

# Choosing the Right Path to Protection

When it comes to rights protection, intellectual property (IP) owners have a variety of options, each with advantages and disadvantages, as Saman Javed finds out.

In Monday's session **CM50 Interplay Between Designs, Copyright, and Trade Dress—Overlapping or Coexisting**, which was moderated by Simon Brown, a Partner at Adams & Adams (USA), panelists discussed the challenges associated with different types of protection in their various jurisdictions.

Imogen Fowler, a Partner at Hogan Lovells (Spain), said anybody who has filed a trademark with the European Intellectual Property Office (EUIPO) in the last few years would have found it is becoming increasingly difficult to get particular types of marks approved.

"The first place we saw things change was in the context of 3D marks. Effectively, the law now says that a shape has to depart significantly from the norm in order to be registerable. That bar is very high, it's very hard to prove," she noted. "So if you're trying to file a 3D mark based on inherent distinctiveness, I would say good luck to you."

Ms. Fowler cited two examples in which the EUIPO rejected applications to register 3D shape marks for confectionary, noting: "These are very well-known trademarks, which are quite unique shapes. I would have thought they would be inherently distinctive, but they didn't meet the threshold."

She added that it has also become more difficult to register 2D marks, with the EUIPO rejecting applications for marks that feature "non-distinctive words and logo elements."

Mr. Brown said that "while a lot of lawyers are more focused on trademarks than any other form of IP, given the difficulties of securing trademark rights, certainly in the non-traditional sphere, it's becoming increasingly important to look at other aspects of IP."



(L to R) Diego Palacio, Ray Zhao, Imogen Fowler, and Simon Brown

One way in which brands are protecting their marks is through trade dress. However, this can only be done at a national level as an "unregistered right" because trade dress does not exist as a specific category for protection in the European Union.

Ms. Fowler noted how this is further complicated by the fact that national laws differ from country to country. "An unregistered right in Spain will not be the same as in Bulgaria," she added. This means that there is no clear scope for the right across Europe.

There are no fees applicable for unregistered rights, but they can be expensive to enforce because it is necessary to demonstrate "serious evidence of unfair competition and actual confusion" to prove infringement, she said.

A category for design patents also does not exist in the EU. Instead,

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unregistered or registered community designs are available.

Since there is no detailed examination required to obtain these rights, Ms. Fowler said, it makes them "really quick to register."

In China, in contrast, design patents are available. Ray Zhao, Partner at Unitalen Attorneys At Law (China), explained that in order to qualify for protection, design patents must be novel, fit for industrial application, and artistic.

"There is no substantial examination for design patents in China. Often companies file design patents, and as long as you meet the formality requirements, the applications will be approved," he said.

While this makes approval extremely fast, the lack of substantial examination can result in disputes when two companies file the same design, he noted.

Copyright applications in China are also not subject to examination, meaning they can be issued in as little as a month, Mr. Zhao said.

However, copyright is registered on a regional basis in the country but the "registries don't share information, so it can be difficult to find what works are already protected," he added.

Nonetheless both copyright and design patents can provide alternatives to or supplement trademark protection.

In the United States, brand owners can protect product packaging and product design in the form of trade dress protection.

Diego Palacio, Attorney at Palacio & Asociados (Argentina), said trade dress protection is a "source indicator for consumers, which helps avoid the likelihood of confusion."

To qualify for trade dress protection, the product packaging must be non-functional, must not be essential to the use or purpose of the product, and must not affect the product's cost or quality.

The packaging must be inherently distinctive or acquire distinctiveness by secondary meaning, while the design is considered inherently non-distinctive and must acquire distinctiveness by secondary meaning.

Mr. Palacio said that in the U.S., trade dress protection lasts indefinitely, as long as it is being used. Additionally, brands can obtain protection after a product has been made available in public. This is important because, in some cases, public disclosure can be helpful to establish acquired distinctiveness, which can be difficult to prove. ●

## There's No Place Like Home (continued)

13 Partner at Goodrich, Riquelme & Asociados (Mexico). "We have had some cases involving Champagne in Mexico as well."

"While it may be easy to oppose an infringement when it's related to goods, it's not always a red line in how to oppose it when it comes to a service," he said, noting that there are even some schools with the name "Champagne."

### The Intangible Value of GIs Promoting Colombian Coffee

Café de Colombia became recognized as a denomination of origin in

Columbia in 2005, and subsequently became recognized in Peru, Ecuador, and Bolivia. It was also the first non-European protected GI in the European Union in 2007 and the first protected GI in Switzerland in 2013.

Since the emergence of highly recognized global coffee chains, the perception of quality coffee brands has shifted, and the Colombian coffee strategy had to evolve. "We came out with a protected GI as part of this strategy," explained Luís Fernando Samper, Founder and President at 4.0 Brands SAS (Colombia). "[It] is an

important tool to protect collective rights."

Earning this status holds great value for Colombian coffee makers and the Colombian people. "Coffee is very important for Colombia, and has a lot of social significance for many. In fact, half of the towns in Colombia produce coffee," he said, emphasizing the added "intangible" value GI protection brings to a product and the perceived quality of a product.

"Once you have GI protection it can be very powerful," he said. "It takes a lot of effort – but once you get it, it can be very useful in legal terms." ●

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Enrique A. Diaz