

СЕКЦІЯ 3. ЗАХИСТ ПРАВ ІНТЕЛЕКТУАЛЬНОЇ ВЛАСНОСТІ: СВІТОВИЙ ТА ВІТЧИЗНЯНИЙ ДОСВІД

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LEGAL PROTECTION OF NON-TRADITIONAL TRADEMARKS IN THE EU

ПРАВОВА ОХОРОНА НЕТРАДИЦІЙНИХ ТОРГОВЕЛЬНИХ МАРОК В ЄС

The article provides an overview of EUIPO regulatory acts and practice related to registration of rights for non-traditional trademarks. Cited cases relate to shape, position, pattern, sound, motion, multimedia and color trademarks.

Keywords: *non-traditional trademarks, EUIPO, examination, eligibility criteria, trademarks, TM protection.*

У статті наведено огляд регуляторних актів EUIPO та аналіз практики щодо реєстрації прав на нетрадиційні торгові марки. Наведені приклади кейсів, що стосуються товарних знаків форми, положення, малюнка, звуку, руху, мультимедіа та кольору.

Ключові слова: *нетрадиційні торгові марки, EUIPO, експертиза, критерії охороноздатності, торгові марки, захист ТМ.*

The most widespread types of trademarks are without a doubt word marks, consisting of text only, figurative marks, consisting of an image, and combined marks, containing text and some form of figurative element.

However, given the numerous advantages that trademark registration brings to the successful applicant, it is not surprising that businesses have sought to register other types of marks. There have been numerous attempts to push the envelope of what can be a trademark, in order to secure that little bit of extra commercial advantage and get ahead of the competition.

Previous EU Trademark Law – the requirement of graphic representation. In the European Union, historically, an important factor limiting the possibilities of what can be a trademark was the requirement under the previous European Trademark Regulation [1] and directives [2] that a trademark *may consist of any signs capable of being represented graphically* [3]. This is arguably a historical necessity, as trademark registers had to be available on paper and distributed offline.

Nevertheless, this did not mean that only graphic signs were capable of being registered. In the *Sieckmann* [4] case, the ECJ ruled that: [...] *a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective*" [5]. These criteria continue to underpin the trademark registration process in the EU to this day.

In *Sieckmann*, the applicant had applied to register a scent as a trademark. The applicant had provided a sample of the scent, as well as the description “balsamically fruity with a slight hint of cinnamon”. However, the application could not satisfy the cited criteria. The description of the odor was not sufficiently clear, precise and objective, as it left room for interpretation by the reader. The odor sample, besides not being a graphic representation, is also not sufficiently stable or durable. A chemical formula, while it could be depicted graphically, would be unintelligible to all but experts in chemistry.

EU Trademark Law reform. Since the coming into force of the new European Union Trademark Regulation [6] (EUTMR) it is no longer required that the mark is represented graphically. Instead, art. 4 of the new EUTMR states that “*An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: [...] being represented on the Register of European Union trade marks (‘the Register’), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.*” The register of European Union trademarks is widely available on the internet and, through digital means, can portray much more than just images. As such the possibilities for trademarks do increase.

In addition to the EUTMR, an important text on what can be a trademark is the European Union trade mark implementing regulation (EUTMIR) [7]. In EUTMIR article 3(1), it is stated that the *trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor.* This codifies the *Sieckmann* criteria, while reinforcing the removal of the graphic representation requirement.

Further in articles 3(3) and 3(4) of the EUTMIR, the types of trademarks that can be applied for are listed. These are Word marks, Figurative (and combined) marks, Shape marks, Position marks, Pattern marks, Color marks, Sound marks, Motion marks, Multimedia marks, Hologram marks, Others.

In this review, we will examine the “non-standard” types of marks, namely all of the types of marks listed above, with the exception of Word and Figurative marks.

Sound Marks. A sound mark is defined in Art. 3(3)(g) EUTMIR as “*a trade mark consisting exclusively of a sound or combination of sounds*”.

Sound marks are unquestionably benefiting from the new regime. Previously, the requirement of graphic representation meant that in order to successfully register a sound, only musical notation would be sufficient. An example of a sound mark registered under the old requirements is EUTM 001040955, depicted in the



European trademark register as , and likely commonly recognized by consumers as “The Nokia Ringtone”.


While melodies such as the above were registrable under the old regime, it was not possible to register all sounds. For example, the roar of a lion is not a melody that can be depicted with notes, and that makes it incapable of being depicted graphically and registered as a trademark. Applicants have tried a variety of unsuccessful methods to circumvent the requirement of graphic representation, including onomatopoeias (for example “Kukelekuuuuu” [8] as the sound of a rooster), sonograms, or a description such as “the first nine notes of Beethoven’s song “Fur Elise”. None of these were considered to fulfil the criteria set in the *Sieckmann* case.

These issues are all resolved under the new regime. Article 3(3)(g) of the EUTMIR stipulates that, apart from musical notation, an audio file reproducing the sound can now be provided. As such, any sound can be registered as a trademark, provided that it satisfies the remaining criteria for being a trademark.


Color or combination of color marks. Color marks are a non-traditional type of trademark which was protectable already under the old EUTMR and continue to be available under the new regime. Article 3(3)(f) of the EUTMIR defines them as a “*trade mark (which) consists exclusively of a single color without contours*” or a “*combination of colors without contours*” and provides the requirements for depiction in the trademark register.


To depict a single-color mark, the applicant must provide a reproduction of the color, as well as a reference to a generally recognized color code, such as Pantone.

An important consideration for color trademarks is that they can be quite difficult to register. The European Court has stated that: “*In the case of a color per se, distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific*” [9]. As such, before an application is filed, a color would likely need to have been in use for some time in order to gain a degree of distinctiveness that would make it capable to serve as a trademark.

A relatively famous example of a single-color mark would be EUTM  000212787, which is Deutsche Telecom’s color, described in the register as *Magenta (RAL 4010 tele magenta)*.

To depict a combination of colors mark, the applicant must submit a reproduction that shows the systematic arrangement of the color combination in a uniform and predetermined manner, and an indication of those colors by reference to a generally recognized color code. An optional description detailing the systematic arrangement of the colors may also be added; The description must be consistent with the image shown.

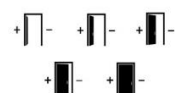
An example of an acceptable combination of colors mark is EUTM  018178473, with the following description: *Description: Color mark consisting of a combination of the colors light blue ("PANTONE 2935 C"), dark blue ("PANTONE 294 C") and red ("PANTONE 7626 C"), which are classified next to one another in the aforesaid sequence in equal parts (each 1/3). Color: "(PANTONE:2935 C)"; "(PANTONE:294 C)"; "(PANTONE:7626 C)".*

Applicants need to be careful to depict and describe their trademarks in a way which shows exactly how the combination of colours creates a systematic arrangement. In Case C-124/18 P, [10]  *Red Bull v EUIPO*, the Court of Justice confirmed the invalidation of Red Bull's trademark, which contained the description "*Protection is claimed for the colors blue (RAL 5002) and silver (RAL 9006). The ratio of the colors is approximately 50%–50%.*". The CJEU confirmed the EUIPO and the General Court's view that the mere indication of the ratio of the two colors does not constitute a systematic arrangement in a predetermined and uniform way. The given ratio of the colors permits for a variety of arrangements and therefore the mark was not sufficiently clear and precise.

Motion marks. Art. 3(3)(h) of the EUTMIR defines motion marks as marks "*consisting of, or extending to, a movement or a change in the position of the elements of the mark*" and governs how a motion mark can be depicted in the register.

The mark shall be represented by submitting a video file or by a series of sequential still images showing the movement or change of position. Where still images are used, they may be numbered and accompanied by a description.

It is important to ensure that the depiction of the mark is sufficiently clear and precise. The EUIPO will refuse marks where the movement cannot be established from the description and graphic representation and/or where such movement is subject to the consumer's personal interpretation.



An example of this is the refused EUTM 16023095, where the mark contains multiple still images of a door at various stages of opening and closing, with a plus and minus sign on each side of the door. The description of the mark suggests that the user can open and close the door by using the plus and minus signs. The EUIPO held that: *“A sign that consists of the opening and closing of a door by pushing buttons on the left or right of the latter is **subject to the consumer’s personal interpretation**. The sign therefore **cannot fulfil the clarity and precision requirements under Article 4 EUTMR** because each consumer would interpret it in a different way and would be subjected to a different sequence of the movement mark”*.

Multimedia marks. Art. 3(3)(i) of the EUTMIR defines multimedia marks as marks *“consisting of, or extending to, the combination of image and sound”* and governs how such a mark can be depicted on the register. The mark shall be represented by submitting an audiovisual file containing the image and the sound.

Important to note that while this is a mix of a sound mark and a motion/figurative mark, the EUTMIR only permits audiovisual files and doesn't allow for other methods of submission, e.g., notation + sequence of images. Theoretically, it may still be possible to submit a multimedia mark in that way as an "other" trademark under art 3(4) EUTMIR, however the practicality of such an approach is likely questionable.

Applicants should be reminded that being in the multimedia format doesn't automatically make a mark more distinctive, and all usual requirements for registrability continue to apply. For example, the EUIPO refused the registration of EUTM 018117130 for computer software and education services related to music, because the mark consisted of a guitar tuner - a common implement in the education of guitar students both in person and online, and therefore lacked distinctiveness.

Hologram marks. A hologram is a surface which shows different colors/shapes/images depending on the angle of viewing. EUTMIR art. 3(3)(j) defines hologram marks as marks *consisting of elements with holographic characteristics*” and states that *“The mark shall be represented by submitting a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety.”*

A quality depiction of the trademark is key to securing a successful registration. As an example, EUTM 018262778 was denied registration due to the provided video file not demonstrating sufficiently well how the holographic image changes.

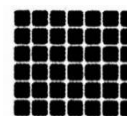
In such situations, where the applicant is unable to secure a good quality video, a series of still pictures or graphics may be a better option.

Pattern marks. Pattern marks are trademarks which consist exclusively of a set of elements that are repeated regularly. Art 3(3)(e) of the EUTMIR dictates that the applicant must provide a reproduction showing the pattern of repetition, as well as a potential description.

The EUIPO will assess whether a pattern is sufficiently distinctive to be capable of being a trademark. If a pattern is commonplace, traditional or typical, it likely is devoid of distinctive character. Basic/simple designs generally also lack distinctiveness, as well as extremely complex designs which might be hard to perceive the elements of and commit to memory [11].

In essence, the EUIPO will review if the average consumer would be able to distinguish the product concerned from those of others, without having to conduct an analytical or comparative examination or paying special attention [12].

An example of a declined pattern application is EUTM 10144848, where the



EUIPO held that the pattern consisted of elements which were too simple to have distinctiveness.

If a pattern is found to not be distinctive for certain goods, it will also likely be found not distinctive for services closely connected to the goods.

As with color marks, the more use and acquired distinctiveness a pattern has when the application is made, the better the chances of registration.

Position marks. Position marks are trademarks consisting of the specific way in which the mark is placed or affixed on the goods.

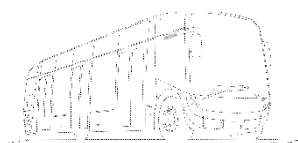
Per Art 3(3)(d) of the EUTMIR, the applicant must submit a reproduction which appropriately identifies the position of the mark and its size or proportion with respect to the relevant goods. The elements that do not form part of the subject matter of the registration are visually disclaimed with broken/dotted lines. There can be a description detailing how the sign is affixed to the goods.

Position marks are arguably mostly known for their use in the clothing and footwear industries, for example, various features on sports shoes such as the one



demonstrated in EUTM 018265691

However, position marks can be put on many products and can consist of many different things - from the manufacturer's logo on a particular place on a bus



(EUTM 018513083), to (potentially, as the application is currently being examined), holes with a specific shape on a particular place on an

electric guitar body (IR 1522030)



Applicants should again be reminded that using a non-traditional trademark is not a substitute for distinctiveness. For example, in case T-547/08 X technology Swiss GmbH, an orange strip on the toe area of socks was considered as a "decorative feature falling within the norms and customs of the market sector", rather than as having trademark character. Similarly, in cases T-433/12 and T-434/12, an application for buttons added to a teddy bear as a positional trademark was denied. This is because buttons are common decorations for such toys and would not be considered as an indication of commercial origin.

Shape marks. Shape marks are marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance.

Article 3(3)(c) of the EUTMIR stipulates that the applicant must submit either a graphic reproduction of the shape, including computer generated imaging, or a photographic reproduction. The reproduction may contain different views (up to six where the representation is not provided electronically).

Shape marks are one of the better-known types of non-traditional marks and have been available for registration under the previous EUTMR also. A recognizable shape mark is the Nutella jar (IR 1191051).

There are three specific exclusions from registrability which apply to shape marks and which need to be examined specifically when applying for a shape mark. These are contained in Art 7(1)(e) of the EUTMR. They are of particular importance, as they cannot be overcome through acquired distinctiveness.

According to Art 7(1)(e) EUTMR, will not be registered, signs which consist exclusively of:

(i) the shape or another characteristic, which results from the nature of the goods themselves.

The shape resulting from the nature of the goods could be for example the goods' natural shape - e.g., a piece of fruit has its natural form. It could also result from regulation (e.g. the dimensions of a rugby ball are prescribed by the standards of that game). The ECJ has also held [13] that shapes that are inherent to the generic function of the goods are also considered to result from the nature of the goods themselves and therefore would be covered by this exclusion. There is no caselaw on this yet – a potential example given by the Advocate General is “*legs with a horizontal level for a table*” – which would be inherent to the generic function of the table.

(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

This exclusion is in place to prohibit the use of potentially endless trademark protection over technical and functional solutions which are protected by IP rights with limited terms.

The EUIPO will assess if the essential characteristics of a shape perform a technical function [14] by employing a variety of criteria, among which are whether the item fits with another article, whether the shape gives the most strength, uses the least material, facilitates convenient storage or transportation and others. If the product in question is patented, that is also a strong indication that the shape falls within this exclusion [15]. It is important to note that the EUIPO will carry out the examination of functional characteristics not just based on the provided depictions and description of the mark, but also on the basis of other relevant materials such as product catalogues or advertising materials.

(iii) the shape, or another characteristic, which gives substantial value to the goods

The EUIPO will assess on a case-by-case basis whether “*it is apparent from objective and reliable evidence that the consumer’s decision to purchase the product in question is to a large extent determined by that characteristic*” [16] and if the answer is positive, will refuse the registration.

It should be noted that in addition to shapes, the exclusions in art 7(1)(e) EUTMR also apply to "other characteristics". There has not yet been any case law on such other characteristics, however the EUIPO has provided a potential example - a sound mark of a roar of a motorcycle for "motorcycles" may be considered to be resulting from the nature of the goods themselves.

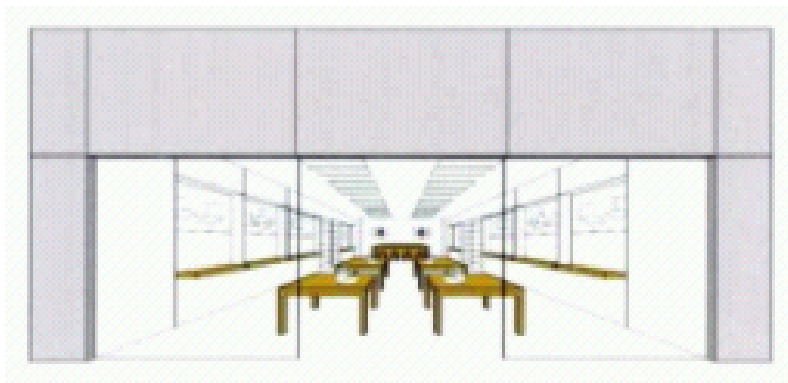
After the exclusions in art 7(1)(e), it needs to be examined whether the shape is distinctive. Generally, the shape needs to be different enough from a common or expected shape, in a way that allows the consumer to identify the origin of the goods just by their shape. The ECJ has held that a simple departure from the norm or customs of the sector would not be sufficient for the shape to have sufficient distinctiveness. Rather, such departure needs to be significant [17]. Further, if a shape is a variant of a common shape of that type of product, it will not have enough distinctiveness [18].

Further, it needs to be examined if there are other elements and factors that provide distinctiveness to the sign even if the shape itself is non-distinctive. The EUIPO will consider any verbal and figurative elements, colors or combination thereof, in consideration of factors such as their size, position and contrast with respect to the shape. For example, the General Court held that in a trademark consisting of the ordinary shape of a lighter with the word "CLIPPER", written in relatively small text on it, the added text was not sufficient to make the shape capable of being a trademark [19].

Other marks. Article 3(4) of the EUTMIR allows for applications which are not listed in art 3(3) to be submitted. They will be accepted, as long as the representations comply with the requirements of art 3(1) - to be represented in any appropriate form using generally available technology, as long as it can be reproduced on the register in a clear, precise, self-contained etc. manner. (FIX). A description can also be provided.

There are several types of "other" marks that the EUIPO has considered. **Smell, taste and tactile** marks are not currently possible to register. As seen in the *Sieckmann* case, smells cannot reliably be described or depicted and therefore cannot be trademarked. Similar arguments apply to taste and tactile marks.

An interesting potential category of "other" marks is that of a **layout of a retail store**. In Germany, Apple applied to register its apple store as a trademark, providing a picture of its layout viewed from outside. The ECJ held that in principle,



a store layout could be a trademark if it is capable of distinguishing the services of the applicant [20]. Regardless, the particular mark was ultimately denied registration.

Conclusion

The protection of non-standard trademarks in the EU is a complex area which, especially in relation to the new types of marks available under the new regime, is in its infancy. For example, only 3 hologram marks have been registered since the coming into force of the new EUTM. There are also less than 100 multimedia marks and less than 150 motion marks on the EUIPO register. For comparison, there are more than a 1.3 million word marks (both active and inactive) on the EUIPO register. As the use of non-standard marks increases, it will be interesting to see how they fare in the real world, and how their owners are able to use them to enforce their rights. A topic of particular interest for future examination could be the attack of such marks on relative grounds and how the courts deal with, for example, a multimedia mark being challenged on the basis of an earlier sound mark.

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