

of Appeal, which are responsible for deciding appeals resulting from, inter alia, the examiners' decisions as well as appeals against the decisions of Opposition Divisions and Cancellation Divisions.<sup>241</sup> An appeal involving a complex legal problem will normally be submitted before the enlarged Board of Appeal.<sup>242</sup> While the Boards of Appeal are the final decision making authority within the organisational structure of OHIM, their decisions can only be challenged before the Court of Justice of the European Union (CJEU) (formerly designated as the European Court of Justice (ECJ)) and the General Court (GC) attached to the CJEU (formerly known as the Court of First Instance (CFI)).<sup>243</sup> Article 257 of the Treaty on the Functioning of the European Union (TFEU) provides for the possibility that the Boards of Appeal become judicial chambers attached to the GC, "maintaining their seat in Alicante but outside OHIM's structure".<sup>244</sup>

### ***C. Subject matter of CTM protection***

Article 4 of the CTMR states, in relation to a definition of a CTM, that a sign which a trademark may consist of is "any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings".

Article 4 of the CTMR, therefore, incorporates graphical representation and distinguishing capability of a sign as formal and substantive requirements for CTM registration.

The definition under Article 4 of the CTMR complies with the minimum registration requirements enshrined in Article 15 of the agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). By stipulating that "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark", Article 15 TRIPS accommodates the substantive and

52 (Kluwer Law International, The Hague 2001).

241 Cf. Article 135 of the CTMR.

242 Cf. Article 135(2) & (3) of the CTMR.

243 Cf. Articles 251 and 256 of the TFEU

244 BENDER, A. and KAPFF, P. von, "Born to be free – the Community Trade Mark in Practice", 32(6) IIC 625, 626 (2001), footnote 6.

formal requirements for trade mark registration inscribed in Article 4 of the CTMR.<sup>245</sup>

### *I. Substantive requirement – the capability to distinguish*

It is generally accepted that many signs are capable of distinguishing goods and services.<sup>246</sup> The requirement of distinctiveness in accordance with Article 4 of the CTMR is rather easy to meet. In this connection, *Davies* states that “[t]he Criterion which has to be applied is that of an *abstract* capability of distinguishing goods or services, which means that the sign has to be considered apart from the goods or services to which it relates.”<sup>247</sup> In practice, “no signs are *per se* excluded from being registered as a trade mark under Article 4 of the CTMR”.<sup>248</sup> The fact that capacity to distinguish is the core element in the definition under Article 4 of the CTMR reiterates the historic basis for trademark protection, which is to protect broadly trademarks as indicators of origin.<sup>249</sup> However, a non-specific subject matter considered to be concept-related, cannot be registered as a CTM for it has no capability to distinguish. In the *Dyson* case<sup>250</sup> a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner was held to be unregistrable. The ECJ’s decision in this case was, *inter alia*, based on the ground that a transparent bin or a collection chamber is a concept (i.e. a mere property of the vacuum cleaner concerned) which could not be regarded as a sign under Article 4 of the CTMR, since it encompassed, “in a

245 Cf. JACONIAH, J., “The Requirements for Registration and Protection of Non-Traditional Marks in the European Union and in Tanzania”, 40(7) IIC 756 (2009).

246 CORNISH, W. & LLEWELYN, D., “Intellectual Property: Patents, Copyrights, Trade Marks and Allied Rights” (6th ed.) 696 (Sweet & Maxwell, London 2007).

247 DAVIES, I. M. (ed.), “Sweet & Maxwell’s European Trade Mark Litigation Handbook” 36 (Sweet & Maxwell, London 1998).

248 DAVIES, I. M. (ed.), “Sweet & Maxwell’s European Trade Mark Litigation Handbook” 36 (Sweet & Maxwell, London 1998). See also Case C-273/00, *Ralf Sieckmann* [2002] ECR I-11737, para. 39 & Case C-283/01, *Shield Mark BV v. Joost Kist h.o.d.n. Memex* [2003] ECR I-14313, paras. 34 and 35. See further Case C-104/01, *Libertel Groep BV v. Benelux-Merkenbureau* [2003] ECR I-3793, para. 23 and Case C-49/02, *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, para. 22, which, in addition to reiterating the graphical representation and capability to distinguish as basic conditions a sign must fulfil in order to be registered, mention that the subject-matter of trademark application must be a “sign”.

249 CORNISH, W. & LLEWELYN, D., “Intellectual Property: Patents, Copyrights, Trade Marks and Allied Rights” (6th ed.) 688 (Sweet & Maxwell, London 2007).

250 ECJ, 25 January 2007, Case C-321/03, *Dyson Ltd* [2007] ECR I-00687, paras. 37 to 40.

general and abstract manner, all the conceivable shapes” of such a transparent bin or collection chamber.

## *II. Formal requirement – the graphical representation*

The requirement that a registrable sign must be capable of being represented graphically, as stipulated under Article 4 of the CTMR, is reinforced under Article 26 of the CTMR, which requires an applicant for CTM registration to furnish OHIM with a representation of the trademark.<sup>251</sup> The legal significance of the requirement for such a representation is mirrored by the fact that an application for trade mark registration may “claim special graphic features or colours, the use of small and capital letters and three dimensional marks” only through graphical representation.<sup>252</sup>

Graphical representation required under Article 4 of the CTMR does not mean actual reproduction of a sign in the register. Nevertheless, this is one methodology. The second method is to provide some contours representing the sign and some description enough to make the trademark examiner and other interested parties know what is claimed and the extent of the consequential monopoly.<sup>253</sup>

## *III. Essence of the formal requirement*

A trademark protection regime must, as a matter of principle, encourage and foster the principle of legal certainty.<sup>254</sup> A registered trade or service mark affords to its proprietor a monopoly over the exclusive use of the signs constituting such a trade or service mark.<sup>255</sup> The use of a registered trade or service mark by third parties having no authorisation from the owner infringes the exclusive right(s) bestowed upon the right holder. The legal certainty, in

251 Article 26(1) (d) of the CTMR.

252 KOOIJ, P.A.C.E. van der, “The Community Trade Mark Regulation: An Article by Article Guide” 60 (Sweet & Maxwell, London 2000). *See also* Rule 3(1) of the CTMIR.

253 DUMFARTH, P., “Prozessuale und materielle rechtliche Aspekte des Widerspruchsverfahrens der Gemeinschaftsmarkenverordnung” 39 (Trauner, Linz 2008). *Cf. also* FEZER, K.-H., “Die Grafische Darstellbarkeit eines Markenformats” 44, in: BOMHARD, V. von, PAGENBERG, J. & SCHENNEN, D., (eds.), “Harmonisierung des Markenrechts: Festschrift für Alexander von Mülendahl zum 65. Geburtstag am 20. Oktober 2005” (C. H. Verlag, München 2005).

254 *See the opinion of Advocate-General Ruiz-Jarabo Colomer in case C-273/00, Ralph Sieckman* [2002] ECR I-11737.

255 *Cf. Articles 9 and 8 of the CTMR.*