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CBP seizure of 'counterfeit' AirPods shows the value of configuration marks

- **US Customs seized 2,000 earpods for allegedly infringing on Apple's marks**
- **CBP action was based on registered configuration trademarks recorded with it**
- **Configuration marks are a worthy investment despite complications with registering**

Configuration marks made an appearance in the mainstream media this week after US Customs and Border Protection (CBP) authorities seized a shipment of 2,000 OnePlus Buds at JFK airport. CBP described the headphones as "counterfeit Apple AirPods" and, despite OnePlus's products being ostensibly genuine products, would not release the products, claiming that they infringed upon Apple's configuration marks. While the media as focused on whether the seizure should have occurred, the value of registering configuration marks with CBP has been made clear.

The shipment of OnePlus Buds was initially seized on 31 August after "a CBP import specialist determined that the subject earbuds appeared to violate Apple's configuration trademark." For CBP, the issue was not trade dress, infringing logos or imitation packaging, but rather the fact that, as a spokesperson [explained](#), "Apple has configuration trademarks on their brand of earbuds, and has recorded those trademarks with CBP". The spokesperson told [The Verge](#) that the "seizure of the earbuds in question is unrelated to the images or language on the box. A company does not have to put an 'Apple' wordmark or design on their products to violate these trademarks".

The clarification was made to push back against media and online questioning of why CBP would seize items that are being widely sold in the United States. Leaving that aside, the incident highlights how CBP will act against products that are at risk of infringing configuration marks registered with the authority.

"Generally, the more times a trademark owner invests with CBP – including preparing trainings to educate agents on what to look for to recognise counterfeit products – the more focused and efficient CBP can be on the trademark owner's behalf," says [Julia Anne Matheson](#), partner at Potomac. She notes that "the more information a trademark owner can share about possible ports of entry and problematic importers, as well as their own authorised importers", the more CBP will be able to act on its behalf.

While configuration marks offer important additional protection for rights holders – including the ability to take action against a potentially infringing product despite it not having a word mark, which is useful when seeking to combat the import of unlabelled counterfeit goods – brands have historically underutilised such marks.

One reason for this is because configuration marks are harder to obtain. [Andrew Price](#), partner at Venable, notes that they "require a showing of acquired distinctiveness and this can be a heavy burden". He adds: "There are a number of landmines to avoid, like patent filing history or advertising that touts functionality; the application and prosecution process usually requires an extra degree of creativity to navigate; and business units do not often follow the best practice using 'look for' advertising to build product design as a brand so it may not capture the attention of in-house counsel."

Being unable to register a configuration mark due to the functionality of its design is an issue that Apple faced with its [original AirPods mark](#). Although that mark has now been obtained, [Eric Perrot](#), partner at Gerben Law Firm, [wrote](#) that "the examining attorney who was assigned to the Apple AirPods application [initially] denied it on the ground that it is merely functional and is, therefore, not something that can registered". At that point he noted the need, when applying for configuration marks, to show that the shape is not functional and, that by obtaining exclusive rights, the company would not gain a functional advantage over its competitors.

These requirements are sourced from Supreme Court decisions such as *Wal-Mart Stores v Samara Brothers* and *TrafFix v Marketing Displays*, explains Matheson. "In *Wal-Mart*, the Supreme Court concluded that product configurations cannot, as a matter of law, be inherently distinctive," she says. Moreover, "*TrafFix* clarified that a mark is function and unprotectable as a trademark if it is essential to the use or purpose of the product or if it affects the cost or quality of the product".

Although the requirements for configuration marks are multifaceted and complex, their value cannot be understated. Creating a unique product design that will stand out in the marketplace requires a level of investment and creativity that is not available to all companies. But, Matheson concludes, "where the investment is made to develop such a design, I generally recommend that clients utilise a combination of patent and trademark protection".

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