

XXXIX **2019** **abpi**
INTERNATIONAL CONGRESS ON
INTELLECTUAL PROPERTY | ABPI
25|27
AUGUST
RIO | BRAZIL





«TRADE DRESS» IN THE EUROPEAN UNION

Renata Righetti

President of AIPPI, Bugnion SpA





Trade dress in EU



There is no “Trade Dress” Statutory Law in EU.

Protection derives from a combination of matters, provisions and **Statutory Rights**, including
Trademarks, Designs and Copyright.



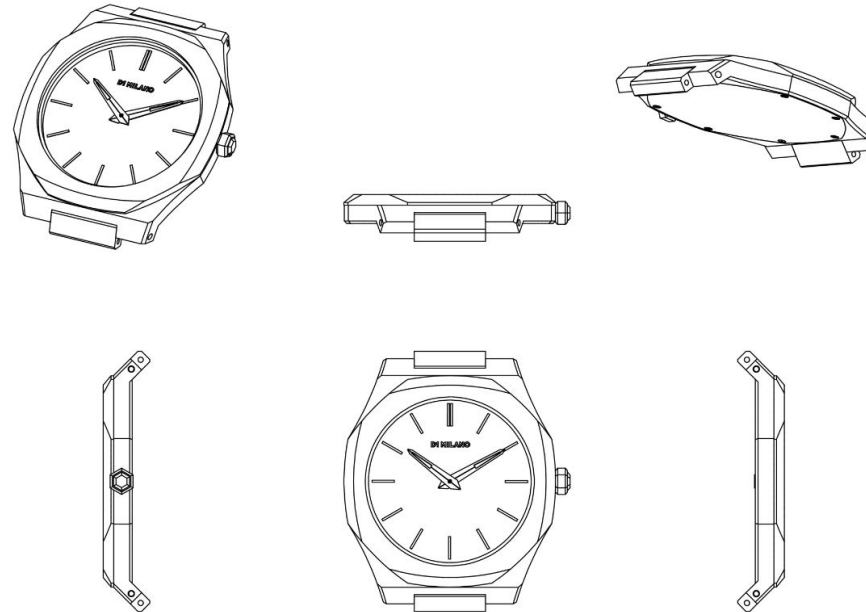


Trade dress in EU



Trade dress refers to the **visual appearance of a product** and/or its packaging as well as their features.

The shape of a product:
3D EUTM 017971654





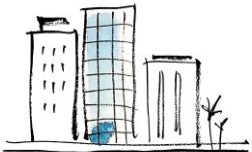
Trade dress in EU



Trade dress refers to the **visual appearance of** a product and/or **its packaging** as well as their features.

The shape of a packaging:

3D EUTM Reg. 005170097



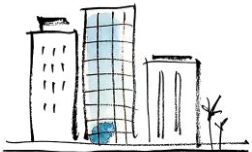


Trade dress in EU



Trade dress refers to the visual appearance of a product and/or its packaging as well as **their features**.

The color of a product:
Color EUTM Reg. 017694076



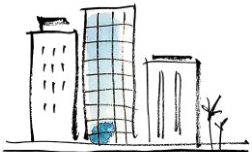


Trade dress in EU



Trade dress refers to the visual appearance of a product and/or its packaging as well as **their features**.

The storefront – disposition of the features in the shop
IR No. 1060321





Combination of Trademark/Design/Copyright law



EU Trademark Provisions:

ART 7.1.e EUTMR

The following **shall not be registered** [...]

(e) 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;





Combination of Trademark/Design/Copyright law



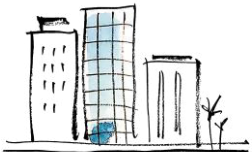
EU Design Provisions:

Art. 4.1 CDR

1. A design **shall be protected** by a Community design **to the extent that it is new and has individual character.**

Art. 8.1 CDR

1. A Community design **shall not subsist in features** of appearance of a product which are **solely dictated by its technical function.**





Combination of Trademark/Design/Copyright law



NO EU Copyright Law applicable directly to Member States:

“The **EU copyright legislation is a set of eleven directives** and **two regulations**, which harmonise essential rights of authors and of performers, producers and broadcasters.

By setting harmonised standards, the EU law reduces national discrepancies, ensures the level of protection required to foster creativity and investment in creativity, promotes cultural diversity and ensures better access for consumers and business to digital content and services across Europe.”

(Source: European Commission)

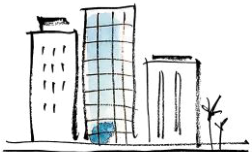




The selection process



- 1. Trademark**
- 2. Design**
- 3. Copyright**





Trademark protection



Why EU Trademark first?

- i) It is **renewable** for an unlimited period of time (ten years after ten years)
- ii) It protects a **broader subject matter** (the likelihood of confusion standards for trademarks apply).
- iii) The subjective point of view to take into account, when assessing similarity/invalidity, is the **"average consumer" instead of "informed user"** in the particular field of expertise.
- iv) There is **no issue of "disclosure" or "pre-publication"** to be taken into account.





└ A few examples of EU TMS/ Trade Dress

A few examples of EU TMS perceived as Trade Dress



Philips vs Remington

(First decision – principles – exceptionally mentioning of use)

Only marks having a distinctive character by their nature or by their use are capable of distinguishing the goods claimed from the goods of other undertakings and, as a result, capable of being registered.

Interpreting art. 3(1) and (3) of EEC Directive No. 89/104 to approximate the laws of the Member States relating to trademarks, in particular tridimensional EU trademarks

ECJ found :

- **the shape of a product does not necessarily require any capricious addition which has no functional purpose.**
- when it consists exclusively of the shape of a product, **a sign is unregistrable** provided that the essential functional features of that shape are **attributable only to the technical result.**

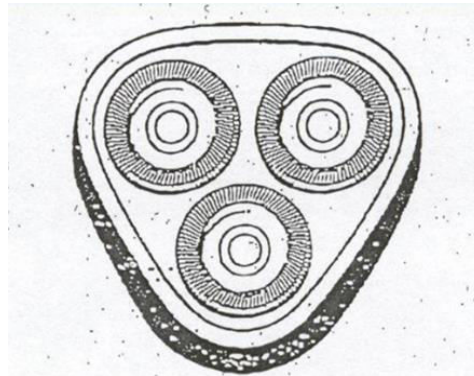


A few examples of EU TMS perceived as Trade Dress



Philips vs Remington

*"it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of **specific and reliable data**, that the presumed expectations of an **average consumer** of the category of goods or services in question, who is reasonably **well-informed and reasonably observant and circumspect**, are taken into account and that the identification, by the relevant class of persons, of the product as originating from a given undertaking is as a result of the use of the mark as a trade mark".*



C-299/99



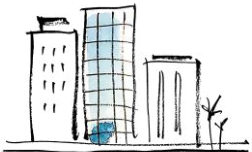
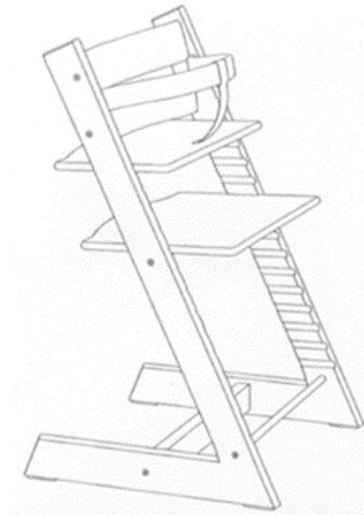
A few examples of EU TMS perceived as Trade Dress



Hauck vs Stokke

Interpreting art. 3(1)(e)(i) of Directive 2008/95/EC, namely, **prohibition of registration as a trademark for shapes resulting from the nature of the goods.**

- Article 3(1)(e)(iii) which **prohibits the registration of shapes that give substantial value to the goods.**



┌ A few examples of EU TMS perceived as Trade Dress



Hauck vs Stokke

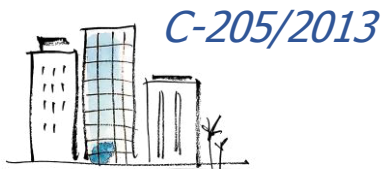
ECJ found:

Tridimensional trademarks should be refused when:

- i) the sign consists exclusively of the shape of the products
- ii) together with the shape of a product, **the sign consists of one or more essential characteristics typical of the general/comprehensive functions of the product itself**
- iii) **Such functions should be the typical functions that consumers would look for** in the product of competitors

The refusal applies **even if the shape is not indispensable to the function of the goods.**

One of the stricter decision on “trade dress” in EU



A few examples of EU TMS perceived as Trade Dress

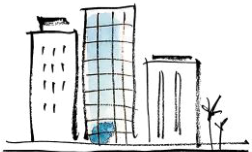


Christian Louboutin +1 vs van Haren Schoenen BV

CJEU Advocate General:

*"A trade mark combining colour and shape **may be refused** or declared invalid on the grounds set out under EU trade mark law.*

The analysis must relate exclusively to the intrinsic value of the shape and take no account of attractiveness of the goods flowing from the reputation of the mark or its proprietor".



A few examples of EU TMS perceived as Trade Dress

Christian Louboutin +1 vs van Haren Schoenen BV



ECJ:

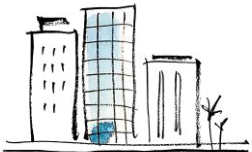
*[...] **it cannot, however, be held that a sign consists of that shape** in the case where the registration of the mark did not seek to protect that shape **but sought solely to protect the application of a colour to a specific part of that product.***

*[...] the description of that mark explicitly **states** that the contour of the shoe does not form part of the mark and is intended purely to show **the positioning** of the red colour covered by the registration.*

*In any event, a sign, such as that at issue in the main proceedings, cannot be regarded as consisting 'exclusively' of a shape, where, as in the present instance, the main element of that sign is **a specific colour** designated by an internationally recognised identification code.*

*In the light of the foregoing [...] Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that **a sign consisting of a colour applied to the sole** of a high-heeled shoe, such as that at issue in the main proceedings, **does not consist exclusively of a 'shape'**, within the meaning of that provision." (paragraph 24-27).*

C-163/16



A few examples of EU TMS perceived as Trade Dress

Red Bull GmbH vs EUIPO

This is the most recent Decision dated **July 29, 2019**

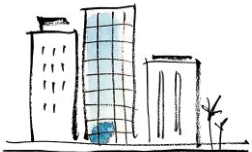
ECJ, upholding the Decision of the General Court in favor of EUIPO stated that:

"...the EUIPO declared the two marks in question ('the marks at issue') invalid, inter alia on the ground that they were not sufficiently precise.[...] Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%–50%

[...] the mere indication of the ratio of the two colours blue and silver allowed for the arrangement of those colours in numerous different combinations and did not therefore constitute a systematic arrangement associating the colours in a predetermined and uniform way

[...]The appeal must be dismissed as in part unfounded and in part inadmissible"

C-124/18

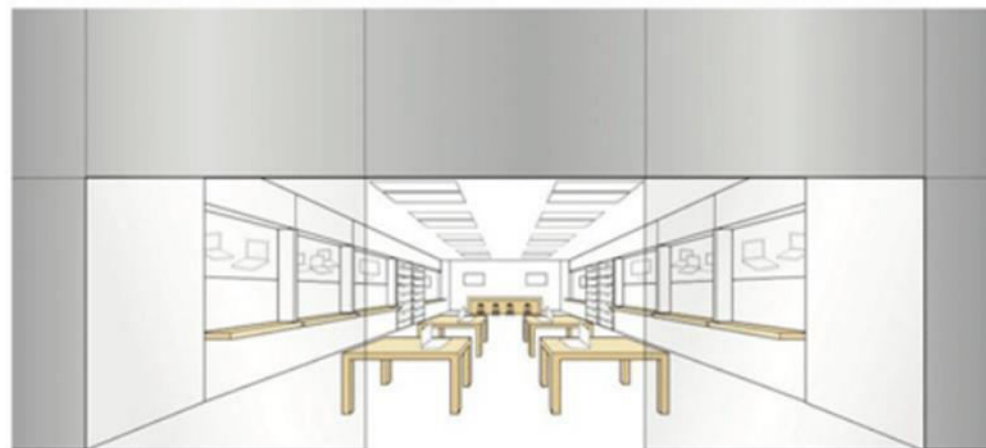




EU system – EUIPO/28 member states



“Presentation of the establishment” – IR No. 1060321



Registration

2010/50 Gaz, 06.01.2011, US2010/50 Gaz, 06.01.2011, AU, BX, CH, CN, DE, ES, FR, GB, IL, IT, JP, KR, MC, NO, PL, RU, SE, SG, TR





EU system – EUIPO/ 28 member states



Apple Inc. vs DPMA

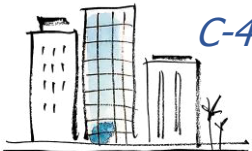
GERMAN PTO

- 1) *Examiners issue a refusal*
- 2) *BoA entrusts the ECJ to interpret the Directive*

ECJ:

*"[...] a representation, such as that at issue in the main proceedings, which **depicts the layout of a retail store** by means of an integral collection of lines, curves and shapes, **may constitute a trade mark** provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings [...].*

***The distinctive character of the sign must be assessed in concreto by reference to, first, the goods or services in question and, second, the perception of the relevant public, namely the average consumer of the category of goods or services in question,** who is reasonably well informed and reasonably observant and circumspect (see, in particular, *Linde and Others*, C-53/01 to C-55/01, EU:C:2003:206, paragraph 41; *Koninklijke KPN Nederland*, C-363/99, EU:C:2004:86, paragraph 34; and *OHIM v BORCO-Marken-Import Matthiesen*, EU:C:2010:508, paragraphs 32 and 35)."*



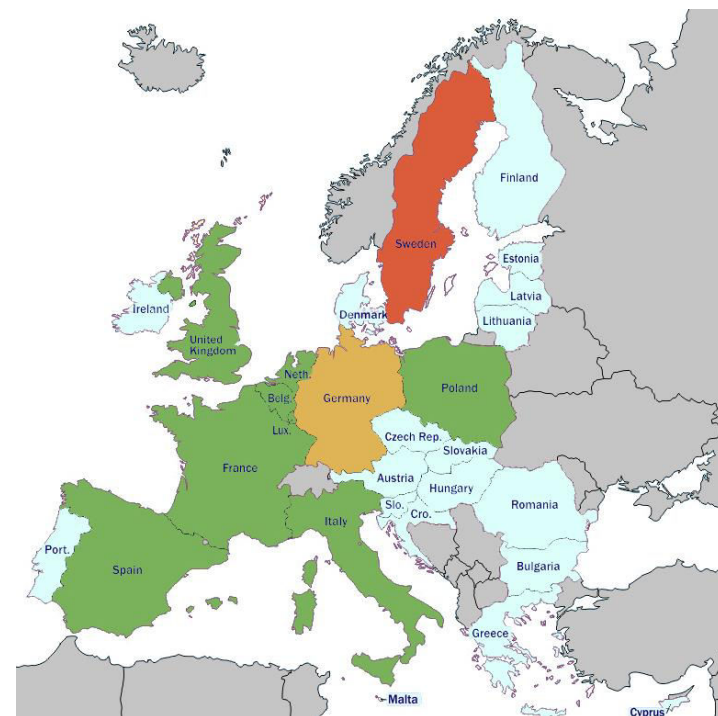
C-421/13





EU system – EUIPO/28 member states

Apple Inc. v. DPMA (C-421/13)



-  Trademark registered
-  Trademark retired
-  Trademark refused





Design protection



A powerful option too, why?

- i) It's **easy**
- ii) It's **low cost**
- iii) It lasts up to **25 years**
- iv) It **could** occasionally **become a TM** (secondary meaning)
- v) It has wide **unlimited** possible **subject matter**





└ A few examples of Community Design/ Trade Dress



A few examples of Community Design perceived as trade dress



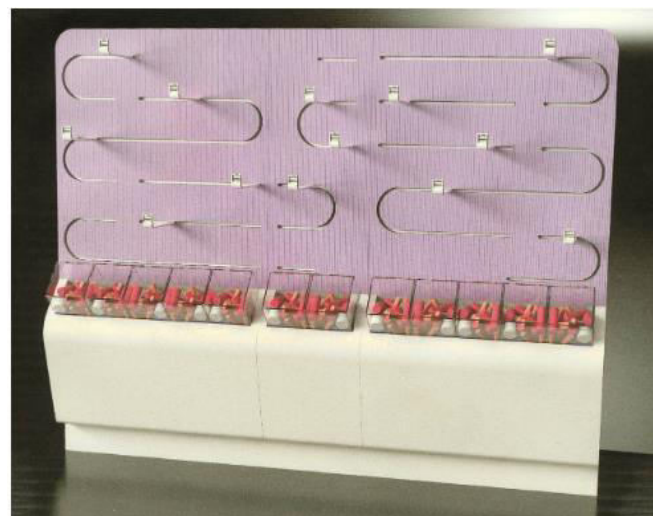
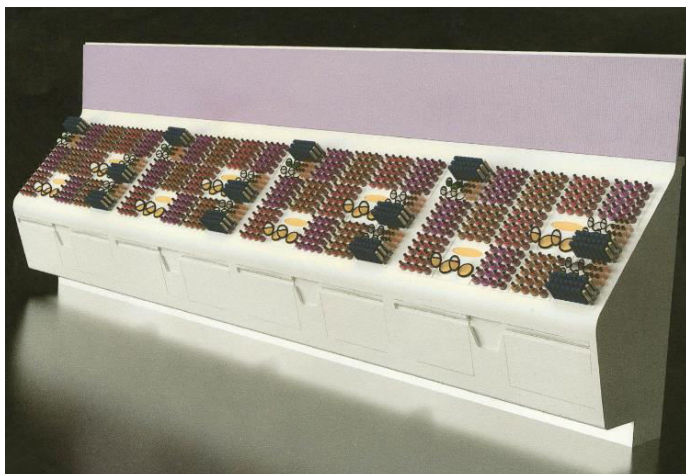
RCD 001243570-0001

Locarno

32.00

Indication of the product

Furniture, Shop ornamentation and decoration





A few examples of Community Design perceived as trade dress



RCD 001243570-0001

Locarno

32.00

Values

Furniture, Shop
ornamentation and
decoration



A few examples of Community Design perceived as trade dress

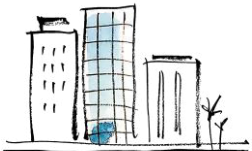
RCD 002422428-0001

Locarno

19.04

Values

Covers for magazines



A few examples of Community Design perceived as trade dress



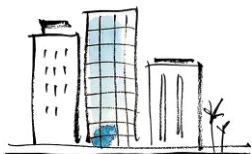
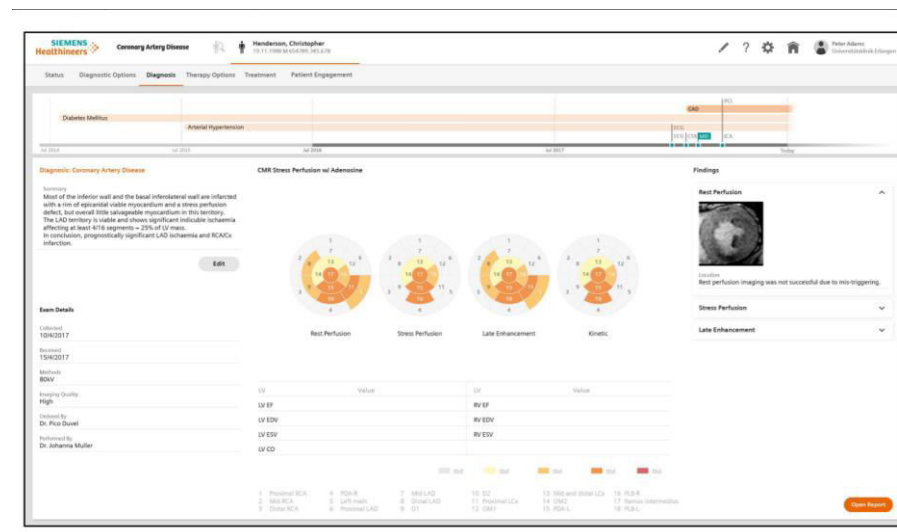
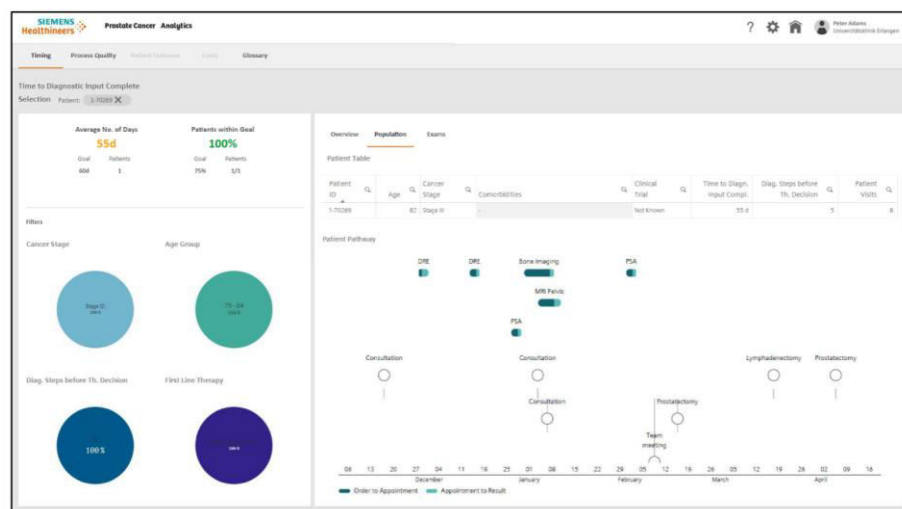
RCD: 005832706-0024-38

Locarno

14.04

Values

Graphical user
interfaces





Copyright



Directive 98/71/CE of October 13, 1998 on the legal protection of designs, in preamble 8, states :

*«[...] in the absence of harmonisation of copyright law, it is important to establish the **principle of cumulation of protection under [...] design protection law and under copyright law**, whilst leaving Member States free to establish the extent of copyright protection and the conditions under which such protection is conferred;*

*Works protected by Copyright are **comprised** within the scope of **Directive 2004/48/CE of April 29, 2004 on the enforcement of Intellectual Property Rights***





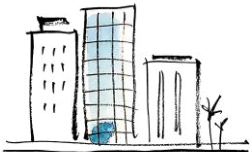
Copyright



There is no Copyright EU Law

which is to say: no provisions applicable directly to member States

- *Country by Country approach*
- *Creative Character + Artistic Value*
- *Subjective Element + Objective Element*





A few examples of National Copyright Decisions on Trade Dress



Copyright



ITALY

Creative Character:

Regardless of functionality, creative character occurs when the originality in the shapes/lines is greater than the average creativity in connection with similar products in the same marketplace.

Artistic Value:

Recognition among institutional and cultural environment.
(Exhibitions, museums, art shows)

Italian Supreme Court of Cassation: 23292/2015, 7477/2017





Copyright

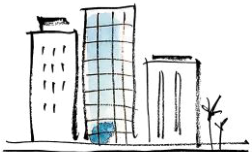
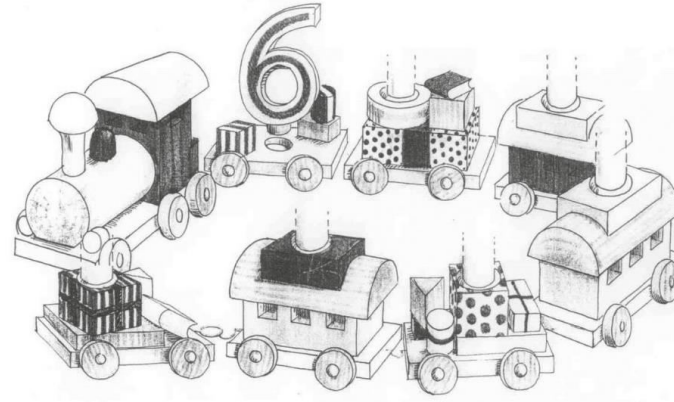
GERMANY

German Federal Court (BGH) finds that the creator of an industrial design is reasonably independent from “design rights” when enforcing **works of applied art** on the grounds of Copyright law.

The purpose of the plaintiff’s designs - the Birthday train - were to be used and therefore it was a sample of applied art, not fine art.

No high standards of originality

Federal Court of Justice: I ZR 143/12





Copyright

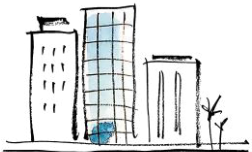
FRANCE

*Figures 1.1. and 1.2 "tracksuits of French design" can be considered eligible of protection under the provision of Book V of IPC [...] [Designs/Models] but not of Book I and III [Copyrights] of the same IP code as the **company making the request does not point out in what way the outfit is the result of a personal effort of creation and reflects originality** which is not limited to the individual character of the Designs*

TGI Paris, 3rd Chapter, 1st section, 11 January 2011



Figures 1.1 and 1.2. (cont.)





Copyright

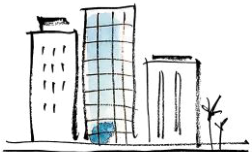
UNITED KINGDOM

Section 4(1) CDPA

*"In this Part "artistic work" means
[...] a work of artistic craftsmanship"*

"Lucasfilm contended that the helmet was sculpture [...]. Mann J found the helmets to be a mixture of costume and prop and that their primary function was utilitarian, namely to express an idea as part of character portrayal in the film. He held that this lacked the necessary quality of artistic creation required of a sculpture. [...] It remained the Star Wars film itself that was the work of art. The helmet was utilitarian in the sense that it was an element in the process of production of the film" (Press Summary, UK Supreme Court).

Lucasfilm Ltd & Ors v Ainsworth & Anor [2011] UKSC 39





Practical Conclusions in connection with Statutory Rights



EU Trademark

Worths trying

Community Design

Comprehensive protection in the EUIPO

Copyright

*No EU as a whole
Possible forum shopping advantage*





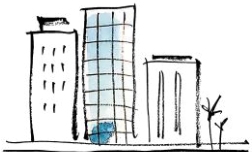
What to do when none of those options are available or possible?



National Laws on Unfair Competition/Passing Off, Fair Trade, Consumers' Protection, etc. could help to protect the peculiar image/shape of a product from:*

- *Look-alikes*
- Copycat
- *Parasitic copying*
- *Slavish Imitation*

* Occasionally somehow harmonized by several EU Directives





Look-alikes - Copycat - Parasitic Copying – Slavish Imitation



Since 1993, when the internal market was established, the main goals to achieve within the EU have been:

- *remove obstacles to free circulation of products*
- *eliminate barriers to trade*
- *support a system of undistorted competition*





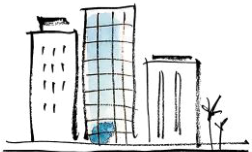
Look-alikes - Copycat - Parasitic Copying – Slavish Imitation



A study on look-alikes etc. was commissioned by the European Commission in 2011 and still remains the more comprehensive and the more detailed reference.*

The study reports and explains the many differences existing among the laws and their implementation among Member States and underlines, among many other things, ***"the inconsistent outcomes when a plaintiff takes action against the same look-alike products across the European Union"***

* <https://publications.europa.eu/en/publication-detail/-/publication/068c999d-06d2-4c8e-a681-a4ee2eb0e116>





└ A few examples of National Decisions on Look-Alike



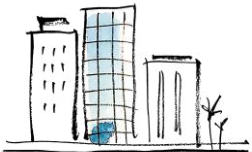
Look-alike

Italy

The concept of «look alike» didn't enter easily into the Italia legal framework.

The first attempts to stop the 'unfair' competitors putting on the market look-alike products either weren't successful or were allowed on the basis of TM infringement.

Nowdays look-alikes are easily stopped and sanctioned, also through preliminary injunctions, on the basis of Unfair Competition provisions





Look-alike

Italy



The **first known case** in which an Italian Judge analysed and recognized **the 'look alike'** as a specific phenomenon in re: **Colussi vs. Elledi**, the so-called Gran Turchese case.

Granting a preliminary injunction in favor of Colussi **the Court of Naples** underlined that, not only there was a risk of confusion of the undertakings, but also there was **misappropriation of the positive message** and of **investments** and the **risk of association**

Order 11/7/2000



abpi



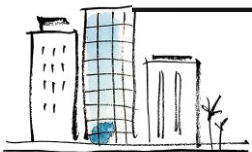
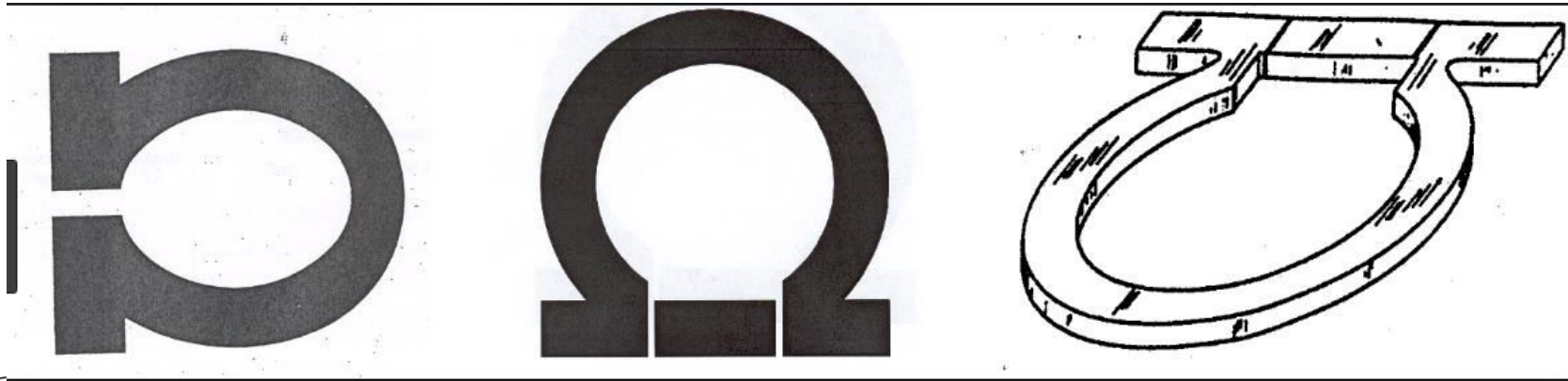


Look-alike

Italy

*The Court highlights that the **3D mark owned by Ferragamo** has to be considered a **source identifier** and **any variations would infringe the distinctive sign** consisting of a 3D shape.*

Italian Supreme Court of Cassation: 26001/2018.





Look-alike

Italy

RECKITT BENCKISER ITALIA S.P.A. and RECKITT BENCKISER
COMMERCIAL (ITALIA) S.P.A.
AIR WICK PURE



VS

TENDENZE S.R.L.
AIR FRESH ESSENCE



*The **Court of Milan** granted on **July 12, 2019** a preliminary injunction, inhibiting the use of Essence*
*The fact that AIR FRESH ESSENCE evokes the impression generated by AIR WICK PURE, has been considered an **unfair competition act** (look alike) as consumers may be induced in error regarding the commercial origin of the products.*



Proceedings n. 8613/2019





Look-alike

Spain

The Supreme Court of Spain, in its decision in the case 'Kraft' vs Galletas Gullon SA, denied all claims on likelihood of confusion between the two producers' products under TM infringement and unfair competition as well



Marca española no. 2845539



Producto look-alike



Community trade mark no. 830794



Spanish trade mark no. 2576774



Look-alike Product

STS 4245/2015 ES:TS:2015:4245 September 2, 2015





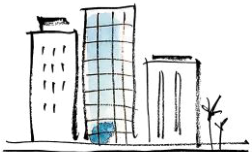
Look-alike

Germany

The Cologne Higher Regional Court **rejected** the claim of unfair competition since the bottles of the parties showed **different product and manufacturer names**



Case 6 U 136/16 of April 28, 2027





Look-alike



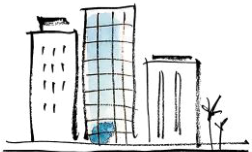
Germany

German Federal Supreme Court judged **against the plaintiff** in case "Keksstangen" assuming that the difference between **TMs and manufacturers names** **didn't mislead consumers**



Federal Court of Justice: I ZR 1133/13

"German courts are keen to emphasize that if a product is not protected by an intellectual property right, it can – in principle – be copied freely, unless there are specific circumstances justifying an exception from this basic rule"





Look-alike



Germany

The higher Regional Court of Cologne found in favour of Wick.

*As consumers perceived Wick's Blau as "the mint in a blue bag with the polar bear" and that **there was no justifiable reason for the competitor to use a polar bear.***



OLG Köln 6 U 131/09



abpi





Look-alike



United Kingdom

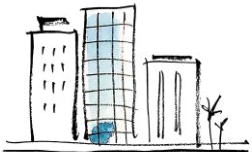
The most famous English case relating to lookalikes is United Biscuits v Asda Stores, the so called "Puffin/Penguin" case.



*"The word PUFFIN is not very different from PENGUIN .Forty per cent of Penguins are eaten by children, and **children often help with the shopping** even though they do not pay for it."*

Where consumers believe something was manufactured by the same person this is sufficient to amount to passing off (as it is a "connection"). Claim for passing off was successful.

FSR 14, 19-21, 1992





Thank you

Obrigada

Grazie

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