

Relationship between Trademark Law and Copyright/Design Law

Trademark Protection for Ornamental Shapes?

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I INTRODUCTION

The overlap between trademark law and copyright or design law has grown with the extension of trademark protection for subject matter that was traditionally protected only by copyright and/or design law. This extension has been triggered not only by the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement (Article 15(1)) but also by prior national and regional initiatives (e.g., Article 2 of the 1988 EU Trademark Directive). The overlap thus covers slogans and titles; two-dimensional artistic works (figurative marks such as color combinations, logos, graphical user interfaces, or computer visual displays); musical works (sound marks); and three-dimensional artistic works (shape marks).

This chapter concentrates only on ornamental shapes. It examines a very specific question: should there be trademark protection for an ornamental shape of a product which is also protected or had previously been protected by copyright or design law? How has this question been answered by the legislatures and/or judges in the civil law world and in the common law world?

II A PERSPECTIVE FROM THE COMMON LAW WORLD

In many common law countries, ornamental features of a product or its packaging are protectable in the design regime rather than the copyright regime. For this reason, the discussion in this section is limited to the interface between trademark law and design law.

There is, in fact, no uniformity in how common law countries approach this interface. Broadly speaking, there can be three different approaches. In the first approach – a rather outmoded one – there is an unqualified ban on trademark registration of an ornamental shape of a product: trademark protection is absolutely forbidden with no exceptions. In the second approach, there is a qualified ban on trademark registration of the shape: trademark protection is forbidden only in certain cases. In the third approach, the matter is determined solely by the distinctiveness criterion in trademark law: there is no objection to registering and protecting the shape as a trademark if the shape is distinctive of a trader's goods.

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The rest of this section elaborates on each of these three approaches. The countries and case law discussed in this section highlight the principal policy considerations underpinning each approach.

*A An Unqualified Ban on Registering the Design as a Trademark – Absolutely No
Second Bite of the Cherry, Please*

At one time in various parts of the common law world, there was an absolute ban on granting trademark protection over the ornamental shape of a product or its packaging. A convenient starting point to understand the rationale for this absolute ban is the 1934 report of the Goschen Committee in the United Kingdom.¹

The Goschen Committee was established in 1933 to review and revise the UK Trade Marks Act 1905 (UK 1905 Act). One of the proposals received by the Goschen Committee was to amend the definition of the word “mark” in the UK 1905 Act:² “‘mark’ includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof.” The proposal was to include in this definition, albeit non-exhaustive in scope, an explicit reference to “a container.”³ The reason for this proposal, as well as why it did not impress the Goschen Committee, is found in this passage of the committee’s report:⁴

[I]t was submitted that the shape of a container often serves to distinguish the origin of particular goods, and that in such cases the shapes and patterns of the bottles and other containers should be capable of registration as trade marks. It was not contended that the right conferred by such registration should extend beyond the mere appearance of the container, and it was admitted that it might be necessary to insert words in the existing definition to make this clear. We are unable, however, to recommend the inclusion of containers as “marks.” The protection afforded by registration under the [Trade Marks] Acts may be of indefinite duration, and we think that the grant of monopolies for indefinite periods for the shape of say a bottle or jar might prove embarrassing to other traders and to the public generally. Under the Patents and Designs Acts, new designs to be applied to containers are registrable for periods of not more than fifteen years, and registration under the Trade Marks Acts might in some, cases interfere with the right of the public to use a design of which the period of protection had expired.

Two important points emerge from this passage. First, when a trader seeks and obtains design protection for an ornamental shape, it could be said that this protection is given on the premise that the shape is destined for the public domain upon the expiration of the protection period fixed by design law. There would be no quid pro quo if, at the end of this period, this trader gets further (and worse, perpetual) protection for the shape under trademark law. Second, this policy objection is so fundamental that it cannot be overcome by proof that the shape has become distinctive of this trader’s goods as a result of prior use. The fact that the shape is in fact functioning as this trader’s badge of origin in the marketplace is irrelevant. This remains

¹ The chairman of this committee was Viscount Goschen. The proper title of this committee is the “Department Committee on the Law and Practice Relating to Trade Marks.”

² See Trade Marks Act 1905, § 3(1) (Eng.).

³ The proposed definition was the following: “A ‘mark’ shall mean any sign or combination of sign including a device, brand, heading, label, wrapper, *container*, ticket, name, signature, word, letter, or numeral” (emphasis added). See DEPARTMENT COMMITTEE ON THE LAW AND PRACTICE RELATING TO TRADE MARKS, MINUTES OF EVIDENCE, 1933, § 1427 (UK). This proposal came from the British Federation of Industries (although all the members supported this proposal): see *id.* §§ 1488–9.

⁴ DEPARTMENT COMMITTEE ON THE LAW AND PRACTICE RELATING TO TRADE MARKS, REPORT, 1933, Cm. 4568, § 13 [hereinafter REPORT OF THE DEPARTMENT COMMITTEE].

irrelevant even if the common law action for passing off would come to the aid of this trader if others use a confusingly similar shape in relation to their goods.⁵ In short, the Goschen Committee's message was this: *absolutely* no second bite of the cherry, please.

In the new law that ensued from the work of the Goschen Committee, namely, the UK Trade Marks Act 1938 (UK 1938 Act), the definition of "mark" as it appeared in the UK 1905 Act was retained.⁶ This definition, it bears repeating, is non-exhaustive in scope. Therefore it was conceivably possible for a court to be persuaded that the shape of a container or an article could qualify as a "mark" under the UK 1938 Act.⁷ And this was what the Coca-Cola Company sought to do in the *Coca-Cola Trademarks* case (*Coca-Cola (UK)*).⁸ This is a perfect case study for our purposes because it concerned a trademark application for a shape in which design rights had expired.

The shape in question was the fluted contour shape of the Coca-Cola Company's by now iconic bottle (the Contour Bottle), which the company used as the container for its cola beverage. In the UK, the Contour Bottle had been in use since the early 1920s. The Coca-Cola Company had a design registration for the shape of the Contour Bottle,⁹ which expired in 1940. Several years later, the Coca-Cola Company filed two applications¹⁰ to register the three-dimensional shape of the Contour Bottle as a trademark under the UK 1938 Act, in respect of non-alcoholic beverages. The Coca-Cola Company tendered evidence to argue that the shape of the Contour Bottle had become distinctive of its cola beverage. It advanced the policy-based argument that was in substance the same as the one put before the Goschen Committee: the registration system was to protect distinctive trademarks and since the shape of the Contour Bottle was distinctive of its beverage, it ought to be allowed registration. The definition of "mark" in the UK 1938 Act, being non-exhaustive in scope, could accommodate shapes.

The House of Lords (now Supreme Court) was not persuaded by the distinctiveness argument. Even assuming that distinctiveness was established,¹¹ the court said, this was irrelevant. Instead, what was relevant was the fact the shape of the Contour Bottle had previously been protected by design rights. The court saw the Coca-Cola Company's present claim for trademark protection over this shape as an inappropriate "attempt to expand the boundaries of intellectual property and to convert [trademark law] into a source of monopoly."¹² Clearly, the Law Lords were of the same mind as the Goschen Committee.

⁵ See *Reckitt & Colman Products Ltd. v. Borden Inc.* (No. 3) [1990] RPC 341 (HL) (the famous JIF LEMON case, involving a plastic lemon-shaped container). The House of Lords found that this container had become distinctive of the claimant's product (lemon juice) and that the defendant's container was confusingly similar to the claimant's container. The defendant was held liable for passing off.

⁶ The definition of "mark" is found in Trade Marks Act 1938, 1 & 2 Geo. 6 c. 22, § 68(1) [hereinafter UK 1938 Act].

⁷ Perhaps this was why the Mathys Committee (the committee established in 1972, under the chairmanship of Mr. H. R. Mathys, to review trademark law and practice under the 1938 Act) recommended that the 1938 Act should explicitly exclude the registration of the shape of goods or their container. COMMITTEE TO EXAMINE BRITISH TRADE MARK LAW AND PRACTICE, REPORT, 1972, Cm. 5601, § 64. The Mathys Committee fully endorsed the Goschen Committee's view that trademark protection for shapes was inappropriate: see *id.*, §§ 60–61.

⁸ *Coca-Cola Trade Marks* [1986] RPC 421 [hereinafter *Coca-Cola (UK)*].

⁹ The registration was effected under the UK Patents and Designs Act 1907, 7 Edw. 7 c. 29. This has since been repealed and replaced by the UK Registered Designs Act 1949, 12, 13 & 14 Geo. 6 c. 88.

¹⁰ One application was filed in 1976, and one application was filed in 1980. The dispute also involved a third application filed in 1980, but this third application was to register a line drawing of the Contour Bottle as a two-dimensional trademark (that is, as a device or logo) and hence is not relevant for our purposes.

¹¹ *Coca-Cola (UK)*, at 457. Note that the Lords left this issue of distinctiveness undecided. The lower courts had differed in their findings: the Trade Mark Registrar and the High Court judge found that the evidence did not prove that the Contour Bottle had acquired distinctiveness, but this finding was overturned by the Court of Appeal.

¹² *Id.* at 456.

To prevent the Coca-Cola Company from having a second bite of the cherry, the House of Lords declared that the Contour Bottle was “a container not a mark.”¹³ Since a container was not even a “mark,” the Coca-Cola Company’s applications failed at the most fundamental level. This legal reasoning in effect operates as a total, unqualified bar to registration.

The impact of *Coca-Cola (UK)* reverberated through the various Commonwealth countries which had modelled their trademark legislation on the 1938 Act. Hence, at one time it was not possible to register the shape of a container or an article as a trademark in countries such as Australia,¹⁴ New Zealand,¹⁵ and Singapore.¹⁶ However, not all Commonwealth countries took such an absolute stance on this issue. The positions of Canada in the late 1950s and South Africa in the 1960s are especially interesting, as discussed below.

The current position in the United Kingdom is very different, and the same can be said of the other countries mentioned in the preceding paragraph. But before looking at what their respective position currently is, let’s pay a visit to Canada and South Africa.

B A Qualified Ban on Registering the Design as a Trademark – No Second Bite of the Cherry Only in Certain Cases

From the outset, policy makers in Canada accepted that the notion of a “mark” could encompass the shape of a container or an article. Its first trademark legislation after Confederation permitted the registration of “packages,”¹⁷ and this was followed by the Unfair Competition Act 1932, which allowed the registration of a “distinguishing guise” defined to mean “a mode of shaping, moulding, wrapping or packing wares” that was adapted to distinguish the applicant’s wares.¹⁸ It was under this concept of “distinguishing guise” that the Coca-Cola Company managed to get a trademark registration for the Contour Bottle in 1952.¹⁹ However, it should also be noted that where the shape had “any element of utility or convenience,” registration would not extend trademark protection to such elements.²⁰

In the late 1940s, the question that confronted the Goschen Committee came before a Canadian law reform committee: should Canada (continue to) allow registration of the shape of a container as a trademark under the concept of distinguishing guise? This law reform committee was the Fox Committee,²¹ established in 1947 to review and revise the Unfair Competition Act 1932. Like the Goschen Committee, the Fox Committee was also concerned that trademark registration of a shape could harm the public interest. But unlike the Goschen

¹³ *Id.* at 457.

¹⁴ See, e.g., *Koninklijke Philips Elecs NV v. Remington Consumer Prods Ltd* (2000) 177 ALR 167, § 15 (Austl.), where *Coca-Cola (UK)* was cited as authority for the view that shapes were not registrable under the former Australian Trade Marks Act 1955.

¹⁵ See, e.g., *Tot Toys Ltd. v. Mitchell* [1993] 1 NZLR 325 (HC) at 348, where *Coca-Cola (UK)* was cited as authority for the view that shapes were not registrable under the former New Zealand Trade Marks Act 1953.

¹⁶ See, e.g., TAN TEE JIM SC, *LAW OF TRADE MARKS AND PASSING OFF IN SINGAPORE* § 3.047 (3d ed. 2014) Vol. 1 at para. [3.047], where *Coca-Cola (UK)* was cited as authority for the view that shapes were not registrable under the former Singapore Trade Marks Act 1939.

¹⁷ See Trade Mark and Design Act 1868, 31 Vict. c. 55, § 5 (Can.).

¹⁸ See Unfair Competition Act 1932, 22 & 23 Geo. 5 c. 38, § 2(d) (Can.).

¹⁹ COCA-COLA BOTTLE, Registration No. UCA44193 (registered on Nov. 21, 1952, in Class 32).

²⁰ This exclusion is found within the definition of “distinguishing guise.”

²¹ The proper title of this committee is “Trade-Mark Law Revision Committee.” The chairman of this committee was Dr. Harold Fox, a renowned lawyer and author of various textbooks on Canadian industrial and intellectual property. One of his textbooks is *Canadian Law of Trade Marks and Unfair Competition*. The report of the Fox Committee is reproduced in the Appendix: HAROLD G. FOX, *CANADIAN LAW OF TRADE MARKS AND UNFAIR COMPETITION* 1142–82 (2d ed. 1956).

Committee, the Fox Committee did not think that the solution was to ban registration of shapes altogether. Instead, it recommended that the new law should have more safeguards, that is, apart from the one in the existing law which excluded protection for “an element of utility or convenience” in the shape. These safeguards were implemented in section 13 of the new law, namely, the Trade Marks Act 1953. This remains the governing trademark legislation in Canada today.²²

The safeguard which is relevant for our purposes is the one set out in section 13(1)(b). This provision bans the registration of a shape of a container or an article (even if it has become distinctive of a trader's goods) where the registration is likely to “unreasonably [] limit the development of any art or industry.” The threshold of this ban is set rather high, and the mere fact that the shape had previously enjoyed protection in the design regime would not cross this threshold. This view is borne out by what happened in *WCC Containers Sales Ltd. v. Haul-All Equipment Ltd.*²³ In many ways, this case is the Canadian equivalent of *Coca-Cola (UK)*. The shape in question was the configuration of a container which was designed for use as a refuse bin in public places like national parks. The company behind the creation of this container (HL) had a design registration over this shape. One year after the expiration of the design registration, HL applied for and obtained trademark registration for this shape. A rival (WCC) applied to expunge this trademark registration on various grounds. One ground was that the shape was already “dedicated to the public”²⁴ upon the expiration of the design registration. This is in essence the policy of no second bite of the cherry that won the debate in the United Kingdom under the stewardship of the Goschen Committee. But this policy did not find favor with the Federal Court of Canada. The court did not see section 13(1)(b) as implementing this policy. The court reasoned that if Parliament had intended to make design protection and trademark protection mutually exclusive, the limitation would have been explicit and unequivocal (as was the case with the overlap between design protection and copyright protection). Section 13(1)(b) was meant to avoid something more troubling than the prior protection of the shape in the design regime.

What is so perfect about this case is that it also illustrates what else is needed to successfully activate section 13(1)(b). As mentioned, HL's container was designed for use as a refuse bin in national parks. HL was the sole supplier of these refuse bins to the national park authorities during the years when the shape of the bin was protected by the design registration. So well-designed was this bin that when the national park authorities needed a further supply of refuse bins, their tenders specified that the bin must be shaped like HL's bin. By this time, HL's design registration had expired. Companies like HL and WCC put in bids, and even though WCC's bid was lower, the tender was awarded to HL because of HL's trademark registration for the shape of the bin. HL had even threatened to sue the national park authorities for inducing trademark infringement if they awarded the tender to any other party. These circumstances were what prompted the Federal Court to conclude that HL's trademark registration “unreasonably . . . limit[ed] the development of any art or industry,” and accordingly to order its expungement under section 13(1)(b).

In South Africa, it has been possible to register a container as a trademark since 1963. This possibility came about as a result of a recommendation from the Chowles Committee,²⁵ which

²² Note, though, the potential repeal of § 13, via Economic Action Plan 2014 Act, No. 1, SC 2014, c. 20, § 16 (Can.) (which has not been brought into force).

²³ *WCC Containers Sales Ltd. v. Haul-All Equip. Ltd.* [2003] FC 962 (Can. Fed. Ct.).

²⁴ *Id.*, § 59.

²⁵ The chairman of this committee was Mr. Victor Chowles, who was South Africa's Registrar of Trade Marks at the material time.

was established in 1961 to review and revise the country's first trademark legislation, the Trade Marks Act 1916. The prevailing view was that this legislation did not permit the registration of containers.²⁶ When considering whether this should be changed, the Chowles Committee specifically referred to the Goschen Committee's objection, noting the latter's view that trademark law should not interfere with "the right of the public to use a design"²⁷ once its protection under design law had expired. However, the Chowles Committee decided – just like the Fox Committee did – that the concern of overprotection of containers could be managed by having safeguards in the new law.²⁸ Thus, the new law, the Trade Marks Act 1963, defined the term "mark" to include "a distinctive container for goods"²⁹ and, at the same time, provided for the expungement of the registration where it was or had become "likely to limit the development of any art or industry."³⁰ Today this safeguard is found in section 10(11) of the Trade Marks Act 1993, as a ground of objection to refuse registration of a container or to expunge a registration thereof.³¹

Just like in Canada, the mere fact that the shape has previously enjoyed protection in the design regime is probably insufficient to prevent registration of the shape under this ground of objection. This appears to be the position taken in *Die Bergkelder Beperk v. Vredendal Koop Wynmakery*.³² The claimant, a wine producer, had registered the shape of its wine bottle as a design. Just when the design protection was about to expire, the claimant applied for and obtained registration of its bottle as a trademark. The defendant, another wine producer, sought to expunge the trademark registration when the claimant sued for trademark infringement. The Supreme Court of Appeal was clearly not impressed with the claimant's behavior, noting at one point that the change in the law to allow registration of containers as trademarks was not meant to confer on a container "a patent-like or industrial design-like monopoly in the container itself."³³ The court ordered the expungement of the claimant's trademark registration for its bottle, but the ground for expungement was that the bottle was not distinctive of the claimant's products. No objection under section 10(11) was raised at all.

An objection under section 10(11) was raised, and successfully activated, in *Triomed (Proprietary) Ltd. v. Beecham Group Plc*.³⁴ This concerned an application to expunge the trademark registration of a particular shape of a pharmaceutical tablet. All the features in this shape mark – its elliptical shape, its curvature and thickness – had functional purposes; for example, the curvature facilitated the coating of the tablet with a polymer film, which in turn aided swallowing or controlled the release of the active ingredients in the tablet. The High Court of South

²⁶ Patents, Designs, Trade Marks and Copyright Act 9 of 1916 (as amended up to Act No. 19 of 1947) [hereinafter Trade Marks Act 1916] defined "mark" in the same way as the UK 1938 Act. In *Cointreau et Cie v. Pagan International* 1991 (4) SA 706 (SCA) at 710 (S. Afr.), the Supreme Court of Appeal cited *Coca-Cola (UK)* as authority for the view that a container was not registrable under the Trade Marks Act 1916.

²⁷ REPORT OF THE DEPARTMENT COMMITTEE, *supra* note 4.

²⁸ COMMITTEE ON DRAFT TRADE MARKS BILL 1961, REPORT, 1961, § 22–23. See also Victor Chowles, *Letter from South Africa*, 52 TRADEMARK REP. 992, 998–9 (1962); G. C. WEBSTER ET AL., SOUTH AFRICAN LAW OF TRADE MARKS, UNFAIR COMPETITION, COMPANY NAMES AND TRADING STYLES 55 (3d ed. 1986).

²⁹ See Trade Marks Act 1963 (Act No. 9/1963), § 2(1) (Ir.). Note that the word "distinctive" in this definition was deleted via an amendment made in 1971.

³⁰ See *id.*, § 10(3).

³¹ Note that this ground of objection in § 10(11) applies not only to a container, but also to the shape, configuration, color, or pattern of goods. Note also that § 10(5) of the Trade Marks Act 1993 prohibits registration of a mark that "consists exclusively of the shape, configuration, colour of goods where such shape, configuration, colour is necessary to obtain a specific technical result, or results from the nature of the goods."

³² *Die Bergkelder Beperk v. Vredendal Koop Wynmakery* 2006 (4) SA 275 (SCA) (S. Afr.).

³³ *Id.*, § 11.

³⁴ *Triomed (Proprietary) Ltd. v. Beecham Grp. Plc* [2001] FSR 34 (SCA) (S. Afr.).

Africa expunged this registration on various grounds,³⁵ including the ground in section 10(11). On the latter, the High Court said:³⁶

[A] monopoly in the shape in question would clearly limit developments in the pharmaceutical industry. . . . It would grant a monopoly on the features of a shape which *give substantial value to the goods themselves*. The more functional a shape, the more likely it is or will become that a monopoly over that shape would be likely to limit the development of an industry.

Anyone familiar with the current position in the European Union (see Section III of this chapter) would immediately recognize the italicized words in this passage: this is the Substantial Value Provision in Article 3(1)(e)(iii) of the EU Trade Marks Directive. It would appear that the qualified ban in South Africa and in Canada, worded in terms of protecting “the development of any art or industry,” is in effect the same as the qualified ban in the EU. It is now time to return to the United Kingdom.

The United Kingdom implemented the provisions in the EU Trade Marks Directive when it enacted the Trade Marks Act 1994 (UK 1994 Act), which repealed the UK 1938 Act. The UK 1994 Act provides that a trademark may consist inter alia of “the shape of goods or their packaging,” and in so doing, abrogated the reasoning in *Coca-Cola (UK)* that a container could never qualify as a “mark.” The concerns raised by the Goschen Committee are now addressed by the Substantial Value Provision, which is found in section 3(2)(c) of the UK 1994 Act.³⁷ The connection between this provision and design law was first made by the Court of Appeal in *Philips Electronics NV v. Remington Consumer Products Ltd.* when it said that section 3(2)(c) was intended to exclude “aesthetic-type shapes”³⁸ from the trademark regime. The court reasoned that shapes which were designed to “appeal to the eye”³⁹ – this is a term associated with registered design law⁴⁰ – were more properly protected as registered designs or protection of the like (in particular, copyright).

Just like in Canada and South Africa, the Substantial Value Provision in the United Kingdom does not bar the registration of a shape as a trademark merely because the shape was previously (or is still) protected by design rights. This was made clear in the UK Government’s 1990 White Paper on *Reform of Trade Marks Law*:⁴¹

The fact that a shape is protectable or has been protected by a registered design or by copyright does not itself mean that it should not be registrable as a trade mark (many ordinary two-dimensional marks are so protected). The question is one to be determined by the facts of the case – does the shape serve primarily to distinguish it from rival products or (to turn the question around) would the main motive of a competitor in using that shape be to mislead purchasers so to its origin.

³⁵ The other grounds were the following: lack of distinctiveness and the functionality objection in § 10(5) (see *Die Bergkelder Beperk* 2006 (4) SA at 275).

³⁶ *Triomed (Propriety) Ltd.* [2001] FSR at [83]. This ruling was upheld by the Supreme Court of Appeal: see [2003] FSR 27 at [30].

³⁷ The UK version refers to “adds substantial value to the goods,” but this difference is immaterial.

³⁸ *Philips Electronics NV v. Remington Consumer Prods. Ltd.* [1999] RPC 809 (CA) 822.

³⁹ *Id.*

⁴⁰ See Registered Designs Act 1949, 12, 13 & 14 Geo. 6 c. 88, § 1(3) (UK) (the features of the design of the article must “appeal to and are judged solely by the eye”). Note that this is no longer a registration criterion: it was removed via the Registered Designs Regulations 2001, No. 3949 (UK).

⁴¹ DEPARTMENT OF TRADE AND INDUSTRY, REFORM OF TRADE MARK LAW, Cm. 1203, § 2.21. This White Paper examined the position under the UK 1938 Act and recommended that the law be amended to allow registration of shape marks, provided that there be safeguards like the Substantial Value Provision in the new law.

The UK courts have also adopted this approach. For example, in *Julius Sämaan Ltd v. Tetrosyl Ltd.* the High Court cautioned that the focus on the inquiry must not be on whether the shape was protectable by design law, but rather on whether the shape added *substantial* value to the goods.⁴² In *The London Cab Corp. Ltd. v. Frazer-Nash Research Ltd.*, the Court of Appeal even went so far as to cast doubt on the relevance of “the presence or availability of design protection in fact” in this inquiry.⁴³

The shift in position in the United Kingdom from “absolutely no second bite of the cherry” to “no second bite of the cherry only in certain cases” was followed in due course by some other common law jurisdictions. For example, when India,⁴⁴ Hong Kong,⁴⁵ and Singapore,⁴⁶ were updating their trademark legislation in the late 1990s and early 2000s, they decided to have the Substantial Value Provision in their new laws.

C No Specific Ban on Registering the Design as a Trademark – It Could Be a Different Cherry

Not all common law jurisdictions followed in the footsteps of the United Kingdom. The interesting examples in this group are Australia and New Zealand. Both these countries considered but decided against having the Substantial Value Provision.

In the case of Australia, it had for a very short period the Trade Marks Act 1994, which contained specific bans on the registration of the natural shapes of goods and functional shapes.⁴⁷ But this legislation was never brought into force. Less than a year after receiving assent, it was repealed and replaced by the Trade Marks Act 1995.⁴⁸ The specific bans in the 1994 version do not appear in the 1995 version. Their absence has been explained in this way: specific bans on the registration of the natural shapes of goods and functional shapes are

⁴² *Julius Sämaan Ltd. v. Tetrosyl Ltd.* [2006] FSR 42 at [99]. In another part of its judgment, the High Court also noted that “merely because consumer products are designed to have an attractive appearance does not mean that their shape adds *substantial* value to the goods” (*id.* at [103]).

⁴³ *The London Cab Corp. Ltd. v. Frazer-Nash Research Ltd.* [2018] FSR 7 at [76]. The Court of Appeal made this observation in relation to the High Court’s finding that the registered shape mark in question (the shape of a motor vehicle) offended the Substantial Value Provision. The High Court had taken into consideration *inter alia* the fact that there was a design registration for this shape (which had not expired). For the High Court’s decision, *see* [2016] EUR. TRADE MARK REP. 20.

⁴⁴ Trade Marks Act, No. 47 of 1999, INDIA CODE (1999), vol. § 9(3)(c).

⁴⁵ Trade Marks Ordinance, (2003) Cap. 559, § 11(3)(c) (HK). *See Re Movado Watch Co. SA*, [2003] 2 HKC 83, where the Hong Kong Trade Mark Registry activated the Substantial Value Provision to reject an application to register the three-dimensional watch face of the MOVADO wrist watch. The design of this watch face, comprising a thick piece of metal black disc with a small concave circle in the 12 o’clock position, is part of the collection of many museums such as the Museum of Modern Art in New York.

⁴⁶ Singapore Trade Marks Act 1998, § 7(3)(c). *See Société Des Produits Nestlé SA v. Petra Foods Ltd.* [2014] SGHC 252, where the Substantial Value Provision was considered for the first time by a Singapore court. The shape in this case was the rectangular slab shape of the KIT KAT chocolate bar. The High Court of Singapore held that the fact that a shape added eye appeal to the product was not sufficient to bar (pun intended) the shape from registration. The Substantial Value Provision would apply only if the evidence showed that the shape was “of such appeal that it would be improper for a trader to monopolise it for an indefinite amount of time” (*id.* at [142]). Such evidence was lacking in this case. Note, though, that the High Court found that the shape of the KIT KAT chocolate bar offended the functionality prohibition in § 7(3)(b) (the shape is “necessary to obtain a technical result”), as well as lacking in distinctiveness. The trademark registration of this shape was expunged on these grounds. The High Court’s findings on these two grounds were upheld by the Court of Appeal: *see* [2017] 1 SLR 35. There was no appeal on the High Court’s finding on the Substantial Value Provision.

⁴⁷ Trade Marks Act 1994 (Cth) § 39 (Austl.) (No. 156 of 1994 which received Royal Assent on Dec. 13, 1994). These bans apply to shapes of goods as well as “other characteristics” of the goods.

⁴⁸ The repeal was made by Trade Marks Act 1995 (Cth) § 5 (Austl.), which came into force on Oct. 17, 1995.

“unnecessary” because these shapes would fail the distinctiveness criterion anyway.⁴⁹ Conspicuously missing from the Australian scene is the Substantial Value Provision. Clearly, the policy makers in Australia are much less (if at all) troubled by the prospect of shapes being protected first by design law and then by trademark law. They are content to leave the matter to be determined solely by the distinctiveness criterion. The Australian position may be rationalized in this way: where a shape previously protected by design law has become distinctive of the design proprietor’s goods, the shape is in fact a *different* cherry from the subject matter of the design registration. Thus, granting trademark protection for this shape does not amount to giving the design proprietor a second bite of the same cherry. Rather, the proprietor is being rewarded for having created a different cherry through use and promotion of the shape.

In New Zealand’s case, it decided to follow the Australian approach rather than the UK approach.⁵⁰ There are thus no specific bans on registration of shapes in the New Zealand Trade Marks Act 2002. Originally, the bill contained bans on registering natural shapes of goods, functional shapes, and shapes that add substantial value to the goods.⁵¹ These bans were deleted on the recommendation of the Commerce Committee tasked to scrutinize the bill. Two reasons were given by this select committee: first, case law (presumably decisions from the United Kingdom and the Court of Justice of the European Union (CJEU)) has shown difficulty in the application of these bans; and second, these bans might “unduly restrict and prevent registration of shapes that are distinctive.” The second reason is almost diametrically opposite from the position taken by the Goschen Committee: whereas the Goschen Committee regarded distinctiveness as irrelevant, the Commerce Committee regarded distinctiveness as the all-important consideration.

III A PERSPECTIVE FROM THE CIVIL LAW WORLD

In the civil law world, ornamental shapes can be protected by copyright and/or design rights. In France, for instance, the principle of the unity of art (*unité de l’art*) dictates this double protection.⁵² A similar situation exists in the Benelux. However, there are some countries that have made it very hard to cumulate the copyright and design protection for such shapes, either by having a higher threshold of originality (e.g., Germany, Portugal, and current Italian law) or a requirement of separability (e.g., Italy before it changed its copyright law in 2001⁵³). There is no uniformity in how civil law countries approach this particular interface, even in the EU, as

⁴⁹ *Koninklijke Philips Elecs NV v. Remington Consumer Prods Ltd* (2000) 177 ALR 167, [15] (Austl.). See also *Kenman Kandy Australia Pty Ltd v. Registrar of Trade Marks* (2002) 122 FCR 494, [43] (Federal Court of Australia) (where the court said that these specific bans were “otiose” in the light of the distinctiveness criterion).

⁵⁰ Commerce Committee, Commentary on Trade Marks Bill 2001 (142-1), 4 (NZ) (“We recommend adopting the Australian approach, which does not make any specific provision for shape trade marks, but rather relies on the general distinctiveness test”).

⁵¹ See Trade Marks Bill 2001 (142-1), cl. 18(1) (NZ).

⁵² In the past, this principle meant that the cumulation was total in the sense that if the conditions of copyright were met, design protection was automatically granted and vice versa. Now cumulation only exists if the conditions of each right are met. This was stated in germ in Cour de cassation [Cass.] [supreme court for judicial matters] crim., Dec. 13, 2011, 2012 Propriété Intellectuelle Bulletin Documentaire, III, 180 (Fr.), and has been more clearly stated in Cour de cassation [Cass.] [supreme court for judicial matters] com., Mar. 29, 2017, <https://legifrance.gouv.fr/affichJuriJudi.do?oldAction=rechJuriJudi&idTexte=JURITEXT000034345512&fastReqId=1171443833&fastPos=1>. Thus the cumulation is full rather than total. On terminology, see ESTELLE DERCLAYE, *Introduction, in THE COPYRIGHT/DESIGN INTERFACE: PAST, PRESENT AND FUTURE* 1 (2018).

⁵³ See Decreto Legislativo 2 febbraio 2001, n. 95, art. 22, in GU Apr. 4, 2001, n. 79 (It.) (implementing Directive 98/71/EC on the Legal Protection of Designs) (entered into force on Apr. 19, 2001).

Article 17 of the Design Directive left this issue unharmonized except to say that cumulation must be possible. In September 2019, the CJEU put an end to this lack of uniformity by deciding that all works of applied art/industrial designs must gain copyright protection like other works, at the normal level of originality, which is as the author's own intellectual creation.⁵⁴ The matter is now therefore fully harmonized in the European Union.

In addition to copyright and design rights protection, it is also possible to protect some ornamental shapes by trademark law in the EU. The second approach outlined in Section II for the common law world applies; namely, there is a qualified ban on trademark registration of the shape – that is, trademark protection is forbidden only in certain cases, as will be seen below.

This section will thus examine how EU law has interpreted this rule and how some of its member states have dealt with the overlap for the area of the overlap that EU law has not harmonized. The section will envisage the two types of overlaps: concurrent (the two or three Intellectual Property (IP) rights subsist on the object they protect at the same moment in time) and subsequent (one or more IP rights “prolong” the previous IP right which has expired).

The possibility of an overlap between a trademark right and a design right (whether registered or not) and/or a copyright is easy to see because design rights and copyrights are concerned with the appearance of a product or work, be it two- or three-dimensional, and these products or works can be shape marks. In addition, in the EU, a three-dimensional work or design can be distinctive as well as original and/or novel and can have individual character.

That said, EU law has a rule (Article 4(1)(e)(iii) of the Trademark Directive (TMD) and the corresponding Article 7(1)(e)(iii) of the EU Trademark Regulation (EUTMR)) which prohibits the trademark protection of signs that consist exclusively of the shape, or another characteristic,⁵⁵ which give substantial value to the goods. The provision reads:

Article 4 – Absolute grounds for refusal or invalidity

1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

(e) signs which consist exclusively of: . . .

(iii) the shape, or another characteristic, which gives substantial value to the goods.

The exclusion, which applies even if the shape or other characteristic has acquired distinctiveness, regulates the trademark/copyright overlap as well as the trademark/design overlap. As the EU courts held in *Bang & Olufsen*⁵⁶ (speakers) and *Hauck*⁵⁷ (the Tripp Trapp children chair), the substantial value of a good can be its beauty, but also other aspects such as safety, comfort, and quality. In a later decision, a European Union Intellectual Property Office (EUIPO) Board found the trademark for Eames' Lounge chair invalid, stating that “[w]here an item has become a “style icon” . . ., it must have substantial value.”⁵⁸ In a case dealing with the iconic Louboutin shoes' red soles, the CJEU held that “a sign consisting of a color applied to the sole of a high-heeled shoe, such as that at issue in the main proceedings, does not consist exclusively of a ‘shape’.”⁵⁹ In a later case dealing with a mark showing drawings of Manhattan registered for

⁵⁴ Case C-683/17, *Cofemel – Sociedade de Vestuário SA v. G-Star Raw CV* (Sept. 12, 2019). All decisions from the courts of the European Union are available at CURIA, <https://curia.europa.eu>.

⁵⁵ The words “or another characteristic” were added when the directive was amended in 2015. Such other characteristics can include two-dimensional aspects.

⁵⁶ Case T-508/08, *Bang & Olufsen v. Office for the Harmonisation in the Internal Mkt.*, 2011 ECR II-06975, [2011] Eur. Trade Mark Rep. 10, § 77.

⁵⁷ Case C-205/13, *Hauck v. Stokke*, 2014 EUR-Lex CELEX LEXIS 2233, §§ 29–32, 35–36 (Sept. 18, 2014).

⁵⁸ Case R-664/2011-5, *Vitra Collections v. European Union Intellectual Property Office*, § 42 (Mar. 18, 2015), <https://euipo.europa.eu/ohimportal/en/research-case-law>.

⁵⁹ Case C-163/16, *Christian Louboutin SAS v. Van Haren Schoenen BV* (June 12, 2018).

a range of goods such as napkins, bags, wallpaper, glassware, and books, the CJEU similarly held that “a sign such as that at issue in the main proceedings, consisting of two-dimensional decorative motifs, which are affixed to goods, such as fabric or paper, does not ‘consist exclusively of the [sic] shape’.”⁶⁰

There has been extensive EU case law on subsection (ii) of Article 4(1)(e), which concerns signs that consist exclusively of the shape, or another characteristic, of goods that is necessary to obtain a technical result. Therefore, the shape of the Philips three-headed electric shaver,⁶¹ of the Lego brick,⁶² and of the Rubik cube⁶³ have all been held unregistrable as a trademark in the EU. On the other hand, the shape of the Lego manikin was registrable.⁶⁴ Even if the feet and hands can be connected to other elements, and thus can be said to serve a technical function, they are not the essential parts of the mark, which consists of the shape of the entire manikin.⁶⁵ Whereas there has been less litigation on subsection (iii), the EU courts have nonetheless held that both indents “reflect the *legitimate aim* of not allowing individuals to use registration of a mark in order to *acquire or perpetuate* exclusive rights relating to technical solutions.”⁶⁶ EU case law thus prohibits both the concurrent and the subsequent overlap.

French courts have held several shape marks valid, stating that the subsection (iii) exclusion (as implemented in the French Intellectual Property Code) did not apply. For instance, the court of appeal of Paris accepted the validity of a mark in the shape of a vine shoot for chocolate because chocolate is meant primarily to be eaten and consumers first seek the quality of the product’s taste before its attractive shape.⁶⁷ The court of appeal of Bordeaux held valid a mark in the shape of a perfume bottle holding that “the shape . . . must not be ‘essentially the reason of the consumer’s purchase,’ that in the field of perfumes, the consumer is generally first interested in the smell of the product and not in the shape of the bottle” and, in this case, the substantial value of the product “result[ed] from the properties including the colours of the product itself, not its packaging.”⁶⁸

In addition to the ban on registering signs consisting exclusively of shapes that give substantial value to the goods, the EU courts have treated shape marks, including packaging, less favorably in terms of distinctiveness because consumers do not generally perceive them as an indication of

⁶⁰ Case C-21/18, *Textilis Ltd, Ozgur Keskin v. Svenskt Tenn AB* (Mar. 14, 2019).

⁶¹ Case C-299/99, *Koninklijke Philips Elecs. NV v. Remington Consumer Prods. Ltd.*, 2002 ECR I-05475.

⁶² Case T-270/06, *Lego Juris v. OHMI-Mega Brands (Brique de Lego rouge)*, 2008 ECR II-03117; Case C-48/09 P, *Lego Juris A/S v. Office for Harmonisation in the Internal Mkt. (OHIM)*, 2010 ECR I-08403.

⁶³ Case C-30/15 P, *Simba Toys GmbH & Co. KG v. European Union Intellectual Prop. Office*, <http://curia.europa.eu/juris/liste.jsf?language=en&jur=C,T,F&num=C-30/15%20P&td=ALL>.

⁶⁴ Case T-395/14, *Best-Lock (Eur.) Ltd. v. Office for Harmonisation in the Internal Mkt.*, 2015 EUR-Lex CELEX LEXIS 380 (June 16, 2015).

⁶⁵ *Id.*, § 33.

⁶⁶ Case C-299/99, *Koninklijke Philips Elecs. NV v. Remington Consumer Prods. Ltd.*, 2002 ECR I-05475, § 82 (emphasis added) (shape of the three-headed Philips electric razor). See also Case T-270/06, *Lego Juris v. OHMI-Mega Brands (Brique de Lego rouge)*, 2008 ECR II-03117; Case C-48/09 P, *Lego Juris A/S v. Office for Harmonisation in the Internal Mkt. (OHIM)*, 2010 ECR I-08403 (shape of the Lego brick); Case T-508/08, *Bang & Olufsen v. Office for the Harmonisation in the Internal Mkt.*, 2011 ECR II-06975, [2011] Eur. Trade Mark Rep. 10, §§ 64–66 (in relation to indents (ii) and (iii)); Case C-205/13, *Hauck v. Stokke*, 2014 EUR-Lex CELEX LEXIS 2233, § 31 (Sept. 18, 2014) (in relation to indent (iii)).

⁶⁷ Cour d’appel [CA] [regional court of appeal] Paris, Jan. 30, 2009, 07/12419, *Propriété Intellectuelle Bulletin Documentaire* 2009, III, 1053 (Fr.), *aff’d*, Cour de cassation [Cass.] com., Oct. 26, 2010, 2011 RTDcom 326, obs. Jacques Azéma (Fr.); *Propriété Intellectuelle Bulletin Documentaire* 2010, III, 823; PIDB 2011, 30, obs. Pascale Tréfigny-Goy (Fr.).

⁶⁸ Cour d’appel [CA] [regional court of appeal] Bordeaux, 1e ch., Nov. 5, 2015, 1400502 (translation by the author).

origin, and therefore the overlap is also curtailed this way.⁶⁹ In France, however, the courts are a little less strict than the EU courts on the application of this rule.⁷⁰ The overall result is that the overlap is reasonably curtailed, and some ornamental shapes are registrable but not many.

The other area harmonized at EU level concerning the overlap between trademark rights, design rights, and copyrights relates to exhaustion of the said rights. EU case law prevents the holder of a copyright and trademark on a product using copyright to block the resale of the product, the trademark right of which has been exhausted by the trademark holder's putting the product on the market. In *Dior v. Evora*,⁷¹ the CJEU held that when copyright forbids the reproduction of a work "attached" to a trademarked good or service (i.e., commercialized as such by the trademark owner) but there is no trademark infringement, copyright law cannot trump the free movement of goods or services which would have prevailed if trademark law had been exclusively applicable. Accordingly, the freedom of movement of goods and services includes the freedom to resell goods but also to bring to the public's attention the further commercialization of those goods (e.g., via advertisement), unless such use of the trademark (or goods) for this purpose seriously damages the reputation of the trademark (or goods).⁷² The *Dior* decision set out a rule that in this situation, copyright law must yield before the EU principle of freedom of movement of goods and services. The case involved genuine Dior perfumes bought for resale by a discount store. In order to advertise the perfumes, the discount store had to reproduce the packaging and bottles on its advertisements. The trademark right was exhausted, and Dior tried to use its copyright in the shape of the perfume bottles and their packaging to prevent the trader from reselling the perfumes. The CJEU would most likely rule the same if it was not copyright but a design right which was invoked to block the resale.

Besides these two rules, EU law does not regulate the concurrent overlap between copyright/design rights on the one hand and trademark rights on the other. So for the few ornamental shapes which can benefit from the two or three rights, most member states have no rules regulating the overlap in relation to ownership, rights, dealings, infringement, and exceptions. Thus, regime clashes occur at those levels as there is not much convergence on these points between the three intellectual property rights (IPRs). When there is no convergence, the stricter regime prevails over the other. For instance, in most countries, because the basic requirements for infringement are the same owing to international conventions and basic principles in the two rights, copyright and design law will override the limitations of trademark law (principle of specialty, use in the course of trade, and requirement of confusion in some cases) and trademark law will override the limitations of copyright and unregistered design law (requirement of copying). So, for instance, if a product is protected by both trademark and design rights, and the infringing product is not an identical or similar product, because of trademark law's principle of specialty, the trademark will not be infringed; but under design law, such principle does not apply, so the design could be infringed. Similarly, design law does not require confusion whereas trademark law does, so if the trademark is not infringed (because it is not a famous trademark, the goods or marks are not identical, and the confusion test is required), the

⁶⁹ See Joined Cases C-53–55/01, *Linde AG, Winward Indus. & Rado Watch v. DPMA*, 2003 ECR I-03161. See also Anette Kur, *Too Common, Too Splendid, or "Just Right"? Trade Mark Protection for Product Shapes in the Light of CJEU Case Law* (Max Planck Institute for Innovation and Competition Research Paper No. 14-17, 2014); Case C-218/01, *Henkel KGaA*, 2004 ECR I-01725, § 49.

⁷⁰ See Alain Berthet & Elisabeth Berthet, *La Marque Tridimensionnelle : Mythe ou Réalité?*, *PROPRIÉTÉ INTELLECTUELLE BULLETIN DOCUMENTAIRE* 413 (2016).

⁷¹ Case C-337/95, *Parfums Christian Dior SA & Parfums Christian Dior BV v. Evora BV*, 1997 ECR I-6013.

⁷² *Id.*, §§ 48, 59.

design may still be infringed as confusion is not required in the design infringement test. Trademark law does not require copying for infringement to be found, but under unregistered design law and copyright, copying is required. Private uses are not all exempted in copyright law, but they are all outside the scope of trademark law. The owner of the rights therefore gets the best of both worlds.

Similarly, in the EU and its member states, there are no exceptions in trademark law except under Articles 5(3)(a) and 10(2)(c) of the TMD (use with due cause of an identical or similar trademark with reputation on dissimilar goods and by extension on identical or similar goods⁷³). Therefore, if a copyright exception applies, but the use is of an identical mark without reputation on identical goods, the trademark regime will trump the copyright regime. This has happened in France in relation to some parodies. The character Titi Fricoteur was not held to infringe the copyright in Bibi Fricotin, but was held to infringe the trademark right.⁷⁴ However, other French courts have allowed the two rights to converge in cases involving parodies. For instance, in a case parodying the ESSO trademark with the symbol “E\$\$\$O,” use of the trademark was held not to infringe copyright (the parody exception was applicable) or trademark law.⁷⁵ In Germany, where there is no case law, the fundamental rights to freedom of the arts (Article 5(3) of the constitution) and freedom of speech (Article 5(1) of the constitution) are the two bases for the development of similar results in both trademark and copyright law.

As to designs, there is some convergence as both trademark and design laws allow private use/ use for non-commercial purposes. But the three other exceptions allowed under design law (acts done for experimental purposes; acts of reproduction for the purposes of making citations or of teaching; and transit of aircraft and ship equipment embodying design infringements, including importation of equipment for repairs and execution of such repairs on the equipment of such aircrafts and ships in transit) will be trumped by the trademark regime at least in double or single identity cases (i.e., cases where the trademarks and the goods of the claimant and defendant are identical, and cases when either the trademark or the goods of the defendant are identical to those of the claimant). Also, a trademark will generally be more easily infringed than a design. This is because the design law test (informed user) is stricter than the trademark law test (average consumer). The case law has interpreted the informed user as a person who is more observant than the average consumer and who will therefore pay more attention to the differences than to the similarities between designs.

For ornamental shapes which are not caught by Article 4(1)(e)(iii)’s ban, since an EU or a national trademark right is renewable *ad infinitum* provided it remains used and does not lose distinctiveness, a subsequent overlap subsists when the copyright or design right in the creation eventually expires. But conversely, if a trademark right expires (i.e., if it is not renewed every ten years in the EU (Article 48 of TMD) or if it has not been used for a period of five continuous years (Article 16 of TMD)) or is no longer distinctive, copyrights or registered design rights still subsist until they expire. The first scenario is more common. While the subsequent overlap is implicitly allowed, the way countries deal with it differs quite a lot.

⁷³ Case C-292/00, *Davidoff & Cie SA & Zino Davidoff SA v. Gofkid Ltd.*, 2003 ECR I-389.

⁷⁴ Cour d’appel [CA] [regional court of appeal] Paris, July 12, 1993, cited by VALERIE LAURE BENABOU, *Les Rapports entre Droit d’Auteur et Droit des Marques et de la Concurrence Déloyale, Rapport National, France*, in *ADJUNCTS AND ALTERNATIVES TO COPYRIGHT, PROCEEDINGS OF THE ALAI CONGRESS, JUNE 13–17, 2001, NEW YORK USA 12* (Jane Ginsburg & June Besek eds., 2002).

⁷⁵ Cour d’appel [CA] [regional court of appeal] Paris, [2006] Eur. Trade Mark Rep. 53. See also Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, Aug. 2, 2002, *aff’d*, Cour d’appel [CA] [regional court of appeal] Paris, [2003] Eur. Trade Mark Rep. 870. However, the Cour d’appel held that Greenpeace was liable in tort for denigration of the mark (because it had added a symbol of death (skull) to it).

In France and Germany, courts are divided on the issue. Some French courts allow registration of a copyright work as a trademark when the copyright has expired,⁷⁶ while some do not.⁷⁷ In the *Mona Lisa* case, the German Federal Patents Court did not allow the overlap for a famous copyright work (Leonardo da Vinci's *Mona Lisa*) because the more famous it is, the less likely it would be distinctive.⁷⁸ In the *Marlene Dietrich* case, the German Federal Court of Justice held that distinctiveness can sometimes subsist even if the person, in this case Marlene Dietrich, is famous.⁷⁹

A decision by the Court of Justice of the European Free Trade Association States (EFTA Court) has shed some light on this issue.⁸⁰ This case concerned applications to register as trademarks the works of the Norwegian artist Gustav Vigeland. After Vigeland's works fell into the public domain in January 2014, the Municipality of Oslo filed applications for registration as trademarks of signs consisting of over one hundred visual works and sculptures by him. The Norwegian Patent Office refused most of the applications on the ground of lack of distinctiveness. The Norwegian Board of Appeal for Industrial Property Rights, before which the appeal was filed, requested an Advisory Opinion before the EFTA Court. The key question was whether a work that is in the public domain under copyright law is eligible for trademark protection. The Court recalled that Articles 4(1)(b)–(e) of the Trade Mark Directive do not entirely guarantee that a sign remains free to use, and therefore that a work remains in the public domain. However, it noted that in some cases it could be refused on the grounds of public policy set out in Article 4(1)(f) of the Trade Marks Directive. It held that it would be the case “for example, under the circumstances that its registration is regarded as a genuine and serious threat to certain fundamental values or where the need to safeguard the public domain, itself, is considered a fundamental interest of society.” It added that “there would be no threat to the need to safeguard the public domain resulting from works that were primarily created to serve as signs to be registered as trade marks.” On remand, the Norwegian Trademark Board of Appeal held that the works of Vigeland were not registerable because by applying to register virtually all

⁷⁶ See Cour de cassation [Cass.] [supreme court for judicial matters], Jan. 13, 1904, [1904] *Annales de Propriété Industrielle* 26, cited by PIERRE-YVES GAUTIER, *PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE* 467 (6th ed. 2007) (a drawing or photograph can in general, even if they have fallen in the public domain as artistic works, constitute a trademark, albeit an old *obiter dictum*); Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Paris, Mar. 20, 1975, [1976] *Annales de Propriété Industrielle* 55; Cour d'appel [CA] [regional court of appeal] Paris, July 6, 1989, [1990] *Propriété Intellectuelle Bulletin Documentaire*, III, 112, cited by Benabou, *supra* note 74.

⁷⁷ See Christophe Caron, *L'Empilement des Propriétés Intellectuelles: Le Droit d'Auteur ne Chasse pas la Marque*, 6 *COMMUNICATION COMMERCE ELECTRONIQUE* (June 2006) (citing Cour d'appel [CA] [regional court of appeal] Besançon, June 5, 1970, 1972 *Annales de Propriété Industrielle* 20, obs. Dusolier (refusing the protection of an architectural work as a trademark on the basis that one should not be able to appropriate for an unlimited time a shape which belongs to the public domain or has a vocation to fall into it)) (noting that some courts including the Court of Cassation have showed some hostility to the reappropriation by trademark law of the public domain of copyright); Cour de cassation [Cass.] [supreme court for judicial matters] com., Oct. 19, 1999, [2000] *Communication Commerce Electronique* 3; Cour d'appel [CA] [regional court of appeal] Paris, 4e ch., June 25, 1997, *Gaz. Pal.* 1998, *Somm.* 63 (“[O]ne cannot, because it diverts trademark rights from their aim, protect as a trademark the arrangement and interior decoration of a shop, which cannot be protected by copyright”). However, this decision may now contradict Case C-421/13, *Apple Inc. v. Deutsches Patent- und Markenamt*, 2014 EUR-Lex CELEX LEXIS 2070 (July 10, 2014).

⁷⁸ Bundespatentgericht [BPatGE] [Federal Patent Court], Nov. 25, 1997, *Gewerblicher Rechtsschutz und Urheberrecht* 1021, 1998 (Ger.) (*Mona Lisa* case).

⁷⁹ Bundesgerichtshof [BGH] [Federal Court of Justice], Apr. 24, 2008, *Gewerblicher Rechtsschutz und Urheberrecht* 1093, 2008 (Ger.) (*Marlene-Dietrich-Bildnis* case).

⁸⁰ Judgment of the EFTA Court, Case E-5/16 (Apr. 6, 2017). The EFTA court is the equivalent of the CJEU for the EFTA states. It is not bound by CJEU case law but often follows it. When the EFTA court interprets EU law, its decisions are therefore relevant to the CJEU and its member states, even if not binding on them.

the works in the park, the municipality was trying to prolong the copyright in the works and not attempting to use the works as sources of origin.⁸¹

IV CONCLUSION

How a country should handle the overlap of trademark protection and copyright/design protection for an ornamental shape of a product is not an immediately obvious one. As the exposition in this chapter has shown, various policy concerns arise for consideration. Some would argue against this overlap on the basis that there should be no “two bites of the same cherry.” On the other hand, it is also possible to argue that where the ornamental shape has been used and promoted in the course of trade to the point where it is functioning as the distinctive badge of origin of an undertaking, the proper regime for protecting this shape is that of trademark law. What this chapter also shows is that the policy choice to be made by the country on this issue is regardless of the legal tradition of a country, whether it is of the civil law or common law tradition.

⁸¹ For a discussion, see Jane Ginsburg, *Intellectual Property as Seen by Barbie and Mickey: The Reciprocal Relationship of Copyright and Trademark Law*, 65 J. COPYRIGHT SOC'Y USA 245 (2018).