



Newsletters

Intellectual Property Update: Current Issues and Practical Advice for Businesses - February 2010

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Basic Geometric Shapes Are Subject to Copyright Protection

A Texas court recently held, in *Glasscraft Door I., L.P., et al. v. Seybro Door & Weathership Co., Inc.*, 2009 WL 3460372 (S.D. Tex. 2009), that common geometric shapes contained in useful items, such as door panels made up of wrought iron and beveled glass, are protected under copyright law.

Plaintiff in *Glasscraft Door* designed decorative door panels consisting of common geometric shapes, such as circles, stars, ovals and arches. It sued for copyright infringement based upon its competitor's knock-off designs. Defendant argued that plaintiff's designs did not meet the copyright requirements for creativity and, therefore, that plaintiff had no copyright protection in its door panels.

The court stated that the threshold for copyright protection is low and that copyright protects designs with only minimal degrees of creativity. Accordingly, it rejected defendant's argument and held that while the individual basic geometric shapes alone are not subject to copyright protection, their creative selection and arrangement is. The court therefore found that each of plaintiff's 22 designs asserted in the lawsuit were both protected by copyright and validly registered. Because plaintiff had registered the copyrights in its designs before they were infringed upon, it was able to seek substantial money damages, including defendant's profits, its own lost profits, and its attorneys' fees and costs for bringing the lawsuit.

This case highlights the fact that common basic shapes can be subject to copyright protection if they are part of a selection and arrangement that rises to the level of creativity required under copyright law.

Geographic Scope of a CTM Registration Is Called Into Question

A case commonly known as ONEL/OMEL is currently causing a stir in the European Union (EU). The reason is that the longstanding rule that use of a mark in one EU member state is sufficient to support a Community Trademark (CTM) Registration is being called into question.

Onel is the name of a small firm in the Netherlands. It owns a CTM Registration for the mark ONEL for Class 35, 41 and 45 services. A competitor owns a

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pending Benelux trademark application for the mark OMEL for either identical or very similar services. The owner of the CTM ONEL Registration has filed a Benelux opposition proceeding against the use of OMEL based upon a likelihood of confusion in the marketplace. The owner of the OMEL mark responded by requesting proof of use for the CTM ONEL in the EU. The owner of the trademark ONEL provided proof of use in the Netherlands only; not of use in any other member states. Consequently, the owner of the OMEL mark requested that the opposition proceeding be rejected based on no evidence of genuine use of the ONEL mark in the EU.

The Joint Statement of Regulation (Joint Statement) considers that use in one member state is sufficient to constitute genuine use in the EU. However, the Benelux Office for Intellectual Property (BOIP) disagreed and has argued that the Joint Statement is not legally binding and should not be taken into account when the monopoly of a CTM Registration extends far beyond the territory in which the mark is actually being used. In other words, the owner of a CTM Registration, which is only used in one member state, should not be allowed to stop the registration and use of an identical or similar national trademark in another member state. To do so, it is argued, would be unfair and an abuse of the right.

The BOIP refused the opposition. Onel will likely appeal this decision before the Court of Appeals in The Hague. The Court of Appeals will most likely put forward clear and specific guidelines as to what is considered a genuine use of the mark in the EU and the minimum geographic scope of a CTM Registration.

The practical application of this case is that if a trademark owner uses a mark subject to a CTM Registration in a reasonable part of the EU, for instance in more than one member state, there is no problem. However, if the court rules in favor of the BOIP and the trademark owner uses the CTM in only one member state, the CTM is vulnerable to cancellation for non-use by a third party. All is not lost if the CTM is cancelled because it can be converted into national trademarks for the member states where use has been made.

WIPO'S First Electronic UDRP Action Is Complete

In 2009, the World Intellectual Property Organization (WIPO) proposed an amendment to the Rules for Uniform Domain Name Dispute Resolution Policy (UDRP) which would allow for electronic-only filing of pleadings brought under those rules. On October 30, 2009, the Internet Corporation for Assigned Names and Numbers (ICANN) Board approved the proposal. It later announced a phased implementation program for the new rules. The phased implementation allowed complainants the option of trying out the electronic-only filing format beginning on December 14, 2009, before it becomes mandatory on March 1, 2010; the last day to file a hard copy UDRP complaint or response is February 28, 2010.

Complainants began taking advantage of the new system immediately. On December 14, 2009, Nokia filed a fairly straightforward fully electronic complaint against Jameela Seif under Section 4(a) of the UDRP. A mere 37 days later, the WIPO Arbitration and Mediation Center released its decision to the parties.

The introduction of the new system is rather timely as it comes almost simultaneously with ICANN's approval of the first four internationalized top-level domains. The international top level domains will allow internet users to type entire domain names in their native language and the approved countries to request their internet names to be included in the internet domain names root system, which will allow global access. According to an ICANN press release, Egypt, Saudi Arabia, the Russian Federation and the United Arab Emirates have been approved, 16 other applications are pending, and more applications are anticipated.

With the introduction of international top level domains, litigation will likely increase. The electronic filing process will be a convenient tool to keep costs down and speed the process up.