

Summary Report



Question Q181

Conditions for registration and scope of protection of non-conventional trademarks

Introduction

The Reporter General received 36 Reports from the following Groups: Argentina, Australia, Belgium, Brazil, Bulgaria, Canada, China, Czech Republic, Denmark, Egypt, Finland, France, Germany, Greece, Hungary, India, Italy, Japan, Latvia, Malaysia, The Netherlands, Norway, Panama, Paraguay, Peru, Philippines, Poland, Portugal, Romania, Singapore, South Africa, Spain, Sweden, Switzerland, United Kingdom, and United States.

1. *How is the scope of what constitutes a registrable trademark defined? Does that definition list specific examples of permissible types of trademark?*

Countries of the European Union referred to Article 2 of the European Trade Mark Directive (89/104/EEC), which provides:

“A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

The German Group noted that the requirement of capability of graphical representation was intended, amongst other things, to allow publication of the registration of the mark so that the public might have information about trade marks which are in force and about the scope of their protection. The French, German and Dutch Groups added that signs which are not visibly perceptible can also be considered for registration if they are appropriately graphically represented.

A similar test is adopted by those countries shortly to join the European Community, including Hungary and Poland. The Finnish Group suggested that the practice of the Finnish Trade Mark Office relating to the registration of non-conventional trade marks differs materially in many respects from that of other member states of the EEA.

A number of countries provided lists of permissible types of trade marks. The Swiss Group included words, letters, figures, pictures, three-dimensional shapes or combinations of such elements. The Polish Group suggested that a trade mark can in particular be a word, a design, an ornament, a colour composition, a three-dimensional form, including the shape of goods or their packaging, also a melody or other acoustic signal. The Latvian Group noted that Latvian law provides a specific list of examples of permissible types of trade marks including words, pictures, three-dimensional shapes, combinations of any of these and sound or light signals and the like.

The Egyptian Group noted that a trade mark is all that characterises a product or service including, names, signatures, words, characters, figures, drawings, symbols, title of locations, stamps, seals, pictures, engravings in relief, set of colours taking a special and distinctive shape and any combination of these. In all cases a trade mark must be visually perceptible.

The US Group noted that a mark is defined as “any word, name, symbol, or device or any combination thereof”, but the definition does not provide specific examples.

The Japanese Group noted that colour *per se* cannot constitute a registrable trade mark; a colour must be combined with other permitted elements (that is characters, figures, signs or three-dimensional shapes) to become an element of the registrable trade mark.

The Australian Group noted that Australian law contains a list of types of trade mark which includes colour, sound and scent. As a definition is inclusive rather than exclusive it could conceivably include more unusual signs, such as a moving image or hologram.

The Chinese Group noted that the definition of trade mark means a visual sign capable of distinguishing goods or services.

Insofar as there is a significant difference between national laws, it appears to be between those countries which require a mark to be visually perceptible and those which require a mark to be capable of graphic representation. The latter definition is broader and may therefore be preferred.

2. *What categories of signs are capable of registration as a trademark? Are any categories of signs excluded from registrability as a trademark?*

Member states of the European Union noted the grounds for refusal or invalidity set out in Article 3 of the EC Trade Marks Directive. These include signs which cannot constitute a trade mark, which are devoid of distinctive character, which are descriptive, which have become generic, or which are contrary to public policy. The German Group noted that certain signs cannot, at present, be represented graphically, including smells, noises, tastes and tactile signs and also complex moving signs.

The Dutch Group noted that there are no categories of signs excluded from registration as trade marks. There are some particular limitations which apply to three-dimensional trade marks.

The Swedish Group noted the decision of the ECJ in *Sieckmann* (Case C273/00) that the graphic representation must be "clear, precise, self-contained, easily accessible, intelligible, durable and objective", and noted that the trade dress for shops is one example of a mark which is difficult to represent graphically and therefore difficult to register.

The Brazilian Group noted that only visible signs are capable of registration as a trade mark and that all other signs are therefore excluded from registrability.

The Paraguayan Group noted a list of signs that are not registrable, including those which infringe copyright or an industrial property right of a third party, those applied for by someone who is not the legitimate owner.

The US does not exclude specific categories of signs from registration.

The Japanese Group noted that because a definition requires a trade mark to be visible, sounds, smells, tastes cannot be registered.

The Chinese Group noted amongst a list of signs which could not be used as trade marks those having the nature of exaggeration and fraud in advertising goods or services.

3. *Where applications to register a colour per se or a combination of colours per se may be accepted for registration:*

3.1 *In relation to goods, is such an application acceptable if it does not specify the outline, contours or proportions in which or the shape or object to which the colour is to be applied?*

The decision of the ECJ in *Libertel* (Case C104/01, 6 May 2003) shows that colours may satisfy the prerequisites for registrability. Accordingly, there should be no need for the outline, contours or proportions of the colour to be defined in the application.

The UK Group noted that a pure colour may be capable of registration but a difficulty may arise with graphical representation and demonstration that the colour is capable of distinguishing the goods of one undertaking from another. The lack of outline or contour around a colour or indication of proportions will increase the burden of proving factual distinctiveness.

The French Group noted that a single colour cannot be registered and that it is necessary to add the reference to an international code or to provide a precise description of the shade or the the percentage of each colour.

The Italian Group noted that applications are accepted without specifications of outlines, forms, proportions or object to which the colour refers.

The Hungarian Group noted that protection had been granted for the colour lilac for MILKA but that other single colours had been refused. Rare combinations of colours had been granted.

The Greek Group noted that an application which does not specify the outline, contour or proportions in which or the shape of objects to which the colour is to be applied is in principle unacceptable for registration, a combination of colours may be registrable if it causes a distinctive overall impression to the consumer.

The Finnish Group noted that a colour per se can be registered even if the graphical representation does not depict anything else.

None of the following countries requires any particular outline, etc. - Argentina, Australia, Czech Republic, Denmark, Latvia, Norway, Poland, Portugal, South Africa and Sweden. Canada, Romania and the US require an outline etc. The following countries do not allow registration of a single colour at all - Bulgaria, Brazil, Paraguay, Egypt, Japan and China.

3.2 *Is such an application registrable in relation to services and, if so, under what conditions?*

It appears that those states which permit registration of colour marks do not distinguish between registrations for goods and services.

The Canadian Group noted that there are circumstances in which the mere application of colour does constitute a trade mark provided it is applied to an article used in services. An example is suggested of a mode or wrapping goods in a certain colour; for example a blue box may identify jewellery services.

The UK Group notes that it may be more difficult to represent a colour graphically in respect of services.

The US requests a drawing for services, as well as for goods, displaying the manner or setting in which the mark will be used for services.

3.3 *Is an applicant required to file a sample of the colour(s) applied for and/or a colorimetric reference or other colour code?*

Countries of the EU noted the guidelines set out in *Libertel*, following *Sieckmann*, requiring a written description of a colour accompanied by the relevant code or codes from an internationally recognised colour identification system. Other means should be identifiable if they can meet the criteria.

The Hungarian Group noted that there was a requirement to file a reproduction of the colour; however, there is no current practice of referring to tables or codes. In Greece a sample of the colour must be filed. In Switzerland the mark should be referred to by reference such as Pantone®. The Norwegian Group noted that an applicant is required to file a sample and should specify a number of an international standard colour code.

The Czech Group noted that the Czech Patent Office has not granted applications referring only to a Pantone reference - a sample is required. In Latvia a sample or a colorimetric reference may be filed. In Argentina, Brazil, Canada, Paraguay and South Africa a sample or a reference is required. In Egypt the applicant is required to file prints of the trade mark in colour whenever colours are claimed. For the purpose of publication, the applicant is required to a colour metric reference.

In the US a sample is required.

3.4 *Can the mark be considered inherently distinctive in relation to certain goods or services?*

3.5 *Will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown?*

In *Libertel*, the ECJ proceeded on the basis that the colour can be inherently distinctive. The German and UK Groups noted that while it may in theory be possible to demonstrate inherent distinctiveness, in practice this will be extremely difficult. The French Group suggests it will not be possible. The Danish Group noted that a mark may be inherently distinctive in relation to services but not goods.

In China a colour can be considered inherently distinctive in relation to certain goods or services.

The following countries answered to this question in the negative; Brazil, Romania, Poland, Latvia and the US. Argentina, Australia, Bulgaria and Paraguay said yes. In the Australian *Philmac* case (2002) the court held that where the colour does not serve a utilitarian, ornamental or economic function and is used in a market where there is no need to use colour, and in such a way that other traders might thereby wish to copy it, then a colour will be inherently adapted to distinguish.

3.6 *Are certain colours denied registration on the basis that there is a need to keep them free for general use?*

The majority of countries answered to this question in the negative. The UK Group noted that while no colours are denied registration on the basis that there is a need to keep them free for general use the UK trade mark office would bear in mind that there is only a limited number of colours available, which reduces the likelihood of the public viewing a single colour as distinctive of one trader's goods. In contrast, the German and French Groups noted that colours arising out of the nature of an article need to be kept free, for example, the colour white for milk and green for goods or services in the ecological sector. Red and blue designate hot and cold water respectively, and yellow has come to symbolise lemon. There would also be a difficulty with descriptive marks - the colour red may be descriptive for motor vehicles if it indicates that they are, in fact, painted red.

The Finnish Group thought that it might be necessary to keep the colour red free for fire engines. The Swedish Group suggested that it may be necessary to keep the colour orange free for lifebelts or life rafts and the Norwegian Group suggested the same colour might need to be kept free for improvement and repair of roads etc. The Latvian Group notes that the Patent Office has kept yellow free for electrical measurement rules for it designates safety. The Australian Group referred to the US *Pink Bats* case (1985) 74 F2d 116. There the Federal Court rejected a "colour depletion theory" which is based on the premise that registration in respect of one shade of colour could monopolise all shades of the same colour, which would be classified as deceptively similar. The theory continues that applicants could thereby monopolise all colours until none was left. The Canadian Group noted the obvious difficulty in registering orange for oranges and yellow for bananas.

It therefore appears that there are no obvious limitations of any use of colours but that existing practices may make it undesirable to allow registration where the public already associates a colour with particular goods or services.

A number of Groups did not answer this question separately. The general view here is that the more distinctive the mark the easier it will be to obtain a registration.

3.7 *To what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark?*

The Dutch Group noted that an application for a combination of colours which does not specify the proportions and division may not be clear, precise, self-contained and objective and therefore may not, following *Sieckmann* be properly registrable. In *Stihl v OHIM* Case T-234/01, the Court of First Instance appeared to accept that a colour combination *per se* complies with the requirements laid down in *Sieckmann*. The UK Group notes that a complex of colours applied to a pharmaceutical capsule was registrable under the old UK law and would probably still be registrable.

The Japanese Group noted that when combined with characters, a figure or sign, colour can become an element for registrable trade mark. However, such a combination will not necessarily strengthen the distinctiveness of the colour *per se*.

4. *Where applications to register three-dimensional signs may be accepted for registration:*

As set out in the Working Guidelines, three-dimensional marks are dealt with in Q148. No Group suggested any variation to the position adopted there.

4.1 *What form of representation of the three-dimensional sign is accepted as part of the application for registration?*

Almost all countries describe a graphic representation of a three-dimensional mark as being acceptable. The UK Group adds that a verbal description may be acceptable if it provides sufficient clarity. The French Group added that a verbal description may be accepted with a photograph or a design of the object.

The Finnish Group notes that a physical sample of a three-dimensional mark may be filed in order to ease the assessment of distinctiveness, however, the state of the sample is unclear.

In China, five pictures/photographs would be accepted.

4.2 *What are the criteria for assessing whether the three-dimensional sign can be considered capable of distinguishing the goods or services of one undertaking from those of another?*

Groups governed by the EC Trade Marks Directive noted Article 3 of the Trade Marks Directive. This provides that which consist exclusively of:

- the shape which results in the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or
- the shape which gives substantial value to goods

shall not be registered. A similar approach is adopted in Hungary and Poland.

The Latvian Group noted the main criteria on whether the sign is capable of distinguishing goods and whether the shape contains some kind of “capricious addition” so is not purely functional. Other countries note that the test for a three-dimensional mark are the same as a test for any other mark.

4.3 *What are the criteria for assessing whether the three-dimensional sign can be considered inherently distinctive in relation to certain goods or services?*

- 4.4 *Will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown?*
- 4.5 *Are certain shapes denied registration on the basis that there is a need to keep them free for general use?*
- 4.6 *To what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark?*
- 4.7 *To what extent do technical or functional considerations prevent registration?*

Many Groups dealt briefly with remainder of question 4 and it does not appear to raise new issues for AIPPI. The UK Group noted that only a very unusual and distinctive shape is likely to be inherently capable of registration. In *Linde* (Cases C-53/01 to C-55/01) the ECJ noted that so long as a three-dimensional mark does not fall foul of article 3(1)(e) of the Directive it should be treated as any other trade mark. However, it may be more difficult to show that such a mark is not devoid of distinctive character because the public may see the three-dimensional shape as a new product. Thus distinction may have to be required through use.

The Finnish Group noted that the Finnish Trade Mark Office would, in some cases, take into account the need to keep a certain shape free for products or services by invoking *Ordre public* and public policy considerations. For example, a circular shape might be kept free for lifebuoys.

In respect of technical and functional considerations, the Swiss Group reported the *Lego* decision of the Federal Tribunal:

- Shapes which correspond to the essence of goods are absolutely incapable of protection.
- Shapes which are technically necessary are absolutely excluded from protection.
- Shapes which are technically conditioned by their purpose are generally lacking in distinctive character but can become distinctive through use.
- Shapes which are technically influenced can generally be registered.

The Japanese Group report that a three-dimensional mark which has acquired distinctiveness through use may be registered. A three-dimensional mark that has inherent distinctiveness can be registered, but it will be very difficult to show this is the case. Trade marks consisting of the shape of goods or their packaging are barred from registration.

5. *Where applications to register smells may be accepted for registration:*
- 5.1 *What form of representation or description of the smell is accepted as part of the application for registration?*
- 5.2 *How is the capacity of the smell to function as a trademark and/or its distinctiveness assessed?*
- 5.3 *How is the mark made available to the public on publication of the trademark application and thereafter?*

Groups from the European Union noted the decision of the ECJ in *Sieckmann*. This rules out the following types of graphical representations - chemical formula; verbal description; deposit; or a combination. It is difficult, therefore, to see how a satisfactory graphical representation may be found. The German and Dutch Groups suggested that it has to be assumed that smells cannot be registered as a trade marks, as a result.

However, the Brazilian Group noted that applications to register smells are not accepted. The position is similar in Egypt, Canada and Japan.

The US Group noted that smells are registrable so long as a detailed written description is provided.

The Australian Group noted that despite developments in other countries the Australian Trade Marks Office continues to accept applications for smells. The applications include a graphical representation as well as precise and accurate description of the trade marks. The results of analytical techniques are not accepted as they would not be readily understood by the ordinary person searching the Register. A number of Groups reported a lack of any experience in their country.

It therefore appears that the graphic representation of smells remains a major stumbling block for registration as trade marks. There does not appear to be a legal principal preventing registration.

6. *Where applications to register a sound mark may be accepted for registration:*
 - 6.1 *What form of graphical representation of the mark applied for is required as part of the application for registration?*
 - 6.2 *Can audio recordings of a sound mark be filed as part of the application for registration?*
 - 6.3 *If such audio recordings are filed as part of the application for registration, how are these recordings made available to the public on publication of the trademark application and thereafter?*

Groups from the European Union note the decision from the ECJ in *Shield Mark* (Case C-83/01). Musical notation will be accepted as a means of graphically representing sound marks. If the musical instrument used to produce a sound forms part of the mark then this should be stated. Audio recordings are not accepted as part of the application - this is a question of graphical representation.

In Germany, the filing of sound recordings is required although this does not replace the need for graphical representation. The Hungarian Patent Office requires musical notation and will accept a tape recording. In Finland an audio recording is required to ease the registration process. In Norway, the applicant has to submit a sample as an MP3 file. Sound recordings may be filed to support marks in Latvia and Argentina. Sound marks are not available under Egyptian law. In Japan sound cannot be registered as a trade mark. In Australia the application must be supported by 8 separate recordings for distribution to the local offices of the Trade Marks Office. In Canada sound marks are not registrable. In the US they are registrable so long as a detailed written description is submitted e.g. the MGM lion - "THE MARK COMPRISES A LION ROARING".

7. *Where applications to register moving images or holograms may be accepted for registration:*
 - 7.1 *What form of representation of the moving image or hologram is accepted as part of the application for registration?*
 - 7.2 *How is the moving image or hologram made available to the public on publication of the trademark application and thereafter?*

Graphical representation appears to present a significant bar to the registration of a hologram or moving image. Where a moving image can be represented by a sequence of still pictures and a written description, the mark may be registrable. Few marks have been registered in France. The French Trademark Office advises not to attach the hologram itself to the application, but to add a description of the way in which the elements appear, are combined or are superimposed, or to give a written description of the progression of the sequence for the moving images. The Swedish Group noted that applications have so far

been refused as not being sufficiently clear and precise. The Czech Patent Office does not consider moving images or holograms capable of being represented graphically. In Latvia, the sample of a hologram is accepted as part of the application for registration and is available for inspection. The official publication contains a photograph of a given hologram in a static pose. Such marks cannot be registered in Japan. In Australia a hologram has been accepted as a registration. In the US a single drawing or five freeze frames may be submitted.

8. *How is the scope of protection of “non-conventional” trademarks assessed? In particular, are registrations for “non-conventional” trademarks treated any differently than registrations for “traditional” forms of trademark either in substantive or procedural terms?*
9. *To what extent is assessment of the registrability of “non-conventional” trademarks influenced by issues relating to enforcement and the scope of protection which should be afforded to those marks?*
10. *To what extent is the assessment of the registrability of “non-conventional” trademarks influenced by the fact that there may be a limited number of certain “non-conventional” marks (such as colours or shapes) available for general use?*

Many national Groups considered questions 8-10 together. They note that non-conventional trade marks are treated the same as other trade marks and that there are neither substantive nor procedural provisions specifically designed for them. At the French Trade Mark Office, smells and sound marks are being examined by the Juridical Division. The French and German Group noted that colour marks may give a narrow scope of protection as it is difficult for people to remember colours specifically. Groups on the EU noted the effect of the *Libertel* decision of the ECJ is to limit the registrability of colours because of the limited spectrum available. The Dutch Group noted under the Paris Convention no exception is made for the assessment of the scope of non-traditional marks.

The Dutch Group noted that so far as the three dimensional marks are concerned, the aim of the Trade Marks Directive is that a shape which has a technical function should be freely available for all.

The Japanese Group noted that concern over the monopolisation of three-dimensional marks has led to the introduction of a requirement that a mark consisting of a shape that is indispensable to securing the function of goods or packaging cannot be registered even when the mark has an inherent distinctiveness or has already acquired distinctiveness for use.

The Australian Group noted that in practice non-conventional trade marks are less likely to be inherently distinctive and generally requires the applicant to file register evidence of use or belief that goods or services will function as a trade mark.

The French Group has cited litigations about smells which have been judged on the basis of unfair competition.

11. *To what extent is the assessment of the registrability of “non-conventional” trademarks influenced by the fact that consumers may be less used to understanding “non-conventional” marks as an indicator of origin?*

The Dutch Group noted the ECJ decision in *Libertel* and *Phillips v Remington*. The Norwegian and Brazilian Groups noted that the task of educating consumers is that of the mark owner.

12. *Further Observations*

A number of Groups made further comments on harmonisation, as follows.

The Finnish Group suggested experiences from the EU indicate that mere harmonisation of the wording of trade mark legislation is generally not sufficient to bring harmonisation in practice. Developing case law provides for only relatively slow means of harmonisation. It would be of importance to harmonisation requirements for graphical representation removing the requirement for paper and replacing this with data files. The Finnish Group suggests removing the requirement for graphic representation of sound marks. The Finnish Group also noted that harmonisation should take into account economic, cultural, political and social differences which may lead to easier harmonisation at first at a regional level. Efforts should be taken to avoid creating overlapping systems of intellectual property.

The French Group suggests improving the notion of a “sign capable of graphic representation” in order not to limit trademarks to the signs whose shape is visible.

Regarding the olfactory trademarks, and taking into account the development of such marks in numerous sectors, the French Group proposes to distinguish the simple or natural fragrances from complex fragrances. The simple fragrances could be admitted for registration for all products or services which are not in any way connected with the fragrance. The filing application could include a literal description associated to a graphic representation, drawn for example, from a chromatography in the gaseous phase or of the three dimensional representation of a digital simulation of the molecule. This would be sufficient to define the right with enough precision, consistency and objectivity with regard to third parties.

The Hungarian Group suggested harmonising the scope of signs that may be the subject of protection and technical conditions required for the application.

The Latvian Group suggested that in addition to a paper publication in official journals, shape and paper marks should also be published on line. Trade marks could be shown in a 360° view. Moving images and holograms could be published in the same way showing all aspects of the mark. The Argentinian Group suggested that particular characteristics of non-traditional marks should not constitute an obstacle to their registration. For smells a simple description together with a laboratory sample might suffice. The Japanese Group notes that although many countries do not allow the registration of non-conventional marks it is likely that their use will increase.

The Japanese Group therefore proposes the preparation of non-mandatory guidelines which can be used as a useful reference by countries that plan to introduce registration systems for non-conventional marks.

13. *The Working Committee*

There seem to be three issues for the Working Committee to consider:

- 1) The **capacity** of non-conventional marks to be act as trade marks. Non-conventional marks are perceived by senses other than vision. The degree of intrinsic or acquired distinctiveness and the need to preserve certain signs free from monopolies carried out for competition reasons.
- 2) The **representation** of such marks in the application has to be clear, precise, self-contained, easily accessible, intelligible, desirable and objective (see the *Sieckmann* decision in the ECJ). Trade Mark Offices must be able to to examine these applications, third parties to watch them for opposition purposes and courts to enforce them in infringement proceedings.
- 3) The **administrative requirements** involved in Trade Mark Offices recording new types of marks and making them available for searching. There may be a need for new systems using technology such as recording systems and electronic bulletins.

The Working Committee should propose clear guidelines for harmonisation on these issues.