

Best protection for new shapes: design registration or 3D trademark registration?

Luis Gayoso Frayssinet of Estudio Colmenares & Asociados discusses the protection of shapes, looking specifically at the unique design of perfume and liquor bottles.

These two options, design registration and 3D trademark registration, play an important role in protecting a new shape creation. There are some characteristics for each, and these will depend on the purpose of the

shape. In general, the design registration requires an absolute novelty and will be valid for 10 years. The 3D trademark must have a territorial novelty within the class(es) of interest.

Most clients within the liquors and perfumes industry decide to protect their new bottle shapes, not as designs, but as 3D trademarks. The main reasons are:

- Specific market. The bottles will be used for particular liquids and will be classified according to them. The client does not intend to use the bottle for another purpose; therefore, the class limitation will be not a concern.
- The possibility to renew the protection. Both types of protection are valid for 10 years. However, unlike the design registration, a 3D trademark could be renewed for further periods of 10 years.

The registration for a design



could be an ornament, piece of furniture, or automobile, and not limited to shapes - designs for Graphical User Interfaces (GUI), VR devices, projected images, etc could also be registered.

Article 113 of the Andean Community Decision 486 is very clear about the broadness of the design scope, while article 134 explains the trademark characteristics:

Article 113 The particular appearance of a product that results from any arrangement of lines or combination of colors, or any two-dimensional or three-dimensional outward shape, line, outline, form, texture, or material, without the intended use or purpose of the said product being thereby changed, shall be considered an industrial design.

Article 134 For purposes of this system, any sign that is capable of distinguishing goods and services on the market shall constitute

a trademark. Signs that are capable of graphic representation shall be eligible for registration as trademarks. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to the registration of the trademark.

In our experience, both types of protections are equally enforceable. There are no advantages or disadvantages on this aspect. The time-frame for obtaining a favorable resolution (within an infringement action) in either case is 180 days.

Contact

Estudio Colmenares & Asociados
Bolognesi 125, Piso 9, Miraflores
Lima 18 - Peru
email@colmenares.com.pe
www.colmenares.com.pe