19 Signs, surfaces, shapes and structures – the protection of product design under trade mark law

Alison Firth*

I. Introduction
Design law has sometimes been called the ‘Cinderella’ of intellectual property. Its territory lies in the border zones between patent law, copyright law and trade marks. It shares this space somewhat uncomfortably with unfair competition and passing off laws. Some years ago the most active border

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* Professor of Commercial Law at the University of Newcastle upon Tyne.
zone in terms of debate and commentary was probably that between copyright and design – and in particular whether copyright should be expelled from the areas occupied by design law. The areas between copyright, other rights and contract were considered by the Association Littéraire et Artistique at its 2001 Congress. Currently, the border between design law and trade marks/trade dress is attracting the attention of scholars, legislators and judges. This appears to have been caused by several factors. The first is a trend towards the use of non-verbal signs as trade marks for goods and services. Globalisation has encouraged this use of non-verbal signs, with their independence from linguistic differences. Of course, the perception of non-verbal signs, such as colours, may vary from culture to culture; consumer perception also depends upon the patterns of trade. Of these “non-traditional” marks the most “traditional” of them all is product design, but it is also the most problematic from a legal point of view because of overlap with utility patents, design patents, and design rights generally. Moves in Australia, Europe, and other jurisdictions towards granting design protection for technically functional design

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6 Naomi Klein, in No Logo (2000) has criticised the role of trade marks in assisting the ills of globalisation and capitalism; challenging this, Olins has suggested that brands act as a two-way conduit and enable consumers/citizens to influence companies (and their social policies) as well as vice versa. Wally Olins, Who’s Wearing the Trousers? The Economist, 6 September 2001. If this is correct then the spread of non-verbal marks may make this process available to a wider range of citizens.


exacerbates the conflict. The issues may also be triggered by failure to effect legislative change – Dinwoodie opines that a US judicial breakthrough on trade dress protection – the Two Pesos case – was not unconnected with the collapse of draft legislation to expand US protection of designs beyond the patent system to a copyright-type protection for ornamental designs.10

Relationships between the creative process, social change and the paradigms of intellectual property law have been charted by many scholars. Reichman has studied the boundaries between traditional intellectual property rights11 and explored alternative bases for liability.12 Suthersanen has pointed out the position of design law at the convergence of the scientific, artistic and industrial paradigms13. Drahos14 has charted the distinctions between physical commodities, abstract objects and legal rights.15 Lury16 has noted the shift from the cult of the author to the cult of the personality, a shift characterised as one from copyright to trade mark type protection.17 The expansion of trade mark rights from misrepresentation into misappropriation under dilution laws18 has been seen as a shift in the other direction, towards copyright-type

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18 Handler has suggested that allowing dilution claims only in respect of different products would resolve this problem in relation to product design. See Milton Handler, A Personal Note on Trademark and Unfair Competition Law before the Lanham Act (1996) 59 Law & Contemp Probs 5–11, cited in Graeme B Dinwoodie,
The protection of product design under trade mark law

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Lovelady has suggested “revealed preference”, a market/perception gauge, as an alternative model to copyright.

That trade marks carry quality and “lifestyle” messages as well as indications of origin is now well understood by the courts as well as brand gurus. However, in the context of product design, legislators and courts are holding on tight to the origin function of trade marks.

How should the law approach this kind of distinguishing sign? Dinwoodie has advocated a teleological approach, based upon the distinguishing function of trade marks. However, courts and legislators in many jurisdictions have clung to a per se exclusionary approach, at least in the case of technical functionality. This is especially the case in the European Union, where the rules on registration of shape marks have been construed strictly against trade mark applicants. Trade dress, which distinguishes service providers, has fared somewhat better, the US leading the way with franchising based on the architectural design of outlets and the Two Pesos


21 See, e.g. Advocate-General Ruiz-Jarabo Colomer of the European Court of Justice in Arsenal Football Club Plc v Reed [2003] RPC 9 ECJ at para A46 [emphasis added]:

It seems to me to be simplistic reductionism to limit the function of the trade mark to an indication of trade origin. The Commission, moreover, took the same view in its oral submissions to the Court. Experience teaches that, in most cases, the user is unaware of who produces the goods he consumes. The trademark acquires a life of its own, making a statement, as I have suggested, about quality, reputation and even, in certain cases, a way of seeing life.

22 Such as Wally Olins, deviser of the ORANGE brand for mobile telephony.


24 See Jerome Gilson & Anne Gilson Lalande, Cinnamon Buns, Marching Ducks and Cherry-scented Racecar Exhaust: Protecting Non-traditional Trademarks (2005) 95 TMR 771 at 813–16 and citations. For an intriguing view of the fairground origin of many early franchise designs, see Barbara Rubin, Aesthetic Ideology and Graeme B. Dinwoodie and Mark D. Janis - 9781848441316 Downloaded from Elgar Online at 04/12/2019 01:56:02AM via free access
case. Under European law, trade dress for services is not excluded from trade mark registration. However, unlike in the US, architectural design has enjoyed scant trade mark recognition in the UK and Europe in general.

II. Shape marks – legislation

A. European Community law on designs and trade marks

In Europe, Directive 98/71/EC on the legal protection of designs harmonised the law of Member States relating to registered designs. It expanded eligible subject-matter beyond the traditional sphere of aesthetic or ornamental design to embrace design in the wider sense, with a very limited exclusion for technical designs where design freedom is effectively absent. Echoing the position in many Member States of the EU, the Directive was remarkably liberal about overlap and cumulation of rights. Art 16 states that its provisions shall be without prejudice to any provisions of Community law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability or unfair competition, whilst Art 17 allows cumulation with copyright. The Community Design Regulation used the same criteria for protection and added the copyright-style Unregistered Community Design, conferring three-year protection from copying to eligible designs.
The shape of goods or their packaging as a class of sign suitable for protection by trade mark registration has been recognised Europe-wide since the promulgation of the Trade Mark Harmonisation Directive and its sister instrument the Community Trade Mark Regulation. The Directive has been implemented in all Member States of the European Union, either by copy-out legislation or by more traditional Parliamentary drafting at national level. Drafts of these pieces of legislation contributed to the drafting of the WTO TRIPs agreement. Probably for this reason, a number of states outside the European Union have followed EC legislation and case law, or that of its Member States.

Burrell, Beverly Smith and Coleman identify a number of causative factors which may have led to the provisions on shape marks:

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This can cause problems of interpretation; national courts often refer directly to the provisions of the European legislation, see, e.g. Boehringer Ingelheim KG v Swingward Ltd [2004] EWCA Civ 129; [2004] 3 CMLR 3, [2004] ETMR 65 (Eng CA).

For drafting history, see Daniel Gervais (2003), The TRIPS Agreement: Drafting History and Analysis; see also Christopher Wadlow, Including trade in counterfeit goods: the origin of TRIPS as a GATT anti-counterfeiting code [2007] IPQ 350.

See, eg, Mike Reynolds’ presentation, Evolution of EC and UK Case Law: Relevance to HKSAR, available at http://www.ipd.gov.hk/eng/trademarks.htm (Hong Kong). In Triomed (Pty) Ltd v Beecham Group Plc [2003] FSR 27 the Supreme Court of Appeal in South Africa applied the decision of the European Court of Justice in Case C-299/99 Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC 2, ECJ as regards the technical functionality of the tablet shape in issue and as to distinctiveness. Relevant provisions were s 10(5) and 10(11), South African Trade Mark Act which exclude the “shape, configuration, colour or pattern” of goods which are “necessary to obtain a specific technical result” or “result from the nature of the goods themselves”, or are “likely to limit the development of any art of industry”.

For example, Hong Kong trade mark law is now independent of UK law but follows UK and EC jurisprudence. Examples may be found in the Examination Manual and decisions at http://www.ipd.gov.hk/eng/trademarks.htm.

In Unilever’s application (Taco shaped ice cream) available at http://www.ipd.gov.hk/eng/intellectual_property/trademarks/trademarks_decisions/decision/DEC199801908R.pdf, the Hong Kong Registry refused the application on technical functionality grounds, referring to UK and EC case law but giving no weight (in the absence of the relevant decisions) to the fact that the mark had been registered in New Zealand, Australia and the UK.

the tendency of EC legislation to harmonise rights coupled with the fact that shapes of products and their packaging were protected in a number of Member States;
• evidence of consumer recognition that shapes could be distinctive as to origin; the European courts have, however, been sceptical about this;
• an expanded view of trade mark function as extending beyond origin to quality;
• protection of the advertising or merchandising function of distinctive shapes.

Burrell et al regard the exclusion from registration in these legislative texts for ‘natural’, functional and aesthetically valuable shapes as not providing sufficient safeguard. Although those authors stopped short of recommending repeal of the provision allowing registration of shape marks, it appears that at least for product shapes conferring technical advantage or non-trade-mark value (usually aesthetic value and in any event not merely brand premium), the European courts have shown great strictness in excluding functional shapes from protection – as suggested by the structure and wording of the provisions, the exclusions are applied without any alleviation for distinctiveness for both technical and aesthetic product shapes. Unlike with the design laws, the fact that the technical effect could be achieved by another shape does not save the mark from exclusion.

The text relevant to shape marks appears at Arts 2 and 3 of the Trade Mark Directive. Art 2 would appear at first glance to support a teleological interpretation:

2. Signs of which a trade mark may consist

A trade mark may consist of any sign capable of being represented graphically, particularly . . . the shape of goods or their packaging, providing such signs are capable of distinguishing the goods and services of one undertaking from those of other undertakings.

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37 Art 295 of the EC Treaty provides that it is without prejudice to national systems of property ownership, which discourages the legislator from diminishing intellectual property rights.
However, Art 3 listing the so-called “absolute grounds” for refusal or invalidity\(^{40}\) states

3. Grounds for refusal or invalidity
1. the following shall not be registered or if registered shall be liable to be declared invalid:

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\begin{align*}
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(e) signs which consist exclusively of:
– the shape which results from the nature of the goods themselves,\(^{41}\) or
– the shape of goods which is necessary to obtain a technical result,\(^{42}\) or
– the shape which gives substantial value to the goods.

This suggests a categorical exclusion, regardless of distinctive character.\(^{43}\)

The first indent of Art 3(1)(e) applies to both the shape of goods and their packaging;\(^{44}\) the second refers only to the shape of the goods themselves. Burrell et al criticise this limitation.\(^{45}\) However, in Henkel KGAA v Deutsches


\(^{41}\) Sometimes called the “natural” shape, although this limb was argued in relation to VIENETTA ice cream – a highly artificial product. *Société des Produits Nestlé SA v Unilever Plc, Aka Unilever Plc’s Trade Mark Applications* [2003] ETMR 53; [2003] RPC 35. Burrell et al assert (p165) that this has been “interpreted out of existence”. Under Japanese trade mark law, Art 3(1)(3) prohibits the registration of marks indicating the shape of goods or packaging “in a common manner”, suggesting that this provision is designed to exclude generic shapes (Japanese TM law, translation thanks to (2007) 22 Yusara and Hara IP News 1).

\(^{42}\) Although an earlier patent would not be a bar to registration *per se*, it would be “virtually irrefutable” evidence of this: LEGO [2007] ETMR 11; European patents have no utility requirement as such, but must be capable of industrial application and are regarded as displaying non-obvious solutions to technical problems. European Patent Convention, Art 57. On the problem-solution approach, see George SA Szabo, *Letter re Paul Cole’s article* [1999] EIPR 42 and citations.


\(^{44}\) Of course the product and packaging may share the same distinctive (or non-distinctive) shape, e.g. TOBLERONE triangular chocolate bars. See Marie-Christine Janssens, *The “Toblerone”? Chocolate Bar Case In Belgium* [2004] EIPR 554.

\(^{45}\) Burrell et al. at 162.
Patent- und Markenamt, the European Court of Justice gave a wider interpretation of “shape of goods” for products, such as liquids, which necessarily take up the shape of their container. On a referral from Germany concerning the shape of a tall bottle for liquid wool detergent, the court held

(1) For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packaging thereof must be assimilated to the shape of the goods, so that that packing may constitute the shape of the goods within the meaning of Art.3(1)(e) of the First Council Directive 89/104 . . . and may, where appropriate, serve to designate characteristics of the packaged goods, including their quality, within the meaning of Art.3(1)(c) of that directive.

This ruling goes also to distinctiveness.

The third indent mentions only “shape” and again could refer to packaging as well as to the shape of goods.

The second indent relates to the technical functionality of the goods. In Philips v Remington the European Court of Justice held that the question of exclusion took precedence over any distinctiveness enquiry. Nor can the prohibitions of Art 3(1)(e) be avoided by registering a graphic mark showing the product rather than the shape itself. If the essential functional character-

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46 Case C-218/01 [2005] ETMR 45.
47 Which narrowed towards the top, with an integral handle, a small pouring aperture and a two-level stopper, which could also be used as a measuring cup.
49 In Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2003] RPC 2, the Court of Justice stated at [76]:

If any one of the criteria listed in Art.3(1)(e) is satisfied, a sign consisting exclusively of the shape of the product or of a graphic representation of that shape cannot be registered as a trade mark.

This was echoed by Jacob J in Philips v Remington in the English High Court, [1998] RPC 283 at 290:

Even though it is only a picture which is formally the subject of the registration, both sides, in my judgment rightly, treated it as a registration covering also a three-dimensional shape. It would be quite artificial to regard a straight picture of a thing, and the thing itself, as significantly different under a law of trade marks which permits shapes to be registered.

This issue was not explicitly dealt with on appeal and has been criticised by Burrell et al, supra. at n36.

In Nation Fittings (M) Sdn Bhd v Oystertec Pte [2005] SGHC 225; [2006] FSR 40 High Court of Singapore, it was ingeniously but unsuccessfully argued that the transi-
istics of product shape are attributable solely to the technical result achieved, it is irrelevant that a similar result could be achieved by other shapes.\textsuperscript{50} In this the exclusion from registration of a shape as a trade mark is more absolute than the exclusion from design registration under EC design law.\textsuperscript{51} The Advocate-General\textsuperscript{52} deduced this after an exercise in literal interpretation of the design and trade mark legislation:

34 The wording used in the designs Directive for expressing that ground for refusal does not entirely coincide with that used in the trade marks Directive. That discrepancy is not capricious. Whereas the former refuses to recognise external features “which are solely \textit{dictated} by its technical function”, the latter excludes from its


\textsuperscript{50} Philips v Remington at [83], applied in Lego Juris A/S v Mega Brands Inc Case R 856/2004-G [2007] ETMR 11 at [56]–[63] and Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2006] EWCA Civ 16; [2006] ETMR 42; [2006] FSR 30. See Julia Clark, \textit{Adorning Shavers with Clover Leaves: Koninklijke Philips Electronics NV v Remington Consumer Products Ltd} [2006] EIPR 352–5. This aspect of the ECI’s ruling in Philips was significant in the successful Swedish appeal which led to a finding of invalidity of Swedish registrations depicting the three-headed shaver. Koninklijke Philips Electronics NV v Rotary Shaver Sweden AB [2005] ETMR 103 Svea Court of Appeal. Prior to Philips, the Swedish court had found the registration of the Tripp Trapp baby’s high chair to be valid over an expired patent and subsisting copyright in the chair design as a work of applied art on the ground that other shapes could be, and were, used to perform the same function: Stokke Fabrikker and Another v Playmaster of Sweden AB (Ltd) and Another [1998] ETMR 395 Ljungby District Court.

\textsuperscript{51} Whereby only those functional designs which uniquely permit of a technical result are excluded. Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community Designs Article 8(1) (“A Community design shall not subsist in features of appearance of a product which are \textit{solely dictated} by its technical function); equivalent in Art 7(1) of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, “A design right shall not subsist in features of appearance of a product which are \textit{solely dictated} by its technical function” (emphasis added). Such exclusions are permitted by Art 25(1) of the WTO TRIPs agreement and interpreted in \textit{Landor & Hawa International Ltd v Azure Designs Ltd} [2007] FSR 9, CA.

\textsuperscript{52} Philips v Remington, n. 48 at para [AG34].
protection “signs which consist exclusively of . . . the shape of goods which is necessary to obtain a technical result”. In other words, the level of “functionality” must be greater in order to be able to assess the ground for refusal in the context of designs; the feature concerned must be not only necessary but essential in order to achieve a particular technical result – form follows function. [The semantic contrast which exists in the German version between the adjectives “erforderlich” and “bedingt” is particularly telling.] This means that a functional design may, nonetheless, be eligible for protection if it can be shown that the same technical function could be achieved by another different form.53

For A-G Ruiz-Jarabo Colomer, this was consistent with the respective purposes of design/patent law and trade mark law – protecting the substantial value of good by design protection, or the value which derives from their technical performance by patents, whilst protecting the origin function and the trader’s goodwill in the case of trade marks. This suggests that the purpose of the prohibition is to protect the legal purity of the design and trade mark regimes,54 but is not necessarily inconsistent with a teleological approach. Alternatively, the exclusion may serve to protect the public domain once design protection has expired;55 Folliard-Monguiral and Rogers56 stress the fact that design protection

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53 This view is consistent with Recital 14 of the Directive 98/71/EC on the legal protection of designs:

Whereas technological innovation should not be hampered by granting design protection to features dictated solely by a technical function; whereas it is understood that this does not entail that a design must have an aesthetic quality; whereas, likewise, the interoperability of products of different makes should not be hindered by extending protection to the design of mechanical fittings; whereas features of a design which are excluded from protection for these reasons should not be taken into consideration for the purpose of assessing whether other features of the design fulfil the requirements for protection.


54 The authority of the A-G’s opinion and of this line of argument have been doubted by Suthersanen. Uma Suthersanen The European Court of Justice in Philips v Remington – Trade Marks and Market Freedom [2003] IPQ 257.

55 In Koninklijke Philips NV v Remington Consumer Products Ltd [2006] F.S.R. 30 at [93] the English Court of Appeal stressed the need to prevent the impairment of competition by the registration of shape marks incorporating technical solutions or functional characteristics.

is limited in time whereas trade mark protection is not. In *Lego Juris A/S v Mega Brands Inc*57 OHIM state a market freedom imperative:

Art.7(1)(e)(ii) CTMR pursues an aim which is in the public interest, namely to bar from registration shapes whose essential characteristics perform a technical function, and were chosen to fulfil that function, hence allowing them to be freely used by all [Remington/Philips at [79] and [80]].

This must be read in conjunction with the fact that many product shapes will be (or have been) eligible for design protection. In fact, a problem with the distinctiveness of a functional product shape is that it may have been acquired during a period of *de facto* monopoly conferred by another right, such as a patent or design registration.

The third limb will usually be triggered by the aesthetic value conferred by the shape of goods. This has been distinguished from what might be described as the “trade mark value” of goodwill in the shape.58 In some product sectors the distinction may be difficult to determine.

Is there any evidence that the methodology of enquiry under Art 3(1)(e) has differed as between the second and third indent, so that evidence of distinctiveness could overcome an objection under the third limb (substantial value), but not the second (technical function)? There was the decision of Lloyd J in *Dualit*,59 deciding the fate of toaster shape marks on distinctiveness rather than functionality grounds. That decision, however, predated the European Court of Justice’s decision in *Philips v Remington*. According to the later approach of *Kitchen J*60 in *Julius Sämaan Ltd v Tetrosyl Ltd* the prohibition is equally mandatory across all limbs. In *Benetton v G-Star*61 the Dutch court62 made a

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58 Or “brand premium”. Thus in *Philips v Remington* in the English Court of Appeal [1999] RPC 809 at 822–33 Aldous LJ stated “In the present case, the shape registered by Philips has a substantial reputation built up by advertising and reliability and the like. That in my view is not relevant. What has to be considered is the shape as a shape.”


60 For many years Mr Justice Kitchen was an editor of the trade mark practitioner’s bible *Kerly on Trade Marks*.

61 *Benetton Group SpA v G-Star International BV* (C-371/06) [2008] ETMR 5.

62 Hoge Raad, 8 September 2006; see Charles Gielen, *Netherlands: Trade marks – shape marks* [2006] EIPR N237. For criticism of the Dutch Supreme Court’s decision on copyright claims in the litigation between Benetton and G-Star see Herman
reference to the European Court of Justice concerning the relationship between the first and third limbs of Art 3(1)(e) in the context of designer jeans. There was evidence that the features of the two trade mark registrations in suit had become distinctive of G-Star before registration. The Amsterdam Regional Court of Appeal indeed held that the attractiveness of the jeans derived from recognition of the trade mark rather than aesthetic appeal. The European Court of Justice gave short shrift to this subtle distinction, regarding the situation as analogous to Philips. A mark which was unregistrable under the third indent could not be saved by proof of acquired distinctiveness.

However, in order to bar a shape from registration any aesthetic surplus has to be substantial. In Julius Sämaan Ltd v Tetrosyl Ltd the outline ‘pine tree’ shape of air freshening cards for hanging on the rear-view mirrors of cars did not confer substantial value within the meaning of the second indent, although it might be an attractive feature to purchasers.

According to Folliard-Monguiral and Rogers, this indent prevents trade mark law from subverting design laws. The law in Europe is thereby in contrast to that in many jurisdictions, where an absolute exclusion is only applied to functional designs and decorative designs may be registered as trade marks for the products in question if acquired distinctiveness can be shown.

If the enquiry under Art 3(1)(e) or its equivalents shows that there is no bar to registration, of course there is still the hurdle of distinctiveness to overcome. This of course must be assessed by reference to the goods or services for which registration is sought. A trade mark will be refused registration if it is incapable of distinguishing, inherently or in fact. The requirement of distinctiveness


Respectively “sloping stitching from hip height to the crotch seam, kneepads, yoke on the seat of the trousers, horizontal stitching at knee height at the rear, band of a contrasting colour or of another material at the bottom of the trousers at the rear, all on one garment” and “seams, stitching and cuts on the kneepad of the trousers, slightly baggy kneepad”.

In the words of the court’s ruling, ‘The third indent of Art. 3(1)(e) of Directive 89/104 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that the shape of a product which gives substantial value to that product cannot constitute a trade mark under Art. 3(3) of that Directive where, prior to the application for registration, it acquired attractiveness as a result of its recognition as a distinctive sign following advertising campaigns presenting the specific characteristics of the product in question.’


Such countries include the U.S. and Japan.
pursues an aim which is in the public interest, namely that descriptive signs or indica-
tions relating to the characteristics of goods or services in respect of which regis-
tration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks.68

Distinctiveness is viewed through the eyes of the hypothetical average con-
sumer, who is reasonably well informed and reasonably observant and circumspect.69 The European Court of Justice held in Philips v Remington and in Linde AG and Others v Deutsches Patent- und Markenamt70 that the standard of distinctiveness is the same for shape marks as for other marks. However

it may in practice be more difficult to establish distinctiveness in relation to a shape or product mark than a word or figurative trade mark. But whilst that may explain why such a mark is refused registration, it does not mean that it cannot acquire distinctive character following the use that has been made of it.71

The provisions are not completely symmetric as between the shapes of goods and that of their packaging. In the case of packaging the case law is driven to a far greater degree by distinctiveness concerns.72 The courts repeatedly state that the standard for distinctiveness is not higher for three-dimensional marks than for any other, but that it may be harder to attain because consumers are less likely to perceive shapes as indications of origin.73

Thus, in practice it may be necessary to establish acquired distinctiveness before registering a shape mark74 which has passed the hurdles of technical function and substantial value. Although the distinctiveness enquiry75 is separate

68 Linde at [73].
70 Joined Cases C-53/01 (Linde, fork-lift trucks) C-54/01 (Winward, torch shape), C-55/01(Rado, wrist watch) [2005] 2 CMLR 44. On torch shapes, see also Mag Instrument Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (C136/02 P) [2004] ECR I-9165, [2004] ETMR 71.
71 Linde at [48].
72 See e.g. (bottle shape with lemon in neck) Eurocermex [2005] ETMR 95 ECJ.  
73 See e.g. (stand-up pouches) Deutsche SiSi Werke v OHIM C173/04P [2006] ETMR 41 ECJ. 
74 Since shape marks are most often used in conjunction with other marks, the decision of the European Court of Justice in Société des Produits Nestlé SA v Mars UK Ltd (C353/03) [2006] All ER (EC) 348, [2005] ECR I-6135, [2005] 3 CMLR 12, [2006] CEC 3; [2005] ETMR 96; [2006] FSR 2 is important – that distinctiveness may be acquired notwithstanding the mark in suit is part of a larger mark (HAVE A BREAK – HAVE A KIT-KAT).  
75 In Betafaç Ltd v Registrar of Trade Marks as Betafaç Ltd's Trade Mark Applications (Nos. 2202706 and 2202901) [2005] EWHC 1335 the fence panels were held to be devoid of distinctive character.
from, and subordinate to, the exclusion enquiry, the fact that the shape has
functional features may be relevant to the distinctiveness enquiry, for example
because the technical features might be common to the trade.76 Packaging
shape may be combined with another feature which confers distinctiveness,
such as the matt white surface of the bottle for sparkling wine in Freixenet.77
As well as the visual aspect, the matt finish of the bottle could be regarded as
a tactile sign; the registration of tactile marks has recently attracted
comment.78

In Julius Sämaan Ltd v Tetrosyl Ltd,79 Kitchen J doubted whether the
provision80 allowing for cancellation of marks which have become generic
after registration applied to shape marks. However, this may disregard the fact
that the first limb of the exclusion is apt to describe generic shapes; if so,
generic shapes are doubly precluded from registration, in that they contravene
the first limb of the exclusion and necessarily lack distinctiveness. In view of
such strictness before registration, it would be surprising to find that shapes
which have become generic due to the fault or default of the proprietor cannot
not be expunged from the register.

Folliard-Monguiral and Rogers list a number of factors which are consid-
ered unpersuasive by the Office for Harmonisation in the Internal Market
when assessing the distinctiveness of shape marks for the Community trade
mark register:

- The creative merit of a mark
- The process of creation of the shape
- Distinctiveness does not require novelty
- The ownership of national registrations81

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76 Linde at [69]; Case C-456/01 P and C-457/01 P Henkel KGM v OHIM (2005)
ETMR 44, ECJ; Maasland NV’s Application for a 3-Dimensional Trade Mark [2000]
RPC 893 (AP) (decided before Linde but, it is submitted, not inconsistent). See also
Arnaud Folliard-Monguiral & David Rogers, Significant Case Law from 2004 on the
Community Trade Mark from the Court of First Instance, the European Court of
Justice and OHIM [2005] EIPR 133 (noting Community trademark decisions).
78 Alexander Gonzalez, Feel the Difference – German Federal Supreme Court
80 Section 46(1)(c) of the UK Trade Marks Act 1994, corresponding to Art 12
of the Directive and Art 51 of the CTM Regulation, refers to the “common name in the
trade”.
81 In Bongrain SA’s Trade Mark Application [2004] EWCA Civ 1690, [2005]
ETMR 47; [2005] RPC 14, CA (fancy cheese shape application rejected), the English
court pointed out that the fact of registration in other jurisdictions would not usually
assist unless the basis for such registrations was clean.
• The stability of the shape

Conversely, the following are relevant:

• The geographical extent of the use
• The public concerned
• Methods of use

This list is consistent with para 51 of Windsurfing Chiemsee, where it was held by the European Court of Justice that, assessing the distinctive character of a mark, one could consider

• The market share held by the mark;
• How intensive, geographically widespread and long-standing use of the mark has been;
• The amount invested by the undertaking in promoting the mark;
• The proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking;
• Statements from chambers of commerce and industry or other trade and professional associations.

Ultimately the question is not whether the shape mark has been used, even extensively, but whether it has become distinctive through use. Thus the manner of use and in particular whether it educates the public to regard the mark as a source identifier will be a crucial aspect.

The perception of the relevant public is key to the question of distinctiveness. In relation to three-dimensional marks, the European Court has shown itself reluctant to exclude end consumers from the enquiry, for example in skein-shaped sausage casing it was argued that a sausage casing sold by the...
applicant to charcuterie manufacturers might become unique to one of the manufacturers after registration. In ‘shape of cheese box’ an attempt to limit the specification of goods to exclude consumers from the enquiry was unsuccessful. Here the sign was described in elaborate terms; the CFI took the view that consumers would simply not observe the detail, so distinctiveness was lacking.

From the above, it is clear that EC law and the law of Member States of the European Union on shape marks are underpinned by an ideal of market freedom. In fact a distinctive trade mark is accepted to be an essential element of a system of undistorted competition in the EC. For this reason it is likely that trade mark jurisprudence in Europe generally will be influenced by that on shape marks. Nonetheless, a ‘keep free’ competitive aspect did not conclusively militate against registration in the ‘stand-up pouches’ case.

An extreme example of application of the consumer perception test to keep a design free from trade mark protection is the case of Dyson, where registration was sought for the transparent dust collection bin of Dyson Ltd’s bagless vacuum cleaners. It was accepted that the application was not to register a shape, because a variety of shapes were possible and two quite different shapes were shown in the application. On appeal from the UK Registry’s refusal to register the mark, the English court referred

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88 T-360/03 Frischpack GmbH v OHIM 23 November 2004 (CFI).
90 Gillette Co v LA Laboratories Ltd OY [2005] FSR 37 ECJ, (citing Hag, Merz & Krell, Arsenal v Reed).
91 Deutsche SiSi Werke v OHIM C173/04P [2006] ETMR 41 ECJ rejecting appeal against finding that consumers would not perceive the shapes of the pouches as trade marks. Conversely in the US TrafFix case, it was held that a finding of competitive necessity was not essential to a functionality refusal: TrafFix, 532 US 23, 58 USPQ 2d 1001.
93 The mark was described in the following way “the mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner”. See ECJ decision at [15]. This decision related to an application to register in the UK. An application to register as a Community Trade Mark (no 522144) was withdrawn prior to the hearing of an appeal, Dyson v OHIM Case T-278/02 [2002] OJ C 289/29.
94 Although in the flexible net-bag case the OHIM Board of Appeal took the view that stability of shape was not essential. See Board of Appeal Decision R 820/1999-3, 14 November 2000, supra. n.82 above.
questions relating to the assessment of distinctiveness to the European Court of Justice. However, in its ruling, the European Court addressed a somewhat different question posed by the European Commission and supported by Advocate-General Leger: was the transparency of the bin a “sign” within the meaning of the trade mark legislation, or merely a concept? In his opinion, A-G Leger referred to aspects of Philips v Remington and continued:

In my opinion it is clear that this reasoning applies legitimately to a functional feature which forms part of the appearance of a product. Although that article refers only to signs which consist exclusively of the shape of a product, I think that the general interest which underlies that provision requires that registration of a functionality like that at issue in the main proceedings be refused.

He expressed the view that registration would confer exclusivity of the technical solution to a single operator for an indefinite time and went on to enumerate the ways in which registration of the transparency concept would frustrate the system of free competition which the EC Treaty sought to establish. A-G Leger also referred to the patentability of such a technical solution and the need to keep trade mark law from straying.

The applicant had previously enjoyed patent protection for the operative features of the bagless vacuum cleaner, so during this period consumers came to recognize the transparent bins as indicating the type and origin of the cleaners. The questions are of great interest, but in the end the court found it unnecessary to answer them.

1. In a situation where an applicant has used a sign (which is not a shape) which consists of a feature which has a function and which forms part of the appearance of a new kind of article, and the applicant has, until the date of application, had a de facto monopoly in such articles, is it sufficient, in order for the sign to have acquired a distinctive character within the meaning of Article 3(3) of [the Directive], that a significant proportion of the relevant public has by the date of application for registration come to associate the relevant goods bearing the sign with the applicant and no other manufacturer?

2. If that is not sufficient, what else is needed in order for the sign to have acquired a distinctive character and, in particular, is it necessary for the person who has used the sign to have promoted it as a trade mark?
The full court handed down a rather briefer opinion confirming the view that Dyson’s application did not constitute a “sign”.\(^{102}\) Again, there was stress on the need to prevent “the abuse of trade mark law in order to obtain an unfair competitive advantage”.\(^{103}\)

In a number of the EC cases cited, consumer perception of the significance of the shape mark is said to have been affected by the presence of other, more traditional, forms of mark on the goods or packaging, usually to diminish the trade mark significance of the shape mark. However this is not conclusive; in Golden Rabbit TM\(^{104}\) it was held that “There does not exist any rule of experience according to which the overall impression of a three-dimensional mark consisting of a shape, a colour, word and figurative elements as well as further features is regularly determined by the word element regardless of the concrete arrangement and get-up of those elements.” By contrast, in Japan, the presence of additional word or device marks is likely to be seen as fatal to distinctiveness of the shape.\(^{105}\)

Having considered in detail the law of the most restrictive regime, it is time to turn to other jurisdictions.

B. US Federal law

Although the influential doctrines of technical and aesthetic functionality\(^{106}\) have long been recognised in US case law, especially in the interpretation of Federal trade mark legislation under the Lanham Act,\(^{107}\) their enshrinement in statutory language at the Federal level came comparatively recently with the Technical Corrections to Trademark Act of 1946.\(^{108}\) This amending legislation introduced specific references into Section 2 of the Lanham Act,\(^{109}\) relating to the Principal Register.\(^{110}\)

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\(^{102}\) Dyson, supra., note 92 at para. [35]–[39].

\(^{103}\) At [34], citing Heidelburger Bauchemie [2004] ECR I-6129 at [24], a case concerning the colours blue and yellow.

\(^{104}\) [2007] ETMR 30 Case I ZR 37/04 Bundesgerichtshof, Germany.


\(^{106}\) The conceptual category of aesthetic functionality has been doubted by the USPTO; see Trademark Manual of Examining Procedure (TMEP) – 5th edition, para 1202.02(a)(vi) Aesthetic Functionality, available online at http://tess2.uspto.gov/tmdb/tmep/.

\(^{107}\) Under ss 1, 2 and 45 of the Trademark Act, 15 USC §§1051, 1052 and 1127. Pub L No 105-330, §201, 112 Stat 3064, 3069, effective from 30 October 1998.

\(^{108}\) US Code 15, para 1052.

\(^{109}\) Section 23(c) of 15 USC §1091(c) is amended to similar effect for the Supplemental register.
No trademark by which the goods of the applicant may be distinguished from the
goods of others shall be refused registration on the principal register on account of
its nature unless it

\[\text{(e) Consists of a mark which}\]

(5) comprises any matter that, as a whole, is functional.

The next subsection makes functionality an absolute prohibition, regardless of
distinctiveness:\textsuperscript{111}

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of
this section, nothing in this chapter shall prevent the registration of a mark used by
the applicant which has become distinctive of the applicant’s goods in commerce.

In relation to marks already registered, Section 14(3)\textsuperscript{112} allows functionality
to be raised in cancellation proceedings more than five years after registration,
the usual period for incontestability, while Section 33(b)(8)\textsuperscript{113} provides a
defence of functionality where infringement of an incontestable mark is
alleged.

Thus the statutory amendments have crystallised TrafFix functionality as a
pre-emptive enquiry which takes precedence over any amount of acquired
distinctiveness. The United States Patent and Trademark Office’s (USTPO)
Manual of Examining Practice for trade marks\textsuperscript{114} gives the competitive imperative
as the basis for this exclusion, defining the traditional functionality of a
feature which is “essential to the use or purpose of the product or affects the
cost or quality of the product”\textsuperscript{115} and citing from Qualitex Co v Jacobson
Products Co, Inc:\textsuperscript{116}

> The functionality doctrine prevents trademark law, which seeks to promote compe-
tition by protecting a firm’s reputation, from instead inhibiting legitimate competi-
tion by allowing a producer to control a useful product feature. It is the province of
patent law, not trademark law, to encourage invention by granting inventors a

\[\text{\textsuperscript{111} As decided in relation to technical functionality in TrafFix Devices, Inc v Marketing
Displays, Inc, 532 US 23, 34–35, 58 USPQ 2d 1001, 1007 (2001). However,
in Wal-Mart Stores, Inc v Samara Bros, Inc. 529 US 205, 120 SCt 1339, 146 LED2d
182, 54 USPQ 2d 1065, the Supreme Court held that decorative trade dress could be
protected under the Lanham Act on proof of factual distinctiveness.}\]

\[\text{\textsuperscript{112} 15 USC §1064(3).}\]

\[\text{\textsuperscript{113} 5 USC §1115(b)(8).}\]

\[\text{\textsuperscript{114} Para 1202.02, available at http://tess2.uspto.gov/tmdb/tmep/1200.htm#_T120202.}\]

\[\text{\textsuperscript{115} See Dinwoodie, Death of Ontology at 686, 694.}\]

\[\text{\textsuperscript{116} 514 US 159, 164, 34 USPQ 2d 1161, 1163 (1995).}\]
monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation. If a product’s functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever [because trademarks may be renewed in perpetuity].

However, it becomes clear from the Manual that the USPTO does not regard the prohibition on functional shapes or other marks as extending to those conferring purely ornamental\textsuperscript{117} advantage, what may in the past have been referred as “aesthetic functionality.” Rather, there seems to be a very limited notion of the “aesthetic functionality” which would disqualify a mark under s 2(e)(5) on the basis of competitive need.\textsuperscript{118} The manual\textsuperscript{119} goes on to describe the doctrine of aesthetic functionality as “the subject of much confusion.”\textsuperscript{120} The examples given\textsuperscript{121} of valid use of the term relate mainly to the use of colour. In Dippin’ Dots, Inc v Frosty Bites Distrib LLC,\textsuperscript{122} the colours of popular flavours of ice-cream were considered functional even when used in particular combinations and style.

In the case of purely ornamental product design, even where substantial value is conferred and the protection of a design patent has been enjoyed,\textsuperscript{123} it seems that a showing of acquired distinctiveness will enable registration to be achieved, unlike the position in the European Community. In a number of cases\textsuperscript{124} the shape of guitar heads has been protected by registration – Yamaha Intl Corp v Hoshino Gakki Co;\textsuperscript{125} Gibson Guitar Corp v Paul Reed Smith Guitars LLP.\textsuperscript{126} A case involving the “Beast” pointy guitar shape has been considered under European Law.\textsuperscript{127} However, the Office for Harmonisation in

\begin{footnotes}
\item[118] Or significant non-reputation-related disadvantage.
\item[119] At para 1202.02(a)(iii)(C).
\item[121] \textit{Qualitex}, 514 US 165; \textit{Brunswick Corp v British Seagull Ltd}, 35 F3d 1527 (Fed Cir 1994); M-5 Steel Mfg, Inc. v O’Hagin’s Inc, 61 USPQ 2d 1086 (TTAB 2001).
\item[122] 369 F3d 1197 (2004).
\item[123] J Thomas McCarthy, \textit{McCarthy on Trademarks}, para 7.91, citing In Re Mogen David Wine Corp 328 F2d 925, 140 USPQ 575 (CCRA 1964).
\item[124] Karen Feisthamel, Amy Kelly & Johanna Sistek (2005), \textit{Trade Dress 101: Best Practices for the Registration of Product Configuration Trade Dress with the USPTO} 95 TMR 137 providing fascinating tables of product configurations registered for food products, furniture and furnishings and musical instruments.
\item[125] 231 U.S.P.Q. 926 (TTAB 1986).
\item[126] 311 F supp 2d 690 (M.D. Tenn 2004).
\end{footnotes}
the Internals Market (OHIM – the Community trademark and design registry) had done an internet search and in its decision communicated the links to the applicant but not copies of the web pages consulted. OHIM’s argument that this was consistent with applicant’s right to be heard was undermined by the fact that when the appeal court tried the links, many did not work. Accordingly the CFI annulled OHIM’s decision on procedural grounds and did not consider the substantive merits of the application.

Returning to technical functionality, US case law shows that this objection will be upheld even if other product designs share similar technical advantages. In Thomas Betts Corp v Panduit Corp128 and Keene Corp v Panaflex Industries Inc129 the product design in issue was one of a dozen or so alternatives on the market, albeit not all optimal. A suggestion in Vornado Air Circulation systems v Durocraft Corp130 that the presence of alternative designs could overcome the evidence of functionality provided by a utility patent was rejected in TrafFix.131 Cases cited by Arden132 suggest that the applicant’s advertising of the technical advantages of its wares is not always taken at face value; sometimes the courts will dismiss it as “mere puffery”, whilst on other occasions giving it weight in a finding of functionality.133

Considering the options of design patent, utility patent and trade dress protection, Valenzuela134 recommends that both utility and design patents be sought for new product configurations, in the hope that decorative features can be shown to be distinctive through use in the period between expiry of design patent (14 years) and utility patent (20 years).

Another difference between jurisdictions is the weight given to the applicant’s or proprietor’s advertising. As the USPTO manual puts it, “The applicant’s own advertising touting the utilitarian aspects of its design is often strong evidence supporting a functionality refusal.”135 However, in the US, Canada

130 58 F 3d 1498 (10th Cir 1995).
135 Para. 1202.02(a)(v)(B) (Advertising, Promotional or Explanatory Material in Functionality Determinations.)
and elsewhere, publicity vaunting the technical value of a product is often viewed as “mere puffery” and disregarded whereas in Europe such “puffs” are taken seriously as admissions against interest. It could be that European consumers take product information more seriously; after all trade mark law is ultimately about consumer perception, so one must be cautious in comparing different markets. However the contrast is quite striking in cases involving the embossing of paper kitchen towels, considered in the next section.

C. Canadian Federal law

Canadian law emphasises that a trade mark is not a product but the symbol of a connection between the product and source. The doctrine of technical functionality was explored in Kimberley-Clark Tissue v Fort James and Kirkbi v Ritvik. In Kimberley-Clark, involving an application to register an embossing design for paper kitchen towels, the opponent argued technical functionality – the applicant had asserted in advertising that the embossing made the towels more absorbent, stronger, and softer. Opposition was rejected on this ground; the applicant’s claims were regarded as “mere puffery.” However, opposition succeeded on the ground that the design was decoration; Canadian law regards ornamentation features as incapable of registration as a valid trade mark unless the feature is shown to have acquired distinctiveness. Here it was relevant that the embossing was often obscured by packaging and not readily visible to consumers.

In Kirkbi, the plaintiff’s LEGO brick indicia were held to consist solely of technical and functional characteristics. These had been protected by the plaintiff’s expired patents. The court discussed the decision in Kimberley Clark and the doctrine of functionality generally. A finding of technical functionality would be fatal to a claim based upon a registered or unregistered mark. Section 13(2) of the Canadian Trade Marks Act provides that no registration of a distinctive guise may interfere with the use of any utilitarian feature embodied in the distinguishing guise.

The distinction between technical and decorative features seems consonant with that in the USA, the defence under s 13(2) seeming to deal with issues embraced in the limited US doctrine of aesthetic functionality. The attitude of the court to the applicant’s advertisements in Kimberley-Clark is in contrast to

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136 Linde (Directive Art 23(1)(b)); Mag (Regulation Art 7(1)(b)).
139 Section 7 of the Trade Marks Act 1985 Act merely codified the law of passing off.
that of the European Courts in the Philips v Remington cases; in the latter, great stress was laid upon advertisements vaunting the technical advantages of the three-headed shaver.

By contrast, another EC example concerned paper kitchen towels. In Georgia-Pacific Sarl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), the application was for a three-dimensional mark consisting of four concentric circles, the outer circle interlocking with the outer circles of adjoining motifs. The application was rejected by OHIM as being devoid of distinctive character for kitchen towels and the like, contrary to Art (1)(b) of Reg 40/94. The design was held to be neither inherently distinctive, nor to have distinctiveness acquired as a result of use. In upholding this decision, the Court of First Instance held that the relief pattern did not operate as an indication of source according to the perception of the relevant public, here consumers. Rather these consumers would regard the pattern as connoting quality, that of absorbency. This was reinforced by the fact that a word mark and the descriptor “super absorbent grâce à son gaufrage spécial” were used on the packaging.

D. Other jurisdictions
New Zealand law seemingly avoids a categorical approach to functional features, even when previously protected by patent. In Fedco Trading v

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142 In assessing distinctiveness, the court observed that there were two aspects, the fact of embossing and the particular pattern used, but looked at the overall effect of these. Case T283/04, supra. note 141 at para. [45] referring to Stihl T234/01 [2003] ECR II 2869 at [32] on the proposition that this did not preclude separate and successive consideration of the individual aspects.
143 Nestlé Waters France v OHIM (bottle shape), T-305/02, ECR II-5207 at [29]; Eurocermex/OHMI, C-286/04P, ECR I-5797; such average consumer was reasonably well informed and attentive; Axions et Belce/OHMI (Forme de cigare de couleur brune et forme de lingot doré), T-324/01 & T-110/02, ECR II-1897, point 31, but such consumer was possessed of imperfect recollection. Procter & Gamble/OHMI (Forme d’un savon), T-63/01, ECR II-5255, point 41.
144 There was some evidence that consumers had been educated to regard embossing generally as conferring superior absorbency, see Case T283/04, supra. note 141, at para. [47].
145 Which can be roughly translated as “super absorbent thanks to its special embossing.”
Miller\textsuperscript{146} a previously patented horticultural vine tie was held to be registrable under the Trade Marks Act 2002 in view of evidence of extensive use and consumers’ perception of the tie as indicating source.

Thai law appears to place few fetters on the registration of shape marks which have acquired distinctiveness. In Société Bic v Department of Intellectual Property,\textsuperscript{147} the Thai Intellectual Property and Information Technology Court recognised the Bic ballpoint pen shape as a famous mark whose non-functional features included the hexagonal body and cone shaped tip.

Art 4(1)(18) of Japan’s Trade Mark Act 1997 states that where a trade mark consists solely of the three-dimensional shape of goods or their packaging, the mark cannot be registered if the shape is “indispensable for the goods or packaging properly to function”.\textsuperscript{148} This applies the doctrine of technical functionality to packaging as well as product shapes but appears to be a higher test than that used in Europe and the USA.

III. What (if any) correlations can be identified between scope of design laws and treatment of shape marks?

It has been argued that the case of Europe shows an inverse relationship between the liberal scope for protecting product shapes under design law and their limited registrability under trade mark law. A strictness militating against trade mark registration may manifest itself in categorical exclusions or in reluctance to find that shape signs are capable of distinguishing. Although due caution must be exercised in comparing the rules applicable to different markets, it does appear that jurisdictions with narrower criteria for design protection, such as the USA, do have a more generous approach to registration of shapes. This could be due to a decreased likelihood that the shape in question was previously protected by design laws, or due to a more relaxed policy. A telling example is that of “retro” toaster designs; Dualit’s shape mark applications were refused in the UK, whilst Sunbeam’s retro design shapes have been registered as trade marks in the USA.\textsuperscript{149} This resonates with Dinwoodie’s ascription of the Two Pesos decision to narrow design protection in the US.

\textsuperscript{146} High Court, 16 December 2004, noted at (2006) 180 TMR 486.

\textsuperscript{147} IP and IT Court, No. 38–41/2547, noted at (2006) 96 TMR 530.

\textsuperscript{148} Translation thanks to (2007) 22 Yusarn and Hara IP News 1.

\textsuperscript{149} See supra. at n59.