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Anything that’s able to convey a meaning

Options and limits for protection of new forms of marks

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27.09.2022

Max Planck Institute
for Innovation and Competition

TUESDAY WEBINARS

PROGRAMME

50’
Presentation

1. **Introduction**
2. **General Requirements**
3. **New forms of signs (1):** interesting, but – until now - not so relevant in practice
4. **New forms of signs (2):** more relevant, and more difficult to handle legally
5. **Conclusion**

10’
Questions and answers

1 Introduction

Introduction. Why do we talk about "new" forms of marks?

In the early days of trade mark law… traders typically used their own name to identify the commercial origin of goods, possibly with some graphical elements added. Accepted were also other forms of word/graphics, such as fantasy marks or marks alluding to the product

Nivea = white as snow in latin, nix, nivis

Other forms of signs were either not accepted as trade marks, or, when accepted, they were not frequently used!

Introduction. Why do we talk about "new" forms of marks?

In the early days of trade mark law… some **relevance in practice was gained** by the **three dimensional shape of containers,** in particular **bottles**

Less frequent was protection for shapes or colours per se, or for sounds, tastes or smells

Introduction. The motives

Reasons for the reticent attitude by national legislatures

Consumers were not supposed to be able to identify such unusual signs as indications of origin

Protection for product configurations (shapes) would disrupt the principle that trade mark protection does not interfere with the **freedom of competition** on the product market

Introduction. EU Law

1 **In EU law…** there has been a **liberal approach** by accepting for registration **any form of sign** that is capable of distinguishing goods or services as to their origin

2 COURT OF JUSTICE OF THE EUROPEAN UNION »

This also **applies to colours per se** and to **signs that are not visually perceptible,** even though they were (originally) not mentioned in the exemplary list of signs eligible for registration (CJEU in Shield Mark)

Some **restriction** originally resulted from the requirement of **graphical representability**. While the requirement has been **abolished**, the **substantive criteria remain in force**.

Introduction. Some statistics

	Registered EUTMs filed on and beyond 1.10.2017	Overall number (where available)
Word	308175	830672
Figurative	258132	642298
3D	1298	5250
Motion	123	n/a
Sound	107	n/a
Position	99	n/a
Multimedia	58	n/a
Colour	49	281

2 General Requirements

General Requirements (just a reminder…): Art. 7(1)(a),(b) – (d), (e) EUTMR

Signs are eligible for protection under the EUTMR if they…

1

…are **capable of distinguishing goods/services** as to **commercial origin** and can be **represented in a manner that clearly identifies the subject-matter of protection (Art. 4, 7(1)(a) EUTMR)**

2

…are **not devoid of any distinctive character,** nor **descriptive,** nor **have become customary in bona fide trade (Art. 7(1)(b) – (d) EUTMR)**

3

…**do not exclusively consist of the shape or other characteristic** of the product which **results from the nature of the goods is necessary to produce a technical result** or which **gives substantial value to the goods (Art 7(1)(e) (i) – (iii) EUTMR)**

Applies to all signs alike, but in practice, **for new forms of marks**, the fulfillment of those requirements can be **more difficult**

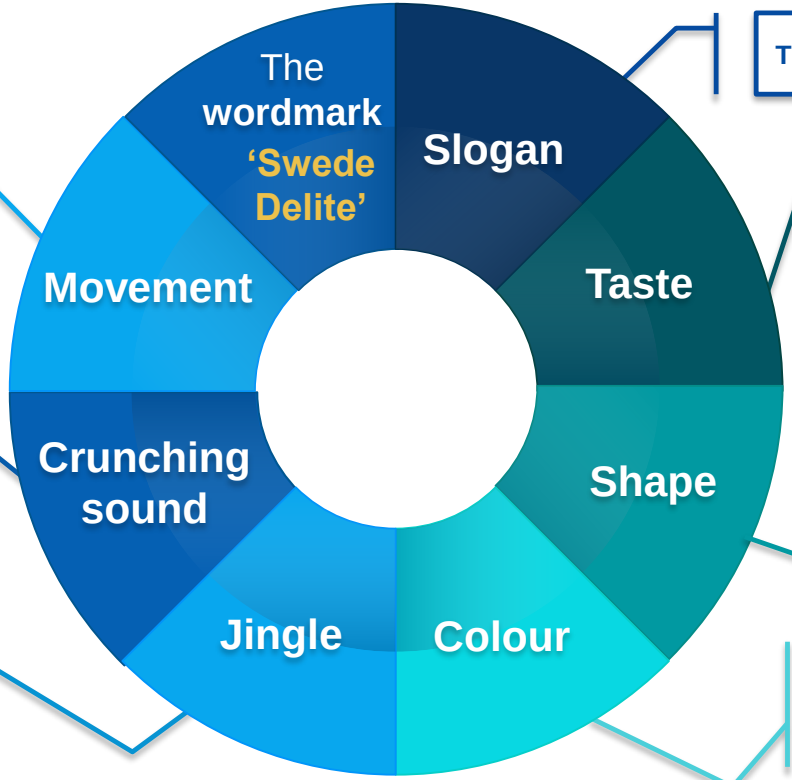
General requirements. Hypothetical case

Swedish citizen Lars P. has created a new type of candy bar…

He wants trade mark protection for…

General requirements. Hypothetical case

General requirements



The **slogan** 'A taste to go nuts for'

The **movement** of the bar slowly rotating and then being broken up to show the inside

The **taste**, described as 'a rich mixture of chocolate with an overtone of toffee and premium choice almonds, with a light spicy note of chili and ginger'

The **'crunching' sound** followed by a deep 'Mhhhh'

The **shape**:

The **jingle** to be played in radio and tv ads

The **colour** of light shade of orange to be used on the product package

3 New forms of signs (1)

Interesting, but – until now – not so relevant in practice

New forms of signs (1). Smells and tastes: Sieckmann criteria

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'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 below. 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.

$C_6H_5\text{-}CH = CHCOOCH_3$.'

Case reference

12/12/2002, T-619/21, **SIECKMANN**, ECLI:EU:C:2002:748

In **Sieckmann** was found that **(graphical) representation of a smell by**

- a description
- a chemical formula
- deposit of a smell sample

was **not able to satisfy the relevant criteria**

Representation must be **"Clear, precise, self-contained, easily intelligible, accessible, durable and objective" (Sieckmann-Formula)**

New forms of signs (1). Smells and tastes: Current situation

Even after the law reform, smells and tastes are not registrable, as the Sieckmann-criteria presently cannot be fulfilled

However, by renouncing to ‘graphical’ representation, Art. 4 EUTMR has become more flexible and open to changes, if modes for representation of smells (or tastes?) by digital means should be improved

Digital scent technology (or olfactory technology) is **the engineering discipline dealing with olfactory representation.** It is a technology to **sense, transmit and** receive **scent-enabled** digital media (such as motion pictures, video games, virtual reality, extended reality, web pages, and music).

…

New forms of signs (1). Smells and tastes: more (potential) obstacles

Even if clear and precise representation of **smell (and taste) marks** becomes possible, they may remain **precluded from protection** due to

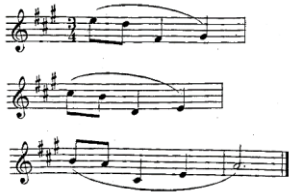
Lacking distinctiveness
E.g. in our example: is the taste 'special' enough?
Descriptive Character
Does the taste/smell indicate the ingredients?
Functionality would arguably 'kill' potential attempts of perfume makers to obtain protection for smells via trade mark law

New forms of signs (1). Smells and tastes: further questions

What about tastes or smells that hide the toxic character of substances?

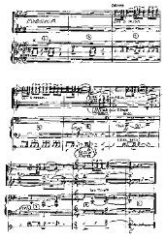
New forms of signs (1). Sound marks: eligibility for protection (Art. 4 EUTMR)

Tunes were considered as unproblematic already under Art. 4 CTMR if they were represented by proper musical notation



NOKIA
tune

Trade mark number	001312008
Type	Sound
Filing date	16/09/1999
Registration date	09/03/2001

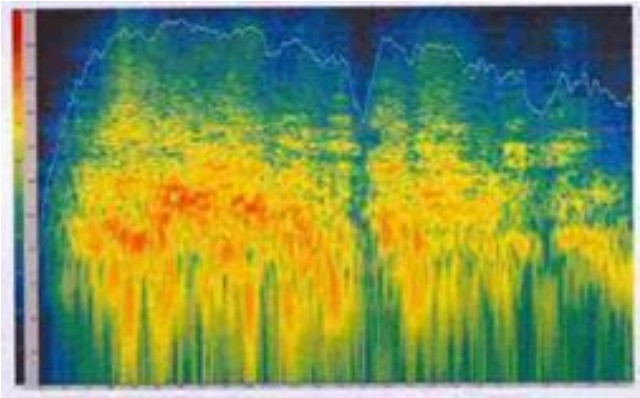


TWENTIETH CENTURY FOX
tune

Trade mark number	001312008
Type	Sound
Filing date	16/09/1999
Registration date	09/03/2001

New forms of signs (1). Sound marks: eligibility for protection (Art. 4 EUTMR)

Sounds were equally accepted by OHIM on the basis of sonagrams (plus sound recording), while they were rejected by some national offices (e.g. the German PTMO) for lack of easy intelligibility.



The **problems were solved by the law reform**; sound files are now universally accepted in the EU as adequate mode of representation

New forms of signs (1). Sound marks: Obstacles to protection of sounds under Art. 7 (1)(b) EUTMR

Sounds are not considered as distinctive …

When they are

- **very brief and/or unspecific,** and/or
- **perceived as technical or functional elements** (GC, T-668/19 – Ardagh)

Same would apply to the ‘crunching’ sound in our example

New forms of signs (1). Sound marks: Obstacles to protection under Art. 7 (1)(c), (e) EUTMR

Sounds or tunes may also be descriptive…

E.g.:
the song ‘Happy Birthday’ for greeting cards;
an onomatopoeia as ‘Yum, yummy’ for snacks;
animal sounds (barking, meow) for pet food

Questionable whether **sounds** are **functional** in the sense that they result from the nature of the goods if they result from the technical configuration of the goods (e.g. machine sounds)

New forms of signs (1). Sound marks: Obstacles to protection under Art. 7 (1)(f) EUTMR?

Tunes may be problematic…

If they contain (parts of) national anthems, religious hymns or cherished pieces of (national) cultural heritage (as addressed with regard to artworks by the EFTA Court in E-5/16 – Municipality of Oslo (Vigeland)

Even if legally acceptable, registration of such signs may **generate massive waves of negative publicity** on social media

New forms of signs (1). Motion marks: eligibility for protection (Art. 4 EUTMR)

Movements could already be registered **under Art. 3 CTMR** on the basis of images showing the different phases of the move (same for holograms).

Here is an **example**:

Registration is rendered **more precise** by the option provided under Art. 4 EUTMR to submit video files

New forms of signs (1). Motion marks: Obstacles to protection under Art. 7(1)(b) EUTMR

Movements may be **non-distinctive…**

If they are **unspecific** and **banal**, such as in our example the bar rotating and being broken up to show the inside

New forms of signs (1). Movement marks: Obstacles to protection under Art. 7(1)(c),(e) EUTMR

Movements may also be descriptive…

If they merely illustrate the **technical** or **functional specificities** of goods

Questionable whether in the latter case movements are also functional in the sense of Art. 7(1)(2)(ii) (see R-772/2002-1 – Lamborghini)

New forms of signs (1). Multimedia marks

Given the omnipresence of electronic devices in peoples' lives, condensing core elements of audiovisual product presentations into a concise form for which trade mark protection is sought may have **great potential**

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Case reference

12/06/2019, C-705/17, **HANSSON**, ECLI:EU:C:2019:481

Practical advantage: The presence of **just one non-negligible, distinctive element renders the entire trade mark protectable**, to the effect that in a conflict situation, account must be taken in the **overall assessment** of even the clearly non-distinctive elements

4

New forms of signs (2)

More relevant, and more difficult to handle legally

New forms of signs (2). Colours per se and colour combinations: Requirements under Art. 4 EUTMR

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Case reference	Case reference
06/05/2003, T-104/01, **LIBERTEL**, ECLI:EU:C:2003:244	24/06/2004, C-49/02, **Heidelberger Bauchemie**, ECLI:EU:C:2004:384

In **Libertel** and **Heidelberger Bauchemie** the conditions for registration of **colours per se** and **colour combinations** were defined:

Colours must be specified as precisely as possible, preferably with the help of an internationally recognized colour code.

New forms of signs (2). Colours per se and colour combinations: Requirements under Art. 4 EUTMR

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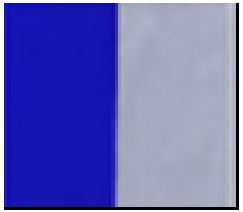

Case reference

29/07/2019, T-104/01,
RED BULL
ECLI:EU:C:2019:641

Non-compliance with the **Libertel and Heidelberger Bauchemie** requirements **leads to cancellation**

New forms of signs (2). Colours per se: Obstacles arising under Art. 7(1)(b) EUTMR

"For consumers … a colour per se is not, in current commercial practice, used as a means of identification."

Furthermore,

"It must … be acknowledged that ***there is, in Community trade-mark law, a public interest in not unduly restricting the availability of colours for the other operators*** *who offer for sale goods or services of the same type as those in respect of which registration is sought."*

(CJEU in Libertel)

Different from other forms of signs, consideration of competitors' **'need to keep free'** is **not limited to Art. 7(1)(c) EUTMR**

New forms of signs (2). Colours per se and colour combinations: Obstacles arising under Art. 7(1)(b) or (e) EUTMR

In view of that, **colours** per se (and colour combinations) are **not** likely to be considered as **inherently distinctive.**

- **Certain colours** may even be considered as **functional** when they result from the nature of goods, such as bright orange for salvage vests, or bright red for fire extinguishers

- **Certain colour combinations** may also be perceived as **heraldic imitations of state flags**

New forms of signs (2). Product shapes and surfaces

Product shapes: Registration based on inherent distinctiveness is possible, but rather infrequent

The **same applies to elements forming an integrated part of the product appearance**, such In addition as e.g. surface decoration (C-26/17 P – Birkenstock), **as well as to packaging and containers.**

In addition, **shape marks often face problems** resulting from **Art. 7(1)(e)**

New forms of signs (2). Product shapes and surfaces: The leading decisions

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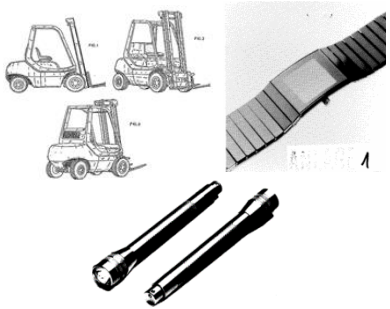

Case reference

08/04/2003, C-53/01 to C-55/01, **LINDE and others**, ECLI:EU:C:2003:206

Case reference

04/10/2007, C-144/06 P, **Henkel,** ECLI:EU:C:2007:577

*… It may in practice be **more difficult to establish distinctiveness** in relation to a **shape of product mark** than a word or figurative trade mark*

*… The **more closely the shape for which registration is sought resembles the shape** most likely to be **taken by the product** in question, the **greater** will be the **likelihood of the shape being devoid of any distinctive character***

New forms of signs (2). Product shapes and surfaces: Practical effects

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Case reference

28/06/2019, T-340/18, **GIBSON Brands**, ECLI:EU:T:2019:455

*…The examination of whether shapes **"depart significantly..."** must proceed from a **given market and the perception as well as** – where that applies – **the sophistication of members of the target group***

- The presence of **aesthetic qualities** is **not decisive**
- It is **not sufficient** that the shape (or pattern) presents a **variation of existing schemes**

New forms of signs (2). Product shapes and surfaces: Practical effects

Is the combination of fishbones and candy bar sufficient to make it depart from the norms and customs of the sector concerned?

Practical solution:

Adding a distinctive element, such as a logo, to the shape.

New forms of signs (2). Product shapes and surfaces: shape ‘in isolation‘ and with logo added

NEGATIVE RESULT

POSITIVE RESULT

New forms of signs (2). Product shapes and surfaces: Descriptive character, Art. 7(1)(c)

Product shapes can also be descriptive (CJEU in Linde, Winward, Rado, concerning ex Art. 3(1)(c) TMD).

However, in practice that option appears **moot**; the only **relevant obstacles** for protection of shapes are **non-distinctiveness** and **functionality (Art. 7(1)(e) EUTMR).**

New forms of signs (2). Product shapes and surfaces: Functionality (reminder)

Signs shall **not be registered** when they consist exclusively of:

(i) **the shape, or another characteristic,** which results from **the nature of the goods** themselves;

(ii) **the shape, or another characteristic,** of goods which is **necessary to obtain a technical result**;

(iii) **the shape, or another characteristic,** which gives **substantial value** to the goods;

Extension to 'another characteristic' does not apply retroactively (C-21/18 – Textilis v. Svensk Tenn). *No relevant practice on 'other characteristics' until now.*

New forms of signs (2). Product shapes and surfaces: Steps and mode of assessing functionality

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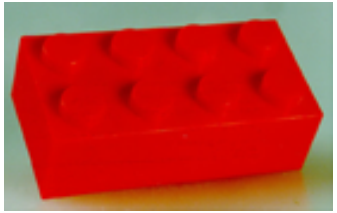

Case reference

14/09/2010, C-48/09 P, **LEGO**, ECLI:EU:C:2010:516

1

*… identification of the **essential characteristics** …may… be **carried out by means of a simple visual analysis** of the sign or … be based on a **detailed examination ….,** such as **surveys or expert opinions,** or **data relating to intellectual property rights** conferred previously…*

2

*… sign's **essential characteristics must all perform the technical function of the goods** at issue.*

New forms of signs (2). Product shapes and surfaces: Steps and mode of assessing functionality

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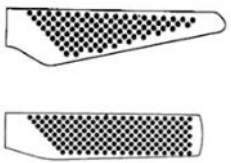

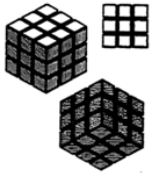

*…[Technical] functionality must not be assessed solely from the graphical image filed with the application**; account must also be taken of the actual product** (if available on the market) **as well as of other evidence** (e.g. patent documentation).*

Case reference

06/03/2014, C-337/12 P,
Pi-Design and Others
ECLI:EU:C:2014:129

Case reference

10/11/2016, C-30/15 P,
Simba Toys
ECLI:EU:C:2016:849

New forms of signs (2). Product shapes and surfaces: Product-inherent functionality Art. 7(1)(e)(i)

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Case reference

14/09/2014, C-205/13,
Hauck v. Stokke
ECLI:EU:C:2014:2233

*… the concept of a 'shape which results from the nature of the goods themselves' means that shapes with essential characteristics which are inherent to the generic function or functions of **such goods** must, in principle,… be denied registration.*
*… **reserving such characteristics to a single economic operator** would make it **difficult for competing** …*

… it is clear that those are essential characteristics which consumers will be looking for in the products of competitors, given that they are intended to perform an identical or similar function

New forms of signs (2). Product shapes and surfaces: What is meant by “such goods”?

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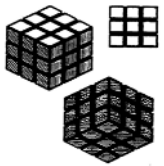
Case reference

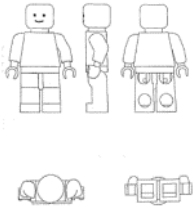
10/11/2016, C-30/15 P,
Simba Toys
ECLI:EU:C:2016:849



‘Three-dimensional puzzle’ (reg.) or ‘puzzle in the form of a magic cube’?

Case reference

16/06/2015, T-396/14, **Lego figurines**
ECLI:EU:T:2015:379



‘Games and playthings’ (reg.) or ‘humanoid figurines to be used in a system of interlocking elements’?

? How broadly (or narrowly) should the relevant product category be defined for assessing whether the essential characteristics of a given shape are technically functional or inherent in the generic functions of that kind of product?

New forms of signs (2). Product shapes and surfaces: Technical Functionality Art. 7(1)(e)(ii)

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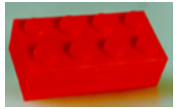
Case reference

18/06/2002, C-299/99,
Philips v. Remington
ECLI:EU:C:2002:377

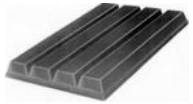
…the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution



Case reference

14/09/2010, C-48/09 P, **LEGO**,
ECLI:EU:C:2010:516

The prohibition *….ensures that undertakings may not use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions*



Case reference

16/09/2015, C-215/14,
Nestlé v. Cadbury ECLI:EU:C:2015:604

… refers only to the manner in which the goods at issue function and it does not apply to the manner in which the goods are manufactured

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New forms of signs (2). Product shapes and surfaces: aesthetic functionality, Art. 7(1)(e)(iii)

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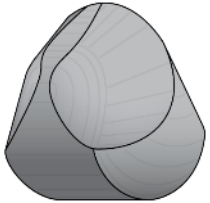


LEADING CASES:

14/09/2014, C-205/13,
Hauck v. Stokke
ECLI:EU:C:2014:2233

23/04/2020, C-237/19
Gömböc
ECLI:EU:C:2020:296

New forms of signs (2). Product shapes and surfaces: aesthetic functionality, Art. 7(1)(e)(iii)

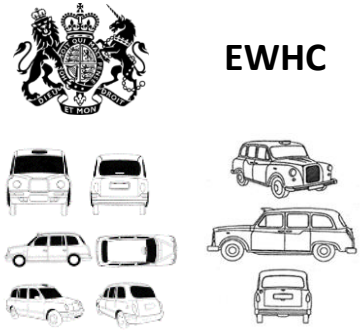
C-205/13 – Hauck v. Stokke	C-237/19 - Gömböc
…The immediate aim …is ***to*** ***prevent the exclusive and permanent right*** *which a trade mark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods*	*… The fact that* ***the*** ***appearance of a product is protected as a design does not prevent*** *a sign consisting of the shape of that product from benefiting from* ***protection under trade mark law****…*
	Ban applies *if* ***it is apparent*** *from objective and reliable evidence* ***that the consumers' decision to purchase*** *the product in question is to a large extent* ***determined*** *by the relevant characteristic.*
Ban also includes ***functional qualities*** *that are* ***intrinsic*** *to shape*	*To be disregarded are* ***extrinsic aspects,*** ***such as*** *the* ***story of the item's creation****, method of production, materials contained, or even the* ***identity of its designer****.*

New forms of signs (2). Product shapes and surfaces: Open question

BoA

Cases R 24/2018-5 and R-486/2010-2

EWHC



Case reference

London Taxi [2016] EWHC 52 (Ch) (20 Jan 2016

'Extrinsic to shape' is also the **reputation of a mark** as an indication of origin…

Difficult, but necessary and crucial:
Distinguishing between **value resulting from the shape as such,** and **value resulting from the reputation of the designer/maker, or from its recognition as an indication.**

New forms of signs (2). Product shapes and surfaces: Relationship between the three types of functionality

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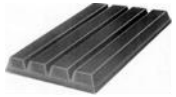
Case reference

14/09/2014, C-205/13,
Hauck v. Stokke
ECLI:EU:C:2014:2233



Case reference

16/09/2015, C-215/14,
Nestlé v. Cadbury
ECLI:EU:C:2015:604

… The three grounds for refusal of registration operate independently of one another, meaning that signs are banned from registration if one of them fully applies.

For instance if the shape of the Gömböc is not considered as aesthetically functional because the main motive for purchasing it is not the shape as such, but the story of its creation, it might still have to be banned from registration because it results from the nature of the product to incorporate the proof of a particular mathematical discovery

New forms of signs (2). Patterns and surface decoration: Distinctive character, Art. 7(1)(b) EUTMR

Pattern and surface decoration

- Regularly **non-distinctive**; similar standards apply as in regards to shape marks
- **No valid factor** that consumers are likely to distinguish goods according to the label regularly attached to them

Case reference

20/10/2011, C-344 and 345/10, **Freixenet**
ECLI:EU:C:2011:680

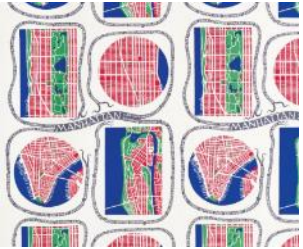
New forms of signs (2). Patterns and surface decoration: Functionality, Art. 7(1)(e) EUTMR

Pattern and surface decoration

- May give **substantial value** to the goods covered
- Signs already registered before the provision was extended to ‘other characteristics’ are safe from cancellation unless the feature is **indissociable from the product** on which it appears

Case reference

14/03/2019, C-21/18
Textilis v. Svenskt Tenn
ECLI:EU:C:2019:199



New forms of signs (2). Position marks

Position marks consisting of **elements affixed at a product at a specific position**.

Can be considered:

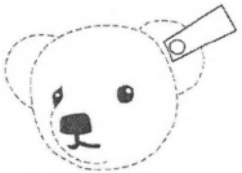
- **non-distinctive** if they are primarily perceived as functional elements or
- as a **common type of ornament or decoration** forming part of the overall appearance of the product.

New forms of signs (2). Position marks

Case reference

16/06/2011, R-2272/2010-2
Louboutin

In Louboutin… ***the colour red… applied to the sole*** *of a high-heeled shoe… departs significantly from the norms or customs of the sector… The trade mark… will be perceived as* ***imaginative, surprising and unexperienced****. It draws the attention to such an extent that it will be easily remembered.*



Case reference

16/01/2014, T-434/12
Stofffähnchen im Stofftierohr
ECLI:EU:T:2014:6

In 'button in the ear' of a teddy bear… *the sign does not depart significantly from the norm or customs of the sector… tags and buttons are common decorative elements of soft toys… the rectangular tag and the round button device are simple geometrical forms… the sign applied for may serve a functional purpose…*

Case reference

15/06/2010, T-547/08,
X Technology Swiss
ECLI:EU:T:2010:235

In **Orange colouring of the toe of a sock** *by reason of the absence of any significant divergence* ***from the norms or customs of the hosiery sector****, the mark applied for would be perceived* ***by the relevant public*** *as a decorative element*

5 Conclusion

Not so "new" any more… but still fascinating

Smells and **tastes**

Tunes, sounds, movements, multimedia

Colours per se and **colour combinations**

- **Unfeasible for now, with uncertain future**
- **Issues may arise under Art. 7(1)(b) – (f), but no major problems**
- **Rarely granted, but potentially very powerful**

Shapes per se and surface decoration – a lottery game?

Protection of product **shapes** per se, **surface decoration** and **position marks** remains precarious

In particular concerning **shapes**:

- the CJEU has over time **tightened the protection requirements**, not least by expanding on the ambit of Art. 7(1)(e)
- **Crucial questions remain open**
- **Case law is not clear and consistent**
- **Borderlines** between Art. 7(b),(c) and the individual items in 7(1)(e) are **blurred**

Anyone here with a better solution??

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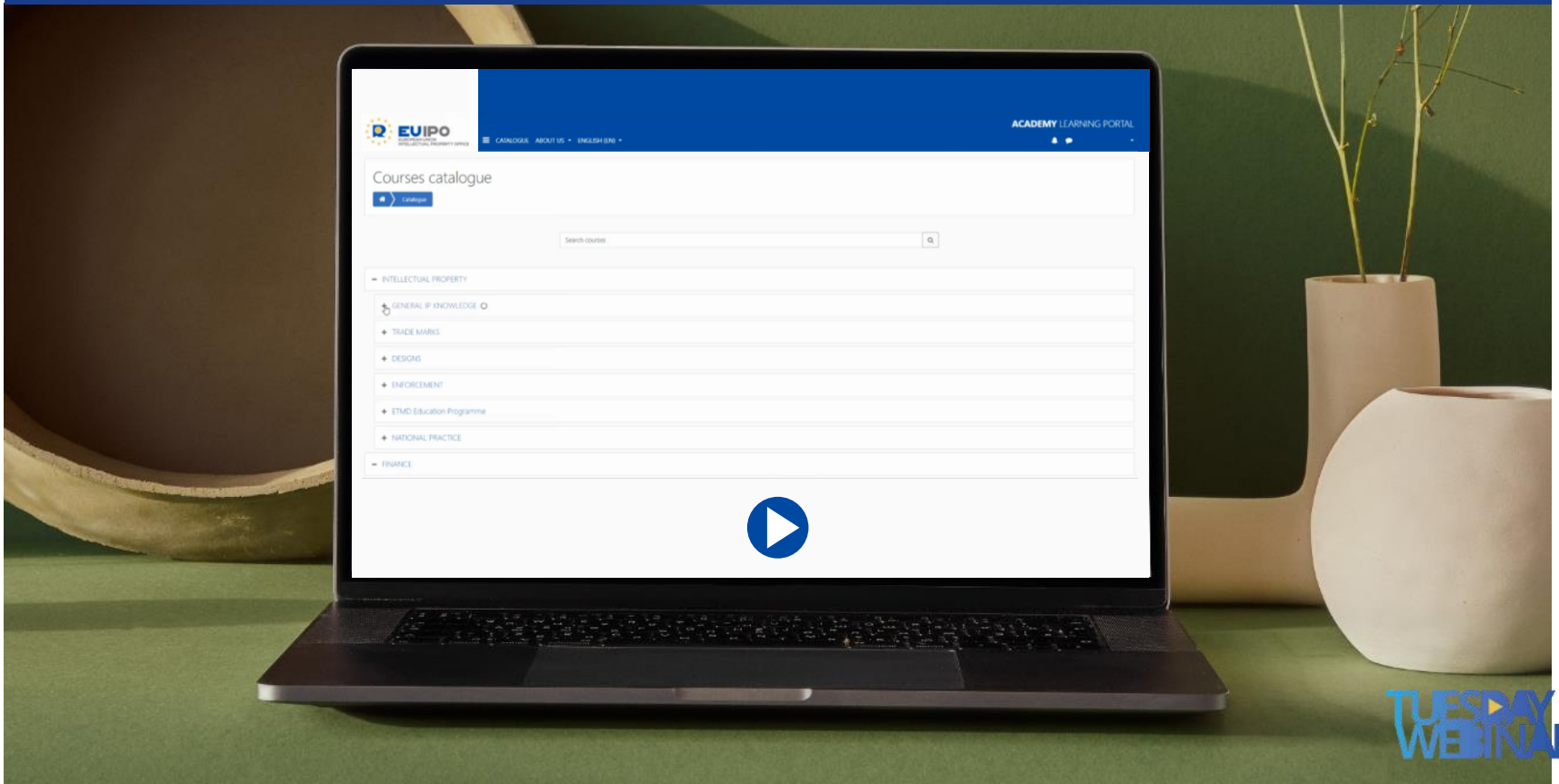

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