

## **Shape of CHANEL NO.5 bottle is NOT DISTINCTIVE : USPTO**

Chanel Limited is a French luxury brand created by Coco Chanel in 1910. In 100 plus years Chanel has created a goodwill for itself in ready-to-wear clothes, luxury goods and accessories for men and women. Chanel recently sought to register the shape of its bottle “No. 5” fragrance as a registered trademark in the US.

Chanel observed that, it has suffered and is suffering huge losses, not only on its goodwill’s end but also on its financial end, because of counterfeiting of its No.5 perfume bottle.

In USA, trademarks are protected under Lanham Act. Both registered and unregistered trademarks are protectable under the Act but registered trademarks enjoy few more layers of protection. Registered trademark enjoys nationwide protection, it is presumed that registered trademark is valid, it is also presumed that owners of registered trademarks are true and bona fide owners, trademark is in continuous use and most importantly infringers cannot claim that they were unaware relating to registration status of the mark. Owner of registered trademark can also claim punitive damages 3 times more than normal amount.

The specimen submitted by Chanel. (Google Images)



Thus, in order to get benefits of being registered trademark user, Chanel applied for trademark registration for its No.5 perfume bottle. Chanel made two separate applications for its No.5 perfume bottle. One application claiming No ‘5’ word mark and other claiming the rectangular shaped container with beveled sides, a thinner neck and on top a horizontal rectangular faceted shape mark.

At the moment, Chanel is facing some preliminary setback from US Trademark Registry as Registry has objected the design trademark application on the grounds of non-distinctiveness. The US Trademark Registry supported its objection by stating that the mark applied for, is

not inherently distinctive and shape of the perfume bottle is very basic in nature and common in the cosmetics, fragrance and perfume industry. The specimen device mark submitted by Chanel in the US application only had only one difference namely, horizontal, rectangular faceted bottle stopper, which in the view of the US trademark Registry is not distinctive enough. The other application with word mark '5' has passed the preliminary stage and now has been published for opposition.

It should be noted that in considering a device mark in any application, the US trademark Registry considers device mark as a whole and not in part. Therefore, mere use of a unique shape of bottle stopper does not distinguish the mark from other marks.

After receiving the objections from the US Trademark Registry now Chanel may respond by contending that it has acquired distinctiveness for its product. One can claim acquired distinctiveness on an unregistered trademark when it acquires distinctiveness and public largely associates the mark to that specific set of goods and services. To support the contention of acquired distinctiveness Chanel may provide verified documents of long use, sales and revenue of Chanel No.5 perfume, promotional and advertisement costs, customers feedback etc. As per various magazines and reports, Chanel No. 5 is one of the world's famous perfume and also among the top selling perfumes.

Registration of trademark would benefit Chanel for perfumes products and also for all other future products Chanel intends to launch under the brand Chanel No.5.

Chanel has also applied for trademark registration of the same mark in India as well, but the application is likely to get objected under Sec 9(a) of the Trademarks Act, 1999 on similar grounds of non-distinctiveness. The reason of objection provided by US Trademark Registry is valid and similar reasoning might be given by Indian Trademark Registry as well. Thus, only time will tell us whether the Indian Trademark registry would consider Chanel's mark on acquired distinctiveness or would raise objection on the application.

