

## QUESTION 181

### Conditions for registration and scope of protection of non-conventional trade marks

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Q181

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#### AIPPI

##### Considering:

- a) that the types of sign used by businesses to distinguish their goods and services have expanded beyond “traditional” word and device marks;
- b) that trade mark owners have in recent years increasingly attempted to obtain registered trade mark protection for “non-conventional” marks, such as colours, shapes, sounds and smells;
- c) the importance of providing adequate means of protection to such “non-conventional” trade marks;
- d) that national and regional laws and practices have responded differently to the legal questions and administrative demands posed by attempts to register “non-conventional” marks and have differed in their acceptance of the extent to which “non-conventional” marks can fulfil the primary function of a trade mark, i.e. to identify the origin or source of the goods or services in respect of which it is registered;
- e) that tension may exist between the wish to register “non-conventional” trade marks and the difficulties in clearly defining, graphically representing, publishing and searching such trade marks;
- f) that applications to register a colour per se are complicated by the fact that colours are often used for decorative or other purposes and that in some instances the public is not used to recognizing colour as an indication of origin;
- g) that three-dimensional shapes can be solely functional or necessary in relation to the goods for which they are used;
- h) that many countries allow registration of colours per se and of three-dimensional shapes as trade marks only on the basis of their acquired distinctiveness.

##### Noting:

- a) AIPPI's Resolutions Q23, Q68 and Q92C-96;

- b) paragraph 5 of Resolution Q148 which provides: “Trade mark law should not protect 3D shapes that are solely functional or necessary, namely those which solely: (a) result from the nature of the goods themselves, or (b) are necessary to obtain a technical result relating to the nature of the goods or services covered by the mark.”; and
- c) the fact that a trade mark can consist of any sign capable of distinguishing the goods or services of one undertaking from those of other undertakings warrants a broad and flexible approach to the registration and protection of non-conventional trademarks.

**Resolves:**

- 1) “Non-conventional” trade marks should, in principle, be capable of constituting registered trade marks.
- 2) The representation of a “non-conventional” trade mark must be clear, precise, easily accessible and intelligible. The public must be able to understand the nature of the trade mark.
- 3) A colour per se can be capable of registration as a trade mark. In many cases a colour per se will only be registrable on the basis of distinctiveness acquired through use. There may also be circumstances where a colour per se may be registered on the basis of inherent distinctiveness in relation to certain goods or services.
- 4) In relation to 3D shapes, paragraph 5 of resolution Q148 is confirmed.
- 5) A sound can be capable of registration as a trade mark and should not be subject to a requirement of graphic representation. A sound mark may be represented by musical notation or other description or by means unequivocally reproducing the sound.
- 6) A smell can be capable of registration as a trade mark and should not be subject to a requirement of graphic representation. A smell mark should be represented by means unequivocally describing or reproducing the smell.
- 7) Trade mark offices should cooperate to harmonise and promote effective methods of representing non-conventional trade marks.