

# Bristows

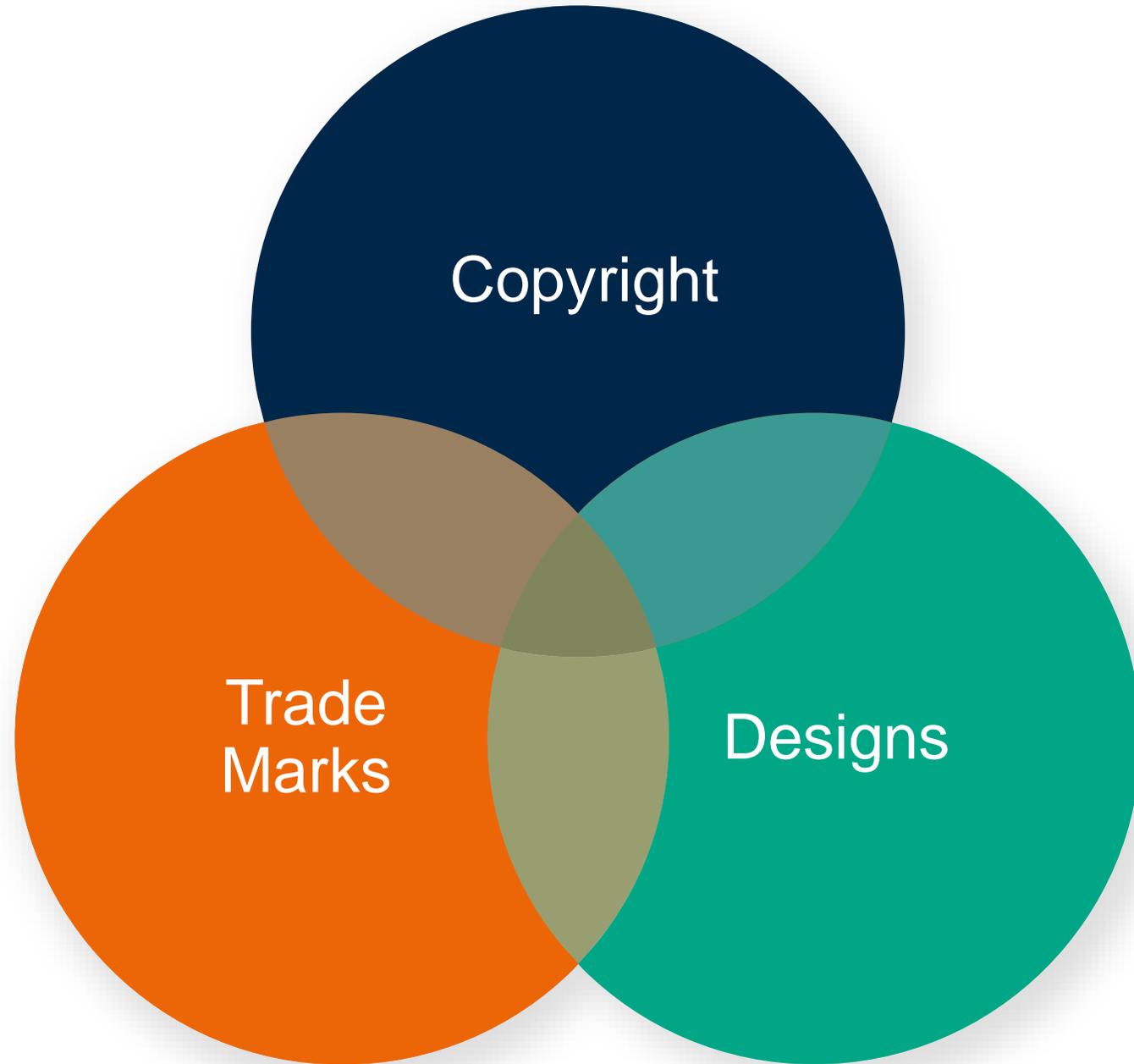
The interplay between trade marks, designs and copyright

Practical legal strategies to help protect new products in the real world

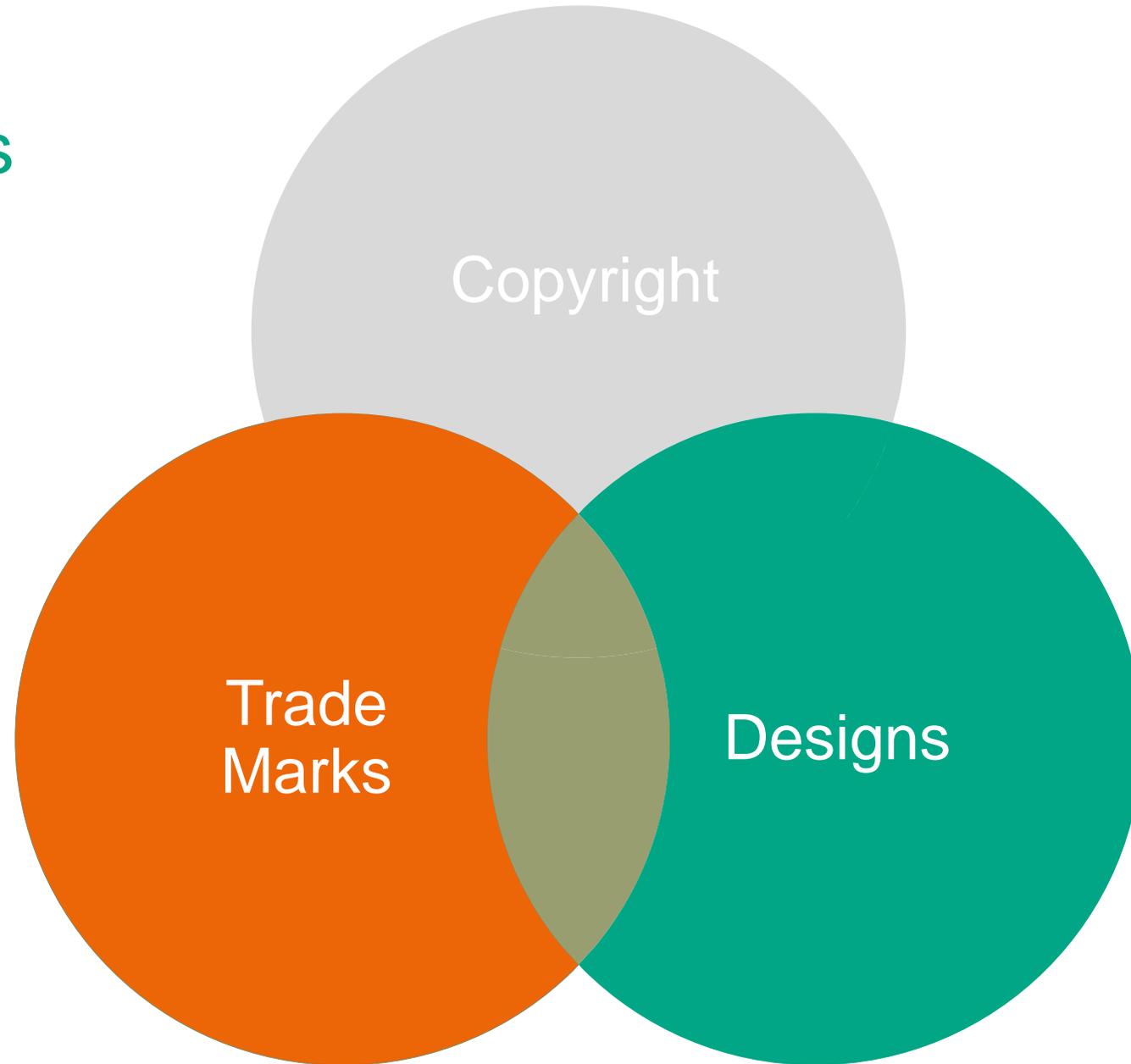
14 May 2024



Sean  
Ibbetson



# Designs & Trade Marks



# Designs & Trade Marks

Right	What is protected?
Registered designs	the <b>appearance</b> of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation
Unregistered design rights	the <b>shape or configuration</b> (whether internal or external) of the whole or part of an article
Trade mark	A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or <b>the shape of goods or their packaging</b>

# Shapes which cannot be registered as trade marks

## s.3(2) excludes shape or another characteristic:

- which results from the nature of the goods themselves
- of goods which is necessary to obtain a technical result, or
- which gives substantial value to the goods.

***s.3(2) Trade Marks Act 1994***

## The underlying rationale:

- ✓ Protect competition by preventing monopolies over basic characteristics of a product which are essential.
- ✓ Maintain the balance provided by the differing time limits afforded to each IP right.
- ✓ Recognises the different purposes of trade marks and designs.

***AG Opinion in Hauck, C-205/13***

# Shapes which cannot be registered as trade marks

**Shape which is necessary to obtain a technical result**

***Gömböc, C-237/19***



1

The exclusion seeks to prevent a monopoly on technical solutions or functional features of a product which a user is likely to seek in the products of competitors.

2

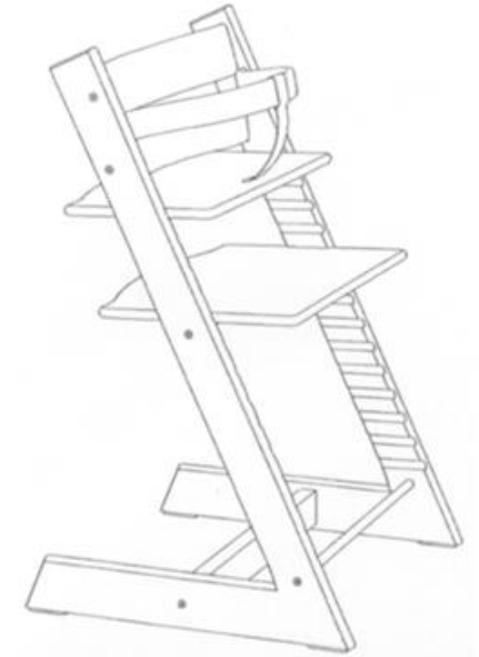
The court can consider information which is not on the register.

# Shapes which cannot be registered as trade marks

## Shape which gives “substantial value” to the goods

### *Hauck C-205/13, London Taxi [2016] EWHC 52 (Ch)*

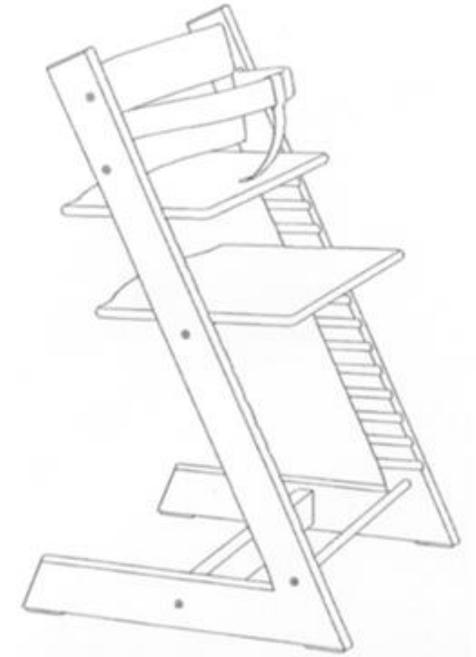
1. Underlying rationale: prevent monopolisation of shapes which enhance attractiveness of goods or strongly influence consumer preference.
2. Not purely economic value
3. The concept is not limited to products which only have artistic or ornamental value.
4. The value does not include reputation/goodwill – the value must derive from the shape/other characteristic.



# Shapes which cannot be registered as trade marks

## Shape which gives “substantial value” to the goods

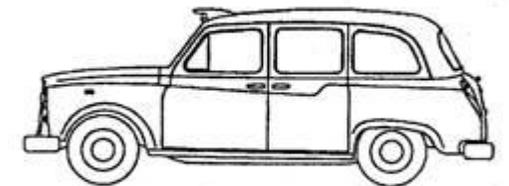
1. Protected as a registered design?
2. Consumer perception
3. The category of the goods
4. Artistic value of shape
5. Dissimilarity from other shapes in common use
6. Substantial price difference compared to similar goods
7. Promotional strategy focussed on accentuating aesthetic characteristics



# Shapes which cannot be registered as trade marks

## Shape which gives “substantial value” to the goods

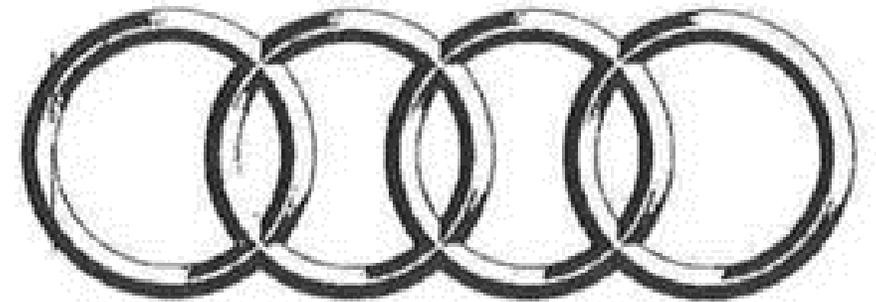
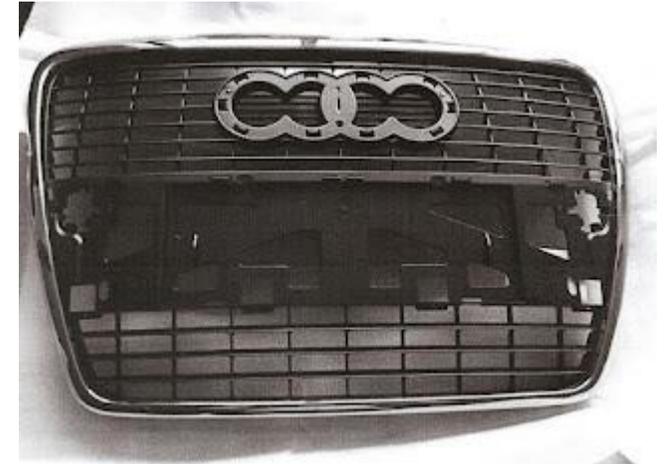
- ✓ Protected as a registered design
- ✓ Consumers placed a value on the shape
- ✓ Recognised that cars have aesthetic qualities as well as functional ones
- ✓ The design was regarded as “iconic” and a “design classic”
- ✓ The shape was dissimilar to other cars
- ✓ The price did not seem to be significantly different
- ✓ LTC promoted its taxis as being iconic and emphasised their appearance



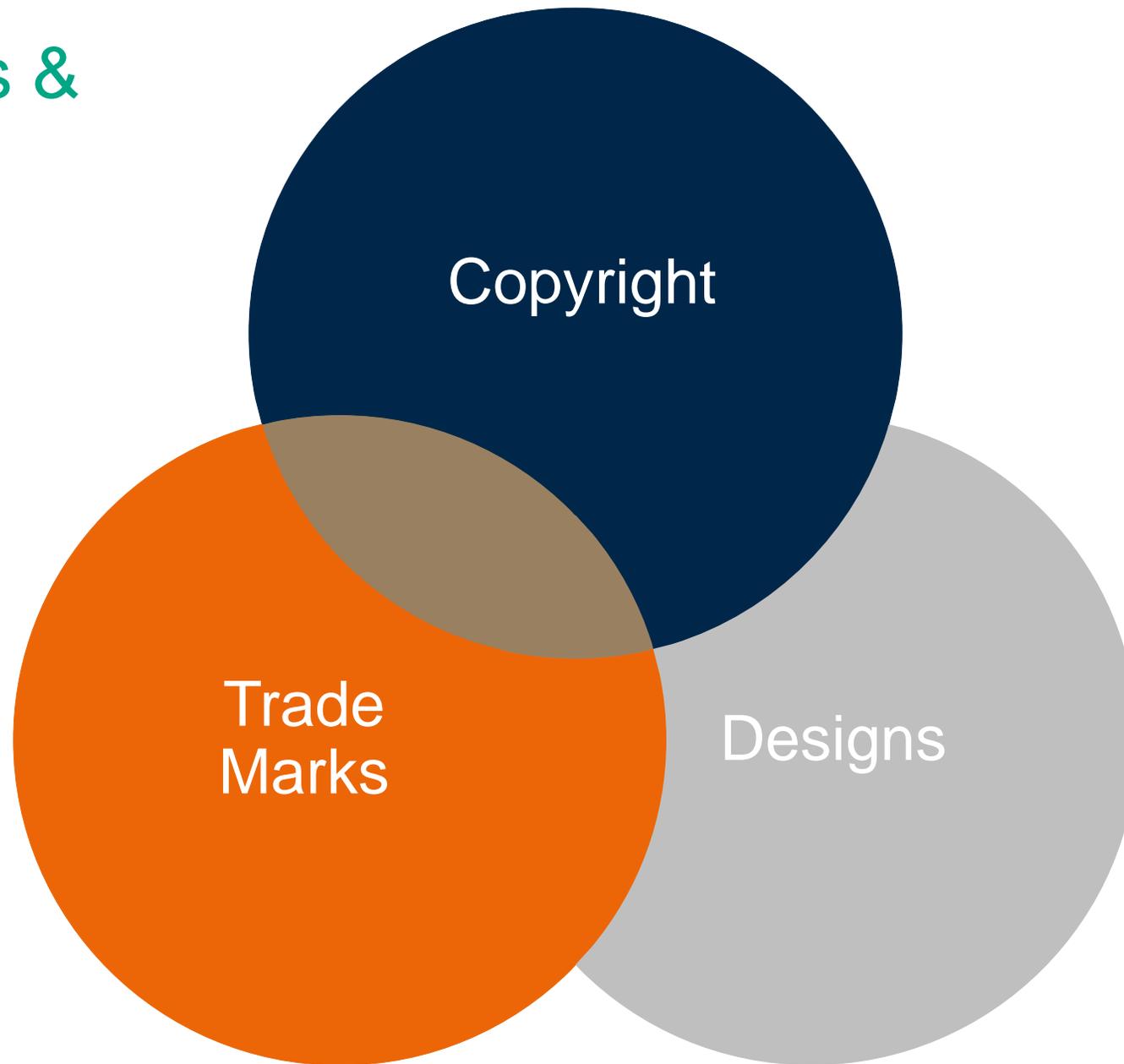
# Spare parts which incorporate a trade mark

## *Audi (C-334/22)*

- The CJEU distinguished between trade mark and design protection, in the context of spare parts for motor vehicles.
- There is no “Repair clause” for trade marks.
- Article 14(1)(c) does not prevent Audi from prohibiting a third party from using a shape on radiator grilles to which the emblem would be affixed.



# Trade Marks & Copyright



# Trade Marks & Copyright

Right	What is protected
Trade mark	<i>A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, <b>sounds</b> or <b>the shape of goods or their packaging</b></i>
Copyright	<i><b>artistic works</b>, including graphic work, photograph sculpture or collage ...work of architecture, and work of artistic craftsmanship <b>Sound recordings</b> <b>Musical works</b></i>

## Possible overlaps between trade marks & copyright



Sound marks may also protected by copyright as musical works and also as trade marks



Distinctive furniture pieces may be protected both as a trade mark (shape) and by copyright (work of artistic craftsmanship).



Logos may be protected both by a registered trade mark and copyright

# Possible overlaps between trade marks & copyright



The layout of a retail store may be registered as a trade mark. Buildings are also protected by copyright, being a work of architecture.

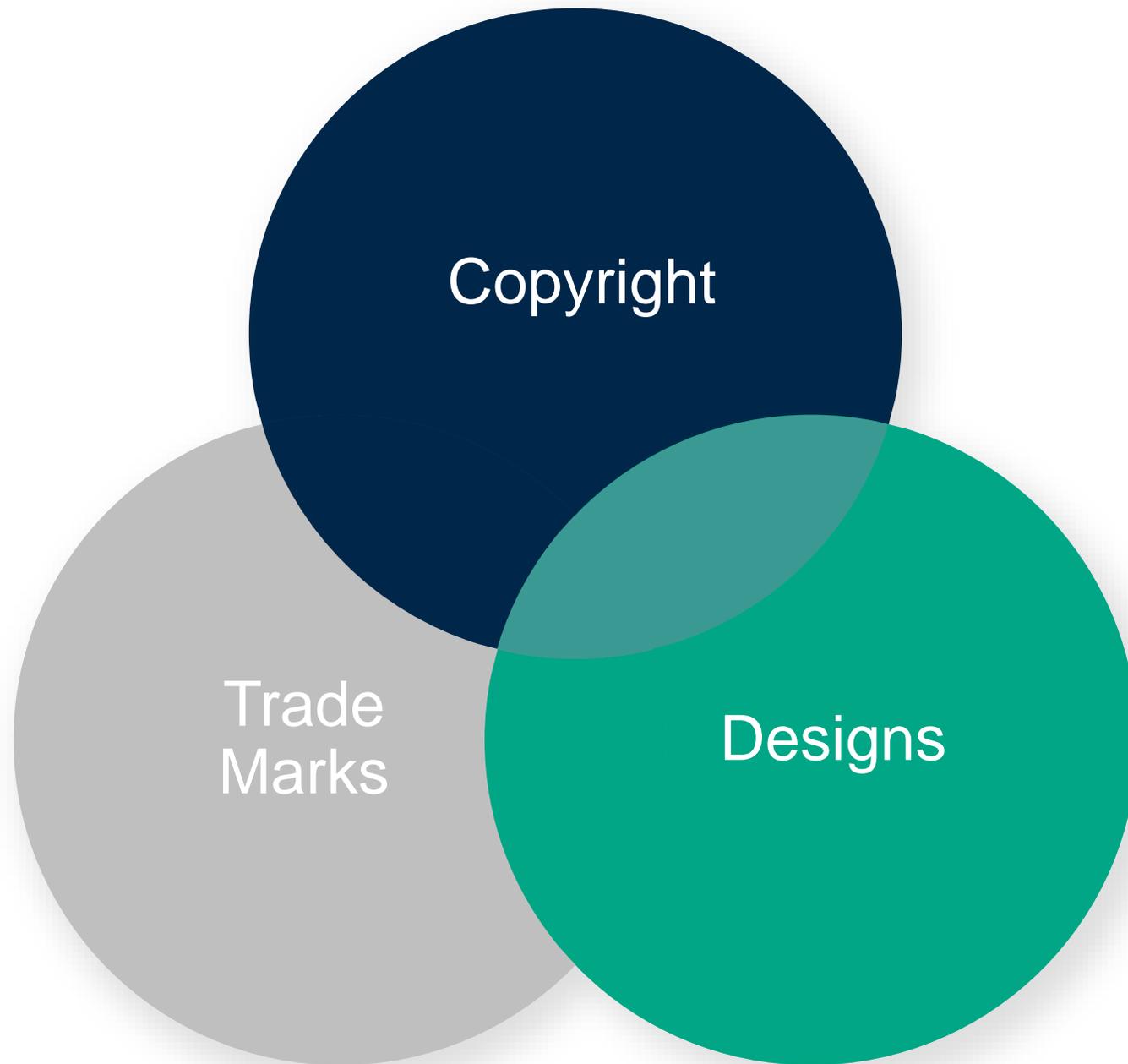


Characters (for character merchandising)

## Is there a problem with this overlap?

- Art 9 InfoSoc Directive provides the Directive is without prejudice to other IP rights
- Copyright provides a much lengthier period of protection than designs, although a perpetually renewable trade mark registration could – in theory – frustrate the copyright ‘bargain’.
- Section 3(2) TMA is equally relevant to copyright as it is designs.

# Copyright & Designs



# Copyright & Designs

Right	What is protected
Registered design and supplementary unregistered design right	<i>the <b>appearance</b> of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation</i>
Unregistered design right	<i>the <b>shape or configuration</b> (whether internal or external) of the whole or part of an article</i>
Copyright	<i><b>artistic works</b>, including graphic work, photograph sculpture or collage ...work of architecture, and work of artistic craftsmanship</i>

## How the overlap is addressed by the legislation

- The availability of copyright protection and designs rights at the same time is explicitly recognised in the legislation.
- In the UK, if unregistered design right and copyright subsist then the owner must pursue the copyright claim.



Should this still be the case if the scope of copyright protection has expanded?

# The expansion of copyright protection: Part 1 - clothing

## *Cofemel* (C-683-17)

- Clothing designs are capable of being copyright works.
- The CJEU noted that “*the protection of designs, on the one hand, and copyright protection, on the other, pursue fundamentally different objectives and are subject to distinct rules*”.



# The expansion of copyright protection: Part 2 – partly functional shapes

## *Brompton (C-833/18)*

- Copyright can subsist in functional shapes but only where the subject matter in question passes the test for originality and not in instances where the product's shape is solely dictated by its technical function.



# The UK IPO's call for views on designs

- Functional designs being protected by copyright (for life + 70 years)
- Section 51 CDPA less frequently applicable if more design products are considered artistic works
- Divergence between UK and EU copyright approach



# Practical legal strategies

# Practical legal strategies

- No specific reason bar to prevent design and trade mark protection for the same product
- You cannot predict exactly what the infringing product will look like
- The outcome of arguments on validity are unpredictable



# Thank you

Bristows LLP  
100 Victoria Embankment  
London EC4Y 0DH  
T +44 20 7400 8000

**[Sean.Ibbetson@Bristows.com](mailto:Sean.Ibbetson@Bristows.com)**