

LEGO: 3D trademarks stand "no chance" in Europe

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July 30 2009

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Reacting to the news that the German Federal Supreme Court last week demolished LEGO Group's three-dimensional trademark registration, the company's senior in-house counsel has told *WTR* that "it seems like non-traditional marks do not really stand a chance in Europe".

The German court cancelled LEGO's registration of its classic brick shape on the grounds that it constituted a "technical function" and was a "generic form" for brick toys (Cases I ZB 53/07 and 55/07 of July 16 2009). "It is still our view that the LEGO brick functions as a trademark," said Mette Andersen, the toy company's corporate counsel. "Consumers recognize it immediately and link it to the LEGO Group. It is not purely functional."

The cancellation was seen as a block to non-traditional marks, applications which, according to Andersen, "are rejected by most trademark offices". She added that even "the Office for Harmonization in the Internal Market (OHIM) tries its best to avoid registering them", citing the *Bang & Olufsen Case* (T-460/05), in which OHIM and its board of appeal disagreed with Bang & Olufsen that its speaker design was distinctive (OHIM's decisions were later overturned by the Court of First Instance – see "Three-dimensional mark for loudspeaker held to be distinctive").

"A brand is not just a name (a word mark)," says Tove Graulund, director of trademarks at Zacco, "but a number of elements (in marketing speak, 'brand cues') that could deserve trademark protection. For example, colours, shapes, sounds, etc." Graulund and others have been arguing for some time at conferences and in front of OHIM that all these elements together make a brand which is sufficient to trigger the consumer to make a purchase. "For this reason, brands are essential to businesses," she explains. "It can be extremely detrimental if one or two brand cues are copied - which is what is done by lookalikes. Typically the colour and some of the design elements are copied, whereas the lookalikes producer is clever enough not to copy the name that will be protected by a trademark registration."

Graulund urges national regimes and the European Commission to "find it in themselves" to grant these rights more generously. Alternatively, "the Commission must look at creating some form of protection for brands through other community legislation," she suggests. "That would make it possible to stop clearly fraudulent and wilful lookalikes."

Elsewhere in the world, SpicyIP today reports that the second sound mark has been registered in India (for background on sound marks - including the first registration - in India, see "Non-traditional marks in emerging markets: the new frontier?"). The blog argues that the trademark office has a "confined approach" to non-traditional marks, as applications can be filed only for "marks capable of being represented graphically". Brand owners in other jurisdictions face equally narrow requirements. For some time, practitioners in the European Union have been arguing against a similar provision in the Community Trademark Regulation (207/2009), which states that a "Community trademark may consist of any signs capable of being represented graphically".

For LEGO, the problem is not representation but functionality and form, and it will not be giving up the fight to protect its sign any time soon. Says Andersen: "We still have the appeal pending before the European Court of Justice" (for background see "CFI blocks Lego's trademark bid").

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