

29.3.2 Unfair competition and “passing off”

The laws of unfair competition provide some protection against a competitor confusing the public into thinking that their activities are associated with your business, even without a registered trade mark or any other IP right. However, this area of law is complicated and there are major differences between countries. The biggest differences stem from whether the country is a “Common Law” or “Civil Law” jurisdiction. Most common law jurisdictions descend from the English legal system and include countries such as the UK (except Scotland), the Republic of Ireland, the United States (except Louisiana), Canada (except Quebec), Australia, New Zealand and Malaysia. India and South Africa also have forms of common law. Continental Europe and much of the rest of the world use the civil law system. In a common law jurisdiction much of the law derives from previous judgements by judges hearing real cases, whereas in civil law countries the main emphasis is on the legal codes such as the French Napoleonic code and much less weight is given to judicial precedent.

The law of “passing off” arises in common law countries. To sue for “passing off” in England you need to prove that:

- Your products have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- The other party is doing something to confuse the public into believing that the products they sell originate from you;
- You have suffered damage (including damage to your reputation) as a result.

However, it can be very difficult and expensive to prove “passing off”. One advantage of registering a trade mark is that it is generally easier to prove infringement of a registered trade mark than “passing off” of an unregistered mark. Once again, this is an area where you should seek professional advice.

29.4 Designs

Designs are concerned with the appearance of a product rather than its function. In chocolate confectionery, the design protection is commonly used for packaging, for example the shape and appearance of an assortment box, but it can also be used to protect the shape of chocolate products themselves. Once again the situation varies around the world, but generally, to be protectable, a design must be new and have individual character. To have individual character the overall impression conveyed must differ from that conveyed by previous designs.

In the European Community there is a two tier protection system:

- The Unregistered Community Design (UCD);
- The Registered Community Design (RCD).

An Unregistered Community Design gives automatic protection for your design for three years after you made the design public. It has the advantage that you do not need to file any applications, but the major drawback is that the

protection can be difficult to enforce. A UCD gives the right to prevent the commercial use of the design only if the use results from intentional copying.

A Registered Community Design gives you exclusive rights over the use of that design. An RCD initially has a life of five years, but it can be renewed in five-year blocks up to a maximum of 25 years. You can register your design and keep it undisclosed for up to 30 months for an additional fee. There is a grace period which allows you to market your product for up to a year before applying for a Registered Community Design, but it is generally safer to register as soon as possible. A major advantage of having a registered right is that it is easier to prove infringement.

It is worth considering designs and trade marks together when looking at protection options. It might be possible to protect a distinctive and novel product shape as a three dimensional trade mark which could provide a valuable alternative to design registration, potentially giving protection indefinitely.

The equivalent protection in the United States to registered designs is the “Design Patent”. Like registered designs, a United States Design Patent is concerned with appearance not function (the patents dealing with function in the United States are called “Utility Patents”). A difference between European Registered Community Designs and United States Design Patents is that for a Design Patent you must show that your design is not just new, but is also not obvious. Whether a design is non-obvious is not always clear, and may lead to differences of interpretation.

29.5 Copyright

Internationally, copyright is of huge economic value, covering such things as books, drawings (including engineering drawings), paintings, music, film, TV, radio and, in many countries, computer software. It is important however to realise that copyright does not protect ideas. If you have written down a great idea for a new chocolate product, your written words (the expression of the idea) will be protected by copyright, but the idea itself is not protected.

The main international agreement concerning copyright is the Berne Convention. Most of the major countries in the world are parties to the Berne convention, so generally copyright protection is international. The Berne convention requires that each member country gives citizens of other countries at least the same degree of copyright protection that it gives to its own citizens, and also the convention imposes minimum standards of protection. The duration of copyright protection must be at least for the life of the author plus 50 years (for all except photographic and cinematographic works), but some countries and regions such as the European Union allow longer protection.

Copyright protection is automatic as soon as there is a record in any form of what has been created. It is useful to mark copyright material with the international