

UNIVERZITA KARLOVA

Právnická fakulta

Zuzana Uhrinová

Non-conventional Signs and Trade Marks

Diplomová práce

Vedoucí diplomové práce: JUDr. Daniel Patěk, Ph.D.

Katedra obchodního práva

Datum vypracování práce (uzavření rukopisu): 10. 11. 2017

CHARLES UNIVERSITY

Faculty of Law

Zuzana Uhrinová

Non-conventional Signs and Trade Marks

Master's Thesis

Supervisor: JUDr. Daniel Patěk, Ph.D.

Department of Commercial Law

Date of submission: 10 November 2017

Prohlášení

Prohlašuji, že jsem předkládanou diplomovou prací vypracovala samostatně, že všechny použité zdroje byly řádně uvedeny a že práce nebyla využita k získání jiného nebo stejného titulu.

Rovněž prohlašuji, že počet znaků vlastního textu předkládané diplomové práce včetně poznámek pod čarou je 152 805.

V Praze dne 10. 11. 2017

Zuzana Uhrinová

Declaration

I hereby declare that this thesis represents my own work and all the sources used for this master's thesis have been properly acknowledged and cited. I declare that this master's thesis has not been used to achieve this or any other academic degree.

I also declare that the character count of the body of the submitted master's thesis, including footnotes, is 152 805.

In Prague on 10 November 2017

Zuzana Uhrinová

Acknowledgement

I wish to express my gratitude to JUDr. Daniel Patěk, Ph.D., who kindly agreed to supervise this master's thesis. I would also like to thank my husband and family for all of their support and patience throughout my studies.

Table of Contents

1. Introduction.....	1
1.1 Historical background to trade mark protection and its recent developments	2
1.1.1 The evolution of trade mark functions and the subject matter of protection	2
1.1.2 Recent developments of trade mark legislation, in particular the EU trade mark reform package.....	6
1.2 The understanding of a non-conventional sign and trade mark.....	8
2. Theoretical background to problems with registration of non-conventional signs	10
2.1 The EU: Absolute grounds of refusal	10
2.1.1 A sign and its representation	10
2.1.2 Capacity to distinguish.....	11
2.1.3 Distinctiveness	12
2.1.4 Limits on the registration of shapes	13
2.2 Canada	13
2.3 The USA	15
2.4 Australia.....	15
3. The types of non-conventional signs and their particularities in respect to their nature and legal protection in the selected jurisdictions	17
3.1 Sound marks	17
3.1.1 The EU	17
3.1.2 Australia.....	21
3.1.3 Canada.....	23
3.2 Scents.....	24
3.2.1 The USA	25
3.2.2 The EU	25
3.2.3 Canada.....	31
3.2.4 Australia	32
3.3 Colour marks	35
3.3.1 The EU	35
3.3.2 The USA	39
3.3.3 Canada.....	41
3.3.4 Australia	42
3.4 Three-dimensional marks/shapes	44
3.4.1 The EU	44

3.4.2 Other jurisdictions.....	47
3.6 Other	49
3.6.1 Motion marks	49
3.6.1 Holograms.....	51
3.6.2 Position marks.....	53
3.6.4 Tactile sign.....	55
4. Alternative ways of protecting non-conventional signs under intellectual property law.....	56
4.1 The relation between three-dimensional marks and design rights.....	56
4.2 Scents and protection under copyright law, patents or trade secrets	57
4.3 Other signs and intellectual property law as a whole	59
5. Conclusion.....	61
6. Bibliography.....	64
7. Abstract (Eng)	70
8. Abstrakt (ČJ)	71

1. Introduction

The development of advertising, commerce and technologies has immensely affected all the areas of intellectual property law, including trade marks. The traditional view on trade mark protection has been continually challenged and shifted by traders' attempts to secure trade mark protection of unusual and innovative types of signs. These non-conventional signs and their capacity to become registered as trade marks are the central objects of study in this thesis. The focal point of interest is to identify and analyse the problems arising in connection with such non-conventional signs and trade marks.

This thesis will attempt to address the fundamental issues and challenges of non-conventional trade marks and their significance, in a systematic manner. That is why the introductory section of the thesis is devoted to outlining the essential functions of trade marks and their development, in order to comprehend the evolution of trade mark subject matter so far. With this in mind, a distinction will be made as for what constitutes a non-conventional sign and trade mark in the studied jurisdictions. This will then determine the types of signs which will be the focus of the thesis. Most importantly, the main emphasis will be placed on identifying and analysing the problems in registering these non-conventional signs and their justifications. An analysis will be carried out for each type of the sign to address its specific attributes and challenges. Finally, the thesis will attempt to conclude its analysis on the topic of non-conventional trade marks by assessing the appropriateness of the current legislation in the studied jurisdictions as well as predict the implications of recent amendments to the European Union law in regard to non-conventional trade marks.

Several methods will be utilised in this thesis. The predominant and initial method of work will be a theoretical documentary search and its synthesis. Given the extensive scope of sources available, selective research will be carried out and theoretical and descriptive materials selected and discussed only for the jurisdictions of this thesis' interest. The theoretical material will include, among others, legislation, intellectual property offices' official documents and guidelines, books and articles. In addition, special emphasis will be placed on the decisions of intellectual property offices and case law and these sources will be analysed whenever available, as they form an invaluable source of practical guidance on the topic of this thesis. This will be especially true for the decisions of the Court of Justice of the European Union (CJEU), which are of utmost importance for the understanding

and interpretation of the European Union trade mark law, which is the broadest and central body of law explored in this thesis. The selected theoretical material will then be analysed and, when relevant, a comparison will be made in terms of varying and similar approaches to the objects of trade mark protection in different jurisdictions.

Lastly, after preliminary research, these jurisdictions have been selected as the areas of study of this thesis: the European Union, the United States of America, Canada and Australia. The reasons were the countries' political and economic significance or the proximity to our jurisdiction in case of the European Union. The legislation of these countries should offer a variety of approaches towards non-conventional trade marks, from liberal to more conservative. However, this shall not be regarded as a comprehensive study of all the trade mark law of these jurisdictions. Such a study would surmount the extent of a master's thesis.

1.1 Historical background to trade mark protection and its recent developments

1.1.1 The evolution of trade mark functions and the subject matter of protection

Before approaching the specific problems and challenges posed by non-conventional signs and trade marks, it shall be considered, how the view on trade marks has already evolved. An attempt will be made to briefly identify trends in the trade mark changes, especially in terms of functions and the subject matter. This could help in determining the attitude towards new types of trade marks in the past and the present day.

First of all, the function of applying marks to goods and services has evolved significantly over the history. At the beginning, the sole function of marks was proprietary and indicated ownership.¹ An example of this proprietary function is marking livestock by a brand or an earmark or labelling goods before loading on a ship so that, in case of a shipwreck, the remaining goods could be easily identified and retrieved.² The proprietary function changed in medieval times with the emergence of guild structures. The guilds were organizations that had control over the production of certain goods and could control the quality of such goods as well.³ Therefore, the members of guilds were required to use marks on their products for quality checks. That is why leather products or pottery were

¹ Bently L and Sherman B, *Intellectual Property Law* (4th edn, Oxford University Press 2014) 809.

² Bently and Sherman (n 1) 810.

³ *Ibid.*

usually marked with letters, the trader's initials or graphic symbols on their surface.⁴ This was the commencement of the marks' function as an indicator of the source of goods and services.

The function of marks shifted concurrently with the industrial revolution. Although the guilds had ended, the traders kept marking their goods because of growing regional trade and factory production. What is more, the literacy of the public and the emergence of mass media incentivised the manufacturers to advertise their products and services using their marks.⁵ Subsequently, the buyers started to not only view the marks as an indicator of the source, but also as a tool to make their purchasing decisions.⁶ A certain standard became associated with a specific manufacturer and thus, marks became not only indicators of origin, but also an indicator of the quality of the product or service.⁷

Around the beginning of the twentieth century, the function of trade marks has evolved further into what has been called a symbol.⁸ As a symbol, the trade mark does not only identify the manufacturer and the quality of the product, but gives rise to other associations and meanings as well. As a result of advertising, the trade mark creates a desire for the associated product not because the consumer believes in its particular quality, but rather because of the trade mark itself. Some assert that trade marks have become valuable in their own right.⁹ As a result, certain style and identity associated with a trade mark has become increasingly important and therefore the presentation, advertising and packaging of products have grown in significance.¹⁰

As the functions of trade marks changed over time, the subject matter of trade mark protection has developed alongside it. At the beginning, the registrable subject matter was limited only to a few acceptable categories of marks, such as a name of the trader presented in a particular or distinctive manner.¹¹ But when trade marks started to function as indicators of both origin and quality, a lobby for stronger protection has started. This development had manifested in various ways. In the United Kingdom, protection grew stronger when the first

⁴ Jakl L, *Národní, Mezinárodní a Regionální Systémy Ochrany Průmyslového Vlastnictví* (2nd edn, Metropolitan University Prague Press 2014) 92.

⁵ Bently and Sherman (n 1) 810.

⁶ Cornish WR, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (4th edn, Sweet and Maxwell 1999) 599.

⁷ *Ibid* 597.

⁸ Bently and Sherman (n 1) 810.

⁹ *Ibid*.

¹⁰ Cornish (n 6) 597.

¹¹ Lea GR, 'Special Marks: After 20 Years, not so Special After All?' [2015] 20(2) *Communications Law* 40, 40.

system for registration of marks was introduced by the Trade Marks Act 1875.¹² In the United States of America (the USA), the lobbying of the United States Trademark Association resulted in broader subject matter coverage in the newly enacted 1905 United States Act.¹³ In this 1905 Act, the registrable subject matter was defined by a negative threshold, which stated that all distinctive marks shall be registered unless there are grounds for refusal.¹⁴ These grounds for refusal were listed in an exhaustive way.¹⁵ What is more, the advancement of international trade has induced the provision of certain minimum international standards of trade mark protection as well. It was not until the 1994 Agreement on Trade Related Aspects of Intellectual Property Rights (the TRIPS Agreement) that a definition of protectable subject matter was accepted on the international level.¹⁶ This definition, found in article 15(1) of the TRIPS Agreement, stated that: *‘Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark’* (emphasis added). Then the article 15 of the TRIPS Agreement goes on to list some of the potentially registrable signs, which are *‘words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs’* and because the list is inclusive, the registrable subject matter seems to be potentially quite extensive. That is why the obligations entered into under the TRIPS Agreement had incentivised some countries to widen the extent of trade mark protection to non-traditional signs as well. This can be demonstrated on the case of Australia. Until a reform took place in 1995, Australia did not recognise any special marks as protectable under their, at the time, current legislation. This has changed with the enactment of the Trade Marks Act 1995, which contains an inclusive definition of a protectable sign and expressly states that shape, colour, sound and scent signs have the capacity to be registered as trade marks.¹⁷ And although there are additional requirements for registration of such non-conventional marks,¹⁸ they have been included in the protectable subject matter.

¹² Bently and Sherman (n 1) 811.

¹³ Lea (n 12) 40.

¹⁴ Ibid.

¹⁵ Ibid.

¹⁶ Ibid.

¹⁷ Ibid 45.

¹⁸ Ibid 45.

Despite such developments as shown in Australia and the fact that the article 15 of TRIPS Agreement seems favourable to non-conventional signs, the TRIPS Agreement does not guarantee protection of non-conventional signs. Firstly, article 15 of the TRIPS Agreement proceeds to allow Member states to ‘[...] *require, as a condition of registration, that signs be visually perceptible.*’ Secondly, the definition is limited to determining a capacity to be registered rather than an automatic registration of the said signs, and thus, the Member states are offered a certain margin of appreciation when enacting their national legislation in this regard. Therefore, according to the TRIPS Agreement as discussed here, non-traditional signs which are not visually perceptible, such as smells or sounds, can be excluded from the registrable subject matter and even the signs specifically listed in the definition, such as combination of colours, are not required to be automatically included in the registrable subject matter of trade marks.¹⁹

However, the subject matter of trade mark protection has expanded afterwards on the international level with the adoption of the WIPO’s Trademark Law Treaty 1994 and especially the Singapore Treaty on the Law of Trade marks of 2006.²⁰ The latter one explicitly states that new types of marks have emerged, such as colour marks, holograms, motion marks, sound and taste marks.²¹

The objective of this brief outline of trade mark history and functions is to show that the subject matter of trade mark protection evolves depending on the changes in society and its needs. Most importantly, one can discern a trend, which is an expansion of the subject matter of trade mark protection rather than its restriction. It shows the importance of discussing signs and trade marks which are considered less traditional now, but might significantly grow in importance in the near future. To demonstrate, the recent amendments of European Union trade mark legislation suggest that the topic of non-conventional trade marks is highly relevant. Therefore, it shall be considered in greater detail in order to demonstrate the growing significance of less traditional trade marks.

¹⁹ Lea (n 12) 41.

²⁰ Ibid.

²¹ Samtani A and others, ‘Smell Marks - a Singapore Study and the Implications for the Commercial Use and Exploitation of Non-Traditional Trade Marks’ [2009] 40(6) International Review of Intellectual Property and Competition Law 698, 699.

1.1.2 Recent developments of trade mark legislation, in particular the EU trade mark reform package

The previous subsection has explored the development of trade mark's functions and understanding. The evolution of trade marks keeps progressing and thus recent developments of trade mark legislation that reflect this change will be examined. The most notable of these changes is the EU trade mark reform package and it will, therefore, be the focus of this section.

The regional harmonization of trade mark law within the EU has started in order to allow for unobstructed free movement of goods and services within the union.²² Therefore, the Trade Marks Directive²³ was adopted in 1988 with the aim of approximating the national law provisions that have an effect on the internal market of the European Union. Additionally, the Community Trade Mark Regulation was adopted in 1994.²⁴ The protected subject matter was, with the understandable differences stemming from the nature of the two legislative acts, the same in the definition found in the Trade Marks Directive as well as the Community Trade Mark Regulation. The definition stated that:

*'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'*²⁵

The definition has been subsequently amended and the words '*any sign*' have been replaced with plural '*any signs*'. When compared with the already studied TRIPS Agreement definition, one observes several discrepancies. Firstly, the TRIPS Agreement expressly includes a combination of colours and omits the shape of goods and their packaging, whereas the definition in the European legislation deals with these two types of signs reversely. Secondly, the European legislation does not include a combination of signs in its wording.

²² Kur A, 'The EU Trademark Reform Package - (Too) Bold a Step Ahead or Back to Status Quo?' [2015] 19 Marquette Intellectual Property Law Review 15, 22.

²³ Codified as Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJL 299/25 (8 November 2008).

²⁴ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [1994] OJL 011/1 (14 January 1994).

²⁵ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJL 299/25 (8 November 2008), art 2.

Moreover, the Trade Marks Directive and Community Trade Mark Regulation both required the capacity for graphical representation as a condition for registration of a sign, while TRIPS Agreement only offers the option of exclusion of signs that are not visually perceptible. Lastly, the EU system excludes certain shapes from registration that the TRIPS Agreement does not.²⁶ These discrepancies are worth mentioning because some of them have been the object of recent developments in the EU trade mark law. To be more specific, the difference in view of graphic representation of visually imperceptible signs points to, as will be discussed later, one of the greatest problems of registration of non-conventional signs. Its change is, therefore, of utmost significance when it comes to the focus of this thesis.

The European Commission's proposals for an amendment of the European trade mark system have been published in 2013 as a result of an evaluation of the functioning of the European trade mark system.²⁷ This was carried out by the Max Planck Institute for Intellectual Property and Competition Law in Munich.²⁸ Out of all the proposed changes, the most important one for non-conventional signs and trade marks is the change regarding the graphical representation requirement. As was explained above, the European legislation effective until October 2017 demands that a mark must be capable of being represented graphically in order to be registered.²⁹ Further impositions on the nature and quality of such graphical representation have been developed by the Court of Justice of the European Union and insist that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.³⁰ However, a view, which considers other non-graphical forms of representation equally or even better equipped to represent certain signs, has become prevalent.³¹ As a result, the study carried out by the Max Planck Institute for Intellectual Property and Competition Law has concluded that the requirement for graphic representation is obsolete and creates uncertainty for non-conventional marks.³² And because the European Commission has established legal certainty as one of the main aims of the changes in the trade

²⁶ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] *OJ L 299/25* (8 November 2008), art 3(1)(e).

²⁷ Kur A (n 23) 19.

²⁸ Max Planck Institute for Intellectual Property and Competition Law, 'Study on the Overall Functioning of the European Trade Mark System' (15 February 2011) <www.ip.mpg.de/fileadmin/IP/pdf2/mpi_final_report_with_synopsis.pdf> accessed 18 October 2017.

²⁹ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] *OJ L 299/25* (8 November 2008), art 2.

³⁰ C-273/00 *Ralf Sieckmann v Deutsches Patentund Markenamt* [2002] ECR I-11737.

³¹ Kur A (n 23) 26.

³² Wong R, 'EU Trade Mark Regulation 2014' [2014] 19(2) *Communications Law* 56, 57.

mark legislation, the proposal has suggested that the requirement of graphical representation should be removed and instead replaced with a more open approach towards other forms of representation as well.³³ The representation must instead be done ‘*in a manner which enables the competent authorities and the public to determine the precise subject of protection afforded to its proprietor*’.³⁴ Some authors believe that this change, which enters into force on 1 October 2017, would result in the possibility to register non-traditional signs that were problematic under the legislation before its amendment.³⁵ This notion will be examined in this thesis. Alongside it, the general impact of other substantial amendments to European Union trade mark law, such as the inclusion of colours and sounds into the trade mark definition, will be considered.

1.2 The understanding of a non-conventional sign and trade mark

There is no universal definition or a consensus on the question of what constitutes non-conventional trade marks. This is because trade mark law has not developed uniformly in different jurisdictions and discrepancies occur. For example, any type of sign other than a word or a figurative sign could still be considered non-conventional in the Czech Republic³⁶ or Slovakia³⁷ whereas in the USA, signs such as shape have become rather common.³⁸ Similarly, in the European Union, over 99% of applications made in 2015 for the European Union trade mark (EUTM) concerned word marks and figurative marks.³⁹ Other types of trade marks are thus in a striking minority, making up less than 1% of all the EUTM applications. This thesis strives to reflect these findings and that is why an inclusionary approach is chosen in order to encompass the widest scope of study. Therefore,

³³ European Commission, ‘Trade Marks: Commission Proposes Easier and More Effective Protection’ (European Commission Press Release Database, 27 March 2013) <http://europa.eu/rapid/press-release_IP-13-287_en.htm?locale=en> accessed 18 October 2017.

³⁴ Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015], art 3.

³⁵ Wong (n 33) 58.

³⁶ This is based on a research of Czech Republic’s national trade marks, registered as of October 2017. According to a search in the National trade mark database (available online at <https://isdv.upv.cz/webapp/WEBAPP.oza.formular>), there are 123 761 registered national trade marks, out of which 415 are three-dimensional, 5 are single colour marks and there is 1 hologram mark. All the other registered trade marks are either word, figurative or combination marks.

³⁷ Vojčík P, *Právo Duševného Vlastnictva* (Vydavatelství a nakladatelství Aleš Čeněk 2012) 299.

³⁸ See part 3.4 of this thesis for more details.

³⁹ Andreottola P, ‘European Union: What Future after the EU Reforms?’ (61 World Trademark Review) <<http://www.worldtrademarkreview.com/Magazine/Issue/61/Country-correspondents/What-future-after-the-EU-reforms>> accessed 16 October 2017.

for the purpose of this thesis, conventional trade marks will be understood as words and figurative marks. Other types of trade marks will be considered as non-conventional. This categorisation aims to reflect the above-mentioned facts as well as the general approach in trade mark law.⁴⁰ Consequently, the non-conventional category can be further subdivided into signs which are perceived visually and those that are not. The first group will include a three-dimensional mark, a single colour, a position mark, a hologram and a motion mark. The second group includes sounds, tactile signs and smells. This subdivision is, as explained later, one of the determining factors for the success of trade mark protection, which is why awareness is brought to it at this point.

Another terminological element that needs to be addressed is the distinction between a sign and a trade mark. The title, as well as the text of this thesis, differentiates between signs and trade marks in order to accommodate a specific issue. Given the example of the European legislation, a EUTM may consist of a sign, but a sign must fulfil several criteria in order to become a trade mark.⁴¹ Not all signs will be registered as trade marks. As a result, not all types of signs that will be discussed have succeeded in obtaining protection through registration. That is why, in order to cover a wider area of study, the topic of this thesis was chosen as to encompass not only those signs that have already been successfully registered as trade marks, but also those that have not.

⁴⁰ See, for example: Vaver D, 'Unconventional and Well-Known Trade Marks' [2005] Singapore Journal of Legal Studies 1, 1.

⁴¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance.) *OJ L 154*, art 4.

2. Theoretical background to problems with registration of non-conventional signs

2.1 The EU: Absolute grounds of refusal

There are several criteria a sign must satisfy to be validly registered as a trade mark in the European Union. Firstly, the sign must fulfil the definition of a trade mark found in article 4 of the Community Trade Mark Regulation and secondly, the mark cannot be excluded by any of the other absolute grounds of refusal.⁴² The first criterion can be broken down into three separate conditions. First, there must be a sign. Second, the sign can distinguish the goods or services of one undertaking from those of other undertakings. And lastly, the sign must be properly represented. According to the text of the Community Trade Mark Regulation of 2009, this means that the sign must be represented graphically, while, as already mentioned, the Community Trade Mark Regulation of 2017 requires representation in a manner that determines clearly and precisely the subject matter of protection.⁴³ The significance and explanation of each of these three conditions shall be briefly assessed in order to fully understand the difficulties non-conventional signs face when applying for registration.

2.1.1 A sign and its representation

There is no statutory definition of a sign.⁴⁴ However, the definition of a trade mark offers some examples, such as words, designs, letters, numerals, and the shape of goods or their packaging.⁴⁵ The list is non-exhaustive and therefore the CJEU was able to establish that apart from the expressly mentioned signs, there are other ones that can be either visually perceptible or not.⁴⁶ As a result, also non-conventional smells or sounds can be considered signs for the purpose of the trade mark definition.⁴⁷

⁴² Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance.) *OJ L 154*, art 7.

⁴³ *Ibid*, art 4.

⁴⁴ Bently and Sherman (n 1) 912.

⁴⁵ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance.) *OJ L 154*, art 4.

⁴⁶ C-273/00 *Ralf Sieckmann v Deutsches Patentund Markenamt* [2002] ECR I-11737.

⁴⁷ For example, see case C-273/00 *Ralf Sieckmann v Deutsches Patentund Markenamt* [2002] ECR I-11737; and C-283/01 *Shield Mark BV v Joost Kist* [2003] ECR I-14313.

Although ‘a sign’ is understood as a broad term, it cannot be interpreted in a manner that would allow any subject matter to constitute a sign.⁴⁸ That is the reason why some non-traditional trade mark applications have been refused, despite a broad understanding of the term ‘sign’. An example could be a trade mark application for a combination of blue and yellow colours that were used for the packaging of the product.⁴⁹ The CJEU warned, when assessing the case, that if colour is only a property or a characteristic of the product, it cannot be considered a sign for the purposes of trade mark law.⁵⁰ Likewise, a distinction must be made between a sign and a concept.⁵¹ According to the CJEU, the idea of a transparent collector bin for vacuum cleaners was a concept that created a property of the product itself and thus could not be considered a sign, as this would create unfair trade advantage for the trade mark holder.⁵² Therefore, the understanding of what constitutes a sign can be the first obstacle for registration of non-conventional trade marks.

As for the representation of a sign, the recent legislative reform has already been discussed in part 1.1.2 of this text. The requirement of graphical representation is, at the time of writing, still in force and will therefore be explored in detail in relation to each type of non-conventional sign in their respective sections of this thesis. In general, this prerequisite for registration of a sign has been interpreted as visual representation that uses images, lines or characters and fulfils seven criteria known as the ‘Sieckmann criteria’: the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.⁵³ The possible consequences of the amended representation requirement will be assessed in the relevant sections of part 3 of this thesis.

2.1.2 Capacity to distinguish

The last possible problem of registration under article 4 of the Community Trade Mark Regulation is that the sign must have the capacity to distinguish the goods and services of one undertaking from those of another. This requirement must not be confused with a separate exclusion in Article 7(1)(b) that requires a trade mark to have distinctive character.

⁴⁸ European Union Intellectual Property Office, ‘Guidelines for Examination of European Union Trade Marks: Part B Examination Section 4 Absolute Grounds for Refusal’ (02/2017, para 4) <https://goo.gl/VJnEML> accessed 18 October 2017.

⁴⁹ C-49/02 *Heidelberger Bauchemie GmbH v Deutsches Patent und Markenamt* [2004] ECR I-6129.

⁵⁰ *Ibid.*

⁵¹ Norman HE, *Intellectual Property Law: Directions* (Oxford University Press 2014) 375.

⁵² C-321/03 *Dyson Ltd v Registrar of Trade Marks* [2007] ECR I-687.

⁵³ C-273/00 *Ralf Sieckmann v Deutsches Patent und Markenamt* [2002] ECR I-11737 [48]-[49].

The interrelationship between these two conditions is explained in the Guidelines for Examination issued by the European Union Intellectual Property Office (EUIPO). It is suggested that the capacity to distinguish refers to an abstract ability of the particular sign to fulfil the trade mark function, i.e. serve as a badge of origin, without consideration of the goods or services the sign is for.⁵⁴ As a result of this interpretation, there should be very few signs that would lack the abstract distinguishing character.⁵⁵ Therefore, this should not be an obstacle for registration of non-conventional signs.

2.1.3 Distinctiveness

The second category of absolute grounds for refusal and another possible obstacle in registration of non-conventional trade marks is the requirement of distinctive character found in article 7(1)(b) of the Regulation. As a result of this requirement, it must be studied how the trade mark would be perceived by the relevant public, which are the average consumers of the specific goods and services.⁵⁶ Unless there is the conclusion that the trade mark is seen as reliably indicating the trade origin of the product or service, it is not distinctive.⁵⁷ It must be noted that the majority of non-conventional signs will not be inherently distinctive, but the lack of distinctiveness in the nature of the sign as such might be overcome by distinctiveness acquired through use in relation to a product or a service.

The distinctiveness requirement is applicable to all types of marks, but despite this, the non-conventional trade marks are dealt with in a slightly different manner. The reason for this has been given by the CJEU. It has explained that the relevant public perceives non-conventional marks in a different way from the traditional word or figurative marks, especially because the non-traditional ones are more closely linked to the appearance of the goods.⁵⁸ What is more, some non-traditional marks require further evaluation of general interest not required for words, slogans and other traditional signs. This general interest lies in determining whether the registration of the trade mark would not create unfair competitive

⁵⁴ European Union Intellectual Property Office, 'Guidelines for Examination of European Union Trade Marks: Part B Examination Section 4 Absolute Grounds for Refusal' (02/2017, para 5) <https://goo.gl/VJnEML> accessed 18 October 2017.

⁵⁵ Ibid.

⁵⁶ Bently and Sherman (n 1) 934.

⁵⁷ C-404/02 *Nichols v Registrar* [2004] ECR I-8499 [43].

⁵⁸ T-16/00 *Viking-Umwelttechnik GmbH v OHIM* [2002] ECR II-3715 [27].

advantage.⁵⁹ Therefore, the distinctiveness requirement has to be studied for each type of non-conventional trade mark separately, because these considerations will differ for each of them.

2.1.4 Limits on the registration of shapes

Apart from the already mentioned possible problems in registration of non-conventional signs, shapes face additional grounds for refusal. These are set in article 7(1)(e) of the Regulation and prohibit registration of signs which are a result of the nature of the goods themselves, are needed to obtain a technical result or give substantial value to the goods. These additional grounds for refusal of registration are aimed at promoting competition by preventing the registration of signs that would create unfair advantage for the trader and thus be against public interest.⁶⁰ The same reasoning is applied in the USA as well, where the mechanical and aesthetic functionality doctrines pursue the same aim.⁶¹ However, there are some uncertainties regarding the understanding of these limitations, such as the precise meaning of the exclusively natural, functional or ornamental character of the relevant shape.⁶² Thus, these grounds for refusal will be studied in detail, as they are of paramount importance to registration of signs comprising shape.

2.2 Canada

Canada has not been a pioneer in the area of trade marks. Up until quite recently, any signs apart from words and designs have been considered as non-traditional, and thus unregistrable.⁶³ But the current position has become more favourable towards non-traditional trade marks. Canadian trade mark law is governed by the Trade-marks Act 1985, which defines a trade mark as '*a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others*'.⁶⁴ The function of a trade mark to distinguish goods and services is clearly stated in the cited definition. However, the term '*mark*' is not defined in the Canadian legislation and therefore, it is left

⁵⁹ Turner-Kerr P, 'Trade Mark Tangles: Recent Twists and Turns in EC Trade Mark Law' [2004] 29(3) European Law Review 345, 364.

⁶⁰ Bently and Sherman (n 1) 914.

⁶¹ Ibid 915.

⁶² Ibid.

⁶³ Provost M-J, 'Canada's Current Position With Respect To Sound Marks Registration: A Need For Change?' [2010] 8 Canadian Journal of Law and Technology 31, 32.

⁶⁴ Trade-marks Act R.S.C., 1985, c. T-13, s. 2.

for courts to determine what constitutes a mark as a subject matter of trade mark protection. The absence of such legislative definition could be seen as an acceptance of the fact that society and the legal norms governing it are constantly evolving and thus it is desirable to leave the interpretation of the term ‘*mark*’ evolve alongside it.⁶⁵ With that being said, the Canadian courts have not been very open to progressive interpretation of the legislation and mostly placed emphasis on the ordinary meaning of the word ‘*mark*’.⁶⁶ In one decision, a trade mark was explained as something that can be seen as marked on the product or its packaging or otherwise associated with the product so that the purchaser was made aware of such association at the time of purchase.⁶⁷ This interpretation combined with the Trade-marks Act 1985 meant that a trade mark had to be marked on the product and thus visual, distinctive and have an established use in relation to the product.⁶⁸ There were several problems that emerged from these conditions when considering non-traditional trade marks. Firstly, the visual requirement excluded all non-traditional trade marks which were not visible, such as sound or olfactory marks. In addition, the problems included reaching the minimal level of distinctiveness and the requirement of pre-sale association. The Canadian Intellectual Property Office was aware of the limitations of the legislation and it therefore proposed a modernization of the legislation in order to respond to new trends, create an efficient trade mark regime and also ensure Canada’s position on the ever-changing international market by addressing the issues of non-traditional trade marks as well.⁶⁹

As a result, there is currently a more open approach towards non-conventional trade marks. The conditions for registration are that a graphic representation is made of the sign without a need for such sign to be visual and even recordings and other multimedia devices are permissible to aid the representation.⁷⁰ The mark cannot be descriptive, deceptively misdescriptive or serve a function.⁷¹ As a result of these changes, non-conventional signs have

⁶⁵ Mackie V, ‘Scent Marks the Future of Canadian Trade-Mark Law’ [2005] 18 Intellectual Property Journal 417, 421.

⁶⁶ Provost (n 65) 35.

⁶⁷ *Playboy Enterprises Inc v Germain* [1987] 13 F.T.R. 178.

⁶⁸ Mackie (n 67) 423.

⁶⁹ Provost (n 65) 32.

⁷⁰ Canadian Intellectual Property Office, ‘Practice note: Trademark consisting of a sound’ (28 March 2012) <www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03439.html> accessed 30 October 2017.

⁷¹ Trade-marks Act 1985, section 12(2).

become more common in Canada. For example, there were no registered sound marks in Canada before 2012,⁷² whereas now, there are 31 registered sound marks.⁷³

2.3 The USA

The USA law system has a dual character, meaning that federal law must be differentiated from the legislation of individual states.⁷⁴ This thesis will centre on the federal trade mark law, which is governed by the Trademark Act of 1946, as amended,⁷⁵ also known as the Lanham Act. The Lanham Act differentiates between marks for goods, labelled as ‘*trademarks*’, and marks for services, which are called ‘*service marks*’.⁷⁶ The key elements of the definition of both trademark and service mark are the same, which is why both types will be referred to as ‘*trade marks*’ for the purposes of this thesis. Similarly to the other jurisdictions, the definition of a trade mark in the Lanham Act utilises an inclusive list of signs. Any word, name, symbol or device, or any combination thereof, might constitute a trade mark, provided that they identify and distinguish the goods or services and indicate their source.⁷⁷ This has been interpreted in a very broad sense and it is understood that anything which is capable of conveying a message, can constitute a symbol or a device.⁷⁸ Contrary to the EU legislation, the definition in the Lanham act does not set any requirements for the representation of the sign. And lastly, requirements of distinctiveness, non-functionality and origin indicator are set out.⁷⁹

2.4 Australia

In Australia, the more conservative trade mark law has undergone a reform in the 1990s. Before this reform, non-traditional signs were not included in the subject matter of trade mark protection.⁸⁰ This has changed with the Trade Marks Act 1995⁸¹

⁷² Mackie (n 67) 424.

⁷³ Information according to a search conducted in the Canadian Trademarks Database on 6 October 2017. The Canadian Trademarks Database is accessible online at www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home.

⁷⁴ Zdvihalová M, ‘Definiční Vymezení Institutu Ochranné Známky dle Právního Řádu České Republiky, Evropské Unie a Spojených Států Amerických’ [2017] 2 Průmyslové vlastnictví 37, 42.

⁷⁵ Trademark Act 1946 (15 U.S.C.).

⁷⁶ Ibid, para 1127.

⁷⁷ Ibid.

⁷⁸ *Qualitex Co v Jacobson Products Co Inc* 514 US 159 (1995) [162].

⁷⁹ Trademark Act 1946 (15 U.S.C.), para 1052.

⁸⁰ Lea (n 12) 45.

⁸¹ Trade Marks Act 1995 (no. 119).

and the adherent Trade Marks Regulations 1995.⁸² The Trade Marks Act 1995 enacts an inclusive definition of a sign and expressly includes some non-traditional signs, such as a sound, colour, shape, aspect of packaging and even scent.⁸³ Nevertheless, the legislation requires that a sign seeking registration must be represented graphically.⁸⁴ Specification of such graphical representation is set out in the Trade Marks Regulations 1995.⁸⁵ The rest of the trade mark definition accords with European one, as it enacts the distinguishing capability of a sign seeking trade mark protection.⁸⁶

⁸² Trade Marks Regulations 1995 (SR 1995 No. 341).

⁸³ Trade Marks Act 1995, subsection 6(1).

⁸⁴ *Ibid*, section 40.

⁸⁵ Trade Marks Regulation 1995 (SR 1995 No. 341) regulation 4.3.

⁸⁶ Trade Marks Act 1995, section 17.

3. The types of non-conventional signs and their particularities in respect to their nature and legal protection in the selected jurisdictions

Part 3 of this thesis explores the particular types of non-conventional signs in detail, with special attention to the practical implications in light of the already outlined theoretical aspects.

3.1 Sound marks

3.1.1 The EU

One of the most important European cases regarding graphic representation of sound marks is the *Shield Mark BV v. Joost Kist*.⁸⁷ In this case, the question of proper representation arose in connection with two sound marks, the beginning bars of ‘Für Elise’ by the composer Beethoven and the sound of a crowing cock.⁸⁸ The first sound mark was represented by musical notation, while the second one was represented by onomatopoeia ‘*kukelekuuuuuuu*’ alongside the word description ‘*the crowing of a cock*’.⁸⁹ The sufficiency of these methods of graphic representation of a sound was assessed. The CJEU has referred back to the seven *Sieckmann* criteria and decided that the criteria were satisfied if the sound was represented by standard musical notation that consists of a stave with a clef, rests, notes and accidentals.⁹⁰ This means that a musical sound mark which comprises a song or musical composition, like a part of the ‘Für Elise’, should be easily graphically represented by musical notation. However, the less standard non-musical sound marks such as an animal sound might face more of a challenge. This is due to the CJEU’s decision that written language or a simple onomatopoeia are not adequate means of representation of a sound mark.⁹¹ The CJEU saw two main problems with a simple onomatopoeia. Firstly, the onomatopoeia itself and the sound were not consistent.⁹² Secondly, the onomatopoeia for the same sound is not objective and differs among cultures.⁹³ For example, the sound of a cock crowing would not be depicted in English as ‘*kukelekuuuuuuu*’, but rather as ‘*cock-a-doodle-doo*’, while in French the same sound is described as ‘*cocorico*’ and as ‘*kukuriku*’ in Hungarian. One can thus easily comprehend why

⁸⁷ C-283/01 [2003] ECR I-14313.

⁸⁸ Ibid.

⁸⁹ Ibid.

⁹⁰ Ibid [62].

⁹¹ Ibid [64].

⁹² Bently and Sherman (n 1) 896.

⁹³ Ibid.

the Court has deemed simple onomatopoeia as inadequate graphical representation of the sound. It seems appropriate that onomatopoeia would be inadequate.

The studied decision indicates that a distinction must be made between two types of sound marks, i.e. music in a traditional sense of the word, such as a piece of a composition or a jingle, and other non-musical sounds. As for the first, it has been confirmed since *Shield Mark BV v. Joost Kist* that standard musical notation as defined in *Shield Mark BV v. Joost Kist* is an obvious and acceptable way of graphical representation.⁹⁴ However, the non-musical sounds, such as animal noises, meteorological event noises or even machinery noises, cannot be represented by musical notation and thus a problem arises. The question is whether they are capable of trade mark protection and that should be the area of study in this next section.

First of all, it has been expressly stated by the Board of Appeal of EUIPO that sound marks not involving music in the traditional sense are registrable as trade marks.⁹⁵ So the main issue is to properly represent such signs. As was seen above, word description and onomatopoeic description were not acceptable and thus applicants made attempts to put other representations to use. The most notable one is representation by a sonogram. A sonogram, or a sound spectrogram, is a three-dimensional representation of the sound's pitch, relative volume and progression over time.⁹⁶ That is why in the *MGM Lion Corporation* case the Board of Appeal stated that a sonogram representation is comparable to standard musical notation as the dimensions of the sound recorded in the representation are the same, although in different symbols.⁹⁷ The Board of Appeal even went as far as to state that a sonogram offers a more accurate representation compared to standard musical notation, because of the nuances that can be captured in it.⁹⁸ These conclusions lead the Board of Appeal to declare that the sound mark which registration was sought for (roar of a lion) is registrable in a form of a sonogram, because a sonogram fulfils all the requirements for graphic representation.⁹⁹ And although the application was denied on appeal in this case due to other reasons, the Board's acceptance of sonograms as a graphic representation of sound marks has prompted anticipation in regard to non-music sound marks.

⁹⁴ R 781/1999-4 *MGM Lion Corporation* [2004] *ETMR* (34) 480 [21].

⁹⁵ *Ibid*, headnote 1.

⁹⁶ *Ibid* [26].

⁹⁷ *Ibid*.

⁹⁸ *Ibid*.

⁹⁹ *Ibid* [28].

However, the stance on sonograms has reversed completely in 2007. This major change came when an appeal was made in the case of *Edgar Rice Burroughs, Inc.* in regard to an application for a sound mark comprising the yell of a well-known fictional character named Tarzan.¹⁰⁰ The Board of Appeal has expressly dissented from the previous decision regarding sonograms as the Board believed the previous stands towards sonograms to be merely *obiter dictum*.¹⁰¹ The Board's reasoning was based upon several premises. It referred back to the Sieckmann criteria and found that a sonogram is neither self-contained, nor clear, easily accessible or intelligible.¹⁰² Let us consider the Board's reasoning behind each of these criteria.

First of all, a sonogram was not considered as self-contained. A representation is self-contained if the person examining the representation can on his or her own, without the need for additional technical aids, reproduce the sound or have a general idea about the character of the sound.¹⁰³ A sonogram cannot be read like this. Technical aids would have to be utilised in order to reproduce the sound, even by a person specialising on sonograms, let alone general public. That is why the representation of a sound by a sonogram is not self-contained, but also why the Board considered it unclear and unintelligible.¹⁰⁴ This is in direct opposition with the already studied decision from 2003 regarding the roar of a lion sound mark.¹⁰⁵ The Board has expressly stated in the latter, that the argument which claims that sonograms cannot be read by the public is not convincing.¹⁰⁶ It was compared with reading standard musical notation and the fact that not everyone can conceive music simply by reading musical notation without certain training.¹⁰⁷ And yet, musical notation is nevertheless an accepted form of graphic representation of sound marks. The Board thus concluded that this should similarly apply to reading sonograms. However, in the studied 2007 dissenting decision the Board has stated that this comparison between sonograms and musical notation is

¹⁰⁰ R-708/2006-4 [2007].

¹⁰¹ Ibid [19].

¹⁰² Ibid [20], [22], [23].

¹⁰³ Ibid [20].

¹⁰⁴ Ibid [22].

¹⁰⁵ R-781/1999-4 *MGM Lion Corporation* [2004] *ETMR* (34) 480.

¹⁰⁶ Ibid [27].

¹⁰⁷ Ibid.

irrelevant and gave it no consideration.¹⁰⁸ A sonogram was thus deemed as not self-contained, clear or intelligible.

Lastly, a graphic representation comprising a sonogram is not easily accessible. Easy accessibility aims at ensuring that third parties can easily identify the subject-matter of the already registered mark and thus assess whether their own marks overlap with the ones already registered.¹⁰⁹ In order to do so, the person must be able to convert the sonogram into a sound in his brain or by technical means.¹¹⁰ The Board concluded that there are no technical means by which a sonogram image could be transformed back into sound.¹¹¹ It considers the existing software programs, but explains that a person reading the trade mark bulletin would be required to install these single-purpose programs and it is unreasonable to require such a thing.¹¹² What is more, it should be the applicant rather than the third person that dedicates their knowledge and money into proper understanding of a mark.¹¹³ Given all of the above, a sonogram is not easily accessible.

Based on the information discussed so far, it seems that it is impossible to properly represent non-musical sounds. It was shown that written descriptions, simple onomatopoeia or even a sonogram, after a more stern view of the EUIPO, are not satisfactory graphic representations. The legislator was aware of this problem regarding non-music sound marks and thus in July 2005 the Commission Regulation (EC) No 2868/95 was amended in its Rule 3(6). The new Rule 3(6) provides for registration of sound marks and states that an electronic recording of the sound may be attached to the electronic application for registration. However, the recording should not substitute the graphic representation of the sound mark, but rather act as a supplement to the graphic representation.¹¹⁴ The Board of Appeal has expressed its view that such a recording would fulfil the criteria of easy accessibility as well as self-containment.¹¹⁵ Given this change and the elimination of the graphic element of sign

¹⁰⁸ R-708/2006-4 *Edgar Rice Burroughs, Inc.* [2007] [21].

¹⁰⁹ *Ibid* [23].

¹¹⁰ *Ibid* [23].

¹¹¹ *Ibid*.

¹¹² *Ibid* [29].

¹¹³ *Ibid* [29].

¹¹⁴ European Union Intellectual Property Office, 'Decision No. EX-05-3 of the President of the Office of 10 October 2005 concerning electronic filing of sound marks' (10 October 2005) <<http://euipo.europa.eu/en/office/aspects/pdf/ex05-3.pdf>> accessed 20 October 2017.

¹¹⁵ R-708/2006-4 *Edgar Rice Burroughs, Inc.* [2007] [46].

representation, it is very likely that the sounds could be represented by sound recordings accompanied with a word description in the future and fulfil the Sieckmann criteria as well.

3.1.2 Australia

Sounds are expressly listed as signs that are the subject matter of trade mark protection in the Australian legislation,¹¹⁶ which undoubtedly settles the question whether a sound can be a sign in Australia. As explained in the introductory section, sounds must have the capability to distinguish goods and services and be represented graphically; otherwise the trade mark cannot be registered. The interpretation of distinctiveness accords with the already discussed European approach and can be fulfilled, for example, by sufficient evidence of acquired distinctiveness of the sound.¹¹⁷ As for the requirement of graphical representation, the threshold of the Australian Intellectual Property Office (AIPO) is lower than that of the EUIPO, especially when it comes to the non-musical sounds. AIPO has issued a detailed Manual of practice and procedure¹¹⁸ which specifies, in detail, the requirements of graphical representation for non-traditional signs, including sounds. This Manual of practice and procedure is not only an invaluable tool for trade mark applicants, but most importantly a conclusive proof that the threshold for the registration of sound marks is lower in Australia than in the EU, regardless of the same legal requirements, still in effect in September 2017, mainly the requirement of graphic representation. To explain, the Manual of practice and procedure shall be examined.

First of all, the Manual of practice and procedure confirms that both musical as well as non-musical sounds are registrable subject matter.¹¹⁹ The musical sounds may be graphically represented via musical notation and endorsed by a verbal description which refers to the musical notation and the recording of the sound.¹²⁰ The recording of the sound mark is a crucial element in the representation of the sound, as it allows for unambiguous and clear formulation of the sound. That is the reason why every sound mark application must

¹¹⁶ Trade Marks Act 1995, subsection 6(1).

¹¹⁷ Lea (n 12) 45.

¹¹⁸ IP Australia, 'Trade Marks Office Manual of Practice and Procedure' (15 August 2017) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017.

¹¹⁹ Ibid, part 21 section 6.

¹²⁰ Ibid, part 21 subsection 6.1.

be accompanied with a recording of the sound on either a CD, DVD or an MP3 recording.¹²¹ This approach lightens the burden of mere verbal description of sound marks, especially the non-musical ones. Those marks can thus be effectively graphically represented by a simple verbal description of the sound which further refers to the recording of the sound. For example, a registered sound trade mark owned by the Yahoo! Inc. Corporation is graphically represented in the register by the verbal description stating that the trade mark constitutes ‘*the word Yahoo sung in a yodelling style as rendered on the CD included with the application form*’.¹²² The recording can be played instantly in the online trade mark database, which is readily available to the public.¹²³ The verbal description and the recording complement each other well in this case and create a clear and concise representation of the sound mark, which grants legal certainty for all the parties potentially involved with the trade mark.

Another example of a non-musical registered sound mark represented by a combination of verbal description and a sound recording could be the trade mark no. 1205861. This trade mark designated for doorbells is endorsed as comprising of ‘*several kookaburras laughing as submitted on the CD recording accompanying the application*’. The simple, yet precise word description without the recording might prove problematic on its own, as information lacks as for the length, key or intensity of the kookaburra bird’s laugh. However, any ambiguity that the description poses is dissolved once the sound recording is played. This form of representation of sounds could be considered as appropriate, efficient and providing legal certainty as for the scope of protection, while accommodating to the non-musical sounds. As a result, there are currently 55 registered sound marks in Australia. Out of these sounds marks, 30 are graphically represented by a musical notation, while 25 are described by words and accompanied with a sound recording.¹²⁴ This means that almost half of the Australian sound marks would not be registered if the graphical representation requirement was interpreted as a need for musical notation. The current approach, therefore, allows for relatively attainable trade mark registration of non-musical sounds and could be

¹²¹ IP Australia, ‘Trade Marks Office Manual of Practice and Procedure’ (15 August 2017, part 21 subsection 6.1) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017.

¹²² Trade mark no. 827728, registered from March 2000.

¹²³ The Intellectual Property Australia online trade mark database, available online at <<https://search.ipaustralia.gov.au/trademarks/search/advanced>>.

¹²⁴ Based on a search conducted in the Intellectual Property Australia online database on 11 October 2017. The IP Australia database is available online at <<https://search.ipaustralia.gov.au/trademarks/search/advanced>>.

an inspiration as for the future development of the European approach. Naturally, certain technological changes would have to be undertaken, such as accommodate the intellectual property offices and online databases with options to store and play musical recordings, but it would greatly serve clarity, certainty and trade mark protection in the long run.

3.1.3 Canada

Sound marks were not protected in Canada up until March 2012. The reason for this laid in the interpretation of sections 2 and 4(1) of the Trade-marks Act 1985, as explained in part 2.2 of this thesis. The Canadian Trademarks Office had jointly interpreted the said provisions as a requirement for the trade mark to be visual and thus refused to register any sound marks.¹²⁵ However, this position has changed and the Trademarks Office has published a practice notice on 28 March 2012 that declares sound marks registrable, provided the conditions laid out in the practice note are met.¹²⁶ The relevant conditions are that the application for registration of a sound mark contains a drawn graphical representation of such sound, its description and an electronic recording on a CD or DVD.¹²⁷ Additionally, the general criteria for trade mark registration apply, which means the sound mark cannot be descriptive or deceptively misdescriptive or serve a function.¹²⁸ The objections of mis/descriptiveness can be overcome, just like with any other type of mark in Canada, by distinctiveness acquired through use.¹²⁹ This practice note has overcome the need for visual appearance of a mark in order to be protected. Instead, the graphical representation alongside with a description and, most importantly, an electronic recording ensure that the sound is adequately described and prevents uncertainty regarding the sound.

To demonstrate, there are currently 31 registered sound marks in Canada.¹³⁰ These include even one of the most disputed sound marks, the Tarzan yell, registered in Canada by Edgar Rice Burroughs, Inc. in 2015.¹³¹ All of the sound trade marks are represented by a sound recording, which can be played directly and instantly by anyone conducting

¹²⁵ Mackie (n 67) 428.

¹²⁶ Canadian Intellectual Property Office, 'Practice note: Trademark consisting of a sound' (28 March 2012) <www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03439.html> accessed 30 October 2017.

¹²⁷ Ibid.

¹²⁸ Ibid.

¹²⁹ Trade-marks Act 1985, section 12(2).

¹³⁰ Information according to a search conducted in the Canadian Trademarks Database on 6 October 2017. The Canadian Trademarks Database is accessible online at <<https://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/home>>.

¹³¹ Trademark registration no. TMA913352.

a search in the online Trademarks Database. In addition, the sound marks are represented by either musical notation or, interestingly, even a sonogram to accompany the sound recording. The question of intelligibility of sonograms does not pose a problem in Canada and is accepted. As a result, it appears that registration of sound marks in Canada is not more problematic than registration of traditional word and figurative marks. With the exception of sonogram acceptance, the Canadian representation system could also be an acceptable inspiration for the future development of European trade mark law.

3.2 Scents

Moving on to scents, it has been concluded by marketing experts that the sense of smell is closely tied with instinctive human behaviour and has immense evocative power.¹³² The CJEU is also aware of the marketing importance of olfactory marks – it showed so in the *Eden Sarl* case when stating that olfactory memory was probably the strongest one that humans possess.¹³³ Therefore, it is not surprising that manufacturers endeavour to take advantage of this type of human memory by adding pleasant smells to their products or linking them with the provided services. For example, there are currently two smell trade marks registered in the USA that are used to distinguish the trade mark owner's retail stores from the stores of their competitors. Firstly, the footwear company Flip Flop Shop has, in 2012, registered 'a coconut scent or fragrance' that they use in their retail stores as a part of their brand.¹³⁴ Similarly, the consumer electronics retailer Verizon has successfully registered a flowery musk scent that is used in their stores in order to distinguish the company from other similar undertakings.¹³⁵ The interest in utilising scents as a potent brand element means that the interest in smell trade marks awakens as well, and smell trade marks are consequently one of the most discussed areas of non-conventional trade mark law.

Although smell marks have been registered in multiple countries in the past, some developments, especially in the European Union, have led experts to question whether smell

¹³² Hernandez C and Perez M, 'The Possibility of IP Protection for Smell' [2014] 36(10) European Intellectual Property Review 665, 665.

¹³³ T-305/04 *Eden SARL v OHIM* [2005] ECR II-4705.

¹³⁴ USA Trade mark Registration No. 4113191.

¹³⁵ USA Trade mark Registration No. 4618936.

is really protectable under the current legislation.¹³⁶ The answer to that question will depend mostly on the studied jurisdiction.

3.2.1 The USA

The USA is a jurisdiction that is the most favourably disposed to registration of olfactory marks, especially smells. The burst of enthusiasm came in 1990 when the Trademark Trial and Appeal Board, which is a body within the United States Patent and Trademark Office, decided that the scent of plumeria blossoms could be registered as a trade mark in the class of sewing thread and embroidery yarn.¹³⁷ This decision has expressed the Appeal Board's view that smell is not inherently distinctive, but it can become a trademark providing that distinctiveness has been acquired by use.¹³⁸ Since the *In re Clarke* case, it became apparent that showing distinctiveness acquired by use can be a strong obstacle in registration of smell marks. This can be illustrated by the 2013 case *In re Pohl-Boskamp GmbH & Co*, where the applicant sought to register a peppermint scent for pharmaceutical formulations of nitroglycerin.¹³⁹ The application was rejected on two main grounds. Firstly, it was assessed that the peppermint scent did not indicate the producer, but only a quality of the product, which is its ingestibility.¹⁴⁰ Secondly, the applicant failed to show the acquired distinctiveness.¹⁴¹ The standard of proof has been set high and although the applicant has submitted market surveys as well as statements from pharmacists, it was not considered sufficient evidence of distinctiveness.¹⁴²

3.2.2 The EU

The European stance on registration of olfactory marks is less favourable under the Community Trade Mark Regulation when compared to the USA. Although, the widely known case of *Venootschap*¹⁴³ was initially thought to enable registration of smell trade marks under the European law, it has since become clear that the case was an exceptional one and smell marks remain to be extremely hard, if not impossible,

¹³⁶ Hernandez and Perez (n 132) 669.

¹³⁷ *In re Clarke* 17 USPQ2d 1238 (TTAB 1990).

¹³⁸ Lea (n 12) 42.

¹³⁹ 106 USPQ2d 1042 (TTAB 2013).

¹⁴⁰ Lea (n 12) 42.

¹⁴¹ *Ibid.*

¹⁴² *Ibid.*

¹⁴³ R 156/1998-2 *Venootschap Onder Firma Senta* [1999] E.T.M.R. 429.

to register. Up to date, there was only one smell trade mark registered and no taste mark registered as a European Union trade mark.

When assessing the registrability of a smell mark, the Second Board of Appeal stated in *Venootschap* that article 4 of the Community Trade Mark Regulation excludes a simple description of a smell sign as a sufficient graphical representation, unless it is a clear and precise description of such a smell.¹⁴⁴ Therefore, when evaluating the description ‘*the smell of fresh cut grass*’ for tennis balls, the Second Board of Appeal studied whether this description was clear and unambiguous to those reading it.¹⁴⁵ The Board’s conclusion was that the smell of fresh cut grass was ‘*a distinct smell, which everyone immediately recognizes from experience*’.¹⁴⁶ The description was therefore deemed as a sufficient graphical representation of the smell and the mark was registered.¹⁴⁷ However, this decision was considered by A.G. Ruiz-Jarabo Colomer as a ‘*pearl in the desert*’ and he anticipated that such a decision is unlikely to be repeated due to its specific individual character.¹⁴⁸

A.G. Ruiz-Jarabo Colomer’s opinion that *Venootschap* was a sui generis case was affirmed by the CJEU in the already mentioned landmark case *Sieckmann v Deutsches Patent und Markenamt* in 2002, where the CJEU interpreted the graphical representation requirement under article 2 of the Trade Mark Directive in application to a smell mark.¹⁴⁹ The first important outcome of this decision is the CJEU’s answer to the question posed by the German Federal Patent Court as for whether article 2 of the Trade Mark Directive should be interpreted to include also signs which cannot be perceived visually *per se*, but can be perceived through indirect reproduction with certain aids or tools.¹⁵⁰ The Court has confirmed that a trade mark can also consist of a sign which cannot be perceived visually, provided that the sign can be represented graphically.¹⁵¹ The Court has further specified the nature of the graphic representation by stating that it must possess these seven qualities: it must be ‘*clear, precise, self-contained, easily accessible, intelligible, durable and objective*’.¹⁵² In this

¹⁴⁴ R 156/1998-2 *Venootschap Onder Firma Senta* [1999] E.T.M.R. 429 [10].

¹⁴⁵ Hernandez and Perez (n 132) 666.

¹⁴⁶ R 156/1998-2 *Venootschap Onder Firma Senta* [1999] E.T.M.R. 429 [14].

¹⁴⁷ *Ibid* [15].

¹⁴⁸ Opinion of A.G. Ruiz-Jarabo Colomer in C-273/00 *Ralf Sieckmann v Deutsches Patent und Markenamt* [2002] ECR I-11737.

¹⁴⁹ C-273/00 *Ralf Sieckmann v Deutsches Patent und Markenamt* [2002] ECR I-11737.

¹⁵⁰ *Ibid* [19].

¹⁵¹ *Ibid* [45].

¹⁵² *Ibid* [55].

case, the applicant submitted a word description of the scent, a chemical formula of the substance of the smell as well as samples and instructions where such samples can be accessed by third parties.¹⁵³ However, none of these representations were considered sufficient. Written description was deemed neither clear, nor precise as it is uncertain what *'balsamically fruity'* means and also how the strength of the *'slight hint of cinnamon'* should be understood.¹⁵⁴ Secondly, it was thought that a graphical representation by a mere chemical formula does not represent the smell, but rather the substance as such.¹⁵⁵ A chemical formula was also considered uncertain because the smell it emits can be strongly affected by external factors such as the composition of the surface to which the substance is applied or the temperature.¹⁵⁶ What is more, a chemical formula was not seen as intelligible and easily accessible to an average member of the public.¹⁵⁷ Lastly, submitting a sample of the compound does not constitute graphical representation either, as it fails to meet the criteria of being durable and stable, because the odour may change or even completely disappear over time.¹⁵⁸ It was also argued that representing smells by samples would be problematic not only for registration of the smell mark, but also for the publication and opposition process regarding such a trade mark.¹⁵⁹ However, the CJEU also concluded that not only is each of these attempts at graphical representation of a smell insufficient on its own, but also a combination of all of them would be equally insufficient to fulfil the requirement of graphical representation in order to constitute a trade mark.¹⁶⁰ Therefore, it seems that although the Court has not ruled out the possibility of smell signs becoming trade marks, there currently seems to be no acceptable way of graphically representing a smell and thus makes it unregistrable. Most authors conclude that there is no adequate way to represent an olfactory mark and thus smell and taste signs currently cannot be registered.¹⁶¹

¹⁵³ Hernandez and Perez (n 132) 666.

¹⁵⁴ Ahuja VK, 'Non-Traditional Trade Marks: New Dimension of Trade Marks Law' [2010] 32(11) European Intellectual Property Review 575, 576.

¹⁵⁵ Ibid.

¹⁵⁶ Ibid.

¹⁵⁷ Sahin O, 'The Past, the Present and the Future of Colour and Smell Marks' [2016] 38(8) European Intellectual Property Review 504, 509.

¹⁵⁸ Ibid 510.

¹⁵⁹ Ahuja (n 155) 576.

¹⁶⁰ Ibid.

¹⁶¹ For example, see: Press T, *Intellectual Property Law Concentrate* (2nd edn, Oxford University Press 2015) 164.

In order to demonstrate the importance of CJEU's decisions and explain the emphasis placed on them in this thesis, it should be noted that the *Sieckmann* decision has also influenced the national registrations of olfactory marks. In the United Kingdom, for example, there were several successful smell applications before the CJEU's decision in *Sieckmann* was made in 2002.¹⁶² These included 'a floral fragrance/smell reminiscent of roses as applied to tyres'¹⁶³ and 'the strong smell of bitter beer applied to flights for darts'.¹⁶⁴ Both of these registrations were based on the written descriptions of the smell. However, a later application made by *John Lewis of Hungerford* was rejected because the United Kingdom Intellectual Property Office has decided that a written description 'the smell, aroma or essence of cinnamon' was neither precise, nor objective graphical representation.¹⁶⁵ The said requirements of precision and objectivity are certainly in line with the seven qualities required of graphic representation as described in the *Sieckmann* case.

Although proper representation is a significant obstacle to registration of smell signs, the requirement of distinctiveness might prove to be equally problematic. This can be demonstrated by the *Myles Ltd's Community Trademark Application*.¹⁶⁶ The applicant sought to register the scent of raspberries for the following goods in class 4: 'fuels, including motor fuels, particularly diesel as heating fuel and engine fuel'.¹⁶⁷ The Third Board of Appeal, maybe surprisingly, considered the written description a sufficient graphical representation of the smell, because the scent of raspberries is unequivocal, precise and unique and sends a clear message.¹⁶⁸ The registration was nevertheless rejected on the grounds that the smell failed to fulfil the primary trade mark function, which is to show the origin of the goods.¹⁶⁹ Therefore, the smell trade mark was rejected due to lack of distinctiveness. Such a conclusion might be drawn with a lot of smell signs, because evidently, consumers do not consider smell as an indicator of origin, but rather a feature of the product itself.¹⁷⁰ But in order for a smell to become a trade mark, it must be autonomous and distinguishable from the product;

¹⁶² Lea (n 12) 44.

¹⁶³ UK Trade mark, Registration no.: UK 00002001416 (1996).

¹⁶⁴ UK Trade mark, Registration no.: UK 00002000234 (1996).

¹⁶⁵ UK Trade mark Application no.: 2000169, of John Lewis of Hungerford Plc (2000).

¹⁶⁶ R-711/1999-3 *Myles Ltd's Community Trademark Application* [2003] E.T.M.R. 56.

¹⁶⁷ *Ibid* [38].

¹⁶⁸ *Ibid* [15].

¹⁶⁹ *Ibid* [46].

¹⁷⁰ Hernandez and Perez (n 132) 668.

it cannot be the product's essential quality.¹⁷¹ As it was put by the Third Board of Appeal in *Myles Ltd's Community Trademark Application*, the smell '...must have a functionally independent and autonomous character relative to the goods.'¹⁷² That is why it is impossible to register functional scents, such as a scent for an air freshener or the scent of a perfume. This was confirmed by the United Kingdom when an application to register the famous No. 5 Chanel fragrance was rejected.¹⁷³ Therefore, arbitrarily associated odours for products, otherwise odourless, might have a higher chance of being distinctive considering that consumers view the scent as an origin indicator rather than a functional element of the product.

As a result of the studied problems with smell signs, which mostly include the impossibility of representation and the lack of distinctiveness, there are only a handful of states worldwide that currently allow for the possibility of registration of smell signs as trade marks. These include Australia, India, Ireland, Russia, Switzerland and Lithuania.¹⁷⁴ On the other hand, some countries decidedly exclude the registration of smell signs as trade marks. Among these is, for example, the Czech Republic and Slovakia. In the Czech Republic, both the set practice and literature explain this approach by reference to the absolute grounds of refusal, specifically the inability of smells to fulfil the definition of a trade mark in the section 1 of the Act no. 441/2003 Coll., on Trade Marks.¹⁷⁵ Firstly, an acceptable graphic representation only includes expressions by written words, numbers, drawings or picture, colour or shape of the product or its packaging and it is believed that smells cannot be properly represented by any of those means.¹⁷⁶ Other means of graphic representation are not excluded, if they possess the ability to distinguish goods and services of different undertakings, but they are extremely rare in practice.¹⁷⁷ As for the requirement of distinctiveness, some Czech experts note that the assessment of a sign's distinctiveness is not only based on objective, but also subjective elements and there are varying degrees of distinctiveness.¹⁷⁸ Nonetheless, this does not undermine the generally accepted view that

¹⁷¹ R-711/1999-3 *Myles Ltd's Community Trademark Application* [2003] E.T.M.R. 56 [40].

¹⁷² *Ibid.*

¹⁷³ Ahuja (n 155) 575.

¹⁷⁴ Hák J, *Známkové Právo v Mezinárodních Souvislostech* (Vydavatelství a nakladatelství Aleš Čeněk 2012) 47.

¹⁷⁵ Horáček R, Čada K and Hajn P, *Práva k Průmyslovému Vlastnictví* (C.H. Beck 2011) 364.

¹⁷⁶ Jakl (n 4) 100.

¹⁷⁷ *Ibid.*

¹⁷⁸ Hák (n 175) 41.

smells are non-distinctive and thus cannot be registered as trade marks.¹⁷⁹ The same approach is applied in Slovakia as well, where smells are considered neither capable of graphic representation, nor distinctive.¹⁸⁰

However, considering the European approach, will there be a change in this view due to the amendments to legislation? One must consider that the removal of the graphic representation requirement from the definition of a trade mark should not be interpreted as creating boundless possibilities for representing signs one wishes to be registered. On the contrary, the European Commission has made it clear, when putting the proposals forward, that although the amended definition leaves the door open to register matter that can be represented by technological means offering satisfactory guarantees, it is not an infinite extension of the admissible ways to represent a sign, but rather a more flexible approach to increasing legal certainty.¹⁸¹ To be more precise, it was explicitly stated that the amended legislation ‘*should not be detract from the level of legal security prescribed in the CJEU’s Sieckmann judgment (C-273/00)*’.¹⁸² Therefore, while new technological means of representation of smells are allowed, there seems to be no change as for the required properties of such a representation, meaning that it must be ‘*clear, precise, self-contained, easily accessible, intelligible, durable and objective*’.¹⁸³ With this in mind, let us consider the possible means of representation of smell.

There are several possible technological ways to represent smell. Gas chromatography and mass spectrometry are two processes by which one can detect components in a sample.¹⁸⁴ Gas chromatography results in a graphical image which shows the components and their quantity, but there are limitations to this method, mainly resulting from the machinery, its type, maintenance, lifespan and can result in different results.¹⁸⁵ Mass spectrometry also has its limits stemming from machinery, specifically the varying resolution ability of different instruments which determines the accuracy of the result.¹⁸⁶ Other instrumental methods are

¹⁷⁹ Ibid.

¹⁸⁰ Vojčik (n 38) 299.

¹⁸¹ Hernandez and Perez (n 132) 667.

¹⁸² Max Planck Institute for Intellectual Property and Competition Law, ‘Study on the Overall Functioning of the European Trade Mark System’ (15 February 2011, para 59) <www.ip.mpg.de/fileadmin/IP/pdf2/mpi_final_report_with_synopsis.pdf> accessed 18 October 2017.

¹⁸³ C-273/00 *Ralf Sieckmann v Deutsches Patentund Markenamt* [2002] ECR I-11737 [55].

¹⁸⁴ Mackie (n 67) 438.

¹⁸⁵ Ibid 439.

¹⁸⁶ Ibid 440.

available as well, such as high performance liquid chromatography, nuclear magnetic resonance or infra-red and ultraviolet spectroscopy.¹⁸⁷ However, it must be noted that some of these technological means have already been unsuccessfully used in smell trade mark applications. An example of that is an application that used a print-out version of a high performance liquid chromatography analysis combined with a written description, and yet, was found inadequate by the EUIPO's Board of Appeal.¹⁸⁸ It is, therefore, difficult to presuppose the success of the other methods as well. Apart from the mentioned methods, there are already companies that specialise in scent marketing and are developing digital scent technology that could transmit and receive scents using digital media.¹⁸⁹ For example, a Swedish company named Scent Communications offers scent marketing services such as fragrant displays, prints, scents for events or retail stores.¹⁹⁰ Technologies are emerging that could potentially be turned into scent smelling devices, such as the Japan Smell-o-vision which can emit smell from any LCD screen by installing vaporising gel pellets into attached air streams.¹⁹¹ According to the creator, a cartridge could be incorporated which would allow for smells to change on demand.¹⁹² Such technologies have the potential to create precise and stable smells in the future, but will presumably not do so for a while.

It can be concluded that while the new trade mark definition might make it easier to register new types of marks, it will most likely not enable registration of smell marks, due to the technological obstacles studied. So it can be concluded that the protection of smell signs will continue to be rather exceptional.

3.2.3 Canada

Apart from the already mentioned and equally applicable obstacles in registration of smell marks in other jurisdictions, the Canadian legislation has added one specific condition known as pre-sale accessibility. This condition is linked with the use of the mark that is expressed in section 4 of the Trade-marks Act 1985. In order to explain the pre-sale accessibility theory one must revert to the function of trade marks, which is to serve

¹⁸⁷ Hernandez and Perez (n 132) 668.

¹⁸⁸ R-186/2000-4 *Institut pour la Protection des Fragrances (IPF)'s Community Trade Mark Application* [2005] E.T.M.R. 42.

¹⁸⁹ Hernandez and Perez (n 132) 668.

¹⁹⁰ Boija Consulting, 'Scent Communications' <<https://scentcom.se/en/>> accessed 16 October 2017.

¹⁹¹ Hodson H, 'Smell-o-vision screens let you really smell the coffee' (New Scientist, 26 March 2013) <<https://goo.gl/tQ3TKu>> accessed 15 October 2017.

¹⁹² *Ibid.*

the consumer in making a purchase by identifying the source of the goods among other producers. Some Canadian commentators argue that this requires the association between the mark and the source of the product before the purchase, otherwise the trade mark function would not be fulfilled.¹⁹³ This might prove very problematic for smell marks due to the packaging of products. If a product is scented and the scent is supposed to be a trade mark, then packaging which conceals such a scent is preventing the consumer recognition of the origin of the goods based on smell. Such a smell thus cannot become a trade mark. This aspect of pre-sale accessibility theory expresses the second part of its name – accessibility.¹⁹⁴ It prevents registration of any smells that are attached to the product in such a way, that the product must be opened after purchase in order to perceive the smell, or that only becomes apparent during the use of the product.¹⁹⁵ The second aspect of the pre-sale accessibility theory is scent recognition.¹⁹⁶ The notion behind this is the scepticism towards the human ability to distinguish different undertones of various scents. What is more, not only is the distinguishing ability questioned, but there are also variations in individuals when it comes to smell recognition.¹⁹⁷ Studies show that there are discrepancies between sexes, meaning that women tend to have a more accentuated sense of smell, and also discrepancies between age groups.¹⁹⁸ In addition, it must be taken into consideration that whole groups of people are odour-blind to some smells. This is the case in the USA where National Institute of Health estimates over 2 million people suffer from a smell dysfunction.¹⁹⁹ Therefore, an objective human perception of smells seems unattainable and this contributes to the Canadian reserved approach towards smell marks.

3.2.4 Australia

Australia falls into the group of jurisdictions which are open towards trade marks comprising smell. This is demonstrated clearly in its legislation, because the Trade Marks Act 1995 expressly lists scent as one of the signs that are the subject matter of trade mark protection.²⁰⁰ This does not mean that Australian legislator is unaware of all the problems that

¹⁹³ Mackie (n 67) 423.

¹⁹⁴ Mackie (n 67) 430.

¹⁹⁵ Ibid.

¹⁹⁶ Ibid 431.

¹⁹⁷ Ibid 433.

¹⁹⁸ Ibid.

¹⁹⁹ Anosmia Foundation of Canada, 'How many people suffer from anosmia?' (2003) <<http://www.anosmiafoundation.com/suffer.shtml>> accessed 15 October 2017.

²⁰⁰ Trade Marks Act 1995 (no. 119) subsection 6(1).

have already been discussed in relation to smell marks. On the contrary, the Manual of Practice and Procedure issued by IPA expresses that graphic representation, which is required by Australian legislation, is probably the most difficult for scents out of all the types of non-traditional trade marks.²⁰¹ Nevertheless, there is currently one scent mark successfully registered in Australia,²⁰² which means that although difficult, proper representation of smell marks is not impossible. As for the distinguishing capability, Australian legislation is close to the already studied jurisdictions. To be more specific, only scents which are self-contained can be distinguishing, whereas smells that are natural to the product, have a masking function or are common in the trade sector cannot have the distinguishing capability required of trade marks.²⁰³ Since these criteria have already been discussed in regard to previous jurisdictions, let us rather consider the unique aspect of Australian approach to smell marks – the representation of smells.

As explained above, the particulars of presentations and descriptions of signs seeking trade mark protection are put forward in the Manual of Practice and Procedure issued by Intellectual Property Office Australia (IPA). As for all the trade marks, regardless of jurisdiction, the unanimous principle is that the representation of the sign must be unambiguously clear to ensure legal certainty.²⁰⁴ Several technical methods of smell representation have been described in regards to other jurisdictions, which could be unambiguous. However, IPA has expressly rejected all highly technical means of representation of scents, due to them being unclear to an ordinary person.²⁰⁵ This requirement is in line with the European approach of intelligibility of sign representation. Therefore, methods such as chromatography, electronic nose, infrared spectroscopy or nuclear magnetic resonance are unacceptable. As a result, there is currently only one way of representation that has been accepted, which is verbal description. Thus, verbal description has been the form of graphical representation of the sole Australian trade mark – the Eucalyptus Radiata smell used for golf tees.²⁰⁶ The description of this registered trade mark is very simple in its method, yet it identifies the exact type of plant in the Eucalyptus

²⁰¹ IP Australia, ‘Trade Marks Office Manual of Practice and Procedure’ (15 August 2017, part 21 section 7) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October.

²⁰² Trade mark no. 1241420, registered in May 2008, owned by E-Concierge Australia Pty Ltd.

²⁰³ IP Australia, ‘Trade Marks Office Manual of Practice and Procedure’ (15 August 2017, part 21 section 7.2.1) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017.

²⁰⁴ Ibid, part 21 section 7.1.

²⁰⁵ Ibid.

²⁰⁶ Trade mark no. 1241420, registered in May 2008, owned by E-Concierge Australia Pty Ltd.

family by its scientific Latin name and is thus highly specific at the same time. The Manual of Practice and Procedure indicates that scents released by plants could be described in an even broader sense, such as '*smell of roses*' or '*smell of apple blossoms*'.²⁰⁷ These descriptions are less specific when it comes to the plant variety they refer to, but would be still acceptable by IPA. Therefore, it seems that the threshold for description of smell marks is quite low when it comes to Australia.

To conclude, one of the main aims of the trade mark law is to help consumers in their consumer choice by relying on the quality of goods or services associated with a certain brand. Trade marks should eliminate consumer confusion of different products. Therefore, in a way, trade marks could be considered a consumer protection law.²⁰⁸ However, one must consider whether a widespread acceptance of non-traditional trade marks would help the goal of protecting consumers. Research that has been carried out in this area suggests that consumers are unable to make a connection between a smell and a brand.²⁰⁹ It was concluded that not only do smell marks lack inherent distinctiveness, but smells are also highly subjective and there is no consensus even upon basic scents, such as a smell of orange.²¹⁰ This could not only be very problematic in infringement proceedings when a determination of the two smells would have to be carried out, but could also lead to consumer confusion. The positive contribution of smell marks is, therefore, questionable.

²⁰⁷ IP Australia, 'Trade Marks Office Manual of Practice and Procedure' (15 August 2017, part 21 section 7.1) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017.

²⁰⁸ Samtani A and others (n 22) 699.

²⁰⁹ Ibid.

²¹⁰ Ibid 707.

3.3 Colour marks

3.3.1 The EU

Colour has not been specifically listed in the enumeration of signs which a trade mark may consist of, but has been added into the definition of a trade mark in the amended Regulation (EU) 2017/1001.²¹¹ This can be seen as a confirmation that colour combinations as well as single colours could be protected as trade marks, however, as is the case with the majority of non-conventional signs, some colour combinations and the majority of single colour marks will not be automatically considered as distinctive.²¹² A colour per se has not even been considered a sign without further context.²¹³ Therefore, acquisition of distinctiveness prior to the application for registration will have to be proven. However, there is lack of guidance when it comes to colour marks and thus questions arise such as when a single colour mark can be distinctive, if it can only be distinctive as a dominant colour or even a sole colour and similar questions.²¹⁴ The two requirements for registration of trade marks, the distinctiveness requirement and proper representation, will now be considered successively.

Firstly, the colour combination or the single colour must be graphically represented. There are several decisions of the CJEU that shed light on how this requirement can be sufficiently complied with when it comes to colours. It was stated in *Libertel* that neither a description of the colour, nor a sample of the colour are satisfactory.²¹⁵ The reasons are that a description can never be objective or precise to the required degree, while a sample is unstable and volatile over the long-run, because it is subject to deterioration.²¹⁶ A solution was offered in the case of *Heidelberg Bauchemie GmbH*'s application, where it was suggested that a reference to an internationally recognised colour code would be a suitable graphic representation of the colour.²¹⁷ Such internationally recognised colour codes include

²¹¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance.) *OJ L 154*, art 4.

²¹² Lea (n 12) 43.

²¹³ Colston C and Galloway J, *Modern Intellectual Property Law* (3rd edn, Routledge 2010) 594.

²¹⁴ Sahin (n 158) 506.

²¹⁵ C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793; [2005] 2C.M.L.R. 45.

²¹⁶ *Ibid.*

²¹⁷ C-49/02 *Heidelberger Bauchemie GmbH v Deutsches Patent und Markenamt* [2004] ECR I-6129.

the Pantone colour chart²¹⁸, the Natural Colour System²¹⁹ or the CMYK colour model. Compared to other non-conventional trade marks, this seems as a rather straightforward solution and suggests that it should not be unattainable to make a sufficient graphical representation of a colour sign.

Yet, criticism has been raised against representation by reference to colour coding systems. Specifically, it has been suggested that referencing a Pantone number is neither intelligible, nor easily accessible.²²⁰ It is true that a degree of analysis is necessary in order to identify the precise colour by a Pantone number, but the degree should be considered acceptable. It must be anticipated that non-conventional trade marks will likely require more interpretation compared with traditional words or figurative marks. An internet search is all that is really necessary for the identification of the colour. Let us compare it with another attempted method of colour representation. In *Ty Nant Spring Water Ltd's Application* the applicant made an attempt to register the cobalt blue colour of a bottle.²²¹ The bottle was described in words as to its thickness, the material and most importantly by the range of wavelength, purity and optical brightness characteristics.²²² Such a description requires additional analysis by a spectrophotometer in order to identify the colour applied for. However, when compared to the reference to a Pantone number, the degree of needed analysis is much greater in the *Ty Nant Spring Water Ltd's* case. Not only does one need the specific equipment, but also the knowledge how to operate a spectrophotometer correctly to replicate the conditions as described in the application. The level of required interpretation is thus high. As a result, the representation is neither intelligible, nor easily accessible. In contrast, to access a Pantone chart all one really needs is Internet access and basic internet literacy. No scientific equipment or special knowledge of the technique is necessary. Thus, based on this comparison, it could be concluded that a reference to an internationally recognised colour coding system is both accessible and intelligible with only minimal need for additional analysis.

Another problem regarding the registration of combination of colours is the specification of the colour arrangement. To demonstrate, let us consider the already

²¹⁸ Pantone LLC, 'Find a PANTONE color' (2017) <<https://www.pantone.com/color-finder>> accessed 16 October 2017.

²¹⁹ Accepted, for example, in the European Union trade mark registration no. 005983283.

²²⁰ Sahin (n 157) 507.

²²¹ *Ty Nant Spring Water Ltd's Trade Mark Application* [2000] R.P.C. 55.

²²² Ibid.

discussed *Heidelberg Bauchemie GmbH* case.²²³ In this case, the application has stated that the colours blue and yellow would be used in every conceivable form for various goods, such as paints, adhesives, solvents etc. Such a specification of the colour arrangement was deemed as neither clear, nor precise by the CJEU. The representation must specify the colour combination systematically, in a uniform and predetermined way.²²⁴ Therefore, the application for a combination of two colours arranged in ‘*any conceivable form*’ must be refused due to lack of precision and clarity. Similarly, the lack of precision and clarity in describing the arrangement of the colour mark has been the main concern in a United Kingdom case that has been decided by the Court of Appeal in 2013.²²⁵ Cadbury has made an application for registration of the colour purple, which was specified by reference to a Pantone number 2685C. Such a description of the colour is sufficient, as was explained above. However, the problem arose with the arrangement of the colour on the packaging of the Cadbury products. The application has stated that the colour would be applied to the whole visible surface of the packaging or alternatively as a ‘*predominant colour*’ of the visible surface of the packaging of the goods.²²⁶ The words ‘*predominant colour*’ were not considered sufficiently precise and clear, because they create a multitude of possibilities for the placement of the purple colour on the surface of the packaging. Therefore, a conclusion can be made based on the *Heidelberg Bauchemie case* and the Cadbury application that although a colour may be specified by reference to a recognised colour system, it does not guarantee the colour mark registration. This is because in addition to that reference, the application must sufficiently specify the colour arrangement of the colours and also the way in which the colour or colours will be placed on the goods or their packaging. Unless there is a clear, predetermined system to this, the colour mark or the combination of colours cannot be registered as trade marks.

When it comes to the distinctiveness of colours, they are not inherently distinctive. Their distinctiveness must therefore be based on prior use. There are two main concerns for colours as trade marks in this regard. Firstly, consumers rarely relate a colour of a product with the product’s origin, which means that colours seldom act as indications of origin. Proving the distinctiveness of colour marks might thus be problematic. Generally, the more

²²³ C-49/02 [2004] ECR I-6129.

²²⁴ C-49/02 *Heidelberger Bauchemie GmbH v Deutsches Patent und Markenamt* [2004] ECR I-6129 [33].

²²⁵ *Société des Produits Nestlé SA v Cadbury UK Ltd* [2013] EWCA Civ 1174.

²²⁶ *Ibid.*

specific the relevant market and the smaller the number of goods and services to which the colour is applied, the higher the chances of acquiring distinctiveness.²²⁷ For example, a single orange colour used in the specific and narrow sector of consultancy services in seed cultivation was successfully registered due to these reasons.²²⁸

Second concern relating to the distinctiveness of colours is the problem of colour exhaustion or colour depletion theory. The CJEU has already warned about this problem in 2003 when assessing the *Libertel* case. It was explained by the CJEU that the number of distinctive colours was limited, which means that registration of even a small number of colours could exhaust all the registrable colours of the colour spectrum.²²⁹ For example, registration of one shade of violet would prevent any other similar shade from being registered due to the risk of confusion. Such a trend would result in a few colour trade mark owners who would have an unjustified competitive advantage and that would counter the public interest.²³⁰ Therefore, when assessing the distinctiveness of a colour sign, the availability of colours for other traders on the relevant market segment must be assessed and preserved. As was expressed in the *Heidelberg Bauchemie* judgment by the CJEU, it would be against public interest to inappropriately limit the available colours for others who trade in the relevant market sector.²³¹ Since these judgments, the concern of colour exhaustion has been expressed by others as well. It was stated that considering the use of colours in industry and trade, the colour exhaustion problem must be taken into account looking forward.²³²

An additional issue worth mentioning in regard to colour marks is the problem of laudatory colours. Laudatory colours include gold, bronze or silver and the consumers might perceive them as simply expressing a quality of a product or its high value, rather than their origin. This notion is based on the approach towards laudatory word trade marks, which have previously been refused registration based on these grounds.²³³ Thus, special attention must be paid to laudatory colour marks, especially when assessing their functionality and the public perception of those colours in relation to the specific product or service.

²²⁷ Bently and Sherman (n 1) 935.

²²⁸ T-173/00 *KWS Saat AG v. OHIM* [2002] ECR II-3843.

²²⁹ *Libertel* C C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793 [54].

²³⁰ Bently and Sherman (n 1) 935.

²³¹ Cook TM, *EU Intellectual Property Law* (Oxford University Press 2010) 241.

²³² Lea (n 12) 43.

²³³ See, for example, R-1457/2007-1 *Estee Lauder v Cofinlux* (Appeal, 23 October 2008).

The conclusions of such an assessment will depend on the particularities of each individual case.

3.3.2 The USA

Both colour combinations as well as colour per se are included in the registrable subject matter in the USA. The trade marks combining two or more colours have been accepted for a long time and are rather unproblematic,²³⁴ unlike single colours. It was not until 1995 that the Supreme Court affirmed that a colour per se can be registered as a trade mark if it meets the legal trade mark requirements.²³⁵ Until then, single colour trade mark applications were rejected due to the already explained colour depletion theory, the potential risk of colour shade confusion in case of an infringement dispute or the argument of functionality of the colour in regard to the product.²³⁶ These justifications have been partially abandoned now and since the *Qualitex Co. v. Jacobson Products Co.* decision, a colour per se can be registered as a trade mark in the USA, if it is distinctive and non-functional.²³⁷ Both of these requirements shall be considered.

Similarly to the European approach, there are two types of distinctiveness in the United States. Distinctiveness has been defined by the Supreme Court in *Two Pesos, Inc. v. Taco Cabana, Inc.* as either inherent or as acquired through secondary meaning.²³⁸ The secondary meaning can be understood as a permutation of the requirement of distinctiveness acquired through use of a mark. Because colours per se are rarely inherently distinctive, the majority of colour mark applications will be based on the colour mark having acquired secondary meaning. Much like under the European legislation, proving the secondary meaning of a colour mark might be a problematic endeavour. The applicant must show that the colour identifies the source of the product rather than the product itself.²³⁹ The burden of showing distinctiveness is very high and will be a result of extensive advertising over a longer period of time. The landmark *Qualitex* case is a suitable demonstration of the secondary meaning requirement. For decades, *Qualitex* has been selling

²³⁴ Lea (n 12) 42.

²³⁵ *Qualitex Co v Jacobson Products Co Inc* 514 US 159 (1995).

²³⁶ Visintine LR, 'The Registrability of Color Per Se as a Trademark after *Qualitex Co. v. Jacobson Products Co.*' [1996] 40 Saint Louis University Law Journal 611, 620.

²³⁷ Lea (n 12) 42.

²³⁸ 112 S. Ct. 2753, 2758 (1992).

²³⁹ Visintine (n 237) 613.

press pads used in dry cleaning, which were of specific green-gold colour.²⁴⁰ The press pads were known for its exceptional quality and the company had spent almost two million dollars on advertising the product among dry cleaning businesses. As a result, the press pads became so well known that some customers ordered the product solely by referring to the colour.²⁴¹ Although not distinctive inherently, the green-gold colour has acquired secondary meaning. This shows that proving distinctiveness might be a lengthy and challenging process.

The second possible obstacle to colour mark registrations in the USA is the functionality doctrine. Functionality refers to an attribute of the product that makes it essential to its use or it has an effect on the product's quality or cost.²⁴² The aim seems to be identical to the European legislator's, who has placed additional registration requirements on shape marks in article 7(1)(e) of the Community Trade Mark Regulation, and that is the protection of free competition. Granting a trade monopoly on a functional feature of a product would hinder free competition in that market segment. However, the functional feature is understood not only as one serving a utilitarian function, but sometimes also an aesthetic one.²⁴³ The aesthetic function was a reason why the black colour mark was refused protection in *Brunswick Corp v British Seagull Ltd*.²⁴⁴ The rationale behind the decision was that the colour was applied to outboard motors which had to be then connected to mounts and other accessories on the ship that were already black.²⁴⁵ As a result, the customers would wish to buy the matching black outboard motor because it would be aesthetically pleasing. On the other hand, the utilitarian functionality means that no mark can be registered if there is a certain competitive need for the colour due to its function. This includes the product's natural colour or a colour naturally connected to the product, the cheapest colour or one that is used for its high visibility or non-visibility.²⁴⁶ Additionally, a colour is functional if it is already used in the specific market with a certain aim, such as was the case with purple abrasives in *Saint-Gobain Corp. v 3M Company*.²⁴⁷ In this case, it was established that in the trade sector of coated abrasives with paper or cloth backing, colour is used for several functions, including colour coding the products to differentiate the grit

²⁴⁰ *Qualitex Co. v Jacobson Products Co.* 115 S. Ct. 1300 (1995).

²⁴¹ *Visintine* (n 237) 635.

²⁴² *Ibid* 623.

²⁴³ *Lea* (n 12) 43.

²⁴⁴ 35 F.3d 1527 (Fed Cir 1994).

²⁴⁵ *Lea* (n 12) 42.

²⁴⁶ *Visintine* (n 237) 646.

²⁴⁷ *Samtani and others* (n 22) 712.

and coat of the abrasive.²⁴⁸ Therefore, the United States Patent and Trade Mark Office refused to register a deep purple colour, because colour is used with a specific function in that sector. Granting a monopoly on one shade of colour would potentially hinder the function of that specific colour in the coated abrasive sector. Therefore, the trade mark application was refused as a result of the functionality doctrine. Enforcing the rule that a sign must not be functional is pertinent to the trade mark function and is prevalent in all the studied jurisdictions. Rejecting trade mark applications for non-conventional signs based on the functionality ground is desirable and should not be altered in the future.

3.3.3 Canada

Canadian stance towards colour marks does not digress from the reasoning that was already discussed in terms of the EU and the USA. Colour marks were admissible as soon as 1987, when an application was made by *Smith Kline & French Canada Ltd.* for a shade of green colour.²⁴⁹ The court expressly stated that colour marks are not excluded from trade mark protection by the Trade-marks Act 1985, as long as they fulfil the function of a trade mark, are distinctive and do not infringe the rights of others.²⁵⁰ In general, the Supreme Court of Canada explained that the main question is whether the colour identifies the origin of the goods rather than the product as such.²⁵¹ It is not sufficient that the colour is associated with the product; it must rather be associated with the manufacturer and his brand in order to serve the trade mark function. In addition, Canadian approach also excludes colour marks that have a utilitarian function.²⁵² So, similarly to the already studied jurisdictions, the ability of a colour or a combination of colours to function as trade marks in Canada depends on the particularities of each case. These particularities include the type of goods in question, their use, the availability of other colours in the colour spectrum in the relevant market, the nature of the relevant market and its structure and marketing practices in such sector.²⁵³ As can be seen from the examined areas, a great emphasis is placed on maintaining free competition in the relevant market sector. So the Canadian approach to colour marks does not depart from the ones in the EU and the US and all of them seem to have a good balance between the interests of traders, but also the market needs and consumers.

²⁴⁸ Samtani and others (n 22) 712.

²⁴⁹ *Smith Kline & French Canada Ltd. v. Canada (Registrar of Trade Marks)* [1987] 2 F.C. 628.

²⁵⁰ *Ibid* [6].

²⁵¹ *Ciba-Geigy Canada Ltd. v. Apotex Inc.* [1992] 3 S.C.R. 120 [55].

²⁵² Mackie (n 67) 427.

²⁵³ Mackie (n 67) 428.

3.3.4 Australia

In the last studied jurisdiction, Australia, a wide variety of colour signs may become a trade mark. A sign, in terms of trade mark protection, might be a colour per se, a combination of colours or a single colour or colour combination in combination with other features specified in the definition of a sign, e.g. a label or the packaging.²⁵⁴ The definition of the sign implies that although less common in practice, a single colour is capable to act as an indicator of origin and be a trade mark. This has been further supported by case law, for example the Australian Federal Court's decision in 2002 regarding the single colour terracotta for components of irrigation pipes.²⁵⁵ The importance of this decision lies not only in the fact that the Federal Court has affirmed the possibility of colour per se trade mark, but has also specified the type of colour signs which could be registrable. Those shall be now considered, as colour per se is a more problematic category of non-conventional trade marks than a combination of colours.

The *Philmac Pty Limited v The Registrar of Trade Marks*²⁵⁶ case has set out four criteria for colour per se signs that wish to be accepted for registration in Australia. Firstly, the colour cannot have a utilitarian function, i.e. to have an impact on the qualities of the product.²⁵⁷ An example could be white colour used on the product for heat reflection. This traces the concepts of functionality in the other jurisdictions. Secondly, the colour cannot be ornamental in the sense that it conveys a meaning.²⁵⁸ An ornamental colour could be green for organic and bio products. Third criterion is that the colour is not the natural colour of the product or the natural result of the manufacturing of such product, such as terracotta pottery.²⁵⁹ Lastly, there cannot be a proven need for use of different colours in the market sector and the relevant colour naturally desired by other traders, e.g. to demonstrate a certain quality of the product.²⁶⁰ The Federal Court has also considered the colour depletion theory, but concluded that it shall not be an unmitigated obstacle in registration of single colour marks.²⁶¹ Thus, it can be observed that the criteria for registration of single colour trade marks

²⁵⁴ Trade Marks Act 1995 (no. 119), subsection 6(1).

²⁵⁵ *Philmac Pty Limited v The Registrar of Trade Marks* [2002] FCA 1551.

²⁵⁶ [2002] FCA 1551.

²⁵⁷ *Ibid* [65].

²⁵⁸ *Ibid*.

²⁵⁹ *Philmac Pty Limited v The Registrar of Trade Marks* [2002] FCA 1551 [65].

²⁶⁰ *Ibid*.

²⁶¹ *Ibid*.

in Australia overlap with the already studied European, as well as Canadian and USA requirements. Such articulate and clearly expressed requirements are to be exalted, as they greatly contribute towards legal certainty among trade mark applicants and the general public. It would be desirable to expand these specifications also to other types of non-conventional trade marks and thus reduce the ambiguities pertaining them.

As for the other aspects of colour marks, as always, the capacity to distinguish and proper representation are essential. The Australian approach does not offer an innovative approach in these aspects. The one thing worth mentioning is that colour does not have to be represented by a reference to a recognised colour scheme, although this is the preferred representation by the IPA.²⁶² A clear and concise verbal description accompanied with a colour sample is considered adequate as well.²⁶³ Here, it must be observed that although not required in Australia, the reference to a recognised colour coding system is a clearer, more objective and durable representation, which accords with the required level of certainty.

So it can be concluded from the studied jurisdictions that both combination of colours as well as a colour per se are widely included in the registrable subject matter of trade mark protection. A colour per se might be more problematic due to its lack of inherent capacity to distinguish goods and services of one undertaking from those of others and thus distinctiveness acquired through use must be shown. In addition, factors such as proper representation of the colour, its function in the market, interests of other traders to use the specific colour and even aesthetic properties can be considered. Furthermore, it is important to note that in the majority of jurisdictions, the colour must be distinctive on its own and not only in relation to specific packaging.²⁶⁴ Overall, colours seem to be among the least problematic non-conventional signs in terms of their registration, and all the requirements that could prevent the registration are well-founded and justified.

²⁶² IP Australia, 'Trade Marks Office Manual of Practice and Procedure' (15 August 2017, part 21 section 4.1) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017.

²⁶³ Ibid.

²⁶⁴ Colston and Galloway (n 214) 594.

3.4 Three-dimensional marks/shapes

3.4.1 The EU

Three-dimensional or shape marks might encounter two main sets of problems when applying for registration. Firstly, they may lack distinctiveness and secondly, the additional grounds of refusal of shapes set out in article 7(1)(e) of the Community Trade Mark Regulation might apply. Before analysing these in detail, a short explanation shall be made about one issue, although not the most significant for shape marks, and that is the representation of the sign.

Representation of shapes is not problematic due to an established and attainable mode of doing so. Mainly, applicants must be aware that a verbal description of a shape is not satisfactory in the majority of the cases, because it is not sufficiently precise.²⁶⁵ This can be demonstrated by the recent case concerning the appearance of tiles in the well-known word game Scrabble. The Court of Appeal for England and Wales has decided to declare the invalidity of the registration of the three-dimensional tile mark, because of its graphic representation.²⁶⁶ The reason was that the representation was only a verbal description of the sign as ‘*a three-dimensional ivory-coloured tile on the top surface of which is shown a letter of the Roman alphabet and a numeral in the range of 1 to 10*’.²⁶⁷ The Court of Appeal did not find this verbal description clear, precise or objective, because many signs could fit the description and the different combinations and presentation of the tile are boundless.²⁶⁸ This shows why the verbal description of a shape sign is problematic. However, accompanying verbal description with design drawings or photographs can easily overcome this problem.²⁶⁹ Some also suggest that adding the information about dimensions would suffice.²⁷⁰ Therefore, graphically representing a shape should be rather unproblematic.

The need for distinctive character of a mark has more impact than the representation requirement when it comes to registration of shapes. This is connected mainly to the already mentioned consumer perception and the fact that the average consumer can fail to recognise

²⁶⁵ Bently and Sherman (n 1) 893.

²⁶⁶ *J.W. Spear & Son Ltd, Mattel Inc. and Mattel U.K. Ltd v Zynga Inc* [2013] EWCA Civ 1175 [32].

²⁶⁷ *Ibid.*

²⁶⁸ *Ibid.*

²⁶⁹ Bently and Sherman (n 1) 893.

²⁷⁰ Colston and Galloway (n 214) 593.

a shape as an indication of origin of the goods.²⁷¹ What is more, the specific market conditions play a role as well.²⁷² Meanwhile, assessing the distinctiveness or non-distinctiveness of a sign is a question of fact.²⁷³ That is why a test has been developed in order to determine whether the consumer can perceive the shape of the particular goods as different from others, and a shape sign must pass the test in order to be registered as a trade mark.

According to the mentioned test, the shape must fulfil its function of originality by departing significantly from the customs of the specific trade sector.²⁷⁴ This test of ‘significant departure’ is carried out by firstly assessing whether the shape is unusual to the extent that the average consumer would become aware of its uniqueness.²⁷⁵ Secondly, one must determine if the shape would be considered as an indication of its origin or simply a decorative or functional feature by the average consumer.²⁷⁶ Therefore in order for a shape to be registered as a trade mark, it must be different from the ones usually used in the trade sector, as was explained in the *Procter & Gamble* case.²⁷⁷ The ‘*not usually used in the trade sector*’ was also interpreted by the CJEU as meaning that the shape enables the public to positively and immediately identify the product of the trade mark owner from those of other traders.²⁷⁸ In this sense, a shape of a piece of candy that sought application had to be refused, because when compared with the usual shape of sweets in the confectionery trade sector, the applicant’s shape did not depart from ‘*features which come naturally to mind and which are typical of the goods*’.²⁷⁹ Similarly, when Lindt attempted to register the shape of its chocolate rabbit wrapped in gold foil with a bell tied around its neck by a red bow, the CJEU concluded that such a shape is not uncommon in the relevant trade sector and thus was not a significant departure and registration was refused.²⁸⁰ So the first criterion a shape must fulfil in order to be registered is to depart significantly from the shapes that are already common in the relevant trade sector.

²⁷¹ Bently and Sherman (n 1) 936.

²⁷² European Union Intellectual Property Office, ‘Guidelines for Examination of European Union Trade Marks: Part B Examination Section 4 Absolute Grounds for Refusal’ (02/2017, section 7(1)(b)) <<https://goo.gl/VJnEML>> accessed 18 October 2017.

²⁷³ Kitchin D and Kerly DM, *Kerly's Law of Trade Marks and Trade Names* (13th edn, Sweet & Maxwell 2001) 174.

²⁷⁴ C-456-01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089 [39].

²⁷⁵ Bently and Sherman (n 1) 936.

²⁷⁶ *Ibid.*

²⁷⁷ T-63/01 *Procter & Gamble v OHIM* [2002] ECR II-5255 (CFI) [43].

²⁷⁸ C-24/05 P *August Storck* [2006] ECR I-5677 [25].

²⁷⁹ *Ibid* [29-30].

²⁸⁰ C-98/11P *Lindt v OHIM* (24 May 2012) (ECJ, Fourth Chamber) [41]-[49].

However, apart from being significantly different from the shapes of other traders, the shape must also be perceived by the average consumers as an indication of origin of the goods rather than just a technical or ornamental feature of the product.²⁸¹ This condition might prove quite problematic for shape marks and many shapes have failed this requirement in the past. One might get a better understanding of the meaning of this requirement by looking at the failed attempts to register shapes as trade marks and the reasons behind those decisions. In 2005, an application was made for a flower-shaped cheese in the United Kingdom.²⁸² The judge contended that average consumers do not expect the shape of food to be a link to the origin of the product and thus the shape of cheese, however unusual in the food sector, cannot serve the basic trade mark function.²⁸³ Similarly, a glass pattern that resembled the chinchilla fur sought registration as a trade mark for windows and glass showers, but it had to be refused because the design was a purely ornamental feature that would not be seen as a badge of origin by the average consumer.²⁸⁴ As can be seen, the perspective of the relevant public is of crucial importance for shape marks. Even if a sign is descriptive at first, prolonged use of the shape exclusively with the product might become distinctive once the public begins to recognise the shape as associated with the trader. The assessment of the sign's distinctiveness may be challenging because not only does consumer perception change depending on the market practice, but it also varies in different trade sectors. As a result, it cannot be expected that creating an unusual shape of a product is sufficient basis for trade mark registration of such a shape.

It is important to note that assessing the distinctiveness or non-distinctiveness of a sign is a question of fact²⁸⁵ and so the applicant must produce substantial evidence to this end. This might be problematic and time-consuming, but also very expensive. The most common options will be briefly explored here to demonstrate the problems non-conventional signs face in this respect. Firstly, applicants use financial evidence of turnover and expenditure on advertising and promotion as evidence of distinctiveness.²⁸⁶ Although this is one of the easier options, it was observed by judges that these means do not show

²⁸¹ *Philips v Remington* [1999] RPC 809 (CA) 819.

²⁸² *Bongrain's Application* [2005] RPC (14) 306.

²⁸³ *Ibid* [29].

²⁸⁴ C-445/02 P *Glaverbel (Patterned Glass)* [2004] ECR I-6267.

²⁸⁵ *Kitchin and Kerly* (n 275) 174.

²⁸⁶ *Kitchin and Kerly* (n 275) 188.

the distinctiveness of the trade mark, but rather its use.²⁸⁷ So an increase in use or investment in advertising cannot be automatically regarded as increase in distinctiveness. Evidence from trade associations, consumer organisations or even suppliers or distributors can be used, but their persuasiveness rests on the level of their independence.²⁸⁸ Lastly, opinion polls are a widely used source of evidence and can be very effective if they are well-conducted.²⁸⁹ But in some jurisdictions, such as England, they are scrutinised in detail and considered, by some, as possibly unreliable, depending on the execution of the poll, the questions, the body of witnesses etc.²⁹⁰ Therefore, this can add to the problems of the distinctiveness requirement of shape signs, but also non-conventional trade marks in general. So overall, the distinctiveness and function of the three-dimensional signs are the main obstacles their registration. The reasoning behind these obstacles is well-founded, and although shapes might be potent trade marks once they are registered, the registration requirements are suitable for this type of sign.

3.4.2 Other jurisdictions

As for the other jurisdictions, the stance towards three-dimensional signs is comparable with the already outlined European approach, especially in the reasoning behind the approach. In the USA, for example, the two main conditions for registration of shapes as trade marks are non-functionality and distinctiveness, which accord with the European approach. The one distinction worth mentioning might be Australia, where the quality of the sign referred to as functionality in other jurisdictions, is subsumed under more general public interest considerations. Functionality of the sign is assessed by evaluating whether other traders would have a general interest in using the relevant shape for their products.²⁹¹ However, the main reason for other manufacturers to wish to utilise such a shape is its function, it can be concluded that the issue of functionality of a sign is generally prevalent. Rightfully so, providing trade mark protection to functional signs would be outside the realm of trade mark function as an indicator of origin, and could be on the borderline of other intellectual property rights, such as patents. This would be an undesirable development.

²⁸⁷ *British Sugar* [1996] R.P.C. 281 [302].

²⁸⁸ *Kitchin and Kerly* (n 275) 187.

²⁸⁹ *Ibid.*

²⁹⁰ *Ibid.*

²⁹¹ *Lea* (n 12) 45.

When it comes to the representation of the sign, the difficulties are not substantial compared to some of the other studied signs, especially scents or non-musical sounds. The shape signs are visual, and although a representation must be made in two-dimensional form, their visual character is an advantage compared to non-visual signs. The ideal situation for any type of sign is to have a specific set of rules outlining the adequate representation. An example of this can be found in the USA, where special rules are set out for three-dimensional marks. The law recognises a special form drawing, which shows the shape in black on a white background and utilises broken lines in order to depict the placement of the sign or the parts which are not claimed as a trade mark.²⁹² If this is not a satisfactory representation, a description of the sign must be submitted as well.²⁹³ These specific rules and guidance are befitting, as they serve legal certainty and simplify the trade mark application process. It is true that the representation of shape signs is not that challenging compared to some of the previously studied types of signs, yet having clear procedural rules such as those applied in the USA would be beneficial and could be recommended.

²⁹² Trademark Regulations 2005 (37 C.F.R.) para 2.52(b).

²⁹³ Ibid para 2.52(b)(5).

3.6 Other

This subsection of the thesis explores the signs which are most unusual and in some cases fail to be acknowledged as a subject matter of trade mark protection. The studied signs include moving images, holograms, position marks and tactile marks. One must bear in mind that the listed signs must meet the same criteria as the already discussed signs, although they appear more complex and problematic. Most importantly, the signs must be able to fulfil the principal aim of trade marks, which is to serve as an indicator of origin of the goods or services.

3.6.1 Motion marks

Motion mark is a short sequence of images, also known as moving images, and is not as novel as one might presuppose. In fact, the first motion mark was registered in the USA as early as in 1957.²⁹⁴ It comprised of a spinning coin and was applied to the category of banking services.²⁹⁵ However, despite several successful motion mark registrations worldwide, this type of signs faces numerous challenges.

Firstly, there can be difficulties in the formal requirements for the proper representation of the moving image. The motion mark is essentially a series of images and thus graphic and visual. That is why most jurisdictions suggest representation via a set of still photographs combined with a word description. For example, in the USA the USPTO's Trademark Manual of Examining Procedure suggests a drawn representation, which shows either a singular moment of the movement or up to five of these moments depicted by stills.²⁹⁶ The drawing should be accompanied with a detailed written description.²⁹⁷ Similarly, EUIPO has accepted a word description and a set of stills as the means to create a clear, objective and precise representation of a moving image.²⁹⁸ Compared to the USA, the number of still images is unlimited.²⁹⁹ However, it can be difficult

²⁹⁴ Lea (n 12) 42.

²⁹⁵ Ibid.

²⁹⁶ United States Patent and Trademark Office, 'Trademark Manual of Examining Procedure' (October 2017, para 807.11) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/d1e2.html>> accessed 18 October 2017.

²⁹⁷ Ibid.

²⁹⁸ European Union Intellectual Property Office, 'Guidelines for Examination of European Union Trade Marks: Part B Examination Section 4 Absolute Grounds for Refusal' (02/2017, section 2.4) <<https://goo.gl/VJnEML>> accessed 18 October 2017.

²⁹⁹ Ibid.

to characterise a fluent motion by static pictures, which is why some applications for EUTMs have been refused based on ambiguity of the movement and lack of clear connection between the individual images.³⁰⁰ This type of problem has been overcome in the USA by allowing the submission of electronic recordings as a specimen of the moving image.³⁰¹ This approach guarantees the full representation of the motion without the risk of ambiguity.

The recent amendments to European legislation could simplify the representation of moving images and approximate it to the already described USPTO's approach. It was the graphic representation requirement that has deemed written descriptions and sets of stills as the only acceptable means to depict a motion mark. However, with the removal of this requirement, it has been suggested that video files could be submitted with a trade mark application.³⁰² The Board of Appeal has indicated such a possibility in connection with motion marks. More specifically, the Board of Appeal has rejected a recent appeal regarding a motion mark and it advised the applicant to file a new trade mark application which would contain an electronic file.³⁰³ This new approach to representation of moving images would certainly simplify the representation of a motion mark as well as provide a clear, precise and unambiguous representation of the sign.

Despite the possible positive upcoming changes in representation of motion marks, some issues still remain for this type of non-conventional signs. Moving images will most likely be in the category of signs which are not inherently distinctive and therefore acquired distinctiveness will have to be shown. This can prove problematic due to the same reasons as already discussed in relation to the other types of non-conventional signs. Also, in the USA, special emphasis is placed on the non-functionality of the sign, discussed in relation to the previous types of signs.

The growing interest in motion marks and the possible simplification of their registration, especially in the EU, is a positive development. The emergence of technology

³⁰⁰ Cavallo MG, 'Which Is the Future for Movement Trademarks in Europe? A Work in Progress..' (International Lawyers Network IP Insider 2017) <www.ilnipinsider.com/2017/06/which-is-the-future-for-movement-trademarks-in-europe-a-work-in-progress/> accessed 16 October 2017.

³⁰¹ United States Patent and Trademark Office, 'Trademark Manual of Examining Procedure' (October 2017, para 904.03(1)) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/d1e2.html>> accessed 18 October 2017.

³⁰² Andreottola P, 'European Union: What Future after the EU Reforms?' (61 World Trademark Review) <<http://www.worldtrademarkreview.com/Magazine/Issue/61/Country-correspondents/What-future-after-the-EU-reforms>> accessed 16 October 2017.

³⁰³ Cavallo (n 299).

and internet has prompted online marketing and electronic forms of advertising in a greater extent than ever before. Online shopping in particular shows that new ways of approaching the consumers and capturing their interest are developing. In this sense, motion marks demonstrate modern branding. They are a great example of the notion that the developing needs of the market and the perception of consumers might make non-traditional trade marks increasingly important.

3.6.1 Holograms

The defining characteristic of a hologram is that it appears as a three-dimensional image. This means that although visual, a hologram is a sign with slightly problematic nature – the three-dimensional image must be reproduced on two-dimensional application form. Therefore, not only the hologram's capacity to be an indicator of origin but also the potential for proper procedural filing must be taken into account.

Holograms are predominantly non-traditional trade marks, which means that consumers are less aware of its possible function as the manufacturer's identifier. As some suggest,³⁰⁴ this can be problematic when trying to show the sign's acquired distinctiveness. The consumers may, for example, believe that the hologram serves another function on the goods or in relation to services. This has been the case in the USA, where an application was made for a hologram device applied to trading cards.³⁰⁵ The Board believed that the hologram on the cards would be considered as an anti-counterfeiting measure, because holograms are commonly used for this purpose on trading cards as well as other products.³⁰⁶ It was also emphasised that holograms are most frequently used for other reasons than those relating to intellectual property, which means that consumers are probably not going to view the use of a hologram as a trade mark.³⁰⁷ Therefore, the application had to be refused on these grounds. However, the functional problems regarding holograms do not render holograms entirely unregistrable. For example, there are currently three registered

³⁰⁴See, for example, Lea (n 12) 42.

³⁰⁵*In re Upper Deck Co.* 59 U.S.P.Q.2d 1688 (TTAB 2001).

³⁰⁶*Ibid* [1692]-[1693].

³⁰⁷*In re Upper Deck Co.* 59 U.S.P.Q.2d 1688 (TTAB 2001) [1693].

EUTMs comprising a hologram.³⁰⁸ The deciding factor will be what is considered the function of the hologram by consumers of the goods or services in question.

As for the proper representation of a hologram mark, the official guidance is rather limited. The EUIPO's Guidelines for Examination completely omit hologram signs.³⁰⁹ IP Australia only briefly suggests that a precise description of the hologram should be submitted, while also showing the hologram's appearance from different angles.³¹⁰ Maybe the best source of information amidst the lack of official guidelines is the successful hologram registrations. As already mentioned, there are currently three EUTMs comprising a hologram.³¹¹ Although this is not an ample amount of examples, some general common criteria might be extracted nevertheless. Firstly, the description states that the sign is a hologram. Secondly, all the representations contain a word description as well as a single image or drawing showing the appearance of the hologram sign. It could also be induced that the applications depend quite heavily on the images for clear and objective description of the mark. The verbal description seems to be supplementary to the image. The BIO-ACTIVE trade mark³¹² is the most pronounced example of this notion. The description of this registered trade mark is limited to the words '*circular hologram, placed on the top of the packaging*'. The specific appearance of the circular hologram and other characteristics are based solely on the image attached to the application. Therefore, it seems that the representation of the hologram sign should not constitute a major obstacle to its registration. A suitable combination of an image or drawing accompanied with a clear, yet not necessarily exhaustive, word description, are an acceptable form of representation of the hologram.

The rather sporadic nature of hologram marks leads to uncertainty regarding the registration requirements. However, general requirements certainly apply. An attempt was

³⁰⁸ Data according to a search conducted in the EUIPO's online trade mark database in October 2017. The particular holograms can be found under their respective EUTM registration numbers, which are: 001787456, 002559144 and 012383171.

³⁰⁹ European Union Intellectual Property Office, 'Guidelines for Examination of European Union Trade Marks: Part B Examination Section 4 Absolute Grounds for Refusal' (02/2017) <<https://goo.gl/VJnEML>> accessed 18 October 2017.

³¹⁰ IP Australia, 'Trade Marks Office Manual of Practice and Procedure' (15 August 2017, part 21 section 9) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017.

³¹¹ Data according to a search conducted in the EUIPO's online trade mark database in October 2017. The particular holograms can be found under their respective EUTM registration numbers, which are: 001787456, 002559144 and 012383171.

³¹² EUTM registration no. 001787456 owned by Bioclin B.V.

made to show that the formal representation of the hologram might be unproblematic. However, this is not the case with the hologram's function as an indicator of origin of the goods and services. Therefore, the main issue regarding hologram trade marks is that the public is mostly unaware of its use as a trade mark. Until this changes, holograms might be problematic to register as trade marks.

3.6.2 Position marks

The hallmark of position signs is their placement on the goods. Position mark applications often consist of clothing patterns or specifically placed stitching on the clothes, but are predominately unsuccessful.³¹³ The reasons for refusal of their registration shall be considered in this section.

The first obstacle to registration of position signs as trade marks is the lack of their distinctiveness. The failed attempts to register clothing patterns as EUTMs are a good demonstration of this problem. For example, the Board of Appeal has considered a heart shaped stitching placed on the right edge of the trousers' back pocket as lacking distinctiveness.³¹⁴ The Board viewed the heart as a mundane shape, which is in line with other basic forms of ornamentation of clothes. There was no significant difference in the shape or its placement that would stand out compared to the existing decoration in clothes manufacturing and would therefore be simply considered as ornamentation rather than an indicator of origin.³¹⁵ The same reasoning was used in the case of a position mark application for a small rectangular sign "I" placed on the back of clothing.³¹⁶ The Board of Appeal has asserted that such a sign would be considered by consumers merely as a decorative or ornamental feature of the clothing, since stitching is a usual component of clothing and the particular sign was thus in no way distinctive.³¹⁷ It can be observed that a position sign in the area of clothing patterns would have to be of a very unusual character in order to be classified as distinctive and the consumers' attention would have to be called to the sign through intense advertising techniques.

³¹³ Humphreys G, 'Non-Conventional Trade Marks: an Overview of Some of the Leading Case Law of the Boards of Appeal' [2010] 32(9) European Intellectual Property Review 437, 439.

³¹⁴ R-238/2010-2 *Cuore* (Marchio Di Pozizionamento) (16 March 2010).

³¹⁵ *Ibid.*

³¹⁶ R-137/2009-1 *'I'* (*Position Mark*) (16 July 2009).

³¹⁷ *Ibid.*

The same applies to other types of position marks than clothing patterns. Their distinctiveness depends hugely on the consumers' ability to distinguish the commercial origin of the goods based solely on the sign. This requires the sign to be unique, rare and extraordinary compared to the standard in the relevant market sector. For example, it was held that a position mark comprising a blue stripe on the inside of scissor handles was in no way outstanding or rare, on the contrary, other producers offered similar colour and position combinations on their scissors.³¹⁸ So in order to be registered, a position mark would have to distinguish itself from other similar ones and be memorable in a way. Otherwise the trade mark function is not fulfilled.

When it comes to the procedural area, the representation of a position sign should not constitute an insurmountable obstacle to registration. A word description, with a clear statement that the application is for a position mark, with reference to a drawing or a picture, should be a sufficient form of representation. It is crucial to clearly indicate not only the positioning of the sign, but also the goods to which the sign is applied. This was emphasised by the EUIPO when an application was made for a position mark described as a copper ring placed between two layers of other metal constituting a utensil '*like the body of a pot or pan*'.³¹⁹ The description was accompanied with an image, but despite that, the character of the copper ring was considered ambiguous.³²⁰ What is more, the description should be precise and refrain from using examples or be open-ended. Therefore, the description '*like the body of a pot or pan*' lacks precision. However, if an applicant refrains from such vague or example-based word descriptions, the representation of a position mark should be rather unproblematic.

It can be concluded that position marks are relatively easy to represent, especially compared to non-visual or three-dimensional signs, but their function might pose a problem. The position of an element on a product is rarely considered as a manifestation of the commercial origin. It is mostly viewed by public as a functional, decorative or ornamental feature. Therefore, the main challenge for applicants will be to create a unique and memorable sign, not used by other producers in the trade, which is capable of indicating the origin of the product.

³¹⁸ R-1476/2005-1 *Johann Kretzer GmbH & Co.* (Appeal, 5 October 2006).

³¹⁹ EUTM position mark application no. 8316184 (a copper ring on pots and pans).

³²⁰ *Ibid.*

3.6.4 Tactile sign

Tactile signs encompass feel or texture of a product's surface. This type of sign is one of the most unusual and it has not been subject of detailed study by courts or intellectual property offices, which means that general criteria for all types of trade marks must be applied and special requirements for tactile signs deduced.

The tactile sign would have to be distinctive, which means that the particular texture or feel must be uncommon to the trade area. This would apply to all the jurisdictions and was expressly confirmed by the IP Australia.³²¹ Therefore, textures such as silk or leather can never become trade marks when used in the clothing area. It can be seen that texture might be very difficult to function as a trade mark, but not impossible. In the USA, a tactile trade mark has been registered in 2003.³²² The registered texture is described as '*flocked*' and is intended for use on glass bottle labels. The word description is supplemented with a simple drawing of a bottle with straight vertical sides and a label placed on that bottle.³²³ The flocked character of a label can be viewed as an example of an uncommon feature. However, close evaluation of its function must be made. Flocked surface is created by placing stacks of micro particles on it and can be carried out to create friction or reduce light reflection. Such reasons have to be excluded before granting trade mark protection. In this particular case, the drawing of the label is placed on the bottle in such a way that it would not create additional friction when holding the bottle, nor would it reflect light as it is too small in size. Considerations like these will have to be made with all tactile mark applications, in order to rule out the sign's functionality.

When it comes to the representation of the sign, a word description seems the most feasible. It must be noted, that clear, precise and objective word description might be very problematic, because the essence of the sign is not visual. The above example of a USA trade mark might be a rarity, comparable to the handful of previously registered smell marks. Yet it shows that existence of tactile marks is feasible.

³²¹ IP Australia, 'Trade Marks Office Manual of Practice and Procedure' (15 August 2017, part 21 section 10) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017.

³²² Trade mark registration no. 2751476, registered in August 2003, owned by DBA Silkwood Wines.

³²³ Ibid.

4. Alternative ways of protecting non-conventional signs under intellectual property law

After identifying the principal issues regarding the registration of non-conventional trade marks, this section considers whether there are any alternative schemes that could be used to protect the studied types of signs. However, this is not to be seen as a comprehensive analysis, because an in-depth study would exceed the scope of this master's thesis. Instead, this section briefly explores, whether such alternatives exist and consequently, if it would not be more suitable to take advantage of them rather than expand the subject matter of trade mark protection.

The first thing to note about the intellectual property rights is that they differ in their justifications. While trade mark protection is mostly based on economic theories of reduced search cost, protection of consumer choice and quality of the products and services,³²⁴ designs, patents or copyright tend to focus more on the creator. They reward and incentivise creation and labour or safeguard the personality of the author.³²⁵ These justifications create significant differences between the intellectual property rights and have crucial impact on the subject matter of their protection and objectives. Nevertheless, there are instances when an overlap of the rights is possible. Some of these instances shall be considered.

4.1 The relation between three-dimensional marks and design rights

In the area of three-dimensional signs, a connection exists between trade mark protection and design rights. In Europe, a shape might be protected as a design provided that it satisfies the Community Design Regulation.³²⁶ The relevant requirements are novelty and individual character of the design.³²⁷ It is commonly suggested that registered community design is a possible alternative to trade mark protection,³²⁸ but it may not always be the case. Once again, the justifications of the two modes of protection shall be considered. While designs reward originality and aesthetics, trade marks facilitate trade and serve an economic function. That is why it is plausible to have a shape of a product which does not serve as an indicator of origin, because it is not inherently distinctive and no distinctiveness has

³²⁴ Bently and Sherman (n 1) 816.

³²⁵ Norman HE, *Intellectual Property Law: Directions* (Oxford University Press 2014) 336.

³²⁶ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs [2002] OJ L 3/1 (5 January 2002).

³²⁷ *Ibid*, art 4(1).

³²⁸ For example: Wong R, 'EU Trade Mark Regulation 2014' [2014] 19(2) *Communications Law* 56, 58.

been acquired through use, yet the fact that it has not been used makes it new and the shape has individual character. In that case, the shape could become a registered Community design. However, the common requirement of both the studied systems is the non-functionality of the shape. But it must be noted that the understanding of functionality differs. Non-functionality of the design refers solely to the prohibition of a technical function,³²⁹ while trade mark law also prohibits other shapes, like those that add substantial value to the goods.³³⁰ As a consequence of this distinction, a shape that is refused trade mark registration on absolute grounds could potentially become a design.

4.2 Scents and protection under copyright law, patents or trade secrets

There is one type of industry that notably endeavours to protect scents in alternative ways and therefore serves as a good example for this part of the study – the perfume industry. Perfumes cannot be registered as trade marks based on functionality grounds, which is why the industry has attempted to protect scents by other means, for example copyright. First of all, it must be pointed out that the European copyright law is not harmonised to the same level as trade mark law and more importantly, the specific area in question, which is the concept of an intellectual work, falls under the area that has not been harmonised.³³¹ As a result, a difference of opinion has emerged. While the Supreme Court of the Netherlands understood the term ‘intellectual work’ more generally and included scents, the French Court of Cassation has denied copyright protection of scents.³³² The latter also seems to be the prevalent view, because granting copyright protection to smells creates barriers in the European internal market.³³³ The obstacle lies in the fact that in the Netherlands, perfumes can only be placed on the market with the authorisation of the copyright owner and thus hindering the free movement of goods.³³⁴ Such an obstruction of free trade is undesirable and thus it is unlikely that copyright protection of smells will become widespread in the future.

³²⁹ Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs [2002] OJ L 3/1 (5 January 2002) art 8(1).

³³⁰ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance) OJ L 154, art 7(1)(e)(iii).

³³¹ Hernandez and Perez (n 132) 671.

³³² Ibid 670.

³³³ Ibid.

³³⁴ Ibid.

The second alternative way of protection of smells could be a patent. The Convention on the Grant of European Patents of 5 October 1973 grants protection to inventions that are new, involve an inventive step and are susceptible of industrial application.³³⁵ This definition of protectable subject matter is in itself a sufficient indication that only a very small subset of smells could be granted patent protection. Considering the types of scents that have been discussed in part 3.2 of this thesis, one could conclude that they would not fulfil the novelty requirement set out for patents. This is because they were common scents such as freshly cut grass, a ripe strawberry or a cinnamon smell. Unless the smell is new, there is very little chance of patent protection. An example of such new scents can be found, again, in the perfume industry. Perfume manufacturers sometimes apply for patent protection of new smell molecules, which are then used exclusively in their own products.³³⁶ However, there are two main disadvantages to patent protection of a smell. Firstly, what is protected is not the perfume as a whole, but rather one or more molecules that are contained within the product as such. And secondly, the manufacturer needs to disclose the compound structure of their invention.³³⁷ As a result, while it is possible to seek patent protection of a scent, the disadvantages outweigh the positives. In addition, patent protection covers only new smells, which could be problematic.

In order to avoid the problem of disclosure of compound structures, the manufacturers could opt for protecting the smell as trade secrets. Trade secrets are protected in the member states of the World Trade Organisation under the TRIPS Agreement in article 39. According to this article, protection is offered to secret undisclosed information that has commercial value and reasonable steps have been taken in order to maintain its secrecy. Consequently, dishonest acquisition, disclosure and use of such trade secret, without the owner's consent, can be stopped.³³⁸ However, the actions must be dishonest. This means that a particular fragrance could be reverse-engineered or acquired through one's own research and thus the others would be entitled to use it and such actions would not constitute a breach of a trade secret.³³⁹ Another disadvantage of trade secrets is that they are more problematic to enforce than a patent and the level of protection differs in each country and is mostly weak compared

³³⁵ Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973, art 52.

³³⁶ Hernandez and Perez (n 132) 672.

³³⁷ Ibid.

³³⁸ TRIPS Agreement, art 39.

³³⁹ Hernandez and Perez (n 132) 672.

to protection through a registration system, such as a patent or a trade mark.³⁴⁰ And finally, once the secret is revealed to the public, it can be used freely by anyone.³⁴¹ Therefore, although protection of information in the form of trade secrets is an acceptable alternative for olfactory signs, it is rather disadvantageous and serves different purpose than that of a trade mark.

4.3 Other signs and intellectual property law as a whole

There are several other alternative modes of protection of non-conventional signs. In common law jurisdictions, the passing-off is a common law cause of action, which protects consumers from confusion about the source of the goods or services.³⁴² It is an action that does not require registration and the nature of the sign is irrelevant, which means that even smell, sounds or any other type of sign could be protected through a passing-off action.³⁴³ However, there are disadvantages to this alternative. Most importantly, there is a great burden of proof associated with the action. The trader is required to prove that the consumers have indeed been confused by the other trader's misrepresentation and also prove the resulting loss.³⁴⁴ This can be a difficult endeavour. Therefore, trade mark law offers better protection, is easier to enforce and it is understandable why common law traders prefer it to the action of passing-off.

Another type of sign worth mentioning is a sound. Original musical sounds could be easily protected under copyright law. However, the same does not have to apply to non-musical sounds, which are often sounds found in nature or otherwise common. These would lack the required originality. Another disadvantage of the copyright protection regime is its limited duration. While trade mark registration can be essentially renewed indefinitely, provided that the mark is used, copyright protection is terminable. So it can be seen as a good supplementary protection of musical sounds, but not ideal on its own.

Given all of the above, designs, patents, copyright and even trade secrets or passing-off action could serve as alternative means of protection of non-conventional signs. However,

³⁴⁰ World Intellectual Property Organization, 'Patents or Trade Secrets?' <http://www.wipo.int/sme/en/ip_business/trade_secrets/patent_trade.htm> accessed 15 October 2017.

³⁴¹ Ibid.

³⁴² Press T, *Intellectual Property Law Concentrate* (2nd edn, Oxford University Press 2015) 151.

³⁴³ McGinnis K, 'Whether Sound Marks Can and/or Should Be Registered as Trade-marks in Canada' [2005] 19 I.P.J. 117, 143.

³⁴⁴ Press (n 343) 151.

the protection is rather limited and the methods pursue different aims than trade marks. As a result, the studied alternatives do not serve as substitutes or equivalent measures. The identified disadvantages are also a clear reason for the current preference of trade mark protection. Understandably so, the economic justifications of trade mark law seem to make it better suited for brand management than for example copyright or trade secrets.

5. Conclusion

The main objective of this thesis was to identify the difficulties that hinder registration of non-conventional signs and the reasons behind those hurdles. Emphasis was placed on the legislation of the EU, but USA, Canada and Australia have been studied as well, with the aim of providing a diverse view on the topic and, if applicable, offer solutions. It was identified that the studied jurisdictions enact non-exhaustive lists of signs that can constitute trade marks. This is considered an appropriate approach, because it reflects and enables the development of trade mark law. However, it does not create a boundless set of subject matter. Instead, additional requirements limit the protectable subject matter and were the vital aspect of the study, because they create the limitations for non-conventional signs. It is argued that there are two main requirements that hinder the registration of non-conventional signs. Firstly, making a proper representation of a sign, especially in case of non-visual signs, such as sounds and scents, poses a problem. Secondly, non-conventional trade marks generally lack inherent distinctiveness and therefore acquired distinctiveness must be proven. This may require extensive advertising as well as arduous proof of consumer recognition. Consequently, each type of non-conventional sign has been studied individually in order to do justice to its specific nature.

The recent amendments to the European Trade Mark Directive and Regulation have been taken into account. It was argued that the graphic representation has three well-established functions – definitional, bureaucratic and informational. It is put forward that these functions do not change regardless of omitting the word ‘graphic’ from the representation of a sign. The representation might now include other non-graphic technological means, such as musical recordings or videos, but these new technological means must fulfil the representation functions and guarantee certainty. This is considered a suitable development, which offers more flexibility, yet preserves the legal certainty. The types of signs which might benefit from this amendment are mainly sounds and motion marks. Allowing sound recordings, that would be publicly available in the online trade mark database and accompanied with a word description, would be a suitable approach already effective in other jurisdictions, as shown by Australia. On the other hand, it is highly unlikely that the amendment would result in a drastic change of approach towards scents. The reason lies in the lack of any suitable form of representation, graphic or otherwise. Smell has been shown as the most subjective sensory perception. It was shown that various factors,

for example the gender and sensitivity of the person or the concentration of the scent play a role in the recognition of smells. It is thus very problematic to determine what the perception of an average consumer would be or to design a consistent scent representation and recognition system. However, the precise effect of the amended legislation is yet to be determined, especially by further rules set out by the EUIPO and CJEU over time.

The last part of the thesis has briefly explored alternative methods of protecting non-conventional signs. It was established that designs, patents and even trade secrets or common law passing-off action could serve as alternative means of protection of certain types of non-conventional signs. However, disadvantages of these methods as well as their justifications show that the preference of trade mark protection is understandable.

This thesis has attempted to show that trade mark law is an ever-changing area of intellectual property law and thus, what might be considered non-conventional now, can become the norm in a few years. It seems that advertising and marketing, in particular, strive to develop new methods to grab consumers' attention. Brand management does not rely on purely visual traditional signs anymore. As a result, new types of signs are used to enhance brand identity and the subject matter of trade mark protection expands. The trend to create new flashy forms of advertising is becoming more apparent, not only in the studied non-conventional trade marks, but even in the area of traditional trade marks. Recently, the concept of fluid trade marks has been introduced, which are those that slightly change their format, such as the Google logo as it appears in the search engine.³⁴⁵ This emerging trend of fluid marks has been labelled by some as 'the wave of the future'³⁴⁶ and it is a good demonstration that trade mark law is constantly evolving, regardless of the type of sign. It is my belief that this is a natural and welcome phenomenon, as long as the main function of trade marks, to indicate the origin of the product or the service, is preserved. The evocative power of a scent or the unique texture of an object can be beneficial for consumers as well as traders, they can reduce search costs and increase market efficiency. However, if the sign fails to benefit the public in these ways, but rather creates confusion in terms of its function, the interests of consumers should outweigh the interests of traders and lobbyists. The position marks in clothing industry could serve as an example of such confusion. In addition, new types of trade marks can not detract from established legal certainty. Provided that all

³⁴⁵ Pearson L, 'How Fluid Trade Marks Can Enhance Your Brand' [2008] *Managing Intellectual Property* 44, 44.

³⁴⁶ *Ibid.*

of the above mentioned concerns are taken into account, the expansion of trade mark subject matter is encouraged.

6. Bibliography

Legislation

Act no. 441/2003 Coll., on Trade Marks (CZE)

Agreement on Trade Related Aspects of Intellectual Property Rights, dated 15 April 1994 as Annex 1C (WIPO); published in the Czech Republic as no. 191/1995 Coll.

Convention on the Grant of European Patents (European Patent Convention); dated 5 October 1973

Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs [2002] OJ L 3/1 (5 January 2002)

Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [1994] OJ L 011/1 (14 January 1994)

Directive (EC) 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L 299/25 (8 November 2008)

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L 336 (23 December 2015)

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Text with EEA relevance) OJ L 154

Singapore Treaty on the Law of Trade Marks (WIPO); dated 28 March 2006

Trademark Law Treaty, dated 27 October 1994 (WIPO); published in the Czech Republic as no. 199/1996 Coll.

Trademark Act 1946 (15 U.S.C.) (USA)

Trademark Regulations 2005 (37 C.F.R.) (USA)

Trade Marks Act 1995 (no. 119) (AUS)

Trade Marks Regulations 1995 (SR 1995 No. 341) (AUS)

Trade-marks Act R.S.C., 1985, c. T-13 (CAN)

Trade Marks Act 1875 (GBR)

Cases

Bongrain's Application [2005] RPC (14) 306

British Sugar [1996] R.P.C. 281

Brunswick Corp v British Seagull Ltd 35 F.3d 1527 (Fed Cir 1994)

C-24/05 P *August Storck* [2006] ECR I-5677

C-49/02 *Heidelberger Bauchemie GmbH v Deutsches Patent und Markenamt* [2004] ECR I-6129

C-98/11P *Lindt v OHIM* (24 May 2012) (ECJ, Fourth Chamber)

C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793; [2005] 2C.M.L.R. 45

C-273/00 *Ralf Sieckmann v Deutsches Patent und Markenamt* [2002] ECR I-11737

C-283/01 *Shield Mark BV v Joost Kist* [2003] ECR I-14313

C-321/03 *Dyson Ltd v Registrar of Trade Marks* [2007] ECR I-687

C-404/02 *Nichols v Registrar* [2004] ECR I-8499

C-445/02 P *Glaverbel (Patterned Glass)* [2004] ECR I-6267

C-456-01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089

Ciba-Geigy Canada Ltd. v. Apotex Inc. [1992] 3 S.C.R. 120

In re Clarke 17 USPQ2d 1238 (TTAB 1990)

In re NV Organon, 79 USPQ2d 1639 (TTAB 2006)

In re Pohl-Boskamp GmbH & Co 106 USPQ2d 1042 (TTAB 2013)

In re Upper Deck Co. 59 U.S.P.Q.2d 1688 (TTAB 2001)

J.W. Spear & Son Ltd, Mattel Inc. and Mattel U.K. Ltd v Zynga Inc [2013] EWCA Civ 1175

Philips v Remington [1999] RPC 809 (CA) 819

Philmac Pty Limited v The Registrar of Trade Marks [2002] FCA 1551

Playboy Enterprises Inc v Germain [1987] 13 F.T.R. 178

R-137/2009-1 'I' (*Position Mark*) (16 July 2009)

R-1457/2007-1 *Estee Lauder v Cofinluxe* (Appeal, 23 October 2008)

R-1476/2005-1 *Johann Kretzer GmbH & Co.* (Appeal, 5 October 2006)

R-156/1998-2 *Vennootschap Onder Firma Senta* [1999] E.T.M.R. 429

R-186/2000-4 *Institut pour la Protection des Fragrances (IPF)'s Community Trade Mark Application* [2005] E.T.M.R. 42.

R-238/2010-2 *Cuore* (Marchio Di Pozizionamento) (16 March 2010)

R-708/2006-4 *Edgar Rice Burroughs, Inc.* [2007]

R-711/1999-3 *Myles Ltd's Community Trademark Application* [2003] E.T.M.R. 56

R-781/1999-4 *MGM Lion Corporation* [2004] *ETMR* (34) 480

Smith Kline & French Canada Ltd. v Canada (Registrar of Trade Marks) [1987] 2 F.C. 628

Société des Produits Nestlé SA v Cadbury UK Ltd [2013] *EWCA Civ* 1174

Qualitex Co v Jacobson Products Co Inc 514 US 159 (1995)

T-16/00 *Viking-Umwelttechnik GmbH v OHIM* [2002] ECR II-3715

T-63/01 *Procter & Gamble v OHIM* [2002] ECR II-5255 (CFI)

T-173/00 *KWS Saat AG v. OHIM* [2002] ECR II-3843

T-305/04 *Eden SARL v OHIM* [2005] ECR II-4705

Two Pesos, Inc. v. Taco Cabana, Inc. 112 S. Ct. 2753, 2758 (1992)

Ty Nant Spring Water Ltd's Trade Mark Application [2000] R.P.C. 55

Books

Bently L and Sherman B, *Intellectual Property Law* (4th edn, Oxford University Press 2014)

Colston C and Galloway J, *Modern Intellectual Property Law* (3rd edn, Routledge 2010)

Cook TM, *EU Intellectual Property Law* (Oxford University Press 2010)

Cornish WR, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (4th edn, Sweet and Maxwell 1999)

Hák J, *Známkové Právo v Mezinárodních Souvislostech* (Vydavatelství a nakladatelství Aleš Čeněk 2012)

Horáček R, Čada K and Hajn P, *Práva k Průmyslovému Vlastnictví* (C.H. Beck 2011)

Jakl L, *Národní, Mezinárodní a Regionální Systémy Ochrany Průmyslového Vlastnictví* (2nd edn, Metropolitan University Prague Press 2014)

Kitchin D and Kerly DM, *Kerly's Law of Trade Marks and Trade Names* (13th edn, Sweet & Maxwell 2001)

Norman HE, *Intellectual Property Law: Directions* (Oxford University Press 2014)
Press T, *Intellectual Property Law Concentrate* (2nd edn, Oxford University Press 2015)
Vojčík P, *Právo Duševného Vlastníctva* (Vydavateľstvi a nakladateľstvi Aleš Čeněk 2012)

Journal articles

Ahuja VK, 'Non-Traditional Trade Marks: New Dimension of Trade Marks Law' [2010] 32(11) *European Intellectual Property Review* 575

Hernandez C and Perez M, 'The Possibility of IP Protection for Smell' [2014] 36(10) *European Intellectual Property Review* 665

Humphreys G, 'Non-Conventional Trade Marks: an Overview of Some of the Leading Case Law of the Boards of Appeal' [2010] 32(9) *European Intellectual Property Review* 437

Jaconiah J, 'The Requirements for Registration and Protection of Non-Traditional Marks in the European Union and in Tanzania' [2009] 40(7) *International Review of Intellectual Property and Competition Law* 756

Khoury AH, 'Three-Dimensional Objects as Marks: Does a "Dark Shadow" Loom Over Trademark Theory?' [2008] 26 *Cardozo Arts and Entertainment Law Journal* 335

Kur A, 'The EU Trademark Reform Package - (Too) Bold a Step Ahead or Back to Status Quo?' [2015] 19 *Marquette Intellectual Property Law Review* 15

Lea GR, 'Special Marks: After 20 Years, not so Special After All?' [2015] 20(2) *Communications Law* 40

Mackie V, 'Scent Marks the Future of Canadian Trade-Mark Law' [2005] 18 *Intellectual Property Journal* 417

McGinnis K, 'Whether Sound Marks Can and/or Should Be Registered as Trade-marks in Canada' [2005] 19 *I.P.J.* 117

Pearson L, 'How Fluid Trade Marks Can Enhance Your Brand' [2008] *Managing Intellectual Property* 44

Provost M-J, 'Canada's Current Position With Respect To Sound Marks Registration: A Need For Change?' [2010] 8 *Canadian Journal of Law and Technology* 31

Sahin O, 'The Past, the Present and the Future of Colour and Smell Marks' [2016] 38(8) *European Intellectual Property Review* 504

Samtani A and others, 'Smell Marks - a Singapore Study and the Implications for the Commercial Use and Exploitation of Non-Traditional Trade Marks' [2009] 40(6) *International Review of Intellectual Property and Competition Law* 698

Turner-Kerr P, 'Trade Mark Tangles: Recent Twists and Turns in EC Trade Mark Law' [2004] 29(3) European Law Review 345

Vaver D, 'Unconventional and Well-Known Trade Marks' [2005] Singapore Journal of Legal Studies 1

Visintine LR, 'The Registrability of Color Per Se as a Trademark after Qualitex Co. v Jacobson Products Co.' [1996] 40 Saint Louis University Law Journal 611

Wong R, 'EU Trade Mark Regulation 2014' [2014] 19(2) Communications Law 56

Zdvihalová M, 'Definiční Vymezení Institutu Ochranné Znamky dle Právniho Řádu České Republiky, Evropské Unie a Spojených Států Amerických' [2017] 2 Průmyslové vlastnictví 37

Online journals and other

Andreottola P, 'European Union: What Future after the EU Reforms?' (61 World Trademark Review) <<http://www.worldtrademarkreview.com/Magazine/Issue/61/Country-correspondents/What-future-after-the-EU-reforms>> accessed 16 October 2017

Anosmia Foundation of Canada, 'How many people suffer from anosmia?' (2003) <<http://www.anosmiafoundation.com/suffer.shtml>> accessed 15 October 2017

Boija Consulting, 'Scent Communications' <<https://scentcom.se/en/>> accessed 16 October 2017

Canadian Intellectual Property Office, 'Practice note: Trademark consisting of a sound' (28 March 2012) <www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03439.html> accessed 30 October 2017.

Cavallo MG, 'Which Is the Future for Movement Trademarks in Europe? A Work in Progress..' (International Lawyers Network IP Insider 2017) <www.ilnipinsider.com/2017/06/which-is-the-future-for-movement-trademarks-in-europe-a-work-in-progress/> accessed 16 October 2017

European Commission, 'Trade Marks: Commission Proposes Easier and More Effective Protection' (European Commission Press Release Database, 27 March 2013) <http://europa.eu/rapid/press-release_IP-13-287_en.htm?locale=en> accessed 18 October 2017

European Union Intellectual Property Office, 'Decision No. EX-05-3 of the President of the Office of 10 October 2005 concerning electronic filing of sound marks' (10 October 2005) <<http://euipo.europa.eu/en/office/aspects/pdf/ex05-3.pdf>> accessed 20 October 2017

European Union Intellectual Property Office, 'Guidelines for Examination of European Union Trade Marks: Part B Examination Section 4 Absolute Grounds for Refusal' (02/2017) <<https://goo.gl/VJnEML>> accessed 18 October 2017

Hodson H, 'Smell-o-vision screens let you really smell the coffee' (New Scientist, 26 March 2013) <<https://goo.gl/tQ3TKu>> accessed 15 October 2017

IP Australia, 'Trade Marks Office Manual of Practice and Procedure' (15 August 2017) <http://manuals.ipaustralia.gov.au/trademarks/trade_marks_examiners_manual.htm> accessed 18 October 2017

Keri SJ, Burkinshaw J and Langworthy EA, 'Moving with the Times: Motion Marks in Canada and the United States' (International Trademark Association Bulletin 2011) <www.inta.org/INTABulletin/Pages/MovingwiththeTimesMotionMarks.aspx> accessed 16 October 2017

Max Planck Institute for Intellectual Property and Competition Law, 'Study on the Overall Functioning of the European Trade Mark System' (15 February 2011) <www.ip.mpg.de/fileadmin/IP/pdf2/mpi_final_report_with_synopsis.pdf> accessed 18 October 2017

Pantone LLC, 'Find a PANTONE color' (2017) <<https://www.pantone.com/color-finder>> accessed 16 October 2017

United States Patent and Trademark Office, 'Trademark Manual of Examining Procedure' (October 2017) <<https://tmep.uspto.gov/RDMS/TMEP/current#/current/d1e2.html>> accessed 18 October 2017

World Intellectual Property Organization, 'Patents or Trade Secrets?' <http://www.wipo.int/sme/en/ip_business/trade_secrets/patent_trade.htm> accessed 15 October 2017

7. Abstract (Eng)

The submitted master's thesis discusses non-conventional signs and trade marks, which have grown in significance, especially from the perspective of marketing, traders and law, as was demonstrated by the recent amendments of the European trade mark law. The main aim of this thesis is to identify the particularities of non-conventional signs and obstacles to their registration from the perspective of the selected jurisdictions and consequently, to evaluate the reasons and justifications of the countries' approach. After a historical overview of trade mark functions and the development of law in the studied jurisdictions, the thesis is concerned with outlining the theoretical legal basis of trade mark protection in the European Union, Canada, Australia and the United States of America. The main focus of the thesis lies in the specific effects of the law on the individual types of non-conventional signs and trade marks, with a particular emphasis on the decisions of offices and courts, especially the Court of Justice of the European Union. The analysis includes sounds, scents, shapes and colours, as well as motion marks, holograms, position marks and tactile signs. The main part of the thesis is subdivided into several sections in order to grasp the particularities and singularities of each type of non-conventional signs. Each section deals primarily with two aspects, which are the most frequent cause of registration refusal, and that is the question of sign's distinctiveness and the options for its representation. While discussing the proper representation requirement, the thesis pays attention to the aforementioned European law amendment resulting from the 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 mark, which abolishes the graphic representation requirement. The thesis attempts to estimate the effects of the amendment on the studied types of marks and their registration. The last chapter is dedicated to a brief overview of alternative modes of protection of certain signs and an evaluation of their expediency.

8. Abstrakt (ČJ)

Tato diplomová práce pojednává o netradičních označeních a ochranných známkách, které se stále více dostávají do popředí zájmu marketingu, obchodníků a také práva, o čemž svědčí i nedávná novela evropského práva ve věci ochranných známek. Hlavním cílem diplomové práce je identifikovat specifika těchto netradičních označení a překážky jejich registrace z pohledu vybraných jurisdikcí a následně zhodnotit důvody a opodstatněnost přístupu jednotlivých zemí. Po historickém nástinu funkcí ochranných známek a vývoje právní úpravy ve vybraných zemích, se práce zabývá vylíčením teoretického právního základu známkoprávní úpravy v Evropské unii, Kanadě, Austrálii a Spojených státech amerických. Jádrem práce se pak zaměřuje na konkrétní dopady právní úpravy na jednotlivé druhy netradičních označení a ochranných známek, a to především v souvislosti s rozhodovací praxí úřadů a soudů, zejména Soudního dvora Evropské unie. Analýza se věnuje zvukovým, čichovým a prostorovým ochranným známkám a známkám tvořeným výlučně barvou, a také známkám pohybovým, hologramům, označením pozice a hmatovým označením. Jádrem práce je členěno na několik částí, jelikož diplomová práce usiluje o zachycení osobitosti a specifík jednotlivých typů netradičních známek. Každá část se věnuje zejména dvěma hlediskům, která jsou nejčastější překážkou registrace netradičních označení, a to otázce rozlišovací způsobilosti daného označení a možnosti jeho znázornění. U požadavku adekvátního znázornění věnuje práce pozornost také výše uvedené novele evropského práva vyplývající z nařízení Evropského parlamentu a Rady (EU) 2015/2424, kterým se mění nařízení Rady (ES) č. 207/2009 o ochranné známce Společenství a nařízení Komise (ES) č. 2868/95, kterým se provádí nařízení Rady (ES) č. 40/94 o ochranné známce Společenství, která uvedený požadavek na grafické znázornění ochranné známky de facto zrušila. Práce usiluje o odhad možných dopadů této novely na zkoumané typy označení a na proces jejich registrace. Před samotným závěrem se práce věnuje stručnému nástinu alternativních prostředků právní ochrany vybraných typů označení a zhodnocení jejich účelnosti.

Title of the Master's Thesis:

Non-conventional signs and trade marks

Keywords:

Non-conventional trade marks, trade mark registration, distinctiveness, graphic representation

Název diplomové práce:

Netradiční označení a ochranné známky

Klíčová slova:

Netradiční ochranné známky, zápis ochranné známky, rozlišovací způsobilost, grafické znázornění