

FACULTY OF LAW
Stockholm University

**NON-TRADITIONAL TRADE
MARKS AND THE ABOLITION OF
THE REQUIREMENT FOR
GRAPHICAL REPRESENTATION**
- EU Trade Mark Registration Process

Yaroslava Kudrina

Master's Thesis, 30 ECTS
Examiner: Per Jonas Nordell
Stockholm, Spring 2018



Abstract

Traditional trade marks, such as words and figures, have for a long time constituted of visual signs. However, due to the evolution of modern technology and changing marketing methods, non-traditional trade marks have been increasing in today's highly competitive market.¹ Consequently, the evolution created legal uncertainties in the European Union (EU) since in order to register a trade mark, it had to be represented graphically. This requirement was difficult to achieve for some non-traditional trade marks which were perceived through other senses than the sight.

On the 1 October 2017, requirement for graphical representation has been amended in the EU Trade Mark Regulation 2017/1001² by a technical neutral requirement which opens up possibilities for registration of European Union trade marks in a more suitable way, using generally available technology.

The purpose of this thesis has been to analyse how the abolition of graphical representation and the new wider requirement will affect the registration of non-traditional trade marks in the EU. Signs which have been analysed in the frame of this thesis are: sound, olfactory, three-dimensional, colour, motion, multimedia, holograms, pattern, tactile and taste marks.

Conclusively, I found that the technical neutral registration requirement has opened up possibilities for trade mark holders to register new types of marks like multimedia marks. Moreover, it has simplified the registration process for already accepted non-traditional trade marks such as hologram, motion and sound marks. However, the reform has hardly affected the registration process of colour, pattern and three-dimensional marks since their biggest challenge with the registration have been the requirement for distinctiveness. Furthermore, it is currently still not possible to register olfactory, tactile and taste marks. Though the new and flexible amendments indicate that those types of marks may be more easily registered in the future.

¹ Statistics of European Union Trade Marks.

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

Table of contents

Abstract	2
Abbreviations	5
1. Introduction	6
1.1 <i>Background</i>	6
1.2 <i>Statement of purpose and the research questions</i>	7
1.3 <i>Methodology and material</i>	7
1.4 <i>Delimitations</i>	9
1.5 <i>Disposition</i>	10
2. Legal background	12
2.1 <i>Traditional and non-traditional trade marks</i>	12
2.2 <i>European Union trade mark law</i>	14
2.3 <i>Abolition of the requirement for graphical representation</i>	15
2.4 <i>EUTM registration requirements</i>	17
2.4.1 <i>The requirement for distinctiveness</i>	18
2.4.2 <i>The requirement for representation</i>	19
3. The practical requirement and the effects of the Sieckmann case	20
4. The past and the future of the non-traditional trade marks	23
4.1 <i>Non-traditional trade marks</i>	23
4.1.1 <i>Sound marks</i>	23
4.1.2 <i>Olfactory marks</i>	27

4.1.3 Three-dimensional marks	32
4.1.4 Colour marks	34
4.1.5 Less traditional marks	36
<i>4.2 Who is affected by the reform?</i>	<i>39</i>
4.2.1 The legislator	40
4.2.2 The owner of the trade mark	40
4.2.3 The user of the trade mark	42
4.2.4 The competitor	42
<i>4.3 Effects of the reform for the non-traditional trade marks</i>	<i>43</i>
4.3.1 Which problems will be eliminated due to the reform?	43
4.3.2 What problems will remain?	43
4.3.3 What new problems may arise and how can they be solved?	44
5. Conclusion and the final comments	47
Bibliography	50

Abbreviations

BOA	Board of Appeal
ECJ	European Court of Justice
EU	European Union
EUIPO	European Union Intellectual Property Office
EUTM	European Union Trade Mark
EUTMR	Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark
EUTMDR	European Trade Mark Delegated Regulation
EUTMIR	European Trade Mark Implementing Regulation
IP	Intellectual Property
MPI	Max-Planck Institute for Intellectual Property and Competition Law
OHIM	Office for Harmonization in the Internal Market
TMD	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
TMS	Study on the Overall Functioning of the European Trade Mark System

1. Introduction

1.1 Background

Traditional trade marks,³ have for a long time consisted of two-dimensional word, logo and figurative marks.⁴ The law has favoured those marks, which made it harder for non-traditional trade marks⁵, such as sound, three-dimensional, colour, olfactory and position trade marks etc. to compete on the same grounds. The reason behind those difficulties was the requirement for graphical representation. A change had to be made in order to bring trade mark law up to speed with the digitalization and constantly upgrading marketing methods. This has led to the recent amendments in the European Union (EU) trade mark law. Therefore, this thesis addresses both the national and the EU legal audience interested in the new reform as well as the brand⁶ owners.

EU trade mark case law demonstrates that many trade mark holders have tried to fulfil the requirement for graphical representation by applying different interpretations. Some marks became more widely accepted, like three-dimensional and colour marks, while others were more difficult to register, like sound and olfactory marks. This created legal uncertainty in the registration process. Mainly because the EU courts' jurisprudence, especially of the General Court, has repeatedly stated that all marks should be treated in the same way, independently of how those are communicated and perceived.⁷

Beginning 1 October 2017, it is not longer necessary for a European Union Trade Mark (EUTM) to be represented graphically in order to obtain registration. Instead, a wider requirement states that the representation must be made in 'a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection'.⁸ This means that registration can be made in any appropriate form using

³ Notice that 'trademark', as one single word, is the spelling used in the United States legislations while the EU legislations use the term 'trade mark' as two separate words. The EU spelling will be further used in this thesis.

⁴ Sahin, 504.

⁵ Different expressions are used for the non-traditional trade marks such as unconventional, exotic, new, extraordinary etc. I believe that the term 'non-traditional' is the clearest expression and therefore this term will be used in the present work.

⁶ In speaking language, the term 'brand' and 'trade mark' are used as substitutes. However, legally only the second one has legal protection while the first one represents the public image of the company by a mark or a sign.

⁷ Sandri & Rizzo, 38.

⁸ Article 4 European Trade Mark Regulation (EU) 2017/1001.

generally available technology, which opens up possibilities for the non-traditional trade mark holders to register signs in a more suitable way.

1.2 Statement of purpose and the research questions

The purpose of this thesis is to analyse the ways in which the abolition for graphical representation, together with the new wider requirement of the European Trade Mark Regulation (EU) 2017/1001 will affect registration of the non-traditional trade marks at the European Union Intellectual Property Office (EUIPO), which holds responsibility for registering and administering EUTMs and eventually in the EU Member States after harmonization of the Trade Mark Directive (EU) 2015/2436.

In order to achieve this purpose, the following research questions will be answered:

1. What are the reasons behind the amendments to the EU legislations?
2. How were the non-traditional trade marks registered prior to the abolition of graphical representation and how will they be affected in the future?
3. Which problems will be eliminated, will remain and may arise due to the amended regulations?

The thesis aims to create a broader understanding for the amended registration requirement and the possible future outcomes.

1.3 Methodology and material

In order to answer the posed research questions, the dogmatic legal method and the EU-legal method will be used. These methods provide the most suitable approach to the stated questions. This is firstly because the dogmatic legal method analyses and systematizes legal rules.⁹ The systematization means that the relationships, similarities and principles are identified and examined. Only generally accepted legal rules such as legislations and its history, case law and doctrine are used to define the law and answer the legal questions. Secondly, because the EU-legal method is a teleological and a systematic method which means that the provisions must be interpreted in the light of their purpose.¹⁰ The overall

⁹ Sandgren, 43.

¹⁰ Hetne & Eriksson, 36. See also Korling & Zamboni, 122.

purpose for the EU has been to create an internal market, while the case law demonstrates how the EU courts have been forcing the law to adjust to these goals.

Case law is therefore essential to analyse, since it explains how EU law should be interpreted by the Member States. For example, the case of *Sieckmann* will be closely studied since it is one of the most important cases that discusses the requirement for the graphical representation for non-traditional trade marks.

Furthermore, EU regulations and directives are studied. This is because according to the principle of supremacy EU regulations and directives prevail over the Member States national law.¹¹ Regulations have a general application and are binding in their entirety to all EU Member States.¹² Regulations address individuals which means that the Member States courts and authorities must directly apply the provisions of a regulation if an individual invokes them.¹³

Since the purpose of this thesis is to analyse registration of a EUTM, the main focus lays on the European Trade Mark Regulation 2017/001 (EUTMR) as well as on the European Trade Mark Implementing Regulation (EUTMIR) and the European Trade Mark Delegated Regulation (EUTMDR). EUTMR establishes a stand-alone system for registration of a EUTM, with the rules that are equally and directly applicable to the law in all of the EU Member States. The interesting articles of the specified provisions are Article 4 EUTMR and Article 3 EUTMIR. Article 4 EUTMR defines the signs of what a EUTM may consist of and the requirements for it. While Article 3 EUTMIR lays out the new representation requirement a mark must hold in order to obtain registration.

Directives on the other hand, addresses the Member States and oblige them to adapt the national law accordingly to the directives and within a certain period of time, usually 1-2 years.¹⁴ The purpose behind a EU directive is to approximate the laws of the Member States so that they can provide equal legal protection and distort competition. National-laws that do not reflect the EU-laws shall be abandoned and priority should be given to the EU provisions.¹⁵ For example, since Sweden is a member of the EU, Swedish trade mark law

¹¹ Bernitz, *Immaterialrätt och otillbörlig konkurrens*, 19.

¹² Korling & Zamboni, 123.

¹³ Bernitz & Kjellgren, 57.

¹⁴ Korling & Zamboni, 123.

¹⁵ Bernitz & Kjellgren, 111.

must be fully harmonized with the latest Trade Mark Directive 2015/2436 (TMD) and the other EU legislations, methods and principles provided by the case law of the EU.¹⁶

Doctrine, legislative history, case law and the EUIPO Guidelines are also examined because they describe the reform more narrowly. They also clarify certain questions regarding the non-traditional trade marks and the new EU trade mark reform. It should be however noticed that the EUIPO Guidelines are not binding. The guidelines only summarize the rules of the provisions and the case law, in order for the interesting parties to gain latest information and market updates on the examination process.¹⁷

Furthermore, in order to understand the EU case law, Article 2 of the First Council Directive 89/104/EEC and the amended Directive 2008/95/EC of the European Parliament and of the Council must be particularly examined. This is because most of the cases presented in this thesis are discussing the Member States national courts asking the European Court of Justice (ECJ) to determine, in the light of the particular circumstances of the case, a preliminary ruling on the wording of Article 2.¹⁸

Additionally, it may seem that this work uses a comparative method, however comparison with different Member States and United States case law, only function as a supporting argument and not as a method of the research. Even though the solutions presented by the Member States and the United States case law should always be considered together with devoted legislations, those sources serve as a useful argument when dealing with the problems in the EU trade mark system.¹⁹

1.4 Delimitations

Firstly, only trade mark law will be covered. Other intellectual properties such as patents, designs and copyrights are not included in this thesis despite the fact that a combination of Intellectual Property (IP) protection can be achieved.

Secondly, the new registration requirement includes all sorts of trade marks. However, this thesis is limited to only cover non-traditional trade marks. Traditional word, logo and

¹⁶ Bernitz, *Immaterialrätt och otillbörlig konkurrens*, 2.

¹⁷ See Current trade mark practice.

¹⁸ This possibility of preliminary ruling is based on the cooperation provided by Article 267 of the Treaty on European Union and the Treaty on the Functioning of the European Union 2012/C 326/01.

¹⁹ Sandri & Rizzo, 76.

figurative trade marks are therefore not included in this research but will be used for comparison.

Thirdly, trade mark protection exists on three levels of law: national, EU and international. Here, only the first two will be covered with the main focus on EU trade mark law. international law is not discussed because it does not mention the graphical representation requirement but simply grants the Member States the possibility to require it.²⁰ National laws are only partly covered because from 14 January 2019 the Member States shall adapt the national laws in compliance with the rules of TMD.²¹ Additionally, Article 3 TMD imply that national trade marks will be given the same opportunity for registration as a EUTM, after national laws have been harmonized.²² TMD is therefore only partly discussed in the present work and the main focus lays on the EU trade mark protection and the EUTMR.

Lastly the Member States are allowed to give a more extensive national trade mark protection. For example, in some Nordic countries, trade mark protection can also be achieved without registration but through acquired distinctiveness by use, if a significant part of the country recognizes the mark.²³ But since this thesis mainly covers the graphical representation requirement in a registration process, protection without registration will not be covered in this present work.

1.5 Disposition

The thesis is divided into five main chapters.

The leading part gives an introduction to the thesis. This part includes information about the purpose, theoretical framework, method, disposition, material as well as the delimitations of this work.

The second chapter clarifies the definition of a trade mark and highlights the differences between a traditional and a non-traditional trade mark. It also presents EU trade mark law with its minimum requirements in a registration process and the developments which have

²⁰ Sandri & Rizzo, 32.

²¹ Article 54 TMD.

²² Notice that Article 3 TMD has a similar wording to Article 4 EUTMR. See further Section 2.4.

²³ Bernitz, Immaterialrätt och otillbörlig konkurrens, 268.

led to the abolition of graphical representation. In this chapter the first posed question is answered.

The following chapter links the second and the fourth chapters together by analysing the practical requirement for registration in the light of the *Sieckmann* case. The analysis includes a review of the practical requirement and its significance as well as a discussion of the *Sieckmann* case that established guidelines for the non-traditional trade marks, which later became codified in the EU trade mark law.

The main part of the thesis is the analysis, in the fourth chapter. This chapter discusses the non-traditional trade marks individually in the light of the case law, a deep study of legislative history, the doctrine and the requirements for registration. This discussion answers the second posed question. The discussion follows by a presentation of different perspectives which the affected parties may have on the trade mark reform. Conclusively, the effects of the amendments will be summarised as an answer to the third posed question.

Finally, fifth chapter contains the conclusion and my final comments on the EU trade mark reform.

2. Legal background

Firstly, this chapter aims to present the definition of a trade mark and state the differences between a traditional and a non-traditional trade mark. Secondly, it aims to give a legal background to EU trade mark law in the light of the abolition of the requirement for graphical representation.

During further presentation, it is important to state that both the trade mark directives and the trade mark regulations have kept similar wording in relation to each other regarding the requirements for registration both before and after the amendments.

2.1 Traditional and non-traditional trade marks

The traditional way of dividing trade marks has been to separate them into ‘traditional trade marks’ and other marks so called ‘non-traditional trade marks’. The first category of trade marks consists of word, sign and logo marks. These marks have been around for a long time which have made them codified in law. Moreover, traditional trade marks can be perceived visually. The second category contains a wide range of marks that have been growing into a stronger position every year due to the technical progress and the changing methods of marketing. Sound, position, tactile, olfactory, and colour marks are just some examples of non-traditional trade marks. They are communicated to the public by different kinds of technological inventions and allow the users to perceive the information from the mark through different human senses. The reason why the non-traditional trade marks have remained untraditional is because it is generally argued that they lack distinctiveness per se and that the average consumer²⁴ does not always recognize them as trade marks.²⁵

Today almost all the products on the market are sold with a trade mark. Trade marks are used in the market to distinguish goods and services of a company.²⁶ A trade mark consists of a sign, which has obtained a national, a EU or an international legal protection.²⁷ A sign is a mark that represents something other than itself and serves as a way of conveying messages.²⁸

²⁴ According to *Gut Springenheide e Tusky*, para 31, an average consumer is reasonably well-informed, observant and circumspect.

²⁵ Sahin, 504.

²⁶ Bernitz, *Immaterialrätt och otillbörlig konkurrens*, 4.

²⁷ *Ibid*, 22.

²⁸ Sandri & Rizzo, 5.

Further a trade mark has different functions depending on which perspective it is.²⁹ For example for a company, a trade mark constitutes an important feature to individualize and separate its goods and services from other competitors. Consumers on the other hand, use the trade marks to navigate on the market.

Generally, it is fair to assume that a trade mark's essential function is to distinguish origin of company's products and services. But also to act as a means of communication of company's messages.³⁰ No further definitions are stated in the EU trade mark legislations. However, Article 4 EUTMR provides examples of what a trade mark may consist of together with the basic registration requirements.³¹ This means that a EUTM can comprise of any types of signs, representing a product or a service and fulfilling the practical representation requirement. Before the 1 October 2017, the practical representation requirement held that a trade mark had to be graphically represented. Now it has been exchanged by a wider requirement which states that the representation of the trade mark must enable the competent authorities and the public to determine the subject matter of protection with clarity and precision.

If we search the EUIPO's online register for traditional EUTMs, we can find 618 575 registered word marks and 460 303 registered figurative marks.³² The register database also contains some, considerably less registered, non-traditional trade marks which mostly have been represented by the old graphical representation requirement. Those are 197 sound marks, 288 colour marks, 3 holograms and 4 625 three-dimensional marks.³³ Regarding the position, motion and pattern trade marks, they have been registered under category 'Other marks' or 'Three-dimensional shape marks', which creates a difficulty in estimating their total amount. Only few non-traditional trade marks have been registered on the basis of the amended regulation. For example, two multimedia marks have been registered by the new requirement.³⁴

²⁹ See further Section 3.2.

³⁰ Sandri & Rizzo, 31.

³¹ See Section 2.4.

³² The search was made at the Register of European Union, 'eSearch plus', 28 February 2018.

³³ Ibid.

³⁴ EUTM No. 17279704 registered by Ifori and EUTM No. 17411315 registered by Zitro IP.

2.2 European Union trade mark law

Even though IP law is primarily national, this area of law has gone through rapid Europeanization in the past decades. The reason for the Europeanization is that it has been important for the EU to regulate this area of the law because trade marks have a crucial impact on the market success.³⁵

EU trade mark system was established in 1996, after nearly 40 years from the first idea to create a unified protection of a trade mark.³⁶ The system's purpose was to produce an alternative protection, to the national trade mark protection, in all EU Member States.³⁷ The establishment of the unified protection and the EUIPO has been a great success in terms exerting a favourable impact on the employment and the competitiveness between the stakeholders.³⁸ Moreover, the Council emphasised that the establishment of the system has contributed to strengthen the competitiveness of the EU.³⁹ But the development has also raised expectations for a streamlined and modernised registration system from the stake holders.

Today EU trade mark law rests on two main legislations the Trade Mark Directive 2015/2436 (TMD) and the European Trade Mark Regulation 2017/1001 (EUTMR), governed by the EUIPO. The TMD seeks to harmonize the trade mark laws of the Member States to an extent where the disparities between them would otherwise obstruct the free movement of goods and services. Whereas the EUTMR establishes unitary rights throughout the whole EU trade mark system.⁴⁰

EUTMR is the recent codification of the EU Regulation 2015/2424 (amending the EU Regulation 207/2009). It entered with a number of changes adapting the legal framework to the digital era and by adding a legal certainty. The changes in the EUTMR are accompanied by two other regulations. The European Trade Mark Implementing Regulation (EU) 2017/1431 (EUTMIR), which contains detailed rules about representation and registration of

³⁵ Com (2013) 161, 1.

³⁶ Thorning & Finnanger, 19.

³⁷ Recital 6 of the Preamble of the EUTMR. See also Mårtenson et al, 110.

³⁸ COM (13) 161, 1.

³⁹ Ibid.

⁴⁰ Peguera, 1. But the concept is also expressed in the Recital 2 and 3 of the Preamble of EUTMR.

certain types of trade marks. And the European Trade Mark Delegated Regulation (EU) 2017/1430 (EUTMDR), which explains when the new procedural rules will take effect.⁴¹

TMD is the recent codification of the Directive 2008/95/EC of the European Parliament and of the Council (which amended the original First Council Directive 89/104/EEC).

One of the main changes of the EUTMR and the TMD is the abolition of graphical representation.

2.3 Abolition of the requirement for graphical representation

From the 1 October 2017, the graphical representation requirement is removed from both the TMD and the EUTMR. The result of the reform is a clear and more accessible system simply because of the EUIPO notion 'what you see is what you get'.⁴² It allows the signs to be registered in any appropriate form using generally available technology, as long as the representation is 'clear, precise, easy accessible, intelligible, durable, self contained and objective'.⁴³

The reason behind the reform is that over time the requirement for graphical representation has led to difficulties regarding the registration of non-traditional trade marks. Traditional trade marks benefitted from the requirement, since non-traditional trade marks did not always succeed to fulfil this requirement because they could not be perceived visually. And, EUIPO was strict with the interpretation of the provisions, keeping a literal approach.⁴⁴ One of the many examples is the case of *Sieckmann* where the possibility to register an olfactory sign was overshadowed by the technical requirement for graphical representation. In order to increase the legal certainty and reduce the objections for formalities some changes were necessary to be made.⁴⁵

In 2008 the EU Commission was requested by the EU Council to review the functioning of the trade mark system. This resulted in a study on 'the Overall Functioning of the European Trade Mark System' which was conducted by the Max-Planck Institute for Intellectual Property and Competition Law (MPI) between November 2009 and February 2011. One of the opinions from the MPI Study expressed that the requirement for graphical representation

⁴¹ EUIPO Brochure.

⁴² EUIPO Info.

⁴³ Article 3(1) EUTMR.

⁴⁴ Sandri & Rizzo, 33.

⁴⁵ EUIPO Summery, 9.

was outdated and a more flexible approach should be stated in the wording of the law.⁴⁶ MPI Study was followed by the Commissions proposal in 2013 to make EU trade mark registration system ‘more accessible and efficient for businesses in terms of lower costs and complexity, increased speed, greater predictability and legal security’.⁴⁷ In order to increase legal certainty for the non-traditional trade marks, the EU legislations were amended and the requirement for graphical representation removed. The goal was to open up possibilities, simplify the process and tempt more companies to register non-traditional trade marks.⁴⁸

The changes that were made to Article 4 EUTMR, will be described in the next chapter in detail.⁴⁹ While the old wording of Article 2 of the Directive 2008/95/EC and its new amended wording of Article 3 TMD, should be already stated here. This is of importance because trade mark case law on graphical representation referred to Article 2 of the old trade mark directives, the Directive 2008/95/EC and the Directive 89/104/EEC (Hereinafter the Amended Directives). Article 2 of the Amended Directives specified which particular signs a trade mark could consist of.

Article 2 of the Amended Directives stated ‘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’.⁵⁰

Now, the wording of Article 2 of the Amended Directives is amended by a new wording in Article 3 TMD, which do not require a graphical representation of the sign.

Article 3 TMD states ‘a trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the register in a manner which enables the competent authorities and the

⁴⁶ MPI Study, 66, para 2.9.

⁴⁷ COM (13) 161, 2 and COM (13) 162, 2.

⁴⁸ Common Communication, 1.

⁴⁹ See Section 2.4.

⁵⁰ Article 2 First Council Directive 89/104/EEC and the amended Directive 2008/95/EC of the European Parliament and of the Council.

public to determine the clear and precise subject matter of the protection afforded to its proprietor'.⁵¹

2.4 EUTM registration requirements

In order to receive protection for a EUTM a mark has to be registered by EUIPO in Alicante, Article 2 and 6 EUTMR.⁵²

Article 4 EUTMR states the two basic registration requirements as well as it provides some examples of what a trade mark may consist of.⁵³ The paragraph states 'an EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the Register of European Union trade marks ('the Register'), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor'.⁵⁴

The stated provision is new and amends the previous wording which stated 'a Community⁵⁵ trade mark may consist of any signs 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'.⁵⁶

According to the amended provisions a EUTM must firstly poses a distinctive capacity, which have been especially problematic to prove for the non-traditional trade marks.⁵⁷ Secondly, the mark has to be clearly and precisely represented so that the public can perceive the information based on the scope of the protection.

⁵¹ Article 3 TMD. Notice that it is almost the same wording as Article 4 EUTMR.

⁵² Whether the mark has been used or not is not relevant for the registration. The protection is obtained for the duration of 10 years and the registration gives the owner exclusive right to the trade mark which means that the third party cannot use the protected trade mark or similar marks in his business, Article 9 EUTMR.

⁵³ Notice that the list is not exhaustive since words 'any signs' and 'in particular' only gives suggestions of what a trade mark can be.

⁵⁴ Article 4 EUTMR.

⁵⁵ On the 23 March 2016, Office for Harmonization in the Internal Market (OHIM) changed its name to EUIPO and a Community Trade Mark became a EUTM.

⁵⁶ Regulation (EU) 2015/2424.

⁵⁷ Lunell, 49.

If the trade mark does not fulfil the basic requirements of a registration, then it constitutes an absolute ground for refusal. Absolute grounds for refusal are stated in Article 7 EUTMR and are permanent in a way that the applicant cannot overcome them. In contrast to relative refusal grounds which consist of an encounter between an old trade mark and the potentially new trade mark. Relative refusal grounds are stated in Article 8 EUTMR and can be excused if the proprietor of the first brand gives his consent.

2.4.1 The requirement for distinctiveness

A mark can consist of any signs that ‘distinguishes the goods or services of one undertaking from those of other undertakings’.⁵⁸ In other words, a trade mark is distinctive if an average consumer can distinguish the mark from other marks in all the EU Member States.⁵⁹ It is also distinctive if the shape is unrelated to the goods and services themselves, like for example the Mercedes Star or the Michelin Man.⁶⁰ If the trade mark devoids of any distinctive character then it cannot be registered according to Article 7(b) EUTMR. Neither can a descriptive mark or a customary mark be registered, Article 7(c)-(d). Nor if the shape results from the nature of the goods themselves; or if the shape is necessary to obtain a technical result; or if the shape gives substantial value to the goods themselves by the virtue of Article 7(e)(i)-(iii) EUTMR.

There are several reasons for the distinctive character requirement. Firstly, it would not be appropriate to give a sole right to a commonly used word and prohibit others from using it.⁶¹ Secondly, it cannot suit the society if a technical result is protected for an eternity.⁶² For example, in the case of *Phillips v Remington*, Phillips was not allowed to register its triple-headed electric razor as a trade mark since it had a technical function and could instead be protected by a patent which protection is limited in time.

The requirement for distinctiveness can be divided in inherent or acquired through use distinctiveness. The new amended regulations allow to submit acquired distinctiveness either together with the application or as a response to the first objection. But if the applicant submits both inherent and acquired distinctiveness as one principal claim, then the examiner

⁵⁸ Article 4(a) EUTMR.

⁵⁹ Compare *Bovemeij Verzekeringen v Benelux-Merkenbureau*, para 28.

⁶⁰ See *Mercedes Benz* case and EUIPO Guidelines, Part B, Examination, 18.

⁶¹ Bernitz, *Immaterialrätt och otilbörlig konkurrens*, 271

⁶² Thorning & Finnanger, 112.

will value them both in one single decision.⁶³ Acquired distinctiveness is therefore more suitable as a second option, allowing the applicant to make a subsidiary claim in case the applicant gets a negative response on his first claim on inherent distinctiveness. Moreover, acquired distinctiveness has to be proven in all the EU Member States.⁶⁴

2.4.2 The requirement for representation

Representation of a trade mark must be made ‘in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor’.⁶⁵ Article 3(1) EUTMIR further clarifies that ‘the trade mark shall be represented in any appropriate form using generally available technology’ as long as the representation is ‘clear, precise, self-contained, easily accessible, intelligible, durable and objective’. Additionally, Article 3(3) EUTMIR lays down some guidelines regarding the way in which the most popular signs can be represented.⁶⁶ This list is however not exhaustive and non-listed future trade marks shall instead comply with the standards set out in Article 3(1) EUTMIR.

The seven criteria which are set out in Article 3(1) EUTMIR are the result of the *Sieckmann* case ruling.⁶⁷ According to the established doctrine the criteria can be understood as follows: the representation has to be ‘clear’, ‘precise’ and ‘self contained’, meaning that the object of the right must be well-defined and complete in itself. So that EUIPO can examine absolute and relative grounds for refusal and publish the trade mark in the official register so that it is ‘easy accessible’. The published information about the mark must be so ‘intelligible’ that the competitors, based on precisely outlined scope of protection, can estimate the scope of the protection and undertake investments with reliance on that. Therefore the information has to be ‘durable’ and ‘objective’, so that no space is left for subjective interpretations.⁶⁸

⁶³ EUIPO Summary, 13.

⁶⁴ Articles 7(3) EUTMR, 2(2) EUTMIR, 27(3)(a) EUTMDR.

⁶⁵ Article 4(b) EUTMR.

⁶⁶ Additionally, EUIPO Guidelines provide recommendations of how exactly some marks may be represented.

⁶⁷ See more on the ‘Sieckmann criteria’ in Chapter 3.

⁶⁸ Sandri & Rizzo, 37. See also Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on 6 November 2001 on Case C-273/00 Ralf Sieckmann, para 38.

3. The practical requirement and the effects of the Sieckmann case

The previous practical requirement for graphical representation meant that a trade mark had to be described vividly in order to be registered. It was worded as following: ‘A trade mark may consist of any sign capable of being represented graphically’. The reason this requirement was considered to be practical, was because it was never a fundamental principle.⁶⁹ Instead it was inserted as the easiest way to ensure that the public could consult with the Register of European Union, in order to clearly and exactly understand the scope of the protection of a certain trade mark.⁷⁰ It was a requirement for technical needs that flawlessly captured and displayed trade mark’s scope of protection in the registry, which made all the other ways for registration seem temporary and vague.⁷¹ However, it should be noted that the graphical representation was natural in time. Because it was decided 40 years ago when other types of registrations did not seem fitted since the submission for trade mark registration was only possible by paper.

The registration of trade marks constitutes an important feature that provides legal certainty and establishes the scope of protection. This was clarified by the Board of Appeal (BOA) in an early case of *Antoni & Alison*. In the case, BOA stated that ‘the sign in question must be capable of being represented graphically, for such purposes as examination, publication and file inspection. In the interest of the general public and the more directly concerned parties, such as proprietors of earlier marks, those interested in determining the scope of protection of the mark or those involved in searching activities, it was considered essential that applicants present a clearly defined image of their mark’.⁷²

Graphical representation in the register provided that legal certainty for trade mark holders of traditional trade marks, by clearly presenting the scope of the protection through an illustration which was ‘accessible to the competent authorities and the public, particularly to economic operators’.⁷³ This requirement was however impractical for the non-traditional marks since not all of them could be presented graphically. For example, sound marks had to apply with a music notation and the representation of motion marks was limited to a

⁶⁹ Sandri & Rizzo, 32.

⁷⁰ *Ibid.*

⁷¹ This interpretation of the first trade mark directive can be derived from Sweden’s legislative history (Prop. 1992/93:48, 71).

⁷² *Antoni & Alison*, 2.

⁷³ *Sieckmann*, para 48-51.

representation by a series of pictures. Moreover, it was questionable how possible future trade marks such as olfactory and multimedia marks would fulfil this requirement.

As it was mentioned above, the *Sieckmann* constitute one of the most important cases regarding the registration of the non-traditional trade marks. The case was about a German olfactory mark. Application was submitted to the German Patent and Trade Mark Office, for protection of a national trade mark, by an odour sample with a verbal description ‘balsamically fruity with a slight hint of cinnamon’ which was represented by a chemical structure $C_6H_5-CH = CHCOOCH_3$. In the main proceedings two questions were raised for the ECJ to answer in a preliminary ruling.

The first question was if Article 2 of the First Council Directive 89/104/EEC could be interpreted in a way which made it possible for a trade mark to consist of ‘a sign which is not itself capable of being perceived visually’.⁷⁴ Secondly the German Federal Patents Court asked if the requirement for graphical representation can be satisfied by a chemical formula, a description written words, the deposit of an odour sample or by combination of those elements.⁷⁵

The ECJ answered the first question by an affirmative reply ‘a trade mark may consist of a sign which is not in itself capable of being perceived visually provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective’.⁷⁶ The second question was negated. The Court stated ‘in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements’.⁷⁷

The seven criteria the ECJ pointed out in the first answer, later became known as the ‘*Sieckmann* criteria’ and were used in the subsequent EU cases on other non-traditional trade marks.⁷⁸ However, the *Sieckmann* criteria left some uncertainties in the trade mark law. For example, it was never explained why specifically these criteria were required for a mark to be considered suitably reproduced. Neither were there any guidelines about how

⁷⁴ *Sieckmann*, para 25.

⁷⁵ *Ibid*, para 56.

⁷⁶ *Ibid*, para 55.

⁷⁷ *Ibid*, para 73.

⁷⁸ See for example cases *Shield Mark* on sound marks and *Libertel* on colour marks.

they should be determined. Some have pointed out that the EUIPO and the ECJ were confused between the terms of ‘graphical representation’ and ‘representation of the mark’ and used those terms equivalently.⁷⁹ But the term ‘representation of the mark’ signifies to the moment at which the application is filed to EUIPO and not necessarily the shape that the mark must have.⁸⁰ This is because ‘representation of the mark’ means a description of the mark and not how it is perceived in the reality. For example, two-dimensional representation has been undoubtedly accepted for three-dimensional marks even though it does not represent the reality.⁸¹

In order to create a greater legal certainty, provide a more flexible and simple registration process for the non-traditional trade marks, a wider requirement was founded.⁸² The amended representation requirement was framed to be unrelated to electronic and technological means.⁸³

⁷⁹ Sandri & Rizzo, 34.

⁸⁰ Ibid.

⁸¹ Sandri & Rizzo, 42.

⁸² COM (13) 161, 7.

⁸³ See Section 2.4 on the wording of the amended provision.

4. The past and the future of the non-traditional trade marks

Firstly, this chapter aims to present and discuss concrete problems with the registration of the non-traditional trade marks with the previous graphical representation requirement. Sound, olfactory, three-dimensional and colour marks will constitute the main part of this analysis since they are mostly known as non-traditional trade marks. Other types of non-traditional marks are also mentioned, but they constitute a smaller part of the analysis.

Secondly, this chapter aims to analyse how problems with the non-traditional trade marks may be resolved now with the amended requirement for registration. In order to do that, the parties affected by the amendments and their goal with the trade mark registration must be established and explained.

4.1 Non-traditional trade marks

4.1.1 Sound marks

A sound mark consist exclusively of a sound or a combination of different sounds.⁸⁴ For a long time it has been debated whether sound marks can be registered as a EUTMs. In the United States it has been possible to register sound trade marks since 1950.⁸⁵ Despite that, EU trade mark law had to wait until 1990 for its first registered sound trade mark.⁸⁶ The problem behind the registration of sound trade marks in the EU and in the Member States was the requirement for graphical representation which required that the sound is represented in a way it can be perceived visually. Eventually, the requirement for graphical representation of sound marks was satisfied by music notation, lyrics combined with music notation or a sonograph together with a sound file.⁸⁷

Shield Mark was the first case where it was confirmed that music notation can satisfy the requirement for graphical representation. In the case, trade mark holder, Shield Mark BV owned 14 trade marks in the Netherlands. The theme for eleven of those marks was ‘the first, elegiac notes of the étude for piano Für Elise, composed by Ludwig van Beethoven’⁸⁸

⁸⁴ EUIPO Guidelines, Part B, Examination, 29.

⁸⁵ National Broadcasting Company (NBC) was the first company to obtained a sound mark, U.S. Reg. No. 523616 (1950) to identify its television broadcasts. However, in America sound marks are called service marks.

⁸⁶ Lunell, 189.

⁸⁷ EUIPO Guidelines previous version, Part B, Examination, 23.

⁸⁸ Opinion of Advocate General Ruiz-Jarabo Colmer, delivered on 3 April 2003 on Case C-283/01 *Shield Mark BV v Joost Kist*, para 4.

and three trade marks had a cockcrow sound. In the national court Shield Mark BV sued Joost Kist for infringement of its registered trade marks. The national court rejected the action and Shield Mark BV appealed to the Benelux Supreme Court, which asked the ECJ to deliver a preliminary ruling. Firstly, it was asked whether sound marks and noises can be registered as trade marks and secondly if music notation meets the requirement for graphical representation. The ECJ answered the questions by referring to the *Sieckmann* case, in which the Court previously stated that the Directive does not contain an exhaustive list of what a trade mark may consist of. Since the list can be adjusted, some Member States (Spain, Italy, France, and Germany), expressly have allowed sound marks to be registered nationally. Therefore, a sound mark should not be excluded from registration in the other Member States that do not expressly allow sound trade marks, if the sign satisfy the mandatory requirements for registration.⁸⁹ And music notation was considered to fulfil such requirements, since it met the criteria stated in the *Sieckmann* case.

Since *Shield Mark*, the EUIPO have been permitting registration of several EUTMs. For example Dolby's sound, registered a sound trade mark through its music notation.⁹⁰ Furthermore Nokia Corporations has registered their theme song as well as YAHOO registered a yell through music notations and a verbal description.⁹¹ However, even though sound marks are more frequently registered now than before, they are still considered to be untraditional.

The reason why sound marks remain untraditional is because all of the above mentioned sounds are melodic and can be reflected through music notation. There are however sounds like animal sounds or other distinctive noises that cannot be represented in the same way. The graphical requirement has been a serious obstacle for the registration of these types of sounds. Because the description in words of the sound alone has not been considered sufficient.⁹² Neither was a sonograph alone, if it was not accompanied by an electronic file.⁹³ This created legal uncertainty in the market between trade mark holders of different

⁸⁹ For example, Sweden where sound trade marks are not expressly allowed, has registered several sound marks. See for example melody played by a van, Hemglassbilen, selling Ice cream (Swe. Reg. No. 330750).

⁹⁰ EUTM No. 1062942.

⁹¹ EUTM No. 1040955 and EUTM No. 1772086.

⁹² See *Tarzan Yell*.

⁹³ EUIPO Guidelines previous version, Part B, Examination, 23. See also Metro Golden Mayer (MGM) lion roar, EUTM No. 5170113, where a sonograph with a verbal description and an audio file was accepted for registration.

sounds since the General Court has repeatedly stated that all marks should be treated in the same way and independently of how those were communicated and perceived.⁹⁴

But it was not only noises that created problems in the market. Questions were raised whether music notation was a clear and precise representation of the sound and therefore fulfilled the Sieckmann criteria. For example, music notation did not always specify the instruments, which created an unclear scope of protection.⁹⁵ Moreover, it was also questioned who needs to clearly and precisely understand the representation of music notation. For example, it is easier for music companies to have an expert ready to interpret the music notes but it might be difficult for an average consumer to do so. However, those arguments seemed to be overshadowed and the EUIPO continued registering sound marks through music notation.

Now after the reform, a sound mark can be submitted either as an audio file or as an accurate representation of the sound in music notation, Article 3(3)(g) EUTMIR. The recent EUIPO Guidelines further specify that if both music notation and an audio file is submitted then it will be asked which one the applicant wishes to retain.⁹⁶ Music notation can be, as before submitted as one single JPEG file or on a A4 sheet. ‘Accurate music notation’ means that ‘the representation must include all the elements necessary for interpreting the melody, that is to say, pitch, tempo, lyrics (if any) etc.’.⁹⁷ The audio file must be in an MP3 format, do not exceed two megabytes and do not steam or loop. If an audio file is submitted together with a sonograph, then the sonograph will be removed from the file.⁹⁸ The EUIPO Guidelines also explicitly state that the verbal description of the sound alone is not accepted as per 1 October 2017. Because the representation of the trade mark alone defines the subject matter of the registration.⁹⁹ However, it should be noted that the EUIPO Guidelines are not binding and mainly consist of the EUIPO’s reflections on the general scenarios provided in the case law.

Moreover, it should be noted that, the recommendation which does not allow verbal description of the sound alone is seemingly strange because the abolition of graphical

⁹⁴ Sandri & Rizzo, 38.

⁹⁵ Thorning & Finnanger, 146.

⁹⁶ EUIPO Guidelines, Part B, Examination, 29.

⁹⁷ Ibid.

⁹⁸ Ibid.

⁹⁹ Ibid.

representation seemed to be approaching the United States trade mark law.¹⁰⁰ In the United States it is instead required that the applicant of a sound, an olfactory or other non-visual trade mark submit a detailed verbal description of the mark.¹⁰¹ Over seas it has therefore been possible to register for example Rue's four-note song from Hunger Games through a verbal description 'a human whistling a G4 eighth note, followed by a Bb4 eighth note, followed by an A4 eighth note, followed by a D4 half note, in the key of G minor'.¹⁰² Moreover, Homer Simpson's sound was registered through the verbal description 'the mark consists of the spoken word D'oh'.¹⁰³ Perhaps the EUIPO was basing their non-verbal description recommendation on the previous *Tarzan Yell* case where the Court stated that a verbal description only gives a vague idea of what the applicant wishes to protect but does not clarify the sound itself. However, if a verbal description is accompanied by an audio file, then there is additional clarification of the sound. Therefore it is probably possible in the light of the new requirement to submit a verbal description of the sound together with an audio file in order to obtain a EUTM registration.¹⁰⁴

Besides the practical requirement for registration, a sound mark has to also be distinctive in a way that the sound must be distinguished from other undertakings by authorities, competitors and the average consumer. This is not an easy task since the average consumer may not perceive the sound as a trade mark. For example, the shorter the sound, the more difficult is it for it to be distinctive and be recognized as a trade mark in respect to the goods. Although, some short sounds have been registered by the EUIPO. For example, Electrolux has registered several sounds, the shortest lasted for 0,396 seconds.¹⁰⁵ But long sound tracks may also have problems fulfilling the distinctiveness requirement. Yet, the Twentieth Century Fox melody succeeded to register as a longer sound track through its music notation and a verbal description.¹⁰⁶

¹⁰⁰ Mannheimer Swartling, 'Ett informationsbrev, No. 7' (October 2017), 6.

¹⁰¹ 37 C.F.R. § 2.52(5)(e). Moreover, Trademark Trial and Appeal Board has noted in early case *In re Gen. Electric Broad. Co.* that 'the nature of the mark is no basis for refusing to register it either as a service mark or as a trademark if it performs as an indication of the source'.

¹⁰² U.S. Reg. No. 85409089.

¹⁰³ U.S. Reg. No. 3411881.

¹⁰⁴ In 1977, an American company Edgad Rice Burroughs Inc tried to register *Tarzans yell* as a sound trade mark by submitting a sonogram. The application was refused since the sonogram was not considered enough for the representation of the sound. However, it was accepted in 1998 through the verbal description and the submission of the sound. *Tarzans yell* is now a registered trade mark in the United States, U.S. Reg. No. 2210506.

¹⁰⁵ EUTM No. 2506392, EUTM No. 2508810 and the shortest sound EUTM No. 2510345. However, all of the registrations have now been expired.

¹⁰⁶ EUTM No. 1312008.

Since the amended regulations started to apply, only two sound mark applications have been registered through a submission of a sound audio file only.¹⁰⁷ However several applications are still pending under examination.

Conclusively trade mark holders of sound marks are the ones which will be significantly affected by the new regulations since their registration process will be simplified. This is because the EU case law has been going around the graphical representation requirement for a while now, allowing sound marks to register through different methods like music notation, which could be perceived visually. Now when the graphical representation is gone, the registration of a sound mark can be simply registered by an uploading of an audio file, which constitute a clearer and more precise description of the sound.

4.1.2 Olfactory marks

According to the recent EUIPO Guidelines, olfactory or smell marks are currently not acceptable to register as a EUTM although they have been considered eligible for trade mark registration.¹⁰⁸ The reason for it, is that the current stage of technology does not allow a clear, precise, easy accessible, intelligible, durable, self contained and objective representation of an olfactory mark. Moreover, it is also questioned if the scent does perform the function of identifying a product and thereby fulfil the requirement for distinctiveness.¹⁰⁹ Yet one scent was successfully registered as an olfactory mark in 2000.¹¹⁰

Smells play an important role in our life since they evoke memories and stimulate emotions. We store the smell in our memory, until we come across it again or go to the same place where we first sensed the smell. ‘Anyone who has found themselves instantly transported to a long ago vacation by the slightest whiff of a fragrance caught in the breeze understands how powerful scent can be’.¹¹¹ Therefore, a smell is usually compared to something we have experienced before and we typically cannot describe it in words other than naming the source of the smell itself. For example, the smell of a banana is described by a distinctive banana smell. Smells are also perceived differently by different people and often depend on the environment.

¹⁰⁷ EUTM No. 17321464, registered on 30 January 2018 by Hyundai Motor Company and EUTM No. 17396102, registered on 22 February 2018 by Flughafen München.

¹⁰⁸ EUIPO Guidelines, Part B, Examination, 33.

¹⁰⁹ Sandri & Rizzo, 111.

¹¹⁰ EUTM No. 428870.

¹¹¹ Matheson, 1.

Olfactory marks can be divided into three categories: primary scent marks, secondary scent marks and unique scent marks.¹¹² Primary scent marks appear as the main scent of a fragrance, normally in perfumes and air fresheners. The fragrant appeal represents the main purpose for a customer to purchase that product. Secondary scent can be found in products whose main functions do not lay in emitting the scent itself, but where the scent attaches a necessary attribute to the products. This is mostly common in soaps, shampoos and detergents. Last category of unique scent marks, have a scent that comes in an addition to the products which normally do not smell, like a sewing yarn. It is mainly unique scent marks which are attached to normally unscented products that can attract the consumers recognition and fulfil the distinctive character of a trade mark.¹¹³ Therefore it is for example not possible to register the smell of jasmine to distinguish air fresheners or a perfume fragrance as a trade mark.¹¹⁴

Distinctiveness is the most important characteristic of a trade mark. However, it is difficult for an olfactory mark to fulfil this requirement.¹¹⁵ The case law has shown that many olfactory marks have failed to prove their distinctiveness.¹¹⁶ The most popular case is *Der Duft von Himbeeren* where the trade mark holder tried to register the scent of raspberries for fuels, particularly diesel oil, with a verbal description which stated ‘the trade mark consist of the scent or the smell of raspberries, applied to the said goods’.¹¹⁷ The BOA argued that the scent was unusual for the product and sufficiently well-known to be clear and precise, with no room for a subjective interpretation and therefore distinctive in itself.¹¹⁸ However, the scent was ultimately denied since it appeared as a decorative element in order to get rid of the unpleasant diesel smell. The case it therefore also interesting since it does not merely discuss the basic requirements for registration but additionally reveals the essential function of the trade mark which is to distinguish goods and services of one undertaking from others.

The distinction must be visible for an average consumer. The BOA states that the raspberry smell ‘cannot guarantee to the consumer the identity of origin of the goods in the application, nor can it enable him to recognise the trade mark independently of the

¹¹² Hammersley, 124.

¹¹³ Karapapa, 1343. See also Sandri & Rizzo, 116.

¹¹⁴ For example, Chanel failed in 1994 to register its fragrance of ‘Chanel No. 5’ through a verbal description of the smell.

¹¹⁵ Sahin, 505.

¹¹⁶ For example, the smell of vanilla on skin patches (No. 1807353) and the smell of citrus on shoe soles (No. 1254861) we not considered to be distinctive enough.

¹¹⁷ EUTM No. 1222090.

¹¹⁸ *Der Duft von Himbeeren*, para 15-16.

goods'.¹¹⁹ This means that even if the consumers would rather prefer to buy a smelling product than not, it is not sure that they will use the smell to identify the product. This is because some consumers normally consider a smell to be one of the products qualities rather than a means of determining the products origin.¹²⁰ For example, cleaning acid with a smell of ocean or citrus gives an indication of freshness but it is not enough for the consumer to recognize this brand from another (Secondary scent). It should also be noted that some products only smell after they are unpacked. Some even say that even if the consumer can smell the product before the purchase it, it has to do with the required product quality and not with the identification of the product itself.¹²¹

But the main reason why there have been so many unsuccessful attempts to register olfactory marks is because of the *Sieckmann* case. In the *Sieckmann* case, the ECJ stated that a chemical formula, description in written words, a deposit of an odour sample or a combination of those elements does not satisfy the requirement for graphical representation in relation to olfactory marks.¹²²

Because chemical formula is insufficient to identify the smell since only few people can feel the smell from just looking at the chemical formula.¹²³ The same product can also turn out differently depending on the concentration, the temperature etc.¹²⁴ Moreover the chemical formula only represent the substance and not the scent which implies that the chemical formula is not sufficiently clear and precise.¹²⁵

Even the verbal description of a smell is questionable whether it is precise and clear because such description would be subjective.¹²⁶ In the *Sieckmann* case the smell was describes as 'balsamically fruity with a slight hint of cinnamon'. But how can 'balsamically' and 'fruity' be described if not from personal subjective experiences. Moreover, how much is a 'slight' hint. This demonstrates that a verbal description is too objective since it triggers different emotions in people, depending on their previous experiences and subconscious.¹²⁷ On the other hand, in the perfume industry scents and fragrances are still described by words which

¹¹⁹ *Der Duft von Himbeeren*, para 45.

¹²⁰ Sandri & Rizzo, 115.

¹²¹ Maniatis, 222.

¹²² See also chapter 3.

¹²³ *Sieckmann*, para 69.

¹²⁴ *Sieckmann*, para 63. See also Sandri & Rizzo, 112.

¹²⁵ Lunell, 164.

¹²⁶ *Sieckmann*, para 65. See also *Antoni & Alison*.

¹²⁷ Sahin, 509.

indicate that a description in words is only problematic in relationship to the graphical representation and not to the registration of the smells in general.¹²⁸

Regarding the deposit, it is questionable how the deposit will be stored and published. Moreover, the ECJ mention that since trade mark protection may be renewed for varying period of times the trade mark has to be sufficiently stable and durable.¹²⁹ Because at the moment ‘an odour changes over time because of volatilisation or other phenomena and that deposit can therefore not produce a lasting olfactory impression capable of constituting a graphical representation’.¹³⁰ This means that even if a precise smell is submitted at the registration point, the smell might change after time or disappear completely. Further it is questionable how the smell will be published for others to understand. According to this argument the graphical representation seems not to be the main obstacle for registration of olfactory marks through a deposit.

Ultimately, the registration was denied because firstly it did not fulfil the registration requirement, which at the moment was graphical representation and secondly because it missed the distinctive character. However, the ECJ stated that a trade mark may consist of a sign that can be represented ‘*by means of images, lines or characters.*’¹³¹ With regard to this statement, it can be implied that other ways of representation can be accepted in the future. Moreover, it is not legally correct to deny the smell registrability solely because the science has not made it stable yet.¹³² Instead decisions have to be made on a case-by-case-basis.

There are additional ways of representing a smell. For example it is possible to capture the smell by a gas chromatography,¹³³ a spectrogram, an electronic nose¹³⁴ or by smelling screens¹³⁵. Moreover, some have even tried to register the smell by an image, *Eden Salr v OHIM*.¹³⁶ In the case, an olfactory mark was submitted with a verbal description ‘smell of ripe strawberries’ together with an image of a strawberry. However, the ECJ stated that the image only represents ‘the fruit which emits a smell supposedly identical to the olfactory

¹²⁸ Sandri & Rizzo, 121.

¹²⁹ *Sieckmann*, para 53

¹³⁰ *Sieckmann*, para 67.

¹³¹ See Chapter 3.

¹³² Sandri & Rozzo, 118.

¹³³ Sandri & Rizzo, 120. However, EUTM application No. 566596 of a mark with the smell of ‘an amber, woody aroma with Virginia tobacco undertones and a mace top note’ and a representation by chromatography was denied.

¹³⁴ An electronic nose is used to detect smells or flavours. See Persaud & Dodd.

¹³⁵ Smelling screens continuously feed air with the odour. See Hodson.

¹³⁶ EUTM No. 1122118.

sign at issue, and not the smell claimed'.¹³⁷ The Court further stated that since there are variety of strawberries, the smell cannot be identified with clarity and precision. The application was therefore refused.

In the framework of the EUIPO only one olfactory mark has been accepted as a EUTM by the ECJ with a verbal description 'the smell of fresh cut grass' as a trade mark for tennis balls.¹³⁸ The mark was firstly refused to be registered by the Examination Division due to the Article 7(1)(a) EUTMR as it did not conform with the requirements of a trade mark. This decision was however annulled by the BOA and the olfactory trade mark was registered in 2000 by the verbal description.¹³⁹ The BOA further pointed out that the question is 'whether or not this description gives clear enough information to those reading them to walk away with an immediate and unambiguous idea of what the mark is when used in connection with tennis balls' and 'the smell of freshly cut grass is a distinct smell which everyone immediately recognises from experience. For many the scent or fragrance of freshly cut grass reminds them of spring, summer, manicured lawns or playing fields, or other such pleasant experiences'.¹⁴⁰ Unfortunately, the 'fresh cut grass' trade mark was not renewed after it expired in 2006 and currently there are no valid registrations of olfactory marks in the EU.

The United States law on the other hand, have allowed registration of scents as trade marks.¹⁴¹ The first registration for an olfactory mark happened in 1991. The registration was for an embroidery yarn in the case *Clarke*. The application was submitted with a verbal description 'a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms'.¹⁴² The mark was considered to be unusual for the product and thereof distinctive which resulted in a registration.¹⁴³ This registration was however abrogated since the yarn was not used and the United States trade mark law allow only active trade marks to remain registered.¹⁴⁴ Another accepted registration in the United States was in 2001 'the smell of cherries to

¹³⁷ *Eden Salr v OHIM*, para 40.

¹³⁸ EUTM no. 428870.

¹³⁹ *Smell of fresh cut grass*.

¹⁴⁰ *Smell of fresh cut grass*, para 13-14.

¹⁴¹ See for example the flowery musk scent U.S. Reg. No. 4618936.

¹⁴² U.S. Reg. No. 1639128.

¹⁴³ 15 U.S.C. § 1052(f) (1988 ed., Supp. V).

¹⁴⁴ U.S. the trade mark law requires, besides distinctiveness, that the mark is continuously used for a period of time in order to keep its protection. Another example of an abrogated mark, is a lemon fragrance for toner for digital laser printers, photocopiers, microfiche, that was abandoned since it was not used, U.S. Reg. No. 75120036.

identify synthetic lubricants for racing cars or motor vehicles.¹⁴⁵ Also this application was submitted solely through verbal description.

Likewise, some Member States of the EU have succeeded to register national olfactory marks. The reason it has been possible for the Member States to allow registration of olfactory marks is because the list in Article 3 TMD is not exhaustive which indicates that the decision for registration is left open for the Member States domestic law to decide. For example in the United Kingdom, Sumitomo Rubber Co registered ‘a floral fragrance/smell reminiscent of roses for tyres’¹⁴⁶ and Unicorn Products registered ‘the strong smell of bitter beer for darts.’¹⁴⁷ Those olfactory marks were however registered before the *Sieckmann* judgement and there have not been any successful applications in the United Kingdom since.

Conclusively, both the United States and the United Kingdom trade mark law as well as the perfume industry in general, speaks in favour of registering olfactory trade marks through a verbal description alone, if the description can be made sufficiently clear and precise. The explanation to why the ECJ in the *Sieckmann* case had the conservative perspective was probably because of the graphical representation requirement. Now when the requirement is abolished perhaps the Court can have a more flexible approach when it comes to registration of olfactory marks. Despite that the EUIPO Guidelines, which are mainly based on the ECJ practice, state that olfactory marks are currently not acceptable for registration as a EUTM. However, the new and flexible amendments indicate that olfactory marks may be more easily registered in the future.

4.1.3 Three-dimensional marks

A three-dimensional mark consist of a shape that can include container, packaging, the product itself or its appearance.¹⁴⁸ It is not only the shape per se that can be protected but also the shape with word elements, figurative elements, labels or those shapes alone. The shape can also be detached from the product, e.g. the Mercedes three-pointed star or the ‘Spirit of Ecstasy’ which appears above the radiator of a Rolls Royce motor car.¹⁴⁹ With the graphical representation requirement it was suitable for a shape mark to register a single

¹⁴⁵ U.S. Reg. No. 2463044.

¹⁴⁶ U.K. Reg. No. 2001416.

¹⁴⁷ U.K. Reg. No. 2000234.

¹⁴⁸ EUIPO Guidelines, Part B, Examination, 22.

¹⁴⁹ However, it is unclear if they should be referred to as shape marks, Sandri & Rizzo, 46, or as position marks, Sandri & Rizzo, 152. It seems that some think that a three-dimensional mark must be independent from the product while others disagree, Sandri & Rizzo, 152.

picture or a photograph that captured maximum six different perspectives of the three-dimensional trade mark.¹⁵⁰

The newly amended representation requirement does not affect the way of how a three-dimensional mark will be submitted. But graphic and photographic representation is still considered to be the most suitable way to define a shape mark.¹⁵¹ Additionally graphical representation may now include computer animated design in the following format: OBJ, STL or X3D and with a maximum size of 20 MB.

Performing a search at the EUIPO's registration database, 4621 registered three-dimensional marks can be found whereof 19 have been filed and registered after the amended requirement.¹⁵²

However, it has never been easy to obtain a registration for a three-dimensional EUTM because consumers are not accustomed to distinguish the origin of a product only on the basis of the shape and packaging.¹⁵³ A shape must therefore be sufficiently original, unusual and has 'that extra something' for the consumer to recognise it as a trade mark.¹⁵⁴ For example a candy wrapped in foil is considered to be common and usual for wrapping confectionery and can therefore not be sufficiently distinctive.¹⁵⁵ Another reason for the three-dimensional mark failure to register is due to the objections raised under Article 7(1)(e) EUTMR which states that signs cannot consist exclusively of a shape (i) which results from the nature of the goods,¹⁵⁶ (ii) which is necessary to obtain a technical result;¹⁵⁷ or (iii) which gives substantial value to the goods.¹⁵⁸

In order to decide whether a shape is distinctive, one should look at how it is perceived by the average consumer. For example in the *Bounty Shape* case, the Court stated that the details on a chocolate bar would most likely be perceived as a decorative elements rather than the origin of the product since the product in question is sold in a opaque packaging.¹⁵⁹ The chocolate bar shape was therefore rejected because of the lack of distinctiveness under

¹⁵⁰ See for example registration pictures for Corsair USB, EUTM No. 4787693.

¹⁵¹ EUIPO Guidelines, Part B, Examination, 22.

¹⁵² The search was made at the Register of European Union, 'eSearch plus', 23 February 2018.

¹⁵³ Thorning & Finnanger, 109.

¹⁵⁴ Sandri & Rizzo, 48.

¹⁵⁵ See *Kiss Device*.

¹⁵⁶ See *Procter & Gamble* where the soap was rejected because it constituted the nature of the goods.

¹⁵⁷ See *Phillips v Remington* where the triple-headed electric razor was rejected because it was necessary to obtain a technical result.

¹⁵⁸ See *Bang & Olufsen* where the loudspeaker was rejected because it gave a substantial value to the goods.

¹⁵⁹ EUTM No. 818864.

Article 7(1)(b) EUTMR. Ultimately only the trade marks with significant and different shape have been able to undergo registration. And often only if they have acquired distinctiveness through use in the whole EU and it has been showed that none of the objections could be raised. For example Freixenet's pink bottle with diamond shaped design has been recently registered as a three-dimensional trade mark.¹⁶⁰

Conclusively it can be stated that, surely it has been a challenge to register three-dimensional trade marks yet graphical representation was never the reason for that. The main reason behind why those marks have remained to be non-traditional is because they have had problems fulfilling the requirement for distinctiveness.¹⁶¹ The new requirement for trade mark registration will therefore hardly affect the three-dimensional trade marks ability to be registered more frequently or faster.

4.1.4 Colour marks

It is well known amongst marketers that colours affect the consumers. For example, consumers can easily recognise a familiar brand by its colour from a distance away. Therefore, colours embody a powerful and an effective tool to create a brand identification, which can overcome cultural and linguistic barriers.¹⁶² Although admissibility of a colour per se mark was first approved in *Libertel* by BOA in and finally by the ECJ.

When it comes to colour marks a difference must be made between 'colour per se marks' and 'figurative or three-dimensional marks in colour'.¹⁶³ Colour per se marks consists of pure colour marks using one or a combination of colours. When registering, the mark has to be submitted without contour in one single JPEG file or on one single A4 sheet.¹⁶⁴ Describing the colour is also preferable but not necessary since colours that are submitted electronically conserve the true colour in the applied form which does not change over time.¹⁶⁵ If there are several colours then it has to be demonstrated how they appear.¹⁶⁶ The protection is given to the shade of colour(s) and their systematic arrangement.¹⁶⁷

¹⁶⁰ EUTM No. 17431115.

¹⁶¹ Lunell, 59.

¹⁶² Sandri & Rizzo, 70.

¹⁶³ Thorning & Finnanger, 130.

¹⁶⁴ EUIPO Guidelines, Part B, Examination, 28.

¹⁶⁵ Thorning & Finnanger, 52. See also *Light Green*, para 18.

¹⁶⁶ See for example EUTM No. 6857651 a combination of colours for a furniture company which described its mark as 'the colours themselves, their relationship to one another and their order is determined by the chart, the names of the colours in the RAL colour code in the order given on the colour chart are: RAL 1016 sulphur

If the representation of a mark contains words, logos etc., it is not a colour per se mark but a figurative or three-dimensional mark in colour which falls under the second category. Coloured trade marks on a product means that the product has to be recognized only in that colour without the name and the logo. It has to be distinctive and unusual for that specific product. Therefore, it is important to mention that it is not the colour itself that can be protected as a trade mark but the colour that is related to some specific goods like orange for Veuve Cliquot¹⁶⁸ or purple for Whiskas cat food¹⁶⁹. National courts have also registered colour marks. In Sweden for example purple has been registered for a coffee brand Löfberg lila.¹⁷⁰

Before and after the reform, graphical representation was never the problem for registration of colour marks since they can be easily demonstrated visually. The problem with registration was therefore due to the fact that colour marks failed to prove the distinctive character.¹⁷¹ This is because colour marks do not possess a prima facie distinctive character, instead such character must be acquired through use.¹⁷² *Libertel* was the first case where the Court pointed out that a colour can be registered as a trade mark if it fulfils the requirement for distinctiveness. But even if a colour does show evidence of distinctiveness the long list of refused colour applications provided by the case law demonstrates that it is almost impossible to obtain protection for one single colour.¹⁷³ Moreover, scope of the protection for one single colour is ‘extremely limited and should be construed quite narrowly’.¹⁷⁴

The requirement for distinctiveness applied to colour marks is natural since registration of one single colour, prevent all competitors to use it on their products. It is therefore closely linked to the need of free competition and the freedom of the trade.¹⁷⁵ A colour mark application must therefore be critically reviewed. For example, in the case *Light Green* the colour ‘lime green’ was not allowed for chewing gums since other distributors may try to use that colour to simulate apple and lime taste of a gum. It was also shown that if the

yellow, RAL 1021 cadmium yellow, RAL 2008 light orange, RAL 3016 coral red, RAL 3018 strawberry red, RAL 4006 traffic purple, the size of the colour strips in relation to each other is 1:1:1:1:1’.

¹⁶⁷ EUIPO Guidelines, Part B, Examination, 27.

¹⁶⁸ EUTM No 747949.

¹⁶⁹ EUTM No. 3793361.

¹⁷⁰ Swe. Reg. No. 372136.

¹⁷¹ Thorning & Finnanger, 138.

¹⁷² Sandri & Rizzo, 92. Notice that the United States law also require that the colour mark has acquired distinctiveness through use, 15 U.S.C. § 1052(f) (1988 ed., Supp. V).

¹⁷³ Thorning & Finnanger, 135.

¹⁷⁴ INTA report, 7.

¹⁷⁵ Sandri & Rizzo, 106.

amount of colours exceed more than three, it is less distinctive since it becomes harder for the consumer to memorize the different colours and their sequence.¹⁷⁶

Conclusively, colours are perceived by the sense of sight, graphical representation was therefore never a problem to resolve, at least after the electronic submission possibility.¹⁷⁷ Instead the problem with colour marks and the reason why they are considered to be non-traditional trade marks has been concerning their distinctive capacity.

4.1.5 Less traditional marks

Besides the already mentioned marks, there are signs which are even less traditional to be registered as EUTMs, some of which have never been registered before e.g. multimedia, touch and taste marks. But as the technological progress is happening and the marketing methods change, it is becoming more popular to attract the consumer with those less traditional trade marks some of which will be discussed below.

A position mark consist of the specific way in which the mark attaches or affixes to the product.¹⁷⁸ In practice position marks usually constitute a detail of a three-dimensional product such as buttons, buckles, hooks etc. Prada for example has registered a red stripe placed longitudinally along its footwear partly covering the rear area of the sole.¹⁷⁹ Another example is Hugo Boss red stripe on the belt loop, which leaps parallel with the belt loop but is narrower than the loop itself, on a pair of trousers.¹⁸⁰ Both mentioned position marks have been illustrated graphically by a sketch on the application and submitted under category 'Other marks' since 'Position marks' category is new. Other trade mark holders have also registered position marks under category 'Three-dimensional marks'.¹⁸¹ It is therefore difficult to account for how many registered position marks there are today. However, this aspect is irrelevant to discuss since from the point of resistibility, position marks are admissible. Submission of a position mark application is most suitable to contain a JPEG file with the visual image of the mark, since it does not has to be three-dimensional in order

¹⁷⁶ Ibid, 138.

¹⁷⁷ Compare for example *Libertel* where the Court argued that the shade of a colour may deteriorate with time on some media, which makes it not durable.

¹⁷⁸ EUIPO Guidelines, Part B, Examination, 26.

¹⁷⁹ EUTM No. 1027747. See also Lloyd Shoes red stripe crossing the heel of a lady's shoe EUTM No. 2308013.

¹⁸⁰ EUTM No. 3453354.

¹⁸¹ Therefore, it has been unclear sometimes if the sign constitutes a position mark or a three-dimensional mark. In some Member States e.g. Germany position marks classifies naturally amongst three-dimensional trade marks.

to present a clear and precise representation of the marks position, size and proportion.¹⁸² It is however still important for the mark to be distinctive which means that the shape of the mark on the object cannot be too common like for example a simple geometric shape.¹⁸³ Neither can it be placed somewhere where it usually appears like for example a coloured tip of the toe on a sock.¹⁸⁴

A pattern mark consist exclusively of a set of elements that are repeated regularly,¹⁸⁵ like for example in Louis Vuitton or Burberry patterns.¹⁸⁶ Previously it had to be registered as figurative mark but now it can be filled under the category 'Pattern marks'. Graphical representation has never been the problem for pattern marks to fulfil and they have been treated similar to three-dimensional and figurative marks.

A motion mark is described as a 'movement of the mark or a change in the position of the element of the mark', Article 3(3)(h) EUTMIR. Compared to multimedia marks, no sound is included with the motion. There are currently 16 motion mark applications pending at the EUIPO which have been filed after the reform.¹⁸⁷ Previously motion marks were registered under category 'Other marks' by submitting still and numbered pictures that captured the movement. Nokia handshake is a classical example.¹⁸⁸ But the following case law has demonstrated that the scope of protection has been low for these kinds of marks.¹⁸⁹ Now when the motion mark can be easily submitted in a video perhaps this could solve the problem with the scope of the protection. However, some questions are still for the case law to decide like for instance if there will be any restriction in time frame of the submitted video.

Holograms show a three-dimensional and free-standing image that do not require any glasses or a special viewing device. Further it can be described as a combination of a three-dimensional and a motion mark. Before the reform, holograms were able to fulfil the requirement for graphical representation by a photographic reproduction in multiple images that captured the holographic effect or a description.¹⁹⁰ This representation was similar to

¹⁸² EUIPO Guidelines, Part B, Examination, 26. See also Sandri & Rizzo, 153.

¹⁸³ See *Lange Uhren* application of geometric shapes on a watch face which was dismissed.

¹⁸⁴ See the refused application EUTM No. 5137781.

¹⁸⁵ EUIPO Guidelines, Part B, Examination, 27.

¹⁸⁶ EUTM No. 15602 and EUTM No. 7190929.

¹⁸⁷ The search was made at the Register of European Union, 'eSearch plus', 2 March 2018.

¹⁸⁸ EUTM No. 3429909.

¹⁸⁹ Thorning & Finnanger, 53.

¹⁹⁰ Lunell, 120.

the three-dimensional trade mark representation.¹⁹¹ But this representation was problematic since it was difficult for third parties to perceive complex holograms through images.¹⁹² Therefore under category ‘Holograms’ only three registered and still valid holograms can be found, registered by the old representation requirement.¹⁹³ However some holograms have been registered under other categories. For example the first registered hologram was a flying bird registered by an IP service company in 2003 which is still valid and can be found under category ‘Other marks’ in the EUIPO’s registration database.¹⁹⁴ Now, with the new requirement holograms can instead be represented in a more suitable way. The EUIPO Guidelines state that a hologram can be submitted either as a video file in an MP4 format or as a graphic or photographic reproduction with all necessary views. Number of views is unlimited as long as it fits on one single JPEG file or on a A4 sheet.¹⁹⁵ The EUIPO currently have one application under examination submitted in an MP4 format.¹⁹⁶ The mark is most likely to go through if no oppositions are raised since it correspond with the recommendations provided in the EUIPO Guidelines.

A multimedia mark consists of a sound and an image. Existing word elements, figurative elements or labels are also protected if those appear in addition to the image and the sound.¹⁹⁷ This is a new type of trade mark that was previously not possible to register with the graphical representation requirement. Now it can be submitted through an audio-visual file in an MP4 format which cannot exceed 8000 Kbps and 20 MB. The first two multimedia marks were accepted late February 2018 and consist of moving figures with a sound.¹⁹⁸ Another three multimedia marks are still currently under the examination by the EUIPO. One of the pending marks consist of a clip from a videogame where a soldier shoots another soldier in the head and the camera follows the bullet.¹⁹⁹ It can be questioned whether this mark will be approved since it may contain elements that could offend the public and therefore constitute an absolute ground for refusal. However since it is a shooting videogame where this kind of violence is frequent, it should probably be accepted anyway because gamers are used to this kind of violence in shooting videogames and secondly if it

¹⁹¹ See Section 3.1.3.

¹⁹² Lunell, 120.

¹⁹³ EUTM No. 12383171 registered by Laboratoires Arkopharma, EUTM No. 2559144 registered by Eve Holdings and EUTM No. 1787456 registered by Bioclin.

¹⁹⁴ EUTM No. 1864610.

¹⁹⁵ EUIPO Guidelines, Part B, Examination, 31.

¹⁹⁶ EUTM No. 17579491 by Zwilling J.A Henckels AG.

¹⁹⁷ EUIPO Guidelines, Part B, Examination, 31.

¹⁹⁸ EUTM No. 17279704 registered by Ifori and EUTM No. 17411315 registered by Zitro IP.

¹⁹⁹ EUTM No. 17282203.

does offend someone then it is probably a small minority.²⁰⁰ But since it is one of the first multimedia mark cases, we can only assume how the EUIPO will examine this type of mark. Even though the examination of this mark should not differ from other trade mark examinations.

Touch marks, also called tactile marks, have a tactile effect of a certain material or texture on the surface of a product. The recent EUIPO Guidelines state that with the current available technology it is not possible to clearly and precisely deduce a file with a tactile effect. Therefore an embossed pattern on a smooth bottle surface has been refused by the EUIPO.²⁰¹ However on a national level, Germany has registered a tactile mark consisting of a braille alphabet.²⁰² Also in the United States some tactile trade marks have been registered.²⁰³

Taste marks, as well as olfactory and touch marks, have potential to become trade marks. However they are currently not acceptable because a trade mark description in words cannot clearly, precisely and objectively describe the taste mark.²⁰⁴ The problem lies in the fact that a taste cannot be objectively described and is strongly influenced by the temperature, the age and other outside factors.²⁰⁵ Additionally there are practical obstacles, for example taste cannot be separated from the product which means that the public can have difficulties accessing the mark in a hypothetical registration database²⁰⁶. Further with the current technologies, taste can only appear after the product is consumed which means that the consumer will only access it after purchase. Another question is whether such mark can be distinctive. Therefore taste marks that have applied have been denied.²⁰⁷

4.2 Who is affected by the reform?

Before we talk about the effects of the reform for the non-traditional trade marks, it is important to notice the differences between the different perspectives the affected parties

²⁰⁰ Thorning & Finnanger, 153.

²⁰¹ *Embossed pattern on a smooth bottle surface.*

²⁰² Ger. Reg. No. 30259811 Underberg.

²⁰³ See the mark which consists of a velvet textured covering in the surface of a bottle of wine, U.S. Reg. No. 3155702 and the mark which consists of a distinctive man-made textured pattern on a Louis Vuitton bag, U.S. Reg. No. 2263903.

²⁰⁴ EUIPO Guidelines, 33.

²⁰⁵ Sandri & Rizzo, 156.

²⁰⁶ *Ibid*, 155.

²⁰⁷ See case *The taste of artificial strawberry flavour* which was rejected both because the flavour was found to be common and because it was found to be devoid of the distinctive character in relationship to pharmaceutical products.

may have. Because, as it was mentioned in the beginning of this thesis a trade mark has different function depending on which perspective it is.²⁰⁸

Literature indicated that trade marks can have four perspectives: the legislator's, the owner's, the user's and the competitor's perspective.²⁰⁹

4.2.1 The legislator

The legislator²¹⁰ strive for a functioning market. The abolition of graphical representation was therefore a way for the legislator to modernize the EU trade mark system and make it in line with the current technological developments. Moreover, an easily identified and individualised product, facilitates communication between the different actors on the market, which is effective for the trade.²¹¹ Colour marks constitute a perfect example to illustrate that. As it was demonstrated above, it is a challenge to obtain protection for a colour mark. But the goal of the trade mark law is not to take away trade mark holders rights to use colours in trade, but to make them use colours in a distinctive way. Moreover, trade mark law protects the owners right against copying and imitation of a trade mark with the purpose to stimulate the individualization and to protect trade marks investments²¹² This means that trade mark protection does not only cover the counterfeiting and fraud but also let the trade mark holders to make business with the trade mark e.g. sell, licence and develop. A registration is therefore a way to monetize the sole right and to protect the investment of the owner. However, protection must only be given to those marks that carry a distinctive value and fulfil the registration requirement. It is therefore important for the legislator that all the trade marks, both traditional and non-traditional, are given equal possibilities for registration.

4.2.2 The owner of the trade mark

Trade mark holders are also the owners of the mark. The owner's ambition is to attract as many permanent users as possible. A trade mark for the owner constitutes a communication and advertising tool that carries information and the identity of the product, e.g. names,

²⁰⁸ See Section 2.1.

²⁰⁹ Melin, 114.

²¹⁰ 'The legislator' should be interpreted as an abstract entity which includes courts, legal authorities etc.

²¹¹ Melin, 114.

²¹² Bernitz, Immaterialrätt och otillbörlig konkurrens, 1.

origin, state, price etc. used to attract a suitable user.²¹³ Traditional trade marks have been providing that information for a longer period of time. But in today's highly selective market of products and the sea of messages approaching the users from every direction in their everyday life, non-traditional trade marks allow manufacturers to stand out and make a distinct appeal to attract the users. Besides they are not depending on the language understanding, like traditional trade marks do, which makes it easy to communicate information to the users cross countries.²¹⁴ Therefore allowing new forms of marks may expand capabilities of the owners and allow them to advertise for their products in unique ways which will increase their competitiveness.

For the owner it is also important to differentiate his mark from others and be able to react fast if someone infringes his or her mark. The opposition system for a EUTM makes it both fast and inexpensive to react to an infringement.²¹⁵ However a EUTM need to be registered for the protection to occur. Once the trade mark is registered by the EUIPO, protection is given in all EU Member States which includes almost 500 million people and counting.²¹⁶ For the owner that uses his mark across the EU, a EUTM constitute a good protection.

But for the owner it is also important to protect the trade mark since it constitutes an investment that encapsulates the brand's values. A weak protection may therefore lower the trade mark value.²¹⁷ And the value of a trade mark can sometimes be enormous. Google is for example the world's most popular brand today and values to 229 billion dollars.²¹⁸ Therefore, it is important for the owner to register, control and protect his sole rights so that he or she has the willingness to spend money on advertisements and individualization of the products and services the company offers.²¹⁹

The reform creates therefore a significant opportunity for companies to add further layers of protection to the non-traditional trade mark portfolios on an EU level.

²¹³ Ibid, 8.

²¹⁴ Sandri & Rizzo, 3.

²¹⁵ Thorning & Finnanger, 21.

²¹⁶ See EU statistics over population in the EU.

²¹⁷ Mårtensson et al, 17.

²¹⁸ Brown, 30.

²¹⁹ Mårtensson et al, 17.

4.2.3 The user of the trade mark

The user is the consumer that receives the information from the trade mark e.g. identity, price, quality, reputation, function, features etc. Consumers use this information to compare different products on the market. Information is valuable for the user since today's market provides an enormous option of same products which are separated by trade marks. For example, if two trade marks of the same product are placed next to each other, a consumer can easily select the one that attracts the most, based on the shape, colour and other features he or she values the most. A trade mark is perceived by the user as a whole and the user does not analyse its various details.²²⁰ In a daily life, consumers often rely on the colour appearance, certain image that surrounds the trade mark or the extravagance of a package, in order to find a product that impresses them by the first thing they notice. The non-traditional marks are still unusual and may quicker capture the consumer's attention. For example a motion mark is more suitable to attract a consumer's attention than a regular static figurative mark.²²¹ Since the consumers constitute the main audience of a trade mark, it is natural for the courts to use 'the average consumer' as a referencing point.

4.2.4 The competitor

The competitor wants to break the connection between the owner and the user and instead attract the user to its own brand. Some companies try to establish themselves on the market by using similar marks to the already existing trade marks. Other companies try to find ways to differentiate themselves from others by unique trade marks which generate a value to their features. However, it is mutually important for all the competing companies to have a functioning registration system where they can gain information on the registered trade mark's scope of protection. Moreover, also the competitor needs an effective legal system so that 'free riding' can be avoided. Before the reform it was therefore important for them that previous registration uncertainties with the non-traditional trade marks are solved.

²²⁰ Sandri & Rizzo, 13.

²²¹ Ibid, 161.

4.3 Effects of the reform for the non-traditional trade marks

4.3.1 Which problems will be eliminated due to the reform?

The legislator's goal of abolition of graphical representation was to modernize the EU trade mark system so that it can be in line with the current technological developments and the digital era. In general, it seems that the reform has succeeded in its goal. Instead of having to adapt to the visual requirement, a more flexible approach is now available which allows registration to adjust to each specific mark. For example, it is no longer needed for a sound trade mark to present a graphical representation by music notation, instead a simple audio file can be uploaded. This means an equal treatment both for noises and melodic sounds. Also motion marks and holograms can be more suitably represented by a video file. The reform is therefore expected to ease the registration process for some already used non-traditional trade marks e.g. sound, motion and holograms and thereby allow more non-traditional marks to get registered. Moreover, the simplified registration process is expected to create a clearer understanding of the scope of the protections for each registered mark. For example, an audio file for a sound mark will be much easier to compare to other sound marks, than a music notation.²²² The EUIPO explain it as 'what you see is what you get'.

The newly amended requirement for registration also implies a wider understanding to the definition of a trade mark i.e. not only a static sign which is represented graphically but also a sign that can be perceived through different human senses. The wider definition opens up possibilities for the trade mark holders to register some completely new marks, like multimedia marks. In the future also touch, tactile and olfactory marks can get registered when that technologic possibilities appear, without the graphical representation being in their way. In this way equal treatment is ensured both for the traditional and the non-traditional trade marks.

4.3.2 What problems will remain?

Even though the abolition of graphical representation opens up possibilities for the trade mark holders to register more non-traditional marks, all marks still have to overcome the requirement for distinctiveness. As it was demonstrated earlier in this thesis, the problem with few registrations for non-traditional trade mark was not only depending on the graphical representation requirement but also because they could not overcome the

²²² Sandri & Rizzo, 146.

distinctiveness requirement. For example, the reason why three-dimensional and colour marks have been difficult to register is because they did not live up to the distinctive character requirement. In the case of colour marks, it was agreed that they do not possess inherent distinctiveness which means that all the few registered colour marks earned protection after they have proven acquired distinctiveness through use.

Furthermore, some non-traditional trade marks are still probably not possible to register e.g. olfactory, tactile and taste marks. Surely the graphical representation was one of the main obstacles for their registration since many suggested interpretations of graphical representation regarding these types of marks have been denied. See for example the *Sieckmann* case above where it was stated that registration of olfactory marks is not allowed by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements. However, the distinctiveness requirement and the question of how those marks will be registered and published in the registration database are still left in the open. The EUIPO Guidelines state therefore that those signs are currently not accepted to be registered. But the EUIPO Guidelines are not binding and can be eliminated by the EU courts. However, until new ways are found for the smell to remain durable and precise, olfactory marks just have to find different ways to earn protection. Though it can be concluded that already smelling products like perfumes, aftershaves, cleaning products etc. will not be able to register a specific smell since they are not distinctive enough to constitute a EUTM.

4.3.3 What new problems may arise and how can they be solved?

The first problem is that during the first year(s) of the reform, the handling process can become longer, since with every decision the EUIPO is setting an example for further trade mark applications. The EUIPO must therefore carefully evaluate which marks they allow to be registered. Normally a EUTM registration takes 13 weeks in order for an application to go straight through, if no objections are raised.²²³ However, the first registration of a multimedia mark took 22 weeks to examine and no objections were raised.²²⁴ Perhaps an explanation to this is that the amendments do not specify how new marks like multimedia marks should be evaluated during their registration process. This problem will however be

²²³ Thorning & Finnanger, 27.

²²⁴ EUTM No. 17279704.

eliminated over time and with later established methods for the evaluation process of the new marks.

A consequence of the slower handling process at the EUIPO can be that applicants will try to obtain a national protection instead, for which the handling process is in general much faster. In Sweden for example the average time for an application submitted online is two weeks.²²⁵ However, the problem with that is the fact that the laws of Member States soon has to be harmonized with TMD (by January 2019) which means that a national mark will be given the same right as a EUTM. This can make national registration offices more careful in their registration process which could result in a slow process there too, since no guidelines are set yet. Though, to ensure that the transition to the new directive goes as smoothly as possible for all stakeholders, the EU, the EUIPO and the Commission have been working on developing a common initiative on the representation of new types of trade marks, called 'Common communication' which gives an overview of the transposition process, showing trade marks that are planned to be accepted, their definitions and the accepted electronic file formats for sound, motion, multimedia and hologram marks. This Communication will be updated every six months and reflect the developing positions of the national offices as they advance with the transposition process. The first update will be released 1 June 2018.

Another problem is that dismissed applications will probably appeal, in order to get better understanding of the reform. This will possibly lead to work-overload at the EU courts since they will need to establish new case law with guidelines from the appealing cases. For example, regarding the olfactory marks, even though they are not currently possible to register they are not excluded from the list, since the list is not exhaustive. Olfactory marks can therefore be eligible for registration in the future and cannot be considered impossible to reproduce.²²⁶ This means that even though a verbal description, a chemical formula or a deposit is not enough according to the *Sieckmann* ruling, other ways are still there to be demonstrated in the future. Perhaps soon we will find ways to produce more durable and stable samples or create new ways of capturing the smell and these ways will need to be tested by the courts. Besides it is also questionable whether the *Sieckmann* judgement is still valid since it merely regarded the graphical registration of the smell. Conclusively the appealed cases will create pressure for the EU courts to produce new case law based on the

²²⁵ Thorning & Finnanger, 27.

²²⁶ Sandri & Rizzo, 35. See also *Der Duft von Himbeeren*.

amended requirement for registration. However, since the amendments are still new, we may have to wait a couple of years for the new case law to be established so we can truly comprehend how the amendments will affect the registration process of the non-traditional trade marks.

5. Conclusion and the final comments

A trade mark's function is to distinguish the origin of a company's products and services. Traditional trade marks are composed of word, sign and logo trade marks. They have been around for a long time and are easily recognized as trade marks by the average consumer. However, due to the technological progress and changing marketing methods non-traditional trade marks have been growing into a stronger position every year. The non-traditional trade marks that have been analysed in this thesis are sound, olfactory, three-dimensional, colour, pattern, motion, holograms, position, multimedia, tactile and taste marks.

For a long time, graphical representation requirement has been an obstacle for registration of non-traditional trade marks, especially for those marks which are not able to be represented visually. On the 1 October 2017 graphical representation requirement was amended by a new wider requirement which states that the representation of a trade mark must be made in a way which enables the competent authorities and the public to determine the subject matter of protection with clarity and precision. The aim of the reform was to open up new possibilities and to simplify the registration process for non-traditional trade mark holders so that they are given the same rights of registration as the rights that the holders of traditional trade marks are entitled to. The goal of this thesis was therefore to analyse how the abolition of graphical representation and the new wider requirement affects the registration of non-traditional trade marks in the EU.

The newly amended regulations allow the signs to be registered in any appropriate form using generally available technology, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. This technical neutral provision opens up possibilities for trade mark holders to register new types of marks such as multimedia marks. Moreover, the amended provision simplifies the registration process for the already accepted non-traditional trade marks. For example, it is no longer needed for sound marks to present additional means in order to fulfil the requirement for graphical representation such as music notation. Instead a simple audio file can be submitted which represents a clearer and more precise description of the sound trade mark. Additionally, a video file can more suitably represent motion marks and holograms. Most common types of trade marks are listed in the new regulations and the suggested methods for their representation. This means that the traditional trade marks such as word, figurative and logo marks are now accompanied by the non-traditional trade marks such as sound, multimedia,

motion, holograms etc. The list is however not exhaustive and other types of marks can be registered, provided that they can be clearly and precisely represented.

However, the registration process will not be simplified for all the non-traditional trade marks. During the research I found that some non-traditional marks, like colour, pattern and three-dimensional marks, have stayed untraditional because they have had problems fulfilling the requirement for distinctiveness. This means that the graphical representation requirement was never a problem for the registration of colour, pattern and three-dimensional marks because those marks can easily be perceived by the sense of sight. Instead they have had hard time proving their originality and thereby earn the generous trade mark protection.

Within the framework of this work, a special interest for me was found in the olfactory, tactile and taste marks. Even though the more flexible registration requirement has been enforced, those marks are still not possible to register according to the EUIPO Guidelines. Surely the graphical representation was one of the main obstacles for their registration since many suggested interpretations in case law regarding for example olfactory marks have been denied. In the *Sieckmann* case it was stated that the representation of an olfactory mark cannot be made by a chemical formula, verbal description or a deposition of the smell because it is not clear and precise enough. However, this statement was made in relation to graphical representation requirement. Moreover, the Court never directly implied that olfactory marks cannot be registered which implies that olfactory signs might be registered in the future. Now when the old registration requirement is amended, one may ask if the *Sieckmann* judgement, regarding those forms of representation, is still valid. It is reasonable to think that the Court in the *Sieckmann* case only had a conservative view because of the graphical representation requirement. Now that the requirement is abolished perhaps the ECJ can have a more flexible approach with the registration of olfactory marks. But until the ECJ have declared otherwise, the EUIPO Guidelines state that those signs are currently not accepted for registration.

Nevertheless, those mark's function as an identification and they cannot simply be excluded from the protection solely because they cannot be registered. Besides both the United States and the United Kingdom laws as well as perfume industry in general, speaks in favour of registering olfactory trade marks, at least with a verbal description. This is possible as long as the description can be made sufficiently clear and precise. Moreover, the EUIPO

Guidelines are not binding and can be eliminated by the EU courts. This implies that the problem with the registration of tactile, taste and olfactory marks has not been solved at the registration level but has only been moved forward, for the EU courts to decide in the new case law, based on the amended provisions. Perhaps the goal for the EU legislator, with the simplified process, has been to stimulate more brands to register olfactory, tactile and taste mark in order for the EU courts to provide a judgement on. Because despite the rapid technological developments, interest in those marks has been surprisingly slow to mature and only few cases have been put in front of the Court.

Lastly, the Member States' national trade marks will be given the same registration opportunity as a EUTMs when their laws will get harmonized with the TMD. This will allow the trade mark owners to navigate in cross border transactions without having the inconsistencies in the registration process as the current situation indicates.²²⁷ Harmonisation in this area of law will be particularly important for the United Kingdom, in the light of Brexit. Since the United Kingdom is for the time being still a Member State of the EU, it has a duty to harmonize its national law with the TMD by 14 January 2019. But the Government of the United Kingdom has not yet clarified its position on the implementation of the reform. This is alarming because non-implementation before 29 March 2019, when the United Kingdom is due to leave the EU, can expose the United Kingdom to the risk of liability. Moreover, this could be the United Kingdom's last chance to ensure a high degree of consistency and equal protection with the other EU countries as well as a consequence for the national trade marks holders if the requirement for graphical requirement remains.²²⁸

Finally, the reform is a huge step forward for the EU to ensure that the legal protection of trade marks is in balance with the increasing digitalization and technological developments. However, since the amendments still are fresh, we may have to wait a couple of years for the EUIPO's and the EU courts' practice to be established before real consequences of the amendments can be discussed.

²²⁷ MPI Study, 35, para 2.22.

²²⁸ See The MARQUES position paper on Brexit.

Bibliography

Literature

Claes Sandgren, *Rättsvetenskap för uppsatsförfattare: ämne, material, metod och argumentation* (3rd edn, Nordstedts Juridik, Stockholm, 2015) (Cit: Sandgren)

Erika Lunell, *Okonventionella Varumärken: Form, Färg, Doft, Ljud* (Norstedts Juridik, Stockholm, 2007) (Cit: Lunell)

Frans Melin, *Varumärkes strategi: Om konsten att utveckla starka varumärken* (Liber, 1999) (Cit: Melin)

Fredric Korling & Mauro Zamboni, *Juridisk metodlära* (Studentlitteratur, 2013) (Cit: Korling & Zamboni)

Jörgen Hettne & Ida Otken Eriksson, *EU-rättslig metod: teori och genomslag i svensk rättstillämpning* (2nd edn, Norstedts Juridik, Stockholm, 2011) (Cit: Hettne & Eriksson)

Louise Thorning & Solvår Winnie Finnanger, *Trademark Protection in the European Union with a Scandinavian View* (Thomson Reuters Professional, København, 2010) (Cit: Thorning & Finnanger)

Rita Mårtenson, Marcus Ateva & Carl Anders Svensson, *Varumärket: strategi och juridik* (Studentlitteratur, Lund, 2013) (Cit: Mårtenson et al)

Spyros Maniatis, *Scents as Trade marks: Propertisation of Scents and Olfactory Poverty in Law and The Senses* (Pluto Press, London-Chicago, 1996) (Cit: Maniatis)

Stefano Sandri & Sergio Rizzo, *Non-conventional trade marks and community law*, (Marques, Thurmaston, 2003) (Cit: Sandri & Rizzo)

Ulf Bernitz & Anders Kjellgren, *Europarättens grunder* (4th edn, Nordstedts Juridik, Stockholm, 2010) (Cit: Bernitz & Kjellgren)

Ulf Bernitz, Lars Pehrson, Jan Rosén & Claes Sandgren, *Immaterialrätt och otillbörlig konkurrens* (14th edn, Jure Förlag, Stockholm, 2017) (Cit: Bernitz, Immaterialrätt och otillbörlig konkurrens)

Articles/Journals

Faye M. Hammersley, 'The Smell of Success: Trade Dress Protection for Scent Marks' (1998, 2 Intellectual Property L. Rev., 105) (Cit: Hammersley)

Hal Hodson, 'Smell-o-vision screens give you a real noseful' (2013, New Scientist, 2010) (Cit: Hodson)

Julia Anne Matheson, 'The Sweet Smell of a Successful Registration' (2003, Intellectual Property Counselor, newsletter) (Cit: Matheson)

Krishna Persaud & George Dodd, 'Analysis of discrimination mechanisms in the mammalian olfactory system using a model nose' (1982, Nature International Journal of Science, 352) (Cit: Persaud & Dodd)

Mannheimer Swartling, 'Ett informationsbrev, No. 7' (October 2017)

Miquel Peguera, 'Trade mark functions and trade mark rights' (2014, IPSC Paper) (Cit: Peguera)

Onur Sahin, 'The past, the present and the future of colour and smell marks' 'European

Intellectual Property Review, (2016, 38(8), 504-516) (Cit: Sahin)

Stavroula Karapapa, 'Registering Scents as Community Trademarks' (2010, The Trade Mark Reporter, 100 (6), 1343) (Cit: Karapapa)

EU Legal Acts

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (Cit: European Trade Mark Regulations (EU) 2017/1001 or EUTMR)

Commission Implementing Regulation (EU) 2017/1431 of 18 May 2017 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark (Cit: EUTMIR)

Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 (Cit: EUTMDR)

Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (Cit: Regulation (EU) 2015/2424)

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 (Cit: Trade Mark Directive (EU) 2015/2436) (Cit: Directive (EU) 2015/2436 or TMD)

Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relation to trade marks

First Council Directive of 21 December 1998 to approximate the laws of the Member States relating to trade marks (89/104/EEC)

Consolidated versions of the Treaty on European Union and the Treaty on the functioning of the European Union. (2012/C 326/01)

EU documents

Common Communication on the representation of new types of trade marks by European Trade Mark & Design Network, published 4 December 2017 (Cit: Common Communication)

European Commission, Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark, COM (13) 161 final (Cit: COM (13) 161)

European Commission, Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks, COM (13) 162 final (Cit: COM (13) 162)

Electronic sources

EUIPO, 'SSC009-Statistics of European Union Trade Marks' (Published 5 February, 2018) <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/the_office/statistics-of-european-union-trade-marks_en.pdf > 'Accessed 3 March 2018' (Cit: Statistics of European Union Trade Marks)

EUIPO 'New EU Trade Mark Legislation brochure on changes entering into force on 1 October 2017' (Published April 2017) <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentImages/legal_reform/lr2_brochure.pdf> 'Accessed 22 February 2018' (Cit: EUIPO Brochure)

EUIPO 'New EU trade mark regulation section Elimination of Graphical Representation Requirement' (Published 4 October 2017) <<https://euipo.europa.eu/ohimportal/en/elimination-of-graphical-representation-requirement>> 'Accessed 22 February 2018' (Cit: EUIPO Info)

EUIPO 'EU Trade Mark Reform: Summary of changes applying from 1 October 2017' <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/legal_reform/Overview_changes_en.pdf> 'Accessed 22 February 2018' (Cit: EUIPO Summary)

EUIPO Decision No EX-17-1 adopted by the Executive Director 'Guidelines for Examination of European Union Trade Marks' (Published 1 October 2017) <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/decisions_president/EX-17-1_en.pdf> 'Accessed 22 February 2018' (Cit: EUIPO Guidelines)

EUIPO Decision No EX-16-7 adopted by the Executive Director 'Guidelines for Examination of European Union Trade Marks' (Published 1 February 2017) <https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/decisions_president/ex16-7_en.pdf> 'Accessed 22 February 2018' (Cit: EUIPO Guidelines previous version)

EUIPO, 'Current trade mark practice' (Published 22 November 2017) <<https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>> 'Accessed 2 March 2018' (Cit: Current trade mark practice link)

EU statistics over population in the EU in 2015. Available at <https://europa.eu/european-union/sites/europa.eu/files/population_en.pdf> 'Accessed 27 February 2018' (Cit. EU statistics over population in the EU)

INTA, 'Non-Traditional Trademarks in Europe – Shape and Colour Trademarks – Common Issues with Obtaining, Exploiting and Enforcing Rights, Report prepared by the 2004-2005 Europe Legislation Analysis Subcommittee' (Published March 2005) <<http://www.inta.org/Advocacy/Documents/INTAShapeColorEurope2005.pdf>> 'Accessed 2 March 2018' (Cit: INTA report)

Marques, 'Marques Brexit position paper' Available at <<https://www.marques.org/positionpapers/Download.asp?ID=93>> 'Accessed 27 February 2018' (Cit: The MARQUES position paper on Brexit)

Max Planck Institute for Intellectual Property and Competition Law 'Study on the overall functioning of the European Trade Mark System' (Published 3 April 2013) <<https://publications.europa.eu/en/publication-detail/-/publication/5f878564-9b8d-4624-ba68-72531215967e>> 'Accessed 22 February 2018' (Cit: MPI Study)

Millward Brown, 'Brandz: Top 100 Most Valuable Brands 2016' Available at <http://brandz.com/admin/uploads/files/BZ_Global_2016_Report.pdf> 'Accessed 27 February 2018' (Cit: Brown)

Proposition 1992/93:48. Om ändringar i de immaterialrättsliga lagarna med anledning av EES-avtalet m.m. Available at <https://www.riksdagen.se/sv/dokument-lagar/dokument/proposition/om-andringar-i-de-immaterialrattsliga-lagarna-med_GG0348> 'Accessed 22 February 2018' (Cit: Prop. 1992/93:48)

Table of Cases

EU Case Law

Decision of the Second Board of Appeal, 27 May 2015 in Case R-2588/2014-2, Tactile mark (Cit: Embossed pattern on a smooth bottle surface).

Judgement of General Court (Eight Chamber), 6 October 2011 in Case T-508/08, Bang & Olufsen (Cit: Bang & Olufsen)

Judgement of the Court of First Instance (Third Chamber), 14 September 2009 in Case T-152/07, Lange Uhren v OHIM (Cit: Lange Uhren)

Judgement of the Court of First Instance (Fourth Chamber), 8 July 2009 in Case T-28/08, Mars Inc (Cit: Bounty Shape)

Decision of the Fourth Board of Appeal, 27 September 2007 in Case R-708/2006-4, Tarzan Yell (Cit: Tarzan Yell)

Judgement of the Court, 7 September 2006 in Case C-108/05, Bovemeij Verzekeringen v Benelux-Merkenbureau (Cit: Bovemeij Verzekeringen v Benelux-Merkenbureau)

Judgement of the Court of First Instance (Third Chamber), 27 October, 2005 in Case T-305/04, Eden Sarl v. OHIM (Cit: Eden Salr v OHIM)

Judgement of the Court (Sixth Chamber), 27 November 2003 in Case C-283/01, Shield Mark BV v. Joost Kist (Cit: Shield Mark)

Decision of the Second Board of Appeal, 4 August 2003 in Case R-120/2001-2 Eli Lilly and Company (Cit: The taste of artificial strawberry flavour)

Opinion of Advocate General Ruiz-Jarabo Colmer, delivered on 3 April 2003 on Case C-283/01 Shield Mark BV v Joost Kist

Judgement of the Court, 6 May 2003 in Case C-104/01, Libertel Groep BV v Benelux-Merkenbureau (Cit: Libertel)

Judgement of the Court, 18 June 2002 in Case C-299/99, Koninklijke Phillips Electronics NV v Remington Consumer Products Ltd (Cit: Phillips v Remington)

Judgement of the Court of First Instance (Second Chamber), 5 June 2002 in Case T-198/00, Hershey Foods Corporation (Cit: Kiss Device)

Judgement of the Court, 12 December 2002 in Case C-273/00, Ralf Sieckmann (Cit: Sieckmann)

Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on 6 November 2001 on Case C-273/00 Ralf Sieckmann

Decision of the Third Board of Appeal, 5 December 2001 on Case R-711/1999-3, The scent of raspberries (Cit: Der Duft von Himbeeren)

Judgement of the Court of First Instance (Second Chamber), 16 February 2000 on Case T-122/99, The Procter & Gamble Company (Cit: Procter & Gamble)

Decision of the Second Board of Appeal, 11 February 1999 on Case R-156/1998-2, Smell of fresh cut grass (Cit: Smell of fresh cut grass)

Decision of the First Board of Appeal, 18 December 1998 on Case R-122/1998-3, Light Green (Cit: Light Green)

Judgement of the Court (Fifth Chamber), 16 July 1998 on Case C-210/96, Gut Springenheide GmbH and Rudolf Tusky (Cit: Gut Springenheide e Tusky)

Decision of the Second Board of Appeal, 21 January 1998 in Case R-4/97-2 Antoni & Alison's Application (Cit: Antoni & Alison)

England and Wales High Court

Daimler Ag v Sany Group Company Ltd [2009] EWHC 1003 (Ch) (14 May 2009) (Cit: Mercedes Benz)

Unites States Case Law

In re Gen. Electric Broad. Co., 199 U.S.P.Q. 560, 563 (T.T.A.B. 1978) (Cit: In re Gen. Electric Broad. Co.)

In re Clarke, 17 U.S.P.Q. 2d (BNA) 1238 (T.T.A.B. 1990) (Cit: Clarke)

Other sources

Member State trade marks

Swe. Reg. No. 330750 (1999, Sound) Hemglass

Swe. Reg. No. 372136 (2005, Colour) Löfberg

U.K. Reg. No. 2001416 (1996) Rose smell for tyres

U.K. Reg. No. 2000234 (1996) Beer smell for darts

Ger. Reg. No. 30259811 (2003) Underberg

United States trade marks

U.S. Reg. No. 1639128 (1991) Embroidery yarn

U.S. Reg. No. 2210506 (1998) Tarzan yell

U.S. Reg. No. 2263903 (1999) Textured pattern on a Louis Vuitton bag

U.S. Reg. No. 2463044 (2001) The smell of cherries

U.S. Reg. No. 3155702 (2006) Velvet texture on a bottle

U.S. Reg. No. 3411881 (2008) D'oh

U.S. Reg. No. 4618936 (2014) Flowery musk scent

U.S. Reg. No. 523616 (1950) NBC chimes

U.S. Reg. No. 75120036 Lemon fragrance for printers

U.S. Reg. No. 85409089 (2014) Rue's song from Hunger Games

European Union trade marks

EUTM No. 1027747 (2004, Other) Prada stripe

EUTM No. 1040955 (2000, Sound) Nokia

EUTM No. 1062942 (2001, Sound) Dolby

EUTM No. 1122118 Smell of ripe strawberries

EUTM No. 1222090 The scent of raspberries

EUTM No. 12383171 (2014, Hologram) Laboratoires Arkopharma

EUTM No. 1254861 Smell of citrus

EUTM No. 1312008 (2001, Sound) Twentieth Century Fox Film Corporation

EUTM No. 15602 (1997, Figurative) Louis Vuitton pattern

EUTM No. 17279704 (2018, Multimedia) Ifori

EUTM No. 17282203 Videogame multimedia mark

EUTM No. 17321464 (2018, Sound) Hyundai Motor Company

EUTM No. 17396102 (2018, Sound) Flughafen München.

EUTM No. 17411315 (2018, Multimedia) Zitro IP

EUTM No. 17431115 (2018, 3D shape) Freixnet bottle

EUTM No. 17579491 Zwilling J.A Henckels AG

EUTM No. 1772086 (2001, Sound) Yahoo

EUTM No. 1787456 (2003, Hologram) Bioclin

EUTM No. 1807353 The smell of Vanilla

EUTM No. 1864610 (2003, Other) Flying bird

EUTM No. 2308013 (2002, Other) Lloyd

EUTM No. 2506392 (2004, Sound) Electrolux

EUTM No. 2508810 (2004, Sound) Electrolux

EUTM No. 2510345 (2004, Sound) Electrolux

EUTM No. 2559144 (2005, Hologram) Eve Holdings

EUTM No. 3429909 (2005, Other) Nokia Corporation

EUTM No. 3453354 (2006, Other) Hugo Boss

EUTM No. 3793361 (2008, Colour) Whiskas cat food

EUTM No. 428870 (2000, Other) The smell of fresh cut grass

EUTM No. 4787693 (2008, 3D shape) Corsair USB

EUTM No. 5137781 Coloured tip of the toe on a sock

EUTM No. 5170113 (2008, Sound) MGM lion roar

EUTM No. 566596 Smell of amber, wood, tobacco and a mace

EUTM No. 7190929 (2009, Figurative) Burberry Pattern

EUTM No. 747949 (2007, Figurative) Veuve Cliquot

EUTM No. 818864 Bounty shape