

March 16th, 2018

IESEG SCHOOL

Is the EU evolution of access requirement suiting the needs of the fashion market?

**National or
European
registration?**

Grounds for refusal

**The access
requirements**

Conclusion

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Trademark: National or European registration?

1/ National registrations

➡ One application with the national institute

= A unitary right covering the national territory

2/ European registration

➡ One application with the EUIPO

= A unitary right covering the entire territory of the European Union (28 countries)

Advantages of a EUTM

Disadvantages of a EUTM

An alternative solution

Advantages of a EUTM

- 1 Broader protection (28 countries)
- 2 Interesting costs
- 3 Easier to enforce the rights in all member states
- 4 Automatic extension in case of new member states
- 5 The use of EUTM in a substantial part of the EU is sufficient
- 6 Upstream phase: an overall consideration of the TM development strategy

Disadvantages of a EUTM

1

28 times more likely for the trademark to be contested (by holders of prior rights for e.g.)



High rate of opposition (one EUTM out of five is subject to an opposition)

2

A unique target for an invalidity action or a revocation for non-use

3

Potential enforceable rights from 28 countries

An alternative solution

Filing a EUTM application

OR

Filing national TM applications



Our advice :

"Give serious thought to your development strategy"

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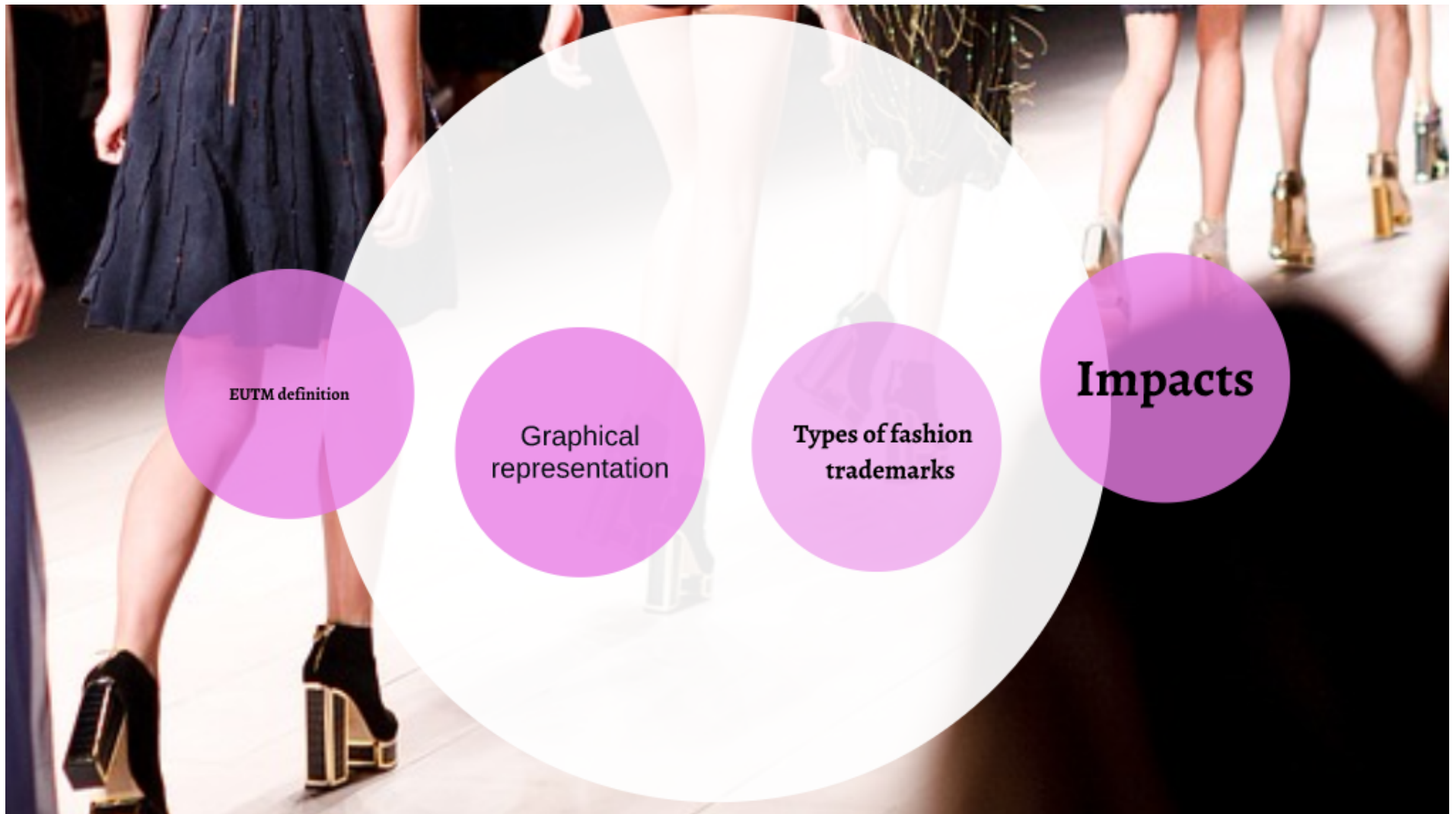
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EUTM definition

CTM (Art 4 of CTMR)

"A Community trade mark may consist of **any signs capable of being represented graphically**, particularly words, including personal names, ... provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings."

EUTM (Art 4 of EUTMR)

"An EU trade mark may consist of **any signs**, in particular words, including personal names, ... provided that such signs are **capable of**:

- (a) **distinguishing the goods or services** of one understanding 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."

No longer necessary to represent a mark graphically for registration purposes (from 24/09/2017)

Graphical representation

‘what you see is what you get’ system

CJCE, 12 déc. 2002, Ralf Sieckman, C-273/00

The representation must be:

- Clear
- Self-contained
- Intelligible
- Objective
- Precise
- Easily accessible
- Durable

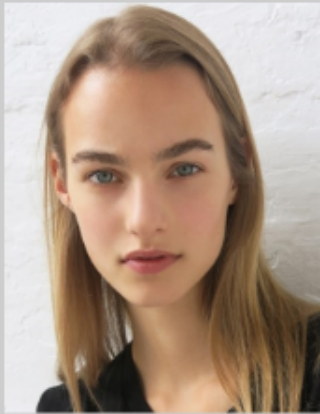
Article 3 of the EUTMIR lists the specific rules and requirements for the representation

The objectives = to increase legal certainty for users
+ to reduce the objection rate for formality objections.

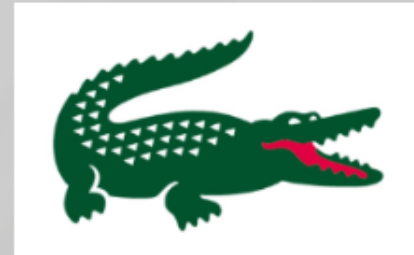


Figurative mark

Where non-standard characters, stylisation or layout, or a graphic feature or a colour are used



A photo of a person's face can be registered as a figurative mark.
(EUIPO - DECISION of the 4th Board of Appeal of Nov. 16th, 2017 In Case R 2063/2016-4, Giraffen houden van Wodka B.V.)



Movement mark

consists of a movement or a change in the position of the elements of a mark

Under the “graphical representation” requirement :

Difficult to obtain a registration when the TM is represented by sequence of still images showing the movement

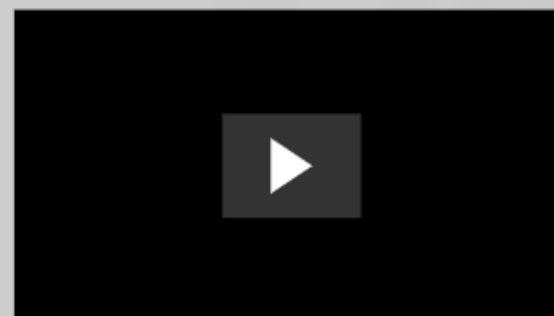
- 1 REFUSED by an examiner
- 2 ACCEPTED by the Board of Appeal

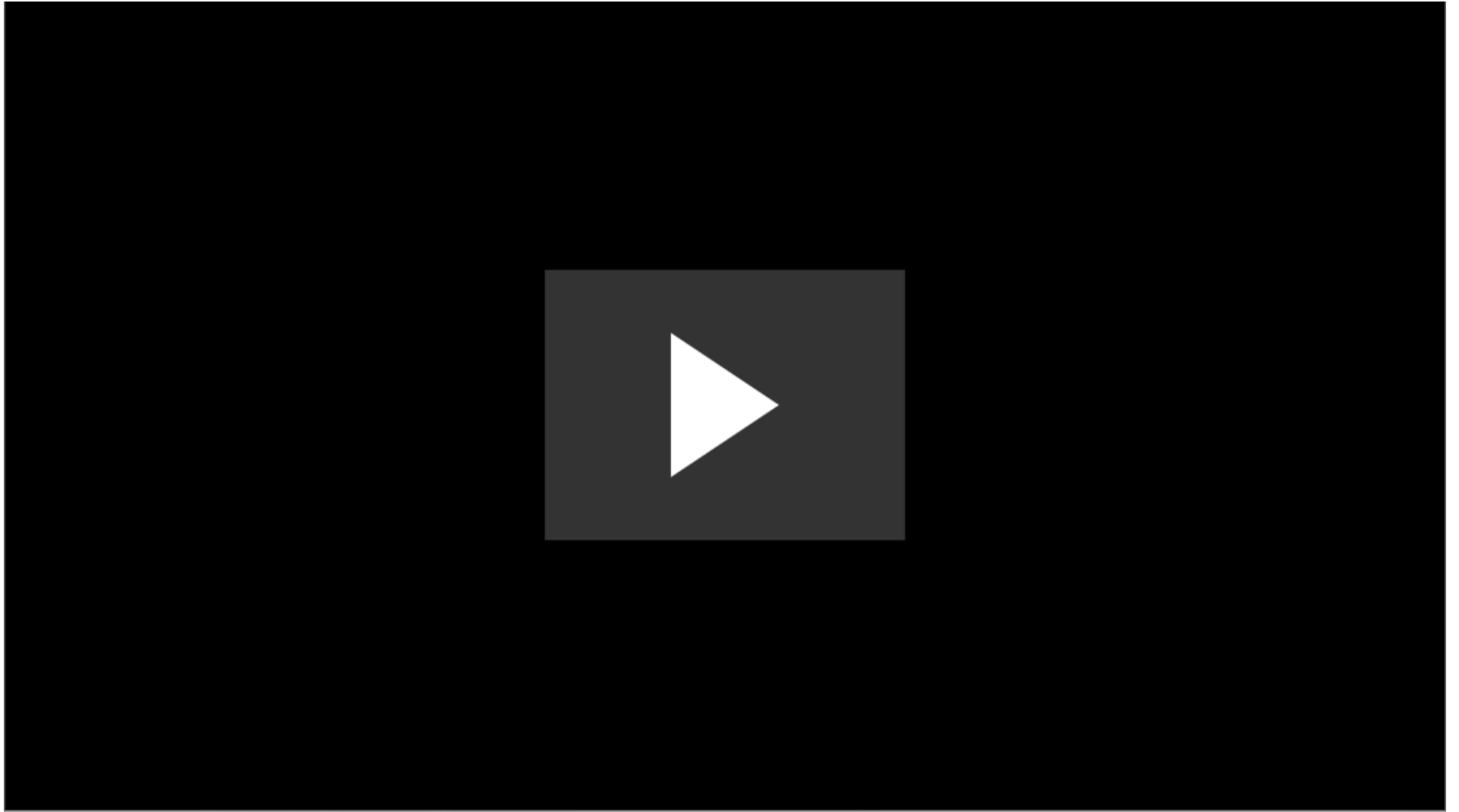
OHIM BoA RR 443/2010-1 23 September 2010 (Sony Ericsson)



After removal of the “graphical representation” requirement :

Easy to obtain registration when the TM is represented by video showing the movement





Sound mark

A sound or a combination of sounds

Under the “graphical representation” requirement:

ACCEPTED: represented by musical note – CTM No. 003673308 (registered)



REFUSED:

EUTM 143 891
R 0781/1999-4 (ROARING LION)

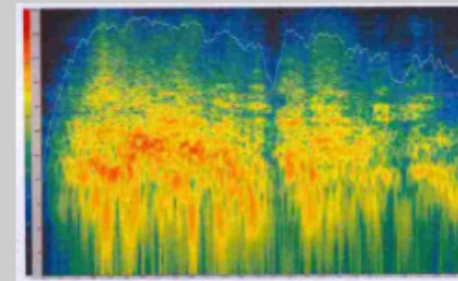
The (alleged) sonograph was considered incomplete, as it did not contain a representation of scale of the time axis and the frequency axis (para. 28).



After removal of the “graphical representation” requirement

e.g. represented by audio file only = acceptable

Metro-Goldwyn-Mayer Lion Corporation EUTM 005170113

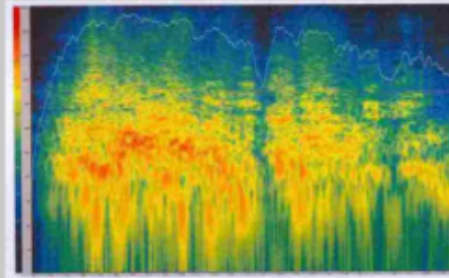


Until the EUTMR, the requirements were a musical notation (with optional sound file) or a sonograph, which had to be accompanied by a sound file.

After removal of the “graphical representation” requirement

e.g. represented by audio file only = acceptable

Metro-Goldwyn-Mayer Lion Corporation EUTM 005170113



Olfactive mark



Chemical formula



Odour sample



Word description



Graphic representation

"In respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements. "

CJCE, 12 déc. 2002, Ralf Sieckman, C-273/00



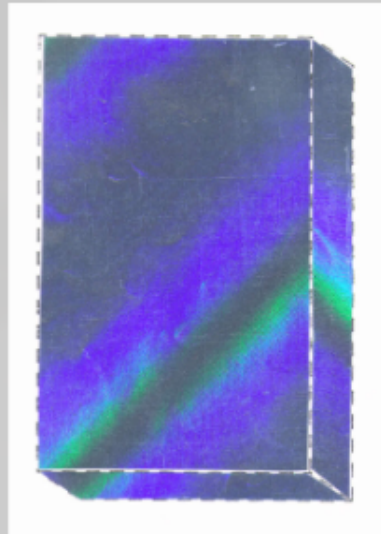
The smell of ripe strawberries 'can refer to several varieties and therefore to several distinct smells. The description was found neither unequivocal nor precise and did not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed. Likewise, the image of a strawberry represents only the fruit that emits a smell supposedly identical to the olfactory sign at issue, and not the smell claimed, and therefore does not amount to a graphic representation of the olfactory sign'.

European First Instance Court, 10.27.2005, Eden SARL / OHMI (affaire T 305/04)

Hologram mark

= a new category of trade mark (as and from 1 October 2017)

Hologram marks consist of elements with holographic characteristics.



Eve Holdings Inc.
EUTM 002559144

Impacts



Not such huge impacts, but simplifying the way of filing for some types of mark

- Simpler for sound marks / motion marks
- But, the number of such unconventional TMs is rather small:

	2017	%
Word Mark	78,398	53.54 %
Figurative	67,367	46.01 %
3D	493	0.34 %
Other	42	0.03 %
Colour	47	0.03 %
Sound	24	0.02 %
Position	21	0.01 %
Hologram	2	0.00 %
Motion	10	0.01 %
Pattern	9	0.01 %
Olfactory	0	0.00 %
Multimedia	5	0.00 %
Σ	146,418	100.00 %



Figurative TM



Motion TM



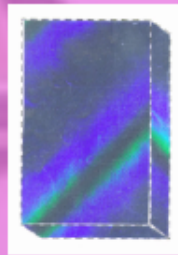
Pattern TM



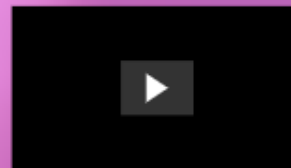
Figurative TM



Position TM



Hologram TM



multimedia TM



3D shape TM

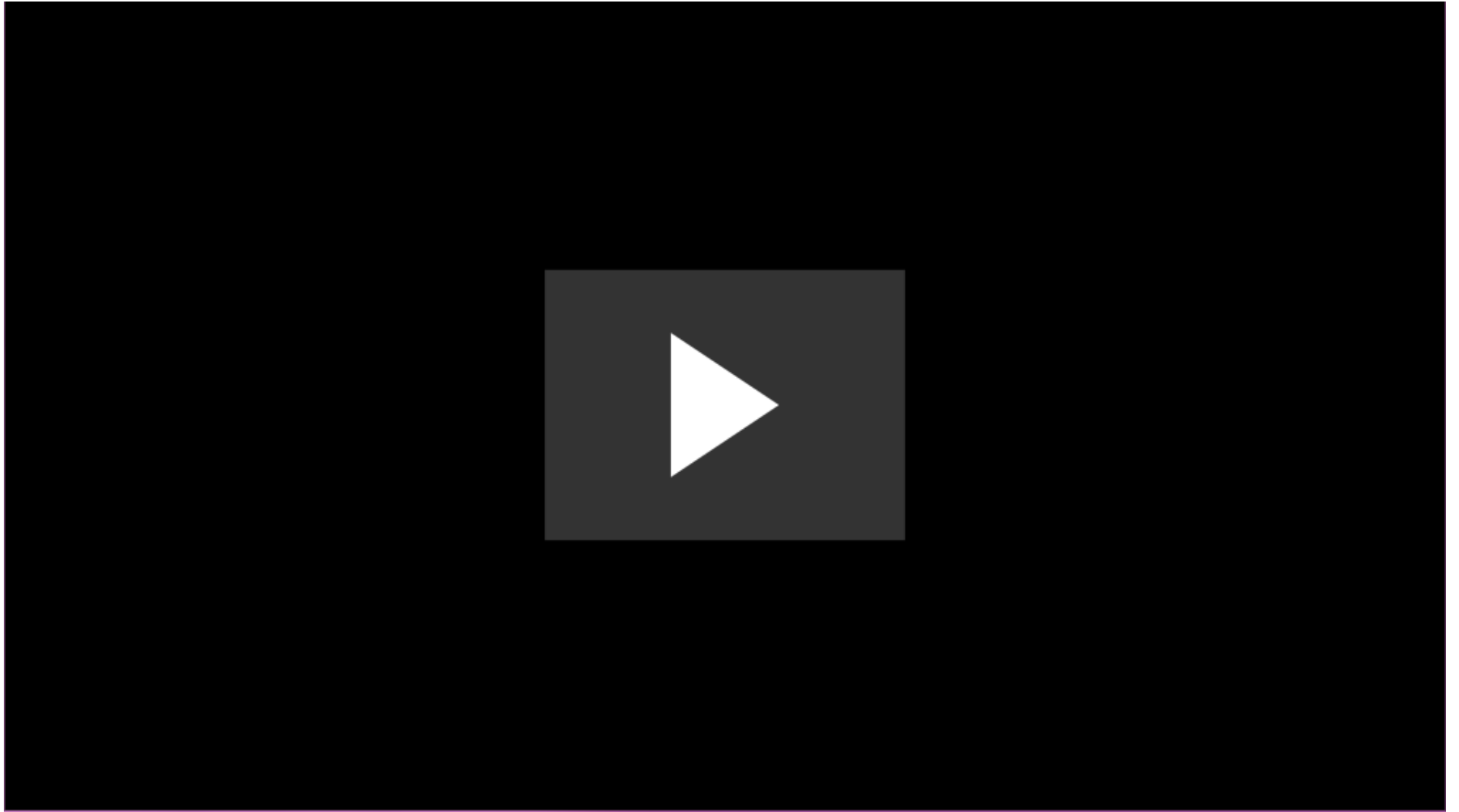
ADIDAS

Word TM



Color TM

from Statistics of European Union Trade Marks of the EUIPO (updated on 01/01/2018)



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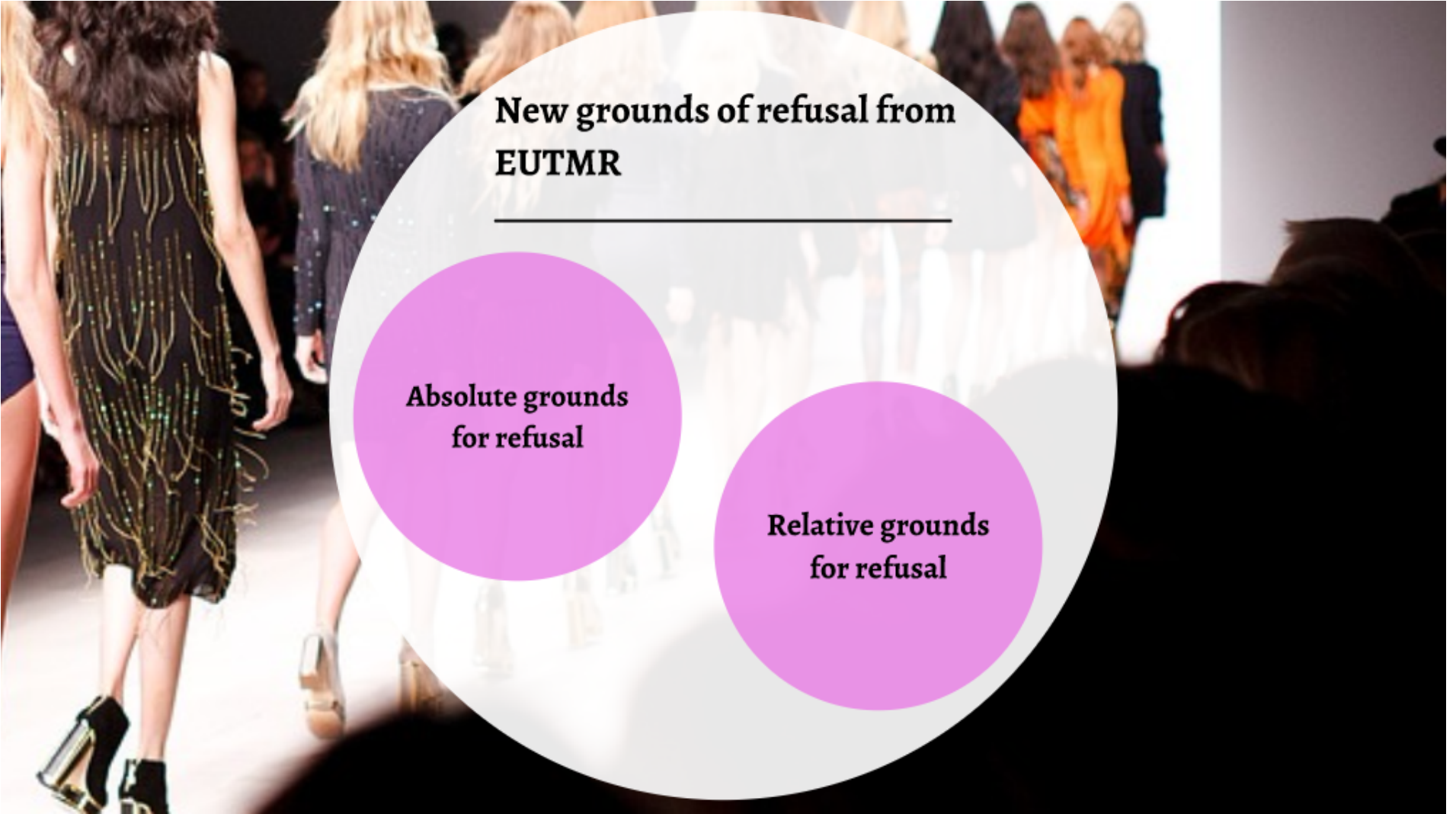
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New grounds of refusal from EUTMR

**Absolute grounds
for refusal**

**Relative grounds
for refusal**

Absolute grounds for refusal

➤ Extension of the scope of Article 7(1)(e) Article 7(1)(e)

CTM (Art 7(1)(e) of CTMR)	EUTM (Art 7(1)(e) of EUTMR)
<p>The following shall not be registered:</p> <p>(e) signs which consist exclusively of:</p> <p>(i) the shape which results from the nature of the goods themselves;</p> <p>(ii) the shape of goods which is necessary to obtain a technical result;</p> <p>(iii) the shape which gives substantial value to the goods;</p>	<p>The following shall not be registered:</p> <p>(e) signs which consist exclusively of:</p> <p>(i) the shape, <u>or another characteristic</u>, which results from the nature of the goods themselves;</p> <p>(ii) the shape, <u>or another characteristic</u>, of goods which is necessary to obtain a technical result;</p> <p>(iii) the shape, <u>or another characteristic</u>, which gives substantial value to the goods;</p>

→ The scope extended to “the shape, **or another characteristic**”

The scope extended to “the shape, or **another characteristic**”

This ground of refusal will apply :

- when the sign, whether 2D or 3D, consists exclusively of the only natural shape of the goods (as natural or regulated products):



- all shapes that are inherent to the generic function or functions of the goods



No definition of “another characteristic” in the new regulation

Possible impacts on the new addition of "another characteristics":

e.g. a sign consisting exclusively of a characteristic, which results from the nature of the goods themselves

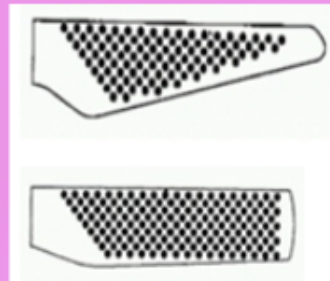


Under CTMR:

"Shape" under Article 7(1)(e) Article 7(1)(e)

Art 7(1)(e) may apply to not only three-dimensional shapes, but also two-dimensional shapes

cf. Judgment of the General Court, 21/05/2015 T-331/10 RENV and T-416/10 RENV Yoshida Metal Industry Co. Ltd. "handles of knife"



Applications for CTM: "figurative signs" (not 3D)

For Classes 8 and 21



Under EUTMR:

"an objection under Article 7 (1)(e) EUTMR to marks consisting of shapes or other characteristics that follow from the nature of the goods, shapes or other characteristics that are necessary to obtain a technical result or shapes or other characteristics giving substantial value to the goods cannot be overcome by demonstrating that they have acquired distinctive character."

Guidelines for Examination in the Office - EUIPO

01.02.2017

Relative grounds for refusal

Extension of the scope of relative grounds for refusal :

Article 8(4a) – newly added Article 8(4a)

opposition can be filed based on designation **of origin or geographical indication**



Under CTMR: opposition can be filed based on rather **“private rights”** only , such as earlier trademarks, trade names, etc.

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Conclusion

The purpose of this reform is to update of the European trademark law in line with current European case law in order to render it more:

- Practical,
- Flexible
- Accessible for users



Of course this reform is extremely beneficial for the fashion market



Thank you for your attention

Guylène KIESEL LE COSQUER

President

CNCPI

13 rue du quatre septembre

75002 Paris - France

March 16th, 2018

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The Infringement Test in the United States

Craig A. Nard

Galen J. Roush Professor of Law
Case Western Reserve University

Director, Spangenberg Center for Law, Technology & the Arts
Cleveland, Ohio U.S.A.



16 March 2018
Paris, La Défense



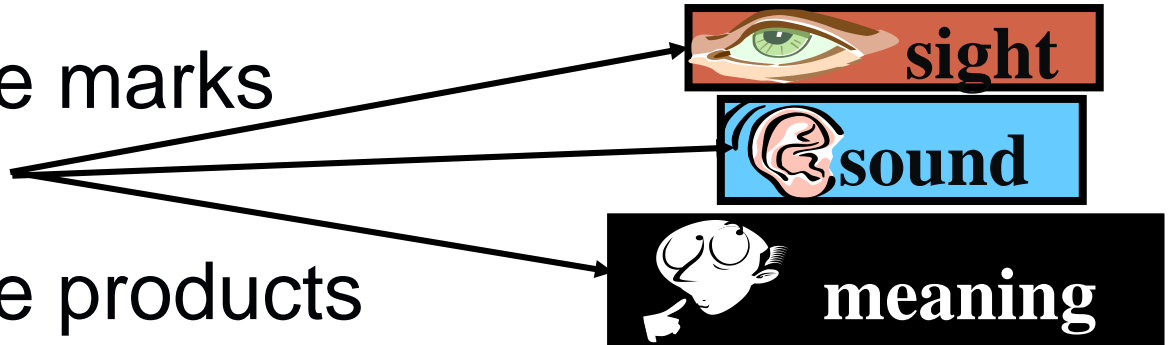
Likelihood of Confusion

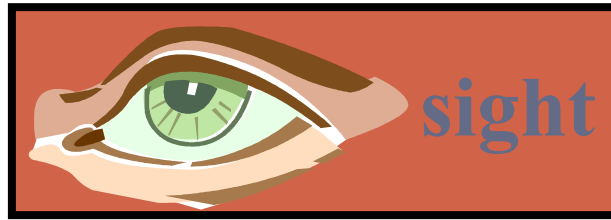


An unauthorized use infringes a trademark owner's rights if the use creates a likelihood that an appreciable number of reasonably prudent purchasers will be confused as to the source of the defendant's products or services, or as to some sponsorship or approval of the goods, services, or commercial activity

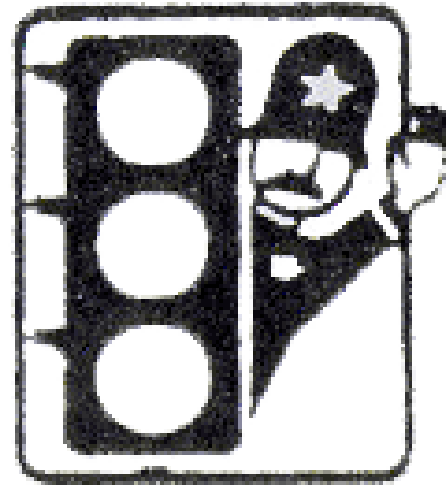
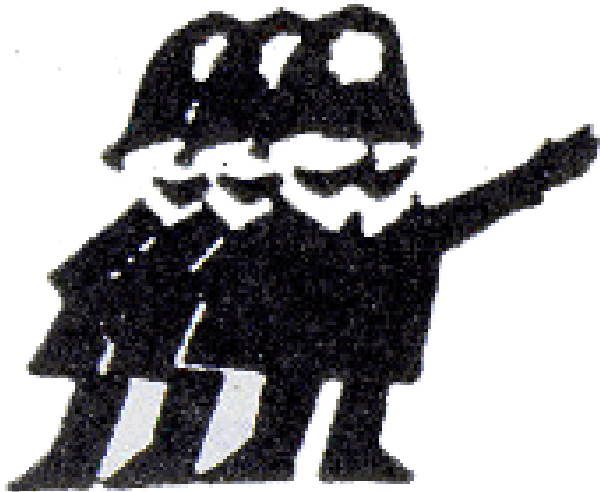
Likelihood of Confusion

1. Strength of the mark
 - Consider distinctiveness and strength in the market (advertising, sales, length of use, etc.)
2. Similarity of the marks
 - Contextual
3. Similarity of the products
4. Likelihood prior owner will bridge the gap
5. Actual confusion
6. Defendant's good/bad faith (intent)
7. Sophistication of consumer

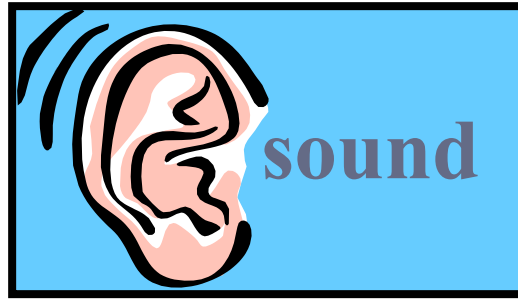




Photocopying and Printing Services



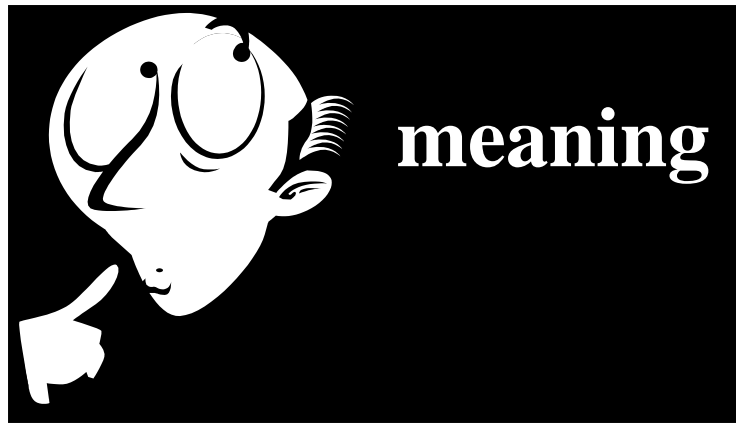
Copy Cop v. Task Printing, 908 F.Supp. 37 (D Mass 1995)
(summary judgment for plaintiff on LOC)



Cygon vs. Phygon
(insecticides)

Dramamine vs. Bonamine
(anti-nausea medications)

Word marks are more likely to be confusingly similar when the marks sound similar to purchasers and goods are closely related



Cyclone vs. Tornado
(link fencing)

Pledge vs. Promise
(furniture polish)

Word marks are more likely to be confusingly similar when the marks convey the same or a similar meaning to purchasers

Initial Interest Confusion

- Occurs not where a customer is confused about the source of a product at the time of purchase, but earlier in the shopping process, if customer confusion ... creates initial interest in a competitor's product.
- Even if that confusion is dispelled before an actual sale occurs, initial interest confusion still constitutes trademark infringement **because it impermissibly capitalizes on the goodwill associated with a mark and is therefore actionable trademark infringement**

Post-Sale Confusion

The classic situation of post-sale confusion is when an observer sees the defendant's inferior product and because of similar marks or trade dress, mistakenly thinks it is a product of the trademark owner, damaging the owner's reputation and image.

Post-Sale Confusion and Knockoffs

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Chanel v. Button Jewelry by Val Colbert



Trademark Dilution

The owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against ... a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury

Likely to Cause Blurring



- (i)** The degree of similarity between the mark or trade Name and the famous mark.
- (ii)** The degree of inherent or acquired distinctiveness of the famous mark.
- (iii)** The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv)** The degree of recognition of the famous mark.
- (v)** Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi)** Any actual association between the mark or trade name and the famous mark.

Dilution by Tarnishment



- Need a Mental Association between protected mark and



consumer taste and how the predicted reaction of conventional consumers in our culture will affect the economic value of the famous mark”

Thank You

3D TM Protection for Fashion Designs under Japanese Trademark and Unfair Competition Laws

Toshiko Takenaka Ph.D.

Professor of Law, University of Washington School of Law (Seattle, USA)

Professor of Law, Keio Law School (Tokyo, Japan)

INTRODUCTION OF NON-TRADITIONAL TRADEMARK REGISTRATION

- 1996 Revision
 - 3D marks
- 2014 Revision
 - Non-traditional marks: Color, sound, motion, hologram, position



Filing & Registration Status of Non-Traditional Trademarks

(As of August 21, 2017)

	total	breakdown by type				
		sound	color	position	motion	hologram
applications of Apr.1, 2015	481	151	192	103	32	3
Number of applications	1,563	559	507	352	123	17
Number of registrations	298	167	2	33	83	11



FASHION DESIGN-PRODUCT DESIGN

- Trademark Law – Registered marks
 - Distinctiveness-Secondary meaning
 - Functionality
- Unfair Competition Law – Unregistered marks
 - Functionality
- Design Law
- Copyright Law
 - Heightened originality standard



The background features abstract, overlapping green geometric shapes, primarily triangles and polygons, in various shades of green, creating a modern and dynamic visual effect.

3D Marks Protection under TM Law Requirements for Registration

REQUIREMENTS

- Distinctiveness Art. 3
 - Incontestable after 5 years from registration
 - (1) Non inherent distinctive marks
 1. Generic terms
 2. Commonly used marks
 3. Descriptive marks
 4. Other non-descriptive marks
 - (2) Acquired distinctiveness: Secondary meaning
- Functionality Art. 4(1)-18



DISTINCTIVENESS

■ Trademark Act Art. 3

- (1) Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:
 - (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;
- (2) Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.



DISTINCTIVENESS

- Sup. Ct. of Japan April 10, 1979
Interpretation of Art. 3(1)
 - Marks not eligible for exclusive use due to the necessity to keep the marks in public domain so that everyone in the market should be able to use
 - Overlapping with Art. 4(1)-18
 - Marks widely used and thus have no distinctiveness for indicating the origin of the marked goods



DISTINCTIVENESS

■ Descriptive marks

- A 3D mark merely indicating the shape of goods including **their packaging** or shape of goods used for services
 1. The mark consisting of 3D features being adopted for enhancing utilitarian or aesthetic function of such goods
 2. The mark including a 3D feature distinguished from common features of goods, such feature being understood by consumers as being modified or decorated for enhancing utilitarian or aesthetic function of such goods
- Limited Exception
 - Novelty - No mark adopting the distinctive feature for the designated goods



DISTINCTIVENESS

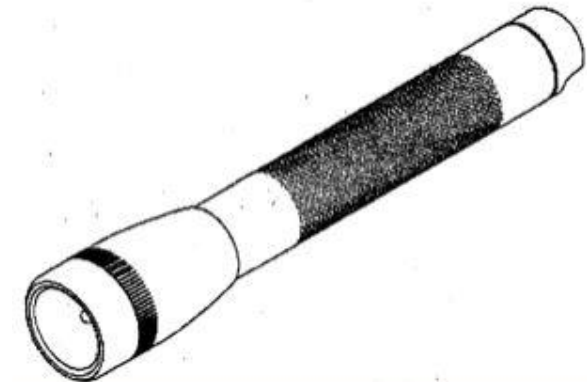
- 3D Mark with words or signs
 - Distinctive: A 3D mark as a whole is distinctive if the mark includes distinctive words or signs even if the 3D mark itself merely indicates the shape or packaging of goods or goods used for services



DISTINCTIVENESS

- IP High Ct July 27, 2007
 - Reversing JPO decision to deny registration
 - Not inherently distinctive
 - Any 3D feature consisting of a shape for contributing a utilitarian or esthetical functions is presumed to be descriptive
 - Limited exception

- Mini Megalite



EXAMPLE OF DESCRIPTIVE 3D MARKS

IP HIGH COURT CASE LAW 4/21/2011

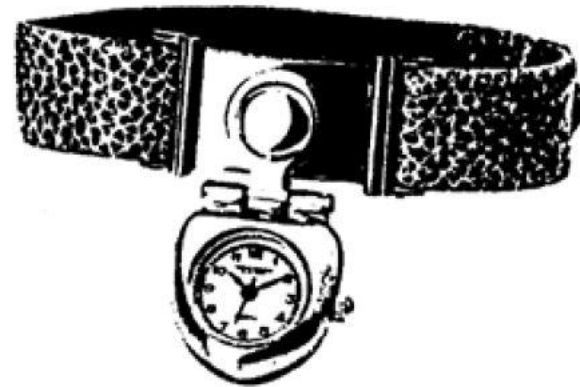
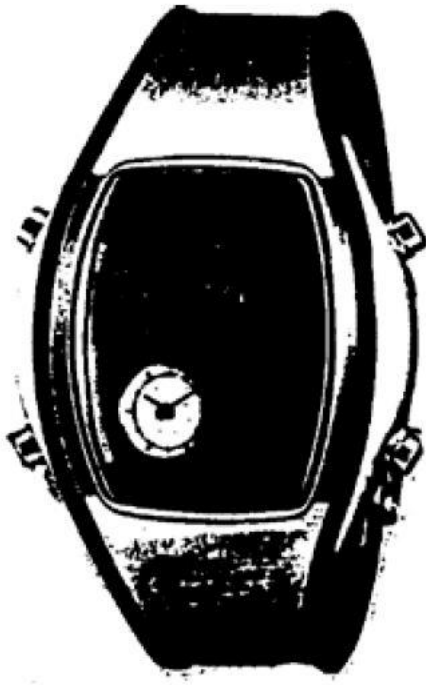


- Descriptive
 - Consumers usually view the shape of a good as being adopted for enhancing the utilitarian or esthetical function
 - If features of the shape is what one could readily adopt to enhance such function, the feature does not function to indicate the origin of goods even if the feature is unique to the common shape of the marked goods
 - The design resembling female naked body is unique although some other perfumes adopt bottles resembling female body
 - However the design is not substantially beyond what being expected to adopt for a package of perfume



EXAMPLE OF DESCRIPTIVE 3D MARKS JPO EXAMINATION GUIDELINES

Goods: Wrist Watch



EXAMPLE OF INHERENTLY DISTINCTIVE 3D MARKS

IP HIGH COURT CASE LAW 6/30/2008



- Inherently distinctive
- Limited exception: Novelty
 - A combination of bar with decorative 3D design resembling a shrimp, a shell, sea dragon and clam is novel being adopted in the designated goods
 - The overall impression of the combination distinguishes the chocolate adopting the combination from other chocolate and consumers use the impression to make a decision to purchase the chocolate.



SECONDARY MEANING

- High Hurdle
 - Novelty of the distinctive 3D features at the time of registration
 - Survey on consumers – distinguished from similar marks on similar goods
 - Consistent use of the mark in Japan
 - The manner the trademark is used – Identical to the registered mark
 - Geographical scope: Sold and advertised nationally in Japan
 - Length: more than two decades
 - High market share



EXAMPLE OF DESCRIPTIVE 3D MARKS

IP HIGH COURT CASE LAW 4/21/2011



- Secondary meaning: Perfume and related goods
 - The 3D feature is new - No similar design used in perfume bottles although there are bottles resembling human bodies
- Evidence: Totality of circumstance
 - Length and manner of use
 - Amount of sales
 - Length and extent of advertisement



EXAMPLE OF DESCRIPTIVE 3D MARKS

IP HIGH COURT CASE LAW 5/29/2008



- Descriptive
 - A mark including 3D features adopted for enhancing the utilitarian or esthetical function
- Secondary meaning: Cola and related drinks
 - The 3D feature is new – No other cola drinks adopt a bottle with similar features.
 - A survey supports the features indicating the origin of goods without a word mark
 - Evidence: Totality of circumstance
 - History of adopting the features
 - Sold nationally for long time
 - Advertisement



EXAMPLE OF DESCRIPTIVE 3D MARKS

IP HIGH COURT CASE LAW 11/16/2010



- Descriptive
 - A mark solely consisting of features of a package (bottle) in a common manner
- Secondary meaning: Lactic acid drinks
 - The 3D feature is NOT new – Other milk drinks adopt bottles with similar features. However, a survey supports 98% of respondents recognized the mark coming from the applicant
 - Evidence: Totality of circumstance
 - Big investment for design and advertisement
 - Sold nationally for long time



DISTINCTIVENESS

- Secondary Meaning – Registered



SOCIÉTÉ ANONYME



Addidas



DISTINCTIVENESS

- **Descriptive marks**
 - However, if distinctive words and signs included in a 3D mark are arranged in the manner NOT to indicate the origin of goods, the 3D mark remains as merely descriptive of the shape of the goods

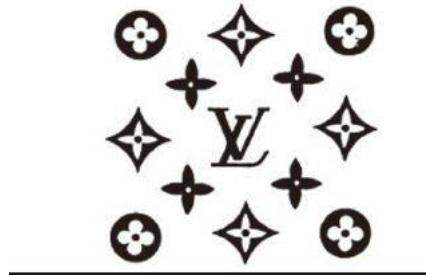


DISTINCTIVENESS

- Secondary Meaning – Registered



Edwin



LOUIS VUITTON



FUNCTIONALITY

- Absolute ground: Exclusion
 - Marks consist of features essential for the function of goods or packaging of the goods
 - Functionality has been examined in light of distinctiveness already



EXAMPLE OF REGISTERED MARKS

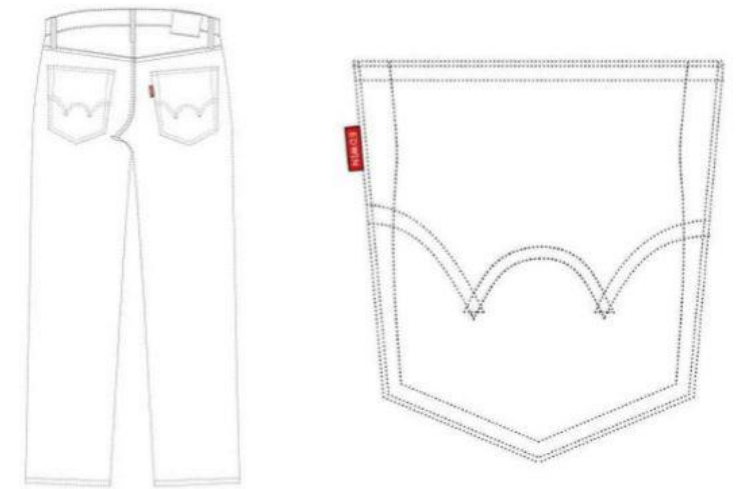
POSITION MARK

Applicant: EDWIN CO. LTD.

Class 25: Trousers, slacks, shorts, jogging pants, sweat pants, ski pants, nightwear, pajamas, nightwear, underwear (underclothing), drawers and underpants, panties, shorts and briefs, clothes for sport but **excluding night gowns, negligees, Japanese sleeping robes [Nemaki], bath robes, other nightwear which has no back pocket in bottoms, undershirts, corsets [underclothing], chemises, slips, brassieres, petticoats, underwear which has no back pocket in bottoms, anoraks, Karatesuits, 'bench warmer' coats, Kendo outfits, Judo suits, headbands [clothing], wind-jackets, wristbands, and other clothes for sport which have no back pocket in bottoms.**

Detailed explanation: The trademark for which registration is sought (hereinafter referred to as the "Trademark") is a position mark which specifies the place to attach the mark. It is attached to the upper left of the back pocket of trousers and consists of a red rectangle tab figure in which the alphabetic characters "EDWIN" are indicated. The description consisting solely of the pocket and tab figure is a partially enlarged figure to clearly indicate the mark attached to the relevant part. The broken lines show one of the examples of the shape of the goods and do not constitute the trademark.

Registration No. 5807881



EXAMPLE OF NONTRADITIONAL MARKS

POSITION MARK (PENDING)

Applicant: Wacoal Corp.

Class 5: Tights, tights stocking and athletic tights (clothes for sport)

Detailed explanation: The trademark for which trademark registration is sought (hereinafter referred to as the "Trademark") is a position mark which specifies the place to attach the mark and consists of the figure attached to the front surface from the thigh to the lower leg of the tights. The broken lines show one of the examples of the shape of goods and do not constitute the trademark.



Source: Website of the Applicant



Enforcement Mechanism and Infringement Test

PROTECTION OF GOOD WILL

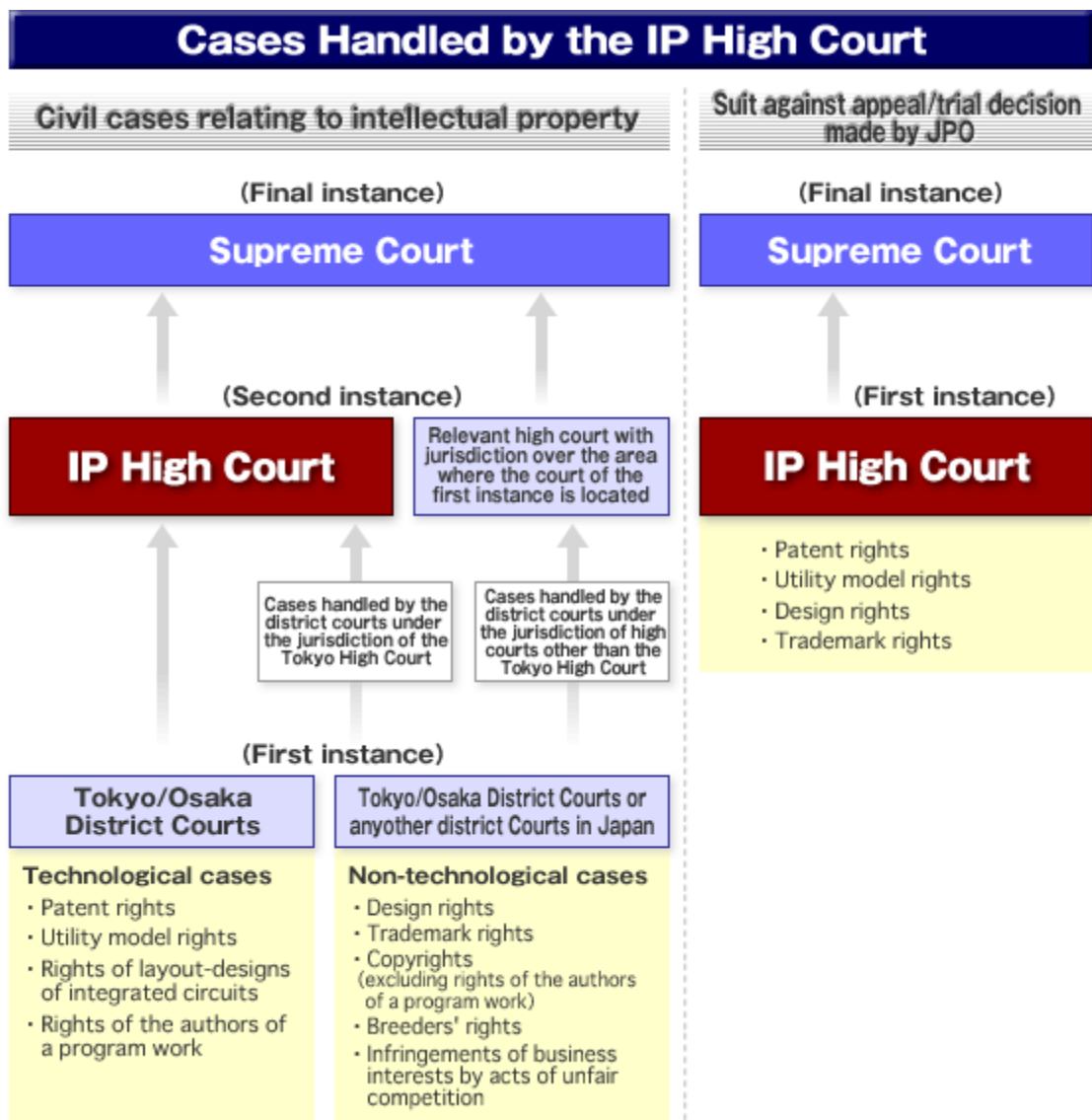
- Registered marks
 - Trademark law
- Unregistered Marks (Comp. unregistered designs)
 - Unfair Competition



ENFORCEMENT MECHANISM

- Court proceeding
 - District courts
 - Regional high courts
 - Supreme Court
- JPO – Invalidation Trial
- Custom Office – Border measures





Int'l Institute of Intellectual Property

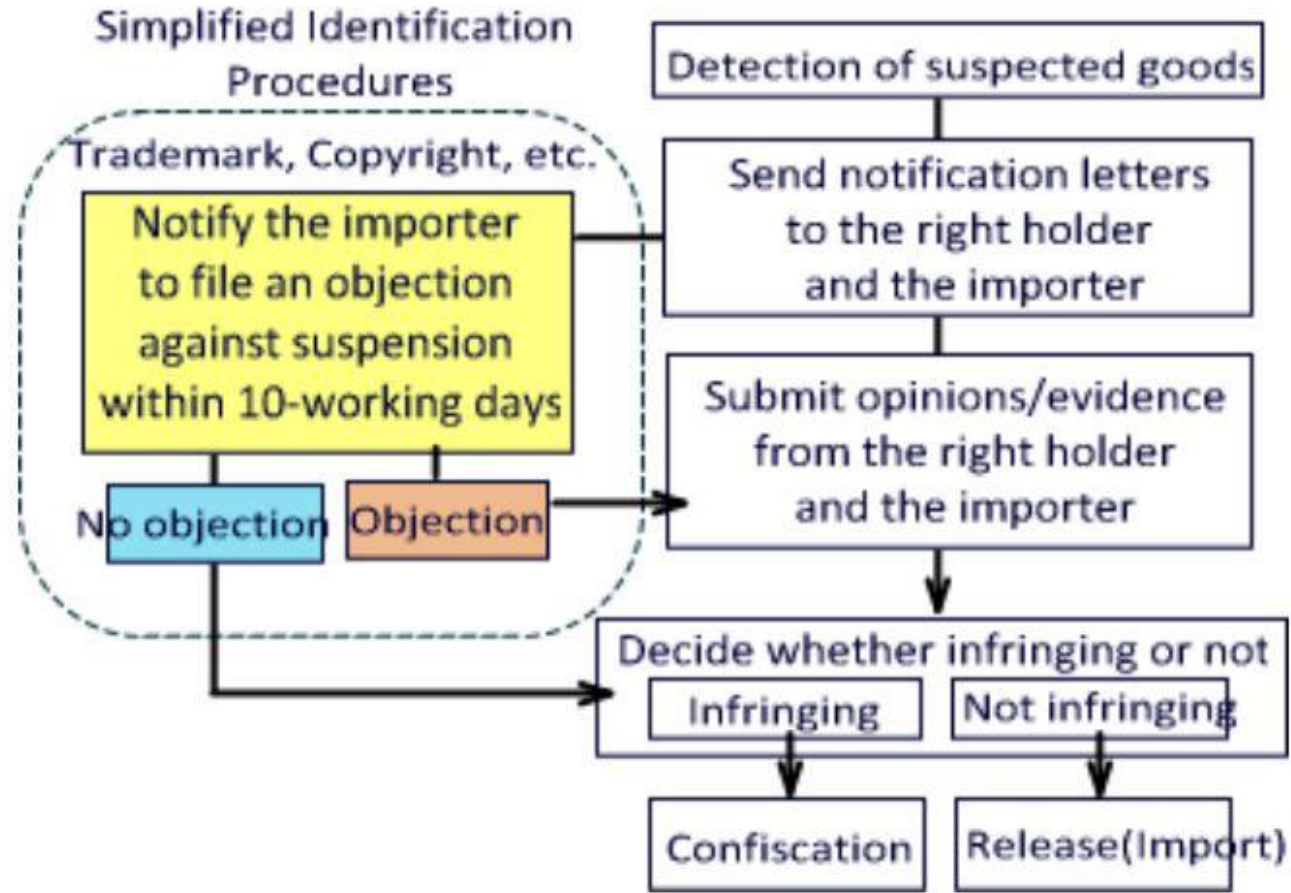
Study on Specialized Intellectual Property Courts, 66 (2012)

<http://iipi.org/wp-content/uploads/2012/05/Study-on-Specialized-IPR-Courts.pdf>



BORDER MEASURE

Outline of Identification Procedures



INFRINGEMENT

- Trademark Law Art. 25

The holder of trademark right shall have an exclusive right to use the registered trademark in connection with the designated goods or designated services; provided, however, that where an exclusive right to use the trademark is established in connection with the trademark right, this provision shall not apply to the extent that the holder of exclusive right to use has an exclusive right to use the registered trademark..

- Right to use: The registered mark with registered goods/services
- Right to exclude: The registered and similar marks with the designated and similar goods



INFRINGEMENT

- Trademark Law Art. 26(1)

A trademark right shall have no effect on any of the following trademarks (including those which constitute part of other trademarks):

- (v) a trademark consisting solely of a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function.
- (vi) a trademark which is not used in the manner not indicate the origin of goods and services (to affect the trademark function)



INFRINGEMENT

- Elements to establish infringement

TM Owner

- Identical or similar to the registered mark
- Used on goods/services identical or similar to the designated goods

Defenses (defendants should establish)

- Using the mark in the manner not affecting the trademark function
- Private use etc.



INFRINGEMENT TEST

SIMILARITY OF MARKS

- **Sup. Ct. of Japan March 11, 1997**
 - Similarity of marks should be determined on basis of overall impression, memory, inspiration resulting from the appearance, impression and sound of the marks given to traders and consumers by taking account of the circumstances surrounding the trading the goods.
 - Although either appearance, impression or sound is similar between the marks, if any other factor surrounding the trade eliminates likelihood of confusion, such marks are not similar.



INFRINGEMENT TEST

SIMILARITY OF MARKS

- Similarity of marks
 - **Traders** and ordinary consumers with an ordinary care to be paid to purchase the goods at issue
 - Sounds, appearance, impression
 - Side-by-side comparison as well as comparison at different times and different places
 - Overall impression v. focus on essential elements
 - Timing: At the closing of trial (for injunction)
- Similarity of goods



TOKYO DIST. CT. MAY 21, 2014

HERMES BIRKIN HANDBAG

- Hermes sued a Japanese company who imported and sold bags from Korea for trademark infringement and a violation of unfair competition law
- Tokyo District Court found trademark infringement and a violation of unfair competition law and issued an injunction preventing the defendant from importing and selling the bags



Trademark Registration

登録番号 第5438059号

登録日 平成23年(2011)9月9日

登録公報発行日 平成23年(2011)10月11日

公開日 平成20年(2008)4月3日

出願番号 商願2008-16949

出願日 平成20年(2008)3月6日

先願権発生日 平成20年(2008)3月6日

存続期間満了日 平成33年(2021)9月9日

拒絶査定発送日 平成22年(2010)2月26日

権利者

氏名又は名称 エルメス・アンテルナショナル

住所又は居所 フランス国75008パリ市リュ・デュ・フォーブル・サントノーレ24番

付加情報 色彩有り 3条2項適用

審判番号 2010-11402

審判種別 査定不服審判

【商品及び役務の区分並びに指定商品又は指定役務】【類似群コード】

18 ハンドバッグ

21C01



Accused Product



TOKYO DIST. CT. MAY 21, 2014

HERMES BIRKIN HANDBAG

- **Similarity of 3D Marks: Likelihood of Confusion**
 - A 3D trademark should be generally interpreted as a trademark that allows those who see it to identify the source of goods or services by the characteristics of a visual image it provides when seen from one or two specific directions (predetermined directions) from which those who see it are supposed to mainly look when they observe the trademark.
 - When a visual image seen from a predetermined direction is **identical or closely similar to a specific flat (2D) mark**, it should be, in principle, concluded that the 3D trademark in question and the flat mark in question are similar in appearance.
 - The direction to be used as a predetermined direction should be determined individually and objectively based on the structural details of the three-dimensional trademark in question.



TOKYO DIST. CT. MAY 21, 2014

HERMES BIRKIN HANDBAG

- **Unfair Competition Art. 2(1)(i)**

Act of Unfair Competition

- The act of creating confusion with another person's goods or business by using an Indication of Goods or Business (meaning a name, trade name, Trademark, Mark, container or packaging for goods pertaining to a person's operations, or any other indication of a person's goods or business; the same applies hereinafter) that is identical or similar to the another person's Indication of Goods or Business that is **well-known** among consumers as that of the another person, or by assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing or providing through a telecommunications line those goods that use said indication;



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

Plaintiff's Product



Defendant's Product



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

- **Well known Indication of Goods and Secondary Meaning**

- The shape of goods are usually adopted to enhance the utilitarian or esthetical function of goods but not for identify the source of goods or services. If the shape has **unique** features to distinguish the good from other goods and continue to use the features exclusively for long time, the shape begins to function to identify the source of goods as consumers begin to view such features as an indication of the source of goods.



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

- **Fact finding**

- Unique features: No other dresses including features similar to the unique features of P's dresses
- Well known: Sales history and amount of sales and advertisement
 - No consumer survey



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

■ **Similarity – Likelihood of Confusion**

- Unique features: In a dress made of smooth polyester fabric, vertically extending narrow pleats (folds having ununiform widths) are provided throughout uniformly the dress including seams of shoulder lines, sleeve openings, hems, to provide a flat design of thin clothes giving an impression like a piece of fabric
 - Functionality argument rejected: Alternative design to provide the same function: preventing wrinkles, easy to wash etc.
- Defendant's products is similar because they have the unique features despite of minor differences: Width of front body, designs of arm openings and neckline



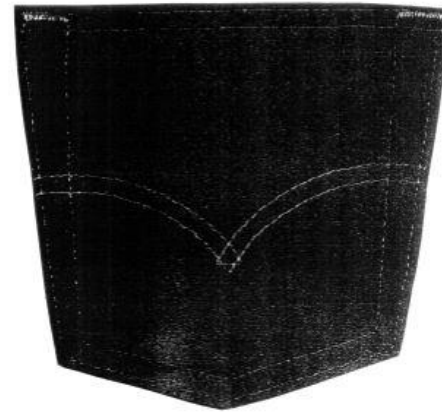
TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

Plaintiff's Product



Defendant's Product



TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

- **Well Known Indication of Goods (Not yet famous)**
 - Consumer survey
 - Those who purchased jeans within 6 months
 - Age between 15-29 46%
 - Age between 15-69 31%
 - Those who purchased jeans within 1 year with the knowledge of the brand of the jeans they purchased and remembered to see the plaintiff's stitch
 - Age between 15-34 86% (37% of them identified jeans with the pocket stitch sold Livi's)



TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

- **Unique Features**

- Plaintiff has been requesting to stop selling jeans with similar pocket stitch whenever it finds such jeans
 - Exclusive use of the features



TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

- **Similarity – Likelihood of Confusion**

- Common features

- Stitches provided on the back pockets of jeans
 - Consisting of two arches on right and left sides
 - Said arches are symmetrical
 - Each arch consist of two parallel lines
 - Such two lines are extending from the right and left ends to the center from the pocket to draw arches gradually discending to cross at the center



OSAKA DIST. CT. MARCH 18, 1987

LOUIS VUITTON MONOGRAM

Registered Marks

- **Limitation on Exclusive Right**

- The Osaka District Court rejected the defendant's argument that the registered mark was used as a design which indicate merely the shape of good by stating that finding the use of mark as an act of using the mark as a trademark does not exclude finding of an act of the same mark as a design. As long as the mark is used to indicate the origin of goods, such use must be found as using the mark as a trademark.



IP HIGH CT. APRIL 12, 2016

FRANCK MUELLER PARODY WATCH



フランク三浦



MULLER



三浦



MULLER



三浦



IP HIGH CT. APRIL 12, 2016

FRANCK MUELLER PARODY WATCH

■ **Similarity of 3D Marks: Likelihood of Confusion**

No likelihood of confusion

Registered mark

- Sound - Similar
- Appearance – Not similar
- Impression – Not similar
- Goods – Not similar

フランク ミュラー

Wrist watches

Cited marks

フランク ミュラー

- Plaintiff: more than \$10,000
- Defendant: less than \$35

FRANCK MULLER

FRANCK MULLER REVOLUTION



The background features abstract, overlapping green geometric shapes, primarily triangles and polygons, in various shades of green, creating a modern and dynamic visual effect.

Merci beaucoup

Si vous avez une question, envoyez un e-mail à
toshiko@uw.edu

Challenges and Tricks to Ensure Trademarks Protection in the EU

Cristiana Sappa

Professor of Business Law

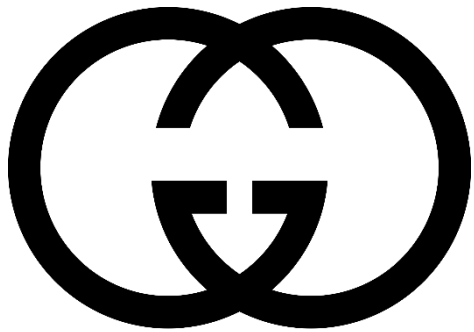
Law Track Coordinator

IÉSEG - School of Management, Lille and Paris

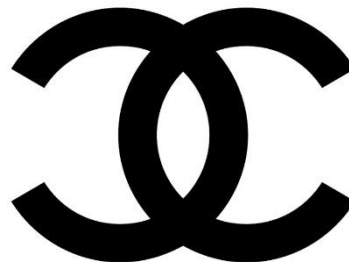
c.sappa@ieseg.fr

TMs and Fashion: Challenges and Tricks to Ensure the Protection

I. A first glance overview



Salvatore Ferragamo



www.energyvip.it

TMs and Fashion: Challenges and Tricks to Ensure the Protection

I. A first glance overview

The Bata logo is written in a bold, red, cursive script.The logo consists of the words "UNITED COLORS OF BENETTON." in a white, sans-serif font, set against a solid green rectangular background.The Guess logo is the word "GUESS" in a large, bold, black, serif font.The H&M logo is the letters "H&M" in a red, stylized, cursive font.The ZARA logo is the word "ZARA" in a large, bold, black, serif font.

TMs and Fashion: Challenges and Tricks to Ensure the Protection

I. A first glance overview



TMs and Fashion: Challenges and Tricks to Ensure the Protection

I. A first glance overview

 Tricks and Challenges : Registration and Enforcement!

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion

1. General principles

Likelihood of confusion (which includes the risk of association) exists if there is a risk that the public ***might*** believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings.

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion

1. General principles

Whether a likelihood of confusion exists depends on the appreciation in a **global** assessment of several factors, which are interdependent. These factors include:

- a. the aural, visual and conceptual similarity of the signs,
- a-bis. the distinctive and dominant elements of the conflicting signs,
- b. the similarity of the goods and services,
- c. the distinctiveness of the earlier mark,
- d. the relevant public.

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion and risk of association

2. Cases in the fashion field

a. The aural, visual and conceptual similarity of the signs

i. Word and Figurative trademarks

Hermes v. Haymes (*First Instance Court of Paris, 18/1/2018*)

HERMÈS

HAYMÈS
辉玛仕

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion and risk of association

2. Cases in the fashion field

a. The aural, visual and conceptual similarity of the signs

i. Word and Figurative trademarks

Louis Vuitton v.

Xi Liu (*First Instance Court of Naples, 9/11/2016*)



TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

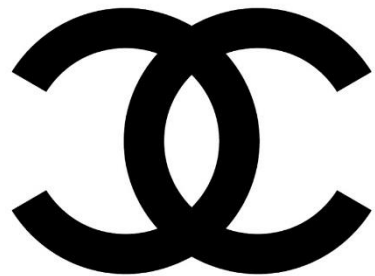
A. Likelihood of confusion and risk of association

2. Cases in the fashion field

a. The aural, visual and conceptual similarity of the signs

i. Word and Figurative trademarks

Chanel v. Carat 24 (*Opposition, UK IPO 1/12/2014*)



TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

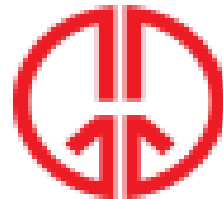
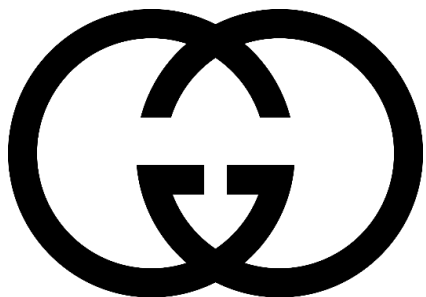
A. Likelihood of confusion and risk of association

2. Cases in the fashion field

a. The aural, visual and conceptual similarity of the signs

i. Word and Figurative trademarks

Gucci v. Luke Anthony Connelly (*Opposition, UK IPO 25/10/2013*)



TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between **trademarks/trademarks and other signs**

A. Likelihood of confusion and risk of association

2. Cases in the fashion field

a-bis. the distinctive and dominant elements of the conflicting signs



Case C-254/09 P

Calvin Klein v. CK Creaciones Kenya

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion and risk of association

2. Cases in the fashion field

b. the similarity of the goods and services

CÉLINE v.



EUIPO Opposition 24/8/2017

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion and risk of association

2. Cases in the fashion field

b. the similarity of the goods and services

MaxMara

v. MAXPARA

EUIPO Opposition 25/7/2016

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion and risk of association

2. Cases in the fashion field

c. The distinctiveness of the earlier mark

If famous TM=protection for dissimilar products as well

Evidence

Detrimental to distinctiveness, to reputation or create an unfair advantage

Christian
Lacroix




G I V E N C H Y

MaxMara

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

A. Likelihood of confusion and risk of association

2. Cases in the fashion field

d. the relevant public.

Average consumer

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs B. Infringement



v.



First Instance Court of Milan, 13/7/2017

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between **trademarks/trademarks** and **other signs**

B. Infringement



TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

B. Infringement



First instance court of Genoa, 16/9/2017

Appeal Madrid, 15/9/2017 (not on 3D TM)

Appeal Brussels 19/6/2015 (not on 3D TM)

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

B. Infringement



v. Vêtir

French Cass. 22 november 2016

(+ Appeal Paris, 10/4/2013, Gucci v. Eram shoes)

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

1. General principles

a. Invalidity

- i. Registration in spite of absolute grounds of refusal
- ii. Registration in bad faith
- iii. Earlier right exist

b. Revocation

- i. Lack of genuine use
- ii. Lack of distinctiveness (loss)
- iii. TM is /became deceptive
- iv. (TM is /became against public order or morality)

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

2. Are they used in the Fashion-related disputes?

a. Invalidity

i. Registration in spite of absolute grounds of refusal



BIRKIN



KELLY

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

2. Are they used in the Fashion-related disputes?

a. Invalidity

ii. Registration in bad faith



(Appeal Paris, 10/4/2013)

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

2. Are they used in the Fashion-related disputes?

a. Invalidity

iii. Earlier right exist



C-263/09 P, 5 July 2011

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

2. Are they used in Fashion-related disputes?

b. Revocation

i. Lack of genuine use



(French Cass. 19/3/2013 Hermès v. Frédéric'M)



TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

2. Are they used in Fashion-related disputes?

b. Revocation

ii. Lack of distinctiveness (loss)

iii. TM is /became deceptive



iv. (TM is /became against public order or morality)

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

3. How to use grounds for invalidity and revocation?

a. EU Trademarks

Judicial actions and Administrative procedures

b. National Trademarks

In some countries like F and Ita: judicial actions



Practice:
Mainly used as a defence in
litigation



Not as a defence in an administrative opposition

(C-196/11, §40f.: in proceedings opposing the registration of a EU TM , the validity may not be called into question

T-109/11, 80§: validity cannot be called into question in the context of proceedings which merely concern the likelihood of confusion (be it opposition or cancellation proceedings before the Office).

TMs and Fashion: Challenges and Tricks to Ensure the Protection

II. Conflicts between trademarks/trademarks and other signs

C. Grounds for terminating a TM

4. *Anything new at the national level?*

Article 45 Procedure for revocation or declaration of invalidity

1. Without prejudice to the right of the parties to appeal to the courts, Member States shall provide for an efficient and expeditious administrative procedure before their offices for the revocation or declaration of invalidity of a trade mark.

Article 53 Transposition

Member States shall bring into force the laws, regulations and administrative provisions to comply with Article 45 by 14 January 2023.



TMs and Fashion: Challenges and Tricks to Ensure the Protection

III. Some first conclusive remarks

A. An assessment of the state of art

1. Case law dominated by big names

Why?

Registration – Enforcement

Effect (Risk)?

(Part of) The scope of protection as defined by case law



B. How to (re-)balance the interests?

The market is composed of big names, but also of SMEs

1. Focus on the TM functions
2. Principle of good faith
3. New administrative procedures will be efficiently used?

TMs and Fashion: Challenges and Tricks to Ensure the Protection



Should you have any question, you can address:
c.sappa@ieseg.fr

Is the Distinctiveness Spectrum in the United States Encouraging the Fashion Market?

Craig A. Nard

Galen J. Roush Professor of Law

Case Western Reserve University

Director, Spangenberg Center for Law, Technology & the Arts
Cleveland, Ohio U.S.A.

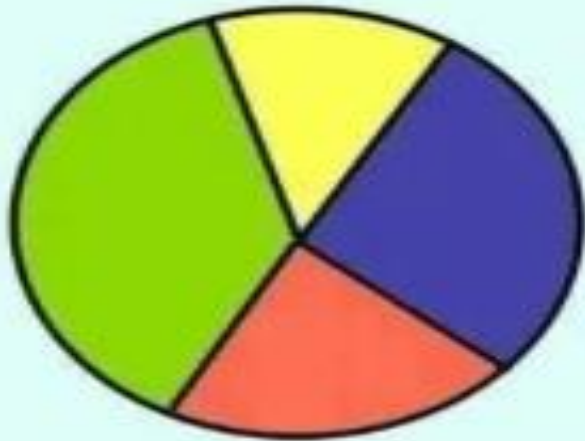


16 March 2018
Paris, La Défense



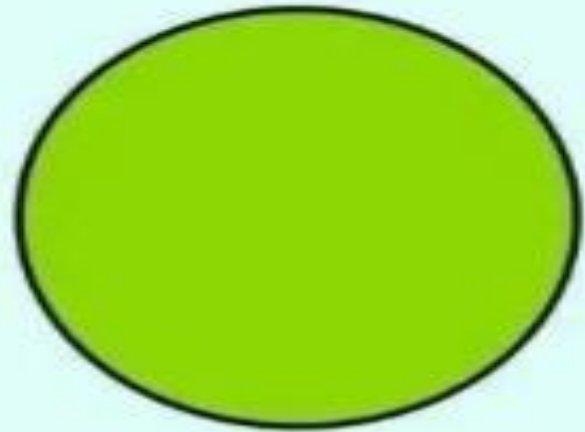
The Power of the Brand®

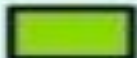
Why people buy an Android Based Phone



-  UI Customizability
-  Value for Money
-  Free Apps
-  Free (Pirated) Apps

Why people buy an iPhone



-  Because Dude!
It's an iPhone!

(12) **United States Design Patent**
Maier

(10) **Patent No.:**

US D657,952 S

(45) **Date of Patent:**

☆☆ Apr. 24, 2012

(54) **HANDBAG**

(75) **Inventor:** **Tomas Maier**, Delray Beach, FL (US)

(73) **Assignee:** **Bottega Veneta International S.A.R.L.**,
Luxembourg (LU)

(**) **Term:** **14 Years**

(21) **Appl. No.:** **29/349,527**

(22) **Filed:** **Apr. 12, 2010**

(51) **LOC (9) CL.** **03-01**

(52) **U.S. CL.** **D3/245**

(58) **Field of Classification Search** **D3/232-233,**
D3/240-246, 318, 324; 150/100, 103-110,
150/113-114, 118-119

See application file for complete search history.

(56) **References Cited**

U.S. PATENT DOCUMENTS

D445,250	S	*	7/2001	Della Valle	D3/246
6,394,157	B2	*	5/2002	Lana	150/113
D535,098	S	*	1/2007	Maier	D3/246
D561,467	S	*	2/2008	Maier	D3/232

OTHER PUBLICATIONS

Figaro, Japanese Fashion Magazine, Dec. 5, 2004, p. 80, Item No. HA16029435, Bottega Veneta Nappa Series Handbag.

* cited by examiner

Primary Examiner — Holly H Baynham

(74) *Attorney, Agent, or Firm* — Pollack, P.C.

(57)

CLAIM

I claim the ornamental design for a handbag, substantially as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of a handbag showing my new design.

FIG. 2 is a front view of the handbag shown in FIG. 1;

FIG. 3 is a rear view of the handbag set forth in FIG. 1;

FIG. 4 is a side view of the handbag illustrated in FIG. 1;

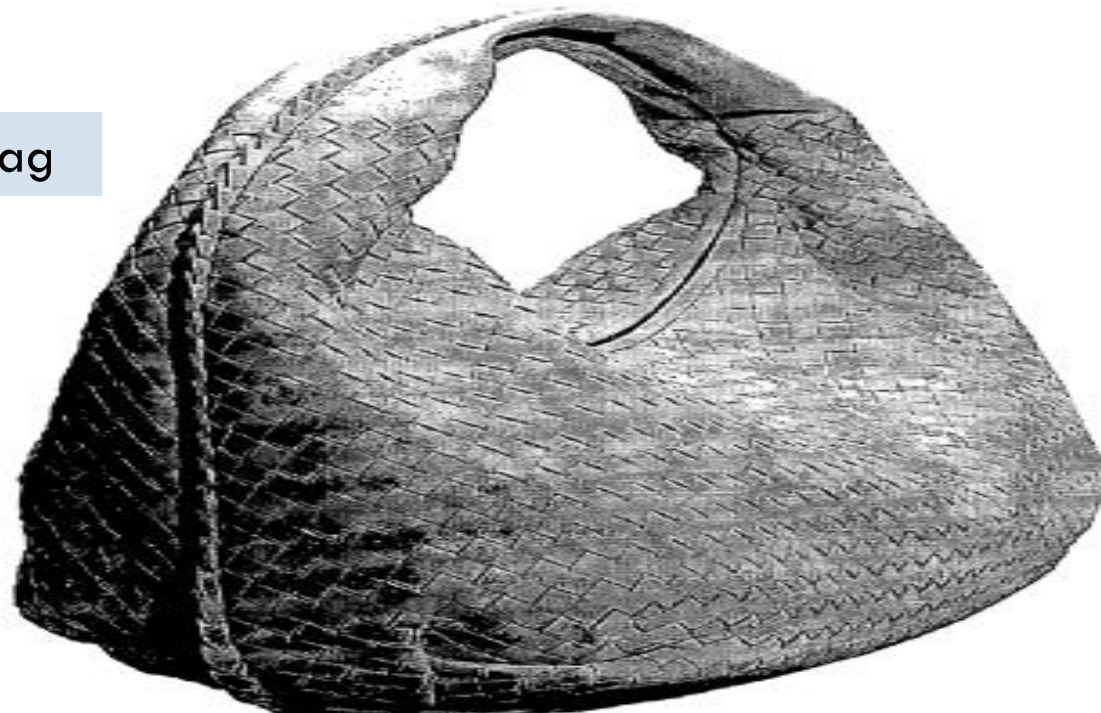
FIG. 5 is an opposite side view of the handbag shown in FIG. 4;

FIG. 6 is a plan view of the handbag illustrated in FIG. 1; and,

FIG. 7 is a bottom view of the handbag set forth in FIG. 1.

1 Claim, 7 Drawing Sheets

Veneta handbag





CHANEL

According to McKinsey, “fashion is one of the world’s most important industries, driving a significant part of the global economy. In 2016, the industry is projected to reach a staggering **\$2.4 trillion in total value**. If it were ranked alongside individual countries’ GDP, the global fashion industry would represent the world’s seventh largest economy”



Statutory Definition

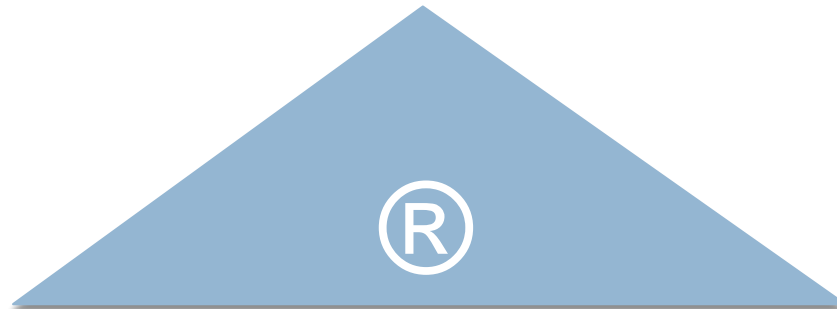
- “any word, symbol, or device, or any combination thereof **used** by a person or which a person has a bona fide **intention to use** in commerce....”
 - § 1127 (§ 45 – Lanham Act)
- Words, logos, sounds, colors, or product design

Why Trademark Protection in Fashion?

SOURCE INDICATING + STATUS

- Modern economic theory
 - ▣ Reduce search costs
 - ▣ Creates incentives to invest in a consistently produced quality product – consumer expectations!
 - ▣ Creates incentives for competition

Reduce Search Costs



Competition

Consistent Quality
(reputation + signaling effect)

DISTINCTIVENESS SPECTRUM

SOURCE INDICATING

Inherently Distinctive

Fanciful

Arbitrary

Suggestive
Terms

With secondary

Descriptive: a term that "merely describes" the product or good, conveying an immediate idea of the ingredients, qualities or characteristics of the goods. Example: "Blue" for hair color.

Arbitrary: actual words that have nothing to do with the product or good. The English language has a wealth of synonyms and nothing words with the product or good. Manufacturers may wish to claim for their products and words coined for the public relations profession supplies new words and slogans as they are needed.

Chap Stick

Secondary Meaning Acquired Meaning



[A] mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when, “in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.”

Proving Secondary Meaning

Direct Evidence:

- direct consumer testimony (including confusion)
- consumer survey

Circumstantial Evidence:

- exclusivity, length and manner of use
- amount and manner of advertising
- amount of sales and number of customers
- established place in the market
- proof of intentional copying

Louboutin V. YSL (functionality)



Functionality – A Three-Fold Test

“A mark is aesthetically functional ... where protection of the mark *significantly* undermines’ competitors ability to compete in the relevant market. In making this determination, courts must carefully weigh ‘the competitive benefits of protecting the source-identifying aspects’ of a mark against the “competitive costs of precluding competitors from using the feature.”

then we turn to a third prong:

“We take care to ensure that the mark’s very success in denoting (and promoting) its source does not itself defeat the mark-holder’s right to protect that mark”

If yes, the design is aesthetically functional

The **Red** Sole Mark

- “We conclude that the red sole mark has acquired secondary meaning when used in connection with the remainder of the Louboutin shoe.”
- We further hold that the red sole mark has acquired secondary meaning in connection with the Louboutin shoe, which the sole does not do in isolation. In other words, when a red sole is used on a black shoe.
- The use of a red sole on a black shoe is not a common or ordinary use of the same color is not a



secondary meaning. The evidence presented by Louboutin, including the fact that the red sole mark is used in connection with the Louboutin shoe, demonstrates that the red sole mark extends to uses in connection with the Louboutin shoe—in other words, in connection with a chromatic red sole. The fact that the red sole mark is used on a red shoe of the Louboutin brand is not a mark.”



“Advocate General Maciej Szpunar maintains his view that the prohibition set out in the trade mark directive is capable of applying to a sign combining colour and shape. Accordingly, he proposes that the Court’s answer should be that the grounds on which registration of a mark may be refused declared invalid are capable of being applied to a sign consisting of the shape of the goods, and seeking protection for a certain colour.”





General Court of the European Union

PRESS RELEASE No 24/18

Luxembourg, 1 March 2018

“According to the Court, EUIPO did not commit an error of assessment in finding, in particular, (i) it likely that the use of the marks applied for would take unfair advantage of the repute of adidas’ mark and (ii) that Shoe Branding Europe had not demonstrated the existence of due cause for the use of the marks applied for.”

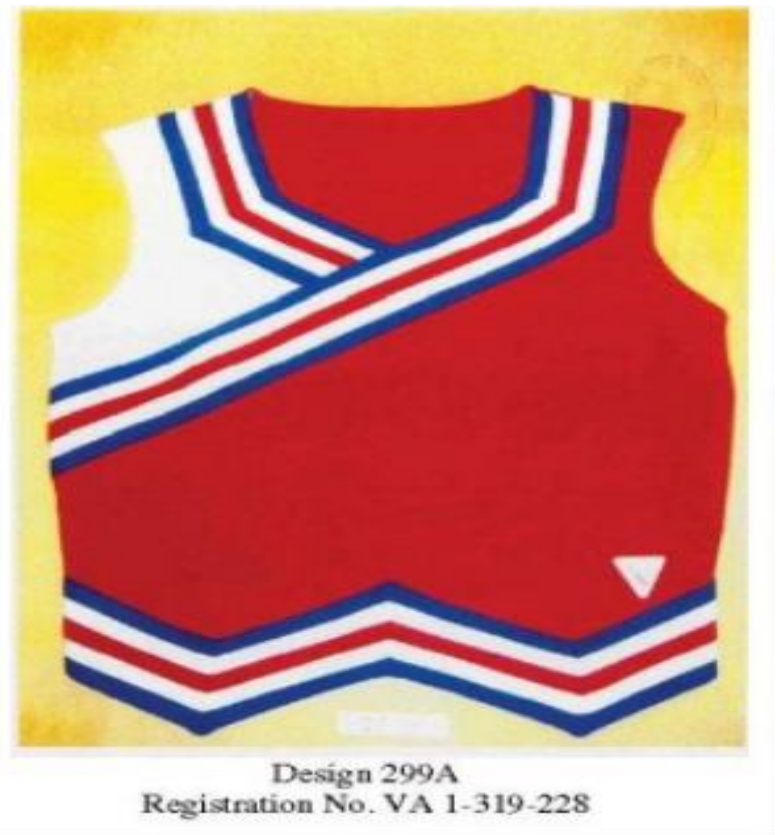
below on the right:



Copyright and Fashion?

Star Athletica v. Varsity Brands

Whether copyright protection protects the particular combination of chevrons, zigzags and stripes that characterizes cheerleader uniforms.



The court explains that the Copyright Act as a whole “makes clear that copyright protection extends to pictorial, graphic, and sculptural works regardless of whether they were created as free-standing art or as features of useful articles.”

TEST: An artistic feature of the design of a useful article is eligible for copyright protection if the feature:

(1) can be perceived as a two-dimensional or three-dimensional work of art separate from the useful article; and

(2) would qualify as a protectable pictorial, graphic, or sculptural work either on its own or in some other medium if imagined separately from the useful article

Applying this test: **First**, one can identify the decorations as features having pictorial, graphic, or sculptural qualities. **Second**, if the arrangement of colors, stripes, and chevrons ... were separated from the uniform and applied in another medium – for example, on a painter’s canvas—they would qualify as “two-dimensional ... works of ... art.”



Design 299B
Registration No. VA 1-319-226



Design 299A
Registration No. VA 1-319-228

What this means is that while the shape, cut, and physical dimensions of a fashion article, are NOT protectable under U.S. copyright law, features or components incorporated into a article may be protectable.



TRADEMARK IS STILL KING

Thank You

Enforcement Mechanism and Infringement Test

PROTECTION OF GOOD WILL

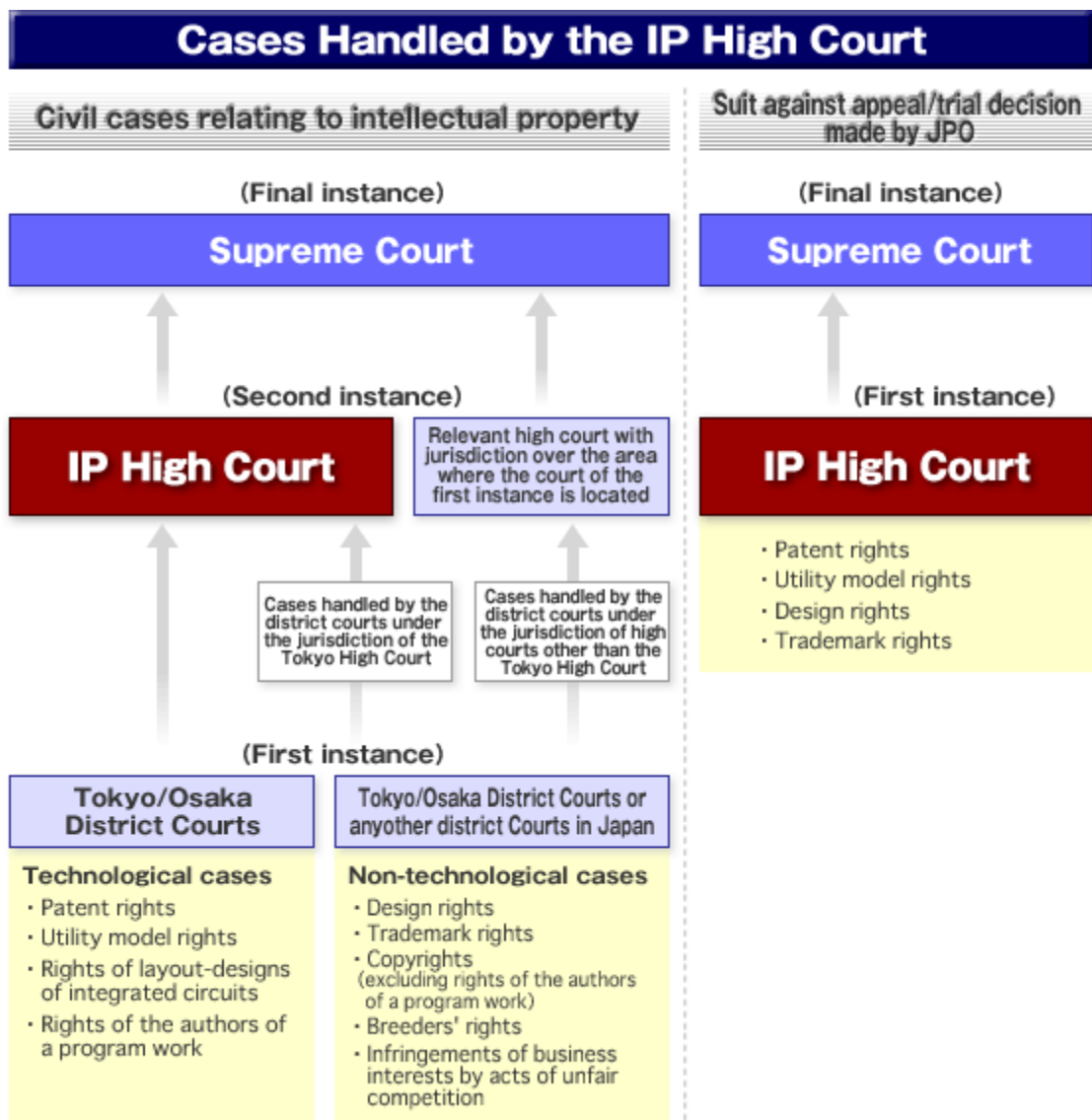
- Registered marks
 - Trademark law
- Unregistered Marks (Comp. unregistered designs)
 - Unfair Competition



ENFORCEMENT MECHANISM

- Court proceeding
 - District courts
 - Regional high courts
 - Supreme Court
- JPO – Invalidation Trial
- Custom Office – Border measures





Int'l Institute of Intellectual Property

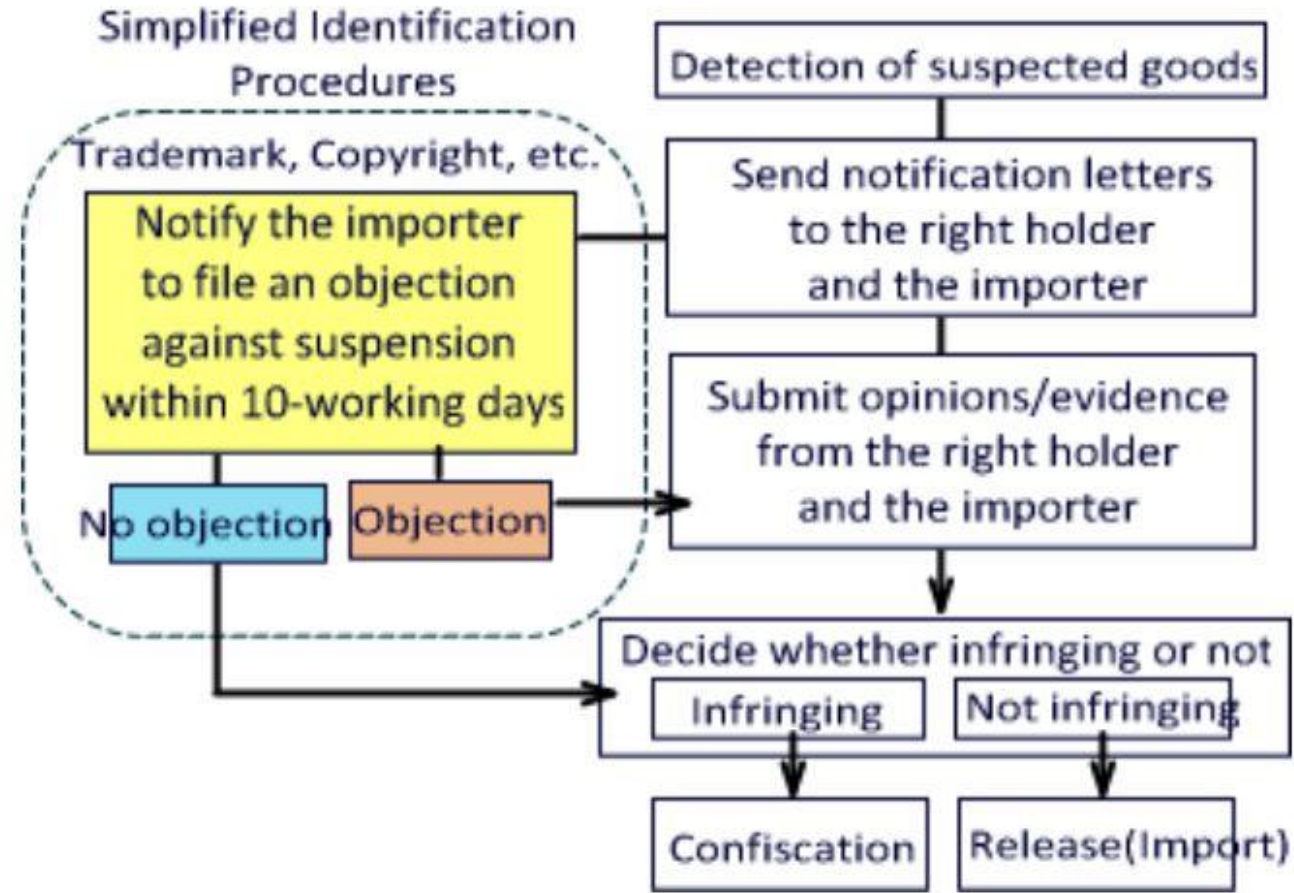
Study on Specialized Intellectual Property Courts, 66 (2012)

<http://iipi.org/wp-content/uploads/2012/05/Study-on-Specialized-IPR-Courts.pdf>



BORDER MEASURE

Outline of Identification Procedures



INFRINGEMENT

- Trademark Law Art. 25

The holder of trademark right shall have an exclusive right to use the registered trademark in connection with the designated goods or designated services; provided, however, that where an exclusive right to use the trademark is established in connection with the trademark right, this provision shall not apply to the extent that the holder of exclusive right to use has an exclusive right to use the registered trademark..

- Right to use: The registered mark with registered goods/services
- Right to exclude: The registered and similar marks with the designated and similar goods



INFRINGEMENT

- Trademark Law Art. 26(1)

A trademark right shall have no effect on any of the following trademarks (including those which constitute part of other trademarks):

- (v) a trademark consisting solely of a three-dimensional shape of goods or their packaging which is indispensable for such goods or their packaging to properly function.
- (vi) a trademark which is not used in the manner not indicate the origin of goods and services (to affect the trademark function)



INFRINGEMENT

- Elements to establish infringement

TM Owner

- Identical or similar to the registered mark
- Used on goods/services identical or similar to the designated goods

Defenses (defendants should establish)

- Using the mark in the manner not affecting the trademark function
- Private use etc.



INFRINGEMENT TEST

SIMILARITY OF MARKS

- **Sup. Ct. of Japan March 11, 1997**
 - Similarity of marks should be determined on basis of overall impression, memory, inspiration resulting from the appearance, impression and sound of the marks given to traders and consumers by taking account of the circumstances surrounding the trading the goods.
 - Although either appearance, impression or sound is similar between the marks, if any other factor surrounding the trade eliminates likelihood of confusion, such marks are not similar.



INFRINGEMENT TEST

SIMILARITY OF MARKS

- Similarity of marks
 - **Traders** and ordinary consumers with an ordinary care to be paid to purchase the goods at issue
 - Sounds, appearance, impression
 - Side-by-side comparison as well as comparison at different times and different places
 - Overall impression v. focus on essential elements
 - Timing: At the closing of trial (for injunction)
- Similarity of goods



TOKYO DIST. CT. MAY 21, 2014

HERMES BIRKIN HANDBAG

- Hermes sued a Japanese company who imported and sold bags from Korea for trademark infringement and a violation of unfair competition law
- Tokyo District Court found trademark infringement and a violation of unfair competition law and issued an injunction preventing the defendant from importing and selling the bags



Trademark Registration

登録番号 第5438059号

登録日 平成23年(2011)9月9日

登録公報発行日 平成23年(2011)10月11日

公開日 平成20年(2008)4月3日

出願番号 商願2008-16949

出願日 平成20年(2008)3月6日

先願権発生日 平成20年(2008)3月6日

存続期間満了日 平成33年(2021)9月9日

拒絶査定発送日 平成22年(2010)2月26日

権利者

氏名又は名称 エルメス・アンテルナショナル

住所又は居所 フランス国75008パリ市リュ・デュ・フォーブル・サントノーレ24番

付加情報 色彩有り 3条2項適用

審判番号 2010-11402

審判種別 査定不服審判

【商品及び役務の区分並びに指定商品又は指定役務】【類似群コード】

18 ハンドバッグ

21C01



Accused Product



TOKYO DIST. CT. MAY 21, 2014

HERMES BIRKIN HANDBAG

- **Similarity of 3D Marks: Likelihood of Confusion**
 - A 3D trademark should be generally interpreted as a trademark that allows those who see it to identify the source of goods or services by the characteristics of a visual image it provides when seen from one or two specific directions (predetermined directions) from which those who see it are supposed to mainly look when they observe the trademark.
 - When a visual image seen from a predetermined direction is **identical or closely similar to a specific flat (2D) mark**, it should be, in principle, concluded that the 3D trademark in question and the flat mark in question are similar in appearance.
 - The direction to be used as a predetermined direction should be determined individually and objectively based on the structural details of the three-dimensional trademark in question.



TOKYO DIST. CT. MAY 21, 2014

HERMES BIRKIN HANDBAG

- **Unfair Competition Art. 2(1)(i)**

Act of Unfair Competition

- The act of creating confusion with another person's goods or business by using an Indication of Goods or Business (meaning a name, trade name, Trademark, Mark, container or packaging for goods pertaining to a person's operations, or any other indication of a person's goods or business; the same applies hereinafter) that is identical or similar to the another person's Indication of Goods or Business that is **well-known** among consumers as that of the another person, or by assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing or providing through a telecommunications line those goods that use said indication;



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

Plaintiff's Product



Defendant's Product



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

- **Well known Indication of Goods and Secondary Meaning**

- The shape of goods are usually adopted to enhance the utilitarian or esthetical function of goods but not for identify the source of goods or services. If the shape has **unique** features to distinguish the good from other goods and continue to use the features exclusively for long time, the shape begins to function to identify the source of goods as consumers begin to view such features as an indication of the source of goods.



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

- **Fact finding**

- Unique features: No other dresses including features similar to the unique features of P's dresses
- Well known: Sales history and amount of sales and advertisement
 - No consumer survey



TOKYO DIST. CT. JUNE 29, 1999

ISSEI MIYAKE PLEATS PLEASE DRESS

■ **Similarity – Likelihood of Confusion**

- Unique features: In a dress made of smooth polyester fabric, vertically extending narrow pleats (folds having ununiform widths) are provided throughout uniformly the dress including seams of shoulder lines, sleeve openings, hems, to provide a flat design of thin clothes giving an impression like a piece of fabric
 - Functionality argument rejected: Alternative design to provide the same function: preventing wrinkles, easy to wash etc.
- Defendant's products is similar because they have the unique features despite of minor differences: Width of front body, designs of arm openings and neckline



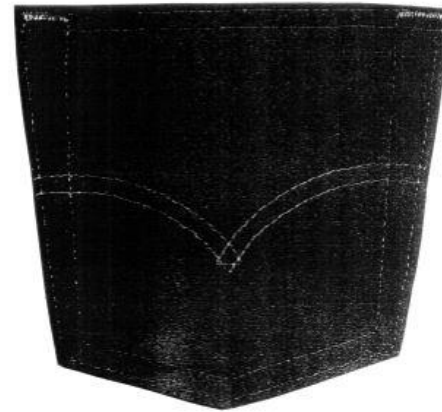
TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

Plaintiff's Product



Defendant's Product



TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

- **Well Known Indication of Goods (Not yet famous)**
 - Consumer survey
 - Those who purchased jeans within 6 months
 - Age between 15-29 46%
 - Age between 15-69 31%
 - Those who purchased jeans within 1 year with the knowledge of the brand of the jeans they purchased and remembered to see the plaintiff's stitch
 - Age between 15-34 86% (37% of them identified jeans with the pocket stitch sold Livi's)



TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

- **Unique Features**

- Plaintiff has been requesting to stop selling jeans with similar pocket stitch whenever it finds such jeans
 - Exclusive use of the features



TOKYO DIST. CT. APRIL 12, 2000

LEVI'S POCKET STITCH

- **Similarity – Likelihood of Confusion**

- Common features

- Stitches provided on the back pockets of jeans
 - Consisting of two arches on right and left sides
 - Said arches are symmetrical
 - Each arch consist of two parallel lines
 - Such two lines are extending from the right and left ends to the center from the pocket to draw arches gradually discending to cross at the center



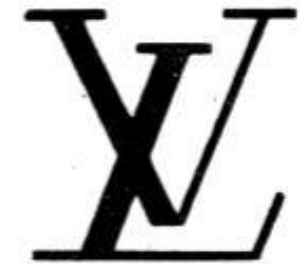
OSAKA DIST. CT. MARCH 18, 1987

LOUIS VUITTON MONOGRAM

Registered Marks

- **Limitation on Exclusive Right**

- The Osaka District Court rejected the defendant's argument that the registered mark was used as a design which indicate merely the shape of good by stating that finding the use of mark as an act of using the mark as a trademark does not exclude finding of an act of the same mark as a design. As long as the mark is used to indicate the origin of goods, such use must be found as using the mark as a trademark.



IP HIGH CT. APRIL 12, 2016

FRANCK MUELLER PARODY WATCH



フランク三浦



MULLER



三浦



MULLER



三浦



IP HIGH CT. APRIL 12, 2016

FRANCK MUELLER PARODY WATCH

■ **Similarity of 3D Marks: Likelihood of Confusion**

No likelihood of confusion

Registered mark

- Sound - Similar
- Appearance – Not similar
- Impression – Not similar
- Goods – Not similar

フランク ミュラー

Wrist watches

Cited marks

フランク ミュラー

- Plaintiff: more than \$10,000
- Defendant: less than \$35

FRANCK MULLER

FRANCK MULLER REVOLUTION

