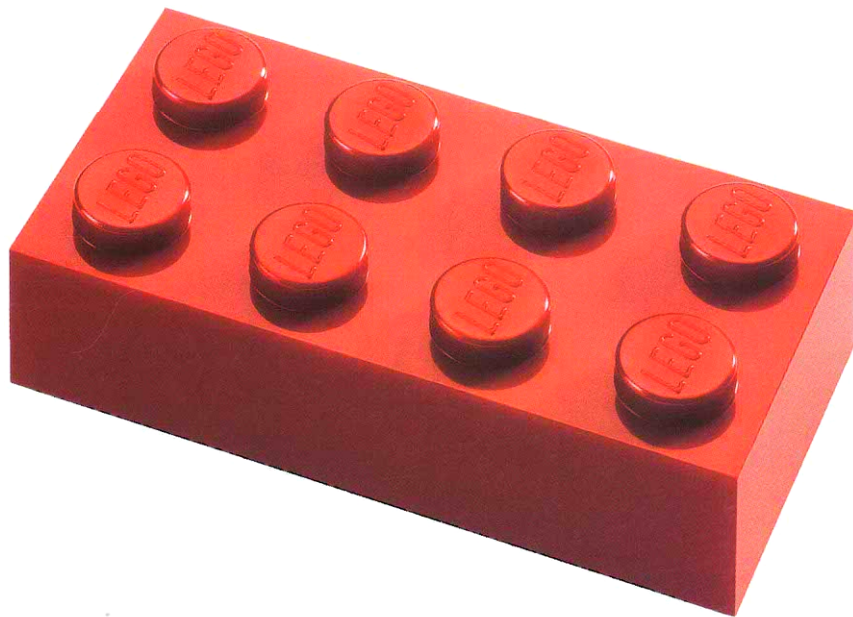


&gt; playthings

## Legal Building Blocks



THE ICONIC LEGO BRICK IS ONE OF THE MOST RECOGNIZED TOYS IN THE WORLD. With billions sold, new model kits marketed regularly and the potential for virtually unlimited creativity, Lego bricks are one of the most frequently requested (and purchased) children's playthings. With all of this success, the Lego companies have recently been unable to succeed in protecting their intellectual property rights in court.

Lego lost a 10-year legal battle in Europe to register as a trademark the three-dimensional "configuration" of its building block. In other words, Lego sought to protect, through trademark law, the actual shape of its bricks.

While not nearly as common as trademarks for words and logos, trademark protection for product and packaging configurations is permitted by intellectual property laws in most countries. For example, in the United States, the shape of Nintendo's Wii video game machine is trademarked. But there are limitations on what product designs can be protected as such, and Lego ran up against those limits.

If a product design is principally "functional," the laws in most countries, including the U.S., won't allow

the design to receive trademark protection. Similarly, under European law, if the shape of a product is necessary to achieve a technical result, then it cannot be a trademark.

### Form Versus Function

If a unique aspect of a product largely performs a function and is necessary to achieve a technical result, the law allows that aspect to be protected by a utility patent.

Utility patents have a limited duration (usually 20 years) after which the idea is available to competitors to use. On the other hand, trademarks can be renewed as long as they are being used as a source indicator. The law prevents protection of a purely functional aspect of a product as a trademark because doing so would essentially grant a monopoly of un-



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limited duration on the technology.

Mega Brands (maker of MEGA blocks) raised this functionality concern against Lego's European trademark registration for its brick. After numerous hearings and interim decisions, the European court accepted Mega's arguments and concluded that various features of the Lego brick perform technical functions and should not be protected by trademark law. For example, the height and diameter of the studs at the top of the bricks affect "clutch power" when the bricks are connected.

**The court relied upon the fact that Lego had prior utility patents on its brick design in denying trademark protection.** The courts in the U.S. generally have a similar harsh view of the impact of utility patents when a party is trying to also protect its design with a trademark.

### Think Ahead

Make sure to carefully plan your strategy for protection of your ideas using all available options. Utility patents are often the right choice, but not always. Also consider design patent and trademark protection for products that have the potential to be long-term superstars, and which have unique looks.

Design patents, which protect the look of your products (as opposed to their functionality) do not pose the significant hurdle to eventual trademark protection that utility patents present. A little smart planning up front can protect you from the bad guys for a long time down the road.

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