

MODULE 4

TRADE MARKS AND DESIGNS

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TRADE MARKS

A DIFFERENT TYPE OF IP

- TM are the bread and butter of the IP world, a lot of IP practice is centred around trade marks, mostly because they are ubiquitous.
- National registration required (like patents), but also non-registered marks can generate protection.
- Extension of protection can be substantially longer than other types of IP. (10 years, renewable)
- Unique in the balance between owner, consumer and competitors.

<https://unsplash.com/photos/yZOfNnI2PA0>



WHY DO WE HAVE TRADE MARKS?

- "...the essential function of the trade-mark . . . is to guarantee the identity of the origin of the trade-marked product to the consumer or ultimate user" Hoffmann-La Roche v. Centrafarm (C-102/77)
- The trade mark can be "an emblem of prestige or a guarantee of quality..." Arsenal v Reed (C-206/01).



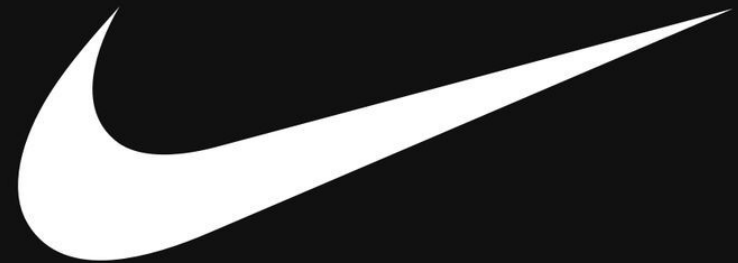
SUBJECT MATTER

- Any **sign** capable of being represented graphically which is **capable of distinguishing** goods or services of one undertaking from those of other undertakings.
- A trade mark may, in particular, consist of **words** (including personal names), **designs**, **letters**, **numerals** or the **shape of goods or their packaging**.
- Wide interpretation nowadays of what is a sign, with most systems accepting a wide variety of signs.



THINGS THAT CAN BE TRADEMARKED

- Words (eg Apple)
- Words with graphics (the Apple word with logo).
- Just a sign (the Nike swish sign, or the apple in Apple)
- Colours
- Smells
- Shapes
- Sounds
- Tastes (more difficult to prove distinctiveness)



COLOURS?

- RAL 4010: T-Mobile Magenta.
- Pantone 1837: Tiffany & Co Blue.
- Pantone 2685C: Cadbury purple.
- Heidelberger Bauchemie (C-49/02),
juxtaposition of colours.

SHAPES

- Nestlé v Cadbury [2017] EWCA Civ 358.
- Part of the titanic TM battle between Nestle and Cadbury, Nestlé tried to get trade mark for shape of KitKat bars.
- Refused, shape of chocolate not likely to make it possible to distinguish the product.
- See also Dyson v Register of Trade Marks C-321/03.



REQUIREMENTS FOR NON-SIGN TM

- A sign must be clear (not ambiguous)
- precise (a colour cannot merely be described as 'purple')
- self-contained (e.g. music notes),
- easily accessible (e.g. the Pantone international database)
- intelligible,
- durable (the graphical representation must remain consistent)
- and objective.

https://en.wikipedia.org/wiki/Cinnamon#/media/File:Cinnamomum_Verum_vs_Cinnamomum_Burmannii.jpg



REQUIREMENT FOR REGISTRATION

- Mark has to have a distinctive character.
- Cannot be too descriptive (can't register a car brand called "CAR").
- The shape cannot have a technical character (otherwise it would be a patent).
- Cannot be a result of the shape of the nature of the good (can't register the shape of a car).



OTHER REQUIREMENTS

- Can't describe the quality of the product: Wrigley registered name "Doublemint" for chewing gum. Mark was allowed by court of first instance because mark had two meanings. Court disagreed it was descriptive.
- Can't register a brand that describes a place (lots of exceptions to this).
- Can't register in bad faith, eg. to stop someone from using a brand in the future.



CAN'T REGISTER A BRAND IF IT'S SIMILAR TO ANOTHER

- Visual, phonetic or conceptual similarity.
- Device marks: visual similarity is the important factor.
- Composite marks: emphasis on the textual element (words speak louder than devices).
- Word marks: a determination of visual similarity involves looking at the length of the marks; their structure (number of words); whether the same letters are used.



INFRINGEMENT

- No requirement of knowledge or intention on the part of the defendant. Strict liability
- No need to demonstrate damage.
- Possibility to commence an action for infringement even though the mark has not been used.
- In order to infringe, it must be shown that the defendant used the mark "in the course of trade".
- Injunctions, damages, stop advertising, de-registration.

<https://unsplash.com/photos/RVwgEHmjUs4>



EFFECTS OF INFRINGEMENT

- An infringement of a registered trade mark is actionable by the proprietor of the trade mark.
- In an action for infringement all such relief by way of **damages**, **injunctions**, **accounts** or otherwise is available to him as is available in respect of the infringement of any other property right.



HONEST PRACTICES

- Think “fair dealing” for copyright.
- Honest practice constitutes a duty to act fairly in relation to the legitimate interest of the trade mark owner.
- This predicates understanding by the public of the third party’s mark, as well as the link between the marks and whether the defendant knew of this link.
- Finally, there can’t be unfair advantage to the third party.

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TECHNOLOGY: DOMAIN NAMES

- Domain name, registered identifier for a website (google.com, wikipedia.org).
- You can use your brand as a domain name (eg nike.com), but often it's on a first come, first served basis.
- You may object to the domain registrar for registration of your brand in bad faith, but there could be competing names.
- Registrars have procedures to remove registration.



TECHNOLOGY SEARCH ENGINE RESULTS

- Can you force your brand to appear higher in a search engine query?
- Can you stop another brand from showing up when someone searches for your product?
- The answer is generally no, but there is a long history of cases trying to test this very question.
- Famous European case of Interflora, which objected to a competitor showing up in searches of its brand. European court ruled that the selection as a keyword of a term also registered as a trade mark without the consent of its owner, does not *per se* amount to infringement.

The Google logo is displayed in its characteristic multi-colored font (blue, red, yellow, blue, green, red) on a light background. The logo is slightly tilted and appears to be on a screen or a printed page.A rectangular button with the text "Google Search" in a blue, sans-serif font. The button is slightly tilted and has a light blue background.A rectangular button with the text "I'm Feeling Lucky" in a blue, sans-serif font. The button is slightly tilted and has a light blue background.

DESIGNS

WHAT ARE DESIGNS?

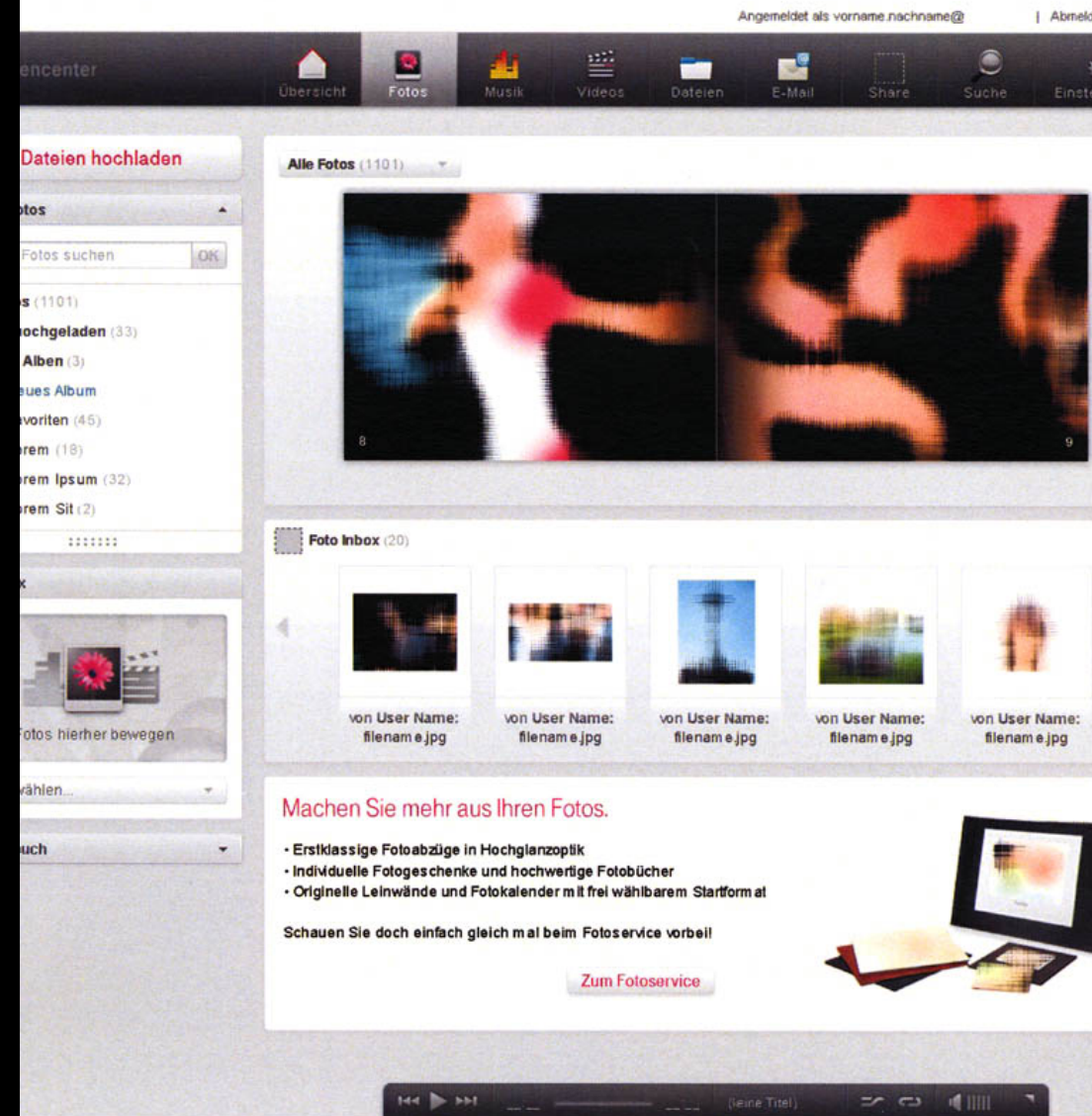
- Design sits in the interface between copyright, patent and trade mark.
- Protection for the aesthetic; designs need not be functional, artistic or protect origin.
- The idea is to protect things that can be mass-produced.
- Industrial designs, registered designs, unregistered designs, design patents.



DESIGN IN SOFTWARE

- Many software elements can be subject to design protection.
- These include things like web designs, pictures, models, typefaces, fonts, icons, and even logos.
- There's some interface between trade marks and designs. It may be useful to consider registering a design for things that are not your brand (eg icons and typefaces).

RCD 001100598-0009



WHAT CAN BE SUBJECT TO DESIGN PROTECTION?

- Because there's no need for distinctiveness or innovation, designs often protect things that cannot be patented or trade marked.
- Much like trade marks, there are few restrictions on what can be subject to design.
- Wide range of items, including logos, shapes and products.
- Can be registered, but there's also an unregistered design right akin to copyright.

United States Patent [19]
Lucas et al.

[11] **Des. 264,109**
[45] **** Apr. 27, 1982**

[54] TOY ACTION FIGURE

[75] Inventors: **George W. Lucas**, San Anselmo;
Ralph McQuarrie, Los Angeles; **Joe Johnston**, San Rafael, all of Calif.

[73] Assignee: **Lucasfilm, Ltd.**, North Hollywood, Calif.

[**] Term: **14 Years**

[21] Appl. No.: **65,304**

[22] Filed: **Aug. 13, 1979**

[51] Int. Cl. **D21-01**

[52] U.S. Cl. **D21/150; D21/177**

[58] Field of Search **D21/150, 166, 171, 177, D21/178**

[56] **References Cited**
PUBLICATIONS

FAO Schwarz, Spring-Summer, 1978, p. 13, Star War Figures, top left figure.
Playthings, Jul., 1978, p. 21, lower left, Metal-Man.

Primary Examiner—Melvin B. Feifer
Attorney, Agent, or Firm—Bruce Schwab

[57] **CLAIM**

The ornamental design for a toy action figure, substantially as shown.

DESCRIPTION

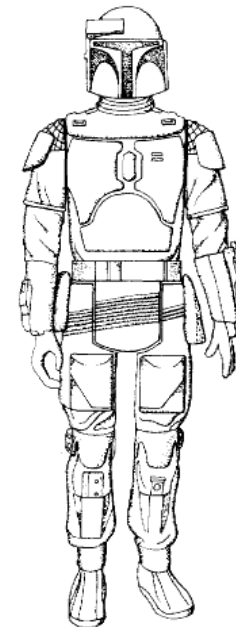
FIG. 1 is a front view of a toy action figure illustrating the new design;

FIG. 2 is a right-side view thereof;

FIG. 3 is a left side view thereof;

FIG. 4 is a back perspective view thereof; and

FIG. 5 is a top plan view thereof.



REGISTERED DESIGN

- A design shall be protected by a right in a registered design to the extent that the design is new and has individual character.
- "design" means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation.

<https://unsplash.com/photos/L6WY8VY7k7s>



UNREGISTERED DESIGNS

- The shape and configuration is automatically protected by unregistered design rights.
- Protection is automatic but less adequate than a registered design right.
- Requires that the design is fixed (a drawing will do), and that the design is original (this means that it is distinctive).



ORIGINALITY

- The design will not be subject to protection if the article is 'commonplace in a qualifying country in the design field in question'.
- There has been an argument of what is the delimitation of the word "article".
- Generally understood as the specific item subject to protection, can be part of a whole.

<https://unsplash.com/photos/cqVel1INT-U>



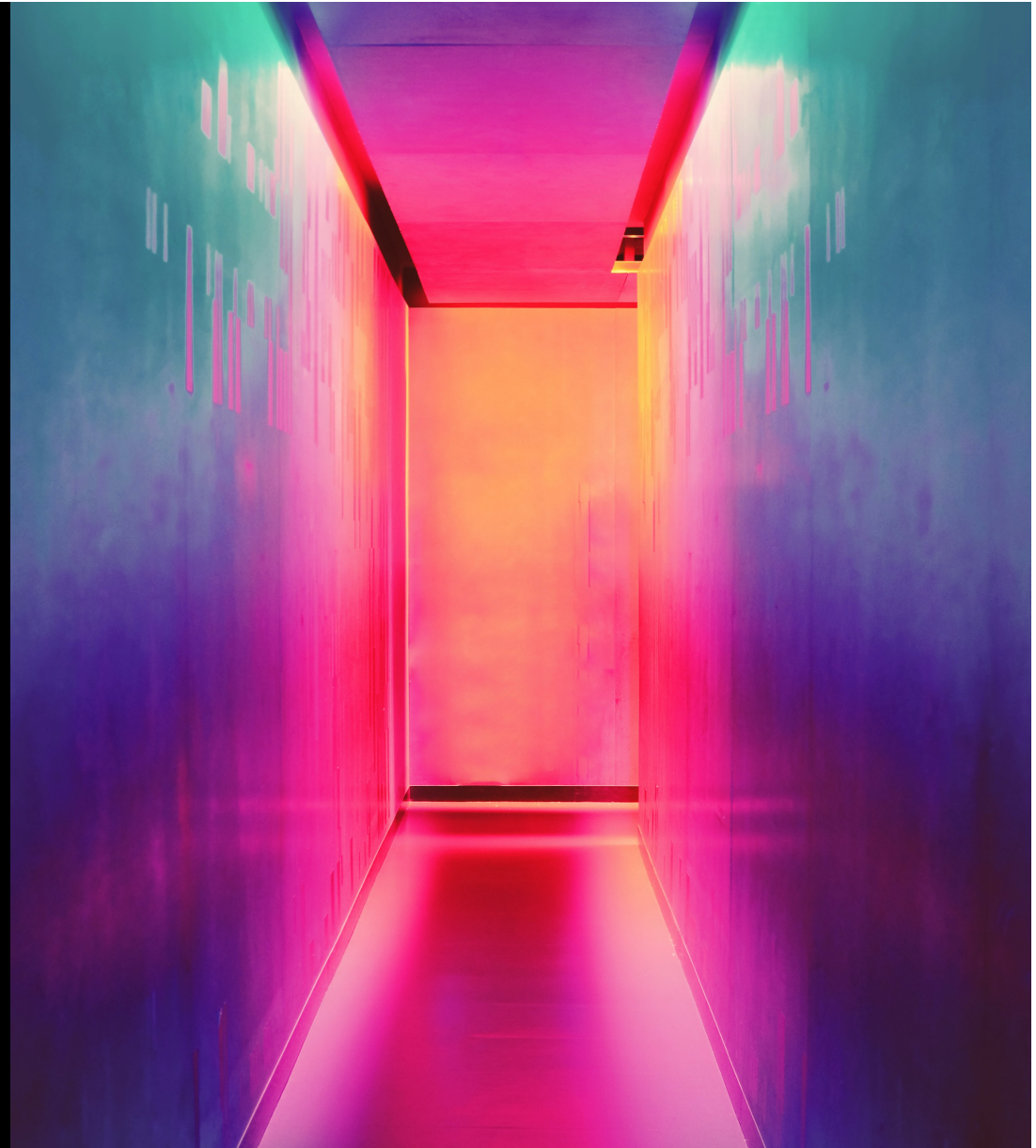
DURATION

- **Registered designs:** 5 years from date of registration, renewable up to 25 years.
- **Unregistered designs:** Protected to the earliest of 10 years after the product was first sold or 15 years after the design was created. This right cannot be renewed.



WHAT DOES IT MEAN FOR APPS?

- First thing you want to do is to register your brand.
- Registering domain name is not the same as trade mark registration, but it's another important practical step.
- Many app elements could be registered under design rights.
- Not all countries have a non-registered design right, so check in advance.



THANKS!

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