their colour? ”*

As readers will remember, this case has featured: a **first Opinion** of Advocate General (AG) Szpunar **[reported by The IPKat here]**; the reopening of the oral procedure and the assignment of the case to the Grand Chamber, so that the CJEU would rule with a greater (13) number of judges than the ordinary chamber procedure (3 or 5 judges), on consideration of the topicality of the issues underlying this reference for a preliminary ruling; and a **second Opinion** of AG Szpunar **[which has sparked some controversy regarding its actual interpretation: see Katpost here]**.

THE IPKAT: INTELLECTUAL PROPERTY NEWS AND FUN FOR EVERYONE!



HOW MANY PAGE-VIEWS HAS THE IPKAT RECEIVED?

31,333,505

NOT JUST ANY OLD IPKAT ...

* "Most Popular Intellectual Property Law Blawg" of all time according to **Justia rankings**, 1 August 2018.

* "Most Popular Copyright Blawg" of all time according to **Justia rankings**, 1 August 2018.



* Recommended by the European Patent Office as reading material for candidates for the European Qualifying Examinations, 2013.

* Listed as "Top Legal Blog" in The Times Online, March 2011.

* One of the only two non-US blogs listed in the Blawg **2010 ABA Journal** 100.

* Court Reporter Top Copyright Blog award winner, November 2010.

* Number 1 in the 2010 **Top Copyright Blog** list compiled by the Copyright Litigation Blog, July 2010.

* Selected by United States Library of Congress for inclusion in its historic collections of Internet materials related to Legal Blawgs 2010.



press release:

“ In today's judgment, the Court takes the view that, since the trade mark directive provides no definition of the concept of 'shape', the meaning of that concept must be determined by considering its usual meaning in everyday language. The Court points out that it does not follow from the usual meaning of that concept that a colour per se, without an outline, may constitute a 'shape'.

Furthermore, while it is true that the shape of the product or of a part of the product plays a role in creating an outline for the colour, it cannot, however, be held that a sign consists of that shape in the case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product.

In the present instance, **the mark does not relate to a specific shape of sole for high-heeled shoes since the description of that mark explicitly states that the contour of the shoe does not form part of the mark and is intended purely to show the positioning of the red colour covered by the registration.**

The Court also holds that a sign, such as that at issue, cannot, in any event, be regarded as consisting 'exclusively' of a shape, where the main element of that sign is a specific colour designated by an internationally recognised identification code." ”

Gucci America Inc. v. Guess? Inc., 2012 BL 125350 (S.D.N.Y. 2012)

Original Gucci sneaker.



Gucci counterfeit? Nope, just a Guess infringement.



**Gucci vs. Guess Lawsuit Decision:
Gucci Wins \$4.66 Million, Ban On
Knock-offs**

Posted: 05/21/2012 6:48 pm Updated: 05/21/2012 9:46 pm



Gucci America Inc. v. Guess? Inc., 2012 BL 125350 (S.D.N.Y. 2012)

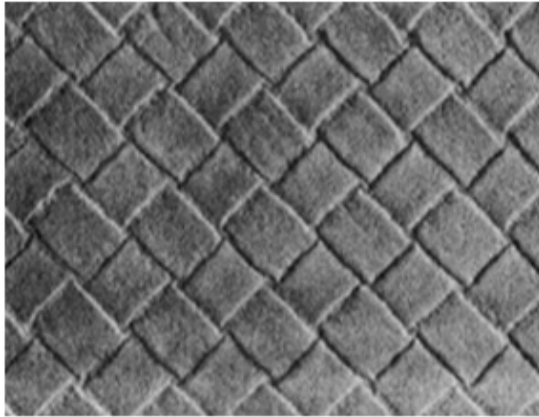
Guess could not show that it had a competitive need to use a similar design on its products.



Gucci's "Diamond Motif" is not functional:

A feature is considered to be ornamental if it is added purely for aesthetic reasons and serves no source-identifying purpose; **the "Diamond Motif" trade dress possesses strong secondary meaning**, both with consumers and within the trade in view of Gucci's evidence of (1) extensive advertising expenditures; (2) unsolicited media coverage; (3) sales success; and (4) exclusive use of the Diamond Motif Trade Dress for over fifty years.

- Guess wins in other countries:
 - In France, the court of Paris ruled in favor of Guess. The court rejected each of Gucci's claims of trademark infringement, counterfeit, and unfair competition. The court also invalidated three of Gucci's G European Community and International Trademarks, so that the Italian label can no longer claim exclusive use of those trademarks. The court ordered Gucci to pay Guess \$30,000 Euro. (<http://fashionista.com/2015/02/french-court-rejects-gucci-trademark-claims-against-guess-paris-france>)
 - In Italy, The District Court of Milan ruled in favor of Guess's claim seeking to nullify three of Gucci's registered trademarks in Milan. The court rejected the infringement claims filed by Gucci, ordered the cancellation of certain Gucci trademarks, and rejected its rights in the "Square G" logo. The decision was, however, partially overturned by the Milan Appeal Court, which found that whilst there had been no trademark infringement by Guess, the retailer was liable for unfair competition. In this instance, Guess was ordered to pay Gucci damages resulting from the unfair conduct. (<http://fashionista.com/2013/05/in-the-battle-of-gucci-vs-guess-italian-courts-side-with-guess-and-cancel-gucci-trademarks>).
 - Courts in China have also ruled in favor of Gucci

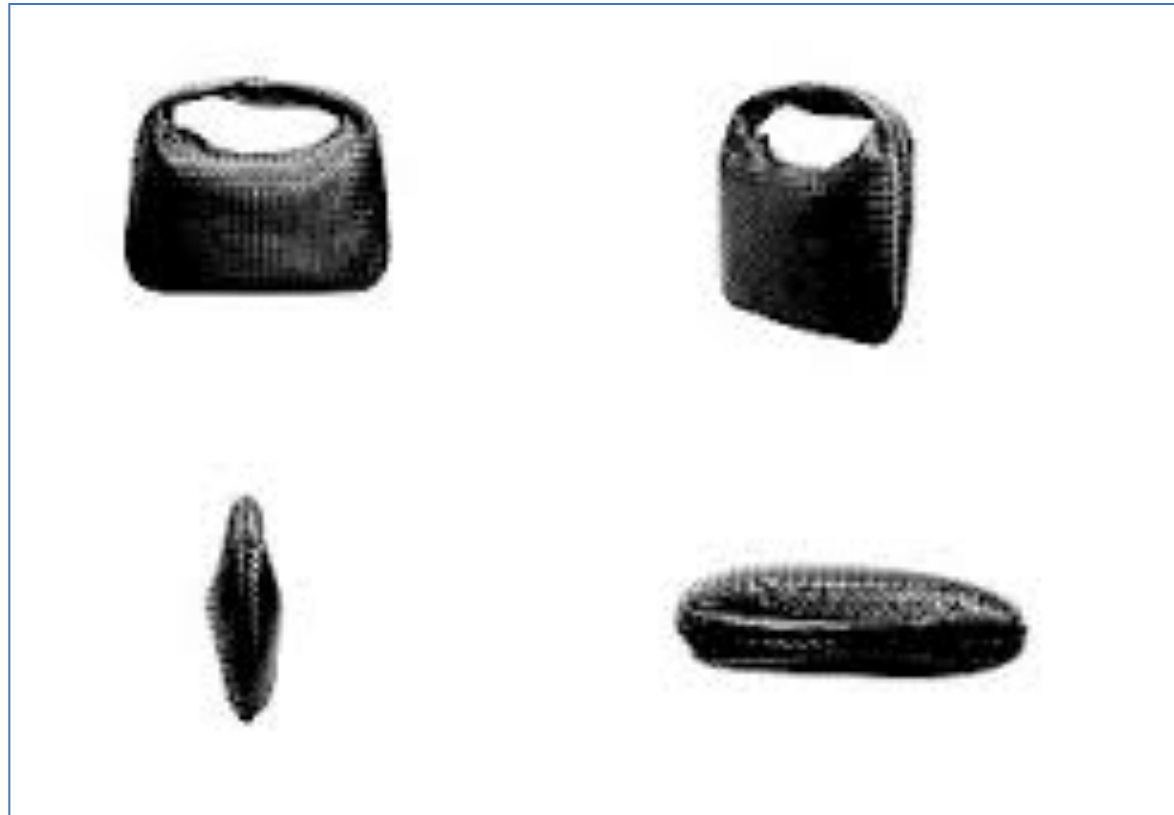


In re Bottega Veneta International Sarl
(Serial No. 77219184) TTAB

- Bottega Veneta secured the weave pattern trademark.
- The TTAB found that:
 - The trademark has come to be recognized by consumers as a source indicator for Bottega Veneta goods, and
 - Registering the mark would not have a significant effect on competition and, accordingly, a registration would not have a negative effect on the use of woven designs made from non-leather materials.
 - The scope of Bottega Veneta's protection only extends to identical or near-identical designs, which replicate each of the features.

Case T 409/10 Bottega Veneta International Sarl v. OHIM

- OHIM refused Bottega Veneta's applications on June 16, 2010.
- The General Court affirmed the OHIM's decision on March 22, 2013.



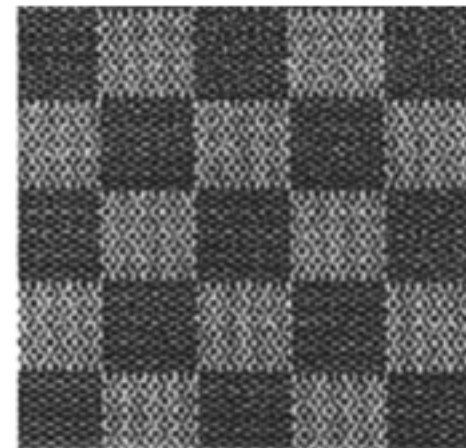
Case T 409/10 Bottega Veneta International Sarl v. OHIM

- OHIM refused Bottega Veneta's applications on June 16, 2010.
- The General Court affirmed the OHIM's decision on March 22, 2013.



Case T-359/12 and Case T-360/12, Louis Vuitton Malletier v. OHIM

- The EU General Court invalidated LV's Damier checkered patterns (black and grey, and brown and beige) were invalidated.
- The registrations were challenged by German retailer Nanu-Nana.
- The General Court held that the registrations were basic and banal, and lacked distinctive character.





Oberbank
3 Banken Gruppe

 Finanzgruppe
Deutscher Sparkassen-
und Giroverband



*Oberbank AG; Banco Santander SA; Santander Consumer Bank OG v.
Deutscher Sparkassen-und Giroverband eV (C-217/13 and C-218/13)*

- In the summer of 2015, the German Federal Patent Court decided that the registration of a special shade of red as a trademark for banking brands in Germany is not admissible.



Oberbank
3 Banken Gruppe



TOP STORIES MEDIA CENTER PROGRAM LEARN GERMAN

GERMANY WORLD BUSINESS SCI-TECH ENVIRONMENT CULTURE SPORTS

TOP STORIES / BUSINESS

LITIGATION

Rosetta Stone loses claim to yellow in court

A German court has ruled that the color yellow can be protected as a trademark. But it must be widely associated with a specific company. The case highlights just how important color alone can be for company branding.



Germany's top administrative court on Thursday rejected a claim by US software publisher Rosetta Stone to veto dictionary publisher [Langenscheidt's](#) exclusive registration of the color yellow as a trademark. Langenscheidt is a Munich-based publisher of yellow-bound bilingual dictionaries and other language-learning aids used by students of German in many nations.

[Rosetta Stone](#), which sells language-learning software in yellow cartons, was appealing an earlier verdict banning it from using yellow. Germany's federal high court has ruled last year that confused buyers wanting Langenscheidt products, might accidentally purchase Rosetta Stone's yellow bound



PICTURED: ROSETTA STONE V4 SPANISH AND OPTIONAL HEADSET

Langenscheidt v. Rosetta Stone
(case I ZR 228/12)



**Societe des Produits Nestle S.A. v.
Cadbury UK Ltd.**



Cadbury

Cadbury's attempt to trademark Dairy Milk purple blocked

Appeal court rules usage of colour was not specific enough and would give Cadbury unfair competitive advantage

Owen Bowcott, legal affairs correspondent

@owenbowcott

Friday 4 October 2013 09.42 EDT



Shares

180

Save for later



Cadbury commissioned a dress made of 1,000 Dairy Milk wrappers to celebrate the colour - Pantone 2685C - at London fashion week. Photograph: Advert

Cadbury has lost a five-year court battle to register a distinctive shade of purple as a trademark for its chocolate bars.

Lawyers for rival Nestlé managed to overturn a previous judgment that would have prevented other manufacturers from wrapping their products in the same Dairy Milk tone.

The row revolved around a specific shade of purple - defined as Pantone 2685C - which the Birmingham-based manufacturer maintains it has used since the first



Nestlé

KitKat goes unprotected as European court rejects trademark case

Nestlé failed to convince European court of justice that four-fingered version of its chocolate bar should be protected by law

Sean Farrell

Wednesday 16 September 2015
10.28 EDT



Shares Comments

1,082 211



Nestlé argued that even without its red and white packaging the shape of the four-fingered KitKat should be regarded as distinct. Photograph: Roger Tooth for the Guardian

Nestlé has failed in an attempt to convince European judges to let it trademark the shape of the four-finger version of a KitKat in the UK.

The European court of justice ruled that the KitKat's shape was not distinctive enough for consumers to associate it with the chocolate covered wafer. Nestlé is not seeking to trademark its two-fingered version of KitKat.

Nestlé had argued that even without its red and white packaging or the word KitKat embossed on the chocolate, the shape of the bar should be regarded as distinct.

The dispute between Nestlé and Cadbury, which has fought to prevent Nestlé

Advertisement

wework virgin atlantic

AND GET A MONTH OF WEWORK COMMONS MEMBERSHIP FREE

book now >

*Restrictions apply



Societe Des Produits Nestle SA and Another v. International Foodstuffs Co. and Others (100/2014), (2014 ZASCA 187); (2015 1 All SA 492 (SCA) (27 November 2014)





Societe Des Produits Nestle SA and another v.
Petra Foods Ltd. and another (2016 SGCA)



Societe Des Produits Nestle SA and another v.
Petra Foods Ltd. and another (2016 SGCA)



- The Singapore Court of Appeal held as follows:
- (i) The Shape Marks lacked inherent distinctiveness and had not acquired distinctiveness.
- (ii) The Shape Marks were not registrable under s 7(3)(b) of the TMA as each essential feature was necessary to obtain a technical result.
- (iii) Even if the Shape Marks were validly registered, they were never put to genuine use and the Shape Marks are liable to be revoked for non-use under s22(1) of the TMA.
- (iv) Since the Shape Marks were not registrable under s7 of the TMA, they could not be protected as well-known trade marks.

Court of Appeal confirms London Taxi Company's trade mark for the shape of the "black cab" is invalid

Gowling WLG



United Kingdom | November 16 2017

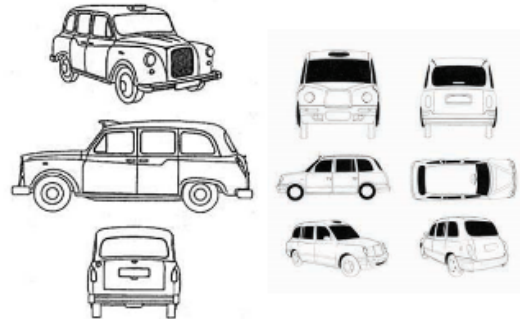
The trade marked three-dimensional shape of the traditional London taxi has been found invalid by the Court of Appeal of England and Wales.

The London Taxi Company (LTC), successor in title to the manufacturer of various London taxi models, sued Ecotive and Frazer Nash Research Limited (FNR) for trade mark infringement and passing off based on goodwill in the shapes of the Fairway, TXI, TXII and TX4 London taxi models. Ecotive and FNR are the manufacturers of the "Metrocab", a new hybrid taxi.

Ecotive and FNR denied infringement and challenged the validity of the trade marks, contending that they lack distinctive character and consist exclusively of the shape giving substantial value to the goods.

The Trade Marks

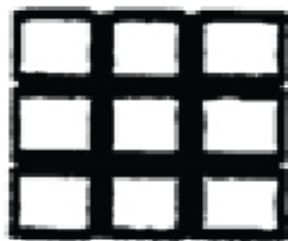
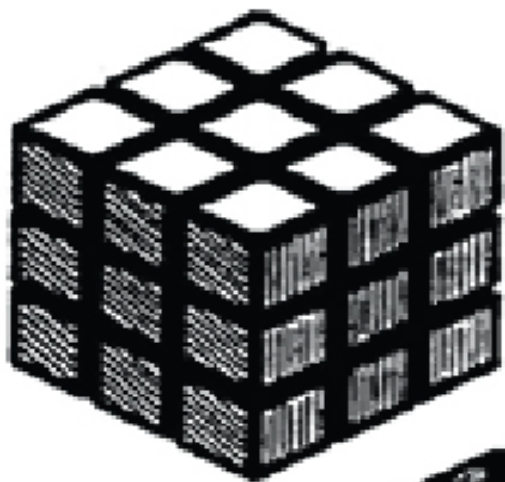
On 5 October 1998, London Taxi Company ("LTC") registered a Community trade mark (as shown below on the left) for "motor vehicles" in Class 12, consisting of a three-dimensional mark influenced by the appearance of the Fairways taxi model. LTC also registered a UK trade mark based on the TXI and TXII taxi models on 1 December 2006, for taxis in class 12 (as shown below on the right).



The Defendants' Metrocab at the centre of the dispute is shown below:



Simba Toys GmbH & Co. KG v.
OHIM (Case T-450/09)



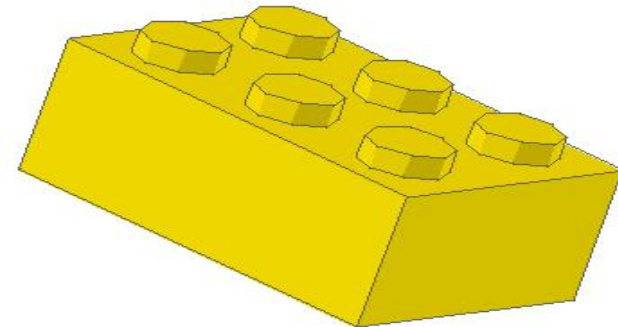
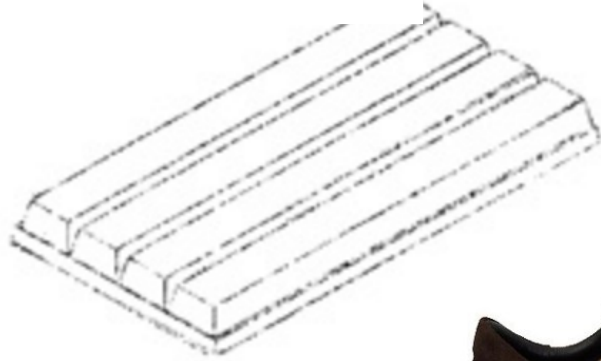
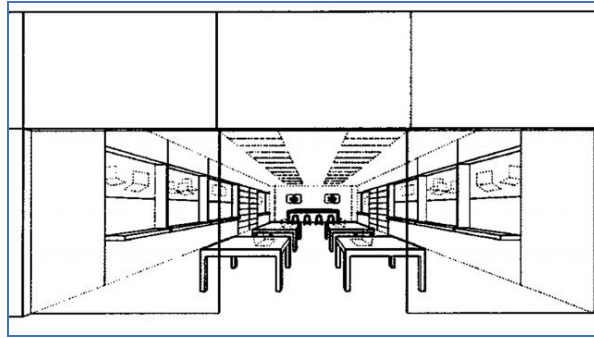
Simba Toys GmbH & Co. KG v EUIPO (Judgment in Case C-30/15 P)

- Simba Toys appealed to the Court of Justice
- In November 2016, the CJEU found that **the essential characteristics of the cubic shape must be assessed in the light of the technical function of the actual goods represented.**
- The General Court should have considered the non-visible elements of the graphic representation of the shape, such as the rotating capability of the three-dimensional ‘Rubik’s Cube’-type puzzle.
- The CJEU **annulled the EUIPO decision that confirmed registration of the shape in question as an EU trade mark.**
- It will be a matter for EUIPO to adopt a new decision taking into account the findings set out by the Court in the present judgment.



What can we derive from these often inconsistent decisions?

What role can Ip offices and trademark examiner play in the registration process on non traditional trademarks?



A crucial role for trademark offices

- Comparison between
 - safeguards against erosion of freedom of competition
 - safeguards against erosion of freedom of expression
- New insights (hopefully)



FREEDOM OF COMPETITION



IS VERDER KIJKEN

Problem: mark/product dichotomy





COUNTERMEASURES



VU  **VRIJE
UNIVERSITEIT
AMSTERDAM**

IS VERDER KIJKEN

**CJEU, 12 February 2004,
case C-218/01, Henkel**

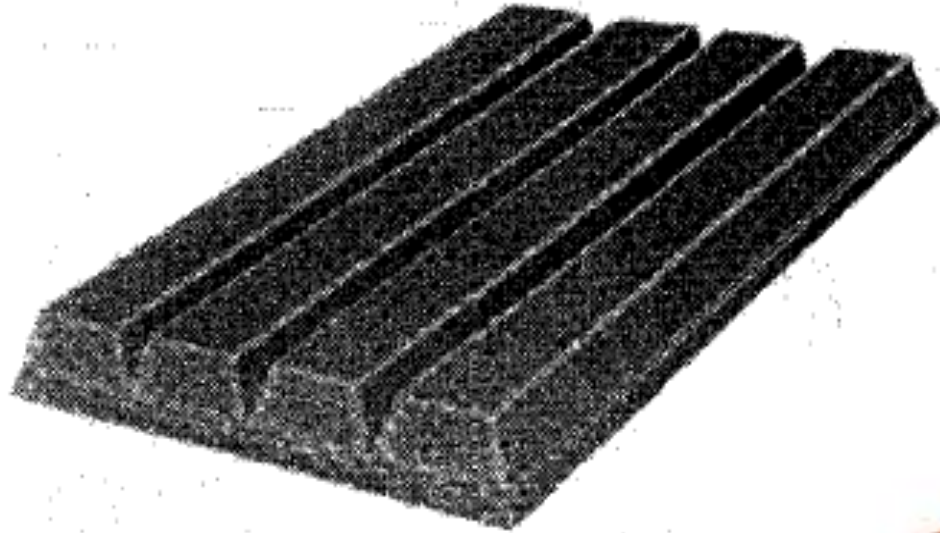


- more difficult to establish distinctiveness
‘Average consumers are **not in the habit of making assumptions about the origin of goods** based on the shape of their packaging...’ (para. 52)
- confirmed in CJEU, 4 May 2017, C-417/16 P, August Storck/EUIPO, para. 34

Acquisition of secondary meaning

- possible, but proof that shape *alone* identifies particular origin of goods
 - CJEU, 16 September 2015, case C-215/14, Nestlé/Cadbury, para. 66
 - UK Court of Appeal, 17 May 2017, case [2017] EWCA Civ 358, Nestlé/Cadbury, para. 98 and 108: ‘whether the mark [...] has acquired the ability to demonstrate exclusive origin...’

CJEU, 25 July 2018, C-84/17 P, C-85/17 P and C-95/17 P, Nestlé/Mondelez



CJEU, 25 July 2018, C-84/17 P, C-85/17 P and C-95/17 P, Nestlé/Mondelez

- unitary character of EUTM: in principle, proof necessary for each Member State
- ‘...does not follow from that finding that, where a mark is devoid of inherent distinctive character throughout the European Union, it is sufficient [...] to prove that it has acquired distinctive character through use in a significant part of the European Union, even though such evidence has not been provided in respect of every Member State.’ (para. 78)

CJEU, 12 February 2004, case C-218/01, Henkel

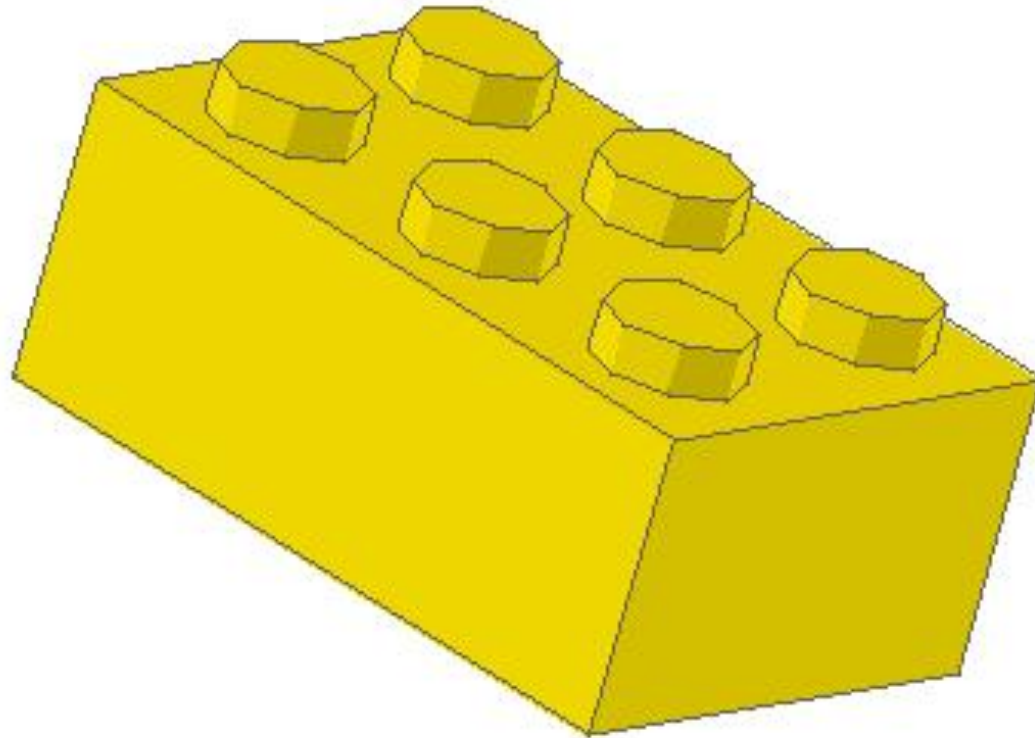
- remaining loophole: inherent distinctive character
- conceivable if the shape is special

‘...a simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal given in Article 3(1)(b) of the Directive. In contrast, a trade mark which significantly departs from the norm or customs of the sector [...] is not devoid of distinctive character.’ (para. 49)

Utilitarian functionality in the EU



Utilitarian functionality in the EU



CJEU, 14 September 2010, case C-48/09 P, Lego/OHIM (Mega Brands)

- result: technical know-how remains free after patent expiry
- costs: risk of confusion/unfair free riding?

‘In the present case, it has not been disputed that the shape of the Lego brick has become distinctive in consequence of the use which has been made of it and is therefore a sign capable of distinguishing the appellant’s goods from others which have another origin.’ (para. 40)

Aesthetic functionality in the EU



Tripp Trapp®

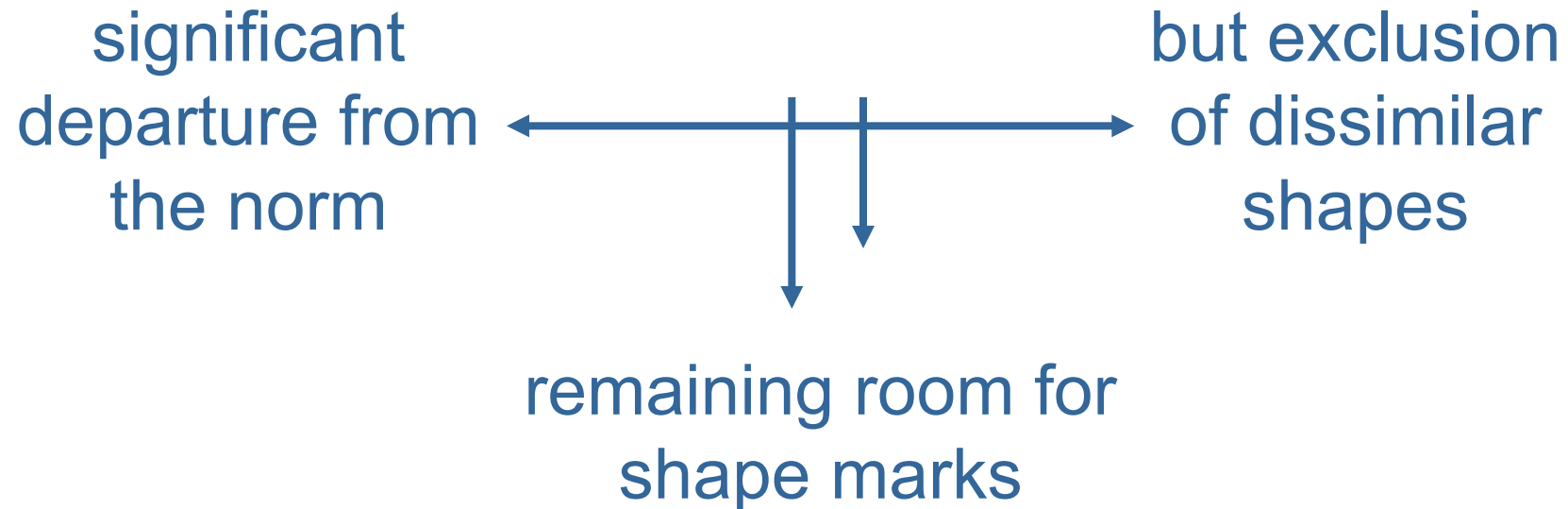
STOKKE®

CJEU, 18 September 2014, case C-205/13, Hauck/Stokke

- substantial value shapes: competition and limited term rationale
- catalogue of essential characteristics
 - nature of the category of goods concerned
 - artistic value of the shape in question
 - dissimilarity from other shapes in the market
 - substantial price difference
 - promotion strategy accentuating aesthetic characteristics (para. 35)

Still room for shape marks?

- CJEU Henkel: the shape must be special (otherwise not distinctive)
- CJEU Hauck/Stokke: shape must not be special (otherwise functional)





CLOSED ESCAPE ROUTES



VRIJE
UNIVERSITEIT
AMSTERDAM

IS VERDER KIJKEN

Broad application of functionality doctrine

- figurative 2D representation of 3D mark does not help
 - CJEU, 4 May 2017, case C-417/16 P, August Storck/EUIPO, para. 36
 - GCEU, 8 May 2012, case T-416/10, Pi-Design and Bodum/Yoshida, para. 24
- decorative elements do not help, unless they play an important role in the shape
 - CJEU, 11 May 2017, case C-421/15 P, Yoshida/EUIPO (Pi-Design), para. 30

Broad application of functionality doctrine

- schematic graphical representation does not help, function of actual goods decisive
 - CJEU, 10 November 2016, case C-30/15 P, Simba Toys/EUIPO (Seven Towns), para. 47
- qualification as abstract colour mark or position mark does not help
 - Opinion AG Szpunar I, 22 June 2017, case C-163/16, Louboutin, para. 65-66
 - Opinion AG Szpunar II, 6 February 2018, case C-163/16, Louboutin, para. 34 and 42

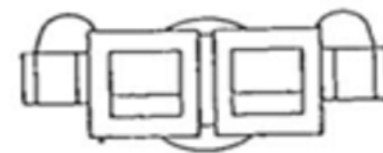
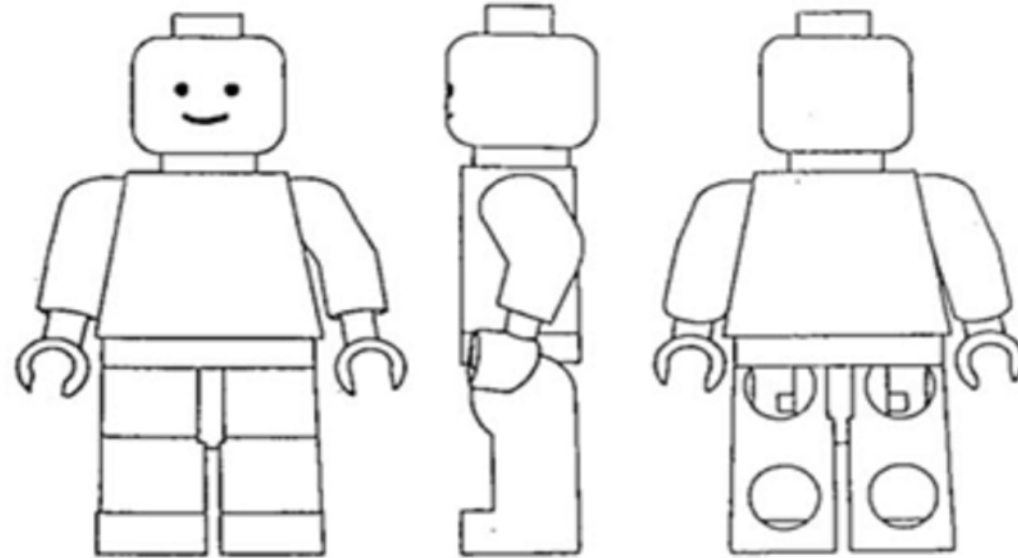


OPEN ESCAPE ROUTES



IS VERDER KIJKEN

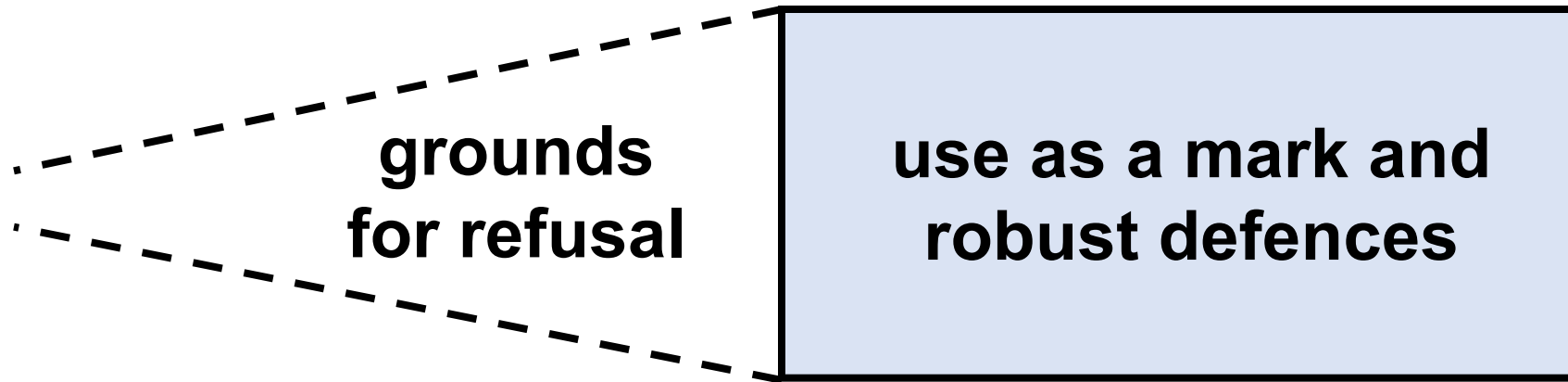
CJEU, 14 April 2016, case C-452/15 P, Best-Lock/EUIPO (Lego)



No mix of functionality grounds

- requirement of 100% nature/technical/aesthetic functionality
 - CJEU, 18 September 2014, case C-205/13, Hauck/Stokke, para. 43
 - CJEU, 16 September 2015, case C-215/14, Nestlé/Cadbury, para. 48
- confirmed at the national level
 - Dutch Supreme Court, 27 November 2015, case ECLI:NL:HR:2015:3394, Hauck/Stokke, para. 3.2.4

In sum: strict access control



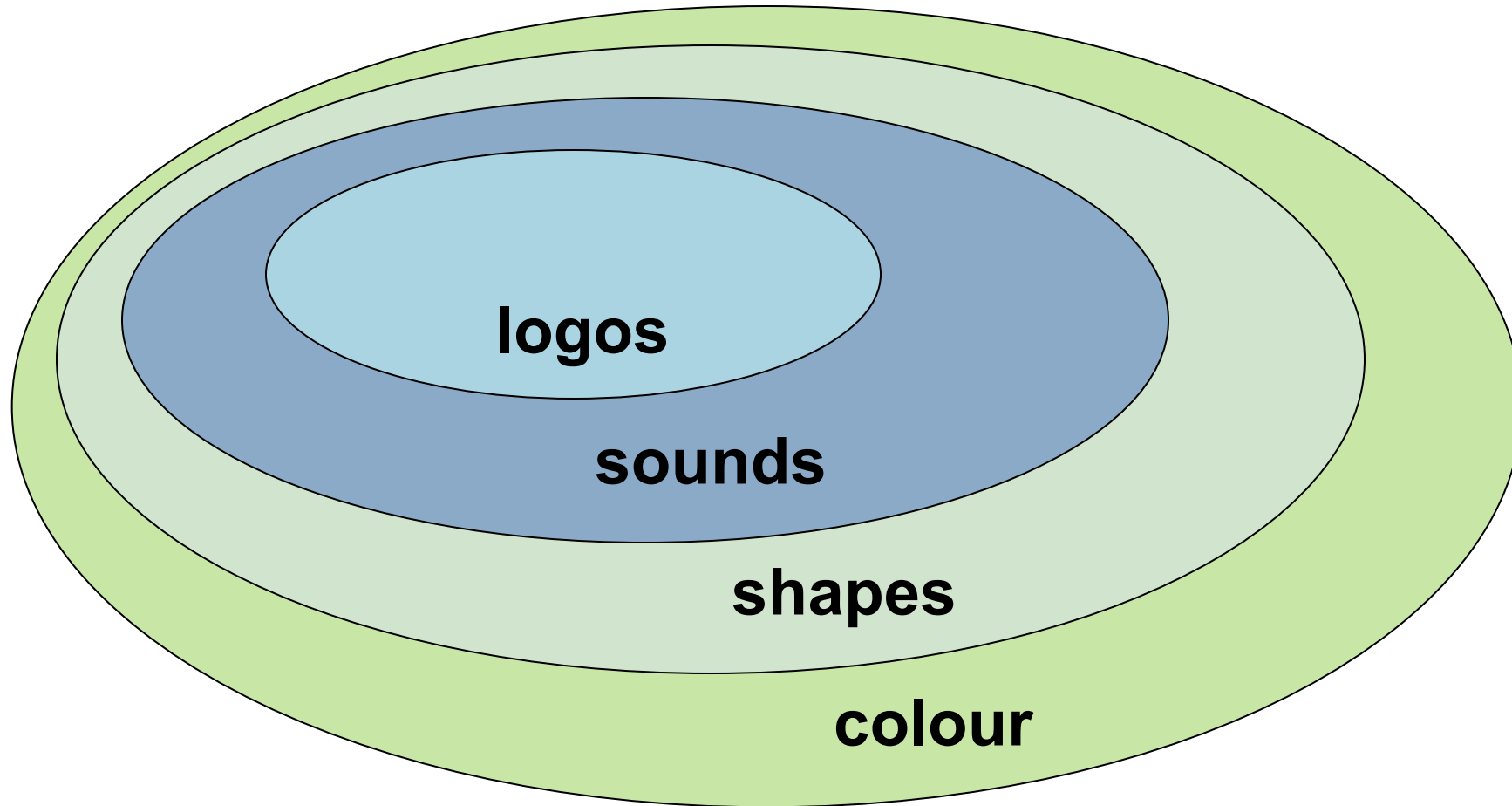


FREEDOM OF EXPRESSION



IS VERDER KIJKEN

Problem: copyright/trademark overlaps



CJEU, case C-283/01, Shield Mark/Kist



‘I find it more difficult to accept [...] that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys.’

(Opinion A-G Colomer, 3 April 2003, para. 52)

EFTA Court, 6 April 2017, case E-5/16,
Vigeland

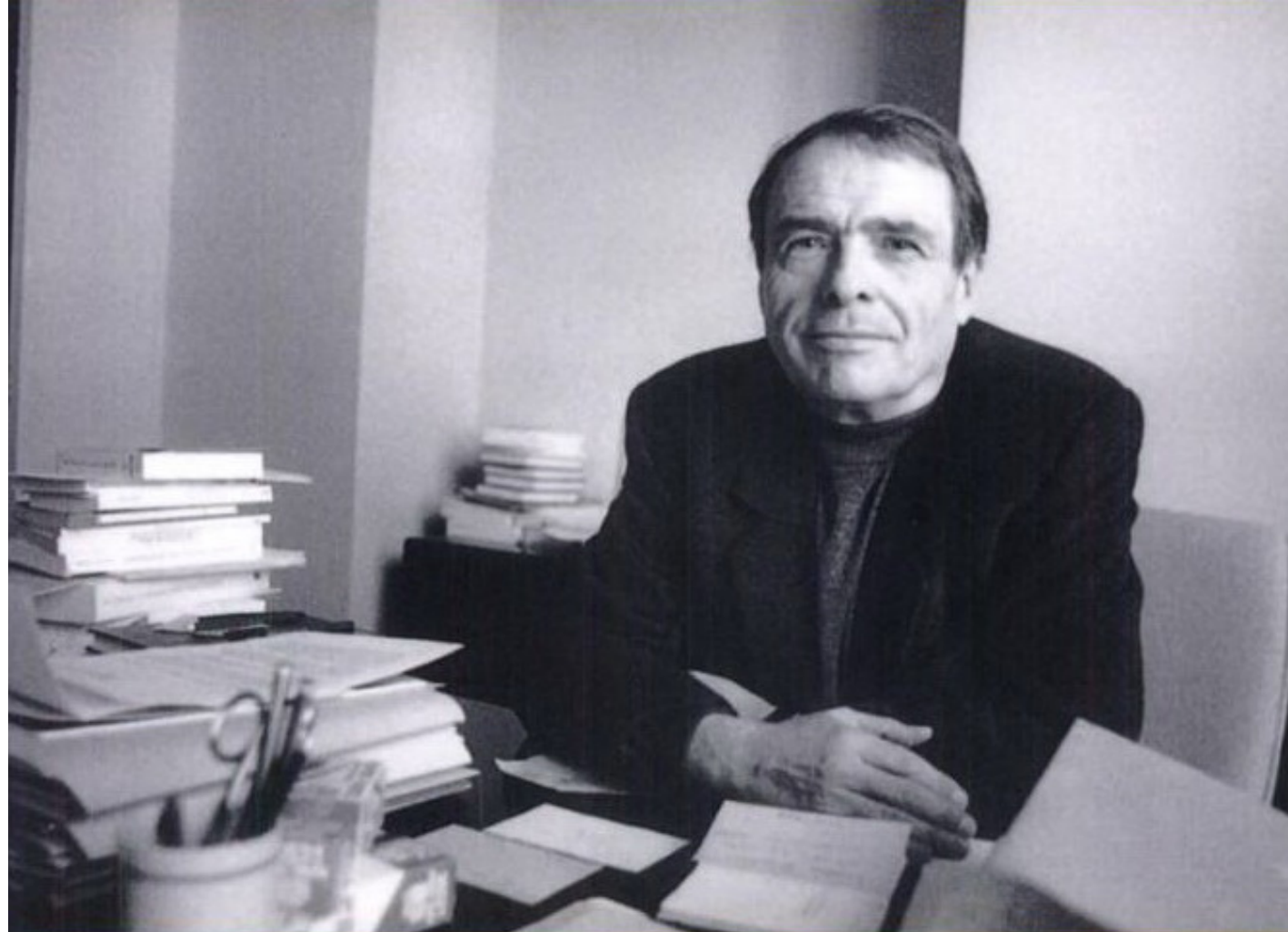


- applicant: city of Oslo
- argument: investment in reputation

Risks

- impediment of the cultural inspiration cycle
 - artificial creation of protection or extension of the term of protection
 - deterrent effect of trademark rights
 - intentional or unintentional censoring of derivative works
- loss of sources of inspiration
 - redefinition and devaluation of building blocks of new creations in commerce

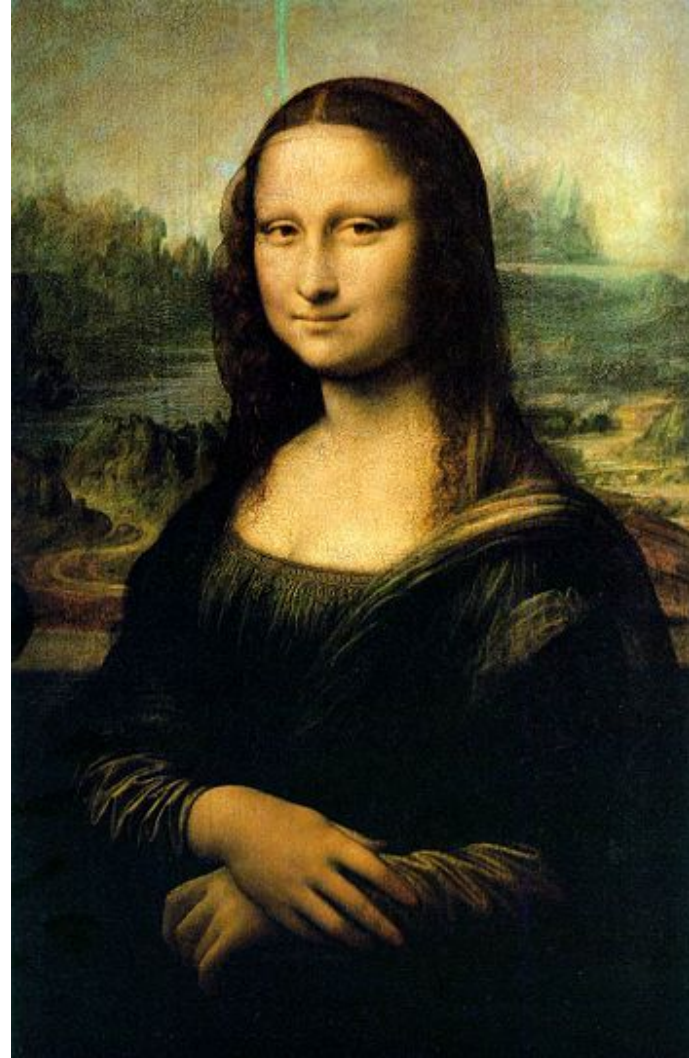
Cultural works non-substitutable



Two scenarios



MICKEY MOUSE





COUNTERMEASURES

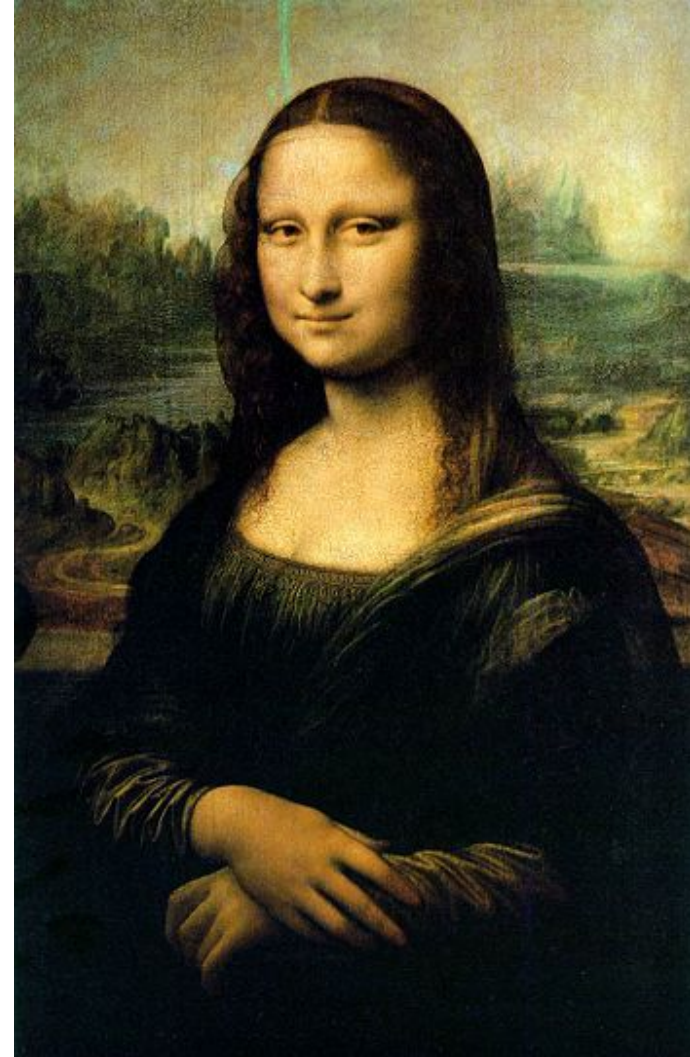


VU  **VRIJE
UNIVERSITEIT
AMSTERDAM**

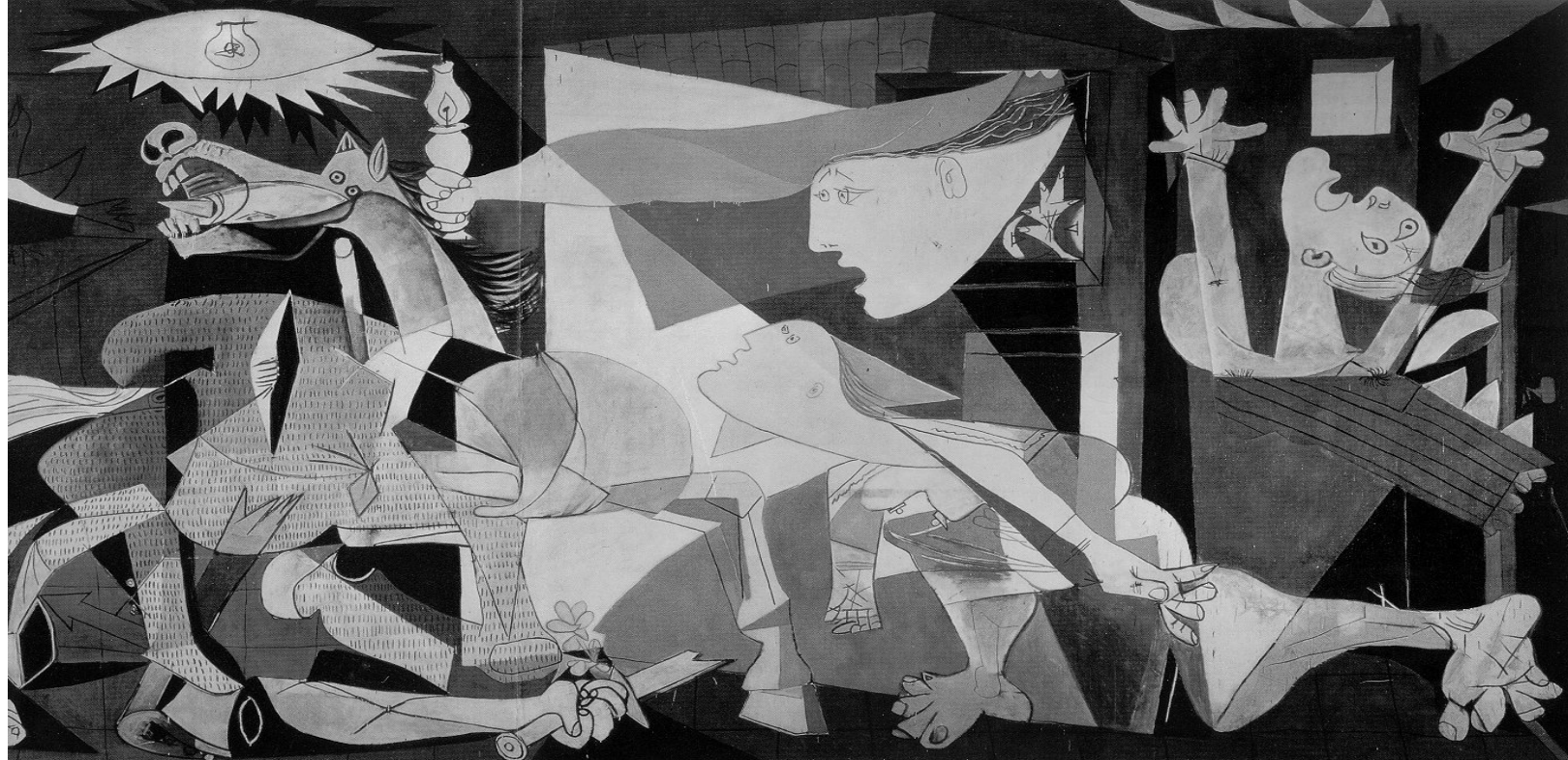
IS VERDER KIJKEN

Federal Patent Court of Germany,
25 November 1997, 'Mona Lisa'

- The Mona Lisa is not distinctive.
- The Mona Lisa has become customary in trade practices.
- But there is no conflict with morality or public order.



Guernica for weapons?



- distinctive?
- customary in trade practices?

Solveig's song for beer?

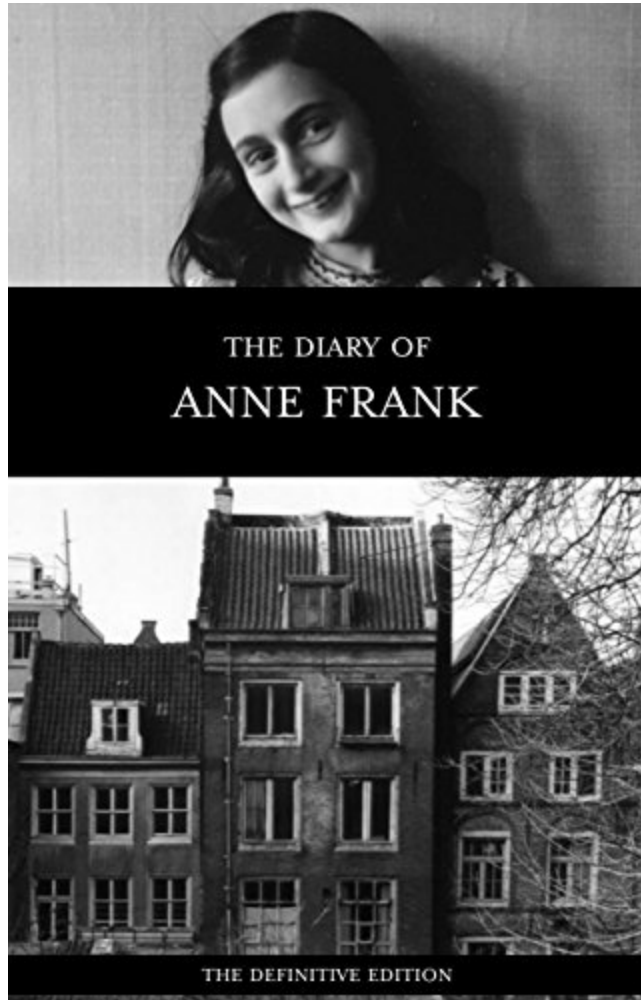


- distinctive?
- customary in trade practices?

Distinctiveness a sufficient safeguard?

- leaving the issue to the marketing efforts of the industry (self-service mechanism)
- undesirable commercial redefinition of important cultural expressions
- risk of privatising (re-monopolising) parts of the cultural heritage
- encouragement of 'cultural heritage grabbing'

Distinctiveness a sufficient safeguard?



Distinctiveness a sufficient safeguard?



Functionality doctrine



General Court, 6 October 2011, case T-508/08, Bang & Olufson



But not covering all situations





PUBLIC ORDER AND MORALITY



VU  **VRIJE UNIVERSITEIT AMSTERDAM**

IS VERDER KIJKEN

EFTA Court, 6 April 2017, case E-5/16, Vigeland

- refusal based on accepted principles of morality
(subjective criterion)

= perception by reasonable consumers with
average sensitivity and tolerance thresholds

‘...certain pieces of art may enjoy a particular status as prominent parts of a nation’s cultural heritage, an emblem of sovereignty or of the nation’s foundations and values. A trade mark registration may even be considered a misappropriation or a desecration of the artist’s work...’

(para. 92)

EFTA Court, 6 April 2017, case E-5/16,
Vigeland

‘Therefore, the possibility cannot be ruled out that trade mark registration of an artwork may be perceived by the average consumer in the EEA State in question as offensive and therefore as contrary to accepted principles of morality.’ (para. 92)

EFTA Court, 6 April 2017, case E-5/16, Vigeland

- refusal based on grounds of public policy
(objective criterion)

= genuine and sufficiently serious threat to a
fundamental interest of society

‘An artwork may be refused registration, for example,
under the circumstances that its registration is regarded as
a genuine and serious threat to certain fundamental values
or where the need to safeguard the public domain, itself, is
considered a fundamental interest of society.’ (para. 96)

EFTA Court, 6 April 2017, case E-5/16, Vigeland

from assessment
of scandalous
nature of the sign
itself

to assessment of
scandalous nature of
the registration as a
trademark

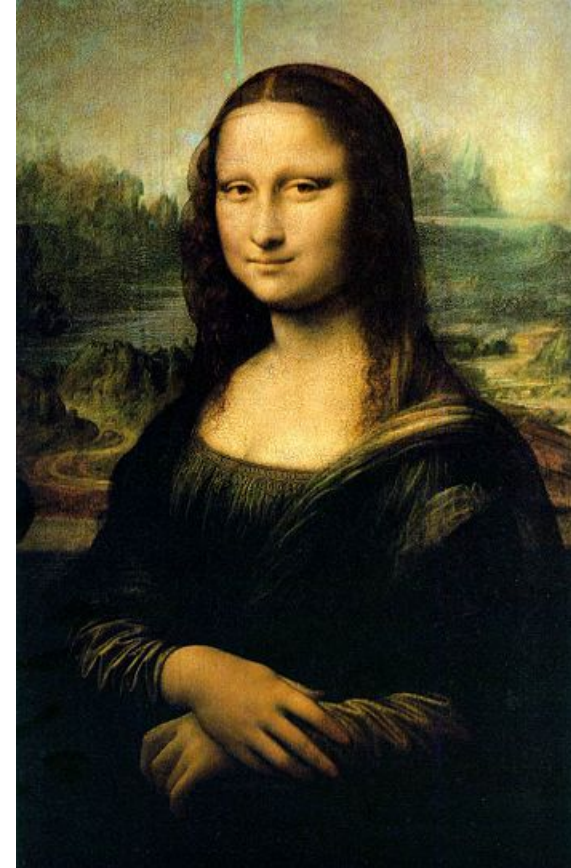


EFTA Court, 6 April 2017, case E-5/16, Vigeland

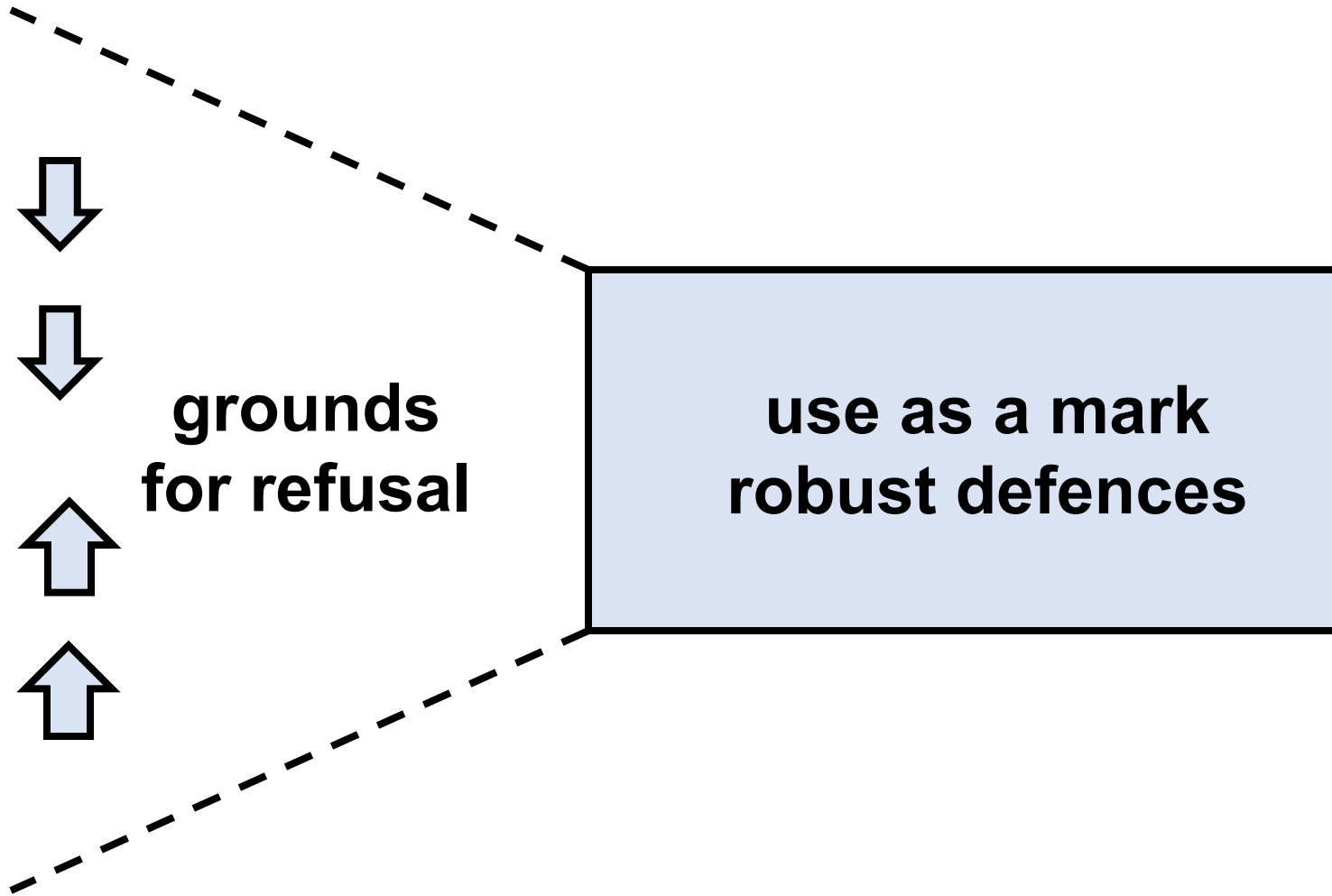
- as effective as doctrine of aesthetic functionality?

‘Accordingly, registration of a sign as a trade mark may only be refused as contrary to public policy in accordance with Article 3(1)(f) of the Trade Mark Directive **in exceptional circumstances.**’

(para. 96)



In sum: lax access control



Culture less important than commerce?





THE END. THANK YOU!



VU  1839 VRIJE UNIVERSITEIT AMSTERDAM

IS VERDER KIJKEN