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Le cumul des droits sur les formes tridimensionnelles – Cumulation of rights with regard to 3D shapes

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INTRODUCTION: THE PROBLEM, I

- The appearance of 3D items, whether functional or aesthetic, can be protected (in practically all EU member states) by a multiplicity of protection regimes, namely
 - Industrial design,
 - copyright,
 - trademark and/or
 - unfair competition law
- Protection can be simultaneous or subsequent



INTRODUCTION: THE PROBLEM, II

- The resulting problems are the same as in all cases of cumulation:
 - In case of conflict with competing products, the rightholder will be able to rely on the “strongest“ of the accumulated rights (for instance, the right with the longest duration, after other rights have lapsed)
 - This may pose problems
 - for undistorted competition
 - under general systematic aspects



INTRODUCTION: THE SOLUTION (OWN APPROACH)

- Cumulation of rights does not pose a problem *per se*. Neither competition nor the general structure of IPR are negatively affected as long as
 - the requirements for protection under the different legal regimes are formulated and applied so as to fully justify the protection granted, and
 - each one of the rights applied is adequately balanced in itself, in particular as regards the relationship between the general scope of protection and the limitations
- It follows *e contrario* that cumulation can operate as a “magnifying glass“, enhancing the visibility of imbalances which otherwise might remain undetected



Structure of the presentation

- In the following, two typical scenarios will be discussed in order to exemplify the problems resulting from cumulation of rights with regard to 3D problems (without attempting to give a fully comprehensive account)
- 1st scenario: Subsequent protection is sought for one and the same item – e.g. a handbag, a pair of jeans, or a loudspeaker – under different protection regimes, in particular industrial design and trademark law
- 2nd scenario: Simultaneous protection is sought for car spare parts under design, trademark and copyright law



1st scenario

SUBSEQUENT APPLICATION OF DESIGN/TRADemark PROTECTION: HOW IT MAY OCCUR

- In its decisions concerning trademark protection of 3D forms, the ECJ has taken a rather restrictive approach
- As a consequence, such signs must regularly (though not necessarily) acquire distinctiveness through use before they are registered
- During the early phase of marketing, such items may however rely on design protection, possibly even in the form of an UCD
- After the lapse of design protection, the form may have gained sufficient distinctiveness to be eligible for trademark protection



TRADEMARK PROTECTION FOLLOWING DESIGN (OR PATENT) PROTECTION: THE LIMITS, I

- **Question: Is it compatible with the ECJ's restrictive approach towards trademark protection of 3D forms to cumulate design and trademark protection in the manner described before?**
- **It would be problematic indeed if quasi-automatic trademark protection regularly follows an initial phase of (registered or unregistered) design protection.**
- **Such automatic sequence of protection regimes can and should be avoided by taking the respective requirements seriously, and by making a clear distinction between them**
- **Subsequent protection is excluded anyhow by virtue of Art. 3.1 (e) TMD in case of the shape**
 - **resulting from the nature of the goods**
 - **being necessary to procure a technical result**
 - **giving essential value to the goods**

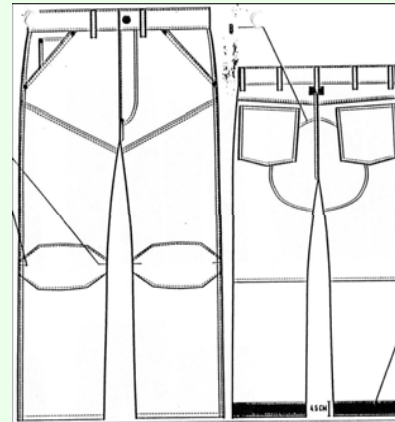
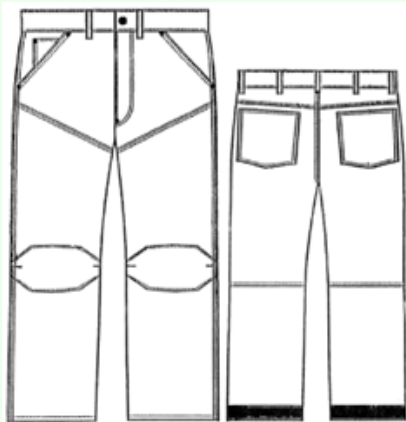


TRADEMARK PROTECTION FOLLOWING DESIGN (OR PATENT) PROTECTION: THE LIMITS, II

- Until now, Art. 3. 1 (e) has been applied rather cautiously
- Even shapes of products that were previously covered by a patent are not necessarily excluded from trademark protection (though exclusion is the most likely result in cases like the Philips' rotary shaver or the LEGO building block)
- Previous design protection was even less considered as posing an obstacle to subsequent trademark registration, but...
- ...does the G-Star/Benetton decision (C-371/06) herald an age of much stricter evaluation regarding shapes of articles typically attracting consumers by their aesthetic appeal?

G-STAR/BENETTON, I

- According to the ECJ's ruling, G-Star's Ellwood Jeans could not be registered as a trademark in spite of acquired distinctiveness, as the shape had initially given substantial value to the goods (see Art. 3.1 e, 3rd indent TMD).





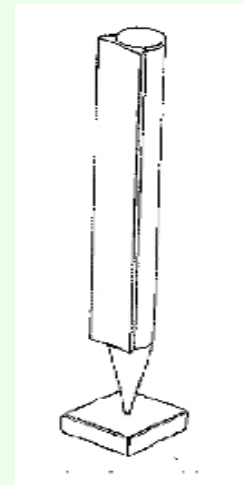
G-STAR/BENETTON, II

- **By strictly limiting itself to answering the question posed to it, and by simply referring to the wording of the TMD without examining the logic of its inner structure, the ECJ avoided having to take a position in the dilemma underlying the provision:**
 - **If a shape is aesthetically appealing, but at the same time serves as a badge of origin, how can it be said that the value of the product is (only) determined by its aesthetic features, and not by the message about commercial origin, which is conveyed simultaneously?**
 - **What would result if the shape were able to claim *telle-quelle* protection under Art. 6 quinquies Paris Convention?**



WHICH CONSEQUENCES TO DRAW FROM G-STAR/BENETTON?

- Does it have to be inferred from G-Star/Benetton that in certain product sectors such as textiles (or jewellery?) shapes can generally not receive trademark protection?
- What about other designs that are particularly attractive? (As an actual example see the BEO-LAB loudspeaker made by Bang & Olufsen)



SUBSEQUENT APPLICATION OF DIFFERENT PROTECTION REGIMES (TRADEMARKS/DESIGNS): OWN CONCLUSIONS

- In particular with regard to aesthetic shapes, a markedly strict approach towards trademark protection (as might be read into G-Star/Benetton) appears as neither practically feasible nor as desirable
- It is necessary, but also sufficient, that the respective requirements of design and trademark protection are taken seriously, and that each set of requirements is applied with a view to the specific set of objectives and functions each right shall perform



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2nd scenario

SPARE PARTS: POSSIBILITIES FOR SIMULTANEOUS PROTECTION

- European design legislation demands that „parts of complex products“ can obtain design protection as such, but leaves it free to members to restrict protection against imitation, if done for repair purposes („repairs clause“)
- Several member states, including Benelux, have introduced such clauses
- A Commission proposal for a repairs clause is pending
- In that situation, car manufacturers increasingly try to secure trademark protection for individual spare parts
- In some countries, such parts are even protected by copyright
- Problem: Is it possible to circumvent a repairs clause by relying on cumulative trademark or copyright protection?



PROTECTION FOR SPARE PARTS UNDER TRADEMARK LAW – GENERAL REQUIREMENTS

- **By contrast to designs (which are not examined as to their substance in nearly all European countries), the registrability of spare parts is regularly examined ex officio before they are registered as marks**
- **Question: Are spare parts excluded**
 - **because their shape is necessary to obtain a technical result?**
 - **because their shape gives essential value to the goods?**
 - **Answer by the German Federal Supreme Court: No!**
- **However, only few parts will be considered as sufficiently distinctive to attract protection**



PROTECTION FOR SPARE PARTS UNDER TRADEMARK LAW – WILL REPRODUCTION FOR REPAIR PURPOSES BE CONSIDERED AS INFRINGING?

- **For those (few) parts which are found to be eligible for trademark protection, the crucial questions in a conflict situation will be whether**
 - **the part is used “as a mark“ by the alleged infringer**
 - **The use is admissible on the basis of Art. 6. lit. b TMD (= use in order to indicate the purpose of a product)**
- **In the light of previous ECJ jurisprudence (in particular case C-48/05, Opel/Autec), it is difficult to predict the result**
- **However, in all probability, the ECJ will not look favourably on attempts to circumvent a repairs clause, if/where it applies**



PROTECTION FOR SPARE PARTS UNDER COPYRIGHT LAW

- In case of copyright protection being granted to spare parts, the situation is even more difficult
- Although the requirements for copyright protection are not harmonized, i.e. national legislatures are basically free in that regard, the matter might be referred to the ECJ on the basis of Art. 28, 30 EC.
- As a matter of principle, the right to prohibit any form of reproduction is part of the specific subject matter of copyright, hence overriding free movement of goods.
- However, the ECJ has demonstrated in Dior/Evora (C-337/95), that copyright protection may have to be curtailed where it hinders the commercialising of products which are legal as such, and where a specific, additional justification for cumulative copyright protection is lacking
- The same could be said in this case!



POSSIBILITIES FOR PROTECTION OF SPARE PARTS UNDER VARIOUS REGIMES: OWN CONCLUSIONS

- Also regarding the specific example of spare parts, cumulation will not lead to serious frictions if the respective laws are applied in accordance with their objectives and functions
- However, in particular regarding cumulative protection under copyright, it may be necessary to apply the principle of free movement of goods as a corrective measure on the European level in order to counterbalance detrimental effects.