

# New types of marks available after the European Union Trade Mark Reform

An Analysis in the light of the U.S. Trade Mark Law

by **Inês Ribeiro da Cunha and Jurgita Randakevičiūtė-Alpman\***

**Abstract:** This article analyzes one of the novelties brought about by the European Union trade mark reform; i.e. the removal of the graphic representation requirement opening opportunities to register new types of marks at the European Union Intellectual Property Office. In this article, the legal requirements for the registration of the non-traditional trade marks under the legal frameworks of the European Union and the United States of America are discussed and the new provisions of the European Union trade mark law on the representation of trade marks are assessed.

Keywords: non traditional trademarks; EU trademark regulation ; trademark representation; US trademark.

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## A. Introduction

1 The amending Regulation (EU) No 2015/2424 of the European Parliament and the Council, which came into force on 23 March 2016<sup>1</sup> and is now codified as

\* Inês Ribeiro da Cunha, LL.M. is an IP Legal Specialist at the International Cooperation and Legal Affairs Department, European Union Intellectual Property Office (EUIPO). Dr. Jurgita Randakevičiūtė-Alpman, LL.M. is a Senior Research Fellow at the Max Planck Institute for Innovation and Competition.

1 Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade

2017/1001<sup>2</sup> (the ‘EUTMR’), brought about a number of amendments to the European Union (the ‘EU’) trade mark law. One of the changes, which came into force on 1 October 2017, is the elimination of the graphic representation requirement establishing that a trade mark can be represented on the Register of European Union trade marks (the ‘Register’) in any possible manner as long as the authorities, e.g., the European Union Intellectual Property Office (the

mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) [2015] OJ L 341/21 (since 30 September 2017 no longer in force).

2 Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [2017] OJ L154/1.

‘EUIPO’)<sup>3</sup>, and the public are able to identify what exactly is protected<sup>4</sup>. Due to this modification, a wider variety of signs is now available for registration as EU trade marks.

- 2 The graphic representation requirement used to be regarded as a “serious restriction”<sup>5</sup> to register the less common, so-called “non-traditional” or “non-conventional”<sup>6</sup> types of trade marks, especially, the non-visual ones. This prerequisite, together with the case law of the Court of Justice of the European Union (the ‘CJEU’), established that although a mark itself does not have to be capable of being perceived visually, it should be able to be represented graphically in images, lines, and/or characters<sup>7</sup>. Therefore, taking into consideration the growing use of new branding strategies that utilize non-traditional marks<sup>8</sup>, in particular, those directed

3 Former Office for Harmonisation in the Internal Market (OHIM). In this article, the abbreviation ‘EUIPO’ will be used.

4 EUTMR, art 4.

5 Tobias Cohen Jeroham, Constant van Nispen and Tony Huydecoper, *European Trademark Law* (Kluwer Law International 2010) 74-75.

6 The terms “non-traditional” and/or “non-conventional” cover marks, other than word or figurative, that are not visually perceptible, but “have a potential for distinguishing goods and services”, or visible signs, that “differ from the traditional notion of signs constituting trade marks by one or more of their features” (World Intellectual Property Organization, Standing Committee on the Law of Trademarks, Industrial Designs and Geographic Indications, Sixteenth Session, ‘New Types of Marks’, November 13-17, 2006, Geneva <[https://www.wipo.int/edocs/mdocs/sct/en/sct\\_16/sct\\_16\\_2.pdf](https://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf)> accessed 23 May 2019) or it can be regarded as ‘any designation that serves to indicate source, origin, sponsorship or affiliation that is not a word mark, graphic symbol, or combination of colours’ (Llewellyn J Gibbons, ‘Non-conventional Trademarks Under United States Law: An Unbounded New Frontier of Branding’ in Mark Perry (ed), *Global Governance of Intellectual Property in the 21st Century* (Springer International Publishing 2016)). The term “non-traditional” is used throughout this article.

7 Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 55.

8 E.g.: “The Singapore Girl” by Singapore Airlines or crunchiness of “Rice Crispies” by Kellogg’s (Martin Lindstrom, ‘Broad sensory branding’ [2005] 14 (2) *Journal of Product & Brand Management* 84, 85-86). Also see: Klaus-Peter Wiedmann and others, ‘Creating Multi-Sensory Experiences in Luxury Marketing’ [2013] 6 *Marketing Review* St. Gallen 61; John Groves, ‘A short History of Sound Branding’ in Kai Bronner and Rainer Hirt (eds), *Audio Branding. Brands Sound and Communication* (Nomos 2009) 61, 61; Jai Beom Kim, Yoori Koo and Don Ryun Chang,

to various non-visual senses (sound, scent, taste or touch) of human beings, this amendment of EU law is generally accepted<sup>9</sup>, even though it provides room for questions.

- 3 The main objective of this article is to discuss the post-reform EU trade mark legal framework regarding the protection of non-traditional trade marks taking into consideration the new criteria for their registration set by the EUTMR and the Implementing Regulation (EU) 2018/626<sup>10</sup> (the ‘EUTMIR’). In this context, it is particularly important to analyze what specific aspects should be taken into consideration when applying for the registration of non-traditional trade marks, in order to fulfil the requirement indicating that a trade mark should be represented on 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”<sup>11</sup>. In this regard, it seems relevant to look into the trade mark registration requirements in certain jurisdictions, such as the United States of America (the ‘U.S.’), where there is no compulsory graphic representation requirement.

- 4 This objective will be achieved by: (i) discussing the pre-reform EU law with regard to the registration of non-traditional trade marks; (ii) analyzing the requirements for the registration of non-traditional trade marks in the U.S.; (iii) presenting the new provisions of the EUTMR and EUTMIR relevant for the registration of non-traditional EU trade marks; (iv) assessing the post-reform approach of EU trade mark law with respect to the registration of non-traditional trade marks. All this will be achieved by analyzing both the pre-reform and new EU law, as well as the U.S. law with regard to the registration of non-traditional marks and exploring the relevant

‘Integrated Brand Experience Through Sensory Branding and IMC’ [2009] 20 (3) *dmi* 7; Melissa E Roth, ‘Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations’ [2005] 1 *Cardozo Law Review* 457, 458-459.

9 E.g.: “<...> there seems to be general agreement that trademark law should be open for such developments, whatever the mode of representation [of a trade mark] may be” (Annette Kur, ‘The EU Trademark Reform Package – (Too) Bold a Step Ahead or Back to Status Quo?’ [2015] vol. 19 *Marquette Intellectual Property Review* 19, 26).

10 Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431 [2018] OJ L 104/37.

11 EUTMR, art 3 (1).

EU and U.S. case law, the legal doctrine and the *travaux préparatoires* regarding EU trade mark reform concerning the registration of non-traditional trade marks.

## B. The Pre-reform EU Law regarding Non-Traditional Trade Marks

5 The question with regard to the registration of non-traditional marks has already been discussed by the World Intellectual Property Organization's Standing Committee in 2006<sup>12</sup> as well as analyzed by the scholars and practitioners of various jurisdictions<sup>13</sup>. The Singapore Treaty on the Law of Trademarks as of 2006 was the first legal act, which explicitly observed the possibility to register non-traditional trade marks under the laws of the signatory states, at the same time not obliging them to recognize this type of marks<sup>14</sup>. Thus, the national and supranational jurisdictions, including the EU, were provided with the freedom to decide what types of trade marks should be protected.

6 Before the EU trade mark reform in 2015, the Council Regulation (EC) No 207/2009 (the 'CTMR') provided that "[a] Community trade mark may consist of any signs capable of being represented graphically"<sup>15</sup>. In theory, the latter provision of the CTMR allowed any signs, including those that are not in itself capable of being perceived visually, to be registered under EU trade mark law, as long as they were capable of graphic representation and distinguished the goods or services of one undertaking from the goods or services of another. In addition, according to the CJEU case law, such a graphic representation (particularly by means of images, lines or characters) had to be in a form that is clear, precise, self-contained, easily accessible, intelligible, durable, and objective<sup>16</sup>. Thus, although the requirement of the graphic representation did not mean that signs, which are not perceptible visually, were excluded from protection<sup>17</sup>, in practice, predominantly the visual signs were those capable of fulfilling the latter prerequisites<sup>18</sup> and, therefore, were the most likely to be registered<sup>19</sup>.

7 This situation did not completely discourage applicants from trying to obtain registrations for non-traditional trade marks, however; only certain marks, such as, colors<sup>20</sup>,

12 World Intellectual Property Organization, Standing Committee on the Law of Trademarks, Industrial Designs and Geographic Indications, Sixteenth Session, 'New Types of Marks', November 13-17, 2006, Geneva <[https://www.wipo.int/edocs/mdocs/sct/en/sct\\_16/sct\\_16\\_2.pdf](https://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf)> accessed 23 May 2019.

13 E.g.: John A Tessensohn, 'Non-traditional trade marks thriving in Japan' [2016] 11 (6) *Journal of Intellectual Property Law & Practice* 413; Roberto Carapeto, 'A Reflection About the Introduction of Non-Traditional Trade marks' [2016] 34 *Waseda Bulletin of Comparative Law* 25; Kexin Li, 'Where Is The Right Balance? Exploring The Current Regulations On Nontraditional Three Dimensional Trademark Registration In The United States, The European Union, Japan and China' [2012] 30 *Wisconsin International Law Journal* 428; Qian Zhan, 'The international registration of non-traditional trademarks: compliance with the TRIPS Agreement and the Paris Convention' [2017] 16 (1) *World Trade Review* 111.

14 Singapore Treaty on the Law of Trademarks, 27 March 2006, art 2(1) <<https://wipolex.wipo.int/en/text/290013>> accessed 23 May 2019; Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks, para 3, 27 March 2006 <<https://wipolex.wipo.int/en/text/290013>> accessed 23 May 2019. Also see: Sheldon W Halpern, Craig Allen Nard and Kenneth L Port, *Fundamentals of US Intellectual Property Law. Copyright, Patent and Trade mark* (5<sup>th</sup> Edition, Wolters Kluwer 2015) 273.

15 Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark [2009] OJ L078/1, art 4. Since 30 September 2017, repealed by EUTMR.

16 Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 55.

17 *ibid*, para 45.

18 Tobias Cohen Jeroham, Constant van Nispen and Tony Huydecoper, *European Trademark Law* (Kluwer Law International 2010) 75.

19 With regard to non-visual signs, see e.g.: Case C-283/01 *Shield Mark* [2003] ECR I-14313, para 60; Case T-305/04 *Eden v OHIM* [2005] ECR II-04705, para 33, 40-43; Decision R 120/2001-2 of 04/08/2003 of the Second Board of Appeal, para 12.

20 E.g.: a mark described in the EUIPO's database as consisting "of the colour green Pantone 348C as applied to the exterior surface of the premises used for the sale of the goods and services", filing No. 000001991 <<https://euipo.europa.eu/eSearch/#details/trademarks/000001991>> accessed 23 May 2019; a mark described in the EUIPO's database as consisting of "Lilac/violet, single colour as shown in the representation. The values (specific coordinates in the colour space) for the present mark are: "L\* = 53.58 ±0.8; a\* = 15.78±0.5; b\* = -31.04±0.5". The mark can be located in "Pantone's Process Book" between the shades with number "E 176-4" and "E 176-3", filing No. 000031336 <<https://euipo.europa.eu/eSearch/#details/trademarks/000031336>> accessed 23 May 2019; a mark in the EUIPO's database as

- 8 shapes<sup>21</sup> and musical tunes<sup>22</sup>, since they were able to be represented graphically, were registered at the EUIPO. According to the pre-reform EU trade mark law and its interpretation, it was not possible to register mere sounds<sup>23</sup> (onomatopoeias, e.g., a roar of a lion or a sound of a motorbike), scents (smells)<sup>24</sup> and tastes (flavors)<sup>25</sup>, because they were not regarded

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consisting of “Magenta (RAL 4010 telemagenta)”, filing No. 000212787 <<https://euipo.europa.eu/eSearch/#details/trademarks/000212787>> accessed 23 May 2019, etc.

- 21 E.g.: a mark described in the EUIPO’s database as consisting “of a container, whose shape forms a parallelepiped, on the front or frontal parallelogram of which is the word ARROZ (which is not claimed) and under it the name DELTA in vertical capital letters in fancy type in which the ends and corners present curved appendices, some of which are circular (E, L and T) and some of which are opposite and symmetrical to each other (E, L, T and A). This side bearing the name has on its upper part a thick angular line with the vertex or acute angle touching the centre of the upper edge of the rectangle, and beneath the name another angular line which is a mirror image of the upper one, and therefore with the acute angle inverted. On the lateral parallelograms the abovementioned lines are continued horizontally and parallel to one another.”, filing No. 000025957 <<https://euipo.europa.eu/eSearch/#details/trademarks/000025957>> accessed 23 May 2019; a mark described in the EUIPO’s database as consisting of a “[c]one, very elongated, slightly curved, of glass, its top part of polished metal, surmounted by a ball.”, filing No. 001647874 <<https://euipo.europa.eu/eSearch/#details/trademarks/000025957>> accessed 23 May 2019, etc.
- 22 E.g.: a mark described in the EUIPO’s database as consisting “of a sound mark called PRELUDE”, filing No. 000907527 <<https://euipo.europa.eu/eSearch/#details/trademarks/000907527>> accessed 23 May 2019; a mark described in the EUIPO’s database as consisting of the “Signature tune of Nokia Corporation”, filing No. 001040955 <<https://euipo.europa.eu/eSearch/#details/trademarks/001040955>> accessed 23 May 2019; a mark described in the EUIPO’s database as consisting “of a musical theme, shown on a score sheet, which can be played on its own or with orchestration”, filing No. 001312008 <<https://euipo.europa.eu/eSearch/#details/trademarks/001312008>> accessed 23 May 2019, etc.
- 23 Case C-283/01 *Shield Mark* [2003] ECR I-14313, para 60.
- 24 Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 73; Case T-305/04 *Eden v OHIM* [2005] ECR II-04705, para 33, 40-43.
- 25 Decision R 120/2001-2 of 04/08/2003 of the Second Board of Appeal, para 12 (in this case the examiner waived the objection based on the art. 7(1)(a) in conjunction with the art. 4 of the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark [1994] OJ L 11/1 before the judgment in the case C-273/00 *Sieckmann*

as capable of being represented graphically in a form that suited the requirements established by the CJEU case law<sup>26</sup>.

- 9 Taking into consideration the situation discussed above, it is important to analyze, what the abolishment of the graphic representation requirement together with the existing case law of the General Court of the European Union (the ‘GCEU’) and the CJEU means for the practical implementation of the new provisions of the EUTMR and EUTMIR. In this context, the position and the experience of the U.S., where the drawing requirement for the registration of different types of signs is more flexible, may be a useful example for the assessment of the elimination of the graphic representation requirement in EU trade mark law.

## C. The Non-Traditional Trade Marks under U.S. Law

- 10 U.S. law does not establish the graphic representation as a requirement for the federal registration<sup>27</sup> of all types of trade marks as it used to be under EU law before the recent reform. The Trademark Trial and Appeal Board (the ‘TTAB’) of the United States Patent and Trademark Office (the ‘USPTO’) already indicated in 1978 that when considering the available types of trade marks, flexibility, which is essential in order to keep up with the ever-changing reality brought about by the development of technology, requires the mark to not be confined to a graphic form<sup>28</sup>. The acceptance of non-traditional marks for registration particularly moved forward in 1995 after the Supreme Court of the United States (the ‘Supreme Court’) ruled that “the source-distinguishing ability of a mark – not its ontological

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was taken, however, if that objection would not be waived, the Board of Appeal would apply the *Sieckmann* case).

- 26 Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 55.
- 27 Under U.S. law, registration is not required for trade mark protection. According to the Trademark Act of 1946, 15 U.S.C. § 1125 (2019), it is possible to sue for the infringement of an unregistered mark. However, trade mark registration under U.S. law provides for certain benefits. For more information on the federal trade mark registration in the U.S., see e.g.: Lydia Pallas Loren and Joseph Scott Miller, *Intellectual Property Law: Cases and Materials* (Semaphore Press 2018) 519-525.
- 28 *In re General Electric Broadcasting Company Inc.* 199 U.S.P.Q. (BNA) 560 (TTBA 1978).

status”<sup>29</sup> permits a sign to serve as a trade mark<sup>30</sup>. In addition, the Supreme Court indicated that the language of the Trademark Act of 1946 (the ‘Trademark Act’)<sup>31</sup> defines the “universe [of things that can qualify as a trade mark] <...> in the broadest of terms”<sup>32</sup>. Thus, single colors may sometimes meet the basic requirements for a trade mark and there is no rule preventing that<sup>33</sup>. The words “symbol”, “device” and “any combination thereof” defining a trade mark in the Trademark Act<sup>34</sup> are the key terms for allowing for the protection of color, sound, shape and other types of signs where they serve as trade marks<sup>35</sup>. The registration procedure for non-visual marks was accommodated by the USPTO establishing the classification “a mark drawing code 6”, which is used for sounds, scents and other non-visual marks<sup>36</sup>.

29 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 164 (1995).

30 *ibid.*

31 Trademark Act of 1946, 15 U.S.C. § 1051 (2019): “The term “trademark” includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”

32 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162 (1995).

33 *ibid.*, 161 and 166 (1995).

34 Trademark Act of 1946, 15 U.S.C. § 1051 (2019).

35 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 172-173 (1995). However, in the legal doctrine, not everyone agrees with this interpretation (see e.g.: Glynn S Lunney, Jr., ‘Non-Traditional Trademarks. The Error Costs of Making an Exception the Rule’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018), 225).

36 Trademark Manual of Examining Procedure, Chapter 800, § 807.09 ‘Drawing’ of Sound, Scent, or Non-Visual Mark (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1103.html>> accessed 12 April 2019; e.g.: (i) U.S. Reg. No. 5905067, registration date 5 November 2019 (sound mark consisting “of Instrumental work performed by two pianos in the key of B-major that is comprised of a five-note melody of D#5, E5, F#5, B4, and ending on the B4 and B5 octaves and accompanied by two B (tonic) chords” for “[i]nsurance underwriting and administration services for all types of insurance; providing underwriting and administration services for pension funds; residential and commercial mortgage

11 The existence of the above-specified drawing code demonstrates that, under U.S. law, formal requirements allow for the protection of non-traditional signs, including the non-visual ones. In addition, few other formal requirements have to be fulfilled in order to obtain a registration. Firstly, a drawing, which shows the mark and serves for providing a “notice of the nature of the mark sought to be registered”<sup>37</sup>, needs to be presented. This condition applies to visual, e.g., word, numerical, three-dimensional, motion and hologram signs, whereas for the registration of sound, scent and other non-visual marks it is not compulsory<sup>38</sup>. Secondly, applications for any mark in non-standard characters<sup>39</sup> must be accompanied by

lending services; real estate brokerage and management services; mutual fund brokerage and investment services, namely, investment banking and funds investment; financial retirement planning services; employee benefits services, namely, processing, administering, and managing employee benefit plans concerning insurance and finance; insurance services, namely, underwriting, issuing and administration of life insurance; issuance and administration of annuities; insurance brokerage services; investment services, namely, asset acquisition, consultation, development and management services; investment of funds for others; annuity services, namely, account and investment administration and the investment and distribution of annuity funds; financial services, namely, investment fund transfer and transaction services; financial services, namely, providing an investment option available for variable annuity and variable life insurance products; financial and investment services, namely, asset and investment acquisition, consultation, advisory and development; insurance and financial information and consultancy services”; (ii) U.S. Reg. No. 5467089, registration date 15 May 2018 (scent mark consisting “of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough” for “[t]oy modeling compounds”); (iii) U.S. Reg. No. 5877077, registration date 8 October 2019 (sound mark consisting “of a man yelling “EEEEEEYOOOOO” in falsetto with “E” drawn out followed by a “U” sound” for “[m]usical sound recordings; musical video recordings”). United States Patent and Trademark Office. Trademark Electronic Search System (TESS) (Word and/or Design Mark Search (Structured) <<https://www.uspto.gov/trademarks-application-process/search-trademark-database>> accessed 23 November 2019 (search criteria: ‘Search Term’ “6”[MD] as ‘Mark Drawing Code’).

37 Trademark Manual of Examining Procedure, Chapter 800, § 807 ‘Drawing’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1103.html>> accessed 12 April 2019.

38 *ibid.*

39 A mark not in standard characters is if: (i) the applicant

a written description<sup>40</sup> indicating all the significant features of a mark<sup>41</sup>. Thirdly, “one specimen for

is claiming a particular font style, size, or color of words, letters, or numbers; (ii) the mark contains a design element; (iii) the mark includes non-Latin characters; (iv) the mark includes non-Roman or non-Arabic numerals; (v) the mark includes uncommon punctuation or diacritical marks; (vi) the mark is three-dimensional, or a configuration of the goods or packaging; (vii) the drawing includes broken lines to show position or placement or to indicate a portion of the product or packaging that is not part of the mark; (viii) the mark includes color; (ix) the mark includes motion; (x) the mark is a sound, scent, or other non-visual mark; (xi) the mark appears in standard characters, but an element of the mark is unclear or ambiguous; (xii) the mark consists of characters from the standard character set, but the characters are displayed in a manner that affects the meaning or significantly contributes to the overall commercial impression of the mark, such as using standard characters that create emoticons (Trademark Manual of Examining Procedure, Chapter 800, § 808.01 ‘Guidelines for Requiring Description’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e2086>.html> accessed 27 November 2019).

40 Trademark Manual of Examining Procedure, Chapter 800, § 808.01 ‘Guidelines for Requiring Description’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e2086.html>> accessed 27 November 2019. In an application for a mark in standard characters, a description may be included and, on the request of the trade mark examining attorney, must be included (Patents, Trademarks and Copyrights, 37 C.F.R. § 2.37 (2019))

41 *ibid*, § 808.02 ‘Description Must Be Accurate and Concise’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e2155.html>> accessed 26 November 2019. In principle, under U.S. trade mark law, “[a] drawing depicts the mark sought to be registered” (Patents, Trademarks and Copyrights, 37 C.F.R. § 2.52 (2019)), however, a description is also compulsory for any mark not in standard characters and, at times, under the request of an examining attorney, it must be submitted even if a mark appears in standard characters (Trademark Manual of Examining Procedure, Chapter 800, § 808.01 ‘Guidelines for Requiring Description’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e2078>.html> accessed 26 November 2019). In comparison to EU trade mark law and EUIPO Guidelines indicating that a description is an optional requirement in the cases where it is allowed and cannot replace the representation of the mark or extend its scope of protection (i.e. the representation defines the subject-matter of the trade mark applied for), the U.S. trade mark law and Trademark Manual of Examining Procedure establish not only more detailed requirements with regard to the description of the U.S. trade marks, but also gives an important role to the it when depicting/defining sound, scent and other non-visual marks. On the description requirement under EU trade

each class, showing use of the mark in commerce on or in connection with the goods, or in the sale or advertising of the services” must be submitted<sup>42</sup>. These formal requirements may vary according to the type of sign that is sought to be registered.

- 12 Apart from these formal requirements, each mark must comply with the substantive prerequisites: it (i) has to have a distinctive character<sup>43</sup>; (ii) has to be in use<sup>44</sup>; and (iii) must overcome the bars to protection established by the Trademark Act, the most significant of which in the context of non-traditional marks is the functionality<sup>45</sup>. While providing evidence on the use of a mark is usually not a difficult task, the establishment of the distinctive character and dealing with functionality issues can be more complicated. Certain types of non-traditional marks (e.g., unique sound marks) may be deemed to be inherently distinctive<sup>46</sup>, whereas color, scent

mark law, see: EUTMR and Guidelines for Examination of European Union Trade Marks, Part B ‘Examination’. Section 2. ‘Formalities’ 1 October 2017 <<https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines-pdf>> accessed 26 November 2019.

42 Trademark Manual of Examining Procedure, Chapter 900, § 904 ‘Specimens’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e489.html>> accessed 23 November 2019; also see: Trademark Manual of Examining Procedure, Chapter 900, § 904.03 ‘Material Appropriate as Specimens for Trademarks’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e636.html>> accessed 23 November 2019; Trademark Manual of Examining Procedure, Chapter 1300, § 1301.04 ‘Specimens of Use for Service Marks’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1300d1e266.html>> accessed 23 November 2019; Trademark Manual of Examining Procedure, Chapter 900 §, 904.01(a) ‘More than One Item Specified in a Class’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e530.html>> accessed 23 November 2019; Patents, Trademarks and Copyrights, 37 C.F.R. § 2.56-§ 2.59 (2019).

43 Trademark Act of 1946, 15 U.S.C. § 1052 and § 1127 (2019).

44 *ibid*. Also a bona fide intention to use any word, name, symbol, or device, or any combination thereof in commerce can be sufficient to fulfil the use requirement.

45 Trademark Act of 1946, 15 U.S.C. § 1052 (e) (2019).

46 E.g.: (i) U.S. Reg. No. 5575905, registration date 2 October 2018 (sound mark consisting “of the spoken words THE RIGHT WAY, NOT THE EASY WAY, with an emphasis on the words RIGHT and EASY” for “[a]ir duct cleaning services; Drain and sewer cleaning and rootering services; Installation and repair of heating, ventilating and air conditioning equipment; Installation and replacement

and commonplace sound marks can almost never possess this feature<sup>47</sup> and must be accompanied by

service for water heaters; Installation of solar energy systems and alternative energy products for residential and commercial use; Installation, maintenance and repair of water filtration, softening, reverse osmosis, chemical feed pump, specialty cartridge and housing, water, and drain and sewer systems; Plumbing services; Repair or maintenance of gas water heaters; Installation and repair of air conditioning apparatus"); (ii) U.S. Reg. No. 5905067, registration date 5 November 2019 (sound mark consisting "of Instrumental work performed by two pianos in the key of B-major that is comprised of a five-note melody of D#5, E5, F#5, B4, and ending on the B4 and B5 octaves and accompanied by two B (tonic) chords" for "[i]nsurance underwriting and administration services for all types of insurance; providing underwriting and administration services for pension funds; residential and commercial mortgage lending services; real estate brokerage and management services; mutual fund brokerage and investment services, namely, investment banking and funds investment; financial retirement planning services; employee benefits services, namely, processing, administering, and managing employee benefit plans concerning insurance and finance; insurance services, namely, underwriting, issuing and administration of life insurance; issuance and administration of annuities; insurance brokerage services; investment services, namely, asset acquisition, consultation, development and management services; investment of funds for others; annuity services, namely, account and investment administration and the investment and distribution of annuity funds; financial services, namely, investment fund transfer and transaction services; financial services, namely, providing an investment option available for variable annuity and variable life insurance products; financial and investment services, namely, asset and investment acquisition, consultation, advisory and development; insurance and financial information and consultancy services"; (iii) U.S. Reg. No. 5842808, registration date 27 August 2019 (sound mark consisting "of a sound mark comprising the word "Oralé" sung to a melody consisting of the following musical notes: G# A# B" for "[a]utomobile dealership services"). United States Patent and Trademark Office. Trademark Electronic Search System (TESS) (Word and/or Design Mark Search (Structured) <<https://www.uspto.gov/trademarks-application-process/search-trademark-database>> accessed 23 November 2019 (search criteria: 'Search Term' "6"[MD] as 'Mark Drawing Code').

47 Sheldon W Halpern, Craig Allen Nard and Kenneth L Port, *Fundamentals of US Intellectual Property Law. Copyright, Patent and Trade mark* (5<sup>th</sup> Edition, Wolters Kluwer 2015) 69; Jerome Gilson and Anne Gilson LaLonde, 'Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks' [2005] 95 (4) The Trademark Reporter 773, 776. There has been one exception with regard to one smell mark (a lemon fragrance 'for toner for digital laser printers, photocopiers, microfiche printers

evidence demonstrating that, due to their use in the market place, these marks clearly indicate to consumers the source of the product or service<sup>48</sup>, i.e. have acquired secondary meaning. Secondary meaning is established, when "in the minds of the public, the primary significance of a product feature <...> is to identify the source of the product, rather than the product itself"<sup>49</sup>. Additionally, quite often the applicants need to prove the non-functionality of a mark<sup>50</sup>. This means that the product's feature which one wishes to register as a trade mark must not be essential to the use or purpose of the good or service and affect the cost or quality of it<sup>51</sup>. If, based on at least one of these two criteria, a product feature is not functional from the utilitarian perspective, it can be aesthetically functional on the condition, that an exclusive use of that feature would place competitors at a significant non-reputation-related disadvantage<sup>52</sup>. These substantive requirements apply to all types of non-traditional marks, but to a certain extent, it may vary depending on their type.

## I. Color Marks

13 In 1995, the Supreme Court confirmed that a single color could serve as a trade mark, establishing a rather broad scope of registrable signs<sup>53</sup>. Formal requirements for the applications of such marks before the USPTO are in accordance with this case law. The to-be-registered sign should be depicted in a

and telecopiers' <<https://www.uspto.gov/trademarks-application-process/search-trademark-database>> accessed 25 November 2019) Serial No. 75120036 (abandoned) (see: Thomas P Arden, *Protection of Nontraditional Marks* (International Trademark Association, 2000) 55.)

48 Douglas A Rettew, 'Offbeat Page in Branding Playbook' [2012] The National Law Journal <<https://www.finnegan.com/en/insights/offbeat-page-in-branding-playbook.html>> accessed 12 April 2019; Trademark Act of 1946, 15 U.S.C. § 1052 (f) (2019).

49 Inwood Laboratories v. Ives Laboratories, 456 U.S. 844, 851, n. 1 (1982) citing Kellogg Co. v. National Biscuit Co., 305 U.S. 111, 118 (1938).

50 15 U.S.C. § 1952 (f) (2019).

51 Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 165 (1995). Also see: Lydia Pallas Loren and Joseph S Miller, *Intellectual Property Law: Cases and Materials* (Semaphore Press 2018) 547.

52 Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 169 (1995).

53 Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995).

color drawing, which consists of a substantially exact representation of a mark as used or intended to be used on the goods<sup>54</sup>. The latter must be accompanied by a description consisting of: (i) a color claim naming the color for which the protection is being sought; and (ii) a separate statement describing where the color appears in the mark<sup>55</sup>. Finally, the applicant must submit a specimen of the mark demonstrating the use of the color in commerce on/in connection with the relevant goods and/or services<sup>56</sup>.

- 14 A single color is capable of registration as a trade mark, if its secondary meaning in the marketplace and non-functionality can be demonstrated<sup>57</sup>. The former prerequisite can be evaluated by analyzing the consumers' attitude with respect to a certain mark<sup>58</sup>. If, over time, consumers begin treating a particular color on a product or its packaging as identifying and distinguishing a particular brand, this color has acquired a secondary meaning<sup>59</sup>. In

addition to the latter direct evidence, circumstantial proof also plays an important role in the discussed situations. This proof consists of data concerning the advertisement of the mark and its expenditures, length and exclusivity of use, as well as success and volume of sales<sup>60</sup>.

- 15 While addressing the functionality, it is analyzed whether the registration of such a mark would undermine competition by allowing the applicant to control a "useful product feature"<sup>61</sup>, e.g., color, with the help of the trade mark law<sup>62</sup>. Colors can be regarded as functional, when, e.g., they are an industry standard used for safety reasons, also if it is more economical to manufacture or use them<sup>63</sup>. When a color does not possess utilitarian functionality, it nevertheless can be aesthetically functional<sup>64</sup>, if "the exclusive use of the feature [e.g. color] would put competitors at a significant non-reputation-related disadvantage"<sup>65</sup>. In one case, the black color for outboard motors, due to its compatibility to boat colors and ability to decrease apparent motor size, was regarded as essential for engine manufacturers to compete and thus held as functional<sup>66</sup>.

54 Trademark Manual of Examining Procedure, Chapter 800, § 807.07(a) 'Requirements for Color Drawings' (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1488.html>> accessed 27 November 2019. Also see: Chapter 1200, § 1202.05(d)(i) 'Drawings of Color Marks in Trademark Applications' (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e2169.html>> accessed 27 November 2019

55 Trademark Manual of Examining Procedure, Chapter 800, § 807 'Drawing' (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1103.html>> accessed 27 November 2019

56 Trademark Manual of Examining Procedure, Chapter 900, § 904.02(c)(ii) 'Specimens for Marks Comprising Color' (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e608.html>> accessed 27 November 2019.

57 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163-165 (1995). However, according to the legal scholarly literature, the threshold to prove acquired distinctiveness, in order to register certain signs as trade marks in the U.S., can be very low (e.g.: Irene Calboli, 'Hands Off "My" Colors, Patterns, and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation' in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 294 citing Jake Linford, *A Linguistic Justification for Protecting "Generic" Trademarks*, 17 *YALE J.L. & TECH.* 110 (2015); *Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986 (Fed. Cir. 2016)).

58 Barton Beebe and others, *Trademarks, Unfair Competition and Business Torts* (2<sup>nd</sup> Edition, Wolters Kluwer 2016) 66

59 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163 (1995).

60 Thomas J McCarthy *Trademarks and Unfair Competition* (Volume 2, Thomson West 2007) § 15:30; Barton Beebe and others, *Trademarks, Unfair Competition and Business Torts* (2<sup>nd</sup> Edition, Wolters Kluwer 2016) 66.

61 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 169 (1995).

62 *ibid.*

63 Trademark Manual of Examining Procedure, Chapter 1200, §1202.05(b) 'Functional Color Marks Not Registrable' (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e2081.html>> accessed 19 January 2020.

64 Gary R Lea, 'Special marks: after 20 years, not so special after all?' [2015] 20(2) *Communications Law*, 40, 42 citing Michael Mirales, 'Aesthetic Functionality', 21 *Texas Intellectual Property Law Journal* 155 (2013).

65 *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 165 (1995).

66 *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532-1533, 32 U.S.P.Q.2d 1120 (Fed. Cir. 1994). Other examples: (i) in the case *Christian Louboutin v. Yves Saint Laurent America*, the U.S. District Court ruled that the red outsoles serve non-trademark functions other than as a source identifier (e.g., "to attract, to reference, to stand out, to blend in, to beautify, to endow with sex appeal"), thus, such a trade mark is aesthetically functional and is a threat to legitimate competition in the designer shoe market (*Christian Louboutin v. Yves Saint Laurent America*, 778



## II. Scent and Taste Marks

16 In 1990, the TTAB held that the scent of Plumeria blossoms could serve as a trade mark for sewing thread and embroidery yarn<sup>67</sup>. With regard to the formal requirements, instead of a drawing, the applicant is required to submit a detailed description of a mark<sup>68</sup>. Since there is not much guidance regarding the description requirement, the fulfilment of this prerequisite depends on each individual case. Similar requirements also apply to the registration of taste marks. Applicants for both types of marks are also required to submit a specimen containing the scent or flavor, which matches the description<sup>69</sup>. This means that, generally, a specimen will consist of the actual goods themselves; thus, in order for the USPTO to correctly direct a specimen to the examining attorney, during the submission it should be indicated that it is a specimen for a scent or flavour mark application<sup>70</sup>.

17 With regard to the distinctiveness requirement, in 1990 it was also held that the scent of Plumeria blossoms could be registered for sewing thread and embroidery yarn not for its inherent distinctiveness, but because it had acquired a secondary meaning. The latter position was based on the arguments that: (i) the applicant was the only one marketing threads and yarns with a scent; (ii) the scent was a feature added by the applicant and not inherent or

natural to the goods; (iii) the applicant advertised and promoted the scented feature; and (iv) it was demonstrated that purchasers had recognized the applicant as the source of the scented goods<sup>71</sup>.

18 However, in a later case, a lemon fragrance, due to its inherent distinctiveness, was approved as a trade mark for laser printers and photocopiers<sup>72</sup>. Nevertheless, inherent distinctiveness of a smell is not common and demonstrating it can be a very challenging task for the applicants<sup>73</sup>. For instance, on the Principal Register there are only four valid registrations of scent marks<sup>74</sup>. They have been approved after the evidence on their acquired

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F. Supp. 2d 445, 453 (S.D.N.Y. 2011)). Later, the Second Circuit of the Court of Appeals in the same case ruled that red outsoles could be protected as a trade mark without analyzing the functionality aspect (Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc., 696 F.3d 206 (2nd Cir. 2012)); (ii) the USPTO TTAB held that the color black for floral packaging is aesthetically functional, because of a competitive need for others in the industry to use black in connection with floral arrangements to communicate a desired sentiment or occasion, such as elegance, bereavement or Halloween, (*In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784, 1791 (TTAB 2013)).

67 *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238 (TTAB 1990).

68 Trademark Manual of Examining Procedure, Chapter 800, § 807.09 "Drawing" of Sound, Scent, or Non-Visual Mark' (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1656.html>> accessed 27 November 2019.

69 Trademark Manual of Examining Procedure, Chapter 900, § 904.03(m) 'Specimens for Scent and Flavor Marks' (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e994.html>> accessed 27 November 2019.

70 *ibid.*

71 *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238, 1238-1240 (TTAB 1990).

72 A lemon fragrance "for toner for digital laser printers, photocopiers, microfiche printers and telecopiers" <<https://www.uspto.gov/trademarks-application-process/search-trademark-database>> accessed 25 November 2019 (search criteria: 'Search Term' '75120036' as 'Serial or Registration Number') Serial No. 75120036 (abandoned); Thomas P Arden, *Protection of Nontraditional Marks* (International Trademark Association, 2000) 55.

73 Carolina Castaldi, 'The Economic Management of Non-Traditional Trademarks. Why, How Much, What and Who' in Irene Calboli and Martin Senftleben (eds) *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2019) 267 citing Amanda E. Compton, *Acquiring a Flavor for Trademarks: There's No Common Taste in the World*, 8 Nw. J. Tech. & Intell. Prop. 340 (2009).

74 (i) U.S. Reg. No. 2463044, registration date 26 June 2001 (cherry scent for "synthetic lubricants for high performance racing and recreational vehicles"); (ii) U.S. Reg. No. 4057947, registration date 22 November 2011 (high impact fragrance primarily consisting of musk, vanilla, rose, and lavender "for hair conditioners, namely, curl creams, hydrating styling creams, intense moisturizing masques, and styling and finishing oils"); (iii) U.S. Reg. No. 4754435, registration date 16 June 2015 (the scent of bubble gum for "shoes, sandals, flip flops, and accessories, namely, flip flop bags"); (iv) U.S. Reg. No. 5467089, registration date 15 May 2018 (a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough for "toy modeling compounds"). United States Patent and Trademark Office. Trademark Electronic Search System (TESS) (Word and/or Design Mark Search (Structured) <<https://www.uspto.gov/trademarks-application-process/search-trademark-database>> accessed 12 April 2019 (search criteria: (i) 'Search Term' "6"[MD] as 'Mark Drawing Code' AND 'Search Term' 'fragrance' as 'Description of Mark'; or (ii) 'Search Term' "6"[MD] as 'Mark Drawing Code' AND 'Search Term' 'scent' as 'Description of Mark'; or (iii) 'Search Term' "6"[MD] as 'Mark Drawing Code' AND 'Search Term' 'scent' as 'Description of Mark').

distinctiveness has been provided<sup>75</sup>. Thus, it seems that the standards for the distinctiveness of scent marks are rather high.

- 19 When refusing the registration of fragrances as trade marks, another argument is that they are functional and, due to the “competitive need for free access to pleasant scents and fragrances”<sup>76</sup>, the protection for such trade marks should not be granted. However, according to the TTAB, a registration of a mark should not be denied simply because the scent may be pleasing<sup>77</sup>. Although there is not much guidance on the functionality aspects of smell marks, it seems that U.S. law requires an extensive amount of evidence thereof<sup>78</sup> making it a challenging procedure<sup>79</sup>.

75 (i) U.S. Reg. No. 2463044, registration date 26 June 2001 (cherry scent for “synthetic lubricants for high performance racing and recreational vehicles”), see: Response to Office Action, 15 November 1996 <<http://tsdr.uspto.gov/documentviewer?caseId=sn74720993&docId=IPC20061018144052#docIndex=14&page=1>> accessed 12 April 2019; (ii) U.S. Reg. No. 4057947, registration date 22 November 2011 (high impact fragrance primarily consisting of musk, vanilla, rose, and lavender “for hair conditioners, namely, curl creams, hydrating styling creams, intense moisturizing masques, and styling and finishing oils”), see: Response to Office Action, 16 March 2010 <<http://tsdr.uspto.gov/documentviewer?caseId=sn77755814&docId=ROA20100317174627#docIndex=20&page=1>> accessed 12 April 2019; (iii) U.S. Reg. No. 4754435, registration date 16 June 2015 (the scent of bubble gum for “shoes, sandals, flip flops, and accessories, namely, flip flop bags”), see: Response to Office Action, dated 12 January 2015 <<http://tsdr.uspto.gov/documentviewer?caseId=sn86265443&docId=ROA20150112173029#docIndex=8&page=1>> accessed 12 April 2019; (iv) U.S. Reg. No. 5467089, registration date 15 May 2018 (a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough for “toy modeling compounds”), see: Response to Office Action, 27 November 2017 <<http://tsdr.uspto.gov/documentviewer?caseId=sn87335817&docId=ROA20171128174227#docIndex=11&page=1>> accessed 12 April 2019.

76 *In re Clarke*, 17 U.S.P.Q.2d (BNA) 1238, 1238 (TTAB 1990).

77 *University Book Store v. University of Wisconsin Bd. Of Reagents*, 33 U.S.P.Q.2d (BNA) 1385, 1405 (TTAB 1994)

78 Trademark Manual of Examining Procedure, Chapter 1200, §1202.13 ‘Scent, Fragrance, or Flavor’ (October 2018), <<https://tmept.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e2882.html>> accessed 12 April 2019.

79 Carolina Castaldi, ‘The Economic Management of Non-Traditional Trademarks. Why, How Much, What and Who’ in Irene Calboli and Martin Senftleben (eds) *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2019)

All this may help to explain the low number of smell marks on the Principal Register of the USPTO.

- 20 The issue of distinctiveness and functionality of flavor marks is treated similarly to the smell ones: the applicant must submit substantial proof of secondary meaning and needs to overcome the non-functionality hurdle<sup>80</sup>. For instance, when deciding on the registration of a taste mark, the TTAB held that an orange flavor is such an essential characteristic of pharmaceuticals that, even though this flavor is “unique”<sup>81</sup>, the consumers will not perceive it as a trade mark without being educated to do so, thus, substantial evidence of acquired distinctiveness should be shown<sup>82</sup>. Additionally, this flavor was regarded to be functional and, therefore, incapable of serving as a trade mark for an antidepressant pharmaceutical product because “the medicinal ingredients in Pharmaceuticals generally have a disagreeable taste that may be masked so that patients will be more likely to take the medicine”<sup>83</sup>. In such a situation, the orange taste performs a utilitarian function and its monopolization would hinder competition in the pharmaceutical market.

### III. Sound Marks

- 21 The first sound mark consisting of musical notes G, E, C played on chimes was registered in 1950 for broadcasting services<sup>84</sup>. According to the Trademark

267 citing Amanda E. Compton, *Acquiring a Flavor for Trademarks: There’s No Common Taste in the World*, 8 Nw. J. Tech. & Intell. Prop. 340 (2009).

- 80 According to the USPTO Trademark Electronic Search System (TESS) (Word and/or Design Mark Search (Structured)), there are no ‘live’ registrations of taste (flavor) trademarks <<https://www.uspto.gov/trademarks-application-process/search-trademark-database>> accessed 25 April 2019 (search criteria: (i) ‘Search Term’ “6”[MD] as ‘Mark Drawing Code’ AND ‘Search Term’ ‘taste’ as ‘Description of Mark’; and (ii) ‘Search Term’ “6”[MD] as ‘Mark Drawing Code’ AND ‘Search Term’ ‘flavor’ as ‘Description of Mark’).

81 *In re NV Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1650 (TTAB 2006)

82 *ibid.*

83 *In re NV Organon*, 79 U.S.P.Q.2d (BNA) 1639, 1648-1649 (TTAB 2006).

84 Serial No. 71541873, U.S. Reg. No. 0523616 (expired) <<https://www.uspto.gov/trademarks-application-process/search-trademark-database>> accessed 12 April 2019. Also see: Roberto Carapeto, ‘A Reflection About the Introduction of Non-Traditional Trade marks’ [2016] 34 Waseda Bulletin

Manual of Examining Procedure, when registering such trade marks, applicants are not required to submit a drawing<sup>85</sup>. Instead, as in the case of all the non-visual marks, a detailed description of a sound, including any words or lyrics, supplemented and clarified by an audio reproduction of that sound mark<sup>86</sup>, must be presented<sup>87</sup>. If a mark comprises music or words set to music, an application should include the musical score sheet to supplement or clarify the description of the mark<sup>88</sup>. Finally, a specimen containing an audio or video and showing how a mark is used in connection with the goods/services must be submitted<sup>89</sup>.

- 22 According to the TTAB, sound marks are dependent on aural perception, which “may be as fleeting as the sound itself”<sup>90</sup>. It distinguishes two types of sound marks: (i) unique, different or distinctive sounds capable of being registered without any proof of a secondary meaning; and (ii) commonplace sounds registrable after acquiring the secondary meaning<sup>91</sup>. In order to fall into the first group, a sound must be “so inherently different or distinctive that it attaches to the subliminal mind of the listener, to be awakened when heard, and to be associated with

the source or event with which it is struck”<sup>92</sup>. This does not mean that the commonplace sounds cannot function as trade marks; however, differently than the arbitrary marks, the non-distinctive ones must be supported by strong evidence demonstrating that present and prospective purchasers “recognize and associate the sound with services offered and/or rendered exclusively with a single, albeit anonymous, source”<sup>93</sup>.

- 23 Regardless of the above-described situation, obtaining a sound mark can still be a lengthy and complicated process, especially, when it comes to onomatopoeias, i.e. animal, human or other noises occurring in the nature<sup>94</sup>, which can be regarded as falling under the category of these commonplace sounds. An example of a successfully registered onomatopoeia under U.S. law is the MGM lion’s roar<sup>95</sup>. However, while dealing with the application for a trade mark consisting of the sound of a Harley-Davidson motorcycle engine, the TTAB stated that it should be considered at trial, whether the “applicant’s asserted mark should be refused registration as a functional by-product of, or descriptive of, motorcycle engines, that the <...> opposers, and some of the others, claim a right to use”<sup>96</sup>.

Thus, if this application had not been withdrawn<sup>97</sup>, the functionality test could have been applied and might have been an obstacle for obtaining the registration.

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of Comparative Law 25, 26-27; Michael B Sapherstein, ‘The Trademark Registrability of the Harley-Davidson Roar: A Multimedia Analysis’ [1998] Boston College Intellectual Property & Technology Forum <<http://bcipitf.org/wp-content/uploads/2011/07/48-THE-TRADEMARK-REGISTRABILITY-OF-THE-HARLEY.pdf>> accessed 12 April 2019.

85 Trademark Manual of Examining Procedure, Chapter 800, § 807.09 “Drawing” of Sound, Scent, or Non-Visual Mark’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1656.html>> accessed 27 November 2019.

86 *ibid.* An audio file in electronic format, when submitting an online application for a registration of a trade mark, or any other medium (compact discs (“CDs”), digital video discs (“DVDs”), videotapes, or audiotapes) in case of paper filling.

87 Trademark Manual of Examining Procedure, Chapter 800, § 807.09 “Drawing” of Sound, Scent, or Non-Visual Mark’ (October 2018) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1656.html>> accessed 27 November 2019.

88 *ibid.*

89 *ibid.*

90 *In re* General Electric Broadcasting Company, Inc., 199 U.S.P.Q. (BNA) 560, 563 (TTBA 1978).

91 *ibid.*

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92 *ibid.*

93 *ibid.*

94 Ralf Sieckmann, ‘Sound Trade and Service Marks’ in Kai Bronner, Rainer Hirt (eds), *Audio Branding. Brands, Sounds and Communication* (Nomos 2009) 193.

95 Serial No. 73553567, U.S. Reg. No. 1395550 (the sound of a lion’s roar used in connection with applicant’s movie production) <<http://tmsearch.uspto.gov/bin/gate.exe?f=te ss&state=4803:loq824.1.1>> accessed 27 November 2019

96 *Kawasaki Motors Corp., U.S.A. v. H-D Michigan, Inc. et al.* 43 U.S.P.Q.2d. (BNA) 1521, 1521 (TTAB 1997)

97 Daniel R Bumpus, ‘BING, BANG, BOOM: An Analysis of *In re Vertex Goup LLC* and the Struggle for Inherent Distinctiveness in Sound Marks Made During a Product’s Normal Course of Operation’ [2011] 21(2) The Federal Circuit Bar Journal 245, 257 citing John O’Dell, Harley-Davidson Quits Trying to Hog Sound, L.A. Times (June 21, 2000), <https://articles.latimes.com/2000/jun/21/business/fi-43145>.

## IV. Motion and Hologram Marks

- 24 In case a to-be-registered sign contains a repetitive motion of short duration<sup>98</sup> or a hologram<sup>99</sup>, the applicant must submit a drawing, which may depict: (i) a single point in the movement; or (ii) up to five freeze frames showing various points in the movement, whichever best represents the commercial impression of the mark<sup>100</sup>. Every application must contain “a detailed written description of the mark”<sup>101</sup>. Finally, a specimen showing the entire motion and illustrating the commercial impression of a mark must be presented in the form of a video, a series of still photos, or screen shots<sup>102</sup>. It is essential for the latter specimen to show the motion mark in association with the goods or services and not simply in a video<sup>103</sup>.
- 25 Since the movement marks are regarded as being the closest to the traditional visual ones, their evaluation with regard to the substantive requirements, i.e. distinctiveness and non-functionality, is similar<sup>104</sup>. However, it might be challenging to prove that the

motion mark actually serves as a source identifier<sup>105</sup>. Therefore, a large part of motion marks is registered for electronic goods or software, where the mark is conveyed to the consumer via a display screen<sup>106</sup>.

- 26 Taking into consideration all the aforementioned aspects of non-traditional trade mark registration, it is clear that under U.S. trade mark law, the drawing requirement does not apply to all the types of marks. This way, the formal prerequisites under U.S. law for registering non-traditional marks, especially non-visual ones, are more flexible and provide more opportunities for obtaining protection for a wider variety of signs than the pre-reform EU legal system. However, despite the more lenient formal requirements established by U.S. trade mark law, the non-traditional marks must overcome the threshold of the substantive requirements<sup>107</sup> that, depending on the type of a mark to be registered, may vary.

## D. The Removal of the Graphic Representation Requirement in EU Law

- 98 Trademark Manual of Examining Procedure, Chapter 800, § 807.11 ‘Marks With Motion’ (October 2018) <<https://tmepl.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1699.html>> accessed 27 November 2019. E.g.: a three-dimensional spray of water issue from the rear of jet propelled watercraft (Serial No. 74321288; U.S. Reg. No. 1946170 <<http://tmsearch.uspto.gov/bin/gate.exe?f=tess&state=4810:wwwgpe.1.1>> accessed 27 November 2019).
- 99 Gary R Lea, ‘Special marks: after 20 years, not so special after all?’ [2015] 20(2) Communications Law 40, 43. E.g.: a holographic logo used in connection with baseball trading cards (Serial No. 76275803; U.S. Reg. No. 2710652 <<http://tmsearch.uspto.gov/bin/gate.exe?f=tess&state=4810:wwwgpe.1.1>> accessed 27 November 2019)
- 100 Trademark Manual of Examining Procedure, Chapter 800, § 807.11 ‘Marks With Motion’ (October 2018) <<https://tmepl.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1699.html>> accessed 12 April 2019.
- 101 *ibid.*
- 102 Trademark Manual of Examining Procedure, Chapter 900, § 904.03 (I) ‘Specimens for Motion Marks’ (October 2018) <<https://tmepl.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e966.html>> accessed 27 November 2019.
- 103 *ibid.*
- 104 Jerome Gilson and Anne Gilson LaLonde, ‘Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks’ [2005] 95 (4) The Trademark Reporter 773, 806.

- 27 Since 1 October 2017, the EUTMR together with the EUTMIR, and the European Union Trade Mark Delegated Regulation<sup>108</sup> are the main documents governing the EU trade mark protection-related aspects. With regard to the registration of non-traditional marks, the most important provision is Art. 4 EUTMR establishing that, in order to be registered, a trade mark, apart from being able to distinguish the goods or services of one undertaking

- 105 Susan J Keri, Jonathan Burkinshaw and Elisabeth A Langworthy, ‘Moving with the Times: Motion Marks in Canada and the United States’ [2011] <<http://www.inta.org/INTABulletin/Pages/MovingwiththeTimesMotionMarks.aspx>> accessed 12 April 2019
- 106 Julie D Shirk and Monica Riva Talley, ‘I second that e-motion: protecting motion marks’ [2015] <<https://www.sterneckessler.com/news-insights/publications/i-second-e-motion-protecting-motion-marks>> accessed 12 April 2019.
- 107 Especially, distinctiveness and non-functionality.
- 108 Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 [2017] OJ L 205/1. Since 13 May 2018, repealed by Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 [2018] OJ L 104/1.

from those of other undertakings<sup>109</sup>, should be represented on 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.”<sup>110</sup> Additionally, Recital 10 of the EUTMR indicates that “a sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”<sup>111</sup> The latter provision, together with the aforementioned Art. 4 provides the formal criteria necessary to fulfil when registering both traditional and non-traditional trade marks.

**28** Pursuant to Art. 31 (3) EUTMR, an application for an EU trade mark shall comply with the formal requirements laid down in the EUTMR and in the EUTMIR<sup>112</sup>. The more practical aspects of the aforementioned requirements are established by the EUTMIR, which provides guidance on the implementation of the provisions of the EUTMR. In particular, the Art. 3 EUTMIR develops the representation requirements of the EU trade marks in light of the Art. 4 (b) EUTMR modifying the previous Rule 3 of the Commission Regulation (EC) No 2868/95 (the ‘CTMIR’)<sup>113</sup>, which was suitable

<sup>109</sup> EUTMR, art 4 (a).

<sup>110</sup> *ibid*, art 4 (b).

<sup>111</sup> *ibid*, recital 10.

<sup>112</sup> EUTMR, art 31 (3).

<sup>113</sup> Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark, rule 3 (since 30 September 2017 no longer in force): “(1) If the applicant does not wish to claim any special graphic feature or colour, the mark shall be reproduced in normal script, as for example, by typing the letters, numerals and signs in the application. The use of small letters and capital letters shall be permitted and shall be followed accordingly in publications of the mark and in the registration by the Office.

(2) In cases other than those referred to in paragraph 1 and save where the application is filed by electronic means, the mark shall be reproduced on a sheet of paper separate from the sheet on which the text of the application appears. The sheet on which the mark is reproduced shall not exceed DIN A4 size (29,7 cm high, 21 cm wide) and the space used for the reproduction (type-area) shall not be larger than 26,2 cm × 17 cm. A margin of at least 2,5 cm shall be left on the left-hand side. Where it is not obvious, the correct position of the mark shall be indicated by adding the word ‘top’ to each reproduction. The reproduction of the mark shall be of such quality as to enable it to be reduced or enlarged to a

only for trade marks capable of being represented graphically.

**29** The catalogue of the marks established by the EUTMIR is similar to the one in the Rule 3 of the Regulations under the Singapore Treaty on the Law of Trademarks<sup>114</sup>. Art. 3 (1) EUTMIR reflects Recital 10 and Art. 4 (b) EUTMR demonstrating flexibility with regard to non-traditional trade marks<sup>115</sup>, but with a willingness to uphold the legal certainty for the parties involved. The latter aspect is reflected by the emphasis given in Art. 3 (1) EUTMIR on the necessity that the representation of a trade mark must conform with the seven prerequisites established in the *Sieckmann* judgement<sup>116</sup>.

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size not more than 8 cm wide by 16 cm high for publication in the Community Trade Mark Bulletin.

(3) In cases to which paragraph 2 applies, the application shall contain an indication to that effect. The application may contain a description of the mark.

(4) Where registration of a three-dimensional mark is applied for, the application shall contain an indication to that effect. The representation shall consist of a photographic reproduction or a graphic representation of the mark. The representation may contain up to six different perspectives of the mark.

(5) Where registration in colour is applied for, the representation of the mark under paragraph 2 shall consist of the colour reproduction of the mark. The colours making up the mark shall also be indicated in words and a reference to a recognized colour code may be added.

(6) Where registration of a sound mark is applied for, the representation of the trade mark shall consist of a graphical representation of the sound, in particular a musical notation; where the application is filed through electronic means, it may be accompanied by an electronic file containing the sound. The President of the Office shall determine the formats and maximum size of the electronic file.”

<sup>114</sup> Regulations under the Singapore Treaty on the Law of Trademarks (as in force on November 1, 2011), rule 3 <<https://wipo.lex.wipo.int/en/text/290013>> accessed 12 April 2019.

<sup>115</sup> EUTMR, art 3 (1): “trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the register”.

<sup>116</sup> Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 55: “<...> 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.”

- 30 Art. 3 (2) EUTMIR establishes that the “representation of the trade mark shall define the subject matter of the registration”<sup>117</sup> and, if there is an option to add a description to the type of mark, it shall accord with the representation and cannot extend its scope of protection<sup>118</sup>. With regard to the latter provision, when the draft EUTMIR was first published<sup>119</sup>, the International Trademark Association (INTA) proposed to delete the reference to the type of mark concerned as the EUTMR does not contain any provision on a typology of marks, but focuses on the need to provide for flexibility in accordance with Recital 10 of the EUTMR<sup>120</sup>. With regard to the aforementioned suggestion on leaving this provision “open”, it is possible to state that the added “type requirement” may bring more certainty for users and the public, and also make searches of trade marks easier this way, fulfilling the criteria set in the EUTMR, particularly, in Art. 4 (b) EUTMR<sup>121</sup>.
- 31 Art. 3 (3) EUTMIR contains a non-exhaustive list of types of trade marks: (a) word, (b) figurative, (c) shape, (d) position, (e) pattern, (f) color, (g) sound, (h) motion, (i) multimedia, and (j) hologram marks<sup>122</sup>. The new EU trade mark regime does not provide any reason to expect any major changes in practice when registering visual marks consisting of words or figures and shapes at the EUIPO<sup>123</sup>. Other visual marks, such as, pattern marks, were previously considered as “figurative marks” for formality purposes<sup>124</sup>, whereas, position marks were

regarded as “other marks”<sup>125</sup>, and the registration of both of these types of marks was available in the pre-reform period. Apart from the fact that all these visual marks are now described in a non-exhaustive list in the EUTMIR, during the reform, no major amendments were introduced to their registration. It seems that the graphic representation in the registration proceedings is still regarded as the best way of representing these marks, so that the competent authorities and the public would be able to identify what exactly is protected, whereas, the peculiarities of registering other non-traditional marks, particularly, non-visual ones, may require further discussion.

## I. Shape marks

- 32 The EUTMIR defines shape marks as “consisting of, or extending to a three-dimensional shape, including containers, packaging, the product itself or their appearance”<sup>126</sup>. The term “extending to” can be interpreted in the sense that the shape marks cover not only the shapes *per se* but also words or figurative elements that are part of the shape<sup>127</sup>. It could be more difficult to obtain protection for shapes than for word or figurative marks with regard to the distinctiveness requirement, since they may not be perceived by the relevant public in the same way as other visual marks, such as word or figurative ones<sup>128</sup>. The extension of protection provided for

117 EUTMIR, art 3 (2) and art 3 (3).

118 *ibid.*

119 International Trademark Association (Belgium). Feedback on the Draft Implementing Regulation, Transparency register No. 10141574843-32 [2016] <[https://ec.europa.eu/info/law/better-regulation/initiatives/ares-2016-5749866/feedback/F787\\_en?p\\_id=6923](https://ec.europa.eu/info/law/better-regulation/initiatives/ares-2016-5749866/feedback/F787_en?p_id=6923)> accessed 12 April 2019.

120 *ibid.*

121 EUTMR, art 4 (b): “<...> 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.”

122 *ibid.*, art 3 (3).

123 However, due to certain legal changes, the shape marks will nevertheless be discussed.

124 Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trade Marks, Part B ‘Examination’, Section 2 ‘Formalities’ 1 February 2016, 19-21 <[7\\_en.pdf> accessed 24 May 2019.](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/decisions_president/ex15-</a></p>
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125 *ibid.*, 28-30.

126 EUTMIR, art 3 (3) (c).

127 Guidelines for Examination of European Union Trade Marks, Part B ‘Examination’, Section 4 ‘Absolute Grounds of Refusal’, Chapter 2 ‘EUTM Definition’ (Article 7(1)(a) EUTMR) 1 October 2017, 5 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_2\\_2017/Part-B/04-part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal/part\\_B\\_examination\\_section\\_4\\_chapter\\_2/part\\_B\\_examination\\_section\\_4\\_chapter\\_2\\_EUTM%20definition\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_2_2017/Part-B/04-part_b_examination_section_4_absolute_grounds_for_refusal/part_B_examination_section_4_chapter_2/part_B_examination_section_4_chapter_2_EUTM%20definition_en.pdf)> accessed 25 November 2019.

128 See: case C-218/01 *Henkel* [2004] ECR I-01725, para 52 (Perwoll bottle); joined cases C-456/01 P and 457/01 P *Henkel v OHIM* [2004] ECR I-05089, para 38 (washing tablets); case C-136/02 P *Mag Instruments v. OHIM* [2004] I-09165, para 30 (three-dimensional torch shapes). For more guidance on the examination of the distinctiveness of shape marks, see: Guidelines for Examination of European Union Trade Marks, Part B ‘Examination’, Section 4 ‘Absolute Grounds of Refusal’, Chapter 3 ‘Non-distinctive trade marks’ (Article 7(1)(b) EUTMR) 1 October 2017, 18 <<https://>

visual elements as part of the appearance of the product<sup>129</sup> may render the shape mark more easily distinctive.

- 33 Additionally, during the reform, Art. 7 (1) (e) EUTMR was modified by inserting “or another characteristic”<sup>130</sup> to accommodate the removal of the graphic representation requirement<sup>131</sup>. Such prohibition should extend in an analogous way to any characteristic of a product falling under this provision, in order to prevent situations where the said characteristics would serve to confer or extend an intellectual property right, e.g. design or patent, for an indefinite period of time<sup>132</sup>.

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euipo.europa.eu/tunnel-web/secure/webdav/guest/document\_library/contentPdfs/law\_and\_practice/trade\_marks\_practice\_manual/WP\_2\_2017/Part-B/04-part\_b\_examination\_section\_4\_absolute\_grounds\_for\_refusal/part\_B\_examination\_section\_4\_chapter\_3/part\_B\_examination\_section\_4\_chapter\_3\_Non-Distinctive\_tm\_en.pdf> accessed 25 November 2019.

- 129 EUTMIR, art 3 (3) (c).
- 130 *ibid*, art 7 (1) (e): “1. The following shall not be registered (...) (e) signs which consist exclusively of: (...) (i) the shape, or another characteristic, which results from the nature of the goods themselves; (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (iii) the shape, or another characteristic, which gives substantial value to the goods”.
- 131 Taras Kubalda, ‘EU Trademark Law Reform Series: Implications for Nontraditional Marks’ [2016] <[https://www.inta.org/INTABulletin/Pages/EU\\_TM\\_Reform\\_7103.aspx](https://www.inta.org/INTABulletin/Pages/EU_TM_Reform_7103.aspx)> accessed 7 May 2019 citing Webinar ‘The EU Trademark Reform: What will it Change for Trademark Owners and Practitioners?’ (speakers: Dimitris Botis, Deputy Director for Legal Affairs, International Cooperation & Legal Affairs Department, Office for Harmonization in the Internal Market (currently, European Union Intellectual Property Office (EUIPO)); Tomas Eichenberg, Policy Officer - Legal Advisor (EU Policy and International), Directorate General for GROWTH, European Commission; Stephen Rowan, Director Trade Marks and Designs Division, UK Intellectual Property Office; moderator: Michael Hawkins, Noerr Alicante IP, S.L. (Spain), Chair of INTA Legislation & Regulation—Europe and Central Asia Subcommittee). More information on the webinar: <<http://www.inta.org/E-Learning/Pages/2015-The-EU-Trademark-Reform-Webcast.aspx>> accessed 7 May 2019.
- 132 Guidelines for Examination of European Union Trade Marks, Part B ‘Examination’, Section 4 ‘Absolute Grounds for Refusal’, Chapter 6 ‘Shapes or Other Characteristics with an Essentially Technical Function, Substantial Value or Resulting from the Nature of the Goods’ 1 October 2017, 3 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/)

## II. Color Marks

- 34 Art. 3 (3) (f) EUTMIR states that where a trade mark consists exclusively of a single color, it shall be represented by submitting a reproduction of the color without contours and shall be accompanied by a reference to a generally recognized color code<sup>133</sup>. If the mark consists exclusively of a combination of colors without contours, it shall be represented by submitting a reproduction of the color combination in a uniform and predetermined manner and the indication of those colors shall be accompanied by a reference to the corresponding generally recognized color codes, giving the option to add a description<sup>134</sup>.
- 35 With regard to the color combinations without contour, the EUTMIR seems to comply with the *Heidelberger Bauchemie* judgement, which established that the representation of a combination of two or more colors needs to be “systematically arranged by associating the colors concerned in a predetermined and uniform way”<sup>135</sup>. In this light, an application for a combination of colors arranged in any conceivable form would not comply with the specificity requirement, which was analyzed by the CJEU in the *Dyson* judgement<sup>136</sup>. This understanding was recently expressed in the *Red Bull* joined cases<sup>137</sup> regarding the combination of colors “blue and silver”, in which the GCEU again referred to the *Heidelberger Bauchemie* judgement with regard to the capability of colors
- 
- trade\_marks\_practice\_manual/WP\_2\_2017/Part-B/04-part\_b\_examination\_section\_4\_absolute\_grounds\_for\_refusal/part\_B\_examination\_section\_4\_chapter\_6/part\_B\_examination\_section\_4\_chapter\_6\_Shapes\_other\_characteristics\_en.pdf > accessed 25 November 2019.
- 133 EUTMIR, art 3 (3) (f) (i). This complies with *Libertel* judgement, where representation requirements of a trade mark consisting of color *per se* without a contour were analyzed (Case C-104/01 *Libertel* [2003] ECR I-3793, paras 37-38).
- 134 *ibid*, art 3 (3) (f) (ii).
- 135 Case C-49/02 *Heidelberger Bauchemie* [2004] ECR I-6129, para 33 (colors blue and yellow).
- 136 Annette Kur and Martin Senftleben, *European Trade Mark Law* (OUP 2017) 101; also see: case C-321/03 *Dyson* [2007] I-00687, paras 37-38.
- 137 Joined cases T-101/15 and T-102/15 *Red Bull v EUIPO - Optimum Mark () and argent)* (GC, 30 November 2017), which are at the present moment under appeal to the CJEU, (case C-124/18 P *Red Bull v EUIPO*, Appeal to the CJEU from the Judgment of the GC of 30 November 2017 in cases T-101/15 and T-102/15).

and combinations of colors of being a sign<sup>138</sup>. The GCEU confirmed the decision of EUIPO's Board of Appeal by finding that the mere indication of the ratio of the two colors (blue and silver) would allow for the arrangement of those colors in numerous different combinations and, therefore, it would not constitute a systematic arrangement in a predetermined and uniform way, but would produce "a very different overall impression and preventing consumers from repeating with certainty a purchase experience"<sup>139</sup>. The case is currently under appeal before the CJEU and although it is not likely that any practical differences in the registration of EU trade marks consisting of color combinations at the EUIPO will occur, it is expected that the CJEU may provide further clarification to the criteria set in the *Heidelberger Bauchemie* judgement with regard to the manner in which color combinations should be represented.

- 36 In the recent *Oy Hartwall* judgement<sup>140</sup>, the CJEU assessed the classification of a sign as a color mark or as a figurative mark in light of the principle of clarity and precision. It stated that the indication of the type of mark "serves to clarify the subject matter and scope of protection sought under trade mark law, in that it enables it to be specified whether the contours are part of the subject matter of the application for registration"<sup>141</sup>. The CJEU also analyzed the effect the classification as a color or figurative mark might have on the assessment of distinctive character<sup>142</sup>. It held that the criteria for the assessment of the distinctive character of color marks is the same as for those of other types of marks, adding that the difficulties that may arise from certain types of marks due to their nature, do not justify laying down stricter criteria "supplementing or derogating from application of the criterion of distinctive character as interpreted by the Court with regard to other categories of marks"<sup>143</sup>. In light

of this, the CJEU readdressed the criteria set by the *Libertel* judgement<sup>144</sup> stating that the perception of the relevant public is not necessarily the same in the case of a sign consisting of a color mark as it would be in the case of a word or figurative mark, because a color *per se* is not normally inherently capable of distinguishing the goods and services from one undertaking from those of another, but, nevertheless, it may acquire following the use that is made of it in the market<sup>145</sup>.

### III. Sound, Motion and Multimedia Marks

- 37 According to the Art. 3 (3) (g) EUTMIR, a trade mark consisting exclusively of a sound or of combination of sounds, "shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation"<sup>146</sup>. Thus, the "graphical representation of the sound, in particular a musical notation"<sup>147</sup>, according to the EUTMIR, could be replaced by an audio file. This means that the applicants for sound marks will no longer need to submit both the graphic representation of the mark and a sound file representing the sound itself in a MP3 format<sup>148</sup>, as it used to be before the EU trade mark reform, because either one of them will be sufficient.
- 38 An accurate musical notation, in principle, should be understood under the criteria set in Art. 4 (b) EUTMR as including "all the elements necessary for interpreting the melody, that is to say, pitch, tempo, lyrics (if any), etc."<sup>149</sup>. This seems to be in line with the *Shield Mark* judgement, in which before the EU trade mark reform, the CJEU established that the requirement of the graphic representation of a sound

138 Case C-49/02 *Heidelberger Bauchemie* [2004] ECR I-6129, para 23: "<...> colours are normally a simple property of things <...>. Even in the particular field of trade, colours and combinations of colours are generally used for their attractive or decorative powers, and do not convey any meaning. However, it is possible that colours or combination of colours may be capable, when used in relation to a product or service, of being a sign."

139 Joined cases T-101/15 and T-102/15 *Red Bull v EUIPO - Optimum Mark () and argent)* (GC, 30 November 2017), para 89.

140 Case C-578/17 *Hartwall* (CJEU, 27 March 2019).

141 *ibid*, para 25.

142 *ibid*, para 26.

143 *ibid*, para 28.

144 Case C-104/01 *Libertel* [2003] ECR I-3793, paras 66-67.

145 Case C-578/17 *Hartwall* (CJEU, 27 March 2019), paras 29-30.

146 EUTMIR, art 3 (3) (g).

147 EUTMIR, rule 3.

148 Ralf Sieckmann, 'Sound Trade and Service Marks' in Kai Bronner, Rainer Hirt (eds), *Audio Branding. Brands, Sounds and Communication* (Nomos 2009) 193.

149 Guidelines for Examination of European Union Trade Marks, Part B 'Examination', Section 2 'Formalities', Chapter 9 'Mark type' 1 October 2017, 29 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_2\\_2017/Part-B/02-part\\_b\\_examination\\_section\\_2\\_formalities/part\\_b\\_examination\\_section\\_2\\_formalities\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_2_2017/Part-B/02-part_b_examination_section_2_formalities/part_b_examination_section_2_formalities_en.pdf)> accessed 25 November 2019.



mark is satisfied, “where the sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals”<sup>150</sup>.

- 39 Motion marks are defined by the Art. 3 (3) (h) EUTMIR as trade marks “consisting of, or extending to, a movement or a change in the position of the elements of the mark”<sup>151</sup>. This provision brings novelties to the already existing practice for registering motion marks by allowing, alternatively to a series of still sequential images, to submit a video file showing the movement or change of position as the representation of such a mark, and also making the description merely optional<sup>152</sup>.
- 40 Lastly, Art. 3 (3) (i) EUTMIR introduces multimedia marks by defining them as “consisting of, or extending to, the combination of image and sound”<sup>153</sup>. In this light, it is a new category in the sense that it combines sound and motion marks and has to be filed by submitting an audio-visual file containing the combination of both<sup>154</sup>. Before the EU trade mark reform, it was not possible to register trade marks combining sound and motion, which makes multimedia marks the novelty of the trade mark catalogue provided in Art. 3 EUTMIR.

## IV. Hologram Marks

- 41 According to Art. 3 (3) (j) EUTMIR, a hologram trade mark is considered as such by having holographic characteristics, which should be represented by “submitting a video file or photographic representation containing the views which are necessary to sufficiently identify the holographic effect in its entirety”<sup>155</sup>. Before the reform, holographic signs were regarded as “particularly difficult to graphically represent as a paper representation does not allow the image to “change”

150 Case C-283/01 *Shield Mark* [2003] ECR I-14313, para 64.

151 EUTMIR, art. 3 (3) (h).

152 EUTMIR, art 3 (3) (h): “<...> the [motion] 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 or accompanied by a description explaining the sequence”.

153 EUTMIR, art 3 (3) (i).

154 *ibid.*

155 *ibid.*, art 3 (3) (j).

as it would naturally on holographic paper”<sup>156</sup> and could have been registered, when a clear mark description with all different views of the mark were submitted to the EUIPO<sup>157</sup>. Taking into consideration the pre-reform situation, it is possible to conclude that by the introduction of “a video file” option, the new legal provisions provide for more opportunities to register holograms as trade marks at the EUIPO.

## V. Olfactory and Taste Marks

- 42 Differently from the visual signs being processed in the cortex responsible for thoughts and actions, smells and tastes are linked to the limbic system, which is in charge of memories and emotions<sup>158</sup>. The latter senses can make a brand more impressionable to consumers and influence their purchasing habits<sup>159</sup>. Hence, it is important to discuss how smells (scents) and flavors can be registered under the current EU trade mark law regime.
- 43 The Advocate General in his Opinion in the *Sieckmann* case stated that any message capable of perception by any senses of consumers could function as a trade mark<sup>160</sup>. However, because flavors and scents are directly connected with the goods and services they referred to, they could not be perceived in an independent manner in the way that visual marks can<sup>161</sup>. In addition, although

156 Guidelines for examination in the Office for the Harmonisation in the Internal Market (Trade marks and Designs) on Community Trade marks. Part B ‘Examination’. Section 2. ‘Formalities’, 1 February 2014, 23 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/decisions\\_president/ex13-05\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/decisions_president/ex13-05_en.pdf)> accessed 8 May 2019.

157 *ibid.*

158 Rich McEarchran, ‘Multisensory branding: Immersing all five senses’ (*Virgin.com Blog*, 2016) <<https://www.virgin.com/entrepreneur/multisensory-branding-immersing-all-five-senses>> accessed 7 April 2019. Also see: Case C-273/00 *Sieckmann* [2002] ECR I-11770, Opinion of AG Colomer, para 29.

159 Martin Lindstrom, ‘Broad sensory branding’ [2005] 14 (2) *Journal of Product & Brand Management* 84, 85.

160 Case C-273/00 *Sieckmann* [2002] ECR I-11770, Opinion of AG Colomer, para 22.

161 *ibid.*, see: footnote 25 of the Opinion of AG Colomer citing Spyros Maniatis, ‘Scents as Trade Marks: Propertisation of Scents and Olfactory Poverty’ in L Bently and L Flynn (eds), *Law and the Senses: Sensational Jurisprudence* (Pluto Press 1996) 217, 222-223.

the ability of humans to perceive colors is just as limited as the ability to perceive scents, visual marks are still regarded as easier to comprehend, because they relate to the concept of shape and form, whereas taste and olfactory signs not only have a narrower range of perception<sup>162</sup>, but also lack precise rules for determining their content<sup>163</sup>. Another argument as to why it may not be possible to register the latter type of marks, was that these types of marks are not capable of being represented graphically and proposed alternatives also did not suit this requirement<sup>164</sup>; a sample of a scent is not durable in time and may alter its content through the passing of it<sup>165</sup>, whereas a chemical formula represents the substance itself and, in the same way as a description, it is not clear and precise<sup>166</sup>. As a result, although the perception of, e.g. smell, can perform an identification function, at that time it could not fulfil the graphic representation requirement<sup>167</sup>. This Opinion was followed in the *Sieckmann* judgement establishing seven criteria<sup>168</sup>, which made the registration of the discussed signs at the existing stage of technology impossible and are now compiled in the current EU trade mark law<sup>169</sup>.

- 44 Despite the fact that there is no mention to olfactory, taste, or tactile trade marks in the EUTMIR, Art. 3 (4) states that when a mark is not covered by any of the types listed, the “representation shall comply with the standards set out in paragraph 1 [of Art. 3 EUTMIR] and may be accompanied by a description”<sup>170</sup>. This clarifies that theoretically

162 Case C-273/00 *Sieckmann* [2002] ECR I-11770, Opinion of AG Colomer, paras 27-28.

163 *ibid*, para 25.

164 *ibid*, para 39.

165 *ibid*, para 42. For further analysis of the opinion, see: Alexander von Mühlendahl and others, *Trade mark law in Europe* (3<sup>rd</sup> Edition, OUP 2016) 64-68.

166 Case C-273/00 *Sieckmann* [2002] ECR I-11770, Opinion of AG Colomer, para 40-42.

167 *ibid*, para 46.

168 “<...> 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.” (Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 55).

169 EUTMR, Recital 10; EUTMIR, art 3 (1).

170 EUTMIR, art 3 (4) (g).

there is no *numerus clausus* list of the types of marks available for registration under the post-reform EU trade mark law. Nevertheless, Art. 3 (9) EUTMIR states that “the filing of a sample or a specimen shall not constitute a proper representation of the trade mark”<sup>171</sup>, which, under the current available technology, would be a way of representing scents and tastes in the Register of EU trade marks. Currently, this makes the registration of these trade marks unattainable.

- 45 In this light, it seems that the aforementioned situation is unlikely to change in the near future for smell, taste, or other non-visual marks in the sense that neither a description nor a sample could comply with the criteria of clarity and precision set in the law. However, an issue may arise if the proprietor of a smell or taste mark validly registered in a Member State of the Paris Convention<sup>172</sup>, would claim the registration of its trade mark as “it is” under the Art. 6<sup>quinquies</sup> of this international legal act<sup>173</sup>. If the latter provision would be regarded as applicable at all, one argument against the registration would be to consider the criteria of the *Sieckmann* judgement set in the EUTMR<sup>174</sup> and EUTMIR<sup>175</sup>, as forming part of the public order; namely to protect the transparency of the Register of EU trade marks<sup>176</sup> and to comply with the requirement of legal certainty<sup>177</sup>. Another possibility would be that, if said signs would be regarded as being capable to be represented on the latter Register, they might not be considered distinctive enough and, thus, such application would be rejected<sup>178</sup>.

- 46 With regards to everything that has been discussed above, it is possible to conclude that although the removal of the graphic representation requirement and the clearer conditions to register certain trade

171 *ibid*, art 3 (9).

172 Paris Convention for the Protection of Industrial Property (as amended on September 28, 1979) <<https://wipo.int/en/text/288514>> accessed 22 May 2019.

173 Annette Kur and Martin Senftleben, *European Trade Mark Law* (OUP 2017) 98.

174 EUTMR, recital 10.

175 EUTMIR, art 3 (2).

176 Annette Kur and Martin Senftleben, *European Trade Mark Law* (OUP 2017) 98.

177 Case C-273/00 *Sieckmann* [2002] ECR I-11770, Opinion of AG Colomer, para 36.

178 Annette Kur and Martin Senftleben, *European Trade Mark Law* (OUP 2017) 99.

marks cannot be disputed, it is necessary to admit that, in practice, the post-reform EU trade mark system reflects the so-called “what you see is what you get” (WYSIWYG)<sup>179</sup> approach. The fact that the representation of the mark defines the subject matter of protection of the trade mark, which also needs to comply with the *Sieckmann* criteria, seems to leave little room at the current stage of technological development to represent on the Register certain non-visual non-traditional trade marks, such as smell or taste.

## E. The Implications for Non-Traditional Trade Marks in the EU

47 The U.S. and the post-reform EU trade mark legal provisions regarding the types of signs available for protection are rather similar. The fact that both legal regimes provide for a rather vast variety of trade marks is clear from § 1127 of the Trademark Act<sup>180</sup> and its interpretation<sup>181</sup>, as well as from the Art. 3 (4) EUTMIR, which offers a non-exhaustive list of the types of marks available for registration<sup>182</sup>. This demonstrates the willingness of these two legal systems to accept the widest variety of trade marks as possible. Taking into consideration the technological progress providing new methods for representation of marks<sup>183</sup> and marketing techniques<sup>184</sup>, this should not be regarded as unexpected.

48 However, despite the increased openness of EU trade mark law<sup>185</sup>, from a practical point of view,

certain limitations with regard to the registration of trade marks not indicated in the Art. 3 (3) (a)-(j) EUTMIR, that are mainly non-visual (e.g., olfactory, taste and tactile), remain. This is conditioned by the fact that, notwithstanding the abolishment of the graphic representation requirement, which was regarded as “crucial to the sound operation of the system”<sup>186</sup>, trade marks must still be capable of being represented on the Register in a sufficiently clear and precise manner<sup>187</sup>; namely, by using generally available technology<sup>188</sup> and meeting the seven criteria established by the CJEU<sup>189</sup>, which are now incorporated into the EUTMIR<sup>190</sup>. Additionally, according to Art. 3 (2) EUTMIR, a description, which, at the moment, is a technologically feasible alternative for representation of non-visual marks, can be used solely for explanatory reasons, but not for representing a mark<sup>191</sup>. Therefore, if a sign consists only of non-visual matter, under the amended EU legal provisions, a description cannot constitute a sufficient representation of any trade mark.

49 Taking into consideration the currently available technological possibilities to represent trade marks, it is clear that the new requirements established by EU trade mark law allows for registration of signs that: (i) are visual (word, figurative, shape, pattern, position, color, hologram or motion

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Bold a Step Ahead or Back to Status Quo? [2015] vol. 19 Marquette Intellectual Property Review 19, 26.

179 EU Trade Mark Reform. Summary of Changes Applying from 1 October 2017 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/eutm\\_regulation/Summary\\_LR2\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/eutm_regulation/Summary_LR2_en.pdf)> accessed 8 May 2019.

180 Trademark Act of 1946, 15 U.S.C. § 1127 (2019).

181 E.g.: Qualitex Co. v. Jacobson Products Co. 514 U.S. 159 (1995); Kenneth L Port, *Trademark Law and Policy* (Carolina Academic Press 2018) 51.

182 EUTMIR, art 3 (4).

183 E.g.: Dev S Gangjee, ‘Paying the Price for Admission’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 61-62.

184 E.g.: Deven Desai, ‘Should Trademark Law Protect Non-Traditional Trademarks? A Look at How Marketing Practices Try to Catch Essences’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 126-129.

185 Annette Kur, ‘The EU Trademark Reform Package – (Too

186 Annette Kur and Martin Senftleben, *European Trade Mark Law* (OUP 2017) 96. “<...> the function of that requirement was, in particular, ‘to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor.’” (Annette Kur and Martin Senftleben, *European Trade Mark Law* (OUP 2017) 97 citing (Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 48).

187 Annette Kur, ‘The EU Trademark Reform Package – (Too) Bold a Step Ahead or Back to Status Quo?’ [2015] vol. 19 Marquette Intellectual Property Review 19, 26.

188 EUTMR, recital 10; EUTMIR, art 3 (1).

189 “<...> 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” (Case C-273/00 *Sieckmann* [2002] ECR I-11770, para 55).

190 EUTMIR, art 3 (1).

191 *ibid*, art 3 (2). Also EUTMIR, art 3 (4): “Where the trade mark is not covered by any of the types listed in paragraph 3, its representation shall comply with the standards set out in paragraph 1 and may be accompanied by a description”

marks); (ii) constitute a sound; or (iii) consists of the combination of visual and sound elements (multimedia marks), whereas the registration of smell, taste or tactile marks, under the new EU regulatory framework, due to the technical difficulties to represent them on the Register, so far, remains impossible. This means that after the reform, in practice, there is still a narrower list of types of signs available for trade mark registration in the EU than in the U.S.

- 50 However, the above-discussed requirements for the representation of marks in the Register<sup>192</sup> limiting the possibility to obtain protection for smell, sound and tactile signs are meant to perform an important task, i.e. “to enable the competent authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor”<sup>193</sup>. Thus, this is not merely a technical requirement, but it also allows one to achieve the objective of clarity and precision of trade mark registrations<sup>194</sup>. Fulfilling this requirement of representation is crucial to EU trade mark law, because it ensures that the scope and nature of each mark is clearly defined in the Register and comprehensible, so that its holder, consumers and competitors can readily ascertain the scope of the protection, and the authorities would be able to properly examine, publish, and eventually protect the mark from unlawful use by others<sup>195</sup>. Therefore, regardless of the needs that may arise from sensory branding strategies<sup>196</sup>, in order to ensure legal certainty and secure the interests of the stakeholders, it should not come as a surprise that the EU trade mark law was not amended in a way to include a description as an appropriate form of representation, and, consequently, making smells, tastes or tactile signs available for trade mark registration.

192 (i) To be capable of being represented on the Register by using generally available technology and (ii) to conform seven criteria established by the CJEU and currently incorporated into art 3 (1) of the EUTMIR.

193 EUTMIR, art 3 (1).

194 Annette Kur, ‘The EU Trademark Reform Package – (Too) Bold a Step Ahead or Back to Status Quo?’ [2015] vol. 19 *Marquette Intellectual Property Review* 19, 26.

195 Melissa E Roth, ‘Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations’ [2005] 1 *Cardozo Law Review* 457, 467.

196 E.g.: Bertil Hultén, ‘Branding by the five senses: A sensory branding framework’ [2017] 6 (3) 1-12 *Autumn/Fall Journal of Brand Strategy* 1.

- 51 Such a cautious approach is also closely connected to the duration of trade mark protection. After meeting formal and substantive requirements for registration<sup>197</sup>, an applicant obtains an intellectual property right, which is relatively inexpensive and, taking into consideration the possibility to renew it every ten years, can even become perpetual<sup>198</sup>. It is argued that such unlimitedly renewable term of exclusive rights together with significantly more flexible application of requirements for obtaining trade mark protection<sup>199</sup> for product shapes, patterns, colors, videos etc., poses the risk of creating negative effects on the market competition<sup>200</sup>, literary or cultural creativity<sup>201</sup>, innovation in product design, and quality<sup>202</sup>. Bearing in mind these concerns, at the moment mostly raised by visually perceptible non-traditional marks, the reluctance of the EU legislator to take a step further by making the standards of representation even more flexible (e.g. introducing a description as a possible means of representation of a mark on the Register), and, as a result, not providing for actual possibilities to register certain non-visual signs<sup>203</sup> as trade marks, can be regarded as appropriate.

197 EUTMIR, art 4.

198 EUTMR, art 52 and 53; Trademark Act of 1946, 15 U.S.C. § 1058 (a) (2019).

199 Irene Calboli and Martin Senftleben, ‘Introduction’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 1.

200 Glynn S Lunney, Jr., ‘Non-Traditional Trademarks. The Error Costs of Making an Exception the Rule’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 231; Irene Calboli, ‘Hands Off “My” Colors, Patterns, and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 305.

201 Martin Senftleben, ‘A Clash of Culture and Commerce. Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 312, 332.

202 Irene Calboli, ‘Hands Off “My” Colors, Patterns, and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks. Critical Perspectives* (OUP 2018) 306-307.

203 Smells, tastes and tactile signs.

- 52 As it was indicated before, the current level of technological development is not sufficient for scents, flavors and tactile signs to be represented on the Register in conformity with Art. 3 (1) EUTMIR<sup>204</sup>. Additionally, allowing to file a description, which also does not suit all the aforementioned requirements, could potentially grant an unclear scope of exclusive rights to one undertaking throughout the EU territory leading to certain issues. Firstly, problems could already emerge during the early stage of registration, when an applicant is performing a trade mark search. Third parties by relying only on a description of an earlier non-visual mark might face the risk of filing an application for an identical or similar trade mark, which will later be opposed and rejected<sup>205</sup>. In the stage of registration of a mark, an assessment based only on the description filed, might not allow the relevant authorities to be able to properly define the scope of protection of the marks at dispute, compare them, and resolve the conflicts properly. Secondly, further issues with respect to the unclear scope of the trade mark protection may arise in infringement proceedings<sup>206</sup>. In such situations, not only the interested parties, but also dispute resolution bodies, are likely to encounter difficulties while dealing with infringement cases involving olfactory, taste and tactile marks.
- 53 One may argue that the post-reform EU legal framework, in comparison to U.S. trade mark law, might not provide businesses with the opportunity to employ their full marketing capacity and, this way, realize their economic potential. However, in this context, it is questionable whether the non-visually perceptible non-traditional trade marks are so significant that it would encourage reconsidering the aforementioned EU legal requirements for trade mark representation. By allowing to file a description for non-visual trade marks, US law in comparison to EU law, demonstrates a more flexible approach with regard to the registration of these types of marks. However, according to the publicly available statistics provided by the USPTO, out of 6,707,708 applications filed with or registrations issued by the USPTO between 1 January 1870 and 6 January 2012, only 477 applications concern sound, smell and other non-visual trade marks<sup>207</sup>. This and other studies<sup>208</sup> demonstrating a small share of non-visual trade marks out of all the applications at the USPTO, allow one to assume that these types of marks still have a rather low significance for businesses.
- 54 According to the publicly available statistics of the EUIPO, the total number of EU trade mark applications filed between 1 January 2017 and 31 December 2017 was 146,457<sup>209</sup>, 24 of which were non-visual trade marks<sup>210</sup>, comprising approximately 0,02 percent of all the aforementioned trade mark applications in that period of time<sup>211</sup>. Meanwhile in the U.S., the number of applications for non-visual
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- 204 EUTMIR, art 3 (1).
- 205 For more details see: EUTMR, art 8 (1).
- 206 *ibid*, art 9. The protection provided by EU trade mark law can be particularly broad, when the allegedly infringed trade mark “has a reputation” in the EU (EUTMR, art 9 (2) (c)).
- 207 Stuart J H Graham and others, ‘The USPTO Trademark Case Files Dataset: Descriptions, Lessons, and Insights’ [2013] *Journal of Economics & Management Strategy* 31, 44-46.
- 208 E.g.: Carolina Castaldi, ‘The Economic Management of Non-Traditional Trademarks. Why, How Much, What and Who’ in Irene Calboli and Martin Senftleben (eds) *The Protection of Non-Traditional Trademarks: Critical Perspectives* (OUP 2019) 257.
- 209 EUIPO Statistics of European Union Trade Marks, 1996-01 to 2019-10 Evolution <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/about\\_euipo/the\\_office/statistics-of-european-union-trade-marks\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/the_office/statistics-of-european-union-trade-marks_en.pdf)> accessed 25 November 2019 (only the period of 1 January 2017-31 December 2017 was taken into account).
- 210 24 applications for ‘sound’ trade marks were filed at the EUIPO from 1 January 2017 until 31 December 2017 (EUIPO Statistics of European Union Trade Marks, 1996-01 to 2019-10 Evolution, <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/about\\_euipo/the\\_office/statistics-of-european-union-trade-marks\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/the_office/statistics-of-european-union-trade-marks_en.pdf)> accessed 25 November 2019). According to the EUIPO trade mark guidelines, the ‘other’ marks are those that are not covered by the art 3(3) EUTMIR and may include not only non-visual, i.e. smell (olfactory) marks, taste marks and tactile marks, but also tracer marks, which are visual (Guidelines for Examination of European Union Trade Marks, Part B ‘Examination’, Section 2 ‘Formalities’, Chapter 9 ‘Mark type’ 1 October 2017, 32-33 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_2\\_2017/Part-B/02-part\\_b\\_examination\\_section\\_2\\_formalities/part\\_b\\_examination\\_section\\_2\\_formalities\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_2_2017/Part-B/02-part_b_examination_section_2_formalities/part_b_examination_section_2_formalities_en.pdf)> accessed 25 November 2019). However, according to the information of the TMview database, none of the applications for ‘other’ trade marks filed at the EUIPO from 1 January 2017 until 31 December 2017 included non-visual trade marks <<https://www.tmdn.org/tmview/welcome>> accessed 26 November 2019.
- 211 EUIPO Statistics of European Union Trade Marks, 1996-01 to 2019-10 Evolution <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/about\\_euipo/the\\_office/statistics-of-european-union-trade-marks\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/the_office/statistics-of-european-union-trade-marks_en.pdf)> accessed 25 November 2019.

trade marks during the same period of time<sup>212</sup> was only 48 out of the total of 451,242, comprising 0,011 percent of the total number of trade mark applications filed at the USPTO<sup>213</sup>. Thus, despite the more flexible formal requirements under U.S. law for trade mark registration and the possibility to obtain protection for a broader variety of non-traditional marks that are non-visual, these types of trade marks in the EU constitute a higher proportion from all the applications filed during the same period of time. Thus, the number of such marks does not only depend on the requirements for registration - in particular the representation - but also on other factors, such as their economic significance to the trade mark owners.

- 55 With regard to all the issues discussed above, the EU trade mark reform has certainly brought about changes to the registration of certain types of visual non-traditional trade marks. The permission to submit a sound file instead of a musical notation<sup>214</sup> or a video file, alternatively to a series of still sequential images, showing the movement, suits the nature of sound and motion signs accordingly, and also fulfils

212 1 January 2017-31 December 2017.

213 Trademark Case File Dataset, 2018 <<https://www.uspto.gov/learning-and-resources/electronic-data-products/trademark-case-files-dataset-0>> accessed 4 August 2019. 48 applications for non-visual trade marks constitute approximately 0,0106 = 0,011 percent of the number of trade mark applications filed at the USPTO (451,242) between 1 January 2017 until 31 December 2017. According to information from the USPTO, serial numbers without a filing date were excluded from the 2018 update of the Trademark Case File Dataset. However, according to the prior version, i.e. Trademark Case File Dataset as of 2017, there were 59 observations of trade marks having the drawing code “6000” used for non-visual trade marks. Nevertheless, as the Trademark Status & Document Retrieval (TSDR) reveals, 10 of those trade marks that have the drawing code “6000” (serial No. 76611478; serial No. 77053384; serial No. 77803694; serial No. 78171354; serial No. 78769423; serial No. 86142261; serial No. 86142303; serial No. 86213691; serial No. 86306920; serial No. 87180991), whose filing date is not indicated in the Trademark Case File Dataset as of 2017, were not filed between 1 January 2017 until 31 December 2017 (Trademark Status & Document Retrieval (TSDR) <<http://tsdr.uspto.gov/>> accessed 4 August 2019), whereas one of them (serial No. 87313375), during the prosecution, was changed from mark drawing code “6000” to code “2000” (“AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S)/ LETTER(S)”) (Trademark Status & Document Retrieval (TSDR). Document “TRAM Snapshot of App at Pub for Oppostn” <<http://tsdr.uspto.gov/>> accessed 4 August 2019).

214 EUTMIR, art 3 (3) (g).

the objective of clarity and precision<sup>215</sup> and, this way, provides for wider opportunities to obtain trade mark protection for sounds and movements as such. Additionally, the possibility to submit an audio-visual file containing the combination of image and sound allows registering multimedia trade marks. However, with regard to the non-traditional marks that are non-visual, due to the current requirements for the representation of trade marks on the Register and currently available technological possibilities thereof, the post-reform EU trade mark law will not significantly affect their registration, and obtaining protection for them will remain impossible. Nevertheless, taking into consideration ongoing technological developments<sup>216</sup> that may allow the representation of more types of trade marks in accordance to the new provisions in the future, it remains possible that under the current EU legal framework we might witness their registration. \*\*

215 Annette Kur, ‘The EU Trademark Reform Package – (Too) Bold a Step Ahead or Back to Status Quo?’ [2015] vol. 19 *Marquette Intellectual Property Review* 19, 26.

216 E.g.: Adam K Raymond, ‘THE INTERNET OF SMELLS: Startups Race To Cash In On The Latest Fad’ (2014) <<http://www.businessinsider.com/internet-smells-ophone-startups-2014-3?IR=T>> accessed 12 April 2019; Kota Shiba and others, ‘Data-driven nanomechanical sensing: specific information extraction from a complex system’ (2017) *Scientific Report* <<https://www.nature.com/articles/s41598-017-03875-7>> accessed 7 April 2019; Adrian Bridgwater, ‘Internet of Smells, olfaction via nanomechanical sensors’ (2016) <<https://internetofbusiness.com/internet-smells-olfaction-via-nanomechanical-sensors/>> accessed 7 April 2019.

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## F. Conclusion

56 The abolishment of the graphic representation requirement should be regarded as a significant development in EU trade mark law, rendering this legal system more adaptable to further technological development and new marketing strategies. Nevertheless, as the analysis of the formal requirements for the representation of registrable signs shows, even after the EU trade mark reform there will still be a narrower circle of types of trade marks available under EU law in comparison to U.S. law. Due to the fact that the EUTMIR in the light of the EUTMR criteria does not accept a description or a specimen as an appropriate representation, certain non-visual non-traditional signs - taking into consideration the currently available technologies for their representation on the Register - remain unavailable for registration at the EUIPO. The latter situation under EU trade mark law should be regarded as being in line with the objective of clarity and precision, which ensures that the scope and nature of the mark is clearly defined on the Register and comprehensible, so that its holder and third parties are able to determine the scope of the protection, and the authorities are able to properly examine, publish, and eventually protect the mark from unfair use by competitors. However, rapid technological development may provide for more possibilities to create a representation of non-traditional trade marks, which would suit the requirements established by EU law, making the registration of the latter types of signs possible without any need to amend the current provisions of the EU trade mark law.