

2025 FICPI Symposium

Jeju Korea



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN





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PRACTICE TOPIC 2

A Common Denominator in Trade Mark and Design



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3 April 2025
11:00-12:30

Moderator:

Swarup KUMAR

Managing Partner

Kumar & Sardana Associates (KSA)
India



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Min-Tae KIM

Min-Tae is the Head of the IP Center at CJ CheilJedang Corporation and a key figure in Korea's IP landscape, holding leadership roles (Director) in Korea Intellectual Property Society (KIPS) and Korea Trademark & Design Association (KOTA).

With extensive experience in corporate legal affairs and academia (as a Professor of Economics at Kyonggi University), he also advises on unfair competition matters for KIPO.



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Elia SUGRAÑES

Elia is a leading IP attorney and Director of SUGRAÑES, with over 25 years of experience in IP strategy, trademarks, and legal consultation. She is the Secretary General of FICPI and Member for Catalonia at the COAPI.

She is an active speaker, professor, and WIPO-recognized mediator, playing a key role in international IP organizations.



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Sugrañes^o

Dr. Francesco Paolo VATTI

Francesco Paolo is an accomplished intellectual property specialist with a strong background in industrial chemistry.

A long-standing partner at Fumero, he is deeply involved in FICPI, serving in leadership roles. He is a qualified attorney before the EPO and EUIPO, with expertise in European patent litigation. He has been a visiting professor at the University of Milan and is listed in the register of Technical Experts of the Civil Court of Monza.



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F U M E R O

CONSULENZA
BREVETTI
DAL 1912

Introduction to Dual Protection

- The idea of securing **parallel protection** for the same subject matter as both a **trade mark** and an **industrial design** is an emerging strategy in intellectual property (IP) management.
- This approach allows businesses to maximize legal protection, extend rights beyond standard durations, and strengthen enforcement against infringers.
- Globally, **jurisdictions vary in their stance** on allowing such dual protection, with some permitting overlap and others restricting it.



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Legal Framework and Availability (India)



- India provides separate **legal frameworks** for trademarks and industrial designs:
 - **Trade Marks Act, 1999** – Protects brand identity, including distinctive shapes and configurations.
 - **Designs Act, 2000** – Grants exclusive rights over the appearance of an article for 10 years (extendable to 15 years).
- India allows **overlapping protection** of a design as a trademark, subject to conditions:
 - Initially, a design can be registered under the Designs Act, 2000, offering exclusive rights for a limited period.
 - If the design **gains distinctiveness** due to extensive use, it may later qualify as a trade mark.
 - If the design registration expires or is cancelled, the design owner might still maintain indefinite protection through a trademark.



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Key Differences - Trademarks and Designs

Aspect	Trademark	Design
Purpose	Identifies the source of goods/services and distinguishes them from others.	Enhances the aesthetic appeal of an article.
Legal Framework (India)	Trade Marks Act, 1999	Designs Act, 2000
Nature of Protection	Protects brand identity, including logos, names, and distinctive shapes.	Protects the appearance, shape, configuration, or pattern of an article.
Duration of Protection	Initially 10 years, renewable indefinitely.	10 years, extendable by 5 years (total 15 years).
Requirements for Protection	Must be distinctive and capable of identifying the origin of goods/services.	Must be new and original, with no prior publication or use.
Overlapping Protection	A design can later qualify as a trademark if it acquires distinctiveness.	Trademarks cannot be registered as designs under the Designs Act.
Remedies for Infringement	Trademark infringement action and passing-off claims.	Infringement action but no passing-off remedy while registered.
Examples	Coca-Cola bottle shape (trade dress), Nike logo	Aesthetic patterns on textile designs, unique shapes of consumer products



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Can Trademarks be Registered as Designs and Vice Versa?

- Design Registration for a Trademark: The Designs Act (Section 2(1)(d)) categorically excludes Trademarks from design protection.
- Trademark Registration for a Design: Not explicitly barred, but challenging.
- Judicial interpretations clarify that a Design, upon acquiring secondary meaning, can function as a Trademark.



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1. *Mohan Lal v. Sona Paint & Hardware (2013)*

- **Facts:** The plaintiff, Mohan Lal, alleged that the defendant, Sona Paint & Hardware, was copying a registered design that had become distinctive over time. The case revolved around whether a design that attains secondary meaning can be protected under trade mark law.
- **Ratio:** The Delhi High Court held that a registered design that has acquired secondary meaning and functions as a trade mark can be protected under the common law doctrine of passing off. A passing off action and a design infringement claim can be pursued simultaneously.
- **Crux:** The case clarified that passing off can be claimed for a registered design if it serves as a source identifier.



2. *Carlsberg Breweries v. Som Distilleries (2018)*

- **Facts:** Carlsberg Breweries sued Som Distilleries for allegedly copying the design of its beer bottle, arguing that it had acquired distinctiveness. Som Distilleries countered that Carlsberg's design registration had expired, and it could no longer claim exclusive rights.
- **Ratio:** The Delhi High Court ruled that while a design registration grants exclusive rights for a limited period, a shape that has acquired distinctiveness and acts as a source identifier may qualify for trade mark protection. However, a trade mark registration cannot be used to extend the monopoly of a design beyond its statutory term.
- **Crux:** The case reinforced that trade mark protection for a design is permissible only if it has attained secondary meaning.

Case Laws



3. *Coca-Cola Company v. Bisleri International Pvt. Ltd. (2009)*

- **Facts:** Coca-Cola accused Bisleri of copying its distinctively shaped bottle and packaging design. The dispute centered on whether the bottle shape, initially protected as a design, had become a trade mark due to consumer recognition.
- **Ratio:** The Delhi High Court held that product packaging and bottle shape can function as trade marks if they acquire distinctiveness. The case highlighted the importance of international trade mark protection for product designs.
- **Crux:** Distinctive packaging and product shapes can be protected as trade marks if they become recognizable to consumers.



4. *Gorbatschow Wodka KG v. John Distilleries (2011)*

- **Facts:** The German vodka company Gorbatschow Wodka KG filed a suit against John Distilleries for copying the shape of its vodka bottle, claiming that it had acquired secondary meaning.
- **Ratio:** The Bombay High Court ruled that the distinctive shape of the Gorbatschow Vodka bottle had acquired secondary meaning, warranting trade mark protection.
- **Crux:** Unique product shapes can serve as both a design and trade mark if they function as a source identifier over time.



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Case Laws



5. *Smithkline Beecham Plc v. Hindustan Lever Ltd. (2000):*

- **Facts:** Smithkline Beecham, owner of a well-known product design, alleged that Hindustan Lever's packaging and product shape closely resembled its own, leading to consumer confusion. The dispute centered on whether mere aesthetic appeal was sufficient for trademark protection.
- **Legal Ruling:** The Delhi High Court ruled that aesthetic appeal alone is not enough for trademark protection. For a design to be protected under trademark law, it must acquire distinctiveness—meaning that consumers must associate the design with a specific source over time.
- **Crux:** The judgment clarified that secondary meaning is essential in trademark claims related to product design. A design must function as a source identifier and not merely serve an ornamental purpose. The case reinforced the principle that trademark law protects trade identifiers rather than general design aesthetics.
- **Impact:** This ruling set a precedent that purely decorative or visually appealing elements do not qualify for trademark protection unless they distinguish a brand in consumers' minds. It discouraged companies from claiming indefinite trademark rights over common product shapes without proving distinctiveness.



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Merits and Demerits of Dual Protection

Merits:

1. Extended Protection Beyond Design Tenure

- While a design registration has a limited duration (e.g., 15 years in India), a trademark can be renewed indefinitely.
- This is particularly valuable for product shapes, packaging, and other distinctive features (e.g., Coca-Cola's bottle shape).

2. Stronger Enforcement Against Infringement

- Design rights protect against copying, but do not require the plaintiff to prove likelihood of confusion.
- Trade marks provide broader remedies under passing off and unfair competition laws.

3. Brand Value and Consumer Recognition

- A registered trademark adds brand equity and goodwill, preventing competitors from using similar product appearances.



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Merits and Demerits of Dual Protection

Demerits:

1. Higher Costs and Complex Examination

- Dual registration requires separate applications, increasing legal and administrative costs.
- In many jurisdictions, a shape mark must acquire distinctiveness through use, which is a high threshold.

2. Potential Conflict Between Design and Trade Mark Rights

- Designs protect new and unique appearances, but a trade mark must be distinctive, not merely decorative.
- If a design is functional, it may not qualify as a trade mark.

3. Risk of Cancellation Due to Functionality or Lack of Distinctiveness

- In India, the registrability of shape marks depends on their ability to distinguish goods.
- If the mark is purely functional or lacks acquired distinctiveness, it may face rejection or cancellation.



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Can Trademarks be Registered as Designs and Vice Versa?

- Design Registration for a Trademark: The Designs Act (Section 2(1)(d)) *categorically excludes* Trademarks from design protection.
- Trademark Registration for a Design: *Not explicitly barred*, but challenging.
- Judicial interpretations clarify that a Design, upon *acquiring secondary meaning*, can function as a Trademark.



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Value and Necessity of Dual Protection

- Parallel protection **enhances IP coverage**, especially for iconic product designs.
- Companies aiming for global markets should first register industrial designs and later trademarks as **distinctiveness** develops.
- A careful legal assessment is required to avoid conflicts, manage costs, and align protection with long-term business strategies.



PS: images are AI generated



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 - HIGH COST OF REGISTRATION
 - LOW CHANCES FOR TRADEMARK REGISTRATION
7. CONCLUSION AND SUGGESTIONS

INTRODUCTION

Copypat products are increasing in the food industry
it is difficult to stop them with separate ip rights alone

Companies face design disputes: After the 'Choco Pie case,' conflicts in the food industry continue.

Repeated similar design issues in the food industry cause consumer confusion

NSP통신, 이복현 기자, 2020-10-08 18:24 KRD7

#디자인분쟁 #초코파이분쟁 #식품업계 #특허청기준모호

f 페이스북 t 트위터 c 카카오톡 l 라인 g+ 확대 g- 축소 p 인쇄

‘부정경쟁행위’ 관련 분쟁 만연한데 관련 법과 특허청 기준 여전히 모호해

<최근 5년간(2016~2020년) 특허심판원 디자인 심판 및 무효심결건수>

구분	2016	2017	2018	2019	2020. 8	평균
디자인 무효심판 인용건수	124	138	146	92	70	114

Average 400+ design disputes/year

(특허청)



INTRODUCTION

As the No.1 food company in Korea, we face many copycat products
The need to protect package designs with multiple rights is increasing

CJ sued “D” company for copying package design

Copycat or Counterfeit?

작성 2010.07.23 11:23 조회 1,973

| 특허청 부정경쟁행위 신고...동원 "통상적인 패키지·디자인" 반발



슈퍼나 마트에 나가보면 같은 종류의 제품 중 비슷비슷한 게 많아서 뭐가 뭔지 헷갈리실 때 많으시죠.

제품명은 물론이고, 포장지 색깔, 모양이 비슷해서 꼼꼼히 살펴봐야만 어느 회사 제품인지.. 어떤 재료로 만들었는지를 알 수 있습니다.

이렇게 제품 자체는 물론이고, 이름, 포장 등을 따라한 제품을 '미투상품'이라고 하네요.



Copycats are increasing

ABOUT OUR COMPANY

Forward thinking lifestyle company inspiring a new life of **health**, **happiness**, and **convenience**

We bring delicious indulgences to the table

We aim to globalize the taste of Korea through creating balanced taste between Korean cuisine and local preferences, and share healthy and convenient lifestyle.



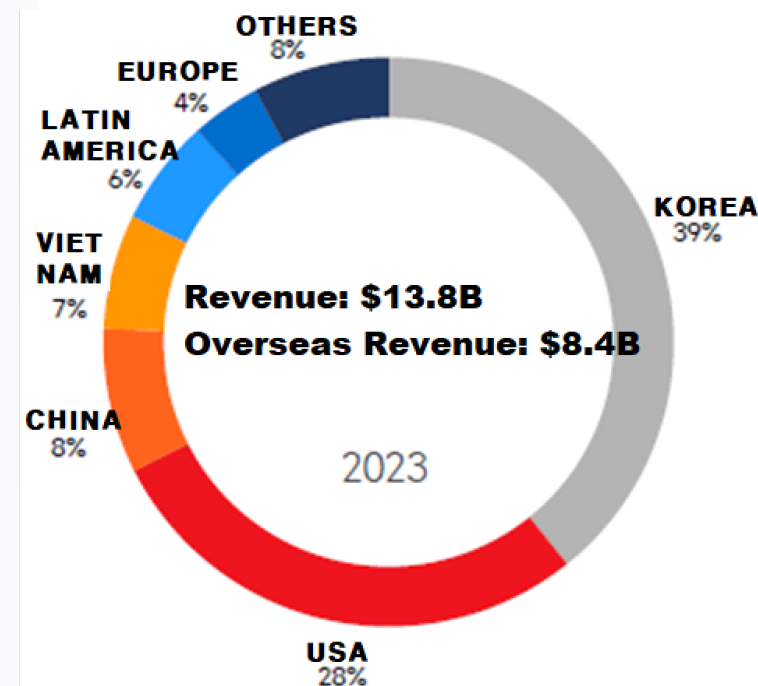
We lead the future of eco-friendly Green BIO technology

The philosophy of the BIO business is to create sustainable life and healthy earth with our eco-friendly technology.



ABOUT OUR COMPANY

From **Korea's No.1 food company** to a **global leader**



ABOUT OUR COMPANY



Global Food Campaign Partner
with Squid Game



Corporate Sponsor for LA Lakers

ABOUT OUR COMPANY

FOOD



BIO

ANIMAL
NUTRITION



TASTE &
NUTRITION



AMINATURE®

tastenrich. flavornrich.™ CJ TIDE

PACKAGE AS A SOURCE IDENTIFIER

Package design impacts how customers see a brand

In global markets, ethnic packaging serves as a **source identifier** for customers

We protect package designs with IP rights to deliver a **good experience of authentic K-Food**



MULTIPLE RIGHTS FOR PRODUCT PROTECTION

✓ BIBIGO Package IP portfolio 포트폴리오

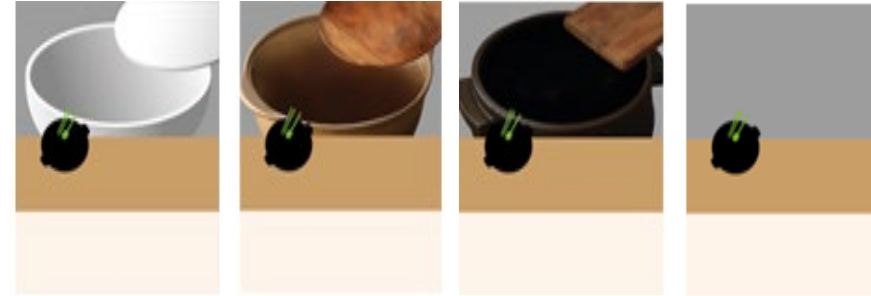


IP 자산

LOGO	
SLOGAN	
LOGO	
Trademark & design	
Design	

Trademark
Design Rights
Copyright

PACKAGE DESIGN PROTECTION EXAMPLES



PACKAGE DESIGN PROTECTION CASES (KOREA)

Easy to enforce against Korean copycat products
Trademark registrations for CORE elements

OUR PRODUCTS



VS



C&D Letters,
Unfair competition Report,
Civil/Criminal action
PACKAGES CHANGED

PACKAGE DESIGN PROTECTION CASES (CHINA)

Various Grounds for Enforcement Against Overseas Copycats



Copyright

Trademark



VS



Civil Lawsuit

PACKAGES CHANGED

DIFFICULTIES IN REGISTERING PACKAGE DESIGN AS A TRADEMARK

High cost for registering IP rights

Protection of Packaging series requires
high costs for trademark, copyright, and design registrations



DIFFICULTIES IN REGISTERING PACKAGE DESIGN AS A TRADEMARK

Low chances of trademark registration for packages

Less likely to be acknowledged for distinctiveness



First **Green** dumpling package

Color trademark filed to enforce copycats issue

"...The color is uncommon in the food industry,

But fails to acquire secondary meaning for dumpling packaging."

→ **Rejected**

CONCLUSION AND SUGGESTIONS

➤ **Bride the gap between market practices and law**

- Recognize the package design as a source identifier

➤ **Establish reasonable criteria For distinctiveness**

- Reduce trademark rejections due to lack of distinctiveness
- Accelerate recognition of secondary meaning to enforce copycat products quickly

THANK YOU

QUESTIONS
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Spain



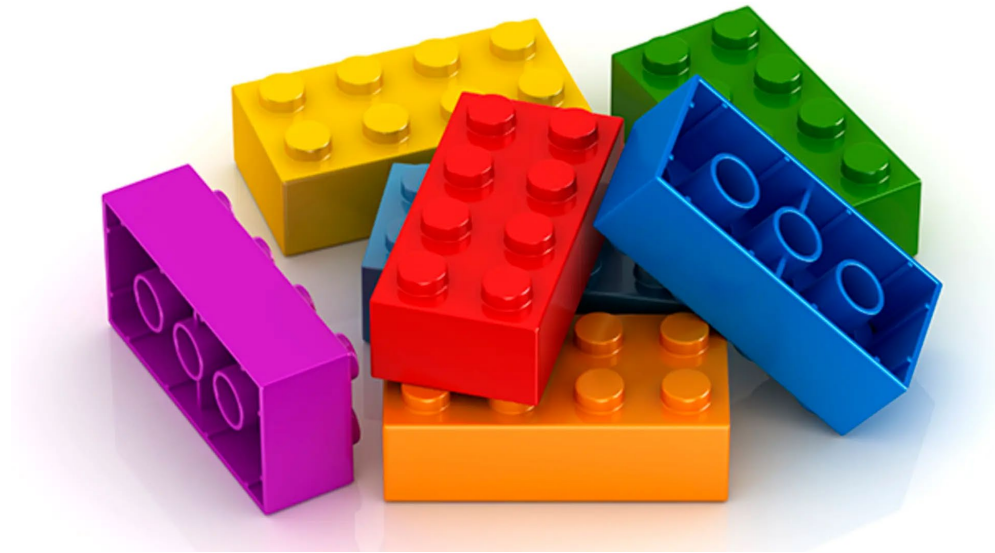
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A Common Denominator in Trademarks and Designs



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Let's break the ice!

Is it a Trademark or a Design...?



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Decision of the General Court of the European Union of 14 July 2021 in case T-488/20 Guerlain.

“In accordance with the case-law, the fact that goods have a high-quality design does not necessarily mean that a mark consisting in the three-dimensional shape of those goods enables ab initio those goods to be distinguished from those of other undertakings, for the purposes of Article 7(1)(b) of Regulation 2017/1001 (judgment of 5 February 2020, Shape of a shoe lace, T-573/18, EU:T:2020:32, paragraph 65).

However, it is not inconceivable that the aesthetic aspect of a mark consisting in the shape of the packaging of a product, in this case its receptacle, may be taken into account, among other factors, in order to establish a difference in relation to the norm and customs of a sector, provided that that aesthetic aspect is understood as referring to the objective and uncommon visual effect produced by the specific design of that mark (judgment of 12 December 2019, EUIPO v Wajos, C-783/18 P, not published, EU:C:2019:1073, paragraph 32).

Consequently, it should be noted that taking into account the aesthetic aspect of the mark applied for must not amount to an assessment of the attractiveness or lack of attractiveness of the product in question, which is by definition subjective, but seeks to determine, in accordance with the case-law referred to in paragraph 43 above, whether that product is capable of generating an objective and uncommon visual effect in the eyes of the relevant public.”



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EU Trademark Regulation 2017/1001

Article 7: Absolute grounds for refusal.

Not registrable (...) signs which consist exclusively of:

- (i) the shape, or another characteristic, which results from the nature of the goods themselves;
- (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;
- (iii) the shape, or another characteristic, which gives substantial value to the goods;



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EU Design Regulation 6/2012

Article 8: Designs dictated by their technical function and designs of interconnections.

1. A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.
2. A Community design shall not subsist in features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.
3. Notwithstanding paragraph 2, a Community design shall under the conditions set out in Articles 5 and 6 subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.



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Trend-setting criteria in case law

Philips Electronics vs. Remington

**Franssons Verkstäder AB vs. Lindner
Recyclingtech GmbH**

Doceram GmbH vs. CeramTec GmbH



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PHILIPS: Opinion of the Advocate General of 23 January 2001 in the Case C-299/99.

MULTIPLICITY OF FORMS CRITERIA



*“34. (...) This means that a functional **design** may, none the less, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.*

35. The Trade Marks Directive excludes all shapes necessary (in the sense of ideally suited) to achieve a technical result. That is to say, in so far as the essential features of a shape are necessary in order to fulfil a function, trade mark protection must not be granted without investigating whether that function could also be achieved by other features.”

Trademark declared invalid



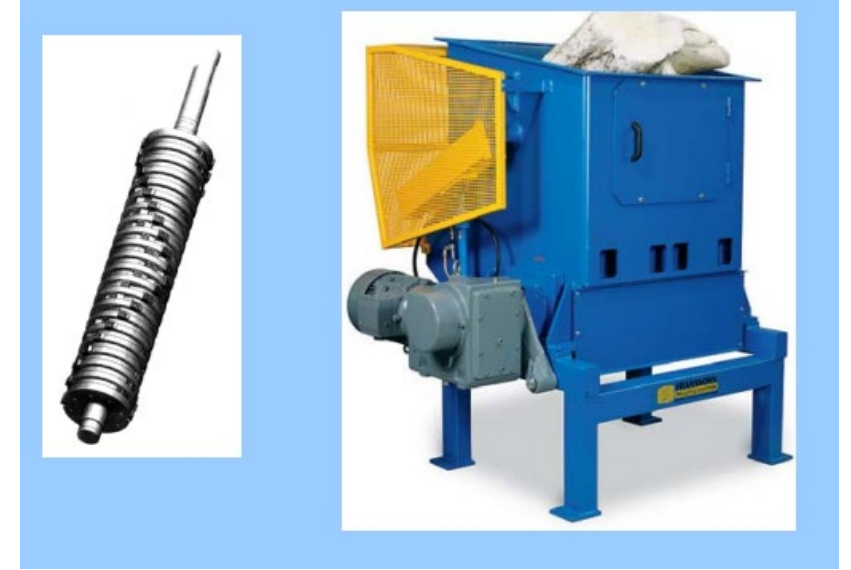
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LINDNER: Decision of the Third Board of Appeal of 22 October 2009, in Case R-690/2007-3.

DESIGNER'S CRITERIA

“30. There is none the less a major flaw in the multiplicity-of-forms theory. If it is accepted that a feature of a product's appearance is not ‘solely dictated by its function’ simply because an alternative product configuration could achieve the same function, Article 8(1) CDR will apply only in highly exceptional circumstances and its very purpose will be in danger of being frustrated. That purpose, as was noted above, is to prevent design law from being used to achieve monopolies over technical solutions, the assumption being that such monopolies are only justified if the more restrictive conditions imposed by patent law (and in some countries by the law of utility models) are complied with.



Design not accepted

“33. Good design involves two fundamental elements: the product must perform its function and it should be pleasant to look at.”



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DOCERAM: Judgment of the Court (Second Chamber) of 8 March 2018 in Case C-395/16.

DESIGNER'S CRITERIA

“31. In light of the foregoing, it must be held that Article 8(1) of Regulation No 6/2002 excludes protection under the law on Community designs for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist.”



RCD No 000242730-0001

Design declared invalid



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LEGO's brick as a Trademark and as Design.



TRADEMARK NOT ACCEPTED (for construction toys)

Judgment of the Court of Justice (Grand Chamber) of September 14, 2010 in Case C-48/09.

“56. (...) under Article 9(1) of Regulation No 40/94 registration as a trade mark of a purely functional product shape is likely to allow the proprietor of that trade mark to prevent other undertakings not only from using the same shape, but also from using similar shapes. A significant number of alternative shapes might therefore become unusable for the proprietor’s competitors.”

DESIGN DECLARED VALID

Judgment of the General Court of January 24, 2024 in Case T-537/22.

37. It follows that a design is declared invalid, in accordance with the provisions of Article 8 of Regulation No 6/2002, only in the case where all of its characteristics are excluded from protection. If at least one of its characteristics is protected, in particular due to the application of the exception provided for in Article 8(3) of that regulation, the design remains valid.

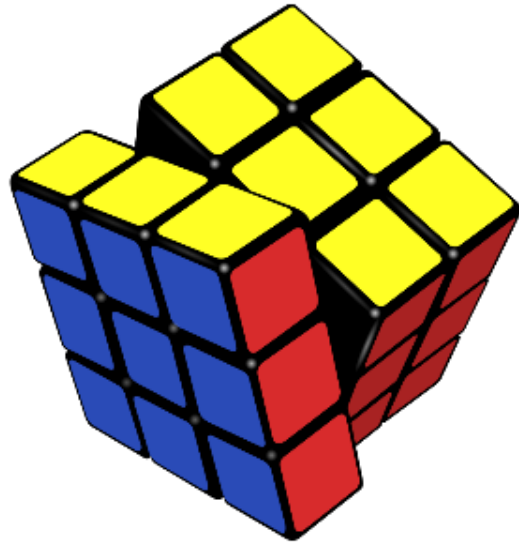


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RUBIK'S CUBE: Judgment of the General Court (Eighth Chamber) of 20 October 2019 in Case T-601/17.



Trademark declared invalid

“90. (...) While it is true that a three-dimensional puzzle with a rotating capability can appear in shapes other than that of a cube, it is, however, irrelevant, as is apparent from the case-law, as regards the examination of the functionality of the essential characteristics of a shape, whether or not there are other shapes which could achieve the same technical result (see, to that effect, judgments of 18 June 2002, Philips, C-299/99, EU:C:2002:377, paragraphs 81 to 83, and of 14 September 2010, Lego Juris v OHIM, C-48/09 P, EU:C:2010:516, paragraphs 53 and 58). It should be emphasised in that context that the registration as a trade mark of a shape is likely to allow the proprietor of that trade mark to prevent other undertakings not only from using the same shape, but also from using similar shapes. A significant number of alternative shapes might therefore become unusable for that proprietor’s competitors (judgment of 14 September 2010, Lego Juris v OHIM, C-48/09 P, EU:C:2010:516, paragraph 56).”

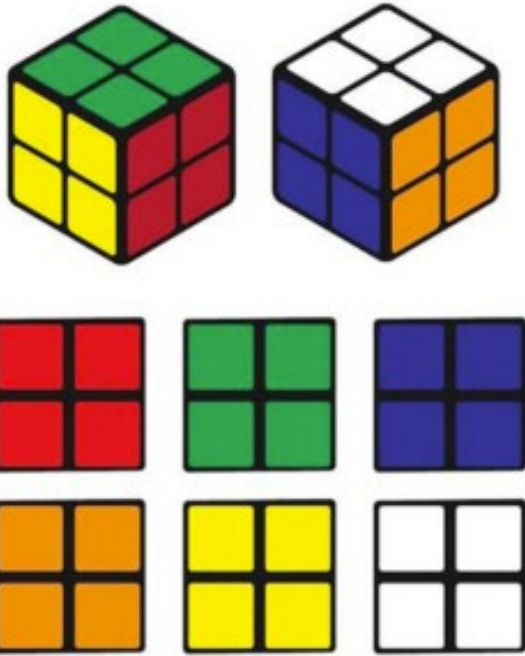


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RUBIK'S CUBE: Decision of the First Board of Appeal of 20 October 2023 in Case R-853/2022-1.



Trademark not accepted

“79. The claim that the colours are not the only solution to obtain the technical result of distinguishing the different cubes rests on the erroneous assumption that the colours are to be distinguished from the shape and must fail for the reasons set out above (paras. 64-71). According to consistent case-law, the existence of alternative shapes capable of achieving the same technical result does not in itself preclude an application from falling foul of Article 7(1)(e)(ii) of Regulation No. 207/2009 (see para. 47). The fact that the same technical result of the Rubik’s cube could be obtained by adding patterns, symbols or letters to the surface of the cubes therefore is irrelevant in the assessment of the functional character of the colours at issue.

80. For the same reason, the argument that the specific choice of the specific colours was made arbitrarily cannot succeed either. (...)

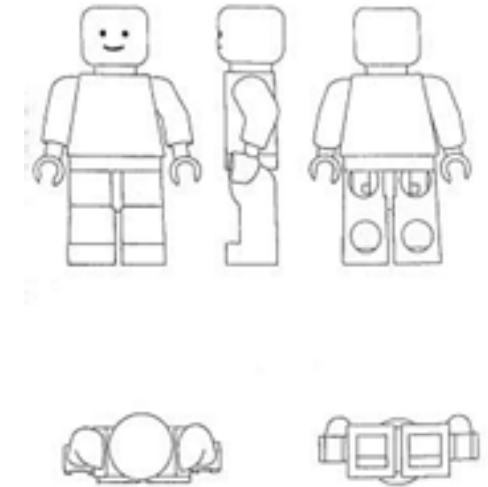


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LEGO's figures: Judgment of the General Court (Sixth Chamber) of 6 December 2023.

“157. In the present case, the shape at issue is therefore capable of protection as an EU trade mark if at least one of its essential characteristics does not stem directly from the technical result of the interlocking nature or modularity of the goods envisaged as an interlocking building figure. Incidentally, it should be noted that the non-technical results of the goods envisaged as a toy figure are irrelevant to Article 7(1)(e)(ii) of Regulation No 40/94 and cannot preclude registration of the contested trade mark.”



Trademark declared valid



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BOEHRINGER: Judgment of the General Court (Second Chamber) of 13 November 2024 in Case T-524/23.

“47. Accordingly, to the extent that it has been established that the patents attribute to the container, the lid and the button – in the same shapes as in the contested mark – technical functions, the Board of Appeal could rightly find that those elements were necessary for inhaling a medical substance.”



Trademark declared invalid

“48. Lastly, although the applicant argues that the technical result sought could also be obtained in alternative shapes, it is sufficient to state, as follows from the case-law referred to in paragraph 21 above, that the possible existence of shapes of other dimensions or other designs, and making it possible to obtain the same technical result, is irrelevant. Such a fact does not mean that the technical solution which those shapes incorporate remains available to other economic operators.



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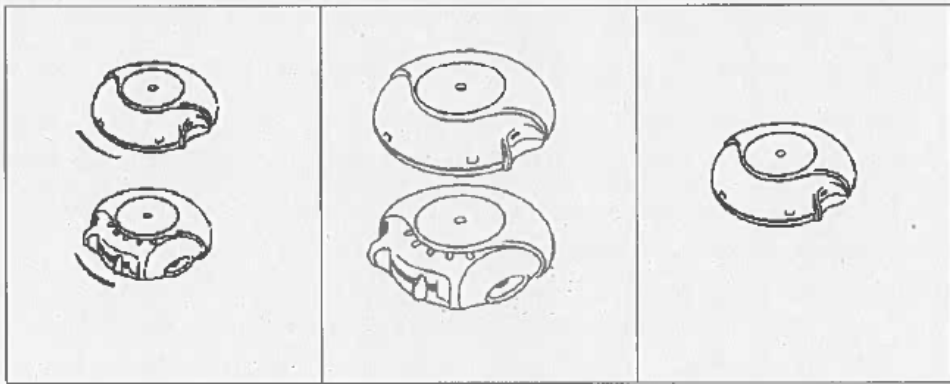
ACCUHALER: Judgment of the Court of First Instance of the European Union No. 25/2024.

GLAXO GROUP LIMITED



MUE	Representación gráfica	Ámbito protección
No. 011131075 Fecha de solicitud: 21 de agosto de 2012 Fecha de registro: 28 de octubre de 2014		Clase 10 (Clasificación de Niza) Clases 17.01.08, 17.01.25, 19.13.25, 98.04 10 (Clasificación de Viena)
No. 011118544 Fecha de solicitud: 14 de agosto de 2012 Fecha de registro: 28 de octubre de 2014		Clase 10 (Clasificación de Niza) Clases 19.13.25 (Clasificación de Viena)
No. 011099711 Fecha de solicitud: 6 de agosto de 2012 Fecha de registro: 6 de noviembre de 2014		Clase 10 (Clasificación de Niza) Clases 19.13.25, 98.04 (Clasificación de Viena)

LABORATORIOS ALDO-UNIÓN



Trademark declared valid



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ACCUHALER: Judgment of the Court of First Instance of the European Union No. 25/2024.

*“27. The defense of the party's rights and legitimate interests does not constitute a bad faith registration. The fact that there was a prior patent that expired does not limit the party's trademark rights since the patent did not protect the shape of the inhaler as reasoned above. In fact, if distinctiveness is also acquired by **secondary meaning**, the fact that there was a prior patent may have served for the sign to achieve such distinctiveness.*

28. A person who legitimately defends his rights in the market cannot be considered as acting in bad faith. (...)”



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ABBOTT Diabetes Pill: Resolution of Appeal of the SPTO of October 19, 2021.



Trademark not accepted

“Whether the shape in question has been the subject of a claim in a granted patent or patent application which constitutes prima facie evidence that the aspects of the shape considered functional in the patent claim are necessary to obtain a technical result.”



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“Molde de Hierro” cider bottle: Judgment of the Supreme Court (Civil Chamber) of July 7, 2023 No. 1190/2023.



Trademark
declared valid

“But it is to be understood that with this last point we are not stating that the existence of alternative shapes does not prevent the ground for invalidity invoked, but rather that, in this case, the wide availability of alternatives and the fact that the registered bottle shape does not express a technical function leads us to consider that its protection as a trademark does not distort effective competition by hindering competitors from the availability of functional or use characteristics that allow the bottle's function to contain cider and make it easier to be poured. Neither the consumer nor the entrepreneur seeks this bottle because of the technical function or use of these characteristics of the bottle, but because its uniqueness allows it to be associated with natural Asturian cider.”



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LIQUID CANDY: Judgment of the Provincial Court of Valencia of June 15, 2020, No. 790/2020.



**Trademark
declared invalid**

“Therefore, to the third question it is appropriate to answer that the challenged mark is a shape that is not differentiated from the rest of the shapes of this product, packaging, which fall within the common, the use or the custom of the sector. And, furthermore, it needs a label containing a word or graphic mark to identify the origin of the products it contains, since, on its own, it does not serve to identify the origin of the business.

Finally, to the fourth question it is appropriate to answer, in accordance with all that has already been explained, that the shape used in the packaging could, if necessary (this is not the object of this procedure) serve as an industrial design to make the product more attractive to the competition but does not serve, in itself, to identify the business origin of the product”.

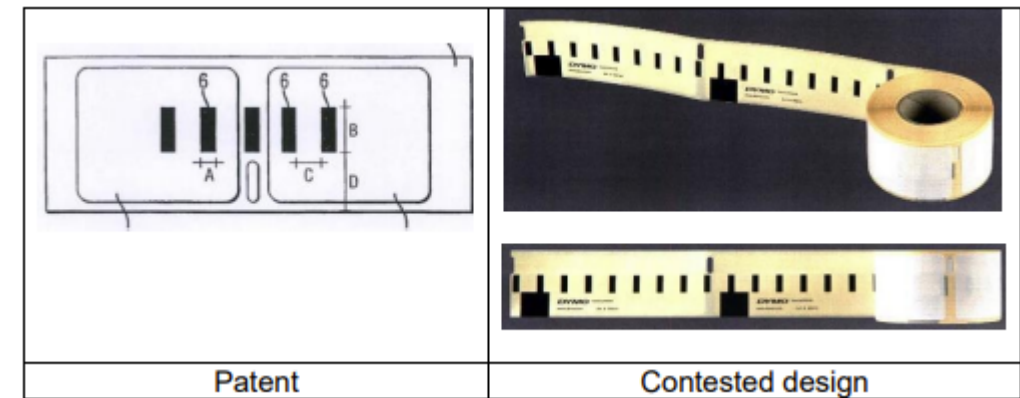


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LABELS: Decision of the Third Board of Appeal of 10 November 2021 in Case R 2413/2018-3.

The BoA examined all the features of the design and compared them with the scope of the patent. It deduced from the patent documentation that only part of the features matched the patent description (the holes and print marks to be read by the sensor enabling the printing process). However, the remaining features, namely the yellow strip to which adhesive white labels are attached, were not contained within the patent description and there is no evidence that these features are solely dictated by the technical function of a printer label (§ 28-30). Therefore, the ground of invalidity under Article 8(1) CDR did not succeed (§ 35).



Design declared valid

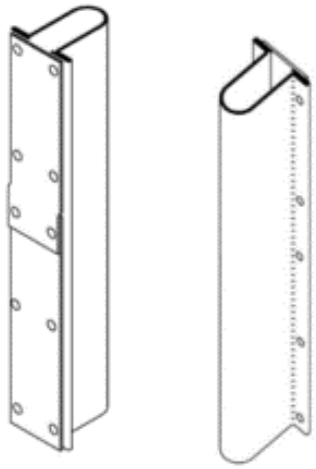


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POSTS: Judgment of the General Court (Sixth Chamber) of October 19, 2022.



“46. In the present case, the applicant relies on the evidence which the intervener provided during the proceedings before EUIPO (Annexes 3, 4 and 5 to the application for a declaration of invalidity), which shows that security fence posts which have shapes that are different from that of the contested design exist. Consequently, even though the existence of alternative designs is not on its own decisive, the Board of Appeal should not have excluded it from its assessment of the considerations which dictated the features of appearance of the product concerned.”

Design declared invalid

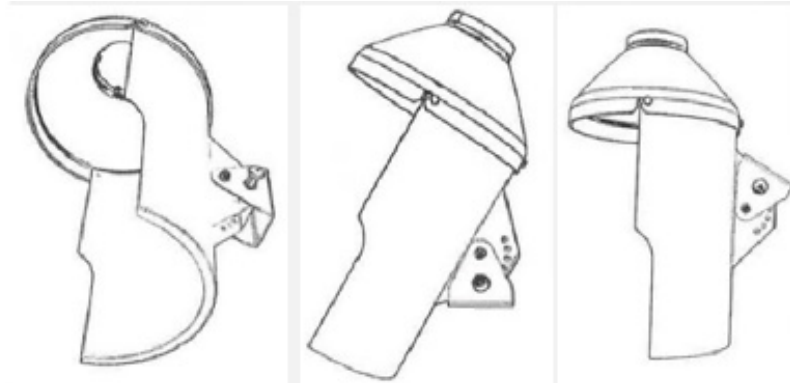


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PAPIERFABRIEK (packaging machine): Judgment of the Court of Justice of the European Union of 2 March 2023 in Case C-684/21.

“23. In light of the foregoing considerations, it is necessary to answer the first question by stating that Article 8(1) of Regulation No. 6/2002 must be interpreted as meaning that the assessment of whether the characteristics of the appearance of a product are exclusively dictated by its technical function, within the meaning of this provision, must be made in light of all the relevant objective circumstances of the case, in particular those guiding the choice of those characteristics, the existence of alternative designs or models capable of performing this technical function, and the fact that the holder of the concerned design or model is also the holder of registrations for a large number of alternative designs or models. However, the latter fact is not decisive for the purpose of applying this provision.”



Design declared valid



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ADS L: Judgment of the Court of Justice (Third Chamber) of 15 January 2025 in Case T-1064/23.

*“86. However, in accordance with the case-law, the existence of a utility model is **virtually irrefutable proof** that the characteristics it discloses or claims are functional (see, to that effect, judgment of 27 June 2017, Flamagas/EUIPO – MatMind (CLIPPER), T-580/15, not published, EU:T:2017:433, paragraph 47 and the case-law cited).”*



Design declared invalid

“88. The Board of Appeal also took into account, in accordance with the case-law cited in paragraph 82 above, that there were alternative designs as regards the size, shape and position of the identified features. However, according to the Board of Appeal, those designs could also be dictated exclusively by a technical function, which, in its view, was the case here, in accordance with the evidence produced before it.”



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Conclusions

To determine whether the prohibition applies, each case must be examined individually. However, the following framework must always be followed:

1. Determine the technical function of the product in question.
2. Analyze the characteristics of the product's appearance, depending on the type of protection. For trademarks, it must be ascertained whether all the essential characteristics perform a technical function in the goods at issue while for designs, the characteristics of the product's appearance must be examined under Article 8(1) of Regulation No 6/2002.
 - The technical functionality of a shape's characteristics may be assessed by considering documents such as previous patents describing its functional elements.
3. Assess whether the characteristics are exclusively dictated by technical function, which is the most complex and debated step. This requires evaluating all relevant objective circumstances to determine whether the need to achieve the technical function was the only factor influencing the designer's choice. If other considerations, such as aesthetic aspects, played any role, the prohibition does not apply.



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Thank you for your attention!



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Dr. Francesco Paolo VATTI

Managing Partner Fumero

Italy



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VON PATENTANWÄLTEN

F U M E R O

CONSULENZA
BREVETTI
DAL 1912

Design law in EU (Council Regulation No. 6/2002)

Requirements for registering a design:

- Novelty (Article 4)
- Individual character (Article 4)
- In case of complex products, components can be registered if visible and if novelty and individual character are present in themselves

- A design shall be considered to be new if no identical design has been made available to the public:
 - (a) unregistered Community design, before the first time it has been made available to the public;
 - (b) registered Community design, before filing date or priority date.

A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the one produced on such a user by any design made available to the public:

(a) unregistered Community design: before it was first been made available to the public;

(b) registered Community design, before the filing date or priority date.

The degree of freedom of the designer in developing the design shall be taken into consideration.

- Not solely dictated by its technical function.
- Not necessarily to be reproduced in exact form and dimensions in order to permit the product in which the design is incorporated to be mechanically connected to another product so that either product may perform its function.
- However, a Community design shall subsist in a design serving the purpose of allowing the multiple assembly or connection of mutually interchangeable products within a modular system.

Introduction

Italian law (Codice di Proprietà Industriale [IP Code])

Requirement for registering a design:

- Novelty
- Individual character
- Same criteria as the EU design
- Shape not dictated by the technical function nor in order to allow connection to other parts for their technical function

Italian law

Trade marks

Art. 7: all signs, in particular words, logotypes, letters, digits, sounds, the shape of a product or of its packaging, colour combination or shades can be registered as trade marks, provided they can enable:

Italian law

Art 7 (contd): a) to recognise products or services from an enterprise from the ones from other enterprises; and

b) to represent them in the register, so as to allow authorities and public to clearly understand the object of protection.

Italian law

Art. 9: 3-D signs which cannot be registered:

- a) a shape imposed by the nature of the product itself;
- b) a shape or other feature needed for reaching a technical result;
- c) a shape or other feature providing the product with a substantial value.

Italian law

Art 12: a trade mark is novel if it is not identical or similar to another registered or unregistered trade mark nor it can be confused with such other trade mark.

If the trade mark which is identical, similar or can be confused is a registered trade mark elapsed since at least two years novelty is still met.

Italian law

Trade marks having no distinctive character cannot be registered.

Exclusion is for words commonly used to describe a product, its quality and features.

The use can make distinctive a non distinctive trade mark.

Italian law

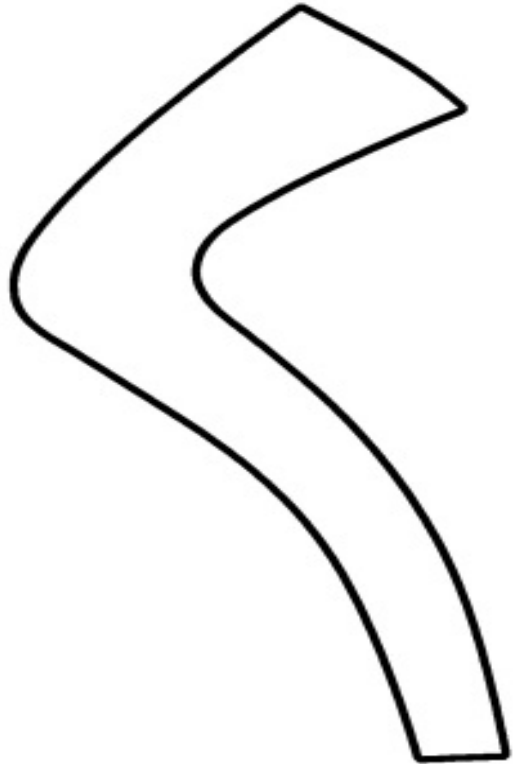
Requirements are rather similar, but not identical.

In particular: distinctive character is different than individual character!

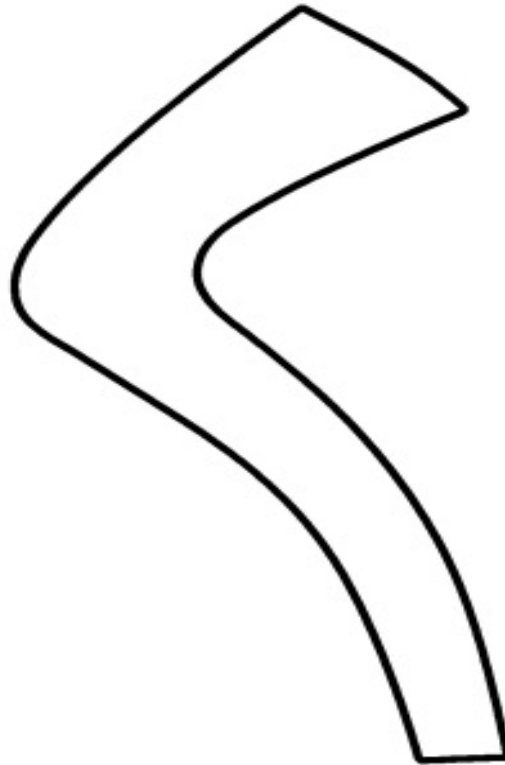
Categories of trade marks

- Words
- Words with a particular font
- Logotype
- Coloured logotypes
- 3D trade marks
- Sounds
- Colours
- “New trade marks”: position, movement...

Exemplary cases



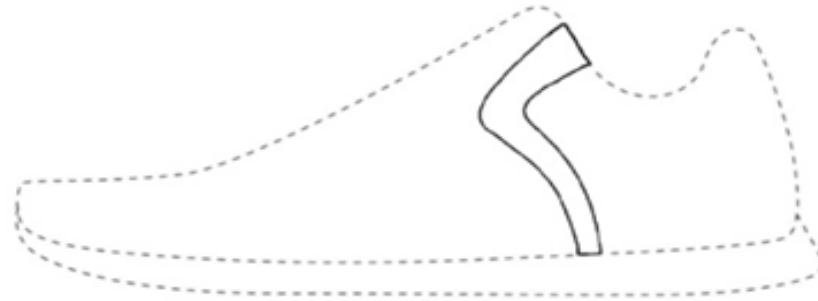
Exemplary cases: 1) Trade mark “whisker”



Exemplary cases: 1) “Whisker”

- EU trade mark application filed on 1 April '16
- Refusal issued on 24 April '16, because the sign is seen as non distinctive. “More a design than a trade mark.”
- Reply sent to EUIPO on 18 May '16.
- Refusal confirmed on 19 May '16
- Appeal lodged on 16 June '16 and rejected on 23 December '16

Exemplary cases: 1) “Whisker”
Filed as Italian trade mark with a different
device:



Exemplary cases: 1) “Whisker”

- filed on 1 December '18
- opposition received on 19 April '19
- decision on 4 November '21 to maintain the trade mark only in classes 9 and 18
- Grant on 5 February '25

Exemplary cases: 1) “Whisker”

- International registration applied for on 22 June '18, designating Benelux, China, Spain, France, Japan, Russia
- List of goods limited in France, Japan and Russia (funnily, only for footwear!)
- Refused in Spain and Germany

Exemplary cases: 2) Handwheel



Exemplary cases: 2) Handwheel

- Most components of the handwheel have the shape dictated by technical needs; however, the internal disc in aluminium has no technical effect
- This internal disc is a feature which allows to recognise the handwheel produced by the Client from handwheels produced by other manufacturers.

Exemplary cases: 2) Handwheel

The protection was sought through a law which is rather peculiar in the Italian jurisdiction: a form of unloyal competition. This is really a common denominator between trade marks and designs!

This law prevents any manufacturer from producing and selling products which are so identical to products of another manufacturer to reproduce even unnecessary, characterising elements.

Exemplary cases: 2) Handwheel

Two degrees of judgment.

In the first degree, the Court of Bergamo stated the following:

- The slavish reproduction does not refer to technical features
- Individual characters of the first handwheel had been reproduced in the second one
- The effect is confusion on the market.

Exemplary cases: 2) Handwheel

- To punish the slavish reproduction, two requirements were requested by the Court:
 - 1) the presence of individualising characters
 - 2) the reproduction of such characters, so as to create confusion in the market.
- Confusion should arise far from the sight and after a certain time, basing on the recollection.
- The assessment should be performed on visible parts.

Exemplary cases: 2) Handwheel

The Court of Appeal of Brescia basically confirmed the first instance judgment.

- All parts of the handwheel are in black plastic
- However, only the disc of aluminium has no technical purpose
- All parts are reproduced, are they necessary or not, creating the impression of the same product.
- The reproduction even of the disc makes the copy illegal

Exemplary cases: 2) Handwheel

The confusion was stated for the whole handwheel and not only for the aluminium disc.

Exemplary cases: 2) Handwheel

This was confirmed in a more recent decision of the Court of Milan.

Handwheel was present on a machine exposed at the fair of Milan in 2003.

The Client's handwheel was recognised as new and original, since it showed elements not technically needed and making the handwheel different than the others.

Exemplary cases: 3) Scooter

In EU:

- Piaggio filed the EU trade mark No. 011686573
- Its reproduction:



Exemplary cases: 3) Scooter
- It corresponds to:



Exemplary cases: 3) Scooter

- The Examiner refused the trade mark because of lack of distinctive character
- Piaggio showed the distinctive character was acquired through use.
- Nullity action requested on the basis of Art. 60(2)d and Art. 59(1)a of the regulation on the EU trade mark.

Exemplary cases: 3) Scooter

Art. 60

(2)2. An EU trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the Union legislation or national law governing its protection, and in particular:

Exemplary cases: 3) Scooter

Art. 60

- (a) a right to a name;
- (b) a right of personal portrayal;
- (c) a copyright;
- (d) an industrial property right

- Reference was to a previous EU design registered in 2010

Exemplary cases: 3) Scooter

Article 59

1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:
(a) where the EU trade mark has been registered contrary to the provisions of Article 7.

Exemplary cases: 3) Scooter

Article 7

1. The following shall not be registered:
 - (b) trade marks which are devoid of any distinctive character;
 - (e) signs which consist exclusively of:
 - (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;
 - (iii) the shape, or another characteristic, which gives substantial value to the goods.

Exemplary cases: 3) Scooter

- The nullity action was rejected, but the subsequent appeal led to the rejection of the trade mark
- Court of Justice – First instance
- Reference public: the general public
- The shape of the scooter is not different from the general shape, therefore no distinctive character
- Moreover, the parts have purely ornamental features, no distinctive character.

Exemplary cases: 3) Scooter

- Also the combination of part has nothing of original
- However: the results of surveys and the iconic character of Vespa led to establish the acquired distinctive character.

Exemplary cases: 3) Scooter

- Lawsuit at the Italian Supreme Court
- Vespa scooter was protected through an EU design
- Protection also with an Italian trade mark, like the EU one seen before (the latter being the basis for claiming priority).

Exemplary cases: 3) Scooter

- The same subject of the EU case requested to declare that it was not infringing the design and the trade mark and that the trade mark was invalid
- Piaggio requested to reject the claim and further to declare at least the infringement of a copyright.

Exemplary cases: 3) Scooter

The court of first instance accepted the request of Piaggio.

The Court of Appeal confirmed the decision.

Exemplary cases: 3) Scooter

The decision in the first instance stated that the shape is not such to give the object a substantial value, since the public would choose Vespa also for technical reasons.

Infringement was declared for the design, the trade mark and the copyright.

Copyright was agreed because the design in the decades had acquired a sort of artistic value.

Exemplary cases: 3) Scooter

- Vespa is in some museums, among which the MOMA of New York



Exemplary cases: 3) Scooter

- The losing party lodged an Appeal at the Supreme Court in Rome. Piaggio counterclaimed in the same proceedings.

Exemplary cases: 3) Scooter

1) It is not necessary that the aesthetic features are dominant to give the product a substantial value.

Copyright is valid, since the design is iconic.

However, copyright can give the shape a substantial value. The Court of Appeal did not explain why the shape in the 3D trade mark has not substantial value.

Exemplary cases: 3) Scooter

- 2) When an industrial product is seen as an intellectual creation, the reproduction and marketing of a product which can be confused with such intellectual creation by another subject is infringement of the copyright related to such creation

Exemplary cases: 3) Scooter

- 3) Copyright protects also modifications and variants.

PRACTICE TOPIC 2

A Common Denominator in Trade Mark and Design - DISCUSSION



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INTERNATIONAL FEDERATION OF
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3 April 2025
11:00-12:30