

relation to trade or service mark protection, should enable a person to know, through an inspection of the register the nature and scope of the signs protected as trade or service marks. This position is in line with a view that:

... the trade mark register is not supposed to be the result of an academic exercise in turning intangible concepts such as sounds and scents into words and pictures: it is a practical tool for any businessman who wants to go into business and who wants to know if he will get into legal trouble if he gives his goods a particular name, appearance, colour or smell. If the register cannot give him that information, it has failed in its primary objective.<sup>256</sup>

The legal monopoly with respect to a trade or service mark is not granted automatically. Such monopoly is contingent upon the applicant furnishing the examiners with information sufficient to establish clearly what the signs are, which constitute a service or trade mark in question. The clarity and preciseness of this information make others aware of what they must refrain from doing in relation to a registered trade or service sign. This is the major reason why graphical representation (under the CTMR) of a sign in the register is mandatory.

#### *IV. Formal and substantive requirements vis-à-vis non-traditional marks*

The standard required for the advancement of legal certainty under the CTMR is based on graphical representation. However, the CTMR does not give an exact and precise definition as to what the phrase “graphical representation” means. It only provides instances of signs that are capable of this kind of reproduction and representation.<sup>257</sup> Thus, it is pertinent to find out whether and how some new forms of trade symbols such as smells, sounds, colours and three dimensional marks<sup>258</sup> are responsive of the formal and substantive requirements for trademark registration under the CTMR.<sup>259</sup>

256 Cf. PHILLIPS, J., “Trade Mark Law: A Practical Guide” 65 (OUP, New York 2003).

257 Cf. Article 4 of the CTMR.

258 These signs are often referred to as non-traditional marks. For instance, while *Sehirali Çelik* uses the phrase in the article entitled „An overview of Turkish Case-Law on Trademark Disputes with Special Consideration Regarding the Rules of the European Court of Justice“, in 39(3) IIC 326 (2008); Ströbele refers to the same concept by using the phrase ‘new trademark forms’ in his article entitled “The Registration of New Trademark Forms”, in 32(2) IIC (2001).

259 For an extensive discussion on graphical representation of the non-traditional marks see JACONIAH, J., “The Requirements for Registration and Protection of Non-Traditional Marks in the European Union and in Tanzania”, 40(7) IIC 756 et seq. (2009). Cf. Also BENDER, A., “Die grafische Darstellbarkeit bei den neuen Markenformen” 157 et seq., in: BOMHARD, V. von, PAGENBERG, J. & SCHENNEN, D. (eds.), “Harmonisierung

However, it is important to mention one fact in the passing: there are no separate criteria for assessing the registrability of non-traditional signs. EU law, for example, does not require authorities to apply a stricter assessment of the registrability of new types of marks than it does for traditional marks.<sup>260</sup>

## 1. Smells

The EU trademark jurisprudence confirms that smells and sounds can be registered and function as trademarks. The case of *Ralf Sieckmann*<sup>261</sup> is recorded to have broken new ground as far as registration of intangible mediums such as smells are concerned. As it was the first in a number of ECJ decisions dealing with unconventional trademarks, it has become the leading decision also with regard to sounds, colours and colour combinations<sup>262</sup>, where initially, the capability of being represented graphically was also considered as problematic, although there was little doubt as to such signs being generally capable of distinguishing goods or services. In the case concerned, the applicant, Mr. Sieckmann, had offered to the German Patent and Trade Mark Office (Deutsches Patent- und Markenamt) the following modes of representation of his olfactory mark:

Trade mark protection is sought for the olfactory mark deposited with the Deutsches Patent- und Markenamt of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester), whose structural formula is set out.<sup>263</sup>

In addition, Mr. Sieckmann had offered to deposit a sample of the smell for which registration was sought. It seems, in light of the first question that the German Patent and Trade Mark Office referred to the ECJ, that the opinion

des Markenrechts: Festschrift für Alexander von Mülhendahl zum 65. Geburtstag am 20. Oktober 2005” (C. H. Verlag, München 2005).

260 ECJ, 8 April 2003, Joined Cases C-53/01 to 55/01, *Linde AG, Winward Industries Inc. & RadoUhren AG* [2003] ECR I-03161, para.49.

261 ECJ, 12 December 2002, Case C-273/00, *Sieckmann* [2002] ECR I-11737.

262 See for example Case C-283/01, *Shield Mark BV v. Joost Kist h.o.d.n* [2003] ECR I-14313, para. 28; ECJ, 24 June 2004, Case C-49/02, Case C-49/02, *Heidelberger Bauchemie GmbH* [2004] ECR I-06129, para. 25; Case C-104/01 *Libertel Groep BV v. Benelux-Merkenbureau* [2003] ECR I-3793, para. 28.

263 He added that “samples of this olfactory mark can also be obtained via local laboratories listed in the Gelbe Seiten (Yellow Pages) of Deutsche Telekom AG or, for example, via the firm E. Merck in Darmstadt.” He also gave the structural formula  $C_6H_5-CH = CHOOCH_3$  as a part of such description (Case C-273/00 *Ralph Sieckmann* [2002] ECR I-1173, para. 11).

prevailed prior to *Sieckmann*<sup>264</sup> that odours could neither be reproduced directly nor be perceived visually. In order to obtain clarification on this point, the German Patent and Trade Mark Office posed the question to the ECJ whether, in the light of Article 2 TD (which corresponds to Article 4 CTMR), smells which can in no way be perceived visually could be presumed to be capable of graphical representation if they are reproduced indirectly through certain aids. Based on a purposive interpretation of Article 2 TD, the ECJ concluded that since the list of signs capable of graphical representation contained in the Article does not claim to be exhaustive, odours and smells are not specifically excluded. For that matter, although smells are invisible, still they can be represented graphically “particularly by means of images, lines or characters”. However, such representation must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.<sup>265</sup>

Consequently, not each mode of representation will constitute an acceptable graphical representation of an olfactory sign. Concerning the modes of representation offered by Mr. Sieckmann,<sup>266</sup> the ECJ insists that “[in] respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words,<sup>267</sup> by the deposit of an odour sample or by a combination of those elements”.<sup>268</sup> With regard to those representations, it is further observed that:

- Only few people would recognise in a formula the subject matter of a trademark application (in this case an odour).
- Description of an odour is graphic representation which is not “sufficiently clear, precise and objective”.<sup>269</sup> Moreover, “such a description is

264 However, the USA Patent Office has been registering olfactory signs and sounds, and the UK Patent and Trademark Office has been registering smell marks, before the Sieckmann decision cf. Case C-273/00 *Ralf Sieckmann* [2002] ECR I-11737, para.59).

265 Case C-273/00 *Ralph Sieckmann* [2002] ECR I-1173, para. 55.

266 Although description of an odour is graphic, it is not sufficiently clear, precise and objective (Case C-273/00 *Ralph Sieckmann* [2002] ECR I-1173, para. 70).

267 This position is contrary to that reached by the OHIM Board of Appeals in *Vennootschap onder Firma Senta Aromatic Marketing's Application*, Case R 156/1998-2 [1999] ETMR 429; and *Myles Ltd's Application*, Case R 711/1999-3, [2003] ETMR 718 (OHIM) in which the description in words ‘the smell of fresh cut grass’ and ‘the scent of raspberries’ were respectively held to be sufficient graphical representation since the smells concerned were well-known to the extent that any one perusing the register would easily recognise the smell concerned, hence further graphical representation were considered unnecessary.

268 Case C-273/00 *Ralph Sieckmann* [2002] ECR I-1173, para. 73.

269 Case C-273/00 *Sieckmann* [2002] ECR I-1173, para. 70.

imbued with subjectivity and can be interpreted in a subjective way, that is, differently by different people”.<sup>270</sup>

- Due to the fact that “an odour sample is not sufficiently stable or durable”, deposit of such sample does not constitute a graphic representation for the purpose of Article 2 of the Directive”.<sup>271</sup>

Viewed in light of the ECJ’s observation above, “graphic representation seems sensibly to be limited to clear and easily determined means of describing sensations which can be appreciated by smell”.<sup>272</sup> The chance for such registrations to succeed is however minimal. Although OHIM had previously allowed registration of the smell of fresh-cut grass for tennis balls,<sup>273</sup> it rather seems that, in view of the *Sieckmann* case, “unless and until there is a further ruling, no more smell marks can validly be registered in the EU”.<sup>274</sup>

## 2. Sounds

Regarding sound marks, the ECJ, in *Shield Mark BV* case,<sup>275</sup> intimated that since sound signs are not by nature incapable of distinguishing the goods or services of one undertaking from those of other undertakings, Article 4 of the CTMR “must be interpreted as meaning that sounds may constitute a trade mark, on condition that they may also be represented graphically”.<sup>276</sup> Because in the *Sieckmann* case the ECJ had expounded the protectable subject matter enlisted in Article 4 of the CTMR to include signs which cannot be perceived visually but may be perceived through surrogate graphical representations,<sup>277</sup> the *Shield Mark* case held that although sound signs are a category of marks that cannot be perceived visually, they may be registered as CTM provided that other conditions (such as graphical representation) are met.<sup>278</sup>

270 Case C-273/00 *Sieckmann* [2002] ECR I-1173, para. 65.

271 Case C-273/00 *Sieckmann* [2002] ECR I-1173, para 71.

272 W. CORNISH & D. LLEWELYN “Intellectual Property: Patents, Copyrights, Trade Marks and Allied Rights” 691, 6th ed. (Sweet & Maxwell, London 2007).

273 Cf. *Vennootschap onder Senta Aromatic Marketing’s Application* [1999] ETMR 429.

274 FIRTH, A., et al, “Trade Marks – Law and Practice” (2nd ed.) 32 (Jordan Publishing, Ltd., Bristol 2005).

275 Case C-283/01, *Shield Mark BV v. Joost Kist h.o.d.n* [2003] ECR I-14313.

276 Case C-283/01, *Shield Mark BV v. Joost Kist h.o.d.n* [2003] ECR I-14313, paras. 36 and 37.

277 Case C-273/00 *Ralph Sieckmann* [2002] ECR I-1173, para 55.

278 Case C-283/01, *Shield Mark BV v. Joost Kist h.o.d.n* [2003] ECR I-14313, paras. 34 and 35.

Having established the view that sound signs are potentially capable of distinguishing goods or services within the ambit of Article 4 of the CTMR, the court proceeded with the decision as to which mode of graphical representation is suitable for such signs. The referring court had enumerated different forms of representation<sup>279</sup> and invited the ECJ to respond particularly on the suitability of those forms in respect of sound signs. In response thereto, the ECJ moved from an analogy that graphical representation (which may be effected by means of images, lines or characters) must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”<sup>280</sup>. It consequently concluded that:

In the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a music work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the sound is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.<sup>281</sup>

The ECJ did not rule upon the appropriateness of a sonogram as a means to represent sounds (e.g., the cry of animals)<sup>282</sup>. Hence, for the time being it is unclear in view of the *Shield Mark* case whether and how sound signs other than those consisting of a musical tune can meet the requirements for graphical representation, and thus for registration and protection as trademarks.

### 3. Colours

The EC trade mark regime<sup>283</sup> provides for a possibility to register a single colour. The ECJ in case C-104/01 *Libertel Groep BV v. Benelux-Merkenbureau* addressed the question whether “a colour per se, not having any shape or contour” can constitute a trade mark within the meaning of the EC trademark directive. In response thereto, the ECJ clarified that a colour may be registered as a CTM, provided it meets the substantive and formal requirements for

- 279 Such as musical notes; a written description in the form of an onomatopoeia; a written description in some other form; a graphical representation such as a sonogram; a sound recording annexed to the registration form; a digital recording accessible via the internet; a combination of those methods; some other form and, if so, which?
- 280 Case C-283/01, *Shield Mark BV v. Joost Kist h.o.d.n* [2003] ECR I-14313, para. 55.
- 281 See Case C-283/01, *Shield Mark BV v. Joost Kist h.o.d.n* [2003] ECR I-14313, para. 2 of the operative part.
- 282 Although the question had been posed; see above, note 273.
- 283 Article 4 of the CTMR.

registration.<sup>284</sup> This clarification has now settled the position of EC law also with respect to the registration of a single colour mark: If used in relation to goods, a colour can serve as a trademark. Distinctiveness of a single colour is thus derived from prior use. In this sense, a colour per se cannot be inherently distinctive, unless some exceptional circumstances apply to it such as where the classes of goods (or services) in respect of which the mark is protected are very narrow and the goods are sold (or the services are offered) in a specific market.<sup>285</sup>

Distinctiveness is not the sole decisive requirement for the registration of a colour mark. A colour mark must additionally fulfil the requirements regarding the capability to be represented graphically in a manner that is clear, precise, self-contained, intelligible, durable and objective.<sup>286</sup> A mere reproduction of a colour on a paper does not satisfy the requirement of graphical representation. However, the legal requirements are satisfied by a designation of a colour based on international identification code of the respective colour.<sup>287</sup>

The graphical representation of combination of colours may, as well, present some difficulties. The ECJ's holding in *Heidelberger Bauchemie GmbH*<sup>288</sup> confirms that colours or combinations of colours may serve a trademark purpose. In this regard, however, a trademark proprietor must limit, through graphical representation, the extent of his protectable subject matter so as to meet the precision and durability requirements of the formal procedure for trademark registration.<sup>289</sup> Graphical representation is not met by "the mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours in every conceivable form".<sup>290</sup> This is due to obvious reasons:

Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.<sup>291</sup>

284 Case C-104/01 *Libertel Groep BV v. Benelux-Merkenbureau* [2003] ECR I-3793, para. 1 of the operative part.

285 Case C-104/01 *Libertel Groep BV v. Benelux-Merkenbureau* [2003] ECR I-3793, paras. 66 and 67. The concept of distinctiveness is discussed below in section D (I) (2) of this chapter.

286 Cf. Case C-104/01 *Libertel Groep BV v. Benelux-Merkenbureau* [2003] ECR I-3793, para. 1 of the operative part.

287 Cf. Case C-104/01, *Libertel Groep BV v. Benelux-Merkenbureau* [2003] ECR I-3793, para. 1 of the operative part.

288 Case C-49/02, *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, paras. 40 and 41.

289 Case C-49/02, *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, para. 32.

290 Cf. Case C-49/02, *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, paras. 34 and 35.

291 Case C-49/02, *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, paras. 34 and 35.

Accordingly, the court rightly held that:

Colours or combinations of colours which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute trade mark... where:

- It has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and
- The application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way.<sup>292</sup>

#### ***D. Grounds for Trade Mark Refusal***

To qualify for registration, a CTM must be subjected to absolute and relative grounds for trademark refusal. These grounds are respectively discussed in sections D(I) & (II) of this chapter.

##### *I. Absolute Grounds*

While many signs may be used to market some products or services, not each of these trade symbols may withstand the rigorous registrability test stipulated under Article 7 of the CTMR. The Article serves as an absolute bar to registration of signs, which do not meet the requirements of Article 4 of the CTMR; or signs and indications which are generic, descriptive, non-distinctive and those signs covered under Articles 7(1) (f) – (k) of the CTMR. In summary, subparagraphs (f) to (k) prohibit the registration of signs which contravene public policy and/or good morals of the society; signs, the use of which is considered to be unauthorised use of emblems, badges or hallmarks; and geographical indications for wine not having that origin.

##### **1. Requirements of Article 4 of the CTMR**

Article 4 stipulates that, to constitute a CTM, a sign must meet both formal (capability to be represented graphically) and substantive (capability to distinguish goods and services) requirements. Article 7(1) (a) incorporates these requirements as absolute grounds for CTM refusal. Thus, the formal and

<sup>292</sup> Case C-49/02, *Heidelberger Bauchemie GmbH* [2004] ECR I-6129, para. 1.