

GILLETTE:

Three-dimensional trademark infringement.

The history of the brand and its popularity

In 1901, American entrepreneur King Camp Gillette revolutionized the world of shaving by introducing the world's best-selling razor. The razor offered men the ability to shave comfortably at home and was considered the first disruptor of the grooming category as well as the barber shop industry.

Men's facial trends were changing rapidly in the late 1800s, clean chins and cheeks and a well-groomed mustache started to become fashionable. Therefore, to achieve this look, men could go to a barber two to three times a week or shave themselves, which could be a dangerous undertaking.

Over time, a more convenient and cheaper way for men to enjoy a good shave became necessary, and the possibility of bringing the barbershop experience into the home was sought.

King C. Gillette realized his permanent blade razor was dull and required professional sharpening. In that moment of frustration, he saw that the only necessary part of his blade was the finest part of the tip. He quickly envisioned that tip on a flattened piece of steel, sharpened on both sides, produced at such a low cost that it was easily and quickly replaceable. Therefore, King C. Gillette's new, disposable razor blade and handle promised men safety and personal freedom to achieve the looks they desired.

Since then, the company has become internationally known as a world leader in the production of razors.



Evolution of the different types of razors



1 / Prototipo



2 / Nueva y Mejorada



3 / Ajustable



4 / Techmatic



5 / Trac II



6 / Atra



7 / Atra Plus



8 / Sensor



9 / Mach 3



10 / Fusion



11 / Body



12 / Proglide



13 / Proshield



14 / Heated Razor

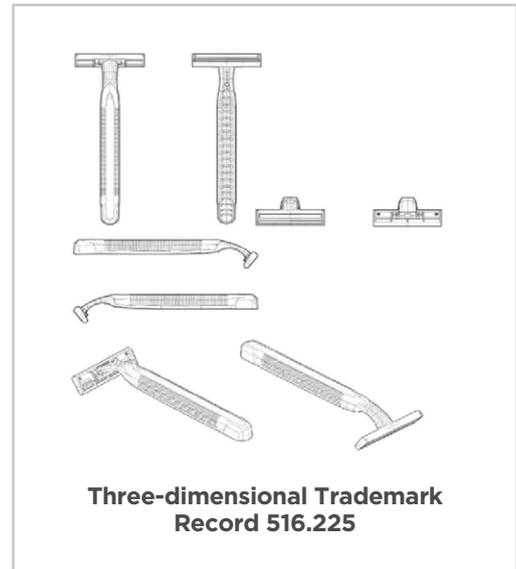
Trademark situation in favor of “The Gillette Company LLC”

Gillette is the holder in Uruguay of several trademark registrations, protected by the Trademark Law No. 17.011 before the National Directorate of Intellectual Property, some of the registrations are as follows:

- ▶ Word mark “**GILLETTE**” granted under Record No. 535.634 to protect products within international class 8.

- ▶ Three - dimensional trademark (frame), granted under Record No. **516.225** to protect products within international class 8, among others.

The registration was granted to protect “*razors and razor blades*” in international class 8, exhibiting each of the views of the product to observe the volume and distinctive aspects of the trademark, in compliance with the requirements for its registration as shown in the frame.



Three-dimensional Trademarks

Trademarks in general are governed by Law No. 17.011, which provides for a series of basic requirements for their registration, including the need to be an original, distinctive, and novel sign. In the case of three-dimensional trademarks, however, in addition to complying with the general requirements, they must meet the following:

1. Consist exclusively of shapes
2. Be distinctive by itself.
3. May be expressed in three dimensions: height, width, and depth.

Therefore, the registration of three-dimensional trademarks with word elements, figurative elements, or colors is not allowed. As a result of this protection, by fulfilling the requirements, Gillette was granted its three-dimensional trademark to prevent the commercialization of products that, without including the GILLETTE trademark, seek to imitate the special shape of the shaver, thus enabling the company to act against those who reproduce or copy their model and infringe its rights.

Backgrounds

GILLETTE became aware that an important store was commercializing products identified with their trademark, in clear trademark infringement. Said store was also commercializing genuine products of the brand but at a higher price than those in infringement. Due to the similarity of the products and the price difference, the consumer public preferred the counterfeit products.

The store in question is in one of the most important business areas, indicating a high level of commercialization of the products, both per unit and in wholesale.



Actions taken

Once aware of the infringement, legal representatives of GILLETTE arrived at the business premises to verify by notary the sale of the merchandise in alleged infringement of its Intellectual Property rights.

Simultaneously, a notarial notice was issued.

Outcome of the out-of-court actions

Following the out-of-court actions among the parties involved, we reached a settlement by signing an out-of-court agreement. In this document, **the representative of the store acknowledges the priority right over the trademarks and designs owned by GILLETTE.**

In addition, it committed itself to:

- ▶ Avoid marketing in the future any product bearing the trademarks owned by GILLETTE:
- ▶ Hand over the rest of the merchandise to proceed with its destruction.
- ▶ Pay a sum of money to reimburse the expenses incurred by GILLETTE arising from the infringement, as well as the costs of the destruction of the infringing products handed over.
- ▶ Include a penalty clause in the event of non-compliance.

Disposal of the merchandise

The merchandise was destroyed completely in a company specialized in the destruction and recycling of products under the regulations and provisions on environmental care in our country.



Article 84 of the Law 17.011: *“Those trademarks mentioned in the previous articles as well as those tools used to the execution thereof shall be destroyed or rendered unusable. Those goods infringing the law that have been confiscated shall be seized and destroyed unless, because of their nature, they can be assigned to state or private charity institutions. Once the apocryphal quality of the merchandise has been established by means of the corresponding technical expertise, the same shall be destroyed at the expense of the plaintiffs or awarded to public or private charitable institutions.”*

Conclusions

Outcomes of the case:

- ▶ Promotion of the protection of a three-dimensional trademark known worldwide, protecting its characteristic design and the excellent quality offered to its consumers.
- ▶ The protection provided by the rights arising from Trademark Law No. 17.011, enabled the protection of these trademark designs, words, word and device and three-dimensional, thus allowing to act against third parties that commercialize these types of products, taking the corresponding actions to withdraw the infringing products from the market.
- ▶ Closing the negotiations, an out-of-court settlement was signed with an express acknowledgment of GILLETTE's rights, as well as an agreement to destroy all of the infringing products.

In conclusion, it is therefore essential to be familiar with the regulation and importance of registering trademarks, not only in the case of word trademarks. Consequently, the benefits of the protection granted include not only protection against third parties trying to copy a trademark's design or logo but also protection against third parties attempting to mislead using the product's formal appearance.

Three-dimensional trademark registration entails the previously mentioned protection, considered also an assurance to the consumer that he/she will not be deceived by a design similar to the original trademark.

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