



3D TRADEMARKS AND INDUSTRIAL DESIGNS MULTI-PROTECTION OF INNOVATIONS CUMULATIVE, NON-EXCLUSIVE RIGHTS LEGAL ASPECTS

Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

Ana Casas
Consultant – IP Lawyer
October, 2021

TRADEMARK: DEFINITION AND CHARACTERISTICS

The trademark, besides of having the usual marketing requirements, also has to be capable of:

- a) To distinguish/individualize a product in the market: to differentiate the product from the others of analogue nature.
- b) To identify the Company which markets / distributes the product.

I. LEGAL CONCEPT: TRADEMARK

Article 4 REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 14 June 2017 on the European Union trade mark

An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- (a) distinguishing the goods or services of one undertaking from those of other undertakings; and*
- (b) being represented on the Register of European Union trade marks ('the Register'), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.*

I. LEGAL CONCEPT: TRADEMARK

Your trade mark is the symbol your customers use to pick you out. It distinguishes you from your competitors. You can protect and build upon your trade mark if you register it.

In some countries, you can also get protection even if your trade mark is not registered, as long as it is used. However, you are well advised to register it in order to obtain the best protection.

The only condition imposed on a registered trade mark is that it must be clearly defined; otherwise neither you nor your competitors will be certain of what it covers.

One trademark has to pass two exams for being registered:

- The absolute grounds: not incur in any of the legal prohibition.
- The relative grounds: not collide with other prior marks.

I. LEGAL CONCEPT: TRADEMARK :ABSOLUTE GROUNDS: LEGAL PROHIBITIONS FOR THE REGISTRATION OF TRADEMARKS

When you create a trademark, it is necessary to take into Account the Absolute grounds established in the art 7 of the REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 14 June 2017 on the European Union trade mark

Article 7 Absolute grounds for refusal



1.The following shall not be registered:

- (a) signs which do not conform to the requirements of Article 4; i.e. **the first chapter of EL QUIJOTE**
- (b) trade marks which are devoid of any distinctive character; i.e. **TABLE in class 20 for “tables”**
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service; i.e. **“bood tables” in class 20 for “tables”**
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade; i.e. **“burguer”**
- (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;

I. LEGAL CONCEPT: TRADEMARK :ABSOLUTE GROUNDS: LEGAL PROHIBITIONS FOR THE REGISTRATION OF TRADEMARKS

- (f) trade marks which are contrary to public policy or to accepted principles of morality; 16.6.2017 L 154/8 Official Journal of the European Union EN i.e. **EUTM 18054227 “MARIHUANA”cl 30,32,34**
- (g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;i.e. **from Italy**
- (h) trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property ('Paris Convention'); **i.e. “CHAMPAGNE”**
- (i) trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the competent authority to their registration has been given;
- (j) trade marks which are excluded from registration, pursuant to Union legislation or national law or to international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications;
- (k) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine;
- (l) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional specialities guaranteed;
- (m) trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law, or international agreements to which the Union or the Member State concerned is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species.

I. LEGAL CONCEPT: TRADEMARK :ABSOLUTE GROUNDS: LEGAL PROHIBITIONS FOR THE REGISTRATION OF TRADEMARKS EXCEPTIONS

Exceptions:

- * When the trademark has acquired distinctive character for the goods or services for which registration is sought in consequence of the use made of said mark.
- * When from the combination of the absolute grounds results a distinctive sign



Trademark composed by Words of
Common use



Trademark with one meaning totally
different of the covered goods

I. LEGAL CONCEPT: TRADEMARK :RELATIVE GROUNDS:OTHER PRIOR RIGHTS

Relative Grounds: are those referred to earlier trademarks

Article 6. Earlier trademarks

1. The following signs shall not be registered as trademarks:

a) Those which are identical to an earlier trademark and claim identical goods or services.

b) Those which by being identical or similar to an earlier trademark and by claiming identical or similar goods or services may give rise to a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.

I. LEGAL CONCEPT: TRADEMARK :RELATIVE GROUNDS:OTHER PRIOR RIGHTS

The general rule is: two trademark should be consider incompatible when they cover identical/similar products with an identical or similar denomination:

Example:

SAMSUNG

SAMSING

Televisions

televisions

I. LEGAL CONCEPT: TRADEMARK :RELATIVE GROUNDS:OTHER PRIOR RIGHTS

Two trademark should be consider incompatible when they cover identical/similar products with an identical or similar denomination, At least they have to coincide in the same market field:



Handbags and perfumes

vs

televisions and electronics

Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

I. LEGAL CONCEPT: TRADEMARK :CLASSIFICATION OF PRODUCTS AND SERVICES

The International Agreement named Nice Classification, classifies all the products and services in the market in 45 classes.

From the class 1 to the 34: are included all the products and from the 35 to the 45 all the services,

This classification is updated each 2 years and each country adapts its content in its Internal rules.

I. LEGAL CONCEPT: TRADEMARK :CLASSIFICATION OF PRODUCTS AND SERVICES

The International classification is ruled by the WIPO (World International Property Organization) and it is detailed in its webpage







http://web2.wipo.int/classifications/nice/nicepub/en/fr/edition-20160101/taxonomy/class-5/?pagination=no&lang=en&mode=flat&explanatory_notes=show&basic_numbers=show

For example: the pharmaceutical products are included in class 5 and the cosmetics in class 3

I. LEGAL CONCEPT: TRADEMARK :TYPOLOGY OF TRADEMARKS

| <u>TERRITORIAL POINT OF VIEW</u> | |
|----------------------------------|---|
| NATIONAL TRADEMARK: | <i>When the trademark is filed directly in the interested National Office.</i> |
| EUTM: | <i>When the trademark is filed before the EUIPO (European Office of the IP). These marks cover the whole EU.</i> |
| INTERNATIONAL TRADEMARKS: | <i>When based on a national registration different abroad extensions are filed before the WIPO (International Office of the IP)</i> |
| FOREIGN TRADEMARK: | <i>When the trademark is filed directly in the National Office of a foreign country.</i> |

I. LEGAL CONCEPT: TRADEMARK :TYPOLOGY OF TRADEMARKS

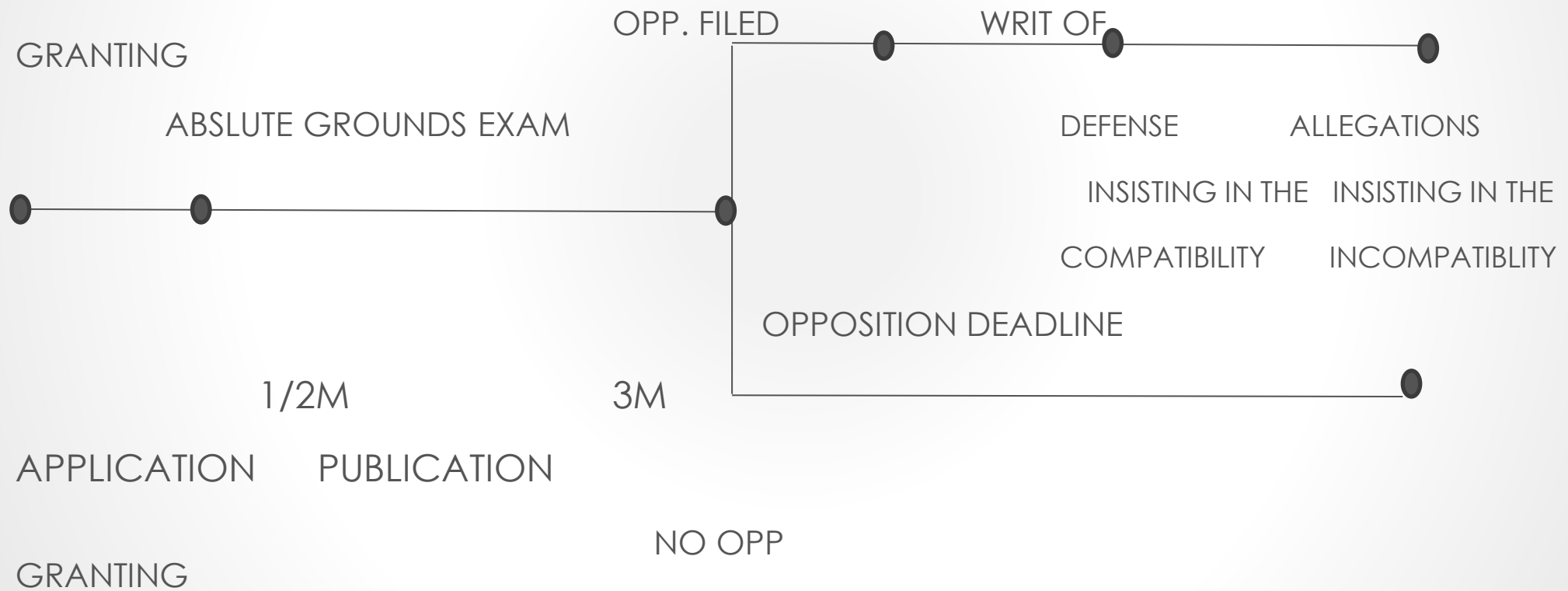
| <u>NATURE POINT OF VIEW</u> | |
|-----------------------------|---|
| VERBAL MARKS: | “BIODRAMINA”; “IPHONE” |
| FIGURATIVE : |   |
| GRAPHIC: |    |
| TRIDIMENSIONAL: |  |

I. LEGAL CONCEPT: TRADEMARK :OTHER TYPE OF TRADEMARKS: LEGAL CHANGES

After studying the basic tools to protect the industrial projects, now we are going to comment the new type of trademarks ruled in the REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 14 June 2017 on the European Union trade mark:

- . Sound trademarks: onomatopoeia
- . Olfactory trademarks :
- . Taste trademarks
- . Hologram trademarks: the vird of VISA card.
- . Movement trademarks:

I. LEGAL CONCEPT: TRADEMARK :OTHER TYPE OF TRADEMARKS: LEGAL CHANGES. REGISTRATION PROCESS



II.- INDUSTRIAL DESIGNS: DEFINITION AND CHARACTERISTICS

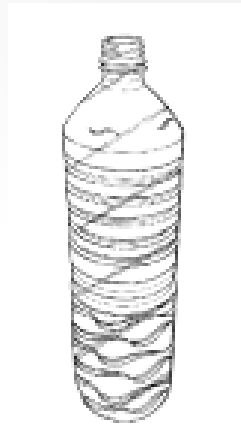
- In the Intellectual Property field, the legal concept of Industrial Design is : **COUNCIL REGULATION (EC) No 6/2002 of 12 December 2001 on Community designs**

'The appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation', (Art 3 Design Regulation).

II.- INDUSTRIAL DESIGN: TYPE OF INDUSTRIAL DESIGNS

An industrial design can be presented as:

a) Tridimensional design, the shape of the product:



II.- INDUSTRIAL DESIGN: TYPE OF INDUSTRIAL DESIGNS

b) Bidimensional design, ornaments, lines, contours, colors, shape of the product



c) A combination of elements such as the mentioned ones:



II.- INDUSTRIAL DESIGN: PARTICULARITIES

An Industrial design is in force and, has the correspondent legal effects, during 25 years from the application date (the owner has to renew it each 5 years during this period).

The industrial design will cover those territories which have been detailed in its application: national, UE or a foreign country.

II.- INDUSTRIAL DESIGN: PARTICULARITIES

Once you file the Design, since it covers the appearance of a product, you have to show all the possible views and angles of the design and the possible versions that the competitors can replicate:



it covers the form of the product in the market

DOUBLE REGISTRATION: COMPANY STRATEGY

it cover the distinctive logotype or word that allows the consumer to identify the product



EU DESIGN Núm. 002077115-0009



EU TRADEMARK No. 7426661



EU TRADEMARK No. 5057179

Owner: THE PROCTER & GAMBLE COMPANY



EU DESIGN Núm. 001543125-0011



EU TRADEMARK Núm 6572382



EU TRADEMARK Núm 6580476



EU TRADEMARK Núm 6580666

Owner: THE PROCTER & GAMBLE COMPANY

WHICH KIND OF PROTECTION DO YOU THINK THESE PRODUCTS HAVE



WHICH KIND OF PROTECTION DO YOU THINK THESE PRODUCTS HAVE



EU Design No. 002405696 – 0060



EU TM18332537



EUTM 03095651

WHICH KIND OF PROTECTION DO YOU THINK THESE PRODUCTS HAVE



WHICH KIND OF PROTECTION DO YOU THINK THESE PRODUCTS HAVE



EU Design No.000006689
000011028



EUTM 012610961

EUTM 000143933

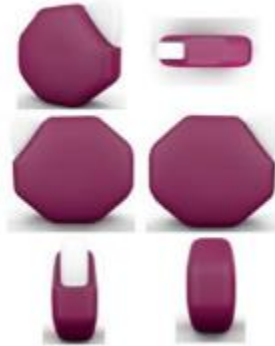


EU Design

Exceptions: when the intensive use of the product converts it in a trademark



EUTM 031203



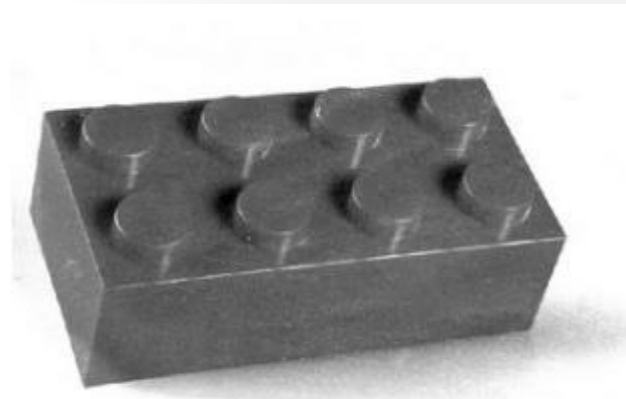
EUTM 3630714



EUTM 8577298



EUTM 0151985



EUTM 4938635

Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

Exceptions: when the intensive use of the product converts it in a trademark

It is pretty clear that, all these products, after their intensive use in the market and their advertising they became a trademark.

With their visualization the consumer can identify the product, the owner and the quality of the product or services it is marketing. i.e.



So the industrial design, which identifies the chocolate shape in this case, has become a distinctive sign for the consumer. And every time the consumer sees a rabbit in the chocolate shops, he is able to figure it out that the LIND trademark and company are behind the product.

**¿In real life ... What can we
protect?**

Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

A new product: ¿what can we protect?

UNIVERSAL DE DESARROLLOS ELECTRÓNICOS S.A.



HENKEL AG & CO KGAA



Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

UNIVERSAL DE DESARROLLOS ELECTRÓNICOS S.A.

HENKEL AG & CO KGAA



CIRSA 

EUTM No. 011224458



International Registration nº
721998

Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

UNIVERSAL DE DESARROLLOS ELECTRÓNICOS S.A.

HENKEL AG & CO KGAA



CIRSA 

EUTM núm. 011224458



EU Design núm. 000293410-0001
"furniture for slots"



IR 728081

EU DESING 000195185-001
"office equipment"



Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

UNIVERSAL DE DESARROLLOS ELECTRÓNICOS S.A.



EU Desing núm.
001919556-0001
"slot video screens"

HENKEL AG & CO KGAA

EU Design 000596061-0004



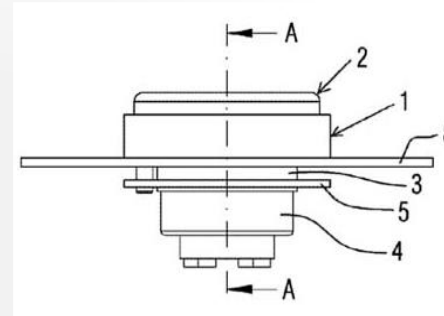
Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

UNIVERSAL DE DESARROLLOS ELECTRÓNICOS S.A.



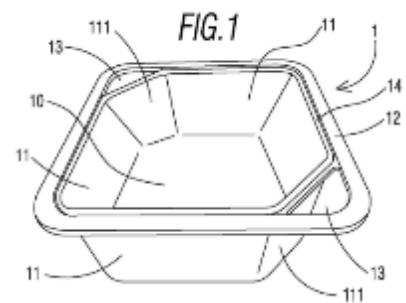
Utility modeln. U201030319 (ES1072280)
por "switch- push botton"



INDUSTRIAL IRIS, S.A.



INDUSTRIAL IRIS, S.A.

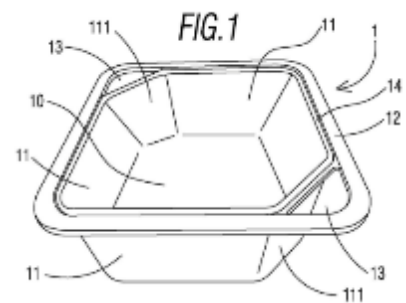


Utility model num. U201230071
(ES1076194) for covering "container with top
for cooking foodstuff"



Community design núm. 001995473-0002 r
"utensils and containers for cooking"

INDUSTRIAL IRIS, S.A.



Utility model núm. U201230071
(ES1076194) "container with top for cooking
foodstuf"



EU Design núm. 001995473-0002 "utensils
and containers for cooking"



INDUSTRIAL IRIS, S.A.

This container design became very famous in Spain and it has been protected through an Industrial design. Its owner has 25 years for marketing it in exclusively



DIFFERENCES BETWEEN THE LEGAL PROTECTION OF A 3D TRADEMARK AND AN INDUSTRIAL DESIGN

| 3D TRADEMARK | INDUSTRIAL DESIGN |
|--|--|
| The 3D trademark covers the distinctive character of the sign in front of other signs preexistent in the same market area. | The Industrial designs cover 'The appearance of the whole or a part of a product resulting from the features'' The industrial design requires novelty and singular character |
| The trademarks require distinctive character | The industrial designs require novelty |
| Trademarks have no time limit they can be renewed endlessly | The industrial designs have legal effects for a maximum of 25 years from the application. |

3D TRADEMARK OR INDUSTRIAL DESIGN

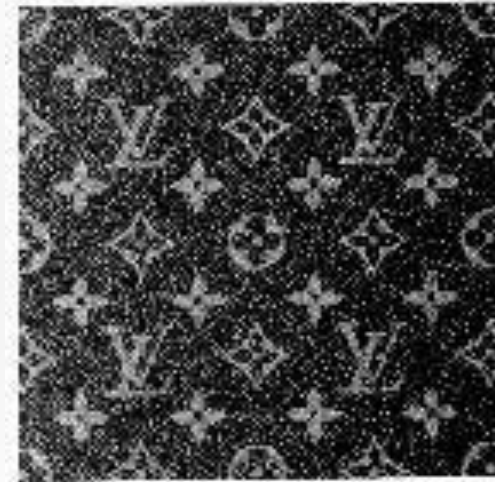
Nowadays, the companies have different legal tools to cover their creations or new projects.

Depending on the character of these new projects (continuity in the market, importance of the Project, etc) the companies will prefer the 3D trademark (which is renewed endlessly) or the Industrial Design (which covers the appearance of the product in the market).

PROTECTION OF BAGS



EU Design 001957200-0001
LOUIS VUITTON MALLETIER



EU Trademark No.
15602

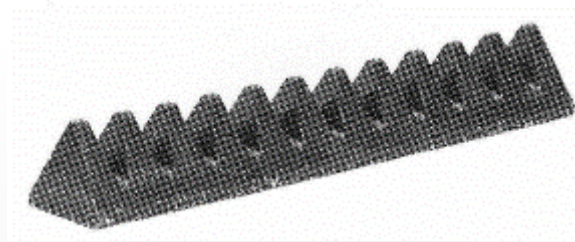
Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

Protection of Chocolates



EUTM 0031203



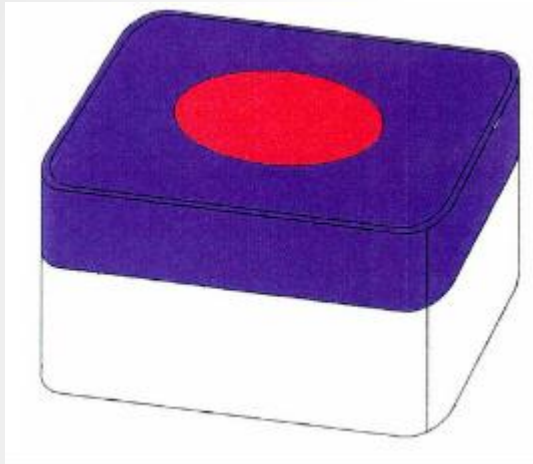
EUTM 0031237



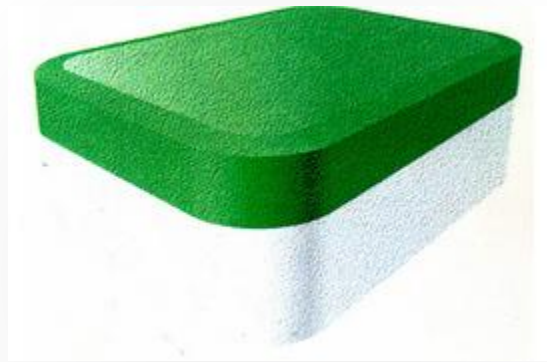
EUTM 00505461

These marks can be renewed forever, so it has been a clever decision to cover the chocolate products as 3D trademark. Kraft Foods Schewiz Holding GMBH

Soaps Protection



EUTM 001 1403000



EUTM 00840090

These marks can be renewed forever, so it has been a clever decision to cover the chocolate products as 3D trademark. Henkel AG & Co. KGaA

RISKS OF 3D TRADEMARKS

The risk of filing a shape as 3D trademark is that it has to keep the distinctive character required by law to be a trademark.

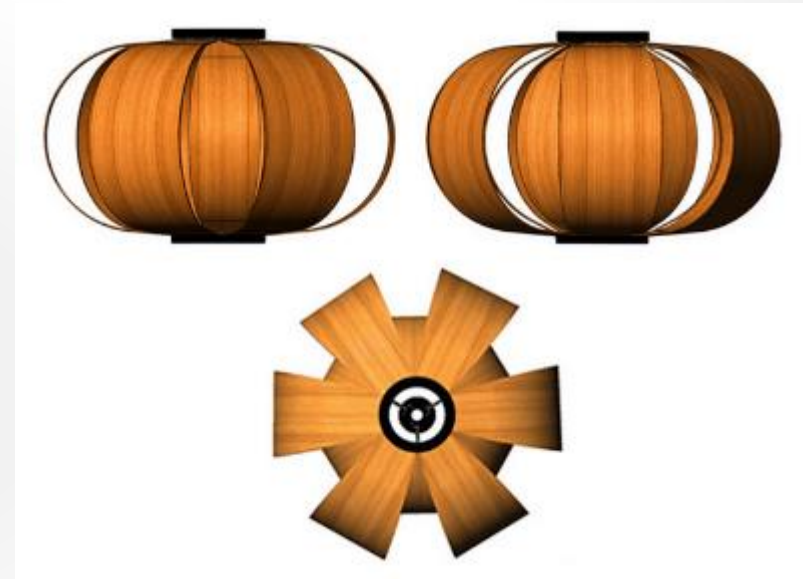
A lot of companies tend to file as 3D trademarks the shape of their products since, if the trademark is granted, they can have an endless protection.

This granting depends on the examiner, who will have to evaluate if the filed trademark accomplishes with the two main requirements:

- A) Distinctive character
- B) Identify the origin of the product

RISKS OF 3D TRADEMARKS

The case of the EUTM 18271785 is an example: it was refused because the examiner considered that the Intended mark lacks of distinctive character. (main requirement of The trademark)



The examiner considered that this mark could not be “per se” a distinctive sign, since the consumer could not identify the company origin from the visualization of the graphic from another similar one

CONFLICT BETWEEN 3D TRADEMARK AND INDUSTRIAL DESIGN

Since the international, community and National laws allow the registration of 3D trademarks and industrial designs, these two type of registration start to be object of conflict in the different markets.

The examiner has to evaluate if the consumer could be misled to think that both signs come from the same Company or the products have the same quality, etc.

So the recent resolutions have become into a detailed analysis of the confronted shapes and their differences.

Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

CASE LAW: EUIPO CANCELLATION NO. 26903 C (NULLITY) DECEMBER 17TH 2019

Agua-Mancha, S.L., against Marqués de Murrieta, S.A,

The applicant filed a cancellation action to declare the invalidation against all products included in class 33 of the European Union mark 15 192 123 based on the EU Design 1 681 545-0001



Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual

CASE LAW: EUIPO CANCELLATION NO. 26903 C (NULLITY) DECEMBER 17TH 2019

The fact that both rights consist of bottles with edges verticals and a space dedicated to a label is not enough for the existence of similarity between the earlier design and the contested mark three-dimensional.

There are different features in both rights as detailed above. Therefore, with all of the above, the overall impression caused by the design above and the contested EUTM is very different.

The consumer will have a very different overall impression when he compares the confronted signs:

CASE LAW: EUIPO CANCELLATION NO. 26903 C (NULLITY) DECEMBER 17TH 2019



In view of the foregoing, it is concluded that the contested trademark is moving away clearly from the previous design. Shows differences in characteristics of the earlier design that are not subject to any technical necessity that forces the author to adopt a certain form and size.

Thank you for your attention

Ana Casas

Consultant – IP Lawyer at Isern Patentes y Marcas

consultant@isern.com

Isern
desde 1924

ISERN PATENTES Y MARCAS
Abogados y Agentes de la Propiedad Industrial e Intelectual