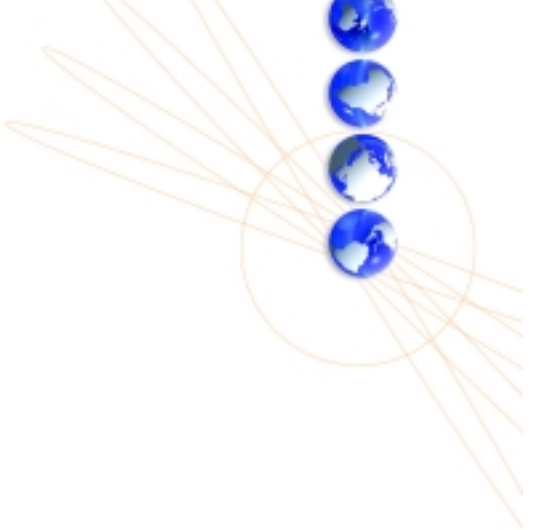




Introduction to Trademarks and Industrial Designs

Marcus Höpferger





WHAT IS A TRADEMARK?





**“A SIGN CAPABLE OF
DISTINGUISHING GOODS AND
SERVICES OF ONE
UNDERTAKING FROM THOSE OF
OTHER UNDERTAKINGS”**





DISTINCTIVE SIGNS

- Signs which DESCRIBE the goods or services on which they are used are DESCRIPTIVE and therefore NON-DISTINCTIVE
- Social and cultural environment is important
- Decision on a case by case basis
- Effect of use





DISTINCTIVENESS

- fanciful or coined signs
 - “SWATCH” for watches
 - Baby-Dry for diapers
- signs adopted arbitrarily in respect of the goods or services for which they are used
 - “apple” for computers
 - “camel” for cigarettes



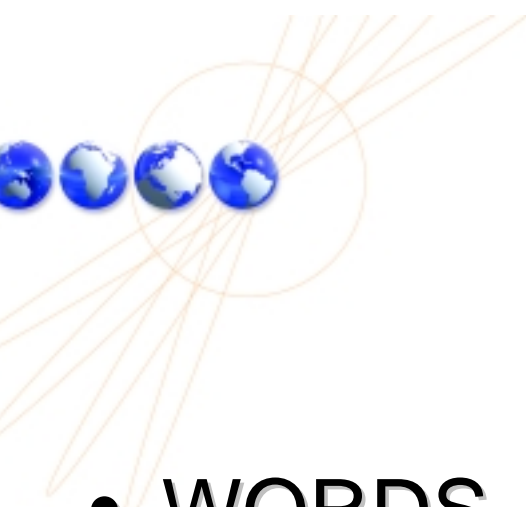


NON-DISTINCTIVE SIGNS

– reference to geographical origin

“INDIAN” for tea





VISIBLE SIGNS

- WORDS
- LETTERS AND NUMERALS
- DRAWINGS
- COLORS AND COMBINATION OF COLORS
- THREE-DIMENSIONAL SIGNS





WORDS

- **NAMES**
 - McDonalds
 - WH SMITH
 - Mars
- **FANTASY WORDS**
 - Kodak
 - Kit Kat
 - Swatch



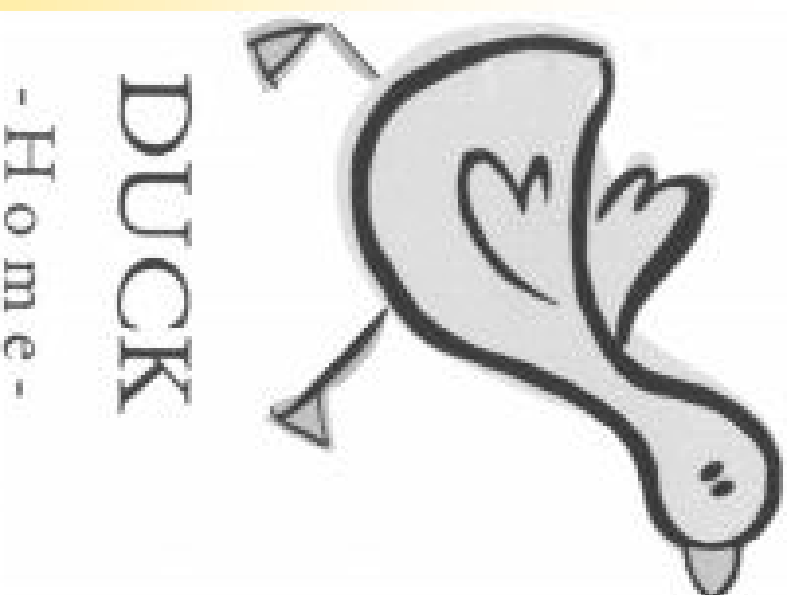
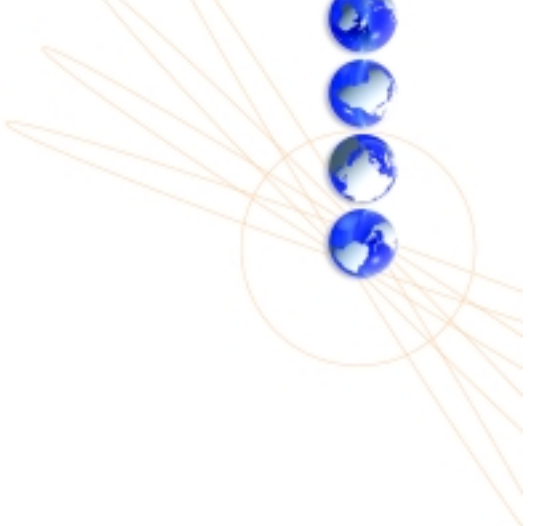


LETTERS & NUMERALS

- M&M
- IBM
- 501
- 320
- S 500
- A6
- No 5



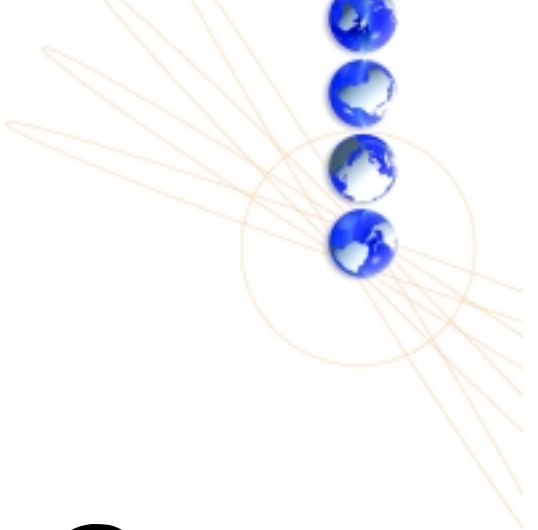
DRAWINGS



DUCK

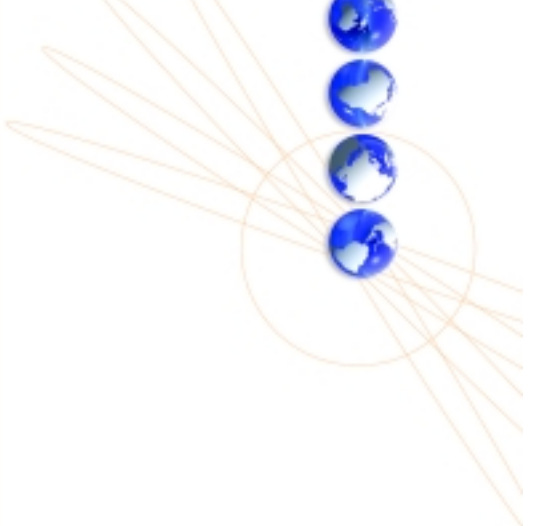
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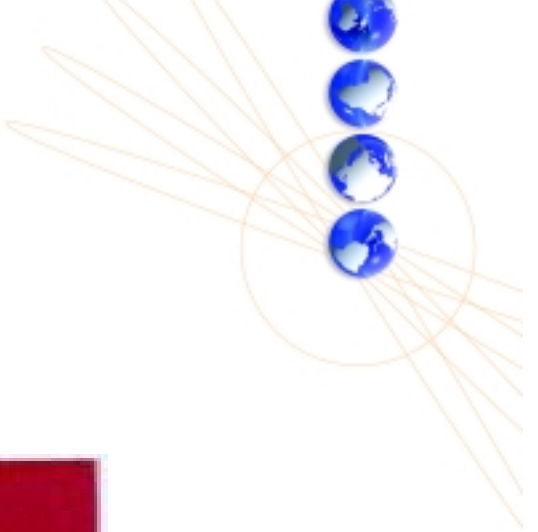




COLORS AND COMBINATION OF COLORS

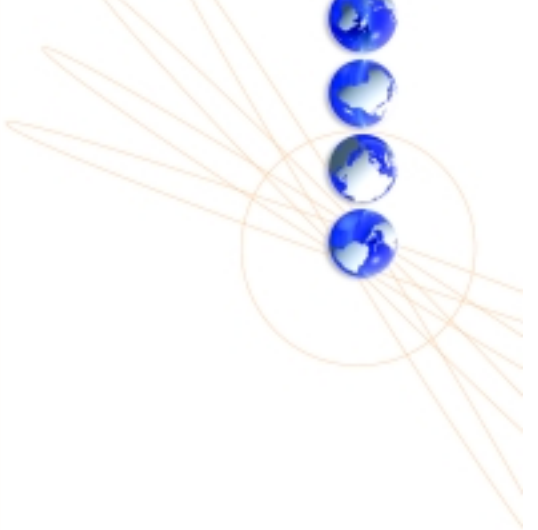




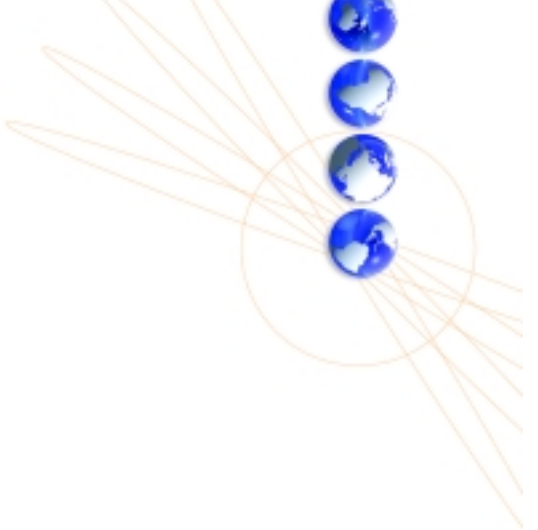
A stylized logo consisting of a white circle containing a white, abstract shape that resembles a lowercase 'p' or a similar character. Four small white squares are positioned around the central shape: one at the top, one at the bottom, one on the left, and one on the right.

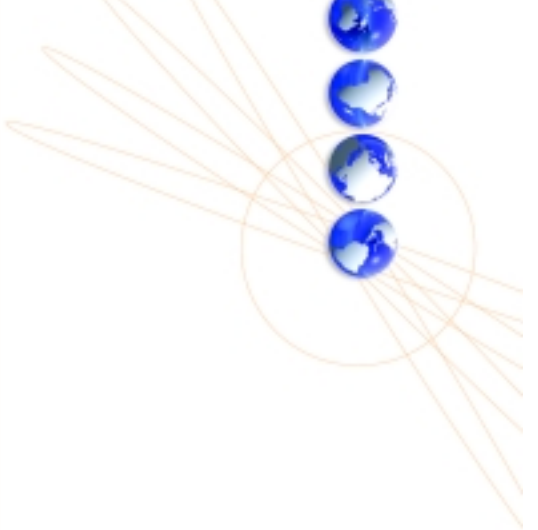
P A R I S E X P O
THE PARIS MEETING POINTS

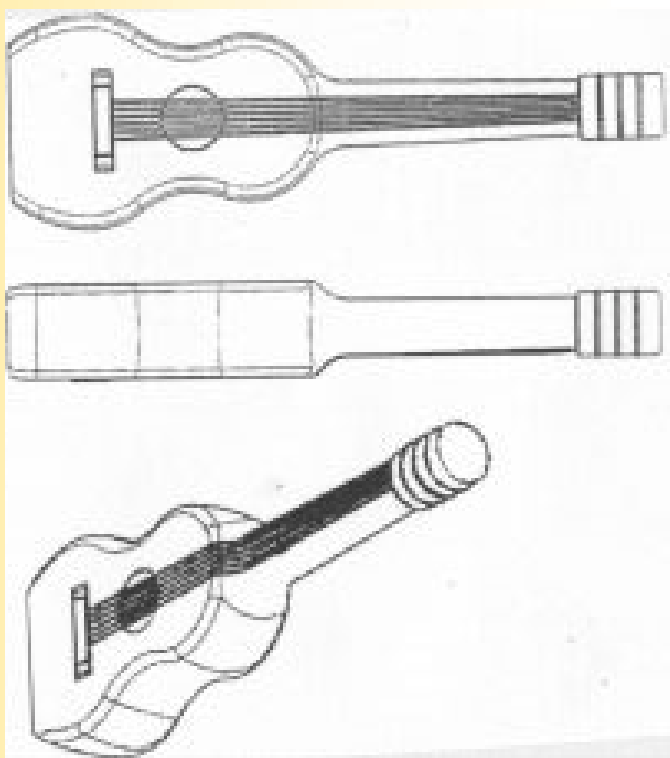
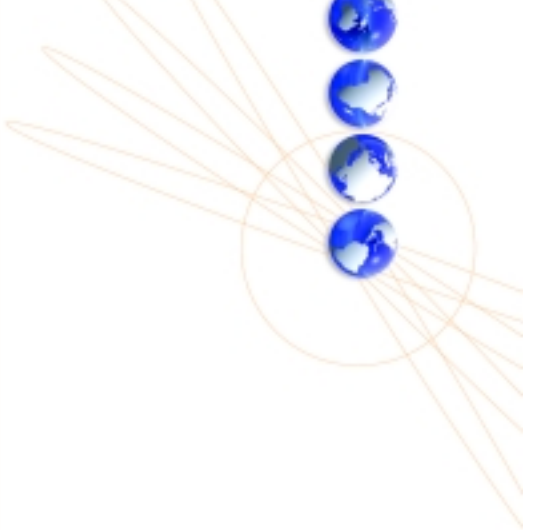




3D SIGNS









OTHERS

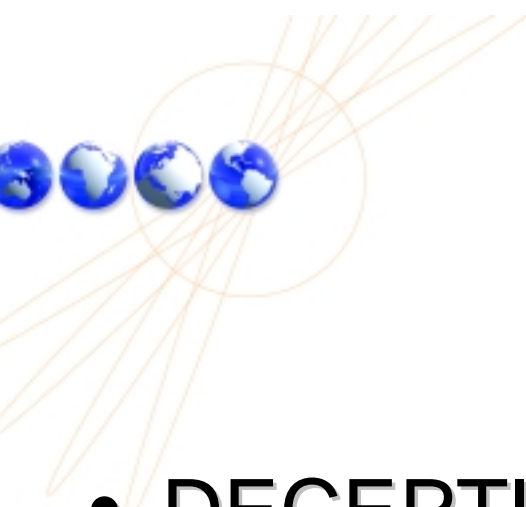
- **OLFACTORY MARKS**
 - “a high-impact, fresh floral fragrance reminiscent of plumeria blossoms” for embroidery yarn

- **AUDIO MARKS**



Porsche 911 (1996)





EXCLUSION FROM PROTECTION

- **DECEPTIVE SIGNS**
 - “ORWOOLA” for goods made 100% of synthetic materials

- **CONTRARY TO MORALITY OR PUBLIC ORDER**
 - “JESUS” for jeans



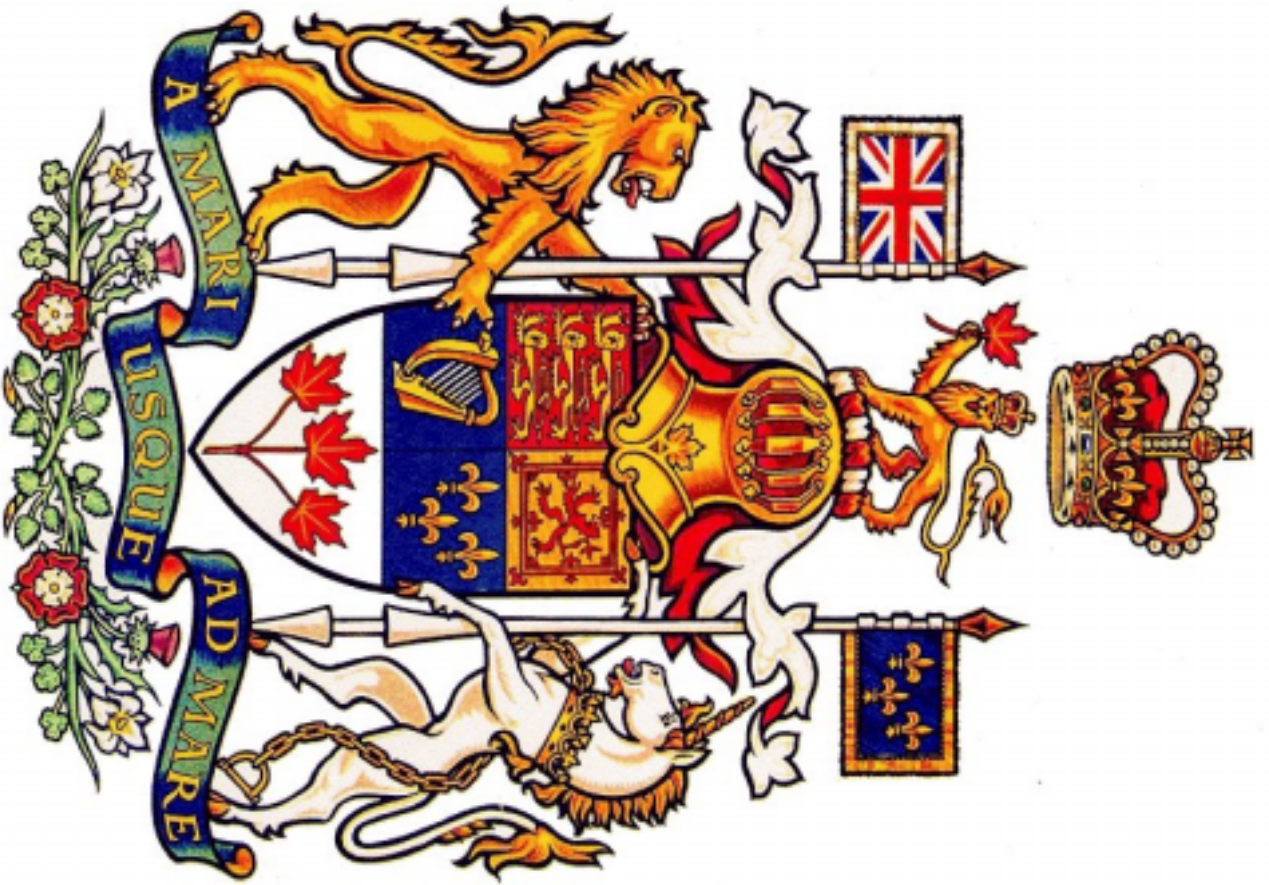


FLAGS AND NATIONAL EMBLEMS

Use reserved for public authorities









ACQUISITION OF RIGHTS

- USE
- REGISTRATION
- COMBINED
 - first-to-register (prior use may be recognized)
 - first-to-use (prior registration may be recognized)





USE

- No formalities required
- First user obtains right
- No transparency
- Uncertainty before product launch
- Problems for determination of priority





REGISTRATION

- First applicant obtains right
- Registration formalities
- Transparent
- Clear cut priority
- International standards require to provide for registration and to grant international priority rights

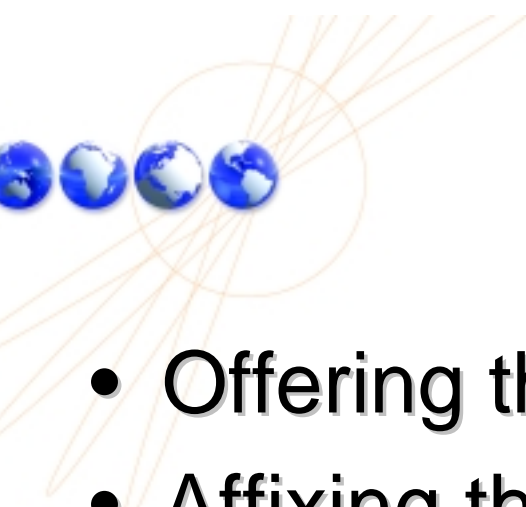




SCOPE OF RIGHTS

- The exclusive right to use the mark
- The right to prevent others from using an identical or similar mark for identical or similar goods or services
- The right to prevent others from using an identical or similar mark for dissimilar goods or services

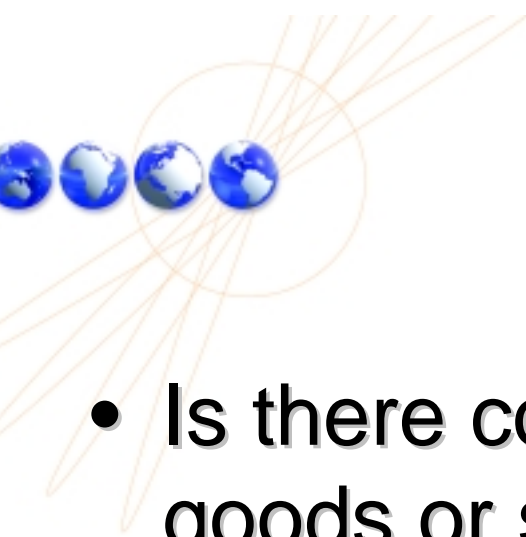




“USE”

- Offering the goods or services
- Affixing the mark to the goods or their packaging
- Putting the goods on the market or stocking them for that purpose
- Importing or exporting the goods under the mark
- Use on business papers or in advertising

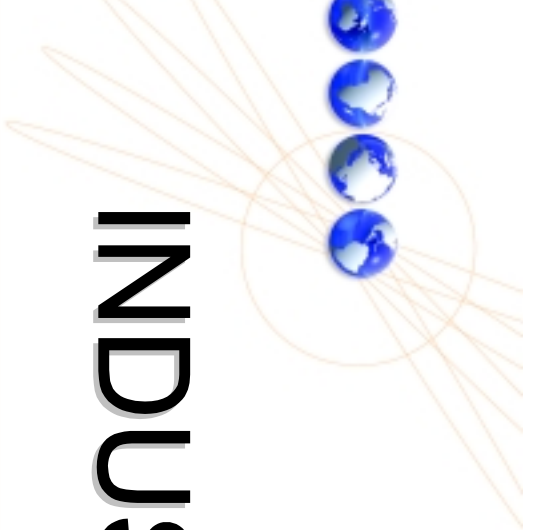




Questions:

- Is there confusion as to the origin of the goods or services?
- Marks are not compared by the consumer side by side
- Confusion can also arise from similarity in pronunciation
- Decision on a case-by-case basis taking into account all elements





INDUSTRIAL DESIGNS

WHAT IS AN INDUSTRIAL
DESIGN?

HOW IS IT PROTECTED?





“THE FORM OF A PRODUCT”

- What is protected?
 - the aesthetic features of an innovation
- What is not protected?
 - the technical features of an innovation (patents)
 - the distinguishing features of an innovation (trademarks)



Two-Dimensional Designs



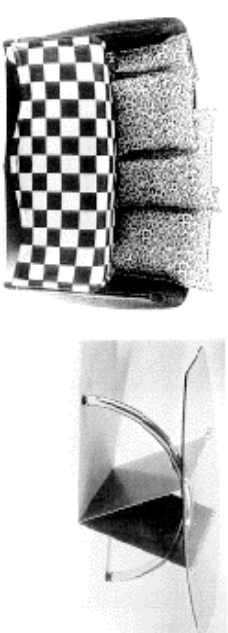
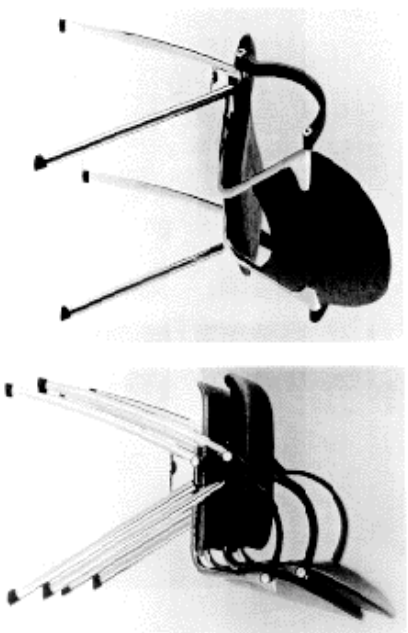
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72



Three-Dimensional Designs

- 3-DIMENSIONAL DESIGNS



1.4



1.2

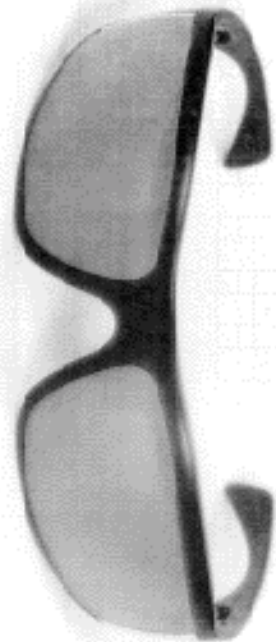
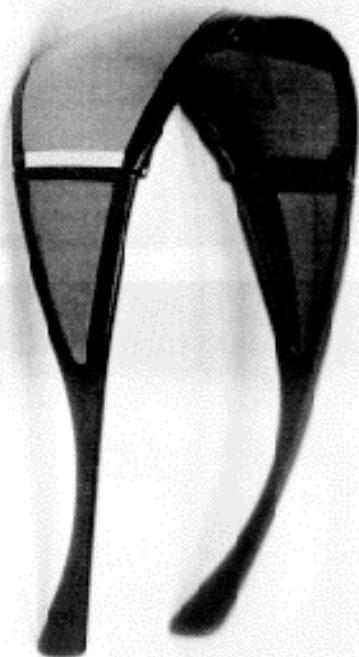


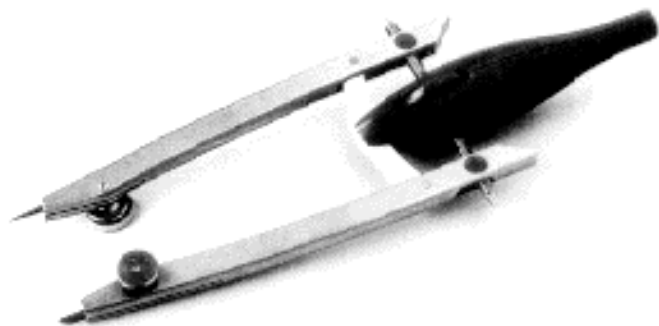
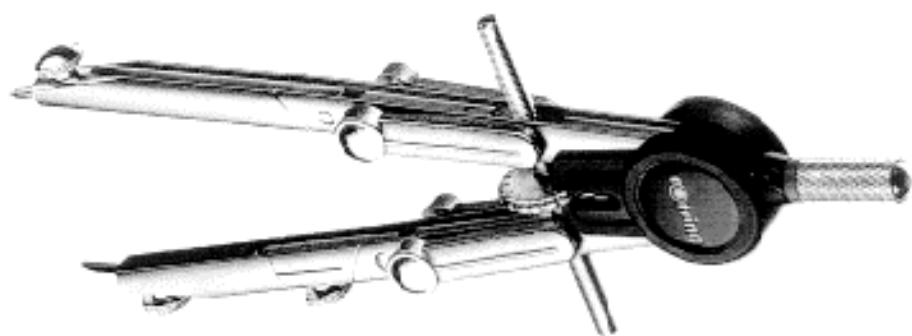
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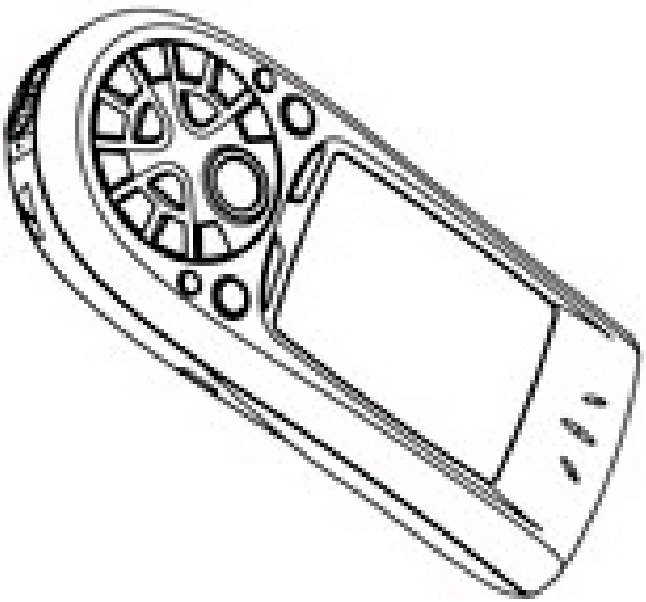
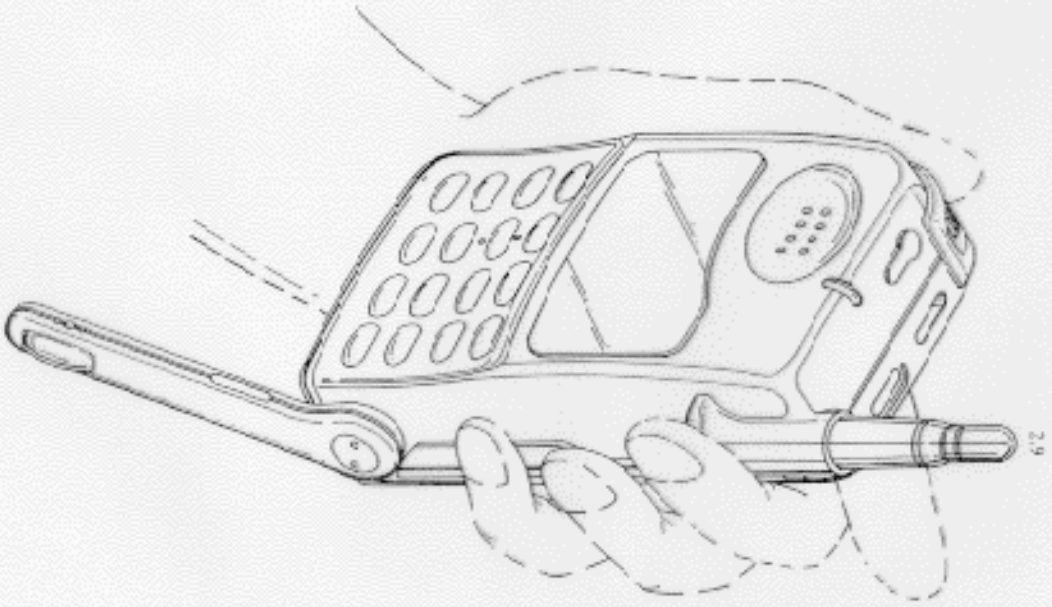
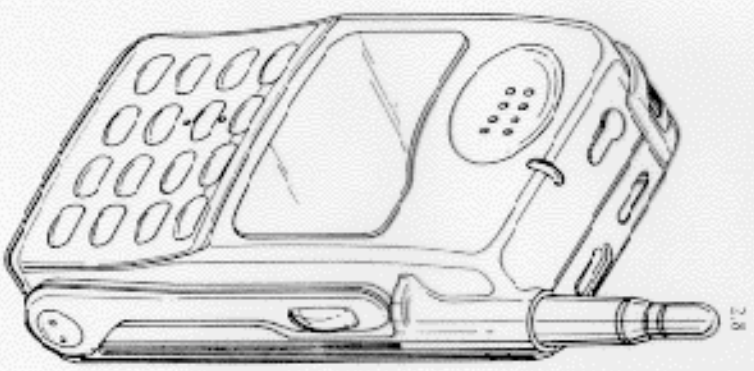


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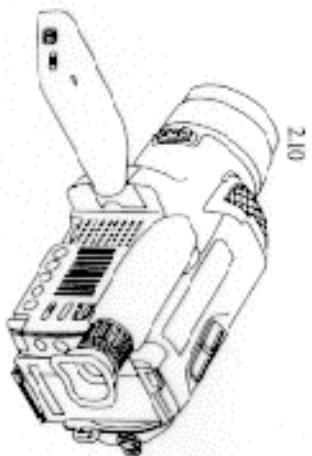
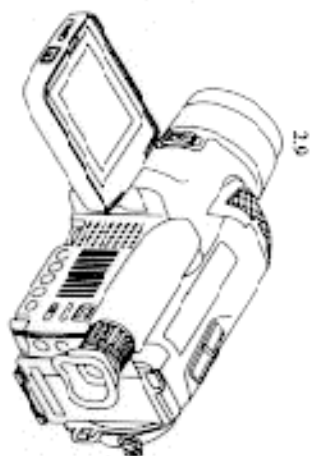
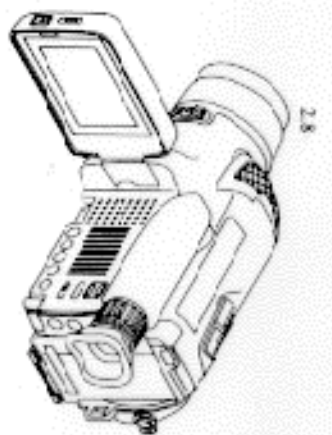
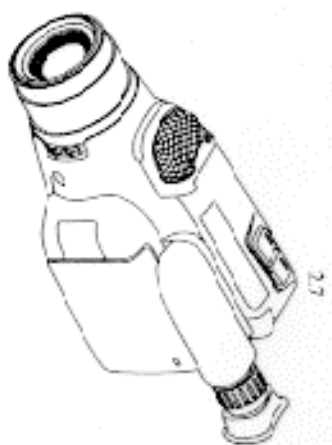
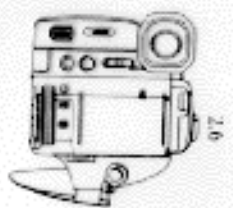
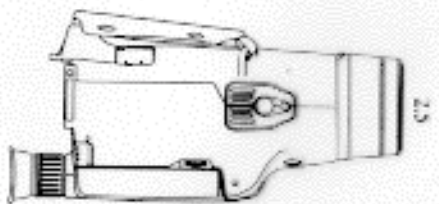


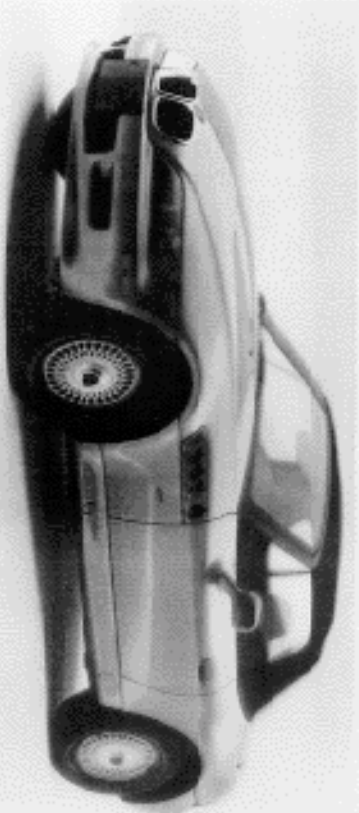




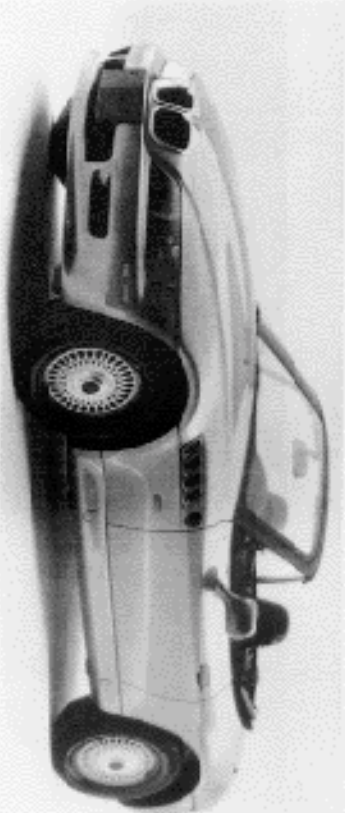


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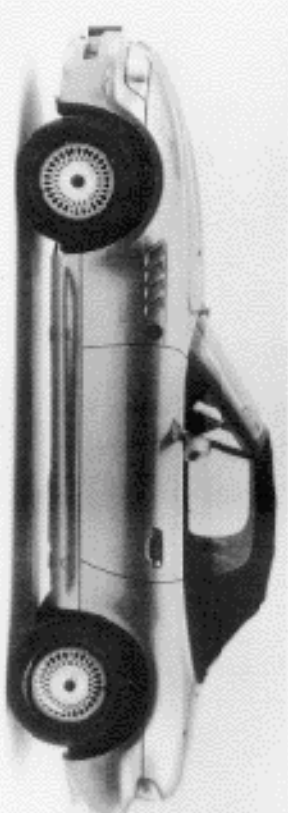


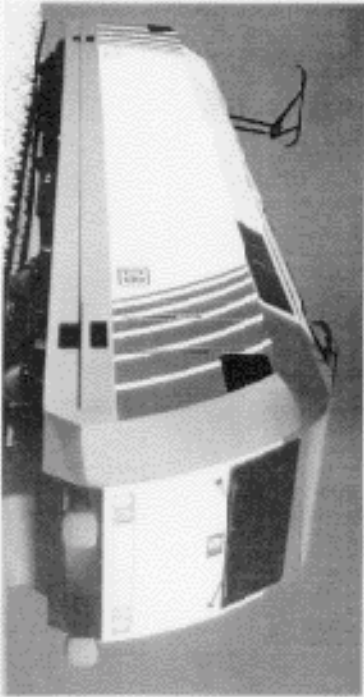


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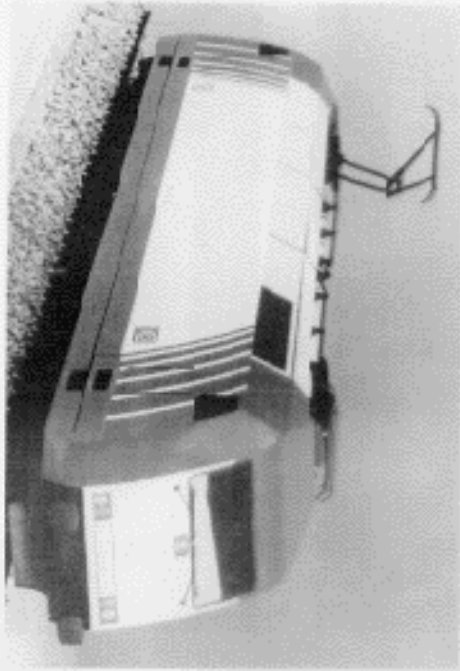


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Forms of Protection for Industrial Designs

- Registered Industrial Designs
- Unregistered Industrial Designs
- Copyright
- Three-Dimensional Marks
- Unfair Competition (passing off)
- Cumulative approach
- Mutual exclusion

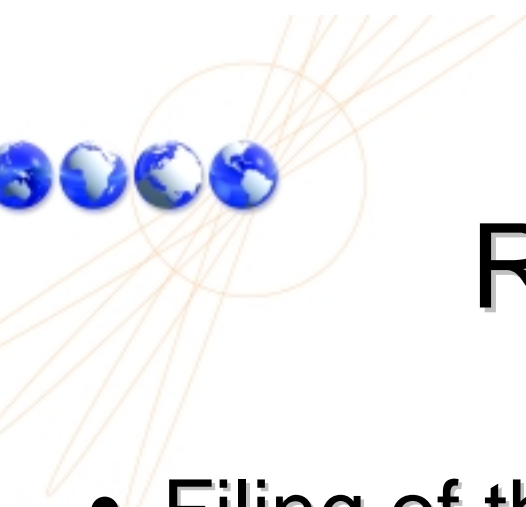




REGISTERED INDUSTRIAL DESIGNS

- Enforcement upon registration
- Novelty and originality
- Registration procedure

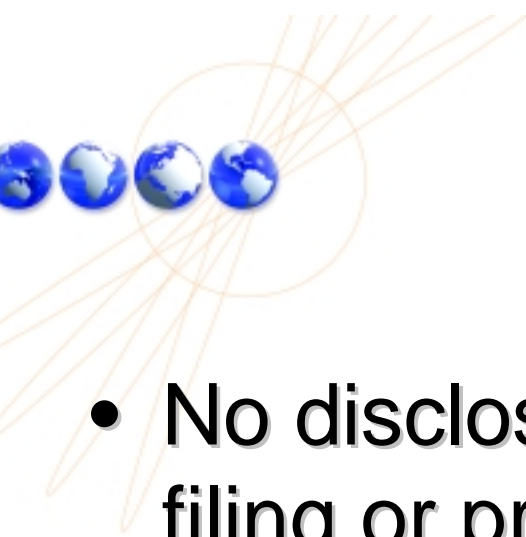




Registration Procedure

- Filing of the application
- Examination
 - absolute grounds for refusal
 - relative grounds for refusal
- Publication
- Renewal
- **Absolute** right





NOVELTY

- No disclosure to the public prior the filing or priority date
- Disclosure
 - publication
 - exhibition
 - use in trade
 - any other disclosure

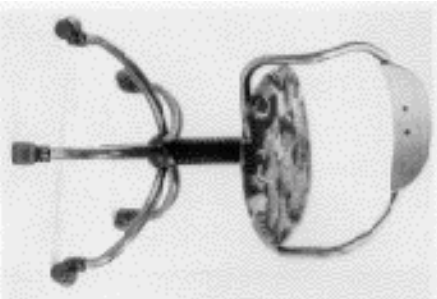




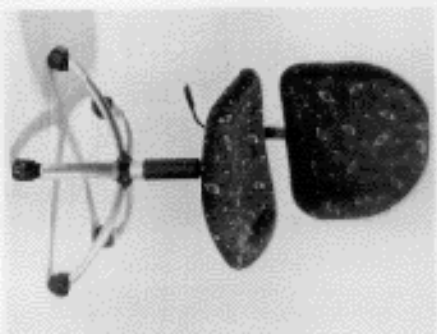
ORIGINALITY

“Not commonplace in the design field in question at the time of the design’s creation” (UK design right)

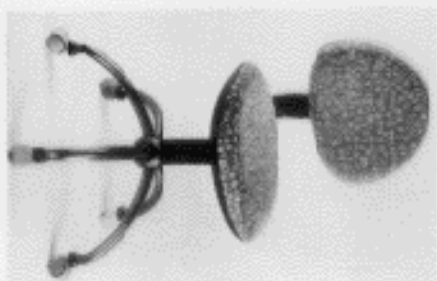




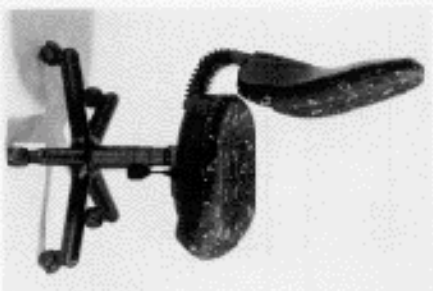
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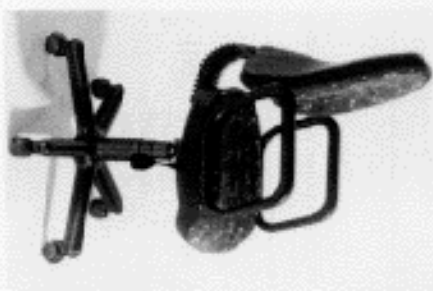
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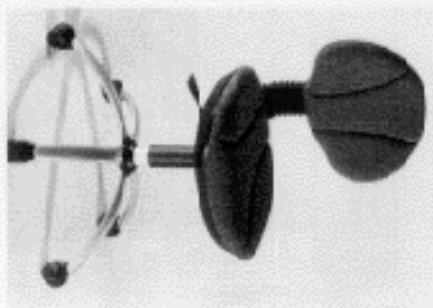
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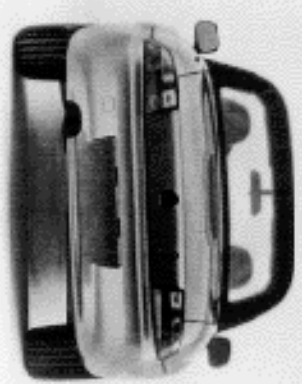
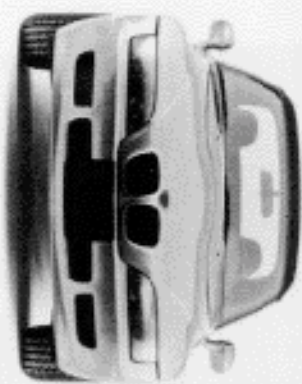
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1.1



1.2

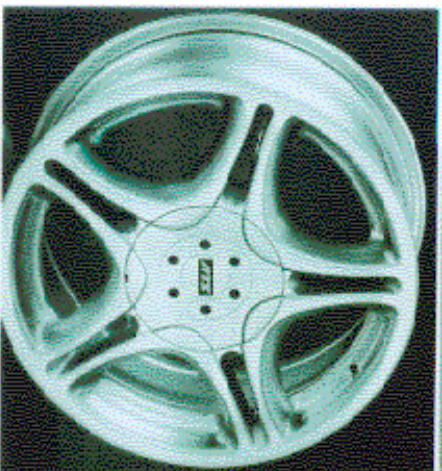


1.3



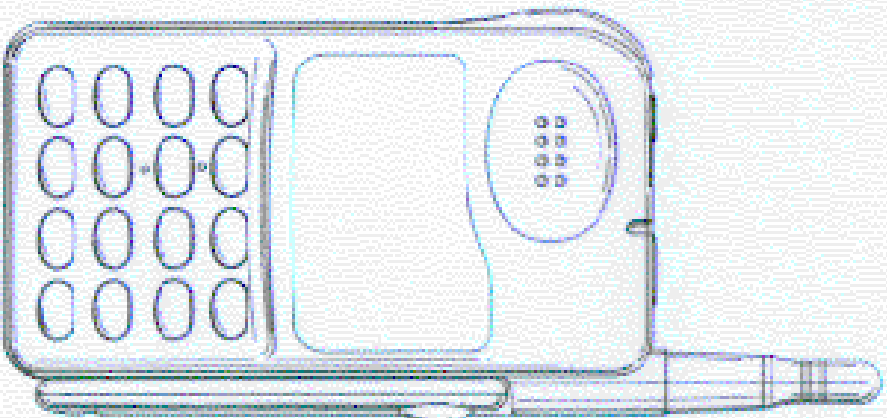
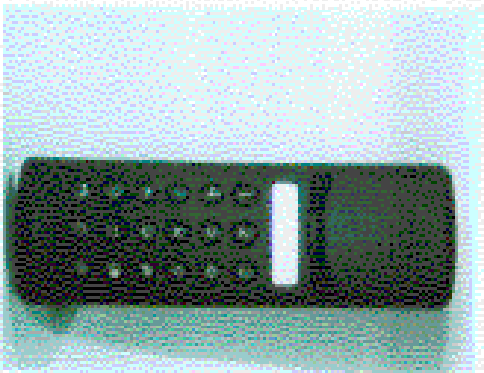
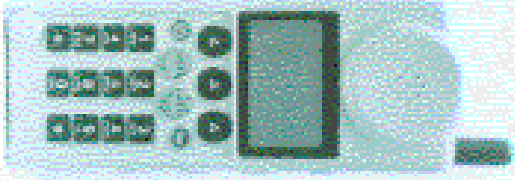
1.4

new and/or original?



17

new and/or original?



1.6



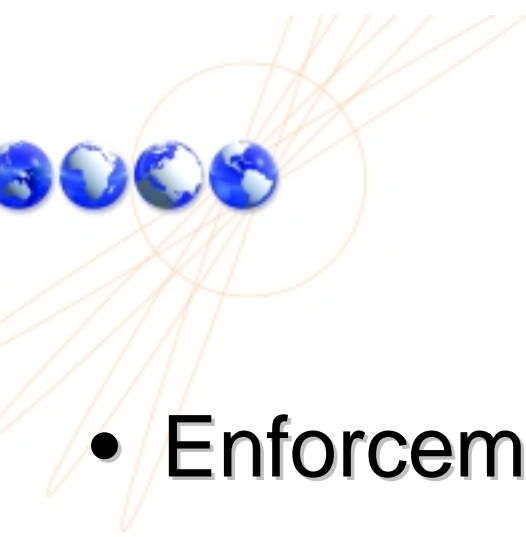
1.7



UNREGISTERED INDUSTRIAL DESIGNS

- Enforcement upon publication
- Originality
- No registration procedure is necessary
- Protection against copying only
- Shorter duration of protection

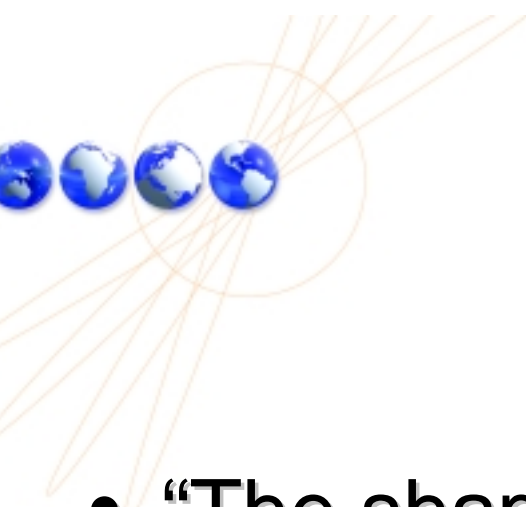




COPYRIGHT

- Enforcement upon creation (fixation)
- Protection for **works of applied art**
- Artistic merit
- No registration procedure
- Protection against copying
- Duration of protection during author's life + 50 (or more) years





Three- Dimensional Marks

- “The shape of goods or their packaging”
- Must be distinctive
- Must not be functional
- Potentially unlimited protection





UNFAIR COMPETITION PASSING OFF

- Right depends on “reputation” or “good will” obtained for the industrial design
- No registration
- Potentially no limitation of the duration of protection





CUMULATIVE APPROACH

Right holder can invoke cumulatively all existing forms of protection (ex: France)





EXCLUSIVE APPROACH

The registration of an industrial design excludes other forms of protection, such as, for example, copyright protection

