

THE LEGAL PROTECTION OF THE PRODUCT FORM

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Abstract: The main purpose of this paper is analysing the legal protection offered by the Romanian legislation to the product's design and consignment. The product's design is a conception, which leads to the distinctiveness of industrial products through an aesthetical element. Having this capacity, the product's design is indissolubly connected to life's quality as well as to an enterprise's economic efficiency, being as such, an orientation tool for the consumer's demand.

The product is anything, that can be offered on the market in order to draw the attention upon, of purchase, of usage or of consume which can satisfy a wish or a need. The offer of the market comprises products under the form of material goods (automobiles, books), of services (hairstyle, concerts), of persons (Michael Jordan, Barbara Streisand), of places (Hawaii, Venice), of organizations and of ideas (family planning, car assurance) (Kotler, 2000, page.543). The product is the first and most important component of the marketing mixture. In process of elaboration of marketing strategy for a product or another, the marketers have to consider the social implications of them, respectively the respectation of legal regulations.

Besides the product, lately packaging has become a very efficient marketing tool. The well projected packages can have utility value for the consumer and one of promotion for the manufacturer. Packaging is the activity of projecting and producing a container or a protecting material for a certain product. The container or the protecting material has the name of package. In order to create an efficient package for a new product it is necessary to take more decisions. The first of them refers to the formulation of the packaging concept. This defines what should be or do the package for the product. What function should be fulfilled by their package: to offer the product a superior protection, to introduce new distribution techniques, to suggest some characteristics of the product or of the firm? In the same time, there should be taken a decision concerning other elements linked to packaging, such as size, form, materials and colour of the package, the text written on it and the brand image.

In the following paragraphs we are going to try to present the way the form of the product and the package are protected legally. The form of the product is a creation by which the individualization of industrial products is realized through an esthetical element. By this function, the form of the product is insolubly related to the quality of life, constituting an element of the environment, as well as the economic efficiency of a firm, being an element of orientation of consumer request and so of growth of commercial value of the product. The effective form of a product can lead to confusion among consumers. If the form is so well-

known that the consumers will correlate the product with a certain commercial source (as in the case of Coca-Cola bottle) the form can be considered an indication which has to be protected.

We have to remark that legislation referring to protection of industrial drawings is available in many countries in order to complete or replace by right of authors of the creations called applied art". Such legislation forbids, usually, the usage of the presentation of identical or similar products. With all these, as in the legislation concerning brand marks, the protection by law of industrial drawings is limited by some means, which vary from a country to another. In a similar manner to specific protection under the law referring to brands, such limitations can refer to general applicability of drawing law for some kind of presentation of the product, and the exact prolongation of the protection guaranteed by the specific regulations. For example, if the protection of drawings for the decoration of a surface is limited to the usage of products on which the drawings are registered, the protection from copying the drawing used for decoration of other products can be obtained by the law of non-loyal concurrence, if the drawing misleads people or produces confusion concerning the commercial source.

For protection against confusion concerning drawings, most regulations of non-loyal concurrence are established by jurisprudence referring to the practice of servile imitation." In this particular domain of non-loyal concurrence it was said often that it is the implicit principle by the free market system that the participants are free to imitate drawings or other forms, presentations or visual characteristics of the products which are not protected by specific laws like invention patents, author rights, drawing or brand images. Some of the specific laws exclude the protection under the non-loyal concurrence law for acts which are covered by specific legislation if the implied drawing could be protected. For example, the Common law of Benelux from 1975 concerning drawings, excludes the action of protecting drawings which could be registered under the non-loyal concurrence law, if the protection could be given if the drawing would have been registered correctly. Consequently, the simple risk of confusion concerning the form of products will not be enough to mean a non-loyal concurrence if the drawing could have been protected by a specific law and the imitation of the product is covered by that legislation. On the other hand the risk of confusion concerning products can be enough to obtain the protection under the non-loyal concurrence if the implied drawing has a certain level of originality, but cannot be registered as a drawing because of some requests of specific regulations or if registration was requested, but not assured yet.

If the drawing, form or other non-functional characteristic of the product is associated by a substantial number of consumers with a certain source or origin, the potential confusion regarding the source of the product will constitute usually an act of non-loyal concurrence. If such a potential confusion appears or not in cases of imitation is an aspect which will be established by the same evidenced factors referring to indications, i.e. after the examination of the problem if characteristics of a product have obtained sufficient secondary meaning and the drawing of the specific product will be judged taking into consideration the similitudes. In some countries it is accepted that the risk of confusion regarding the source can be reduced by using some renouncing acts like a visible declaration excluding the possibility of suppositions that the product or service come from a certain source. Still, such renouncing acts are rarely recognized as being sufficient to reduce the risk of confusion.

The protection against confusion regarding the commercial source of a product can be available as a specific legal regulation regarding brand names, if the applied regulation concerning brand names also refers to the protection of tridimensional brands or to the presentation of the product. Still if the presentation of the product is not registered as brand or if particular forms are possibly excluded from the statutory protection of brand names, the same principles will be applied as those mentioned before for the protection against confusion among the forms of products, under the law of non-loyal concurrence.

About the protection of product form in our legislation we can say that in older legislations, not as in legal regulation nr.84/ 1998, the form of the product is not mentioned among the characteristics constituting a brand. Since these are generally limitative, the problem gave birth to discussions. They are also continued in the newer legal systems referring evidently to the conditions which a product has to fulfill in order to be protected as brand names.

Under the rule of the French regulations formerly valid, P. Roubier rejected the idea that form of product can constitute a brand. The authors having the same point of view, usually distinguish two situations when form is necessarily related or not to the product, still they reach the same conclusion, that it is impossible that it should be protected as brand. In the first case it is about new products to which there can be reserved an exclusive patenting right. This exclusive right is, by its nature, temporary. To admit the protection of the form as brand would mean to arrive to the conclusion that the brand is susceptible of infinite renewing, to unlimited prolongation of protection resulting in patent. P. Roubier resumes thus this idea: "In its definition, for the period of patentation, the brand is unuseful, because the usage of the whole product is impossible not only that of its form or colour, and after the expiration of patenting it would really be exorbitant to constitute a monopoly of manufacturing through the brand" (Roubier,pag. 553). If the form or the colour of the products is not the necessary consequence of manufacturing, since the product can be manufactured having other forms or colours, we find ourselves, according to these authors in front of a form creation, again susceptible, of temporary protection, as model or industrial drawing. This point of view was acknowledged by some instances and it can be found in the French doctrines. There we can find the idea of rejecting product form, admitting still that the form of the package can be protected as brand, since such a protection will not stop but the sale in a similar package of other kinds of products. Numerous jurisprudences admitted, even lacking legal regulations the form of the product as susceptible sign of constituting a brand.

In France the problem was solved by a legal regulation from 31.December 1964, which recognizes brand having three dimensions, including the form of the product. If the form is created to produce a certain industrial result, it is evident that it could not produce a brand itself, because it would be contrary to legal regulations regarding invention patenting, which under the pretext of registering a brand could extend the monopoly of the inventor after the legal period. But, if the form of the product does not influence the industrial result, being a fantasy form, the argument stops to be valid. Neither the argument of the form constituting a model or an industrial drawing, protected as such cannot be taken into consideration, since principally nothing opposes to an object being mentioned in 2 different regulations, as model or drawing, as well as a brand.

M. Gotzen proposes a distinction between the different forms of the product. In his conception they are not susceptible of being protected as brands, besides of the forms requested by the

nature of the product which affects the essential value of it, in order to prevent the accumulation of protection by brand and patenting, and by brand and model. Thus, the artistic form of a crystal bottle could not be considered a brand, since the essential value of such a product consists of its form beauty. (Position exposed in M. Gotzen's thesis) (Bunnen, 1967).

In the Italian law there are favourable solutions for form protection as brand, in case the form is not banal or functional. The West-German jurisprudence was hostile to the protection of these brands, invoking among other things the material impossibility of registering brands having three dimensions. The English law rejects three-dimensional brands as well, considered as not being distinctive enough.

In the present the doctrine is favourable to the recognition of three-dimensional brands in the USA. Although three-dimensional brands, including form, were recognized, the exigencies concerning their distinctive character are more rigorous than for the other signs considered brands. Even in countries where either law or jurisprudence have admitted protection as brand for the form of the product, practice shows that such brands are rare, because they are banal, and not distinctive any more.

In our legal system we have to consider that the form of the product suitable for an express disposition can constitute a brand, and it will not be susceptible of protection only if it is not necessary and it will not produce an industrial result. It cannot be considered signs as the spatial form of some products, if these represent the necessary form for these products are they have an exclusively utility character. The utility character refers to the form of the product, its necessary or natural character, to which it is insolubly, linked the possibility of using the product. Although the legal regulations do not mention it, we underline the necessity of excluding from protection the form of new products, which can be patented in order to prevent an accumulation of protection, as well as of the forms which became banal in a certain domain. Related to this aspect, it is necessary to mention the point of view expressed in our literature, according to which brands constitute form the form of the product are generally and to a certain level descriptive since they reproduce the product for which they are used. The used example to illustrate this idea, the form of a glass is, we think, very suggestive. Indeed, the form of a product made to be used as a glass will hardly represent the distinctive character, which conditions its protection as a brand. The essential argument is the founding of the above mentioned solution and is surely the one resulting from the predominant character of the model aspect of the brand, hypothesis when the protection is considered abusive (Chavanne, pag. 126).

A. Braun notices that "the form associates to the utility value of the product a certain esthetic value. If, taking into consideration the form of the product this esthetic value has a capital importance, the chosen form cannot request a supplementary protection as a brand (Kotler, 2000). A glass company, says the same author, cannot associate the brand with the crystal glasses, because in this case it wouldn't be the sign of a product, but the product itself.

The problem of the form of the product as natural element can determine the distinctivity of a brand, was transformed in an interesting solution by the Court of Liege on 30. June 1993. It is about a product named "Lego". The instance considered that the form belongs to the public domain, and it cannot be suspected of closeness. Even if it is considered, as the decision of

the court says, the form is distinctive due to usage, and it can produce industrial results, not being able to be considered a brand, according to the uniform law of Benelux.

The usage of brand of the package form (envelope, box, bottle, etc.) has met a lot smaller resistance than that of the product form. Even the authors who reject the idea of brand protection for forms of products admit, for a change, that the form of the package can be used as a brand. In the present, many brands have this form. The Coca-Cola bottles constitute a well-known example of such a brand. In the same way many cosmetical products consist of the package form.

The law nr. 84/1998 concerning brands and geographical indications mentions the form of the package among the signs that can be registered as brands. Considering that the form is given to the product representing an external decoration, the form of the product is protected as drawing or industrial model. The model (or drawing) represents a prototype for manufacturing in series of an object, the characteristics of which will have to be respected. From this point of view, reported to other intellectual property rights, the drawings or industrial models enjoy autonomy: towards the author right since the form has to serve exclusively as prototype for the manufacturing of objects in series (being insolubly related to its support or material) and towards the patent of inventions because the form has to maintain the technical idea which conditions manufacturing and functioning of the object, a sufficient independence to constitute the proof of a creative activity.

So for the legal protection of the product form, it is considered admissible the accumulation between the rights of drawings, industrial models and that of brands. With all this, the right of brands does not have to be used to benefit from some more favourable dispositions or to avoid the application of imperative dispositions in the domain of drawings and models. The registration of brands does not have to favourize fraud especially by admitting the unlimited renewal of a brand deposit. It is also true that the distinction between brand and drawing or industrial model often meets difficulties. Drawings or models can often constitute distinctive signs to identify products.

In conclusion, the doctrine underlines the necessity of not admitting theft of brand rights and to respect the rights of creators of drawings or models, as well as that of distinctive signs and avoiding in the same time a confusion between drawings, models and distinctive signs. The deposit of a brand raises difficulties because the esthetic form of the product becomes a way of individualizing it, and the danger of its qualification as industrial model is related to its arrival to the public domain after a relatively short period. In many legislations, like the German and the English ones, the problem is solved by forbidding the deposit of models as brands. In the legislations where the problem is not expressively solved, the general protection is used to reprimed the act of non-loyal concurrence.

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