

FRENCH TRIAL COURT UNBLOCKS LEGO RIVAL

by

Brahm G. Segal

LEGER ROBIC RICHARD, Lawyers

ROBIC, Patent & Trademark Agents

Centre CDP Capital

1001 Square-Victoria - Bloc E – 8th Floor

Montreal, Quebec, Canada H2Z 2B7

Tel.: (514) 987 6242 - Fax: (514) 845 7874

www.robic.ca - info@robic.com

On May 10, 1994, the trial court of Nanterre in the Paris district of "La Défense" released its judgment in the matter of KIRKBI A/S et als. vs. RITVIK TOYS EUROPE S.A.R.L. KIRKBI and its co-plaintiffs belong to the LEGO group of companies, which manufactures and distributes the well-known eponymous construction toys.

In December 1992, the plaintiffs launched a multi-headed action against the defendants alleging, primarily, the infringement of the first plaintiff's three-dimensional trademark and unfair competition. The defendants are part of a Canadian outfit engaged in the same business as the plaintiffs throughout the world. In the months immediately preceding the filing of this claim, the defendants had introduced to the French market two configurations of their MEGA BLOKS construction toys which are compatible to the plaintiffs' standard LEGO blocks and their larger blocks sold under the trademark DUPLO. The defendants had already established themselves in France by marketing oversized construction blocks in a scale that neither the LEGO system nor other competitors offered.

Firstly, the court declared invalid LEGO's registration of a three-dimensional trademark consisting of a 4 X 2 pronged rectangular construction block. The panel hearing the case reasoned that the form and function of the block shown in the registration had merged, and, as its shape was primarily dictated by technical imperatives disclosed in long-expired patents owned by LEGO and an earlier patentee, the Briton HF Page, it could not be registrable under French law. This conclusion as to non-registrability could not be varied by the tendering of survey evidence, as was done was by the plaintiffs, which purportedly established that the shape of the LEGO 4 X 2 block had acquired secondary meaning in France. Therefore, it did not matter whether the defendants could have adopted a different arrangement and prong shape for their own construction block system.

The only constraint on the marketing of look-alike construction blocks in France would be in relation to how the product is marked and packaged. In

the instant case the court held that the defendants' MEGA BLOKS products would not likely cause confusion with the plaintiffs' products, as the MEGA BLOKS system had its own distinctive containers, packaging, trademarks and colour assortments for the blocks themselves. Accordingly, the unfair competition grounds of LEGO's complaint were dismissed as well.

The court did find that a figurine offered in one of the defendants' toys too closely resembled a valid and subsisting industrial design owned by KIRKBI A/S. Modest damages were assessed against the defendants, in part because it was acknowledged that the offending figurine had been altered in the early stages of the litigation so as not to constitute a copy of the LEGO design.

According to Gérard Delille of Caubet Buchman Spalter, who represented the defendants here, the *RITVIK* decision complements the recent line of French cases exemplified by the Supreme Court's (*Cour de Cassation*) 1993 ruling in *LEGO S.A. vs TOMY FRANCE S.A.R.L.*, which established that designing a product to be compatible with another product does not per se amount to an act of unfair competition in France, in the absence of any proprietary right covering the imitated feature of the senior product, and provided that no reference is made by the junior trader that would be likely to cause confusion as to the origin of its product.

Published at (1994), 8 W.I.P.R. 196 under the title *Paris Court Rules for Firm Accused of Infringing LEGO Trademark*.

© LEGER ROBIC RICHARD / ROBIC, 1994.

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

ROBIC + DROIT
+ AFFAIRES
+ SCIENCES
+ ARTS

