

United States of America

Q148

Three-dimensional marks: the borderline between trademarks and industrial designs

I. National or case-law

1. Is in your country legislation, or other sources of law, to protect shapes of goods, packages and other 3D signs as industrial designs and/or as trademarks?

Yes. Under U.S. law, new, original and ornamental designs of an article can be protected by a design patent under federal statutory law.(1) Distinctive shapes of products, packages and 3D designs can also be registered and enforced in the courts as trademarks (often called "trade dress" in U.S. legal terminology when they refer to 3D product shapes; the terms are generally referred to interchangeably herein as "trademark/trade dress") under federal statutory law(2) as well as the common law of unfair competition.

2. If so, what are the conditions and minimum requirements to protect them as:

i) Industrial Designs,

ii) Trademarks.

i) Applicable U.S. law uses the terminology "design patent" rather than "industrial design." For a three-dimensional design to be protected by a valid design patent, it must be: (1) new, (2) original, (3) ornamental, (4) non-obvious to a person of ordinary skill in the art, and (5) not primarily for functional or utilitarian purposes.

ii) For a 3D sign to be registered or protected as a trademark, it must be (a) primarily non-functional, and (b) distinctive. As noted above, 3D trademarks consisting of the overall look of a product or its packaging are called "trade dress" in the United States.

A 3D sign is primarily non-functional if it serves no utilitarian need, or if it is only *de facto* functional, as distinguished from *de jure* functional. A *de facto* functional design performs some function as a matter of fact, but the design is not dictated primarily by the function. For example, the design of a spray bottle is *de facto* functional in the sense that it holds and sprays liquid, but a particular spray bottle design can be a trademark if aspects of it are not solely dictated by function.(3)

A 3D sign, however, cannot be registered as a trademark if it is *de jure* functional, i.e., functional as a matter of law. If the design feature is essential to the operation of the product, or is superior in function or efficiency to other available designs, and thus, provides a competitive advantage to the user, the configuration will be considered *de jure* functional and unprotectable as a trademark/trade dress.(4)

To be protectable as trademark/trade dress, a 3D sign must also be distinctive. In this regard, it can possess either inherent distinctiveness, or acquired distinctiveness through long, extensive and exclusive advertising, promotion and usage (called "secondary meaning").

3. Is there a specific rule that precludes trademark protection for a shape of an object protected or previously protected, as an industrial design or under another modality of industrial property (e.g., utility models or patents)?

Under U.S. law, the rights pertaining to design patent and trademark/trade dress protection exist independently.(5) The existence or termination of either right, i.e., design patent or trademark, has no legal effect on the availability or continuance of the other.(6) However, if a U.S. utility patent (as a distinguished from a design patent) covers a 3D product feature, that fact may be relevant to the possible functionality and consequent unprotectability of that feature as a trademark.(7) Over the years, some U.S. courts have gone

