

QUESTION 148

Three-dimensional marks: the borderline between trademarks and industrial designs

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Q148

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RESOLUTION

AIPPI observes that:

- a) It is commercially important to recognize and protect intellectual property rights embodied in or represented by three-dimensional objects, compositions, or shapes (“3D shapes”), and both trademark rights and industrial design rights can be applied to achieve that objective, notwithstanding the protection that may be available from other parts of the law.
- b) As used in this Resolution, “trademarks” or “trademark protection” also include protection as trade dress or product get-up, which terminology is used in some of the reporting countries; the term “trademarks” also includes service marks; and the term “industrial designs” also includes design patents, which terminology is used in some of the reporting countries, but does not include utility patents.
- c) It is accepted that 3D shapes should be protected and registered as trademarks, as is already the case under many national laws, provided they perform the trademark function.
- d) Trademark law and industrial design law are designed to achieve related but distinct legal purposes, and thus differ from one another in requirements for protection, limitations, scope of protection and other respects;
- e) Unlike industrial designs, trademark rights are not time-limited. The main reason for this is that trademarks contribute to protecting consumers and the public against the risk of confusion as to the source of the product, while industrial designs protect the design owner’s exclusive right to make the product itself, irrespective of source indications.

- f) These and other differences sometimes create issues concerning the compatibility of simultaneous protection under trademark law and industrial design law, and whether trademark protection can continue after industrial design protection expires.
- g) It would be beneficial to reach an international consensus on how these two areas of law can be understood and applied with consistency, minimizing any conflict or tension between them.

Drawing upon its national and regional group reports to study the similarities and differences among its member countries, and to reach a consensus on clear criteria as to when a three-dimensional shape may be legally protected as an industrial design and/or as a trademark, and whether the two forms of protection can coexist simultaneously,

AIPPI resolves:

1. 3D shapes are protectable both as industrial designs and as trademarks, provided that the usual requirements for each modality of protection are satisfied. Industrial design protection is usually time-limited, but trademark protection usually can continue indefinitely, as long as the applicable legal requirements as to use and/or registration are met. In addition to these primary requirements, there may be other requirements which should be met in order to obtain and maintain trademark protection.
2. To be protected as an industrial design, the 3D shape must be new, though the standard of novelty is not the same in every country or territory, for instance some jurisdictions requiring worldwide novelty and others requiring only local novelty.
3. To be protected as a trademark, the 3D shape must be distinctive and not solely functional or necessary, and it must also satisfy other conditions generally applicable to trademarks.
4. To be distinctive the 3D shape must indicate product or service source to the relevant consuming public. The standard of required distinctiveness may not be the same in every country or territory. It is left to the appropriate legislature or courts in each jurisdiction to determine whether a 3D shape can be considered to be inherently distinctive for purposes of trademark protection, or whether the 3D shape can be protected under trademark law only after it has acquired distinctiveness through use. When acquired distinctiveness is required, this factual determination should be made only after considering all pertinent facts and circumstances, as provided in article 6 quinquies C of the Paris Convention.
5. Trademark law should not protect 3D shapes that are solely functional or necessary, namely those which solely: (a) result from the nature of the goods themselves, or (b) are necessary to obtain a technical result relating to the nature of the goods or services covered by the mark.

6. Cumulative protection is possible for the same 3D shape under trademark law and industrial design law, provided the conditions for each type of protection are satisfied. No specific rule precludes trademark protection for a 3D shape protected or previously protected as an industrial design or under another IP modality.
7. The use of a 3D shape which is protected as an industrial design will not lead *per se* to a loss of distinctiveness and a loss of trademark protection (or eligibility therefore). However, indiscriminate licensing by the industrial design owner, without observing trademark licensing requirements could cause the 3D shape to lose its distinctiveness and trademark protectability. Observing proper trademark marking procedures and taking legal action to stop unauthorised use by infringers helps to avoid loss of distinctiveness in a 3D shape.
8. Expiration of industrial design protection in a 3D shape should have no effect on the continuation of trademark protection in the same 3D shape, but trademark rights can be lost if the trademark ceases to perform a trademark function, or for other reasons provided under national trademark law. If trademark rights are lost, an industrial design right in the same 3D shape may nevertheless remain valid.
9. In filing an industrial design application, Convention priority should not be accepted on the basis of a prior trademark application for the same 3D shape, or *vice versa*.
10. Protection of a 3D shape as a trademark should not be precluded by the fact that the shape is used in combination with a word mark or another type of sign. The use of the 3D shape with the word mark or other type of sign can lead to acquired distinctiveness for the 3D shape and can prevent loss of rights in the 3D shape on non-use grounds.
11. Determination of trademark infringement should focus on the shape as a symbol of source; determination of industrial design infringement should focus on reproduction of the shape of the product itself. Civil remedies should generally be similar for both trademark and design infringement.

AIPPI calls upon countries and other jurisdictions not complying with the foregoing general principles to bring their legislation into accordance therewith.
