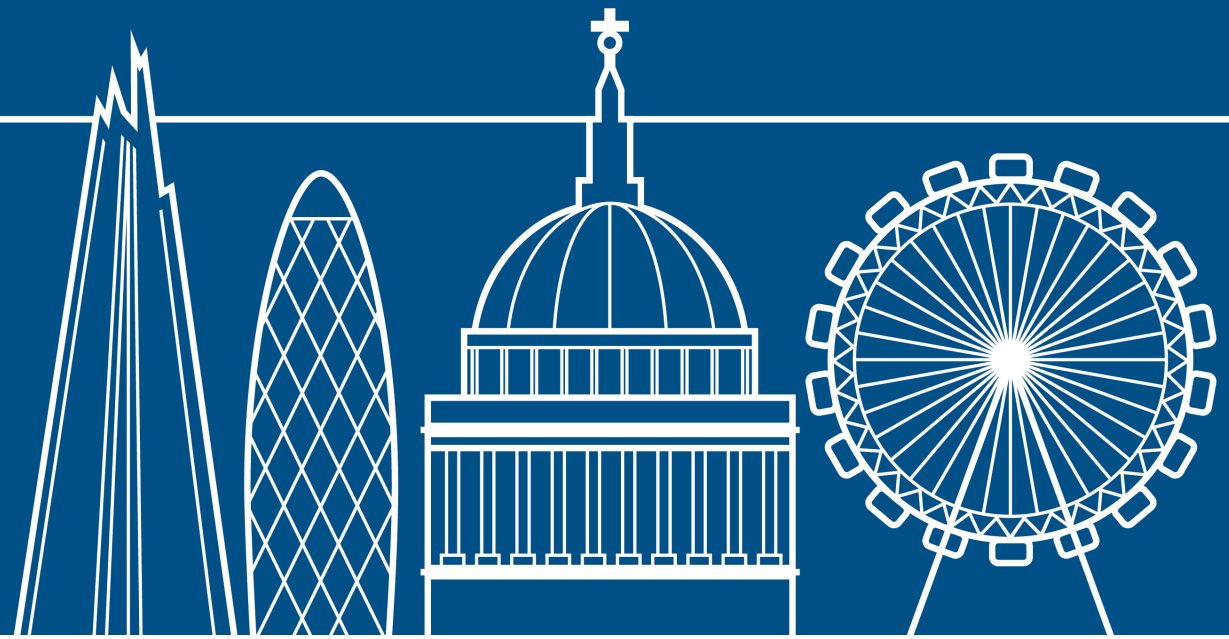




FICPI ExCo & 21st Open Forum

London, 1-7 October 2023



Protecting 3D Product Configuration Trade Marks

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY

www.ficpi.org



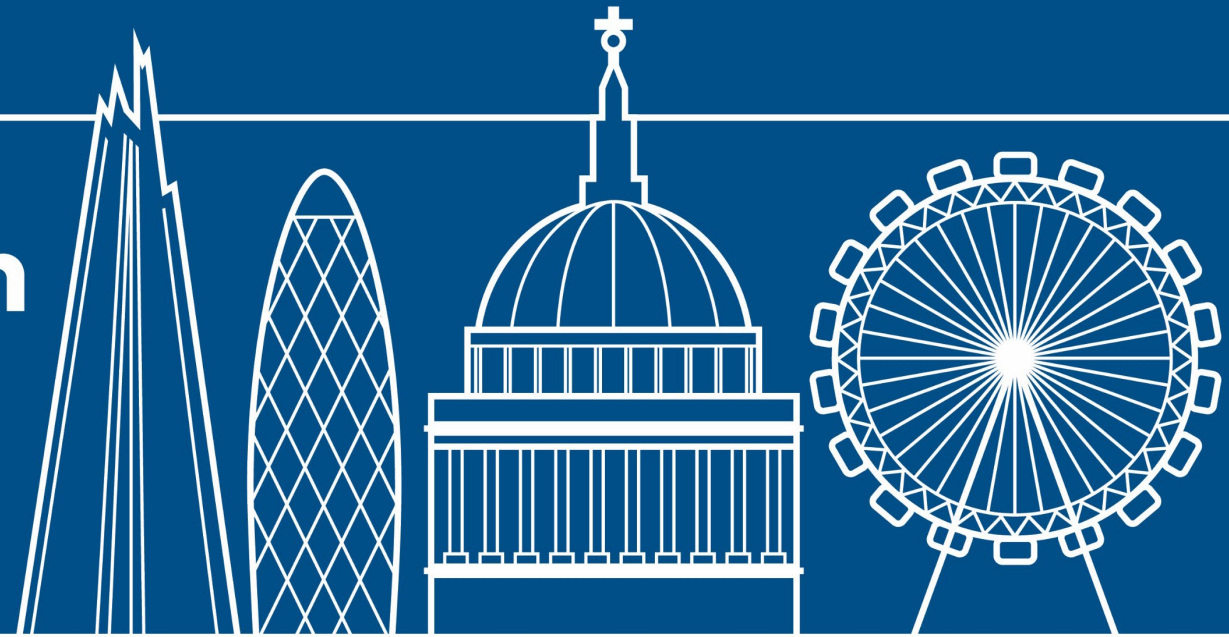
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21st Open Forum

London

4-7 October 2023



Introduction

Naresh Kilaru

Partner, Finnegan Henderson Farrabow & Dunner

USA



circle



21st Open Forum
London, England
4-7 October 2023



Naresh Kilaru



Henning Hartwig



Lanying Lena Shen



21st Open Forum

London

4-7 October 2023



Protecting 3D Product Configuration Trademarks in the U.S.

Naresh Kilaru

Partner, Finnegan Henderson Farrabow & Dunner

USA



circle

FINNEGAN

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Protecting 3D Product Configuration Trademarks in the U.S.

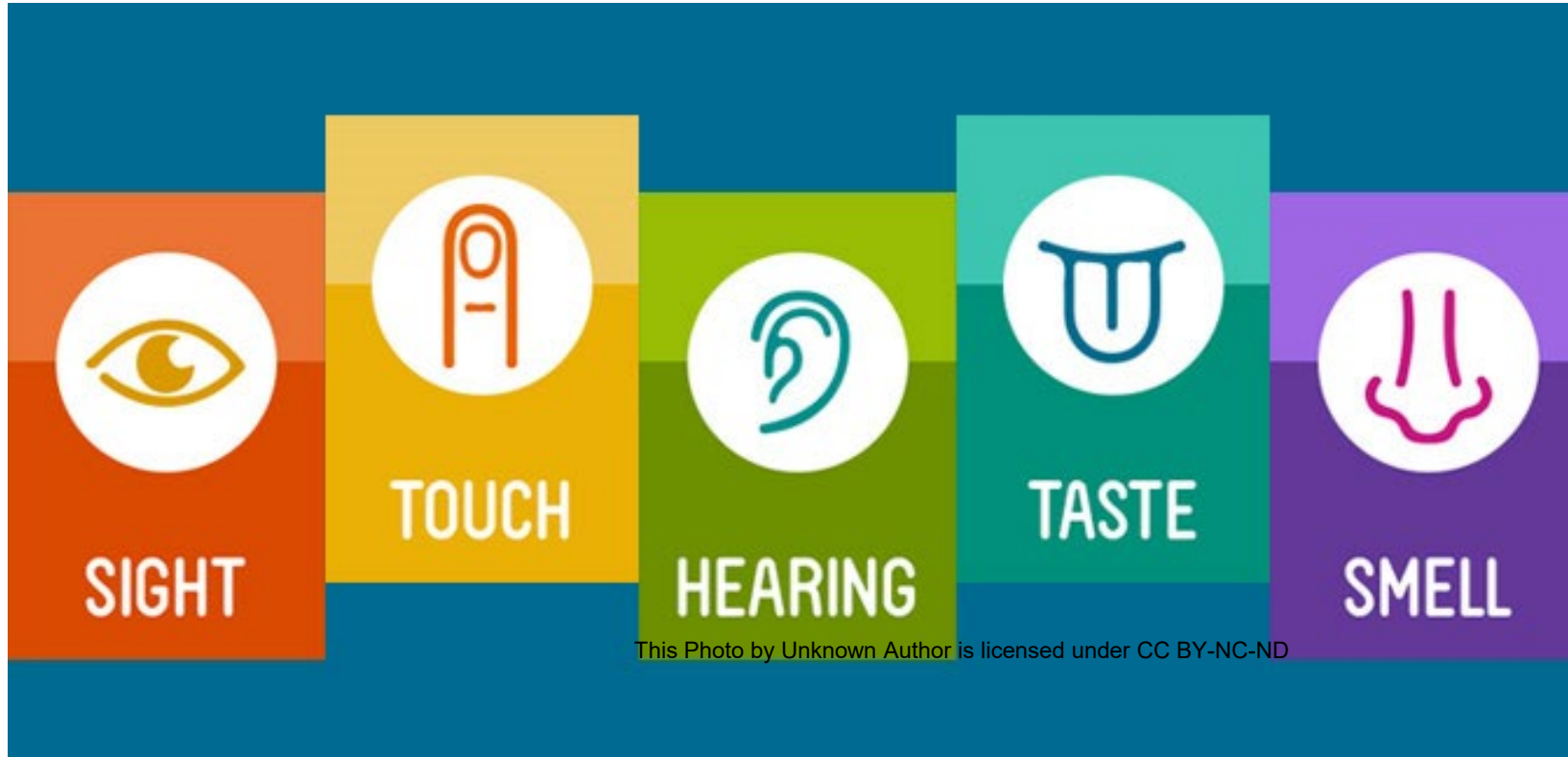
Naresh Kilaru

naresh.kilaru@finnegan.com

FICPI Open Forum, London (October 5, 2023)

New Ways To Capture Consumers' Attention?

Engage All The Senses!!



Types of Non-Traditional Trademarks

- Smell



plumeria blossom fragrance for yarn



grapefruit, lavender, vanilla, peppermint, and other scents for file folders, hanging folders, paper expanding files

cherry and other scents for synthetic automotive lubricants

FUEL FRAGRANCES

In 1992, Manhattan Oil introduced Fuel Fragrances to be used in gasoline, methanol, and diesel fuels. One four ounce bottle treats 10-20 gallons of gasoline, 30-55 gallons of methanol, or 5-10 gallons of diesel. The product is widely used from lawnmowers to top fuel dragsters. Fuel fragrances are intended to set you apart from the rest and be a crowd pleaser. They do not enhance or inhibit performance and are safe to use in all internal combustion engines. For best results use in vehicles without catalytic converters.



One 4 oz. bottle treats 40-55 gallons of alcohol fuel, or 20-30 gallons of nitro-methane or gasoline.

Types of Non-Traditional Trademarks

- Sound Marks



Animal Sounds:
Duck quacking word AFLAC



Animal Sounds:
lion roaring



Mechanical Sounds:
Sound of a windproof lighter opening, igniting,
lighting and closing



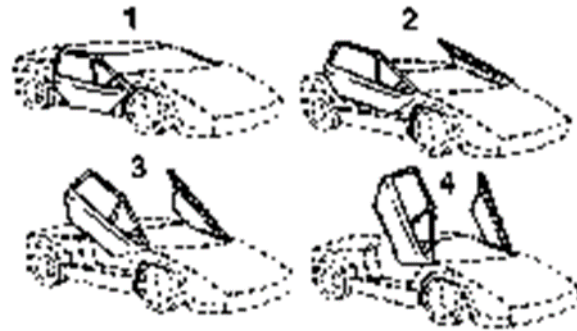
Human Voice: Pillsbury Dough
Boy Giggle



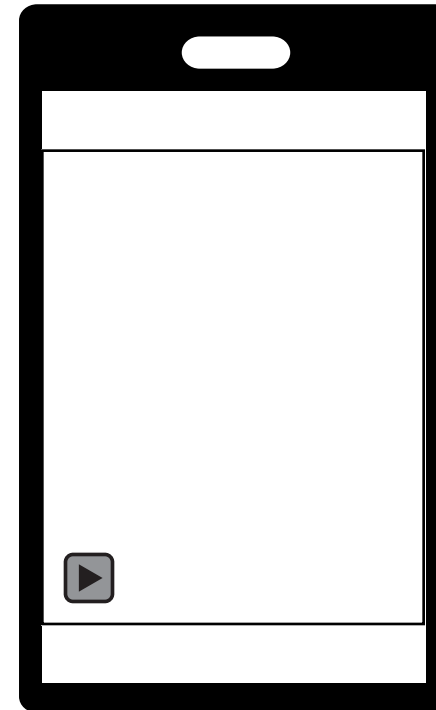
Types of Non-Traditional Trademarks

- Visible Motion marks:

Lamborghini Doors



Salt Bae



Types of Non-Traditional Trademarks

- Single Color



Owens Corning Pink for insulation fiberglass



'Pullman Brown' for UPS trucks and uniforms



Canary Yellow for Post-its stationary notes



'Tiffany Blue' for jewelry, boxes, pouches, furnishings, etc.

Types of Non-Traditional Trademarks

- Three Dimensional Marks – Building Design



Types of Non-Traditional Trademarks

- Taste?
- Holograms?
- Gestures?

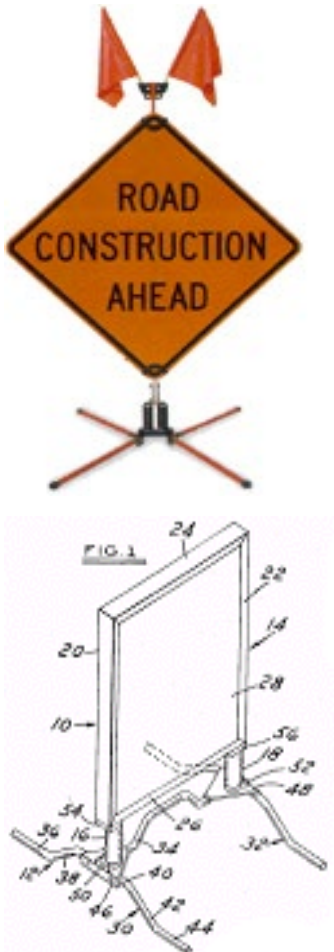


LEGAL REQUIREMENTS

- A mark is eligible for trademark protection when it:
 1. identifies the source of a product;
 2. is nonfunctional; and
 3. is distinctive.

- Trademarks Never Protectable If Functional:
 - Claimed Feature is Essential to the Use or Purpose of the Product, or if
 - Feature affects the Cost or Quality of the Product
- If Feature is not Functional under these two Criteria
 - ➔ Availability of Alternative Designs may weigh against Functionality

- **TrafFix Devices, Inc. v. Mktg. Displays Inc., (2001)**
 - Mark is functional if it is “essential to the use or purpose of the product or if it affects the cost of quality of the product.”
 - “[w]here the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.”



Functionality – Example

- ***Brunswick Corp. v. British Seagull Ltd. (Fed. Cir. 1994)***, affirming TTAB holding the color black for outboard motors is functional because it makes motor appear smaller and coordinates well with different boat colors.



- Inherently Distinctive Marks
 - Consumers likely to view as source identifying
 - Immediately protected upon adoption (registration)
- Acquired Distinctiveness
 - Not something consumers would immediately use as a source identifier
 - Protected only after consumers recognize them as trademarks
- Generic or Functional
 - Never protected

- **Seabrook Test for Inherent Distinctiveness**

- Whether mark is a common basic shape or design
- Whether mark is unique or unusual in field
- Whether mark is merely a refinement of a commonly adopted and well-known form of ornamentation recognized by public for those goods
- Whether mark is capable of creating a commercial impression separate from any word mark

- The following non-traditional trademark types that may be Inherently Distinctive:
 - Product Packaging trade dress
 - Décor
 - Uniforms
 - Certain sound marks
- Nearly all other non-traditional marks require proof of acquired distinctiveness through consumer recognition (called Secondary Meaning).

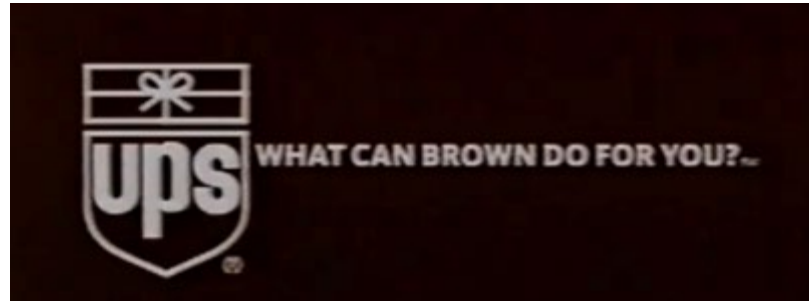
- **Proof of Acquired Distinctiveness:**
 - “Secondary Meaning”
 - Prior existing Principal Registration
 - Five years substantially exclusive and continuous use in commerce
 - Direct and circumstantial evidence of acquired distinctiveness
 - Volume of Sales and Advertising
 - “Look for” advertising
 - Unsolicited Media Coverage
 - Consumer/Dealer declarations
 - Surveys and consumer studies

- Principal Register
 - Full Trademark Rights
 - Presumption of Nation-Wide Rights
 - Presumption of validity
- Supplemental Register
 - For Marks that have not yet acquired distinctiveness
 - Primarily serves as public notice
 - May block later trademark applications

BEST PRACTICES

Best Practices – ‘Look-For’ Advertising

- Companies can actively work to build an association between a mark and its source by advertising a good or service and telling consumers to ‘look for’ a certain mark, which serves as an entity identifier.
- UPS launched an advertising campaign titled, “What can brown do for you?”



- This gave the color a personality and supported and encouraged the association consumers already had since the first use of the color in the 1920's.

Best Practices – Surveys

- Consumer surveys can indicate that consumers perceive the mark as an indicator of source and can shed light on likelihood of confusion.
- They can be extremely destructive if they are not conducted in accordance with industry standards.
- In *Black & Decker Corp. v. Positec USA Inc.*, a poorly-conducted consumer survey was “the linchpin of [p]laintiff’s case on likelihood of confusion.”
- The court vacated a jury award of approximately \$54 million.

Best Practices – Avoid Functionality

- Any mark that would place competitors at a significant disadvantage will likely be found to be functional.
- Example: The blue color of Sun Water Systems, Inc.’s water filtration system was found to be functional as the color is “almost exclusively associated with water” and limiting the use of the color would severely restrict marketing efforts.



Best Practices – Purposeful Advertising

- Advertising is crucial to support claimed distinctiveness, but functionality should not be touted.
- In *In re N.V. Organon*, registration was refused because applicant's own advertising described the functional benefits of the orange taste of its antidepressants.



*“Remeron Sol Tab offer[s] the unique advantages of Remeron in a **more patient-acceptable formulation to increase the ease and convenience of therapy and ultimately enhance patient compliance. Remeron Sol Tab . . . has a pleasant (orange) taste.**”*


Best Practices – Media Attention

18 Best-Smelling Hair Products Ever, Ranked
Our editors took a stroll down memory lane (aka, the hair care aisle) to determine which brands hair smells best with this list.
By JANE DAVIS, ANDREA BENTLEY | COMMENT

Best-Smelling Hair Product No. 7: DryBar Detox Dry Shampoo (\$21)

DryBar dry shampoo smells exactly like a DryBar salon — which, if you've never been to one, smells like powder, roses and summer garden and champagne bubbles and all things girls and happy. My boyfriend and I frequently make this smile like champagne, but he's saying it's my all-time favorite dry shampoo for the scent alone.

How to Use:
 SEE HERE (MSRP, \$21; sometimes sold in bundles, \$45.50) (detox, 4.5 oz.) (detox, 4.5 oz.) (detox, 4.5 oz.)





- Keep extensive records of media attention to support the claim of acquired distinctiveness.
- This can be in the form of magazine articles, social media posts, consumer reviews, cameo appearances, third-party retailer product descriptions, etc.

The Best-Smelling Hair Products of All Time
The Beauty | November 1, 2018

20 Products From Ulta And Sephora That Smell Good Enough To Eat
by Stephanie — on Jul 09, 2018 in Beauty and Makeup

No. 4: DryBar Detox Dry Shampoo

DryBar dry shampoo smells exactly like a DryBar salon — which, if you've never been to one, smells like powder, roses and summer garden and champagne bubbles and all things girls and happy. My boyfriend and I frequently make this smile like champagne, but he's saying it's my all-time favorite dry shampoo for the scent alone.



21st Open Forum

London

4-7 October 2023



Protecting 3D Product Configuration Trademarks – A EU case study]

Henning Hartwig

Partner, Bardehle Pagenberg MBB

Germany



circle



BARDEHLE
PAGENBERG

Protecting 3D Product Configuration Trademarks – A EU case study

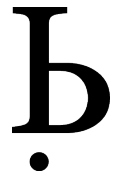
FICPI's 21st Open Forum, London

October 5, 2023

Dr. Henning Hartwig, Attorney-at-Law, Munich

- I. Introduction – BIRKENSTOCK going public (NYSE)**
- II. The TIC TAC mint war**
- III. Acquisition of configuration marks**
- IV. Infringement of configuration marks**
- V. Varia**

I. Introduction – BIRKENSTOCK going public (NYSE)



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Extras > IndyBest > Fashion & Beauty > Women's Shoes

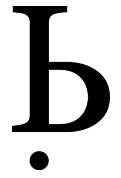
Birkenstock sandals are Barbie-approved – these are the pink styles to buy now

The movie has caused a 340 per cent surge in demand for the cult shoe brand

Daisy Lester • Monday 07 August 2023 12:10

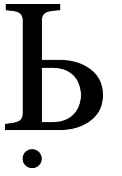


I. Introduction – BIRKENSTOCK going public (NYSE)



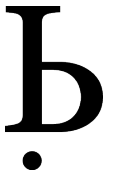
- We face competition from counterfeit or “knock-off” products manufactured and sold by third parties in violation of our IP rights, as well as from products that are **inspired by our footwear in terms of design and style**, including private label offerings by retailers.
- In addressing these or similar issues in the future, we may also be required to incur substantial expense to protect our brand and enforce our IP rights, including through **legal action in Germany, the United States or other countries**, which could negatively impact our business, financial condition and results of operations.

I. Introduction – BIRKENSTOCK going public (NYSE)



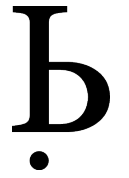
- Some of our footwear designs, including several of our core products, are not protected by design patents or other design rights. This may mean that we cannot legally prevent third parties from creating “lookalike” products or products that otherwise use our designs.
- Beginning in 2018, we modified our approach to IP protection and enforcement and began to more consistently seek to register our design rights and seek to obtain patents on new products and to consistently enforce our IP rights against infringement.

I. Introduction – BIRKENSTOCK going public (NYSE)



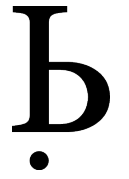
- However, our ability to enforce our IP rights with respect to counterfeit or infringing products in the market may in some cases be **challenged by defendants as barred in certain jurisdictions based on allegations that we failed to timely enforce our IP rights**. Any failure to protect or enforce our IP rights could diminish the value of our brands and could cause customer or consumer confusion. As a result of any of the foregoing, there could be a material adverse effect on our business, financial condition, and results of operations.

II. The TIC TAC mint war (three arenas)



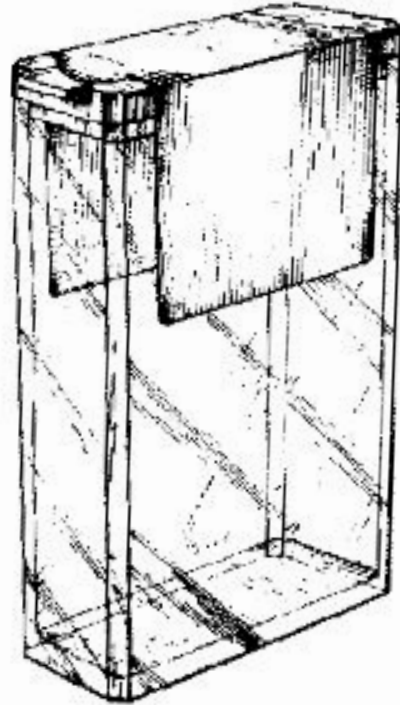
- IT (claim for trademark infringement followed by the defendant arguing that the product configuration marks would be invalid because the shape would give substantial value to the goods and would be necessary to obtain a technical result)
 - Turin District Court (November 12, 2019 – 5140)
 - Turin Appeal Court (February 17, 2021 – 199)
 - Italian Supreme Court (May 11, 2023 – 12881/2023)
 - Adversary: MOCCA SPOL. S.R.O., Czech Republic (**BLIKI**)

II. The TIC TAC mint war (three arenas)



**Italian Registration
1564272 registered
on March 12, 1974**

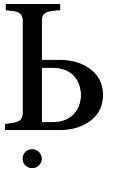
**(available in the Italian register
under the application number
362023000124665)**



**Italian
Registration
1478173
registered on
January 31,
2012**

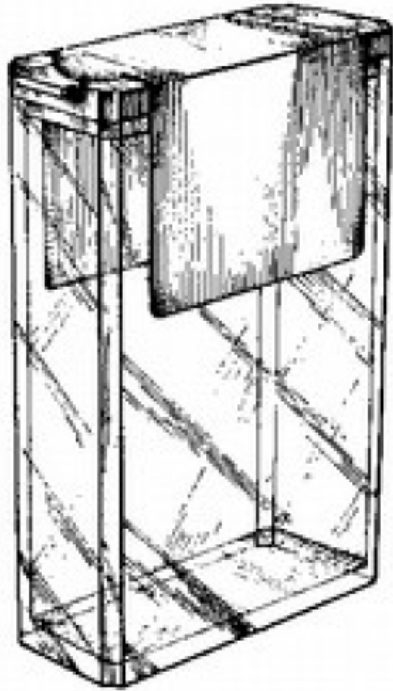
**(available in the Italian
register under the
application number
302011901956195)**

II. The TIC TAC mint war (three arenas)

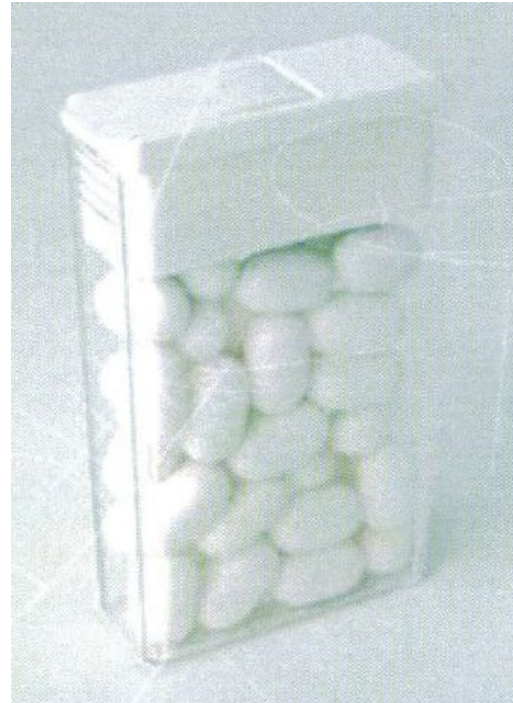


- FR (claim for trademark infringement followed by the defendant arguing that the product configuration marks are invalid because the shape is purely functional)
 - Paris District Court (June 7, 2019 – 17/02478)
 - Paris Appeal Court (February 15, 2022 – 19/21858)
 - Adversary: BMB sp. z o.o., Poland (**MIK MAKI**)

II. The TIC TAC mint war (three arenas)



**International Registration 405177,
registered on March 12, 1974, with
effect in France (*inter alia*)**

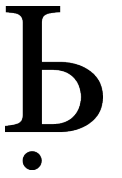


**French Registration
3485937 registered on
March 5, 2007**



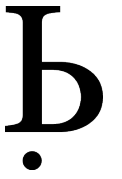
**French Registration
3485933 registered on
March 5, 2007**

II. The TIC TAC mint war (three arenas)

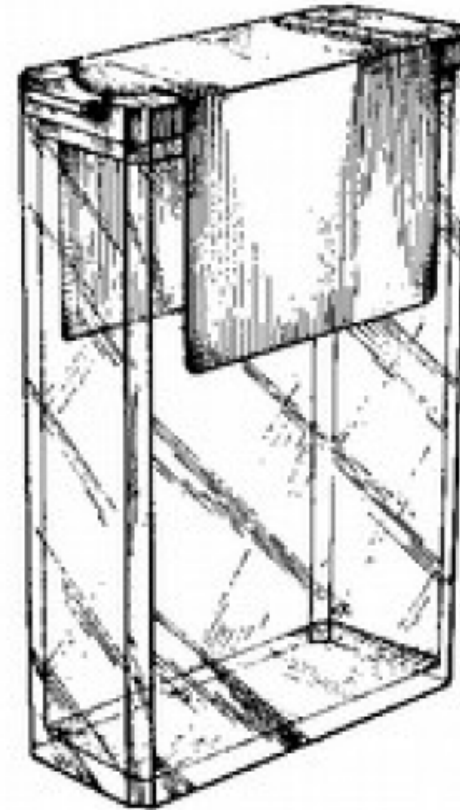


- CJEU (C-693/17 P)
 - Claim for infringement (use of a distinctive sign in a subsequent design) based on IR 405177 (claiming priority from IT 276963) as a ground for invalidity brought against later RCD 826680-0001 (no lack of genuine use argued)
 - Adversary: BMB sp. z o.o., Poland (**MIK MAKI**)

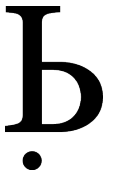
II. The TIC TAC mint war (three arenas)



**International
Registration No 405177
of a trademark,
registered on March 12,
1974, with effect in
France (*inter alia*)**

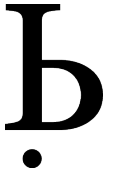


III. Acquisition of configuration marks



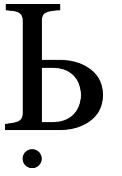
- **Standards (inherent distinctiveness)**
- Only a shape which **departs significantly from the norm or customs of the sector** and thereby fulfils its essential functions of indicating origin is not devoid of any distinctive character

III. Acquisition of configuration marks



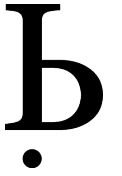
- **Standards (technical solution)**
 - In order to refuse a shape as being necessary to obtain a technical result, it is necessary that **all the essential elements of the shape must incorporate a technical solution**
 - Minor additional features (for instance: color) do not change the outcome

III. Acquisition of configuration marks



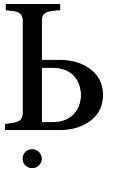
- **Standards (technical solution)**
 - European trademark law, precluding registration of signs consisting exclusively of the shape of goods which is necessary to obtain a **technical result**, must be interpreted as referring only to the **manner in which the goods at issue function** and it does not apply to the manner in which the goods are manufactured

III. Acquisition of configuration marks



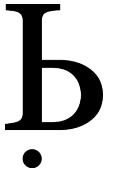
- **Standards (substantial value)**
 - Ground for refusal applies to a sign which consists exclusively of the shape of a product with one or more characteristics **each of which gives that product substantial value** (the target public's perception of the shape of that product only one of the assessment criteria which may be used to determine whether that ground for refusal is applicable)

III. Acquisition of configuration marks



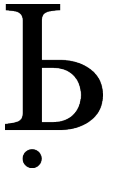
- **Challenges to validity**
 - IT: Configuration marks invalid because the shape gives substantial value to the goods and is necessary to obtain a technical result
 - FR: Configuration marks invalid because the shape is purely functional

III. Acquisition of configuration marks



- **Turin Appeal Court (according to the Italian Supreme Court)**
 - No coincidence between the patents and the shape marks as the subject of the patent is specific technical solution applied to the opening of the box of sweets while, in case of the marks, **essential relevance is given to the transparent rectangular container** underneath
 - Shape represents **only one of the possible forms of making a container for sweets**, with only the closing mechanism being subject of the patents
 - Shape of the box is not characterized by an aesthetic value such as to constitute an independent reason for purchasing “Tic Tac” sweets as the consumers’ **purchasing motivations** correlate rather to other factors, such as the reputation of the mark

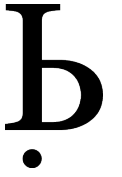
III. Acquisition of configuration marks



■ Italian Supreme Court

- Judges on the merits essentially held that the patents related only to the opening mechanism of the container and only the marks to the overall shape
- It cannot be said, therefore, that the factual premises of the conclusions reached were different in the two lower decisions
- Finding of fact that the shape of the container, as such, was not covered by the patent protection, which the judgment considered as relating solely to the way it was opened and closed
- MOCCA's plea inadmissible (aimed at repeating finding of facts)

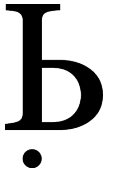
III. Acquisition of configuration marks



- **Italian Supreme Court**

- **Necessary form** means what is necessary to obtain a technical result, and therefore functional, because it is imposed by the industrial utility it pursues, so that, according to this principle, when a given form is “necessary”, that is, **inseparably connected with the utility of an invention**, the imitation is in itself lawful, provided that this element of inseparability and therefore of necessity exists
- **Substantial form** means what gives substantial value to the product because it increases its **commodity value, without changing its ontological function**

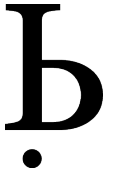
III. Acquisition of configuration marks



- **Italian Supreme Court**

- Judgment under appeal ascertained the extrinsic character of the shape with respect to the product and excluded that the former is an “indefectible” (*indefettibile*) character of the latter
- Possible to clearly distinguish between the shape and the product as manufactured
- Shape of the container did not constitute a technical solution to a problem, confirmed by the possibility that the container could take other forms, without functional prejudice to the purpose of containing and distributing sweets because it is not a shape that constitutes a pure solution to a technical problem

III. Acquisition of configuration marks

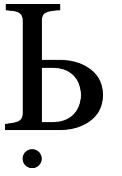


- **Challenges to validity**

- CJEU: Absence of genuine use?

- BMB did not argue lack of genuine use of the earlier mark, according to the text of the four decisions being available
- Established case law that, when an earlier trademark is asserted as a ground of invalidity of a later design, the holder of the contested design may request proof of use of the earlier mark **as if this would be a trademark opposition or invalidation case**, and if the proof is not delivered, the invalidity request must be rejected

III. Acquisition of configuration marks

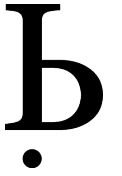


- **Challenges to validity**

- CJEU: Absence of genuine use?

- Absence of a challenge remarkable as the earlier mark, which is a ‘classic’ black and white line drawing showing a transparent container without any content and any labelling, is, if at all, **hardly marketed in that specific appearance** (but, rather, labelled and filled)
- Would BMB have challenged genuine use of the earlier mark (under the relevant French national trademark law) the tribunals would have had to decide whether **use of a concrete product** (in the case at hand: the ‘Tic-Tac’ container) amounts to **use of an abstract, black and white mark**

III. Acquisition of configuration marks

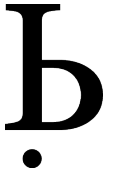


- **Challenges to validity**

- CJEU: Absence of genuine use?

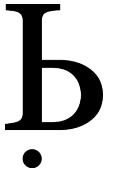
- To the best of our knowledge, **no such constellation has been decided by the CJEU**
- Obstacles appear to be rather high for finding genuine use because, pursuant, for instance, to German case law, registration of a shape mark as inherently distinctive does not establish a presumption that use, of that mark, by a third party would per se be perceived, by the relevant public, as ‘use as a mark’. Rather, the **infringement court must establish such facts where in dispute.**

III. Acquisition of configuration marks



- **Challenges to validity**
 - CJEU: Absence of genuine use?
 - If this held true, then it would appear **at least questionable to proceed from the presumption** that an abstract shape mark, such as International Registration No 405177, has been genuinely used through distributing filled and labelled containers designed according to that mark

III. Acquisition of configuration marks

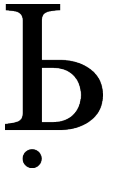


- **Challenges to validity**

- CJEU: Absence of genuine use?

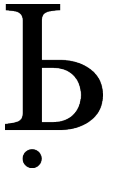
- Rather, it seems to make sense to require the right holder to show that the public would see the 'shape', within a complex sign, as sufficiently distinctive (rather than merely functional or ornamental) to be perceived as an independent mark
- The same test applies when finding similarity or dissimilarity between an earlier 'abstract' mark and a later complex sign because, for finding similarity, the earlier mark must retain an independent role within the later sign

IV. Infringement of configuration marks



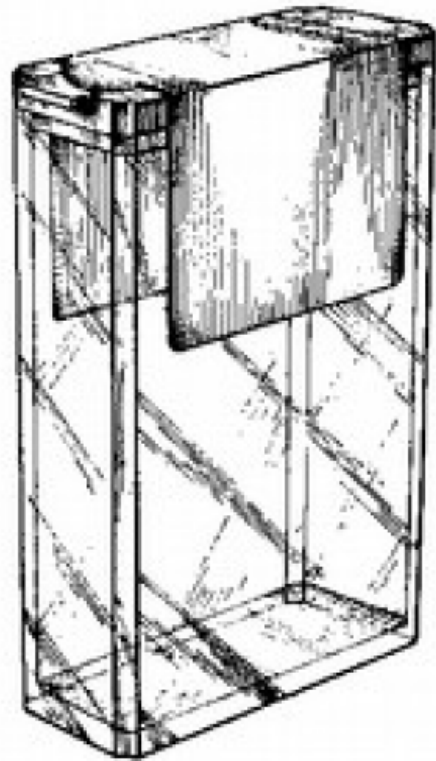
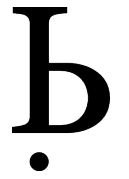
- **Standards (Paris Appeal Court, February 15, 2022 – 19/21858)**
 - Likelihood of confusion must be assessed by reference to the trademark registration
 - Only conditions of use of the contested sign and the marketing of the allegedly infringing goods must be taken into account
 - Perception of the relevant public to be examined by reference to the sign and the goods and services referred to in the application

IV. Infringement of configuration marks



- **Standards (Paris Appeal Court, February 15, 2022 – 19/21858)**
 - Risk must be analysed globally with respect to all relevant factors, and in particular the reputation of the mark
 - Overall assessment of the similarity of the trademark and the sign at stake must also be based on the overall impression they produce with respect to their distinctive and dominant elements

IV. Infringement of configuration marks



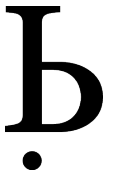
International Registration No 405177,
registered on March 12, 1974, with
effect in France (*inter alia*)



RCD 826680-0001

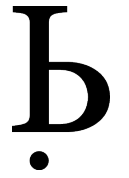


IV. Infringement of configuration marks



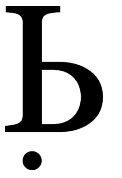
- **CJEU (decision of March 6, 2019 – C-693/17 P)**
 - General Court: BOA's finding that the earlier mark represented a standard container that can be filled with various products, such as sweets, and that its distinctive character per se was below average not disputed by BMB
 - Given that the goods in question were confectionery, the level of attention of the relevant public was rather low

IV. Infringement of configuration marks



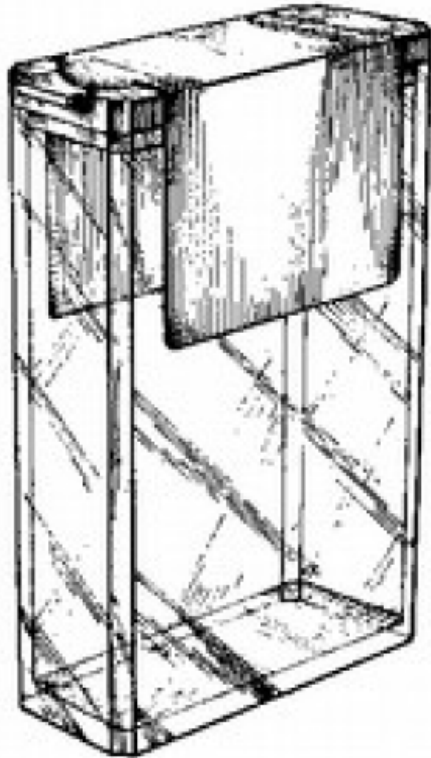
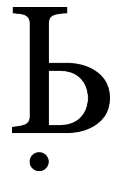
- **CJEU (decision of March 6, 2019 – C-693/17 P)**
 - With respect to RCD No 826680-0001, the General Court endorsed the findings of the BOA that the label is a mere detail, in so far as that label will be perceived as a mere label affixed to a container that contains sweets
 - BOA held that neither the label of the contested design nor the MIK MAKI logo dominates the overall impression conveyed by the contested design, overshadowing the impact of the three-dimensional box

IV. Infringement of configuration marks



- **CJEU (decision of March 6, 2019 – C-693/17 P)**
 - That RCD 826680-0001 is “not visually rectangular” does not override similarities
 - Given that the public retains only an imperfect recollection of the sign, consumers would not perceive the differences referred to if the shapes are presented to them at different times
 - In the absence of word elements in IR 405177, no phonetic comparison of the signs could be carried out
 - Conceptual comparison also impossible given that both registrations were deemed devoid of any meaning

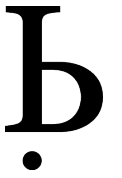
IV. Infringement of configuration marks



**International Registration No 405177,
registered on March 12, 1974, with
effect in France (*inter alia*)**

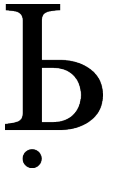
<https://www.lexology.com/commentary/intellectual-property/france/inlex-ip-expertise/validity-of-3d-trademark-ferrero-thinks-outside-the-box-to-protect-tic-tacs>

IV. Infringement of configuration marks



- **Paris Appeal Court**
 - Goods identical as the contested boxes are filled with sweets
 - Oval shape and coloured, particularly white and orange/green (like the confectionery visible in FR 3485937 and FR 3485933)

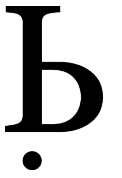
IV. Infringement of configuration marks



■ **Paris Appeal Court**

- **Visually**, accused boxes are transparent boxes of parallelepiped shape with a side of small width whose upper face consists of a recessed part, like the boxes appearing on the three 3D marks
- As in case of the IR 405177, their upper part is covered with a band covering the widest part of the box. As in case of FR 3485937 and FR 3485933, their recessed part in the upper portion of the box is white, and the boxes are filled with small oval, white or orange/green sweets
- In the absence of word elements, no **phonetic** comparison of the signs can be made
- **Conceptual** comparison also impossible

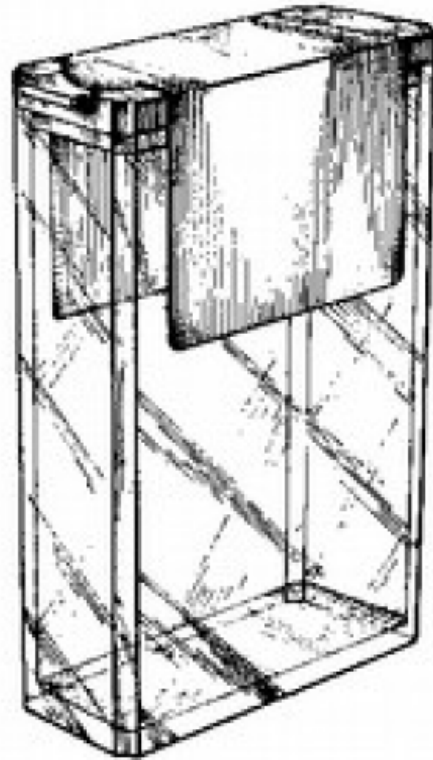
IV. Infringement of configuration marks



- **Paris Appeal Court**

- Differences essentially due to the rounded edges of the accused boxes (not visible when seen from the front), the larger size of the label with an asymmetrical curved shape at its lower end, and the mention of MIK MAKI and the representation of fruits on this label, do not alter the same visual impression produced by the accused boxes
- Level of attention of average consumers of small confectionery is rather low
- No direct comparison

IV. Infringement of configuration marks

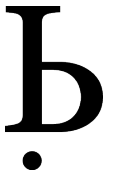


**International Registration No 405177,
registered on March 12, 1974, with
effect in France (*inter alia*)**



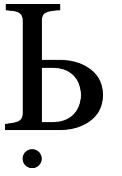
BLIKI
[Ferrero's "Tic Tac" container - a landmark in
the protectability of shape trade marks
regarding food containers - brandwrites.law](#)

IV. Infringement of configuration marks



- **Turin Appeal Court (according to the Italian Supreme Court)**
 - Infringement of the “Tic Tac” marks is proven, as already held at first instance, given the **combination of elements that make the signs identical or similar, resulting in a likelihood of confusion on the part of the public**, with consequent unfair economic advantage caused by the **exploitation of the reputation of the widely known marks**

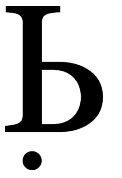
IV. Infringement of configuration marks



- **Italian Supreme Court**

- In complaining that the marks were found to be infringed the appeal in fact ends up re-proposing a judgement on the fact, being outside the scope of review
- Appellant claims that the Supreme Court should revisit the concrete case already examined by the judges on the merits
- Assessment of evidence reserved exclusively to the discretionary appreciation of the trial judge, whose conclusions as to the reconstruction of the facts cannot be reviewed

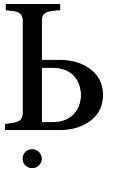
IV. Infringement of configuration marks



- **Turin Appeal Court**

- Shape marks represented by two transparent plastic boxes in the shape of a rectangular parallelepiped with the ends drawn at right angles and equipped with a white opening mechanism (also rectangular) partially incorporated in the plastic wrapping with a protruding rim, the oldest of which has a paper label on the upper part positioned astride the wrapping (and without any inscription) and the second (without any label) containing elongated oval-shaped white sweets

IV. Infringement of configuration marks



- **Turin Appeal Court**

- Contested box represents a (substantially identical) rectangular parallelepiped of transparent plastic (containing identical elongated oval white sugared almonds) fitted with a (equally identical) mechanism of white rectangular opening mechanism and a paper label on the upper part positioned astride the packaging
- Substantial identity of the boxes
- Use of different trademarks on the boxes not relevant

- **Trade dress protection?**
 - **There is no such thing as international trade dress protection**
 - **There is only (at best) national trade dress protection but:**
 - Lack of consistent terminology
 - Scope of protection limited to national territories
 - Obtaining jurisdiction over acts in “foreign” countries available in EU, but difficult elsewhere

- **Trade dress protection?**
 - **National trade dress protection often provides (at best) protection against copying (“slavish imitation”)**
 - Proof of copying rests on plaintiff (different from trademark law)
 - Copying difficult to prove unless defendant’s knowledge of original is shown
 - **No presumption of**
 - Rights under trade dress law (different from trademark law)
 - Ownership or authorship of trade dress rights (different from trademark law)

- **Trade dress protection?**
- **How to value trade dress protection?**
 - Scope of protection of a trade dress right requires enforcement to maintain status quo (vulnerable to “dilution”, loss of goodwill, risk of “look-alikes”)
 - Scope of protection of a trade dress right flexible and in the proprietor’s own hands (like trademark law)
 - It’s all about confusion and misappropriation (not: prior art)!

Curious?

14. Three-dimensional trade marks and designs: comparison and conflict

Alexander von Mühlendahl

I. INTRODUCTION

The systems of protecting intellectual property rights in the European Union are created in parallel and each for its own reasons – trade marks for promoting fair competition and informed choice and protecting investment in goodwill; designs for rewarding designers for their creative efforts and for fostering an innovative industry in the European Union.

Trade mark law was harmonised and unified in the European Union through the First Trade Mark Directive, adopted in 1988,¹ and the Community Trade Mark Regulation, adopted in 1993.² The Directive required the Member States to adapt their national legislation and administrative practice to the mandates of the Directive; the Regulation


EE
Elgar

RESEARCH HANDBOOK ON Design Law

Edited by
Henning Hartwig

DESIGN.
A. BARTHOLDI.
Statue.
No. 11,023. Patented Feb. 18, 1879.

LIBERTY ENLIGHTENING THE WORLD.



Auguste Bartholdi
by *A. Bartholdi*

UNITED STATES PATENT

AUGUSTE BARTHOLDI, OF PARIS, FRANCE
DESIGN FOR A STATUE.

Specification forming part of Design No. 11,023, dated February 18, 1879; appl. (Term of patent 14 years.)

To all whom it may concern:

Be it known that I, AUGUSTE BARTHOLDI, of Paris, in the Republic of France, have originated and produced a Design of a Monumental Statue, representing "Liberty enlightening the world," being intended as a commemorative monument of the independence of the United States; and I hereby declare the following to be a full, clear, and exact description of the same, reference being had to the accompanying illustration, which I submit as part of this specification.

The statue is that of a female figure standing erect upon a pedestal or block, the body being thrown slightly over to the left, so as to gravitate upon the left leg, the whole figure being thus in equilibrium, and symmetrically arranged with respect to a perpendicular line or axis passing through the head and left foot. The right leg, with its lower limb thrown back, is bent, resting upon the bent toe, thus giving grace to the general attitude of the figure. The body is clothed in the classical drapery, being a stola, or mantle gathered in upon the left shoulder and thrown over the skirt or tunic or under-garment, which drops in voluminous folds upon the feet. The right arm is thrown up and stretched out, with a flamboyant torch grasped in the hand. The flame of the torch is thus held high up above the figure. The arm is nude; the drapery of the sleeve is dropping down upon the shoulder in voluminous folds. In the left arm, which is falling against the body, is held a tablet, upon which is inscribed "4th July, 1776." This tablet is made to rest upon above the hip, and so position with relation inscription. The left, so as to bring the face thereof. The head, with wreath and calm, features crown or diadem, fringed seven rays, and representing a and sandal-strapped.

This design may be seen known to the gilt statue or statuette, or relief, in metal, stone Paris, or other place also be carried out in engravings on metal, photographing or otherwise.

What I claim as my invention is the herein-described female figure, with on a torch, while the of tablet, and having it substantially as set forth in testimony where specification in the pending witness.

Witnesses:
C. TRAILER,
COPPER.

RESEARCH HANDBOOKS IN INTELLECTUAL PROPERTY



Thank you for your attention!

hartwig@bardehle.de



21st Open Forum

London

4-7 October 2023



China: Protecting 3D Product Configuration Trade Marks

Lanying Lena Shen

Senior Partner, Dakun IP Law Firm

P.R. China



circle

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY

www.ficpi.org

China: Protecting 3D Product Configuration Trade Marks

Lena Shen, Partner & Attorney-at-law

Dakun IP Law Firm

Patent • TM • Copyright

FICPI @London, October 5, 2023

Outline of Content

- 1. What means possibly available for protecting a product configuration in China**
- 2. Acquisition of a 3-D product configuration trade mark in China**
- 3. Enforcement of a 3-D product configuration trade mark in China**
- 4. Protection of un-registered product configuration in China**
- 5. Tips on protection of product configuration in China**

Part I: What means possibly available for protecting a product configuration in China □

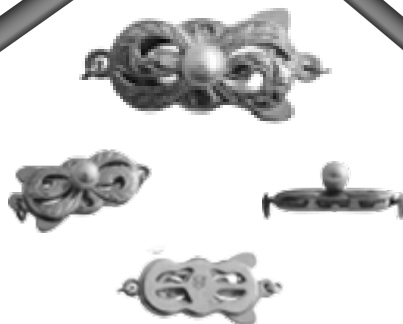
- non-functional
- distinctive
- not forbidden to use as a mark
- not similar to earlier marks



- novelty
- inventiveness
- practical applicability
- non-functional



- original
- legitimate
- reproducible
- minimal aesthetic significance



- unauthorized use
- identical or similar to the name, packaging or decoration of another person's products
- certain influence
- non-functional

Part II: Acquisition of a 3-D product configuration trade mark in China

Examination of a 3-D product configuration trade mark in China

Formality requirements	<ul style="list-style-type: none">• declaration on the type (3-D) of mark to apply• explanation of the use of the mark• mark specimen to demonstrate the 3-D shape with at least three views	Rules 13.3 & 43 of the Implementing Regulations of the Trademark Law of China
Substantive examination criteria	<ul style="list-style-type: none">• distinctive• non-functional• not forbidden to use as a mark• not similar to earlier marks	Articles 10-13, 30-32 of the Trademark Law of China

Implementing Regulations of the Trademark Law of China

Rule 13, Paragraph 3

Where an application is submitted for registering a trademark in the form of a three-dimensional mark, the applicant concerned shall make relevant declarations in the written application, explain the use means of the trademark, and submit a trademark specimen that can be used to determine the three-dimensional shape. The trademark specimen submitted shall include at least three views.

Rule 43

Where an applicant designating China for territorial extension requests for the protection of a three-dimensional mark, color combinations or a sound mark as a trademark or requests for the protection of a collective trademark or certification mark, it shall, within three months from the date of registration of the trademark in question in the International Register of the International Bureau, submit relevant materials prescribed by Article 13 herein to the Trademark Office via a duly established trademark agency. Where the applicant fails to submit relevant materials by the foregoing deadline, the Trademark Office shall dismiss its application for territorial extension.



IR 1221382

Class 3

Approved goods: perfumes

Refused goods: the rest

2014.8.8	International registration filed
2015.7.13	Refused in China due to lack of distinctiveness
2015-2020	<ul style="list-style-type: none"> The applicant failed in review of refusal, administrative litigation for first & second instance The applicant eventually won for registration on goods of “perfumes” at the re-trial before the Supreme Court of China and the Supreme Court requested the Trademark Office to make a new review decision New review decision made by the Office, approving registration on the goods of “perfumes”

The applicant: failed to provide 3 views of the mark as required

TM Office: note it as a device mark in the system



Supreme Court’s decision:

1. the TM Office shall give the applicant chance to submit documents if any missing;
2. even with no sufficient views of the 3-D mark, the TM Office shall still examine the application as a 3-D mark as it is clearly indicated as such at WIPO;
3. The Office shall give priority to the following factors when carrying out examination: (1). the distinctiveness of the trademark under application and the distinctiveness obtained through its use; and (2). the principle of conformance with examination standards. Although it is required to take into consideration individual cases in the trademark review and judicial examination procedures, the basic basis for examination shall always be the Trademark Law and relevant administrative regulations, and the uniformity of law enforcement standards cannot be ignored on the grounds of individual examination.

Examples of registered product configuration trade mark in China

1. shape of the product per se
2. package or container of the product

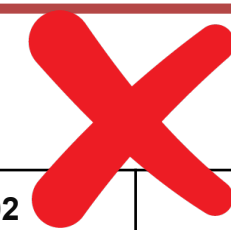




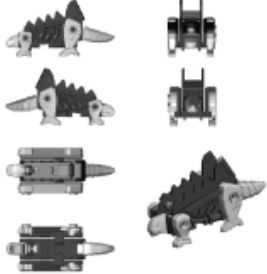


TM No. 22910139	TM No. 61484768	TM No. 22439704	TM No. 43203716	TM No. 11839757
3 (Bath lotion; ; Lipsticks; Facial washing milk; Cleaning preparations; etc.)	11 (refrigerators; freezers; etc.)	8 (spanners; hand tools; etc.)	25 (footwear)	30 (Cocoa Products; chocolate; Pastries)
				



Lack of distinctiveness (Article 11 of the Chinese Trademark Law)

novel or creative design ≠ distinctiveness



TM No. 46737681	TM No. 37949759	TM No. 46713402	TM No. 64650802	TM No. 24706136
30 (Sugar; Bread; Cereal-based snack food; Baozi [stuffed buns]; steamed bun; Instant rice; Steamed bun stuffed with bean paste; etc.)	18 (Imitation leather; Tool bags, empty; Shopping Bags; Travelling trunks; Briefcases; Bags for sports; Backpacks ; Rucksacks; Handbags; School bags ; School satchels; Bags)	28 (Games; Conjuring apparatus; Amusement park riding equipment; Building blocks [toys]; Toys; Card game equipment; Body-training apparatus; etc.)	33 (alcohols; wine; etc.)	12 (Electric vehicles; Cars; Direction Indicators for Bicycles; Bicycles; Bicycle pumps; Baby carriages; Prams [baby carriages]; Bicycle tires [tyres]; Vehicle seats; etc.)
				

Provisions of the Supreme People's Court on Several Issues Concerning the Adjudication of Administrative Cases on Granting and Affirming Trademark-related Rights

Article 9

Where only the inherent shape of a product or a certain part thereof is used as a three-dimensional mark for applying for trademark registration, and the relevant public is unlikely to identify the three-dimensional mark as a mark indicating the origin of the product under normal circumstances, the three-dimensional mark shall be considered as lacking the distinctiveness of a trademark.

The fact that the shape of the product is originally created by the applicant or is first used by the applicant does not necessarily mean that the shape has the distinctiveness of a trademark.

Where the relevant public is able to identify the source of the relevant product by virtue of the mark referred to in Paragraph 1 after long-term or extensive usage, the said mark may be deemed as having the distinctiveness of a trademark.

Acquired distinctiveness through use proven



TM 19119659

Class 3

Approved goods: dry shampoos; hair conditioner; shampoos; hair lotion

Refused goods: soaps; cleaning foams; perfumes; etc.

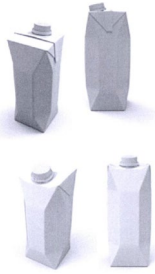
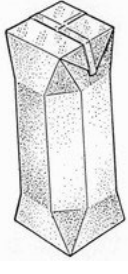

2016.2.19	Application filed
2016.12.8	Refused due to lack of distinctiveness (Article 11 of the Chinese Trademark Law)
2016.12.23	Review application filed
2017.12.1	<p>Review decision made to partially approve the registration</p> <p>Review decision:</p> <p>1. The 3-D shape of the bottle in the applied trademark has been used long time and in big scale on shampoos, hair conditioners, dry shampoos and hair lotion and has acquired high reputation. But not on the other goods.</p> <p>2. The applicant's word mark used on the applicant's products with such a shape has been a well-known trademark. The bottle shape has become an unseparated part of the applicant's product and it has been widely known.</p> <p>3. The bottle shape of the product has been able to indicate the origin of the products and it has established a corresponding relationship with the applicant.</p>

Acquired distinctiveness **NOT** proven



TM No. 15485959 Court decision:

1. No inherent distinctiveness. Whether the applied trademark was originally created or first used by the applicant does not necessarily result in the trademark having the distinctive features a trademark should have.
2. Acquired distinctiveness not proven. The use evidence only showed long term use and high reputation of the concerned package on the juice and liquid milk products but the relevant public of the designated goods shall not be limited to the juice and liquid milk industry but the whole paper and packaging product industry.

TM No.	15485959	IR 1346898	22826051
Class	16	16	16
Goods	Paper; Cardboard; Cardboard articles; Packing paper ; Wrapping paper; Cartons or cartons; Bags [envelopes, pouches] of paper or plastics, for packaging; Packaging materials of cardboard or paper for bottles; etc.	Cardboard packaging and packaging material of paper and plastic-coated paper for beverages	Box of paper or paperboard (for beverage packaging); Paper milk packaging material (coated with plastic); Container made of cardboard (for milk or juice packaging); Box of paper or paperboard (for milk or juice packaging); Paper fruit juice packaging material (coated with plastic); Containers of paper or plastic (for beverage packaging)
Mark			
Exam. history	<p>2014.10.11: Application filed</p> <p>2015.08.05: Refused due to lack of distinctiveness</p> <p>2015.08.20: Review application filed</p> <p>2016.3.17: Review failed</p> <p>2016-2017: Administrative litigation for first and second instances. Decided to refuse the application.</p>	<p>2017.02.03: International registration date</p> <p>2018.04.12: Refused due to lack of distinctiveness</p> <p>No review of refusal filed.</p>	<p>2017.02.15: Application filed</p> <p>2017.11.23: Refused due to lack of distinctiveness</p> <p>2017.12.06: Review application filed</p> <p>2018.07.06: Review decision made</p> <p>No appeal to court.</p>

Lack of distinctiveness



TM No. 10192478

Class 34

designated goods: pipe strip (for pipe); pipe racks for tobacco pipes; tobacco pipes; tobacco pouches; cigar cutter; pocket machines for rolling cigarettes; cigarette tips; cigarette mouth; humidors; lighters for smokers





2011.11.16	Application filed
2012.10.13	Preliminarily approved and published for opposition
2012.11.21	Opposition filed
2013.1.15	Opposition withdrawn
2013.5.13	Registration publication
2018.4.23	Invalidation filed
2019.4.28	Decided to maintain the registration in the invalidation procedure (ruling: though the 3-D shape does not have distinctiveness on the goods, the mark also contains the word "CLIPPER" making the overall mark distinctive)
2019-2022	Administrative litigation before the court, deciding the concerned trademark should be invalidated and requesting the Trademark Office to make a new decision
2023.4.10	The Trademark Office made a new decision to invalidate the trademark

Court rulings:

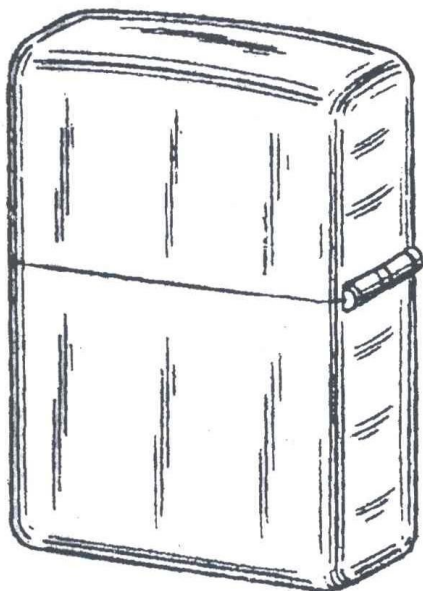
1. The 3-D shape of the concerned trademark is a common shape of a lighter; the word on it is too small in scale; overall, there is no inherent distinctiveness on the designated goods;
2. Not sufficient evidence to prove acquired distinctiveness;
3. The 3-D shape concerned in this case is not necessary for the goods to achieve its function, nor creates any special technical feature, nor has increased the customer's intention to buy, so it is not functional to be used on the designated goods.

Non-functional requirement (Article 12 of the Chinese Trademark Law)



<p>mark</p>				
<p>Class & goods</p>	<p>Class 12 Tyre</p>	<p>Class 8 Shaver head</p>	<p>Class 21 Porcelain bottle</p>	<p>Class 14 ornament</p>
<p>Reasons for refusal</p>	<p>The 3-D shape is necessary or commonly used to achieve the inherent purpose of a product</p>	<p>The 3-D shape is necessary to make the product gain specific functions or to make the inherent functions of the product easier to achieve</p>	<p>The 3-D shape is used to give aesthetic value to the appearance or shape of a product, thereby substantially influencing consumers' purchase intention.</p>	

Non-functional requirement



TM No. 3031816
Class 34
designated goods:
lighters for smokers

2001.12.5	Application filed
2002.8.20	Refused
2002.9.11	Review of refusal filed
2008.7.13	Preliminarily approved and published for opposition
2008.10.13	Opposition filed
2012.4.16	Opposition review filed
2014.4.13	Opposition review decision, decided not to approve for registration
2014-2016	Administrative litigation before the court, deciding the concerned trademark should not be approved for registration

Court rulings:

1. It should be forbidden to enjoy exclusive right over the functional technical feature forever; the right holder may use utility model patent right to protect its creation over some functional technical feature for a limited time to balance the interests of the creator and the public;
2. If the shape of a 3-D logo is essential for the purpose of the product, or affects the cost or quality of the product, then the shape is functional;
3. Evidence of alternative designs usually proves that the shape of the applied trademark does not have functionality, but such alternative designs should have a basic appearance similar to the shape of the applied trademark;
4. The key features of the concerned 3-D shape are unavoidable designs adopted by the lighter manufacturers to make portable, easy to grip, and non-scratch lighter.
5. Since non-functional requirement is not met, there is no need to judge acquired distinctiveness through use.

“imperfect” 3-D mark:

- combination of non-distinctive 3-D shape and distinctive 2-D elements
- the applicant gives up the exclusive right over the 3-D shape

TM No. 56594839	TM No. 37340045	TM No. 29746025	TM No. 58391176	TM No. 66747703
Class 3	Class 3	Class 14	Class 9	Class 7
 <p data-bbox="231 1025 532 1086">立体商标 “立体图形”放弃专用权</p>	 <p data-bbox="621 943 970 1005">立体商标 “立体图形”放弃专用权</p>	 <p data-bbox="1131 1019 1460 1080">立体商标 手表外壳图形放弃专用权</p>	 <p data-bbox="1615 1039 1903 1100">立体商标 “立体图形”放弃专用权</p>	 <p data-bbox="2020 1058 2333 1119">立体商标 “立体图形”放弃专用权</p>

Part III: Enforcement of a product configuration trade mark in China

Trademark VS. Trademark/Trade dress

Trademark infringement & unfair competition

	TM No. 28645718 Class 33	TM No. 5667880 Class 33	TM No. 7107227 Class 33	TM No. 4831519 Class 33
Registered TM				
Infringing products				

Trademark VS. Trademark/Trade dress

Trademark infringement & unfair competition

	<p>TM No. 11839757 Class 30</p>	<p>TM Nos. 13908832, 13723219 Class 21</p>
<p>Registered TM</p>		
<p>Infringing products</p>		

Factors to consider when judging infringement:

1. similarity between the 3-D trademark and infringing products
2. similarity of goods
3. significance and popularity of 3-D trademark
4. subjective malice of the suspected infringer

Trademark VS. Trademark/Trade dress

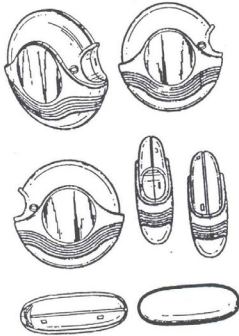
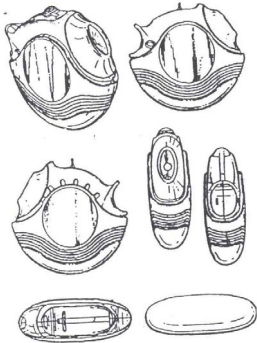
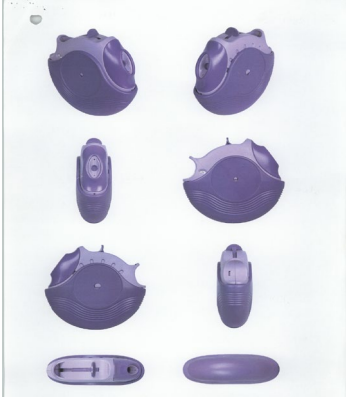
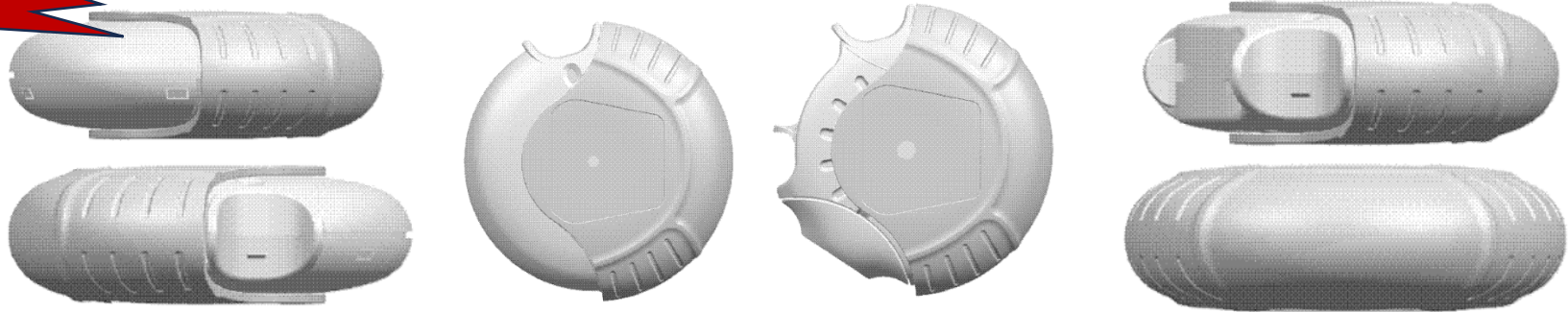
Trademark infringement & unfair competition

Registered TM	Infringing products
TM No. 7830163 Class 33	
	

Court rulings:

1. Although there are differences in the text and other parts of the bottle bodies, the color, shape, and position of the text used on the bottle bodies and caps are very similar, which can easily lead consumers to mistakenly believe that the accused infringing product, “□ □ □” (blue’s blue) is the “□ □ □” (dream’s blue) series products produced by the TM registrant or has a certain association with it.
2. Later acquired design right cannot defend infringement .

3-D Trademark VS Design

	<p>Chinese TM No. 3101099 Class 10 Goods: inhalers; surgical apparatus and instruments; medical apparatus and instruments</p>	<p>Chinese TM No. 3101102 Class 5 Goods: medicines for human purposes; drugs for medical purposes; pharmaceutical preparations</p>	<p>UK TM UK0002353195D Class 10 Goods: inhalers</p>
<p>Earlier 3-D TM</p>			
<p>Chinese design patent ZL 201830353074.2, product: dry powder inhaler (used for medicine inhaling)</p>			
<p>Later design</p>			

invalidated

3-D Trademark VS Design

Earlier 3-D TM	Chinese TM No. 5667880 Class 33 Goods: Alcoholic beverages, except beer
	
Later design	Chinese design patent ZL 201430195368.9, product: bottle for alcohol
	

invalidated

In this case, the prior arts also include other earlier design rights but the court confirmed the similarity between the earlier 3-D mark and the concerned design patent.

Court rulings:

1. The oblique section design of the earlier trademark is very unique and not the usual design for bottle products. As a distinctive part of trademark, it has strong significance.
2. The involved patent and the earlier trademark both include the bottle mouth, bottleneck, and bottle body. The shapes of the bottle mouth and bottleneck are the same, and the fronts of the bottle body have a very obvious oblique plane from the bottleneck to the middle and lower parts of the bottle body. The overall contours of the two are similar.
3. Though there are some differences in details, based on the fact that the overall contour of the patent in question is basically the same as that of the earlier trademark, and the oblique plane position and unique design are similar, the above differences are not sufficient to have a significant impact on the overall visual effect, and the two belong to similar designs.
4. Confusion or misleading will be caused.

3-D Trademark VS Design

Factors to consider when judging infringement:

1. whether the designated goods of the earlier 3-D mark and the product utilizing the design patent belong to the same or similar product category.
Exception: for marks widely known, this test can be relaxed.
2. Whether the earlier 3-D mark and the design are similar/identical to each other.
3. Whether confusion will be caused to harm the interests of the 3-D trademark right holder.

**Part IV: Protection of un-registered product
configuration in China
--Unfair Competition Action**

Protection of unregistered 3-D product configuration --Unfair Competition Action



IR G1031242
refused in China



CHRISTIAN LOUBOUTIN VS Guangdong Wanlima Unfair competition litigation

Court: Beijing IP Court

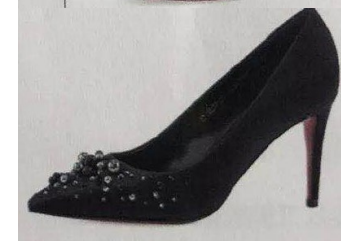
Decision:

1. Infringement established
2. Damage compensation of CNY 5 million plus reasonable cost CNY 445,000 (in total about USD 756,250)

Court ruling:

1. The plaintiff is an interested party over its product name with a certain influence "red sole shoes", and the decoration with a certain influence, i.e., the red decoration used on the outer sole of women's high heels.
2. Evidence submitted by the plaintiff is sufficient to prove that its "red sole shoes" product and red sole decoration have high market awareness, that stable connection between the plaintiff and the "red sole shoes" has been established among the relevant public, and that it have significant distinctiveness to indicate product source. The said product name and decoration shall be protected with Article 6 of the Unfair Competition Law.
3. The defendant's unauthorized use of the product name and decoration of "red sole shoes" is sufficient to mislead the consumers to believe that it has certain specific connections with plaintiff.

Infringing products



Protection of unregistered 3-D product configuration --Unfair Competition Action

Plaintiff's products



KABUSHIKI KAISHA YAKULT HONSHA VS Shanghai Yuejia Food Unfair competition litigation

Court: Shanghai Putuo District Court & Shanghai IP Court

Decision:

1. Infringement established
2. Damage compensation of CNY 350,000 (about USD 48,611)

Court ruling:

1. The two parties manufacture same products and there is competition between the two parties.
2. Evidence submitted by the plaintiff can prove that the packaging and decoration of the 5-in-one-pack "Yakult" lactic acid bacteria milk beverage, through long time use and promotion, has become a product packaging and decoration with high market awareness and significant distinctiveness, sufficient to indicate the source of the product.
3. The defendant's 5-in-one-pack products are similar to the plaintiff's in appearance and the distribution channels and consumers of the two overlap. Confusion about the product source will be and has been caused.
4. The defendant committed infringement of the plaintiff's right before and had reached a settlement agreement with the plaintiff. It therefore has bad faith to commit infringement again.

Infringing products



Part V: tips on protection of product configuration in China

Tips on protection of product configuration in China

1. To Use various means of protection as suitable and possible
2. To avoid functional elements if it is to register as a 3-D trademark
3. To keep distance from others' business logo or designs in similarity
4. To make the design special, creative and unique
5. To put into use and keep using to make it well-known
6. To collect and keep use evidence

Thank you

Dakun IP Law Firm

Patent • TM • Copyright

dakun@dakun-law.com

lenashen@dakun-law.com

www.dakun-law.com



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