

Marcas no tradicionales, su admisibilidad y efectos en el derecho de la competencia

“So limited a “monopoly” as that cannot affect legitimate competition, and is of the very essence of any rational system of individual and exclusive trade symbols.” Frankl Schechter

CONTENIDO

I – Antecedentes y Justificaciones

II – Conceptos y Clases

- a. Visuales (Formas, Hologramas, Colores, marcas de posición: Levis' Straus, e imágenes en movimiento)
- b. No Visuales (Texturas: Old parr en Ecuador, sabores: "the taste of liquorice en Benelux, sonidos: y olores)

III. Problemáticas entorno al registro y efectos en el derecho de la competencia

- Registro: Distintividad / Funciones de la marca
- Efectos anticompetitivos?

I- ANTECEDENTES

- De los sellos de creta, inscripciones egipcias, Romanos, Etruscos a la persecución pública
- *De la Lex Cornelia de injuriis*, c. 81 B.C. a las marcas:
..Quién tome el nombre de otro como si fuera el suyo, y acción al consumidor que ha sido "depcionado"
- Del Estatuto de Parma a los derechos de los competidores – Monopolio de los gremios

FUNCIONES DE LA MARCA

- IDENTIFICADOR, DISTINGUIR:
 - ✓ EUROPA: ARSENAL FOOTBALL CLUB V. REED
- Perspectiva Económica (Landes y Posner): Elección del consumidor y motivación para el empresario para invertir en calidad.
- FUNCIÓN DE PUBLICIDAD O MERCADEO
 - ✓ Shechter, The rational basis for trade mark protection: "*To describe a trademark merely as a symbol of goodwill, without recognizing in it an agency for the actual creation and perpetuation of goodwill, ignores the most potent aspect of the nature of a trademark and that phase most in need of protection*".

- AG COLOMER EN ARSENAL: "*It seems to me to be simplistic reductionism to limit the function of the trade mark to an indication of trade origin...Experience teaches that, in most cases, the user is unaware of who produces the goods he consumes.*"
- J. LITMAN, "*Breakfast with Batman*": "*if competition is still the American way of doing business, then before we give our exclusive control of some coin of competition, we need or should need a justification. Protecting consumers from deception is the justification most familiar for trademark law, but it does not support assingning broad rights to prevent competitive or diluting use when no confusion seems likely*"

EUROPA

- Dyson v. Registrar of Trade Marks
- Sieckmann v Deutshes Patent und Markenamt:

"Balsamically fruity colour with a slight hint of cinnamon": C₆H₅-CH=CHCOOCH₃ +laboratorios



Clara, Precisa, completa en sí misma,
fácilmente accesible, inteligible, duradera
y objetiva.

LIBERTEL: ¿En qué circunstancias el color es distintivo?

- Mercado y bienes restringidos y específicos
- ¿Se limitará considerablemente a la competencia?



- “In that regard it must be pointed out that a colour per se cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used.
- A verbal description of a colour, in so far as it is composed of words which themselves are made up of letters, does constitute a graphic representation of the colour ...

“It must be borne in mind that, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used...”

- UK CASO CADBURY
- Análisis de distintividad
- Importancia de la reivindicación gráfica: clara, duradera, fácilmente accesible, objetiva e inteligible
- Otras opciones de protección: "Passing off"



ESTADOS UNIDOS



CIRCUIT JUDGE JOSE CABRANES:

- *"We see no reason why a single-color mark in the specific context of the fashion industry could not acquire secondary meaning—and therefore serve as a brand or source identifier—if it is used so consistently and prominently by a particular designer that it becomes a symbol."*

CONFUSIÓN DEL CONSUMIDOR, NOTORIEDAD, COMPETENCIA DESLEAL?



Koninklijke Philips Electronics V. Remington Consumer Products Ltd

- *"the directive in no way requires that the shape of the article in respect of which the sign is registered must include some capricious addition"*



¿AMPLIA PROTECCIÓN?

*· There is no class of marks having **a distinctive character** by their nature or by the use of them which is not capable of distinguishing goods or services within the meaning of Article 2 of the Directive".*

*"where the functional characteristics of the shape of a product **are attributable solely to the technical result**, article 3(1) (e), second indent, precludes registration of a sign consisting of that shape, even if that technical result can be achieved by other shapes"*

ANÁLISIS DE DISTINTIVIDAD EN EL OJO DEL CONSUMIDOR

- *"where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods may be sufficient to give the sign a distinctive character"*
- *Las cortes analizarán la posición de los consumidores de acuerdo con la naturaleza de los bienes; es decir, si se trata de bienes de lujo o rutinarios*

PROCTER & GAMBLE V OHIM



- Para el consumidor la forma del producto no es tan importante
- Argumento de PROCTER: El bien es un de uso diario, así que la forma es un factor determinante en la elección del consumidor

MARCA DESCRIPTIVA

CASO LINDE AG. WINWARD INDUSTRIES INC. RADO
UHREN AG V DEUTSCHES PATENT UND MARKENAMT:

*The bar on registration of descriptive marks apply to
shape goods marks....May be freely used by all"*

"A. Folliard –Monguiral, "Distinctive character
acquired through use"

BATALLA DE FORMAS

CADBURY V. NESTLÉ (KIT KAT)

- ¿Es necesaria inherente distintividad?
- ¿Sí es distintiva pero tiene efectos anticompetitivos?



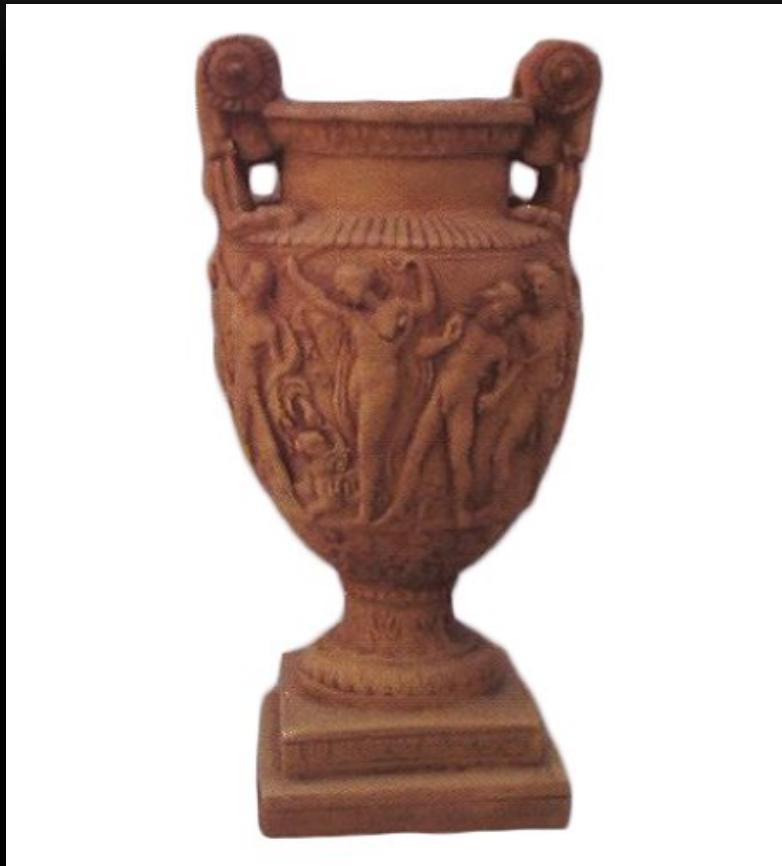
LAS FORMAS, la Libertad de expresión y Parodia



- *Its resemblance to Plaintiff's famous trade dress is too muted to poke fun*

Hershey Co. v. Art Van Furniture, Inc.

TWO PESOS AND DURACO PRODS V. JOY PLASTIC ENTERS



- 1. Forma inusual y que perdure en la memoria
- 2. Conceptualmente sea separable del producto
- 3. Identifique el origen del producto

EFFECTOS EN LA COMPETENCIA?

- Wallace Int'l Siversmiths, INC v. Godinger Silver Art CO:

AESTHETIC FUNCTIONALITY

- Shire US Inc. v. Barr Labs:
Color de pastillas genéricas
- *TraFFix Devices, Inc. v. Marketing Displays, Inc*

INQUIETUD: POST- IT
NOTES?



MARCA SONORA

- Metro Goldwin Meyer
- Shield Mark BV contra Joost Kis h.o.d.n. Memex:
"Kukelekuu" (Benelux)
"Cock a doodle do"



- CONCLUSIONES