

PROTECTION OF PRODUCT DESIGNS: TRADE DRESS APPROACH

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Abstract

Product designs can play a very important role in consumer choices as it affects this first encounter. Product design can be considered to be a subclass of Industrial design. It can be easily imitated because its nature is ornamental or aesthetic aspects of the article and display the public. So, it is needed to protect for the benefit of creators and consumer. The laws provide overlapping protection for non-functional or ornamental product designs but the nature and extent of such protections have led to some confusion among practitioners and scholars. Product designs can be protected by way of industrial design rights and/or trade dress rights. When trade dress is distinctive of the products of a particular manufacturer or merchant, it may be protected as a three dimensional mark or trade dress. The main purpose of trade dress protection of product design is to protect the consumer from accidentally purchasing products that are designed to imitate other products. The scope of the research is protection of industrial design under trademark law and unfair competition law. This paper clarifies the nature and extent of protection product design under trademark law and the appropriateness of this protection for lack of specific industrial design law.

Key Terms: Industrial Design, Product Design, Secondary Meaning, Trade Dress, Inherent Distinctiveness and Acquired Distinctiveness.

Introduction

New products are appearing on the market daily. Products play a very important role for the enjoyment of our lives. Mostly, consumers will choose to buy based in part on a good overall impression, a good brand and an attractive product design or product shape. So, product design is also a major tool for building brand personalities and for creating product and company images. As a result of continuous growth of competing products in several businesses, the role and impact of product design becomes a means of product communication. Product design can build favourable consumer associations.

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So, product differentiation is a very important method for companies that operate in competitive environments.

Product design can be considered to be a subclass of industrial design. In legal sense, the industrial design of a product contributes to its appeal and can be a major factor in the commercial success of a product. In the early days, some characteristic of industrial design may be protected under patent law, that is called design patent. Sometime, the product design or packaging composed original artistic aspects or work of applied art, it can be protected by copyright law. The industrial design of a product or its packaging may be protected under trademark law; it can be called product design or trade dress or three-dimensional mark.

The main legal system for the protection of a product design is industrial design law. In addition to the protection of industrial design approach, the ornamental or aesthetic nature of the some products, having to meet the legal requirements for protection, can be protected by registering a three-dimensional trademark or get-up or trade dress under the respective trademark law. Trade dress is one of the categories of trademark and includes the shape and design of the product itself. This paper will analyze protection of product designs by way of trade dress protection under trademark law.

This research paper will begin with the concept of product design. It will then describe the product designs protection under trademark approach including the advantages and disadvantages of that system. The purpose of this research is to analysis the way of protection of product designs under trademark system of other countries and to focus the approach of product design protection in Myanmar based on the current practice of trademark protection. Because, our country is a developing country and cannot expend the effort to create the other industrial design categories such as hull design, car design. The individual creator and SMEs of our country face difficulty to protect product design under industrial design approach.

Material and Methods

A descriptive, comparative and an analytic method are applied in this paper. The materials used for the purpose of the research are books, articles

and internet sources. Some data collected from interviewing with individual creator of industrial design.

Concept of Product Designs

Product design is the visual appearance and can be one of the key parts of the successful of products. In legal sense, there is no separate definition of product design in international conventions but product design can be considered to be a subclass of industrial design. The simple legal definition of an “industrial design” as defined by the World Intellectual Property Organization is that “an industrial design generally constitutes the ornamental or aesthetic aspects of various articles, such as the three dimensional features (e.g., shapes) or two dimensional features (e.g., patterns, lines or colors) of packages, containers, furniture, household goods, lighting equipment, jewelry, electronic devices, and textiles.” Industrial designs may also be relevant to graphic symbols, graphical user interfaces (GUI), and logos.¹ Industrial design is also important in relation to packaging, containers and “get-up” of products.²

The concept of protection of product design provides the model law of WIPO. Article 2(1) of Industrial Design Law provides “industrial design right shall protect the three-dimensional or two-dimensional design of the whole or a part of a product to the extent that it fulfils the requirements as to novelty and individual character”. Article 2(2) states that “the term design shall mean the appearance (outer look) of a product, or the part thereof, characterised by its visible features, in particular: shape, contours, colour composition, texture, lines, motives, or a combination of these features”. According to Article 2(3), “for the purpose of this Law the term product shall mean any article manufactured by industry or handicraft”.³

The purpose is to protect the imitation of innovative product appearances design. Basically, the legal protection of product design is done the same way as industrial design. The scope of industrial design protection is

¹ www.wipo.int/designs/en/.

² Looking Good: An introduction to Industrial Designs for Small and Medium-sized Enterprises. WIPO publication No.498, p 3.

³ https://www.wto.org/english/thewto_e/acc_e/hrv_e/WTACCHRV57_LEG_7.pdf.

so wide. So, this research paper will limit the scope of product design protection under trademark law.

Industrial designs have been granted protecting the shapes such as; automobiles, computers and bottles, silverware engraving, and lamp characteristics. Since product design became an integral part of the manufacturing process during the industrial revolution, the protection of industrial design has been recurring topic among industrial designers and intellectual property scholars. The functions of the product may be protected by a registered patent, provided that the patentability requirements are fulfilled. If the product design or packaging composed artistic aspects and original works of authorship, they may be capable of copyright protection. The design of a product or its packaging may be protected under trademark law, given that the requirements are fulfilled.¹

Relationship between Product Designs and Trade Dress

In another jurisdiction, trademark laws also may be applied to protect 3-D marks, including trade dress, if they are distinctive signs capable of distinguishing goods with respect to the origin of the goods to avoid from deceiving consumers. In some jurisdictions, laws of unfair competition, including the common law of passing off, would also apply to industrial designs.²

The role of product design plays in reinforcing brand power. So, protection of product design can also be found under trademark law. A trademark is a word, phrase, symbol, or design, or combination of the same, which identifies the source of the goods or service. If the form, design or packaging of a given product is or becomes a distinctive feature of the product

¹ Regan E. Keebaugh, Intellectual Property and the Protection of Industrial Design: Are Sui Generis Protection Measures the Answer to Vocal Opponents and a Reluctant Congress?, *Journal of Intellectual Property Law*, Volume 13, Issue 1, Article 8, October 2005, University of Georgia School of Law, p.256.

² Jay Dratler, Jr, "Trademark Protection for Industrial Designs", *University of Illinois Law Review* No. 887, 1998, p 17.

in question, then in some countries it may be protectable as a three-dimensional trademark or as trade dress under the trademark law.¹

Article 6(1) of the Paris Convention states in respect of trademarks that: "The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation". Article 15.1 of the TRIPs Agreement states that a trademark should be defined as: "any sign capable of distinguishing the goods or services of one person from those of other persons". In this provision, the three-dimensional sign or trade dress can be protected under trademark regime.

Protection of trademarks is not limited to words or symbols, but can be extended to encompass almost anything that would tend to be associated or be capable of being associated with a single source. Trademark protection is only conferred if the shape or design is distinctive enough to function as a badge of origin. A trademark as applied to product design is commonly referred to as "trade dress."² The unique shape of a bottle of Coca-Cola and the peculiar triangular shape of the Tobler one chocolate bar are examples of three-dimensional marks or trade dress. The shape of the bottle of Coca-Cola was initially an industrial design and only later it was registered as a trademark in many countries.³

Trade dress is defined as "the overall appearance and image in the marketplace of a product or a commercial enterprise". Trade dress encompasses many characteristics of a product including color, size, weight, texture, shape, and graphics, or a combination of these characteristics. And then, the design and shape of a product which has distinctive feature, is also qualified to be protected as a trade dress. The primary purpose of a trademark or trade dress is to indicate the owner or producer of the commodity and to distinguish it from like articles manufactured by others. Trade dress may also refer to the manner in which a product is packaged, wrapped, labeled,

¹ http://www.wipo.int/edocs/mdocs/sme/en/wipo_ip_bak_03/wipo_ip_bak_03_www_34147.pdf.

² <https://martensenwright.com/en/trade-dress-product-design/>.

³ www.wipo.int/export/sites/www/sme/en/.../pdf/ip_panorama.

presented, promoted, or advertised, including the use of distinctive graphics, configurations, and marketing strategies.¹

In some countries, an industrial design functions as a trademark in the market place, then it may be protected as a three-dimensional mark, this may be the case of when the shape of the product or its packaging are considered to be distinctive.² Trade dress law can sometimes protect the design configuration and shape of the product itself, although in some cases obtaining an industrial design protection may be more appropriate than using trade dress protection.

Acquisition of Industrial Design Rights on Product Designs

If the company develops new designs, the owner should think carefully about how to best protect them. In most countries, a product design needs to be registered in order to be protected under industrial design law as a “registered design”. In some countries, industrial designs are protected under patent law as “design patents”. In other countries, industrial design law grant without registration, called “unregistered industrial designs”, but the time and scope are limited.³

The international conventions, WIPO administers treaties, together with national and regional laws make up the international legal framework for industrial designs. Under the Paris Convention for the Protection of Industrial Property 1883, industrial designs must be protected in each Contracting State, and protection may not be forfeited on the ground that articles incorporating the design are not manufactured in that State.⁴

As some products are manufactured and sold internationally, the obtaining of an industrial design right in multiple countries is needed.

¹ Jay Dratler, Jr, “Trademark Protection for Industrial Designs”, University of Illinois Law Review No. 887, 1998, p 21.

² B.W. Gray, K. Murphy, E. Bouzalas, Industrial Design Rights: An International Perspective, 2016, Kluwer Law International, p.33.

³ Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), 2002, Industrial Designs and Their Relation with Works of Applied Art and Three Dimensional Marks, WIPO SCT 9/6, p.3.

⁴ Article 5*quatuorquies* of the Paris Convention of Industrial Property, 1967 refers to the Stockholm Act dated 14 July 1967 of the original Paris Convention for the Protection of the Industrial Property 1883.

However, such obtaining of protection can become costly and complex. For example, the Hague System for the International Registration of Industrial Designs 1925 can provide a more cost effective and simple approach for the attainment of industrial design registration in multiple countries.¹

The Locarno Agreement Establishing an International Classification for Industrial Designs (1968) establishes a classification for industrial designs (Locarno Classification). The competent offices of the Contracting States must indicate in official documents reflecting the deposit or registration of industrial designs the numbers of the classes and subclasses of the classification of which the goods incorporating the designs belong.²

To ensure better coexistence and consistency of the systems of design protection in individual EU countries, the EU adopted Directive 98/71/EC on the legal protection of designs in 1998. The objective of the Design Directive is to ensure that registered design rights give the right holder equivalent protection in all EU countries.³

Unlike the US, Australia and Japan, unregistered designs are protected through the unregistered community design route in the EU. In the US, Australia and Japan unregistered designs may only be protected through trademark and copyright law. Unregistered community designs are suitable mainly for small companies or freelancers to protect their products for a short period, for example, fashion since the registration process is costly and time consuming.⁴

The protection of unregistered designs is basically aimed at protection against imitation and fraud. If it is recognized that such designs must be protected for a period longer than 3 years, such design protection can be transferred to long-term protection as a registered design within 12 months from the start of marketing.⁵

¹ http://www.wipo.int/treaties/en/registration/hague/summary_hague.html.

² http://www.wipo.int/treaties/en/classification/locarno/summary_locarno.html.

³ https://ec.europa.eu/growth/industry/intellectual-property/industrial-design/protection_en.

⁴ Sharifa Sayma Rahman, Industrial Design in Different Jurisdictions: A Comparison of Laws, 2014, Journal of Intellectual Property Rights, Vol 19.

⁵ Mr. Riichi Ushiki, Legal Protection of Industrial Designs, Patent Attorney USHIKI International Patent Office, 2001, Japan Patent Office.

Acquisition of Trade Dress Rights on Product Designs

Besides industrial design right, the product design that relates to the appearance of the product or shape of packaging may be also protectable as trade dress under trademark law or under unfair competition law.

When trade dress is distinctive of the products of a particular manufacturer or merchant, it may be protected as a trademark. Thus, a trademark is a form of trade dress that serves to distinguish the goods or services of one undertaking from those of another.¹

The purpose of both trademark and unfair competition law is to protect the public, as well as the source of goods identified by the trademark. The test for determining infringement in both cases is the likelihood of confusion. A trademark is a word, name, symbol, device, or any combination thereof, which serves to indicate the source of the product with which it is used. The specific source need not be known to the purchasers of the trademarked product. Instead, it is sufficient that a single entity exists which controls use of the trademark. The ability of a mark to indicate the source, and to distinguish that source from the source of goods made or distributed by others, is called distinctiveness.²

Trade dress can be protected through common law rights. Prior to 1964, some configurations of goods were protected under unfair competition laws. Although some of those designs may have been so arbitrary that distinctiveness was not an issue, in most cases, secondary meaning was the test used to determine whether the design performed as a mark to indicate the source of the goods. This test was analogous to the test for determining whether trademark rights had developed in a descriptive word or group of words, such that they qualified as "not merely" descriptive. Functional designs, like generic words, were not protected but were free for all to use. The test for infringement was likelihood of confusion.³

¹ Judy Winegar Gons, *Intellectual Property Principles and Practice*, 2014, Nathan Associates Inc, p.248.

² Pegram, John B., *The Scope of Industrial Design Protection under Trademark and Unfair Competition Laws*, 1989, *University of Baltimore Law Review* : Vol. 19: Iss.1, Article 16.

³ Ibid

Generally, an application to register trade dress must include all the same content as a trademark application. The recognition and protection of trade dress rights can search under International Provisions relating to Trademark. "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark."¹ Such signs, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for protect as trademarks.

Trade dress must be both distinctive and nonfunctional. Most trade dress is protected without registration. Trade dress that is not inherently distinctive can be registered. If an owner can show secondary meaning, it can be registered. In United States, the trade dress can be registered on the United States Principal Register. And then, it follows that if trade dress is not registered, it is still protectable under the Lanham Act, as long as the trade dress owner can show distinctiveness and that it is non-functional.²

In the United States, similar to trademarks, a product's trade dress is legally protected on the United States Principal Register by the Lanham Act³. The Lanham Act is the Federal Statute that regulates and protects trademarks and trade dress. And then, it follows that if trade dress is not registered, it is still protectable under the Lanham Act, as long as the trade dress owner can show distinctiveness and that it is non-functional. So, some of the well-known marks which creates new product design, can enjoy an unregistered trademark rights.⁴

Protectability of Product Design as Trade Dress

A product design is protectable as "trade dress" when it functions as a trademark, i.e., when the configuration serves to identify the source of the

¹ Article 15(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement 1994)

² <https://www.justia.com/intellectual-property/trademarks/trade-dress/>.

³ The Lanham Act, also known as the Trademark Act of 1946, is codified at 15 U.S.C. §1051 et seq.

⁴ <https://corporate.findlaw.com/intellectual-property/trade-dress-the-forgotten-trademark-right.html>

product. In order to be trade dress rights, the design must be distinctiveness and non-functional.¹

1. Inherently Distinctiveness

The trade dress must be distinctive (i.e, unusual and memorable) so that it can serve primarily as the designator of origin of the product or service. The same distinctiveness principles apply in the context of trade dress, although selection is from designs and configurations, not words. Since the categories of distinctiveness apply equally to trade dress as to trademarks and since many courts discuss distinctiveness in terms of marks. However, trade dress is not inherently distinctive and can acquire distinctiveness only if it has developed secondary meaning.²

In order to determine whether a particular trade dress has attained this requisite level of distinctiveness, the courts classify the distinctiveness of the trade dress into one of the following four categories of increasing distinctiveness: (1) generic; (2) descriptive; (3) suggestive; or (4) arbitrary or fanciful.³

In the case of *Duraco Products Inc. v. Joy Plastic Enterprises Ltd.*,⁴ in order to be considered the trade dress right, there must be inherently distinctive. One court has required that it “must be unusual and memorable, conceptually separable from the product, and likely to serve primarily as a designator of origin of the product.”

However, *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*,⁵ the U.S. Supreme Court ruled that product designs such as the appearance of a line of children’s clothing are not inherently distinctive and can only be protected if they acquire distinctiveness through sales or advertising.

¹ Intellectual Property Practice Group, Protection of Product Configurations: Supreme Court To Review Samara Brothers Intellectual Property Practice Group Newsletter - Volume 3, Issue 3, Winter 2000.

² Ibid

³ Joel W. Reese, Defining the Elements of Trade Dress Infringement under Section 43(A) Of The Lanham Act, Texas Intellectual Property Law Journal, 1994, p.108.

⁴ 40 F.3d 1431 (3d Cir. 1994).

⁵ 529 U.S. 205 (2000).

In China, trade dress protection provides exclusive rights over a certain product get-up that acts as an indicator of origin. In order to qualify for protection, a trade dress must have a unique quality, rather than being common or generic, so that it can be distinguished from the get-up of other products in the market. The trade dress and associated products must also have acquired a substantial level of reputation, so that the relevant public would recognize the product get-up as originating from a certain source.

Acquired Distinctiveness or Secondary Meaning

If the trade dress has not inherently distinctiveness, the owner must prove that it has acquired distinctiveness or secondary meaning. Public disclosure can be helpful to establishing trade dress rights because shape of the product is distinctive. It means that it has developed a “secondary meaning” in the minds of consumers. This means that consumers have come to associate the design with the source of the product.

Secondary meaning exists when a term that otherwise describes a product has become so affiliated with a specific product’s maker that it has taken on a second meaning. Secondary meaning requires only that customers associate the word or symbol with a single, albeit anonymous, commercial source. The more descriptive and the less inherently distinctive the word, symbol, or trade dress, the greater the quantity and quality of evidence of secondary meaning must be to prove that level of distinctiveness necessary to achieve trademark, service mark, or trade dress status.¹

In the case of *United Distilleries vs. Jagdish Joshi*² dealt with the issue of copying trade dress on different goods. In the case, the plaintiff the owner of trade mark JOHNNIE WALKER for Scotch Whisky objected to the use of a similar trade dress being used on Gutka (Chewing Tobacco). The defendant adopted the “device of striding figure and the slanting label” for their products “Gutka”. The High Court of Delhi found that was imitation of the trade dress and explanation of having adopted the trade mark based on Hindi film personality was not accepted in view of the overall similarity between the trade dresses of the marks of the plaintiff and defendant.

¹ Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, 4th edition, 2003.

² 2000 PTC 502 (Del).

2. Non-functionality

To be protectable for trade dress protection for product designs, it must be non-functional. Ornamentation that is subject to an industrial design cannot be a functional aspect of the invention. The feature is functional if it is essential to the use or purpose of the article. For example, the shape and color combinations used in cellular phones are often not essential to the article's purpose or use, it is essential for transmitting information. If the mobile phone's exterior housing were deemed to be a creative invention, the inventor would be entitled to an industrial design rights.

Non-functionality, along with distinctiveness, determines whether a particular trade dress is entitled to protection. If the trade dress has acquired the requisite level of distinctiveness and is nonfunctional, then the trade dress is entitled to protection. The absence of either distinctiveness or non-functionality causes the trade dress to be ineligible for protection, because consumers, as a matter of law, do not associate the trade dress with a particular source.¹

Infringement of Trade Dress Right

Trade dress encompasses the total image and impression created by a product. Trade dress infringement occurs when one company uses trade dress similar enough to another's to cause a "likelihood of confusion" in an ordinary buyer's mind.² While trademark prevents others from copying the name of the good or service, trade dress prevents copying the appearance. To sue for infringement of trade dress, the owner must be able to articulate and prove that the trade dress is inherently distinctive, or has acquired secondary meaning, and that the junior use is likely to cause consumer confusion. Trade dress can be protected only if the owner of the trade dress can show the average consumer would be confused as to the origin of a product if another product appears in the same or similar packaging.³

¹ <https://corporate.findlaw.com/.../trade-dress-the-forgotten-trademark-right.html>.

² <https://www.upcounsel.com/trade-dress-infringement>.

³ Jeffrey S. Edelstein and Cathy L. Lueders, Recent Developments In Trade Dress Infringement Law, 2000, IDEA: The Journal of Law and Technology, p.7.

These same factors are normally considered in deciding the issue of likelihood of confusion in other trademark infringement cases as well as trade dress infringement cases.¹ In US, the Circuit Courts use a number of factors as a guideline for determination of whether there is likelihood of confusion or not. The courts generally consider: strength of the plaintiff's trade dress; proximity of goods; similarity of the plaintiff's trade dress and the defendant's trade dress; level of purchaser care; marketing channels utilized by both parties; evidence of actual confusion; defendant's intent in adopting the trade dress and likelihood of expansion of product lines.²

Advantages of Trade Dress Protection on Product Designs

The advantages of trade dress protection for product designs is that it can be perpetual as long as the mark continues to be used in commerce and can be renewed any number of times. In some circumstances, the two types of protection can exist simultaneously. Firstly, product design can make to secure industrial design protection. And then, the owner can develop the trade dress rights during a half before the industrial design expires. A company can start with industrial design protection and finish with trade dress protection. Trade dress helps the illiterate people who cannot read the trademark on the product as well as the manufacturers to reach the people easily.

Enforcement of Product Design Rights

Product design rights are usually enforced in the Registration Office or Intellectual Property Court, generally on the initiative of the owner of the rights, as provided for by the applicable law. The remedies and penalties vary from country to country and could be civil (injunctions to desist from an infringement, payment of damages, etc.), criminal or administrative.

1. Injunction

. When a court issues an injunction in a trade dress case, it stops the defendant company with a court order from continuing to use the trade dress in question. Courts can limit the use of trade dress through an injunction. In

¹ <http://www.thefashionlaw.com/learn/trade-dress>.

² INTA, The Trademark Reporter, Annual Review, Vol 97, March-April, 2007, No 2, p.126.

Hamdard National Foundation vs. Abdul Jalil,¹ the issue of trade dress and dilution of trade mark in relation to dissimilar goods was in issue under Section 29(4) of the India Trade Marks Act, 1999. It is to be pointed out that the dilution of trade mark is a concept unrelated with confusing similarity or imitation of trademarks or similarity of trade dress. Even if confusing similarity is not proved, still the rights holders may desire an injunction for which dilution of the trade mark is alleged.

2. Monetary Relief

A court might also award a plaintiff with money damages in the form of actual losses suffered by the plaintiff due to the trade dress infringement, and/or recovery of the defendant's profits that resulted from the infringement.²

3. Attorneys' Fees

In rare cases, the winning party in an infringement suit might be entitled to recover the cost of their legal fees.

Trade Dress Protection of Product Designs in Myanmar

Myanmar needs to build a fair market competition system and to create a safe and secure environment for the consumers by preventing the flow of counterfeit marks and products. In Myanmar, industrial design systems are still in the developing stage and there is no specific law for the protection of industrial design rights. In the early days, there has been the statute law for industrial design protection that was Design and Patents Act 1945. And then, the Patents and Designs (Emergency provisions) Act, 1946 came into force in Myanmar when the Patents & Design Act of 1945 was repealed in 1993. This Act was not legally effective until then because Section 2 of the Act stipulates that it would not enter into force until the Myanmar Patents and Designs Act of 1945 was repealed.

There is no substantive law in operation on industrial designs. But, there was a trade dress protection in Myanmar. In *U Tin Latt (a) U Sai Latt and one other v U Kyaw Nyein*³ case, the judges described that “a trademark

¹ 2008 (38) PTC 109 (Del).

² <https://www.upcounsel.com/trade-dress-infringement>.

³ Special Appellate Civil Case No. 23, 2000.

includes a device, brand, heading etc. and any combination thereof.” This case is arisen out of the “Taung Gyi Mauk Mai,” medicated Thanetkhar which is used as cosmetics and the different name “Shan Mauk Mai” but similar trademark, get-up, size of plastic container and instruction cause the passing off action. Although the names are different, similar trademark, get-up, size of plastic container and instruction cause likelihood of confusion and it cause the passing off action. In an infringement action of trade dress, the plaintiff has to prove is that he is the true owner and that the defendant is using a get-up which is either the same or similar to his trade dress. The desicions is temporary injunction in favour of the owner of Taung Gyi Mauk Mai.

Form September 1, 2017, the registration of industrial design was not allowed. In Myanmar, the individual product designer or the SMEs still faced difficulty to protect the design of their products. With the interviewing of some owners of product design, they have need IP awareness how to protect their product design in local and aboard.

Although there is no separate trademark registration legislation in Myanmar, a traditional practice of trademark is more develop than other categories of intellectual property. Trademark system and practice in Myanmar is more familiar than industrial design protection. The owner of product design can use the same process for trademark registration, purporting to be the trade dress right.

The declaration must be made by the trademark owner and must include a description of the goods and services and a copy of the trademark. So, they can protect their product as three-dimensional sign or trade dress which have qualified the require standard. If there is an infringement, the civil or criminal litigation process can be used. In addition, if a product design is branded, it can generally be protected by a well-known trademark right instead of a design right. If there is infringement of the product design, the brand will be diluted.

Although there is no trademark registration legislation in Myanmar, a traditional practice has developed. The owner of product design purporting to be the trade dress right can make a Declaration of Ownership and register the

declaration with the office of the Registrar of Deeds and Assurances. The individual product designer or the SMEs still faced difficulty to protect the design of their products. The declaration must be made by the trademark owner and must include a description of the goods and services and a copy of the trademark. So, they can protect their product as three-dimensional sign or trade dress which have qualified the require standard. They can use the same process for trademark registration. If there is an infringement, the civil or criminal litigation process can be applied.

Findings and Discussions

Product designs are business assets that can increase the commercial value of a company and its products. The more successful a design, the higher is its value to the company and its brands. Myanmar needs to protect trade dress rights in line with current economic system. In Myanmar, conducting a search for registered or product configuration trade dress marks may be difficult and the detail trademark and trade dress search system is essential. A review of the results as well as the associated file histories can provide further suggestions for the best approach to take to successfully register a specific product configuration trade dress. There is necessary the formality or substantive examination, opposition or publication in a gazette. There should establish separate intellectual property office for industrial design registration, trademark and trade dress registration in order to harmonize international practice.

Myanmar is a member of WTO, WIPO, and ASEAN. In accordance with the TRIPs Agreement, Myanmar is required to implement and comply with Articles 1-12, Article 19 of the Paris Convention and the terms of TRIPs by no later than 1st July 2021. In Industrial Design Law (Draft)¹, industrial design means “the lines, sketches, colour, shape, configuration, pattern, features or ornament applied to a product or external features of a whole or part of the product resulting from features and ornament, by any industrial or manual process”. And then, that draft law defines “product means any product

¹ Industrial Design Law (Draft), published at the date of 8th, 9th, 10th August, 2017 in the Mirror Newspaper.

made by any industrial or manual process”. This expression is not adequate enough and it should define more clearly.

The Industrial Design Law (Draft)¹ describes that in order for a design to be registrable, the design must be novel, sufficiently distinctive and must be not disclosed to the public. The requirement of distinctiveness is a new introduction under the draft law and requires that the design must not be identical with, or similar to, known designs while at the same time requiring the design to be “significantly distinct”. However, there should add the factors which are for determination of distinctiveness. And then, there should define the requisite degree of similarity.

The Trademark Law (Draft)² provides a broad definition of trademark that “signs capable of distinguishing the goods and services”. It is consistent with Article 15(1) of TRIPs Agreement. Under this definition, the product design can be protected as a trademark, if the design is distinctive. The expression “shape of a product” should be explicitly mentioned in the definition of a mark. In order to encourage producers to invest in product designs in Myanmar, there should be accessible, modern and effective legal protection.

Conclusion

Intellectual property rights should be considered as a critical safeguard in protecting a business’s investment in their product design. For a corporate marketing strategy, the brand and design should be developed to attract customer’s attention and should be legally protected. When protecting innovative three-dimensional designs, many often consider two distinct possibilities of protection: industrial design or trade dress. Many companies have tried to establish trademark rights in their unique design elements, called trade dress. Despite some popular misconceptions, these protections are not mutually exclusive; in fact they can be complementary. But, there are the differences as well as the advantages of each. The combination of industrial

¹ Industrial Design Law (Draft), published at the date of 8th, 9th, 10th August, 2017 in the Mirror Newspaper.

² Trademark Law (Draft), published at the date of 8th, 9th, 10th August, 2017 in the Mirror Newspaper.

design and trademark protection provides a broader level of investment protection than either property right alone could provide. By designing products with built-in industrial design and trademark protection, businesses can extend property and investment protection indefinitely.

And then, courts are familiar with trademarks and thus laws for enforcing trademark rights are more developed for the laws for design rights. So, registration and protection process of trademark rights is more possible than registration and protection industrial design rights. Armed with trade dress rights, a firm may prevent competitors from marketing products with similar designs. Providing strong protection for industrial design is the first step in encouraging growth in the design industry. The current level of protection for industrial design in Myanmar is simply too weak to accomplish the goal of building a strong design industry in Myanmar. Although industrial design can be protected through design patents, copyright, and trade dress, all of these methods of protection have limits and difficulties that render them inadequate for the protection needs of industrial designers.

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References

Conventions and Agreements

Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (TRIPs Agreement).

Paris Convention for the Protection of the Industrial Property (1883).

The Hague Agreement Concerning the International Deposit of Industrial Designs, 1925.

The Locarno Agreement Establishing an International Classification for Industrial Designs, 1968.

Books

- B. W. GRAY, K. MURPHY, E. BOUZALAS, 2016, *Industrial Design Rights: An International Perspective*, Kluwer Law International.
- Budi Suratno, *Industrial Design Protection in Indonesia: A Comparative Study of the Law on Industrial Design Protection between Japan and Indonesia*.
- Hugh Griffiths, 1993, *Overview of Developments in Europe on Industrial Design Protection* Fordham Intellectual Property, Media and Entertainment Law Journal, Volume 4, Issue 1, Article 25.
- Intellectual Property Practice Group, 2000, *Protection of Product Configurations: Supreme Court To Review Samara Brothers Intellectual Property Practice Group Newsletter - Volume 3, Issue 3*.
- Jay Dratler, Jr, *Trademark Protection for Industrial Designs*, University of Illinois Law Review No. 887, 1998.
- Joel W. Reese, *Defining The Elements of Trade Dress Infringement Under Section 43(A) Of The Lanham Act*, Texas Intellectual Property Law Journal, 1994.
- Judy Winegar Gons, 2014, *Intellectual Property Principles and Practice*, Nathan Associates Inc.
- Looking Good: *An Introduction to Industrial Designs for Small and Medium-sized Enterprises*, 2005, WIPO publication No.498.
- Max Ng Chee Weng, Daniel Lim Ying Sin and Adrian Loke Weng Hong, 2002, *Law for Business Series Intellectual Property*, LexisNexis.
- Mr. Riichi Ushiki, 2001, *Legal Protection of Industrial Designs*, Patent Attorney USHIKI International Patent Office, Japan Patent Office.
- Regan E. Keebaugh, 2005, *Intellectual Property and the Protection of Industrial Design: Are Sui Generis Protection Measures the Answer to Vocal Opponents and a Reluctant Congress?*, Journal of Intellectual Property Law, Volume 13, Issue 1, Article 8, University of Georgia School of Law.
- Sharifa Sayma Rahman, 2014, *Industrial Design in Different Jurisdictions: A Comparison of Laws*, journal of Intellectual Property Rights, Vol 19.
- Susanna Monseau, 2012, *The Challenge of Protecting Industrial Design in a Global Economy*, Texas Intellectual Property Law Journal, Vol.20, No.3.
- Thomas McCarthy, 2003, *McCarthy on Trademarks and Unfair Competition*, 4th edition.
- WIPO Magazine, November 2012.

Cases

Duraco Products Inc. v. Joy Plastic Enterprises Ltd., 40 F.3d 1431 (3d Cir. 1994).

Hamdard National Foundation vs. Abdul Jalil, 2008 (38) PTC 109 (Del).

U Tin Latt (a) U Sai Latt and one other v U Kyaw Nyein, Special Appellate Civil Case No. 23, 2000.

United Distilleries vs. Jagdish Joshi, 2000 PTC 502 (Del).

Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (2000)

Internet Sources

http://www.wipo.int/designs/en/faq_industrialdesigns.html.

http://www.wipo.int/treaties/en/classification/locarno/summary_locarno.html.

http://www.wipo.int/treaties/en/ip/paris/summary_paris.html.

http://www.wipo.int/treaties/en/registration/hague/summary_hague.html.

<https://corporate.findlaw.com/intellectual-property/trade-dress-the-forgotten-trademark-right.html>.

https://ec.europa.eu/growth/industry/intellectual-property/industrial-design/protection_en

<https://www.justia.com/intellectual-property/trademarks/trade-dress/>

<https://www.upcounsel.com/trade-dress-infringe>