

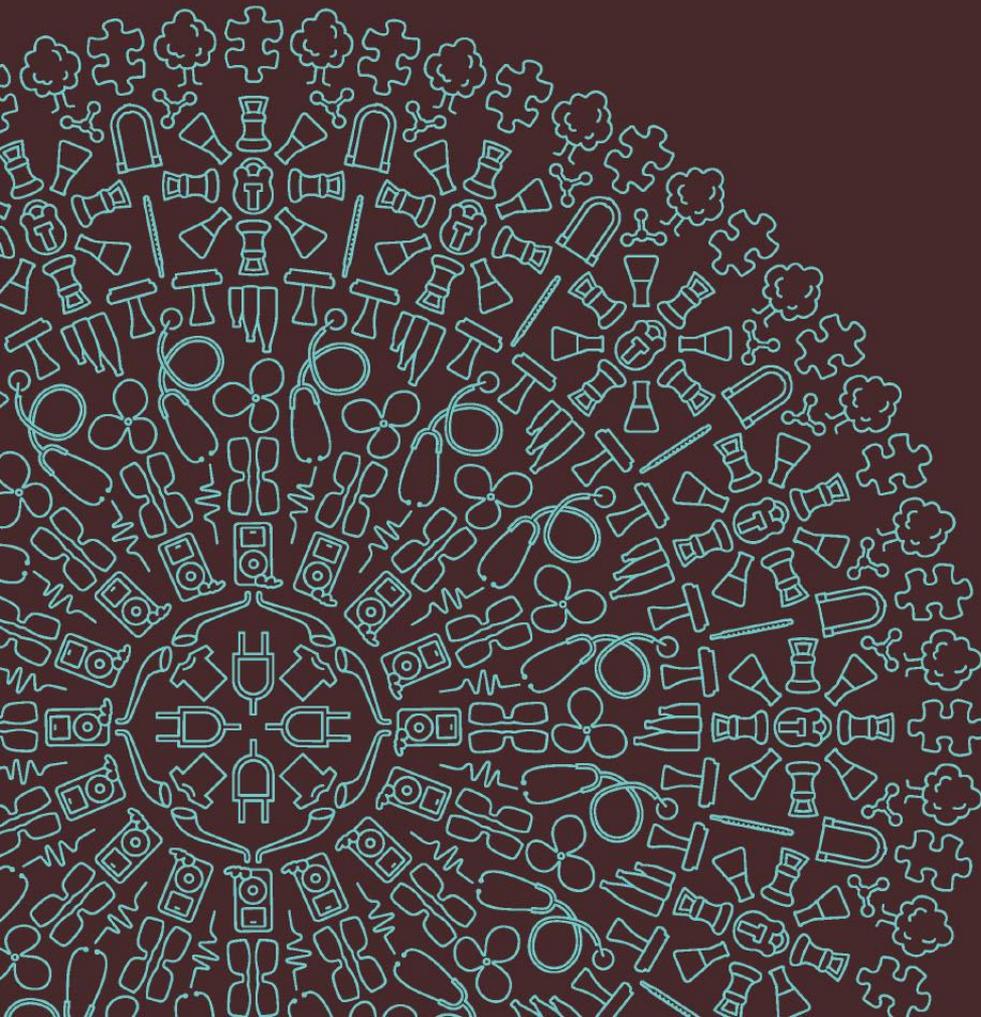
# BRISTOWS

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Will the removal of the "graphical representation" requirement in the EUTMR make a difference when registering non-traditional marks?

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# Agenda

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1. EU Trade Mark Reform: what has changed and why?
2. What hasn't changed?
3. The impact on non-traditional trade marks



# Legal Framework

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## The Old Framework

- Community Trade Mark Regulation (Council Regulation (EC) 207/2009)

## The New Framework

- EU Trade Mark Regulation (2015/2424) amending 207/2009
- Implementation Regulation (2017/1431)
- EU Trade Mark Regulation (2017/1001) (codified)
- Trade Marks Directive (2015/2436) **[Jan 14 2019]**

# The Old Regulation

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## Council Regulation (EC) No 207/2009

- *Article 4: Signs of which a Community TM may consist*

A Community trade mark may consist of any signs capable of being represented graphically...provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

- *Article 7: Absolute grounds for refusal*

The following shall not be registered:-

(e)

- (i) the shape which results from the nature of the goods themselves;
- (ii) the shape of goods which is necessary to obtain a technical result;
- (iii) the shape which gives substantial value to the goods.

## Pre amendment CJEU case law

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### *Sieckmann v Deutsches Patent und Markenamt C-273/00*

- Olfactory mark for chemical substance methyl cinnamate
- Function of the graphic representation requirement is to define the mark to determine precise protection afforded
- Register enables accessibility to authorities and economic operators- for both to know with **clarity and precision** the nature of the signs
- In order to understand scope must be **self contained, easily accessible and intelligible**
- To fulfil its role it must be **perceived unambiguously** and in the same way so that it guarantees indication of origin
- Given it can be renewed it must be **durable**
- Avoid subjectivity so must be unequivocal and **objective**

## Pre amendment CJEU case law

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### ***Libertel***

- Considered registrability of single colours – orange rectangle for telephone books
- TM did not satisfy Sieckmann criteria
- Sample of colour on paper unlikely to be durable
- Written description may suffice – depending on circumstances.
- Designating colour using internationally recognised ID code would be precise and stable

### ***Heidelberger***

- Considered registrability of two colour combination
- Blue and yellow rectangle for various goods “in every conceivable form”
- Not precise and uniform – allowed numerous different combinations
- Must be systematically arranged by associating the colours in a predetermined and uniform way

### ***Shield Mark***

- First 9 notes of ‘Für Elise’; Cock crow
- Describing sounds in written language will not automatically fail
- Doesn’t need to be immediately intelligible – musical notation
- Verbal description of sounds lacked clarity and precision

# The New Regulation: An Overview

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## Amendments to: Article 4

Signs of which a ~~Community trade~~ **an EU** mark may consist

~~A Community~~ **An EU** trade mark may consist of any signs, ~~capable of being represented graphically,~~ **in** particularly words, including personal names, 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.**

# The New Regulation: An Overview

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## Amendments to: Article 7

### Absolute grounds for refusal

#### 1. The following shall not be registered:

##### (e) signs which 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;

# The New Regulation: An Overview

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## Why make any changes?

- The Proposal to Amend suggested the removal of 'graphically' will provide some more certainty for non traditional trade marks
- Representation by other means, not just graphical, might be preferable as it could provide more certainty
- Future proof- aim to allow the future registration of signs for sounds and smell

# The New Regulation: Article 4

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## Implementation Regulation (EU) 2017/1431

### Recital (6)

- Technical alternatives to graphic representation are afforded by new technologies
- Registration process being brought into line with technological developments

### Article 3: sets out technical requirements for each NTM

- Sound mark – audio file
- Motion mark – video file/sequential still images

## The New Regulation: Article 4

**So, the ‘Sign’ must still...**

- be a representation (albeit not a graphical one)
- Satisfy some of the Sieckmann criteria (now codified)

.....do the rest of the Sieckmann criteria apply?

## The New Regulation: *Sieckmann* codified

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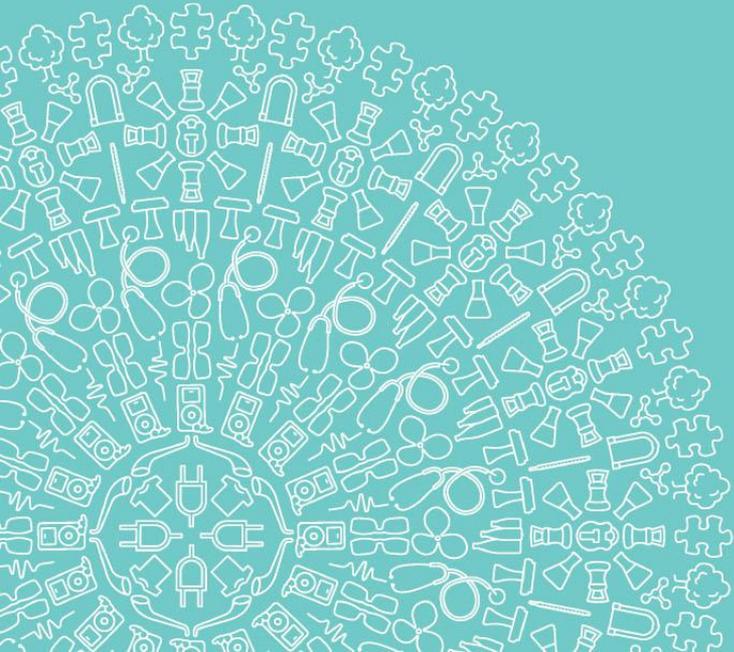
...YES

### EUTMR 2015 : Recital 9

*(9) In order to allow for more flexibility while also ensuring greater legal certainty with regard to the means of representation of trade marks, the requirement of graphic representability should be deleted from the definition of an EU trade mark. A sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is **clear, precise, self-contained, easily accessible, intelligible, durable and objective.***

EUTMR 2017: Recital 10 is drafted in similar terms.

What hasn't changed?



## Article 7: Absolute grounds

- **Article 4 gateway**
- **The now expanded [shape] and other characteristics exclusions**
- **Distinctive character**

## Why have an Article 4 'gateway'

***Sieckmann* explains the factors when considering interpretation of a sign:**

- About legal certainty- need to know scope of protection
- Concerns mainly the form - As Mummery LJ said in *Cadbury* (colour purple) the purpose of requirement of Art 2 /Article 4 (unamended) was to avoid abuse by operators in order to gain unfair advantage.

## The exclusions and how they apply to 'other characteristics'

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- **Art 7(e)(i) Nature of goods**

EUIPO Guidelines suggest an olfactory trade mark for scent of perfume could be excluded as forms exclusively nature of the goods

- **Art 7(e)(ii) Necessary to obtain technical result**

EUIPO Guidelines suggest a sound trade mark in relation to insect repellent might be excluded if the sounds in fact repels insects.

- **Art 7(e)(iii) gives substantial value to the goods**

*Hauck*- involved value that the shape gave to the goods

*Louboutin* – under old regime so question if sign is colour itself or shape and colour combination.

➤ What if was decided under new regime?

## Distinctive character requirement

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### Non traditional trade marks still face burden of overcoming distinctiveness issues- no change

- *Libertel*: “normally colour is a simple property of things”. Consumers not in habit of making assumptions about origin based on colour.
- *Mag*: consumers not normally make connection between the shape of goods and origin
- *Nestle v Cadbury* (shape of KitKat): the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company.

# Impact on non-traditional shape marks



## Non-traditional marks

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- The new Regulation now expressly includes sound and colour marks
- Drafting of the new Regulation and the TMD allows for the list of NTMs to be expanded in future to accommodate advances in technology.
- Implementation Regulation sets out specific rules and technical requirements for some of the most popular types of NTMs

## Sound marks

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### Pre EUTM Reform:

- Musical score, sonograph and spectrograms accepted to satisfy graphical representation requirement
- A description of the sound insufficient
- Sound files previously accepted, but in combination with a graphical representation.

# Sound marks

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## Post EUTM Reform

- TM offices may now accept digital sound files (JPEG/MP3) as a sole means of representation (though musical notation/sonograph may still be included for added clarity)
- Sound marks the easiest NTM to represent graphically – removal of graphical requirement unlikely to result in large increase in registrations
- Traditionally sound marks struggle with distinctiveness rather than [graphical] representation.
- Should provide more clarity on register – particularly for those who can't read music!

## Smell marks

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- Chemical  
formula/description/sample  
insufficient (*Sieckmann*)
- Image & description  
insufficient (*Eden*)

## Smell marks

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- EU legal system/technology not yet ready
- “Filing a sample/specimen cannot constitute representation of a TM (Art 3.9; Implementing Reg)
- Current technology for samples not easily accessible or durable
- Subject matter of protection cannot be determined with clarity/precision with generally available technology (EUIPO Guidelines for Examination)
- New drafting future proofs to allow for innovation and an improvement in technology

## Colours

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### **Colour (single)**

- Reproduction of the colour (JPEG) AND a reference to a general recognised colour code (ref to colour code not previously obligatory)
- No requirement for a description

### **Colour (combination)**

- Reproduction of the colour combination (JPEG) that shows the systematic arrangement of the colour combination in a uniform and predetermined manner AND an indication of those colours by reference to a generally recognised colour code
  - A description detailing systematic arrangement of the colours may also be added
- ***Red Bull*** – would the General Court decision have been different under the new Reg?

## Shapes

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- Historically, requirement to represent shape marks graphically not particularly onerous. Removal of graphical requirement unlikely to result in dramatic change

### ***Louboutin AG opinion***

- AG opinion – TM consists of the shape of the product, which seeks protection for colour too.
- Art 7(1)(e) “...*designed to prevent the monopolisation of external features of goods which are essential to their market success, and thus to prevent the protection conferred by the mark being used to gain an unfair advantage*”.
- Opinion would likely have been the same under the new regime.

## Motion and holograms

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- “*Mark consisting of, or extending to, a movement or change in the position of the elements of the mark*” (Imp Reg)
- A video file (JPEG/MP4) showing the movement or change of position can now be used as sole means of registration ,
- Series of still sequential images showing the movement now optional (previously mandatory)

