

LETTER FROM EUROPE

Interior Designs:

Is space the final trade mark frontier?

Sometime after I'd piloted Wagamama to victory against the awful Rajamama copycat Indian-themed restaurant, my late friend Paul O'Farrell, who was the COO, asked whether we could get additional trade mark protection by seeking to register the interior of the restaurant (the law having changed considerably a little over two years earlier to include non-traditional trade marks). In fact, BP had registered a trade mark that depicted a typical garage forecourt with the colour green applied to certain aspects of it, but it was actually just a colour mark, and not an attempt to trade mark the three-dimensional physicality of the gas station itself.

I was aware that someone (I forget who now) had sought to register the interior of a restaurant, the description of which had been written more like a patent claim than an interior design brief. It 'claimed' an interior of a restaurant 'comprising' various features, ranging from chequered tablecloths, fisherman's nets strung from the ceiling, articles from the sea like driftwood (and probably the odd dead starfish), and a key feature of business cards being tacked to a wall board.

It didn't succeed, a result that accorded with my own view that it wasn't describing the interior with sufficient certainty. And to be honest, I'd been in restaurants like that with my parents by the seaside as a youngster, so there was nothing particularly distinctive about it, either. (I didn't think pinning business cards to a board was ever going to be a standout feature.)

So I advised Paul it wasn't going to be a runner at this stage, although with its long, shared benches and placemats where your order is scribbled down in strange hieroglyphics (and a number of other things), you could certainly tell you were in a Wagamama restaurant when inside.

Paul trusted my advice and nothing further was done. Not long after the project was shelved, the owner of a bar called Planet Football attempted to register the interior of his establishment—the attempt was rejected out of hand.

Fast forward nearly 20 years later, and Apple Inc. has seemingly attempted to do something similar in Germany. However, the German court has questioned whether it is even possible to register the layout of the premises, since the Community Trade Mark (CTM) Regulation only refers to 'packaging of goods'. The German court has therefore referred the matter to the CJEU. Of course, we British assume anything is up for grabs, as the CTM Regulation simply says that a trade mark can consist of "any sign capable of graphical representation, *particularly words...*", etc. I'll save for another day my views about Parliamentary drafting, and the legal disparity between 'particularly' and 'exclusively'. However, as with the Planet Football decision, the graphical description is the key aspect. Nevertheless, the UK's approach is similar to that of the U.S., although there a more liberal interpretation of what constitutes a trade mark, and how it can be described, applies.



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(Apple already has a registration for the interior of its store as a trade mark in the U.S.)

Not infrequently have I heard the phrase "You're such a lawyer!" used against me at social gatherings. So I have come to recognise that in some circumstances, we IP lawyers have not only to step back to look at a particular trade mark situation, but ask someone else's view. After all, they will undoubtedly be closer to the legal construct of the 'average consumer', than I probably am. It's why, in my view, having real people as witnesses in court proceedings is still important and relevant. With this in mind, I spoke to my fiancée about whether interiors of stores could be distinctive, and about Apple's in particular. I was slightly taken aback by her answer. She said she could recognise an Apple store because of the windows and layout, especially when you go up the escalators to the top floor (at least in London, which is two storeys high). This was despite my pointing out,

perhaps somewhat cynically, that there is an extremely large Apple logo stuck on the window as you go in.

She drove home her point a couple of weeks later, whilst we were out in a shopping mall. She pointed to a store, which I instantly recognised as an Apple store ... but the logo was more difficult to spot, as it was above the entrance. I conceded defeat on the point.

As her views began to change my own thinking on this subject, I was reminded again of the *Wagamama* case. The judge in that case was the late, great Sir Hugh Laddie. The clients were keen to bring in expert evidence on speech patterns to show the virtual identity in the cadence between *Wagamama* and *Rajamama*. I flatly refused, but felt it inappropriate at the time to reveal my reasoning. Just trust me, I pleaded. They did, and we won.

At the end of the case, I was asked why I had been so adamant not to have that expert evidence.

“Because I had the privilege of once sitting next to the judge’s wife at dinner,” I explained.

“So?” came the retort.

“She’s a speech therapist,” I replied.

The client appreciated that if our so-called expert had come to a different conclusion from that of Lady Stecia, the judge may well not have decided the case in the same way. I’m not saying he would have taken his wife’s views over another’s, but let’s face it, she wasn’t being paid by any of the parties, so who would you chose?

In that case, the Judge’s wife could have been both an expert *and* the

average consumer. So the more I discussed the issue of the interiors of Apple’s stores with my average consumer fiancée, the more it seemed to me the store could potentially (at least in Apple’s case) function as a trade mark. Still, whether my fiancée noticed or not, the giant logo was still there, either on the window by the entrance or above it. So if the interior is capable of functioning as a trade mark, it does so in much the same way as ‘Have a Break’ does with ‘Have a KitKat’ (KitKat being a particularly well known chocolate biscuit in the UK and elsewhere). It may well be a ‘weak’ trade mark, or a ‘secondary’ one, depending on the terminology you might wish to use, but it is still functioning as a trade mark.

That doesn’t mean Apple will necessarily succeed in obtaining a registration, even if the referral to the CJEU goes in its favour. There remains the issue of whether the description, whether in terms of words or an image, is sufficiently clear, precise and objective to qualify for registration. Perhaps they can overcome this hurdle, too.

Even if they are successful, another hurdle potentially awaits, one that was not considered in the *Planet Football* case. While drawings or images will no doubt be treated as a 2-D image of a 3-D object (or space) if it is a description, it remains a description of something that is three-dimensional. So the question is: do the three ‘shape’ criteria for refusing a registration—does the mark result from the nature of the goods, have a technical function, or give substantial value to the goods—apply also to services? That is not part of the question the German court has

referred to the CJEU, and it is a shame that they didn’t ask the question at the same time.

The reason the question exists at all is because although the CTM Regulation only refers to the shapes of goods, it would be a bizarre result if you could obtain a 3-D registration for services, which used only a written description, and so avoid the three criteria, yet for the shape of goods or their packaging, this avenue is blocked. And it is likely also blocked for services, where there is use of an image or drawing as a 2-D image of a 3-D object, as these will still have to comply with the three shape criteria, as the ECJ held in the *Phillips v. Remington* case (and as the CJEU has reiterated in this year’s *Yoshida Metals* decision).

It strikes me that what Apple is actually seeking to register as a trade mark is the expression of my fiancée’s ‘experience’ when she goes into an Apple store. In essence, it’s similar to the use of a copyright to protect the expression of an idea. Ultimately, the CJEU will have to answer a fundamental question: Can trade mark law be extended to such an extent?

Who knows? But with the right responses in the CJEU to all the questions posed (whether now or later), and with the right evidence, Apple may just get there, and pave the way for others to follow.

In years to come, this *Letter from Europe* may well be looking at the efforts of Apple to enforce their mark. Now that will be an equally fascinating struggle to talk about!