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PROTECTION OF THE APPEARANCE OF AN INDUSTRIAL PRODUCT THROUGH SHAPE MARKS, INDUSTRIAL DESIGNS OR COPYRIGHTS: THE EU LEGAL PERSPECTIVE AND PRACTICAL APPROACH

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Abstract. This presentation will deal with the challenges from an EU perspective of protecting the shape of industrial products with exclusive rights. Apart from patent protection, which is not addressed by this presentation, traditionally, in Italy, my country of origin, and in the EU, there are three routes to monopolize the shape of an industrial products to the benefit of just one entity. These three routes correspond to designs, trademarks and copyrights. All of them present pros and cons and have to cope with some related issues, which are going to be addressed in the following. The general and final purpose of the presentation is to provide the audience, both scholars and practitioners, with some hints for further dogmatic reflections and, at the same time, with some useful practical insights and takeaways on the EU law, case law and practice.

Keywords: Design, three-dimensional trademarks, copyright, IP overlap.

Designs. Design corresponds to the *sui generis* right specifically devised to protect the shape of an industrial products.

In other words, design is the natural tool to firstly look at when it comes to the need of the businesses to differentiate themselves or their products from the competitors and to gain or consolidate market shares.

The design of a product, intended as its visible appearance combining useful and aesthetical features, is an universally recognized competitive edge which can determine the success (or the failure) of a business.

There are businesses around the world which based most of their success on designs.

For almost two decades now, the EU has adopted a legislation on designs which made designs closer to trademarks than to patents as it used to be in the past.

Designs can be protected in the EU as long as (i) they are *novel*, that is not identical to earlier disclosed designs, and as long as (ii) they display the so called *individual character*, that is when they produce in an *informed user* an overall impression different from the overall impression produced in the same informed user by any earlier disclosed designs.

Designs in the EU are an exceptional legal tool for companies for many reasons.

Just to mention a few of them:

- Designs are intended for the purpose they serve, which they fit thus very well.

- Designs can protect, with some restrictions, also functional features of the shape of the product.

- Designs shall enjoy a cross-protection irrespective of the product concerned: there is thus no principle of speciality as for trademarks.

- Designs are very easy to obtain at a reasonable cost.

But there are also disadvantages (some of which related to the advantages):

- Any design disclosed anywhere is potentially novelty destroying.

- Clearance searches are therefore still somehow difficult and expensive.

- Design laws across the globe are not (fully) harmonized and some prudence shall be exercised when disclosing and extending the registered design outside the EU.

- Design protection expires after a maximum period of 25 years.

Trademarks. Trademarks are also a viable option to protect the shape of an industrial product. Or, at least, used to be.

Obtaining trademark protection for a certain shape of an object which is totally unrelated to the shape of the product itself is not an issue.

Instead, challenges are encountered when the shape for which an exclusive right is sought is the shape of the product itself.

The EU approach in this respect is quite strict, since trademark protection is potentially perpetual and the exclusivity on a shape of a certain product may provide a perpetual monopoly on the features of the shape which depends on some technical characteristics, which instead should

be protected by means of a patent or of a design and thus for a limited number of years.

This effect is seen as a possible unduly restriction of free trade and competition and is therefore limited by the EU law and its interpretation, which is in fact very narrow in admitting this possibility.

Firstly, it is established that the shape must be inherently distinctive in respect of the concerned products.

This, according to the EU case-law, means that the shape must significantly depart from the customary shapes of the products in the concerned field.

For non-distinctive shapes, proving the secondary meaning is also an option. But a very burdensome one since the secondary meaning, that is the acquired distinctiveness through use, shall be referred to the whole territory of the EU.

Most undertakings confronted with this proofs in fact failed, even in respect of iconic products which were largely recognized by the public but unfortunately not in all the EU Member States.

Furthermore, even assuming that a certain shape of a certain product is inherently distinctive, the same shall not be accorded trademark protection if some additional conditions are not met.

In particular, shall not be registered 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.

Especially the last indent of this provision caused headaches to practitioners and undertakings, which saw their trademark application refused or cancelled.

Furthermore, in respect of the shapes falling in the above exclusions, proving the secondary meaning will not be an option: functional or fine shapes shall be in fact excluded from trademark protection even if they became distinctive through use.

That is why, to succeed, some undertakings had to claim that, actually, not a shape mark but a position mark was sought (!).

In the end, trademark protection for the shape of the product itself in the EU is a hard job to obtain and even a harder job to keep.

Therefore, it should be sought in respect of somehow disrupting products changing the market paradigms and being complex enough not to fall in the traps of the exclusions, in particular, of the exclusions regarding the functional shapes or the shapes giving substantial value to the product.

Copyrights According to the EU law EU Member States shall provide cumulative copyright protection for industrial products protected, protectable or even no longer protected under design law.

The only requisite established by the EU law for copyright protection of an industrial product is the *originality* of the work, exactly as for music, literature and works of fine arts.

An original work, according to the European Court of Justice, is a work which is the author's own intellectual creation reflecting his personality and expressing his free and creative choices.

However, the extent to which, and the conditions under which, such a protection is conferred, including the level of originality required, shall be determined by each EU Member State.

This means that throughout the EU design protection of an industrial product shall be cumulated with copyright protection simply as long as the industrial product can be qualified as an *original* work according to the EU jurisprudence.

Then, the single Member States may still provide different rules for granting copyright protection, which remains in fact not fully harmonized.

Very recent case-law of the European Court of Justice furthermore suggests, that the provision of additional requirements other than *originality* specifically devised for industrial products but not, for example, for works of fine arts, literature or music, is against the EU laws.

In other words, it seems that if on a national basis there are additional requirements to access copyright protection other than originality, those additional requirements must be in principle the same for all types of copyrightable works, including industrial designs.

The current trend, as suggested by the above mentioned recent case-law, is therefore in the direction of lowering the requisites for copyright protection of industrial products possibly limiting it to *originality* only as it is the rule for the majority of the copyrightable subject matters.

On the other end, it seems that the interpretation of what is *original* and of what is to be meant with *copyrightable work* is becoming stricter, by requiring, for example, that the link between the author and its work as expressed by the creative process is convincingly argued and proven.

Particular attention shall be also paid to the identification of the *copyrightable work* which shall be identifiable with sufficient precision and objectivity and shall not therefore consist of a simple aesthetical effect subjectively perceived by the observer.

The chain of title and the assignment of the copyrights from the authors to the undertakings shall be also secured by the businesses, especially for enforcement purposes.

In the end, the current scenario, with just one important exception (i.e. the UK), shows that copyright protection for industrial products is available, with local peculiarities, in the majority of the EU Member States.

This is of course a very good news for innovative businesses, considering that copyright protection is going to last, as an international general rule, for 70 years after the death of the author.

Especially for those businesses owning iconic products no longer protected or protectable under design law.

Takeaways and conclusions

Takeaway for scholars (and possibly legislators) is that the protection of the shapes of industrial products is still a very challenging and fascinating subject where IP rights are confronted with competitive rights and other constitutional principles (freedom of trade, economic initiative, speech, expression, etc.).

Personally I am convinced that some limitations regarding trademark protection should be removed to ensure adequate protection to just a bunch of outstanding shapes with only a small compression of the aforesaid competitive rights and constitutional principles, which would in fact still apply to the vast majority of the shapes.

Secondary meaning should be possible, still with the very high burden of proof, also for shapes which are now excluded from trademark protection. Takeaway for practitioners and businesses is to carefully analyse the peculiarities of the case and to seek professional advice by possibly relying on more than one route: designs will be the rule; copyrights will be the dream; trademarks will be the challenge.