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Master Thesis

**Special Trade Marks – Legislation And The  
Situation In The European Community**

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**Intellectual Property Rights Law**

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# Summary

As already indicated by the title, this thesis concentrates on the legal and practical issues concerning special marks in the European Community. Chapter 1 contains some general remarks together with comments on the scope, purpose and methodology of this thesis. Chapter 2 discusses international conventions affecting trade marks in general and special marks in particular. The European Community legal instruments on trade marks as well as the main contents of the Community trade mark are addressed in Chapter 3. The author hopes that readers will obtain an overview of the Community trade mark situation after reading this chapter. Chapter 4 deals with the doctrine of functionality that is crucial in determining the requirement of distinctiveness for trade marks. The doctrine is also relevant to any discussion about the protection of special marks. The most important part of the thesis is discussed in Chapter 5. This chapter seeks reasonable answers to questions relating to special marks, e.g. what is the borderline between protectable and unprotectable special marks, what are solutions to the controversial issues of specific unusual marks. Finally, Chapter 6 summarises remarks drawn from previous Chapters.

# Preface

Trade marks have become a key factor in the modern world of international trade and market-oriented economies and have been and will remain increasingly important to the success of a wide range of businesses. A trade mark is an item of property that can be extremely valuable to its owner. It is the principal means of product recognition. It facilitates repeated purchases by satisfied customers. Wisely chosen, properly protected, and carefully used, a trade mark can, over time, become an asset of huge importance, ensuring significant returns on the original marketing and advertising investments. Together with the usual or traditional marks such as word and device marks, unusual marks such as 3D, colour, sound, and smell marks have also fulfilled these roles. These special marks, however, have been faced with many difficulties from both the legal and the practical side. Some of them have not even survived such controversy. Therefore, studying special marks is an interesting topic which has both legal and practical significance.

On this occasion, I would like very much to thank my supervisor, Professor Hans Henrik Lidgard, who suggested I take on this interesting subject and also gave me valuable comments and support.

# Abbreviations

art.	Article(s)
ass.	Assistant
AG	Advocate General
BCJ	Benelux Court of Justice
CFI	Court of First Instance
EC	European Community
ECJ	European Court of Justice
Co.	Company
Corp.	Corporation
CTM	Community Trade mark(s)
CTMR	Community Trade Mark Regulation
e.g.	For example
EU	European Union
GATT	General Agreement on Tariffs and Trade
Ibid.	Ibidem
INTA	International Trademark Association
IR	Implementing Regulation
IPR	Intellectual Property Right(s)
No.	Number
Nos.	Numbers
OHIM	Office for Harmonisation in the Internal Market (Trade marks and designs)
OJ	Official Journal
para.	Paragraph(s)
p.	Page
pp.	Pages
TRIPs	Agreement on Trade-Related Aspects of Intellectual Property
UK	United Kingdom
US	United State of America
USPQ	United States Patent Quarterly
USPQ 2d	United States Patent Quarterly second series
WIPO	World Intellectual Property Organisation
WTO	World Trade Organisation
v.	Versus
3D	Three-dimensional



# 1. Introduction

Until quite recently, the means of identifying one trader's products from those of another would be a word mark and perhaps also an accompanying device mark. This tradition has been overturned by recent changes in marketing and advertising practices. Nowadays, in order to maintain his market position, a trader often has to have, in addition to the traditional word and device marks, packaging with distinctive design in terms of colour and, if possible, shape, a slogan that appears both with the product and separately from it, and an advertising jingle or tune that, when heard, will immediately bring the product to mind. Even fragrances are also used to indicate their products. The development of these new practices has led to a recognition, both by the public and by most trade mark authorities, that a trade mark can now take many different forms. These special marks such as shape, colour, sound, smell, slogan, and certain others have appeared and now exist together with traditional marks.

In my country, Vietnam, trade marks have already proved their crucial importance. Vietnam became a member of the Paris Convention and the Madrid Agreement in 1949. Vietnamese trade mark legislation has been in conformity with these conventions. Vietnamese trade marks are mainly governed by the Civil Code<sup>1</sup> and the Decree No. 63-CP<sup>2</sup>. Accordingly, signs can be registered as trade marks provided broadly that are signs capable of distinguishing the goods or services of one trader from these of other traders. A trade mark may appear in the form of words, letters, pictures, or their combination in one or many colours<sup>3</sup>. Shapes that are not simple and not geometrical may be registered as trade marks<sup>4</sup>. It is clear that the Vietnamese trade mark legislation permits one to register any sign that is capable of distinguishing. Notably, colour and shape marks are included in the legal texts. Regretfully, in practice, the Vietnamese Industrial Property Office has just allowed 3D marks to be registered. With this thesis I have a good opportunity to compare the legal and practical issues relating EC law on trade marks in general and special marks in particular with those of my country. It, of course, also helps me to find out reasonable answers to problems raised by these issues.

This thesis focuses on the legal and practical concerns surrounding special marks in the EC. The aim is to answer a series of controversial questions relating to special marks including why they are recognised or objected to, what has happened to them recently, what are outstanding issues and what are their solutions, what is the dividing line between registrable special marks and unregistrable ones, and what the future of special marks is. The legislation and reality in the EC are the main references for answers of these questions. Some international and US considerations, however, are also discussed in this thesis. IPR, in

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<sup>1</sup> Civil Code of the National Assembly, 28/10/1995.

<sup>2</sup> Decree No.63 of the Government, 24/10/1996 detailing the regulations on industrial property. The provisions on trade marks can also found in legal documents of the other concerned State authorities, for example the Ministry of Science, Technology and Environment, Ministry of Trade.

<sup>3</sup> Art. 785-Civil Code.

<sup>4</sup> Art. 6(2)(a)-Decree No.63.

general, and trade marks, in particular, are non-border subjects. Further, the US is the historical leader in this field with the first registrations for special marks and is also the origin of important doctrines concerning trade marks such as the doctrine of functionality, that will be discussed in this work. Concerning the situation in particular EC Member States, the UK is referred to most frequently since it has been considered as the most diligent in protecting special marks.

Work on this thesis has been performed via descriptive, analysis, comparative, and synthetic methods. The materials have been gathered mainly from legal journals, and many of the sources are electronic.

## 2. International Conventions Affecting Trade Marks

Before the existence of any international agreement in the field of intellectual property, it was difficult to obtain unitary protection for IPR in various countries, since each nation had its own law based on its own particular legal doctrine and practice<sup>5</sup>. However, during the second half of the last century, international trade increased rapidly and internationally oriented flow of technology developed significantly. This situation required the legislation of various key countries on IPR to be unified and harmonised. The Paris Convention was the earliest international effort in the field of IPR. It has been followed by a series of multilateral and bilateral agreements.

### 2.1 Paris Convention<sup>6</sup>

The Paris Convention is the original Convention and an important pillar in the field of industrial property. It is applied in the widest sense to all kinds of industrial property, namely patents, registered designs and trade marks. The wording of the convention is quite broad, leaving a considerable discretion to its Member States as to how they are to implement the obligations provided for in it<sup>7</sup>. The Convention has provisions on trade marks but none of them are specifically on special marks.

Two “cornerstones”<sup>8</sup> of this Convention are the national treatment and the priority system. According to the national treatment, each contracting state must treat an overseas national who applies for a trade mark in the same way as it treats its own nationals. The system of claiming Convention priority means that after lodging a trade mark application in one State, the applicant is allowed a period of six months in which he can apply for a trade mark in other States and can in effect get those later applications backdated to the date of his first application. This gives him priority over later applicants.

### 2.2 Madrid Agreement<sup>9</sup>

The Madrid Agreement is a special Agreement under the Paris Convention, since only parties to the Paris Convention may join. It extends the general principles of the Paris Convention by enabling trade marks to be protected through the intermediary of a Central Registration Bureau based in Geneva. The Madrid system provides a procedural shortcut

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<sup>5</sup> WIPO III.

<sup>6</sup> Paris Convention for the Protection of Industrial Property was signed on 20 March 1883, came into effect on 7 March 1884 and has been revised several times, the last occasion being the Stockholm Amendment in 1967. This convention is administered by WIPO, based in Geneva. For further details, see WIPO III.

<sup>7</sup> Annand and Norman, p. 2.

<sup>8</sup> Robinson SC, p. 51.

<sup>9</sup> Madrid Agreement for the International Registration was signed on 14 April 1891, came into force 1892. For further details, see WIPO III.

for filing a batch of national applications by means of a single transaction, thus, saves transaction and representation costs.

This Agreement expresses the important role of national authorities<sup>10</sup>. It concentrates on procedural issues and mentions nothing about unusual marks.

## **2.3 Protocol Relating to Madrid Agreement<sup>11</sup>**

The objective of the Protocol was to make the Madrid system more attractive to non-members, since following the Madrid Agreement some major countries in the trade mark field were still absent, e.g. Japan, the UK and the US. It would also help create a link to other inter-governmental trade mark systems, especially the proposed CTM, thereby safeguarding the continuing relevance of the existing Madrid Agreement system. The Protocol also governs the system of international registration of marks, however, it makes some changes to the Madrid Agreement<sup>12</sup>. As the Madrid Agreement does, this Protocol concentrates on procedural issues and mentions nothing about unusual marks.

It is necessary to mention that the EC is not yet a party to this Protocol. Although the European Commission has tabled a proposal for the adhesion of the EC to the Protocol, the Council of the EC has still not taken a decision on these proposals<sup>13</sup>.

## **2.4 Trademark Law Treaty<sup>14</sup>**

The Treaty is flexible and merely declares that contracting States may not impose on trade mark applicants or proprietors any requirements over and above those laid down in the Treaty.

Interestingly, where almost all of international conventions mentioned above do not mention the protection of special marks (see also TRIPs below with its broad definition including colour mark), this Treaty provide explicitly that hologram and non-visible signs such as sound marks and olfactory marks are excluded from the scope of application. This is presumably because they are not easily reproduced by graphic means and because only few countries provide for the protection of these marks in their law<sup>15</sup>.

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<sup>10</sup> Art. 1(2) and (3) requires that before an application for a mark can be registered internationally, it must have been registered nationally by the national office of the country of origin. Merely filing an application will not be sufficient unless filing constitutes registration in that country.

<sup>11</sup> Protocol relating to the Madrid Agreement concerning the International Registration of Marks, was adopted in 1989, entered into force in 1995, and came into operation on April 1, 1996 including the four who are members of the EEC but not of the Madrid Agreement (Denmark, Greece, Ireland and UK). For further details, see WIPO III.

<sup>12</sup> See art. 2, 5(2)(c) and 8.

<sup>13</sup> See OHIM I.

<sup>14</sup> Trademark Law Treaty 1994, came into force on 1 August 1996. For further details, see WIPO III.

<sup>15</sup> WIPO III.

## 2.5 TRIPs<sup>16</sup>

TRIPs lays down minimum standards for the protection of all IPR including trade marks, copyright and related rights, geographical indications, industrial designs, patents, integrated circuits and confidential information. Its Member States are required to provide effective enforcement procedures in respect of those rights. The EC is a co-signatory along with its 15 Member States to this agreement, and the Community has shared competence with the Member States in this matter.

Many valuable provisions on protection of trade marks are found in TRIPs. So far, TRIPs is the sole international agreement providing a definition of trade mark in its art 15(1). This can be interpreted as being permissive and suggesting that member countries may also register signs that are not visually perceptible (to be discussed below).

## 2.6 Classification Agreements

### Nice Agreement for International Classification of Goods and Services<sup>17</sup>

For the purpose of assisting the registration of and search for trade marks, the Nice Agreement divides goods into 34 classes and services into 8 classes. It is kept constantly up to date by WIPO, with new products being added and old ones deleted<sup>18</sup>.

### Vienna Agreement for International Classification of the Figurative Elements<sup>19</sup>

This Agreement establishes a common classification of the figurative elements of marks. It comprises a list of sections into which marks consisting of two-dimensional designs or 3D shapes are classified<sup>20</sup>. Its aim is to facilitate searching but it has no effect on the scope of protection afforded to a mark. The Agreement has widespread influence and is used in both the Madrid and the Community systems.

## 2.7 Interim conclusion

International intellectual property conventions affecting trade marks were concerned principally with assisting the trade mark applicant in obtaining multiple national

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<sup>16</sup> Agreement on Trade-Related Aspects of Intellectual Property was concluded as part of the Uruguay Round on the re-negotiation of the GATT in 1994, which established the WTO. It entered into force on January 1, 1995. For further details, see WIPO II and WIPO III.

<sup>17</sup> Agreement of Nice for the International Classification of Goods and Services concluded in 1957. For further details, see WIPO III.

<sup>18</sup> See WIPO IV.

<sup>19</sup> The Vienna Agreement Establishing for International Classification of the Figurative Elements of Marks concluded in 1973. For further details, see WIPO III.

<sup>20</sup> See WIPO V.

registrations<sup>21</sup>. These conventions included the opened provisions for the contracting states and special marks were not provided specifically in any of them.

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<sup>21</sup> Annand and Norman, p. 2.

# 3. EC Trade Mark Legislation

## 3.1 EC trade mark legal instruments

### 3.1.1 EC Treaty

The expression “intellectual property” has not appeared in the Treaty, which has referred rather to “industrial and commercial property”<sup>22</sup>. Art. 295<sup>23</sup> provides that “the Treaty shall in no way prejudice the rules in Member States governing the system of property ownership”. The European courts, accordingly, considered that it could be argued that they had no jurisdiction at all for questions concerning IPR because art. 295 said that all questions of property had to be dealt with under national law. In order to get out of this situation, the ECJ found a “judicial solution”<sup>24</sup> by drawing a distinction between the existence of industrial property rights and their exercise. While the existence of industrial property rights remains unaffected by Community law, their exercise may come within the prohibition of the Treaty<sup>25</sup>. With this solution, pending harmonisation, questions concerning IPR were considered by the Court both under art. 81 and 82<sup>26</sup> that deal with competitive considerations and under art. 28 to 30<sup>27</sup> that concern the free movement of goods. Questions of IPR are now settled more unitarily and conveniently by applying the harmonised intellectual property system of legislation in the Community.

### 3.1.2 First Council Directive 89/104/EEC<sup>28</sup>

Trade marks have long been recognised as one of the most valuable assets of a business. The national laws on trade marks of the Member States, unfortunately, had wide disparities and thus an adverse impact on the internal market. Therefore, “the creation on a unitary trade mark system in the Community was a logical development in the creation of a Common Market”<sup>29</sup>.

The First Council Directive 89/104/EEC (hereinafter Harmonisation Directive) was introduced with the aim of reducing the differences between national trade mark systems which result in barriers to trade and which affect free movement of goods and services, thereby hindering the development of a single market. The Harmonisation Directive does not affect the rules on procedure and is limited to rules on substance. By harmonising the national trade mark laws of Member States, “the Directive is intended to limit to some extent

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<sup>22</sup> Groves, Martino, Miskin and Richards, p. 2.

<sup>23</sup> Ex art. 222.

<sup>24</sup> Groves, Martino, Miskin and Richards, p. 4.

<sup>25</sup> The test of distinction between “existence and exercise” was affirmed in the landmark case C-78/70 Deutsche Grammophon Gesellschaft mbH v. Metro SB Grossmärkt GmbH and Co KG. In this case, the ECJ also applied the “specific subject matter” test under art. 30 (ex art. 36).

<sup>26</sup> Ex art. 85 and 86.

<sup>27</sup> Ex art. 30 - 36.

<sup>28</sup> First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade mark see OJ EC No. L 40/1, 11.2.1989, pp 1-7.

<sup>29</sup> Groves, Martino, Miskin and Richards, p. 55.

the problems of free movement which are likely to arise when products bearing national trade marks try to cross the borders<sup>30</sup>.

Despite its welcome by harmonisation enthusiasts for its wide coverage, many areas were left unsettled by the Directive, such as the national trade mark office's *ex officio* handling of grounds for refusal. The Directive's aim of harmonisation was achieved to a certain extent, but could not, on the whole, be described as being totally in conformity with single market requirements.

### **3.1.3 Council Regulation (EC) No. 44/94<sup>31</sup>**

The second legal instrument of the community trade mark system is the Council Regulation No. 40/94 (hereinafter CTMR). It was introduced in the absence of full harmonisation of national trade mark laws and in order to compensate for deficiencies in the earlier Harmonisation Directive, particularly the procedural issues. Thus, in comparison with the Harmonisation Directive, some articles contain the same wording<sup>32</sup>, some others are more detailed<sup>33</sup> and many articles are completely new<sup>34</sup>.

The most notable fact is that the Regulation introduced the Community trade mark (CTM). The CTM offers an advantageous and practical solution with its unitary character as provided in art. 1(2). As a result of this Regulation, a trade mark can be registered for all MS with one single application, one single legislation, one single procedure, one single Office and one unitary fee system. As the Regulation set up a new institution (OHIM), it had to deal with other matters than the aforementioned Harmonisation Directive, including rigid provisions for the establishment of the CTM. CTMR provides for a dual system of co-existence with national trade marks in which both the CTM and national trade mark were given status of equal treatment.

### **3.1.4 Other relevant legal texts<sup>35</sup>**

In order to allow a trade mark to have effect throughout the Community as based on a single application to the OHIM, a series of other legal texts were issued by the European authorities and OHIM. The Commission Regulation (EC) No 2868/95<sup>36</sup> (hereinafter IR) is also an important legal text besides the Harmonisation Directive and CTMR. It contains the necessary provisions on the registration procedure for a CTM, as well as on the administration of CTM, on appeals against decisions of the Office and proceedings for the revocation or invalidation of a CTM<sup>37</sup>. The Commission Regulation (EC) No 2869/95<sup>38</sup> lays

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<sup>30</sup> Robinson SC, p. 37.

<sup>31</sup> Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark, OJ EC No. L 11/1, 14/01/1994, pp. 1-32.

<sup>32</sup> E.g. art. 4, 12 and 13.

<sup>33</sup> E.g. art. 17 and 22.

<sup>34</sup> E.g. art. 5, 19, 20, 21 and the procedural articles.

<sup>35</sup> See OHIM I.

<sup>36</sup> Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark.

<sup>37</sup> IR, Recital.



down the fees payable to the OHIM. The Commission Regulation (EC) No 216/96<sup>39</sup> lays down the rules on the procedures of the Boards of Appeal - OHIM.

## 3.2 Some main contents of the EC trade mark legislation

### Types of CTM

The EC trade mark legislation recognises different types of trade marks including trade marks of goods and services, guarantee marks, certification marks and collective trade marks<sup>40</sup>. It also includes certain provisions concerning well-known trade marks that derived from art. 6 bis of the Paris Convention<sup>41</sup> and trade marks that have reputation in the Community<sup>42</sup>.

### Signs can constitute CTM

Art. 2 of the Harmonisation Directive and art. 4 of CTMR embody the same view that trade marks are signs satisfying two conditions i.e. they are capable of being represented graphically, and of distinguishing the goods or services of one undertaking from those of others. These are also known as the two requirements of form and content.

The signs listed in these articles are only examples used most frequently by undertakings to identify their goods or services. It means that this list is not exhaustive and all signs can potentially constitute a CTM. "It is designed to simplify the adaptation of administrative practices and court judgements to business requirements and to encourage undertakings to apply for trade marks"<sup>43</sup>. Therefore, depending on certain circumstances, the Trade Mark Offices, the national courts, or in the last resort, the ECJ will be responsible for determining whether specific signs constitute a CTM. The definition is open-ended and therefore able to adapt to changes in business practices and serve the needs of commerce better.

Accordingly, the CTM can be word marks (including company name, surnames, geographical names and any other words or sets of words, whether invented or not, and slogans); letter and number marks (including one or more letters or numerals, or any combination thereof; figurative marks (including fancy devices, drawings and symbols and also two-dimensional representations of goods or containers); 3D marks (including the shape of goods or their packaging); colour marks *per se* (including single colours or

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<sup>38</sup> Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonisation in the International Market (Trade marks and Designs).

<sup>39</sup> The Commission Regulation (EC) No 216/96 of 5 February 1996 laying down the rules of the procedure of the Boards of Appeal of the Office for Harmonisation in the Internal Market (Trade marks and Designs).

<sup>40</sup> See art. 1 and 15-Harmonisation Directive; art. 1(1) and 64 to 72-CTMR.

<sup>41</sup> See art. 4(2)(d)-Harmonisation Directive; art. 8(2)(c)-CTMR.

<sup>42</sup> See art. 8(5)-CTMR.

<sup>43</sup> The Commission Explanatory Memorandum to the Draft CTMR, COM (80) 635 final/2, 27/11/1980, p. 23.

combinations of several colours); sound marks and other marks that satisfy the above criteria<sup>44</sup>.

The sign must be capable of being represented in a form that can be recorded and published. This is an essential feature of any system of registering rights. It enables interested parties to ascertain the scope of existing CTM rights, either by consulting the CTM Bulletin or by conducting a search of the Register of CTM. It also aids owners of earlier marks to check the Bulletin for conflicting applications for CTM. The basic rules governing representation of a CTM are set out in Rule 3 of the IR and summarised at Guideline 3.7 of the OHIM Guidelines<sup>45</sup>.

The sign must be distinctive, so consumers can distinguish it as identifying a particular product, as well as from other trademarks identifying other products. This requirement is, therefore, addressing the question whether a sign performs or is intended to perform the function of a trade mark<sup>46</sup>. The test of whether it is distinctive is bound to depend on the understanding of the consumers, or at least the persons to whom the signs are addressed. A sign is distinctive for the goods to which it is to be applied when it is recognised by those to whom it is addressed as identifying goods from a particular trade source, or is capable of being so recognised. The distinctiveness of a sign is not an absolute and unchangeable factor. Depending on the steps taken by the user of the sign or third parties, it can be acquired or increased or even lost.

Clearly, according to the EC trade mark legislation, the signs that can constitute a CTM are broadly understood. This paves the way for the recognition and protection of special trade marks.

### **Signs that cannot constitute a CTM**

There are two main grounds that prevent signs from being registered as CTM, namely absolute grounds for refusal and relative grounds for refusal.<sup>47</sup>

Absolute grounds for refusal are based to a large extent on art. 6 quinquies of the Paris Convention. In the case where an application for registration includes one of the following characteristics, OHIM is obliged to refuse. Signs which do not conform to the requirements of art. 4 of CTMR; trade marks which are devoid of any distinctive character; trade marks which consist exclusively of descriptive signs; trade marks which consist exclusively of generic signs or indications; signs which consist exclusively of either the shape which results from the nature of the goods, or which is necessary to obtain a technical effect, or which gives a substantial value to the goods; trade marks contrary to public policy or accepted principles or morality; deceptive trade marks; trade marks for wines which falsely indicate their geographical origin; signs, which have become customary in ordinary language and established practices of the trade.

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<sup>44</sup> See OHIM IX.

<sup>45</sup> OJ 9/96, p. 1326.

<sup>46</sup> Ibid., p. 56.

<sup>47</sup> See art. 3 and 4- Harmonisation Directive; art. 7 and 8-CTMR.

Relative grounds for refusal refer to conflicts that arise from the rights of another party. These grounds, which are fully set out in art. 8 of CTMR, may be based either upon an “earlier trade mark” (art. 8(1)) or on certain other prior rights (art. 8(4)); also included is the case where an agent or representative of the proprietor of a trade mark registers the mark without the proprietor’s consent (art. 8(3)).

## **Distinctiveness acquired through use**

The non-distinctive trade mark can be registered if it has acquired distinctiveness through the use made of it<sup>48</sup>. This provision is derived from art. 6 quinquies C 1) of the Paris Convention and is also affirmed in art. 15(1) of TRIPs. This acceptance is very important for trade marks in general and for the registration of special marks in particular (as will be seen in Chapter 5).

Guideline 8.12.1 of the OHIM Guidelines<sup>49</sup> indicates the terms and conditions of the proof of acquisition of distinctiveness through use of the sign. This proof must bear on the place, period, extent and nature of the use. It can be presented in the form of documents from that period, such as catalogues, invoices and advertisements. Written statements, taken in compliance with national laws, can be used in support of the proof that distinctiveness has been acquired. The acquisition of distinctiveness must be achieved throughout the Community. It means that the proof that a trade mark is distinctive outside the Community is in itself insufficient. Notably, distinctive character acquired after the date of filing of a CTM application may be taken into account.<sup>50</sup>

Under art. 7(3) of CTMR, the distinctiveness acquired through use only applies for art. 7(1)(b), (c) and (d). It means that the shape falling in art. 7(1)(e) is outside this acceptance. This interesting point will be discussed in section 5.1 of this work.

## **Person who can be proprietor of CTM**

This is provided for very broadly in art. 5 of CTMR. Accordingly, nationals of both Member States and non-Member States are entitled to apply for and own CTM. Nationals of non-Member States that are parties to the Paris Convention or to the Agreement establishing the WTO may also file applications for a CTM without fulfilling any further requirement. Nationals of States which are not parties to the Paris Convention may also apply for CTM where they are domiciled or have their seat or a real and effective industrial or commercial establishment within the territory of the Community or of a State which is party to the Paris Convention. Even if they do not belong to this broad group of natural and

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<sup>48</sup> See art. 3(3)-Harmonisation Directive; art. 7(3)-CTMR.

<sup>49</sup> OHIM OJ 9/96, p. 1332; see also Rule 22-IR.

<sup>50</sup> These guidelines were tested in Joined Case C- 108 and 109/1997, *Windsurfing Chiemsee*. In this case, the ECJ held that the distinctiveness acquired through use can be shown by the following proofs: the market share held by the trade mark, how intensive, geographically widespread the trade mark has become, how long the trade mark has been used and the amount invested by the undertaking in promoting the mark.

legal persons, nationals of other countries may still apply for a CTM, provided that the reciprocity rule exists between the Community and the State that such person belongs.

### **Likelihood of confusion**

Both the Harmonisation Directive and CTMR contain similar provisions with respect to conflicts between earlier trade mark rights and marks or other signs<sup>51</sup>. The criterion is that in case of identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there must be a likelihood of confusion on the part of the public. Confusion may arise from phonetic similarity, visual similarity and similarity of meaning<sup>52</sup>.

The criterion of “likelihood of confusion which includes the likelihood of association with the earlier mark” was interpreted in the Sabel case<sup>53</sup>. In this case, the ECJ held that mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion<sup>54</sup>. The appreciation of likelihood of confusion “depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection”<sup>55</sup>.

### **Rights conferred by a CTM**

The proprietor of a registered CTM has the right to use exclusively the trade mark<sup>56</sup>, to prevent the reproduction or imitation of the trade mark<sup>57</sup>, to transfer the trade mark or to grant licenses for some or all of the goods or services for which the trade mark is registered, in part or the whole of the Community<sup>58</sup>, and to oppose the registration of similar Community or national trade marks which could cause confusion to the consumer<sup>59</sup>.

The list of prohibited acts includes the use of the sign on products or packaging, the importation or exportation of products under that sign, and the use of the sign in business papers and advertising<sup>60</sup>.

### **Exhaustion principle of trade mark rights**

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<sup>51</sup> See art. 4 (1)(b) and 5(1)(b)- Harmonisation Directive; art. 8 (1)(b), 52(1)(a) and 9(1)(b)-CTMR.

<sup>52</sup> About the evaluation of confusion, see Franzosi, pp. 300-318.

<sup>53</sup> Case C-251/95, Sabel BV v Puma AG. See also Case C-342/97, Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV9.

<sup>54</sup> Case C-251/95, Sabel BV v Puma AG, the conclusion of Judgement.

<sup>55</sup> Case C-251/95, Sabel BV v Puma AG, para. 9. See also 10<sup>th</sup> Recital-Harmonisation Directive.

<sup>56</sup> See art. 5(1)-Harmonisation Directive; art. 9(1)-CTMR.

<sup>57</sup> See art. 5(1)-Harmonisation Directive; art. 9(1)-CTMR.

<sup>58</sup> See art. 8-Harmonisation Directive; articles 17, 18 and 22-CTMR. See also Rules 31 to 35-IR.

<sup>59</sup> See art. 42-CTMR.

<sup>60</sup> See art. 5(3)-Harmonisation Directive; art. 9(2)-CTMR.

Art. 7.1 of the Harmonisation Directive as well as art. 13(1) of CTMR have used uniform wording for fixing the principle of exhaustion of trade mark rights. It provides that a trade mark proprietor cannot prohibit the use of his mark in relation to goods that have been put on the market in the Community under the trade mark by him or his consent. There is also in both cases one exception to the basic rule i.e. where there exist “legitimate reasons” for the trade mark proprietor to oppose further putting the goods into commerce, e.g. if their condition has been changed or if they have been impaired after their first commercialisation<sup>61</sup>.

## **The registration procedures**

The procedure for registering a CTM can be broken down into stages including file of application, examination of the application (formal and substantive), publication of the application, possible opposition proceedings and registration<sup>62</sup>.

## **Jurisdiction and procedure in legal actions**

As mentioned, the Harmonisation Directive does not harmonise procedural issues, thus, the provisions on jurisdiction and procedure in CTMR are completely new. Title X of CTMR sets out the rules on jurisdiction and procedure governing any legal action involving a CTM. It offers judicial protection against breach by the third party of the rights conferred by the trade mark. On the other hand, it opens to third parties the means to challenge the validity of a CTM once it has been registered by the OHIM. Finally, it provides how to proceed with legal disputes that may concern the CTM.

The jurisdiction and procedure are governed by two basic sources including the Brussels Convention<sup>63</sup> and the Protocol on Litigation<sup>64</sup>. The national courts of Member States are obliged to enforce the EC trade mark legislation and not to apply national provisions that would be in conflict with the Community rule. The ECJ has jurisdiction under art. 63 of CTMR.

## **3.3 Interim conclusion**

It is presumed that the introduction of the Harmonisation Directive and CTMR shifted the focus on trade mark law from the national to the Community arena. The community trade mark system has become known as an open, flexible, transparent system and one compatible with the international conventions that the Community participates in. The most considerable value of this system is that it makes a single application having unitary effect

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<sup>61</sup> See Case C-173/98, *Sebago Inc., and Ancienne Maison Dubois et Fils SA v. GB-Unic SA*. See also Joined cases C- 414/99 to 416/99, *Zino Davidoff SA v A & G Imports Ltd and Levi Strauss & Co. and Others v. Tesco Stores Ltd and Others*.

<sup>62</sup> See art. 25 to 38-CTMR. See also Rules 23 to 28-IR. For further details, see Annand and Norman, pp. 60-102.

<sup>63</sup> Brussels Convention on Jurisdiction and the Enforcement of Judgements in Civil and Commercial Matters, OJ EC C 189, 28/7/1990.

<sup>64</sup> Protocol on Litigation annexed to the 1989 Luxembourg Agreement relating to Community Patents, OJ EC L 401, 30/12/1989.

throughout the whole of the EC. It, moreover, leads to the expansion of the range of registrable trade marks. These have forced “many trade mark owners to rethink their strategy”<sup>65</sup>.

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<sup>65</sup> Annand and Norman, p. 1.

## 4. Doctrine of Functionality

The doctrine of functionality was originated and developed mainly in the US. The doctrine can be applied to IPR in general<sup>66</sup>, however, its concept is deeply embedded in trade mark law. The functionality doctrine has been adopted and applied by almost all trade mark authorities and courts to determine the imperative requirement of distinctiveness for trade marks and has become ever more important in relation to trade mark law. In this work, the doctrine will also be very important when the author looks at the special marks.

### 4.1 The US position<sup>67</sup>

Where a feature of a product performs or contributes to its function then trade mark protection of that feature would effectively preclude or restrict others from producing goods which require or perform the same function. “The possibility of such anti-competitive effect has led the US courts to adopt a functionality doctrine”<sup>68</sup>. Accordingly, the US Patent and Trademark Office and the courts will not grant trade mark protection to features of a product design which are functional. The rationale for this is that if a business could get trade mark protection for a functional features this would hinder competition by preventing others from using the features to achieve the same necessary function. “The exclusion of functional design from the subject matter of trade mark law is intended to ensure effective competition, not just by the defendant, but also by other existing and potential competitors”<sup>69</sup>. Functional features, moreover, “is the province of patent law, not trade mark law”<sup>70</sup>. This was discussed in Kellogg case<sup>71</sup>.

Generally, a product feature is functional, and cannot serve as a trademark, “if it is essential to the use or purpose of the article or affects [its] cost or quality”<sup>72</sup>. In Qualitex case, the Court stated that “if a design’s ‘aesthetic value’ lies in its ability to ‘confe[r] a significant benefit that cannot practically duplicated by the use of alternative design, ‘then the design is ‘functional’”<sup>73</sup>. The US courts also drew the distinction between *de facto* functionality and *de jure* functionality<sup>74</sup>.

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<sup>66</sup> E.g. for copyright, see California University; for design, see US Court of Appeal.

<sup>67</sup> See US Supreme Court. See also Cullbert.

<sup>68</sup> McCarthy, J. Thomas, Trademarks and Unfair Competition, 1984, 2<sup>nd</sup> edn.

<sup>69</sup> Restatement (Third) of the Law of Unfair Competition, 1995, para. 17.

<sup>70</sup> US Supreme Court.

<sup>71</sup> Kellogg Co. v. National Biscuit Co., 305 US 111 (1938). See Connecticut University; Harvard University.

<sup>72</sup> Inwood Labs, Inc. v. Ives Labs, Inc., 456 US 844, 850 n.10 (1982).

<sup>73</sup> Qualitex Co. v. Jacobson Products Co., 115 See Ct. 1300, 1306 (1995), at 1306.

<sup>74</sup> “De facto functionality is functionality in the lay sense, i.e., directed toward a use or purpose. As noted above, a feature that is de facto functionality may or may not receive protection. Similarly, a feature that at one point is non- functional may become functional later. De jure functionality refers to the legal conclusion: what product features may be copied (de jure functional) and what features may be protected (de jure non-functional)” - Federal Intellectual Property protection for computer software.

The functionality doctrine limits the scope of trade mark protection by stating that if a product's feature is functional, it is prohibited from being used in a trade mark "where doing so will put a competitor at a significant disadvantage"<sup>75</sup>. The doctrine "prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature"<sup>76</sup>.

The federal courts have demonstrated that they can apply this doctrine in a careful and reasonable manner, with sensitivity to the effect on competition<sup>77</sup>. The Court further noted that "[t]he 'ultimate test of aesthetic functionality' ... 'is whether the recognition of trademark rights would significantly hinder competition'"<sup>78</sup>.

Despite the fact that most cases where the doctrine of functionality played a role concerned the shape or get-up of a product<sup>79</sup>, it has been effectively applied for other trade marks, for example for colour marks<sup>80</sup> by the US courts.

## 4.2 The EC position

The EC was not the originator of the functionality doctrine and this doctrine, presumably, was not developed strongly here. However, the legislation and case law of the Community as well as of Member States have already indicated the adoption and application of this doctrine in the EC.

The EC trade mark legislation approaches closely to the US doctrine of functionality. The concepts of the doctrine are reflected in the provisions on the grounds for refusal to register as CTM<sup>81</sup>. "Art. 7(1)(b) to (c) of Regulation No. 40/94 address the concern of the Community legislation to prevent the grant to one operator alone of exclusive rights which could hinder competition on the market for the goods or services concerned"<sup>82</sup>.

The doctrine of functionality has been a necessary part in determining the requirement of distinctiveness for CTM by OHIM and the European courts. Here they have considered most cases in the context of a close relation between functional features and competition aspect. For example, in case R 134/2001-1, the Board states that no trader can monopolise

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<sup>75</sup> *Qualitex Co. v. Jacobson Products Co.*, 115 See Ct. 1300, 1306 (1995): "forbid[ding] the use of a product's feature as a trade mark where doing so will put a competitor at a significant disadvantage because the feature is 'essential to the use or purpose of the article' or 'affects [its] cost or quality'".

<sup>76</sup> *Qualitex Co. v. Jacobson Products Co.*, 115 See Ct. 1300, 1306 (1995), at 1304.

<sup>77</sup> US Supreme Court.

<sup>78</sup> *Qualitex Co. v. Jacobson Products Co.*, 115 See Ct. 1300, 1306 (1995), at 1304.

<sup>79</sup> See cases *Inwood Labs, Inc. v. Ives Labs, Inc.*, 456 US 844, 850 n.10 (1982); *Weber Stephen Products Co.* 3 USPQ 2d 1659; *Morton-Norwich Products, Inc.*, 213 USPQ 9.

<sup>80</sup> See cases *Qualitex Co. v. Jacobson Products Co.*, 115 See Ct. 1300, 1306 (1995); *Owens-Corning Fiberglass* 227 USPQ 417.

<sup>81</sup> See art. 3(1)(b) to (e)-Harmonisation Directive; art. 7(1)(b) to (e)- CTMR.

<sup>82</sup> Case T-129/2000, *Procter & Gamble v. OHIM*, para. 69.



a method of use that is clearly attractive to the customer as well as being functional<sup>83</sup>. It is notable that, in the Community, the doctrine has just been applied for a 3D mark<sup>84</sup> and the line between functionality and non-functionality is not clearly drawn in every case. However, some European scholars have referred to this important doctrine when considering other marks<sup>85</sup>.

The doctrine has been adopted in some Member States. For example, in UK, “the provisions of section 3(2) [of The Trade mark Act 1994] contain a balanced mechanism akin to but not identical with the doctrine of functionality developed by the US courts”<sup>86</sup>. Moreover, the cases in UK “have adopted hints of the ‘functionality doctrine’”<sup>87</sup>. In Germany, the courts relied for many years on the “need to keep free for other traders” doctrine. Until 1963 the doctrine was applied in trade mark infringement cases as a limitation on the scope of protection of relatively weak marks<sup>88</sup>.

### 4.3 Interim conclusion

One objective of trade mark law is to promote competition by enabling traders to reap the reputation related rewards of a desirable product or service. It is not the function of trade mark law to gain a non-reputation-related advantage over their competitors and to inhibit competition by for example achieving a perpetual monopoly in a functional feature. The functionality doctrine has been developed, particularly in the US, to protect against the misuse of trade mark legislation in this way<sup>89</sup>. The refusal of registration by way of the functionality doctrine forces producers to face potential competition in the market place and thus contributes to the fundamental public interest principles of trade mark law. The role of this doctrine will perhaps makes the EC trade mark authorities and courts address more specifically its future development and application in the EC.

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<sup>83</sup> R 134/2001-1, para. 14.

<sup>84</sup> See Cases R 566/1999-1; R 875/1999-1; R 8/2000-2; R 656/2000-2; R 134/2001-1.

<sup>85</sup> See Burton.

<sup>86</sup> Firth, Alison, Gredley, Ellen and Maniatis Spyros, p. 98.

<sup>87</sup> Burton, p. 382.

<sup>88</sup> Cases Polymar, BGH [1963] G.R.U.R. 630; Polyestra, BGH [1968] G.R.U.R. 694.

<sup>89</sup> Cullbert.

# 5. Special Trade Marks

As mentioned above, the development of commercial reality has led to a recognition by both public and most trade mark authorities that trade marks now can take unusual forms. It means that besides the traditional forms such as word and device, there exist other special forms such as shape, colour, sound, smell, slogan, hologram animation, gesture and taste. In the EC, this recognition is clearly reflected in EC trade mark legislation, especially in art. 4 of CTMR (with the same wording in art. 2 of the Harmonisation Directive).

Being trade marks, the special marks, primarily, are governed by legislation on trade mark. However, due to their unusual characteristics, there are some specific and different provisions on the special marks, particularly requirements on graphic representation. Therefore, this part does not repeat general provisions on trade marks but mainly focuses on key distinctive points of the special marks from the legal aspect and also looks at the registration situation in order to find out the border line between registrable special marks and unregistrable ones. The author also wants to draw notes and decide whether each of the special marks considered should be protected or not.

## 5.1 3D mark

### 5.1.1 Statutory provisions and the registration situation

A 3D mark is a mark consisting of a 3D shape including containers, packaging and the product itself<sup>90</sup>. A typical category of this is the shape of goods or their packaging.

Internationally, the general trend is clearly in the direction of a gradual acceptance, as trade marks, of the shapes of products and packaging elements<sup>91</sup>. In the EC, a 3D mark is the only special mark that is expressly mentioned in art. 4 of the CTMR<sup>92</sup>. In addition to that, IR and OHIM Guidelines set out the requirements for graphic representation of 3D marks<sup>93</sup>. Accordingly, a 3D mark may be represented either by line drawings or by photographs. Six different perspectives of the mark may be supplied, provided that these fit on one sheet. A written description of the mark is optional<sup>94</sup>.

In order to be registered as trade marks, 3D signs must also be capable of distinguishing the goods or services of this trader with those of other traders. A typical example for obtained distinctiveness of 3D mark is the shape of the Coca-Cola bottle that “a blind person can

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<sup>90</sup> OHIM VIII; see also Joint statements by the Council and the Commission of the European Communities entered in the minutes of the Council meetings, at which the Regulation on the Community trade mark is adopted on 20 December, OHIM OJ 5/96, p. 613.

<sup>91</sup> Daniel, p. 593.

<sup>92</sup> After the introduction of the Harmonisation Directive, almost MS explicitly provide in their national laws the protection of 3D mark, e.g. France, Portugal, Spain, and UK.

<sup>93</sup> Rule 3(4)-IR. See also Guideline 3.7-OHIM Guidelines, OHIM OJ 9/96, p.1326.

<sup>94</sup> See Annand and Norman, p. 31.

identify Coca-Cola by touching the bottle even though he or she cannot read the words on the bottle<sup>95</sup>.

The practice shows that many goods are made in a range of shapes, all of which may be commonplace. Commonplace shapes or small variations on commonplace shapes should be regarded as devoid of any distinctive character. In the Procter & Gamble Co. washing machine case, the CFI held that the 3D shape for which registration has been sought, namely a square tablet, could not be registered. The reason is that it is one of the basic geometrical shapes and is an obvious one for a product intended for use in washing machines or dishwashers<sup>96</sup>.

Where the shape is devoid of any distinctive character, the sign may still be accepted if it contains additional elements such as get up, words or devices and becomes distinctive<sup>97</sup>. However, where the added matter is *de minimis* or unclear, or is itself devoid of any distinctive character, the application should be refused<sup>98</sup>.

Until recently, as mentioned, a 3D mark is a special mark that has the highest number of applications as well as registrations in comparison with other special marks<sup>99</sup>. OHIM grants registration for 3D marks in the form of goods, their packaging alone or shape in combination with other signs such as word, figurative, colour...

In the UK, besides the registration for shape of goods<sup>100</sup> or their packaging<sup>101</sup>, the UK Patent Office also grants trade mark protection to other unusual 3D marks such as the external shape of a dining, restaurant, hotel, entertainment and shopping complex housed inside large-scale beverage cans and the layout of the cover page of the Daily Mail weekend magazine<sup>102</sup>. In France, the French Patent and Trade Office grants trade mark protection to the product itself, shapes of bottles of perfume and wine, packaging for all types of products, interior decoration of a shop, painting on buses for travel services, and exterior shapes of restaurants in the franchising business.

### **5.1.2 The exceptions from registering for 3D mark under art. 7(1)(e)<sup>103</sup>**

#### ***The shape which results from the nature of the goods themselves***

This EC exception was discussed for the first time in the Coca-Cola case before the English House of Lords<sup>104</sup>. In this case, the Lords held that since liquid has no shape, an application

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<sup>95</sup> Australia Manual.

<sup>96</sup> Case T-128/00, Procter & Gamble Co. v. OHIM, para. 56. See also Case T-129/00, Procter & Gamble Co. v. OHIM.

<sup>97</sup> E.g. case R 177/1999-2.

<sup>98</sup> For further details, see also UK Manual, chapter 6, section 6.4.

<sup>99</sup> See Appendix 1; see also Annand and Norman, p. 28.

<sup>100</sup> UK Registration No. 2002390.

<sup>101</sup> UK Registration No. 2000548.

<sup>102</sup> UK Registration Nos. 2048209 and 2002557.

<sup>103</sup> Art. 7(1)(e)-CTMR, the same wordings in art. 3(1)(e)-Harmonisation Directive .

<sup>104</sup> Coca-Cola Trade Marks [1986] RPC 421.

for registering a bottle or a container for liquid as a trade mark must be an application for registering the goods themselves. Concerning this argument, the OHIM Guidelines expressly reject at Guideline 8.6<sup>105</sup> that “Quite clearly a liquid can have any shape of a container for liquids does not arise from the nature of the goods themselves”. However, the document gives no further guidance on how the nature of the goods exception is interpreted and applied<sup>106</sup>.

The decisions and cases of the Benelux courts, the OHIM and the European Courts show that shapes resulting from the nature of the goods are those that are determined by the function of the goods and indispensable to the manufacture or distribution of products<sup>107</sup>. Examples are the shape of an umbrella, the shape of a carrier bag and the shape of an egg box, and the shape of the toothbrush which needs to have a handle and brushes<sup>108</sup>. In the Procter & Gamble Co. soap case<sup>109</sup>, therefore, the CFI pointed out that the shape whereby soap is bent inwards along its length and has grooves do not come about as a result of the nature of the product itself since there are other shapes of soap bar in trade without those features<sup>110</sup>. Registration as a trade mark for basic shapes would obviously permit traders to monopolise the respective goods themselves. However, the shapes with arbitrary or fanciful elements attached or the shapes which are not common in trade may be outside the “nature of the goods” exception. On this ground, OHIM has accepted the registration as a CTM the shape of a 1950s-look toaster with rounded contours<sup>111</sup>. Where registration is sought for the shape of packaging, it is refused if the shape results from such basic features of the goods e.g. a round package for a bicycle wheel.

### ***The shape which is necessary to obtain a technical result***

Shape of goods resulting in some technical advantage may also be excluded because of conflict with the patent system. The exclusion seeks to prevent monopolisation through trade mark law of non-patentable products<sup>112</sup>.

The example of the “technical result” exception given by the OHIM Guidelines is that while the pins in an electric plug are necessary for the plug to work, the overall shape of the plug is not determined by this technical requirement<sup>113</sup>. Clearly, the key to application of the exception is a *necessity*. If a technical result can be required by alternative shapes then the particular shape in question is probably outside the exception<sup>114</sup>.

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<sup>105</sup> OHIM OJ 9/95, p.1331.

<sup>106</sup> Annand and Norman, p. 44.

<sup>107</sup> E.g. CTM Application No. 64840 for anti-theft clock for use on automobile steering wheels; CTM Application No. 182402 for chair; CTM Application No. 121707 for flasher; See also Annand and Norman, p. 44; Kamperman, p. 68.

<sup>108</sup> UK Manual, chapter 6, section 2.8.

<sup>109</sup> Case T-122/00, Procter & Gamble Co. v. OHIM.

<sup>110</sup> *Ibid.*, para. 55 & 56.

<sup>111</sup> CTM Application No. 000048728.

<sup>112</sup> Kamperman, p. 68.

<sup>113</sup> Guideline 8.6, OHIM OJ 9/96, p. 1331.

<sup>114</sup> Similarly, in *Ide Line Aktiebolag v. Philips Electronics NV* [1997] E.T.M.R 377, the Stockholm District Court held that a shape was “necessary” to reach a technical result if there was no other route to that

Moreover, the shapes necessary to obtain a technical result must be those which make a vital contribution to the practical or useful character of the product, and may thus be termed “functional” or “utilitarian”. Non-drip teapots, scissors with handles specially adapted for the disabled and easy-grip feeding bottle are obvious examples where shape plays a key role<sup>115</sup>.

### ***The shape which gives substantial value to the goods***

When the third exclusion does not lend itself to easy interpretation, the OHIM Guidelines also make no comment on this exception. This exception was solved mostly by the BCJ. Influenced by Benelux precedents<sup>116</sup>, it is generally assumed that the ‘substantial value’ exception directs the tribunal’s enquiry into the consumer’s motive for buying the goods<sup>117</sup>. If consumers purchase the goods primarily because of their visual-appeal, irrespective of the origin of the product, then the shape is excluded from registration as a CTM, e.g. a crystal vase, a set of miniature china houses<sup>118</sup>. Conversely, where goods are purchased primarily for reasons unconnected with their visual-appeal, such as taste and comestible value<sup>119</sup> the “substantial value” exception does not apply. Therefore, the Coca-Cola bottle would not fall within this exception. Despite the shape of the Coca-Cola bottle being so distinctive that a blind person can recognise it, consumers purchase it primarily because of its special taste. The exception will also be inapplicable where the goods are bought largely because of the trade mark significance of their shape. For this reason, OHIM accepted three applications for the horn, star and kangaroo shapes of snack foods<sup>120</sup>.

### **5.1.3 Lego case and the debate surrounding functionality, necessity and distinctiveness of 3D mark**

The first 3D CTM consisting of the product itself on the basis of distinctiveness acquired by use that concerned the Lego building block<sup>121</sup>. There has been much controversy surrounding this case, with many different approaches. Interestingly, many trade mark regimes in the Community have refused to register the Lego brick as a trade mark or have refused protection under unfair competition law. Some, however, have protected the brick. These approaches can be divided into two groups. The first group considers the 3D shape of Lego brick as functional, thus, it must be excluded from registration as trade mark. The

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result. See also Watts, p. 150; Annand and Norman, p. 44; UK Trade Marks Registry Work Manual, chapter 6, section 8.6.

<sup>115</sup> Firth, Gredley and Maniatis, pp. 92 - 93.

<sup>116</sup> E.g. cases Adidas v. Joseph De Laet and Others BCJ of 23 December 1985, NJ [1986] 285; Superconfex v. Burberrys BCJ of 14 April 1989, NJ 1989, 834; Burberrys II, BCJ of 16 December 1991, NJ 1992, 596.

<sup>117</sup> Annand, p. 45; Firth, Gredley and Maniatis, p. 97; Strowel, p. 160.

<sup>118</sup> District Court of Rotterdam [1982] BIE 193. See also case of children’s bath in the shape of a scallop shell - Court of Appeal den Bosch (1993) Revue de droit intellectuel 238.

<sup>119</sup> Vieneta-Ice [1994] IER 16.

<sup>120</sup> CTM Application Nos. 000014167, 000014217 and 000013342.

<sup>121</sup> CTM Application No. 000107029, published in CTM Bulletin No. 90/1998 of 23 November 1998, p. 57. See Appendix 2, figure 1.

notable representatives of this group are France, Norway, Sweden and UK<sup>122</sup>. They state that mainly functional elements of product design could not be protected by trade mark law even where they had acquired a secondary indication of origin, namely the distinctiveness obtained through use.

The other approach considers that the stud-tube interlocking system of the Lego brick was a functional form but not a necessary one in that a competitor could create its own set of interlocking bricks based on Lego's system but not compatible with it<sup>123</sup>. In other words, they focus on the distinction between functional features and necessary ones. Accordingly, a shape which is functional but not necessary may be protected as a trade mark. In addition to that, they also state that some functional features of the Lego brick have distinctive character, and that they could therefore almost be regarded by consumers as *de facto* trade marks<sup>124</sup>. At this point, they show the relation between functionality and distinctiveness obtained through the use. Accordingly, a shape which is functional but distinctive can not be excluded from protection as trade mark. The notable exponents of this approach are the German Bundesgerichtshof and the Italian Supreme Court<sup>125</sup>.

Clearly, the key point of debate on Lego case is the confusion surrounding the link between functionality and other concerned elements. The first is the link between functionality and necessity. This has not yet been discussed in the OHIM decisions and the cases of the European courts. The second is the link between functionality, necessity and distinctiveness. Should a functional shape be excluded from protection as a CTM if this shape is unnecessary to the product or/and distinctive from other products? According to the US doctrine of functionality, functional 3D shapes can not be registered as trade marks, even if they are considered as distinguishing marks of a particular trader's goods: "The rule against protection for functional shapes prevails over recognition accorded consumers' mental associations of the shape with a single source"<sup>126</sup>. "A survey showing a high degree of customer recognition as a mark would be irrelevant to any 'functionality' enquiry"<sup>127</sup>. In the EC, after the decision of OHIM that the Lego brick can be registered on the basis of distinctiveness acquired through use, the answer seems to be contrary to that of the US. As already mentioned (in Chapter 3, section 2), distinctiveness acquired through use under art. 7(3) of CTMR in fact only applies for art. 7(1)(b), (c) and (d); the shape falling in art. 7(1)(e) is outside this acceptance. It is clear that conflict between this decision and art. 7(3) arises here. Thus, it is not clear whether this decision is persuasive enough to stop the long debate surrounding the Lego case and lead the courts of the Member States to follow it.

#### 5.1.4 Issue of concurrent protection

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<sup>122</sup> See SA Lego v. SARL Tomy, Cour de Cassation, March 29, 1994, [1995] G.R.U.R. Int. 505; Supreme Court of Norway – Noyesterrett, December 20, 1994, [1995] G.R.U.R. Int. 508; Dan Bowman v. Lego [1997] G.R.U.R. Int. 700; Lego Systems Aktieselskab and another v. Lego M Lemelstrich Ltd., [1983] FSR 155.

<sup>123</sup> Cuonzo and Pike, p. 139.

<sup>124</sup> Ibid.

<sup>125</sup> For further details, see Cuonzo and Pike.

<sup>126</sup> McCarthy on Trademarks (4<sup>th</sup> ed.), para. 7.66.

<sup>127</sup> Ibid., para. 7.81.

Can a 3D object be registered under both design and trade mark law? In the EC, it is not clear both legally and practically. There has not yet any application or case concerning this concurrent protection. Some consider that art. 7(1)(e) of the Harmonisation Directive appeared to seek to “exclude from registration certain shapes which are protectable under patents, registered designs, copyright and other such intellectual property rights”<sup>128</sup>. But some believe that it must be acceptable<sup>129</sup>.

I think that a 3D object can be protected under both design and trade mark law on the grounds of legal basis, the purpose of the division into design law and trade mark law and the practical situation.

First of all, international conventions<sup>130</sup> and the EC legal texts<sup>131</sup> do not include but do not exclude this concurrent protection of 3D signs under both design and trade mark law. Moreover, there is no legal conflict on the requirements and the protection between design and trade mark law.

One of the reasons for dividing design and trade mark law is to extend the range of protection for product or packaging design. It means that if a 3D design meets two requirements of novelty and industrial character then it will be primarily protected under design law. And if a 3D design just meets the lower requirement that is distinctiveness then it will be protected under trade mark law.

The practice of America<sup>132</sup> and other countries such as Australia<sup>133</sup>, Canada<sup>134</sup>, moreover, show that this concurrent protection is completely acceptable.

Therefore, where a 3D object satisfies requirements of novelty and industrial character and is outside the exceptions for shape mark under art. 7(1)(e) it can be protected under both design and trade mark law. It also must be born in mind that “if a sign is original or new, it is a *fortiori* distinctive. Nevertheless, not all novelties are distinctive”<sup>135</sup>.

### 5.1.5 Interim conclusion

Despite the existence of some vague points, it is assumed that a 3D mark is provided for clearly and firmly in the EC trade mark legislation. 3D signs will be registered as CTM if they are used for indicating the origination of goods or services and do not fall within exceptions from registering as mentioned above.

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<sup>128</sup> [1999] E.T.M.R 816; see also Kamperman Sanders, p. 68.

<sup>129</sup> See Stowell, p. 161.

<sup>130</sup> E.g. Paris Convention, TRIPs.

<sup>131</sup> See Harmonisation Directive; CTMR; Directive 98/71/EC of the European Parliament and the Council of 13 October 1998 on the legal protection of designs, OJ L 289 of 28 October 1998, pp. 28-35; Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs, OJ L 1/2002 of 5 January 2002.

<sup>132</sup> See United State Playing Card Co’s Application [1908] 1 Ch 197.

<sup>133</sup> See Australia Manual, section 3.2.

<sup>134</sup> Canadian Federal Court’s decision of 18 October 1993, Remington Rand Corp. v. Phillips Electronics NV, [1994] 3 EIPR, D-48.

<sup>135</sup> Franzosi, p. 188.

## 5.2 Colour mark

### 5.2.1 Statutory provisions and the registration situation

TRIPs provides explicitly that the combination of colours “shall be eligible for registration as trade mark”<sup>136</sup> although it does not mention the protection for a single colour mark. In addition to this, the Harmonisation Directive and CTMR do not provide but do not preclude the possibility of registering one or several colours as trade marks. Nevertheless, it is accepted in the Community that “a colour mark *per se* is a mark composed of one colour or several colours, regardless of any specific shape or configuration”<sup>137</sup> and can constitute trade mark. IR<sup>138</sup> and OHIM Guidelines<sup>139</sup> permit the registration of a trade mark in colour. Moreover, joint statements by the Council and the Commission do not rule out the possibility of registering as a CTM a combination of colours and a single colour<sup>140</sup>.

In order to be registrable, accordingly, the single colour or the combination of colours must be capable of graphic representation and distinctive. There is no requirement that the colour must be defined by a Pantone Matching System (PMS)<sup>141</sup> or a similar standard. The applicant is free to use his own description of the colours. The indication may be made in any manner, such as by naming the colour<sup>142</sup>. Thus, most published CTM applications have claimed colour merely by reference to the name of the colour although some have utilised the Pantone standard<sup>143</sup>. In addition, a reproduction of the mark shown in colour must be provided on a separate sheet. Where the mark consists exclusively of colour this will entail supplying a sample of the actual colour applied for. A written description of the mark in the application form is optional<sup>144</sup>.

The first colour mark *per se* was registered in US from 1985 for pink fiberglass insulation<sup>145</sup>. In the Community, the first colour mark *per se* was registered in 1999 for single lilac/purple colour<sup>146</sup>. In comparison with other special marks, 3D marks come first and colour marks are second in terms of the number of applications and registrations by

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<sup>136</sup> Art. 15(1)-TRIPs.

<sup>137</sup> OHIM VIII.

<sup>138</sup> See Rule 3.5.

<sup>139</sup> See art. 3.7.1 and art. 3.7.4.

<sup>140</sup> OHIM OJ 5/96, p. 613.

<sup>141</sup> PMS is “a popular colour matching system used by the printing industry to print spot colour. Most applications that support colour printing allow you to specify colours by indicating the Pantone name or number. This assures that you get the right colour when the file is printed, even though the colour may not look right when displayed on your “. For further details, see Nanotech 1.

<sup>142</sup> OHIM Guidelines, Guideline 3.7 OHIM OJ 9/96, p. 1326. See also OHIM VIII.

<sup>143</sup> E.g. CTM Application No. 000012880 with description that “Pantone 375C and Pantone 350C”.

<sup>144</sup> IR, Rule 3(3); See also OHIM VIII.

<sup>145</sup> Owens-Corning Fiberglass 227 USPQ 417 (1985).

<sup>146</sup> CTM Application No. 000031336. See Appendix 2, figure 3.



OHIM<sup>147</sup>. The majority of registered colour marks consist of colour in combination with other additional elements such as word, device or shape of goods or their packaging<sup>148</sup>. OHIM has also granted registration for the combination of colours *per se* as trade mark<sup>149</sup>.

## 5.2.2 The debate surrounding the protection for colour mark *per se*

### 5.2.2.1 The objection

Although many countries permit the protection of colour alone as a trade mark, some others object to this protection. The objections can be divided into two kinds as follows: 1. The colour (whether consisting of a single colour or a combination of colours) *per se* should not be protected as trade mark; 2. The combination of colours *per se* can be protected as trade mark but a single colour *per se* can not be protected.

The objection to protection for colour marks *per se* is pointed out in following arguments<sup>150</sup>:

Firstly, colours which are essential to the use or purpose of the goods or services, or which affect cost or quality, should not be protected since this would have an adverse effect on competition. Secondly, particular colour may be used for certain products, or there may be a limited number of “the best colours” that appeal to consumers. Various businesses also argue that they need to have colours free from trade mark protection, since the monopolisation of a colour would unfairly restrict the ability of these companies to meet consumer demand and packaging requirements, or aptly “describe” their products through colour. Allowing monopolisation of colour may unfairly restrict the ability for others to compete<sup>151</sup>. Thirdly, since there is only a limited number of colours, registration and protection should not be allowed because it will deplete the supply of colour available for use by others. Fourthly, the critics of colour registration state that deciding the likelihood of confusion between shades would be difficult and subtle, and the courts would be “ill-equipped to solve such problems”<sup>152</sup>. Fifthly, it would be difficult to search colour to obtain an accurate picture of those colours, which conflict with the proposed trade mark. Finally, some argue that adequate protection already exists for colour marks via “trade dress-related provisions”<sup>153</sup> of the various countries’ trade mark laws, or through laws of unfair competition or passing off.

While most countries permit the protection of trade marks which comprise a combination of colours, the extent to which a single colour can be protected as a trade mark varies considerably from country to country. Some countries specially prohibit the registration of a

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<sup>147</sup> See Appendix 1.

<sup>148</sup> E.g. CTM Application Nos. 000015651 and 000015669 for two shades of the same colour for Louis Vuitton design; CTM Application No. 000043935 for Red stripe in the heel of a man’s shoe; CTM Application No. 000068775 for the distinctive colouring of a container for liquid foods.

<sup>149</sup> E.g. the combination of green and black colours in Case R 136/1999-1.

<sup>150</sup> About this argument, see INTA, 1996; see also Schwarz, pp. 394-395.

<sup>151</sup> See also R 169/1998-3, para. 29.

<sup>152</sup> INTA, 1996.

<sup>153</sup> Ibid.

single colour trade mark<sup>154</sup>, while others permit this registration only upon proof of a very high level of acquired distinctiveness<sup>155</sup>. This objection is also based on the above mentioned grounds for colour *per se* generally. The critics additionally remark on the non-distinctive characteristic of single colour. They think that single colours lack distinctiveness and their registration must be refused. A single colour as such is not usually interpreted by the consumer as being primarily an indication of origin or brand identifier but as being a means of advertising<sup>156</sup>. Furthermore, all undertakings should be free to use any colours they like to characterise their goods or services. In view of the limited number of colours, especially primary colours such as red, yellow and blue and other basic colours such as white, black, green, there would otherwise be a danger that the monopolisation of individual colours by registering them as trade marks would be seriously disadvantageous for undertakings who were unable to secure a colour for themselves. In particular, the monopolisation of the particular single colour might also make the adjoining shades of colour unavailable to other undertakings, since the consumer, when deciding whether or not to purchase goods, particularly daily requisites, will not generally pay full attention to the exact shade<sup>157</sup>.

### **5.2.2.2 The recognition<sup>158</sup>**

Admittedly, extensive use of some colours in many different arrangements and/or with other additional elements e.g. word, figurative, shape signs may make colours *per se* become distinctive. Where the colours are used in a particular pattern or arrangement, or only constitute a trade mark when applied to the goods or packaging, however, it is likely to be more difficult to prove that the colours are a distinctive trade mark without including that pattern, arrangement or form of use in the graphic representation of the sign. This becomes even more difficult with a single colour since single colour normally lacks distinctiveness and its registration will probably be refused on the basis of art. 7(1)(b).

Personally, I think that colour *per se* including single colour and the combination of several colours should be registrable as a trade mark on the grounds of legal basis, commercial reality and doctrine of functionality, all as discussed immediately below. However the ability for registration of a combination of colours should be higher than that of the single colour.

#### *Legal basis*

Art. 15 - TRIPs includes the protection of a combination of colours as trade mark. Concerning a single colour, TRIPs does not oblige its member states to protect a single colour as trade mark, even in a particular shade: however it does not prohibit this. Moreover, the provisions on trade mark contained in the EC legislation and national laws of many MS recognise protection for colour marks *per se* including both single colours and

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<sup>154</sup> E.g. Austria, Germany (despite the provisions in its new German Marks Act, effective January 1, 1995 that specifically include colours and combinations of colours as registrable marks), Portugal and Spain.

<sup>155</sup> E.g. UK.

<sup>156</sup> For this argument, see Dawson, p. 386.

<sup>157</sup> Case R 342/1999-2, para. 15.

<sup>158</sup> About this argument, see US Supreme Court; see also Cullbert.

combinations of colours<sup>159</sup>. Obviously, there is no legal rule preventing colour *per se* from serving as a trade mark. And where a colour or a combination of colours *per se* meets the legal requirements for traditional trade marks, it must also be registered as a trade mark.

### *Commercial reality*

Businesses have increasingly used colour as a marketing tool to distinguish their goods or services, by using them in the product itself, on the packaging or in advertising material. Colour marks have performed the same role as more traditional marks. In addition, this argument is also supported by stating that where colour acquired distinctiveness by use then it can be registered<sup>160</sup>.

### *The doctrine of functionality*

In some cases the doctrine of functionality is applied to prevent the registration of marks. However colour can sometimes be functional, but not always. A colour may be functional if it serves a utilitarian purpose or confers utilitarian or functional advantages (for example, yellow or orange for safety signs) or if it would allow the owner to gain a competitive advantage in terms of cost of product. The colour sought to be monopolised may be the natural colour of the product due to the manufacturing process so that other traders would be forced to stop production or change to a more costly production process. In these cases, of course, colours are not registered as trade marks. It means that where colours are outside these cases then they may be registered as trade marks.

Relating to the argument of competitive need, the doctrine of functionality forbids the use of a product's feature as a trade mark where doing so will put a competitor at a significant disadvantage because the feature is "essential to the use of purpose of the article or affects [its] cost or quality"<sup>161</sup>. Colour depletion theory is unpersuasive, since when a colour serves as a mark, normally alternative colours will likely be available for similar uses by others. Moreover, if that is not the case – if a colour depletion does arise – the doctrine of functionality normally would seem available to prevent the anti-competitive consequences<sup>162</sup>.

Moreover, determining confusion between different colour marks would not present a more difficult question than determining the likelihood of confusion in other trade mark contexts. The use of the Pantone Matching System (PMS)<sup>163</sup> or some other widely known e.g. Cyan-

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<sup>159</sup> Cases R 7/1997-3; R 122/1998-3; R 169/1998-3. See also Smith, Kline & French Laboratories Ltd., v. Sterling Winthrop Group Ltd. [1976] R.P.C 513; UK Registration Nos. 1469512 and 1469513 to BP Amoco plc.

<sup>160</sup> In R 59/1999-2, the Board held that the colour green/colour is registrable since the distinctiveness acquired by use.

<sup>161</sup> Inwood Labs, Inc. v. Ives Labs, Inc., 456 US 844, 850 n.10 (1982).

<sup>162</sup> See US Supreme Court.

<sup>163</sup> See footnote 141.

Magenta- Yellow-Black (CMYK)<sup>164</sup>, Red-Green-Blue (RGB)<sup>165</sup> and easily available standard can effectively support the search process.

### 5.2.3 Requirements on the registration of colour mark *per se*

Obviously, the above grounds show that colour *per se* consisting of a single colour or combination of colours should be registrable as CTM. Similarly to other marks, not all applications to register colour as CTM will automatically be allowed. There are certain cases where colours should not be registered. For example where colours have superior utility for certain products, where the colour may become generic in common trade<sup>166</sup>, or where the colour is inherently unregistrable for certain goods e.g. the red for red ink. Here, “the doctrine of functionality is alive and well and many still be an obstacle to many registrations”<sup>167</sup>.

Colour can be registered as a trade mark if the three following conditions are satisfied: 1. There is no competitive need for the colour within the particular market. The evidence that tends to satisfy this concern is that manufacturers within the industry do not typically colour their products. 2. The colour must not be essential to the utility or function of the product. The kinds of evidence that tend to satisfy this concern are: there is no utilitarian need to apply the particular colour to the product and the colour is arbitrary in relationship to the product’s natural colour. 3. The colour is used to indicate the origin of goods or services. At this point, the applicant should show duration of use, advertising expenditure and other trade evidence.

With registration of single colour, these conditions are applied more strictly. Usually, a single colour *per se* is unregistrable unless distinctiveness acquired through use can be shown. Evidence will always be required to demonstrate factual distinctiveness and show that the mark is exclusively associated with the applicant’s goods or services. Moreover, a single colour can also under certain circumstances be inherently distinctive if it is a very unusual colour in relation to the goods or services concerned<sup>168</sup>.

### 5.2.4 Interim conclusion

Colour marks are not provided for explicitly as are 3D marks and have been faced with some arguments against their *per se* protection on grounds that come mainly from competition aspects. It can not be denied that colour signs *per se* have been recognised as CTM and are increasingly becoming important as brand identifiers. Therefore, traders

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<sup>164</sup> CMYK is a colour model in which all colours are described as a mixture of these four process colours. It is the standard colour model used in offset printing for full-colour documents. For further details, see Nanotech 2.

<sup>165</sup> See Nanotech 2.

<sup>166</sup> In Case R 169/1998-3, the Board held that the yellow colour is commonly and effectively used in advertising and in trade as a basic colour, together with images, graphics or texts. In Case R 210/1999-3, the Board held that the dark grey/green for timepieces, particularly radio-controlled alarm clocks is a common colour in trade.

<sup>167</sup> Schwarz, p. 395.

<sup>168</sup> Case R 342/1992-2, para. 15 and 16.

should be confident when seeking the registration of both single colour and combination of colours *per se* as CTM. However, we must also bear in mind that currently, almost all of applications for the single colour are refused by OHIM<sup>169</sup>. Many national courts refer to the European court regarding actual protection of single colours<sup>170</sup>. Thus, the belief in registration of single colour marks *per se* can not be as strong as that for the combination of colour marks *per se*.

## 5.3 Sound mark

### 5.3.1 Statutory provisions and registration situation

Under most conventions, the definition of a trade mark either encompasses sound as a trade mark, or at the very least, does not exclude such marks<sup>171</sup>.

As was the case with the colour mark, the sound mark is not included in but is not precluded from the Harmonisation Directive or CTMR. And there is no guideline about sound mark in IR. However, the Council and the Commission consider that art. 4 does not rule out the possibility of registering sounds as CTM<sup>172</sup>. OHIM Guidelines, moreover, state clearly that sound marks are registrable in principle, in particular musical phrases<sup>173</sup> but give little guidance on how applications for sound marks will be treated. According to the OHIM Guidelines and OAMI Manual, using musical notations is an acceptable form of graphic representation<sup>174</sup>. A written description of the sound mark may be added to the form at the applicant's option<sup>175</sup>. The mark description may also include the title of the piece of music or other information, but this is not a requirement<sup>176</sup>.

Concerning the provisions on sound marks, the national laws of Member States are different. Some Member States provide explicitly protection of sound marks, e.g. Germany, France and Italy. And other Member States do not specially exclude from or include in their national law the protection of sound marks, for example UK, Sweden.

Until now, only seven (7) sound marks have been registered as CTM<sup>177</sup>. Member States also permit the registration of at least some sound marks. For example the UK Trade Mark

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<sup>169</sup> Case R 122/1998-3 for the light green. Case R 169/1998-3, for the yellow. Case R 5/1999-3 for the blue. Case R 342/1999-2 for the blue. Case R 379/1999-1 for the yellow. Case R 176/2000-2 for the orange.

<sup>170</sup> E.g. BCJ referred to ECJ in the case *Re Libertel's Orange*, see [2001] E.I.P.R, N-139.

<sup>171</sup> INTA 1997.

<sup>172</sup> Joint statements by the Council and the Commission of the European Communities entered in the minutes of the Council meetings, at which the Regulation on the Community trade mark is adopted on 20 December, OHIM OJ 5/96, p.613.

<sup>173</sup> OHIM Guidelines, Guideline 8.2, p. 1331. See Also OHIM VIII.

<sup>174</sup> OHIM Guidelines, Guideline 8.2, p. 1331. See also OAMI Manual, section 5-Absolute grounds, part 2.5.

<sup>175</sup> IR, Rule 3(3).

<sup>176</sup> OAMI Manual, section 5-Absolute grounds, part 2.5. For the requirement of graphic representation, see also *Franzosi*, p. 185.

<sup>177</sup> Including application No. 000907527 with the description that "the mark consists of a sound mark called *Prelui*"; application No. 001040955 with the description that "signature tune of Nokia Corporation" (see Appendix 2, figure 2); application No. 001416858 without description; application No.

Registry granted the protection for British Telecom's 'beeps' on the speaking clock; and ICI's sound of a dog barking<sup>178</sup>.

### **5.3.2 Outstanding issues and some proposed solutions to protection for sound mark**

#### ***5.3.2.1 Outstanding issues***

The registration of sound marks has been faced with some outstanding issues such as graphic representation, test of infringement, distinctiveness acquired by use and registration notice. The most problematic issue is graphic representation.

##### ***Graphic representation***

The normal way of graphic representation of sound mark is the use of musical notations and written description. As a practical matter, however, not everyone can read written music. Moreover, written musical notes while indicating pitch, normally will not indicate tone, and different tones can be used, namely musical notes give a "description" of the music but not the music itself. Some questions, thus, arise here. For example, "if consumer confusion precludes competitors from using certain variations of the registered sound, how far removed from the described sound must a sound be to be considered available? Are certain sounds easier or harder to discern from others? Does one need to be musically trained to judge this based on written notes"<sup>179</sup>.

If digital recordings of the sound mark were to be used as the filing form, there may be problems associated with the fact that only the researcher or examiner would be listening and comparing sound marks. It is reasonable to worry that it would be also a burden to trademark offices with the need for dedicated means to store versions of the marks<sup>180</sup>.

##### ***The test of infringement***

The difficulty of perceiving sound marks through current ways of graphic representation influences the infringement test concerning such marks. The determination as to how different another sound mark must be from the written representation can be problematic. How to define exactly the confusion between two sound marks or between a sound mark and another visual mark? If a company adopted a call of a specific bird as a mark for its service, and a competitor used the name and a picture of the same bird as the service mark for the similar services, confusion could result. The question is whether the action of this competitor constitutes infringement or not. Undoubtedly, proving infringement for sound marks is more difficult than for other visible marks.

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001312008 with description that "the mark consists of a musical theme, shown on score sheet, which can be played on its own or orchestration"; application No. 001480805 without description; application No. 001062942 with the description that "the mark consists of a melody, as represented on the musical staff, including musical notes".

<sup>178</sup> UK Registration No. 2056092, UK Registration No. 2007456. About the registered sound marks in UK, see Annand and Norman, p. 29.

<sup>179</sup> INTA, 1997.

<sup>180</sup> Ibid.

### *Distinctiveness acquired by use*

Sound marks can be registered if the applicant shows the distinctiveness acquired by use. However, the provisions on manner of use vary from Member State to Member State. Germany does not consider the use of a mark in advertising to be a proper use of a mark on wares. German law requires that the mark be used on the goods, wrappers, containers, or leaflets accompanying the goods. But other national laws such as those of the U.K, Italy and Sweden recognise such use as proper use. UK law only requires use "in relation to "goods or services and this is considered to include for example, use in advertisement. And Swedish law permits the use of a mark for goods in advertising in domestic publications or in domestic or foreign broadcasts received in Sweden.

### *Registration notice*

A potential problem for the registrar is the increased difficulty involved in proving and supplying effective notice to others of the registration of sound marks over visual marks.

### **5.3.2.2 Some proposed solutions to protection for sound marks**

Sounds are capable of functioning as trade marks as any other kinds of trade marks and should be protected in the same way with other trade marks. As previously mentioned, however, the protection for sound marks has met with some difficulties. The immediate concern is, thus, to find solutions to these outstanding issues.

The first key issue is graphic representation. The articulation of a sound mark through graphic representation can be addressed by written description and other ways. Examples are a combination of audio tapes, staff music and written descriptions, and perhaps in the future by filing digital versions or computer generated versions of the sound mark which can alleviate problems associated with reading music and identifying either pitch or tonality, or both, and can facilitate ready searching. In addition, the legal texts should regulate that the applicant has the duty to ensure that the sounds he seeks to register are graphically represented sufficiently to enable these sounds to be clearly articulated. Written description must be accurate and precise. Any vagueness or undue breadth in the description which renders the scope of mark unclear would in turn render the mark unregistrable or the registration invalid or unenforceable.

The second is the solution to assessing the manner of use. While the Community legislation is silent about this and the national trademark laws of Member States differ in their affixation requirements for use on goods, this requirement will have to be re-evaluated and clarified. It is possible that a sound-marking device could be attached to a product or its packaging in order to fulfil an affixation requirement, but this is often impractical or undesirable. The argument can always be raised that a sound is intangible, and thus cannot be properly affixed. Nonetheless, accommodation of the intangible nature of a sound mark is an open possibility, as many countries have already done, as long as the sound is used so as to become connected with the goods and remains consistent. Where a sound mark is used in such a manner so as to have become connected with the goods or services and thereby functions as a trade mark, there should be no risk in recognising use without physical affixation (e.g. the chime of a computer when turned on).

Thirdly, difficulties in assessing confusion between two sound marks or between a sound mark and a visual mark can be dealt with using the reasoning and logic presently applied to other types of marks. The concept of assessing the aural impact of a mark and acoustic similarity between trade marks is not altogether new. Phonetic similarity in word marks already forms part of the assessment of trade mark registrability and confusion in many jurisdictions<sup>181</sup>.

Finally, registration notice requirements can be addressed, for example, by providing written notice on printed matter that accompanies the product.

### **5.3.3 Interim conclusion**

EC trade mark legislation recognises the protection of sound mark. Unfortunately, it gives little guidance on how to obtain the registration of this special mark. At the Community level as well as in Member States, the requirements or standards for registration of sound marks are mainly based on case law. However, the practical issue is the limited number of application prosecuted thus, and the guidelines on sound marks are not well developed.

Usually, sounds can be registered if they are represented adequately, sufficiently and precisely in the graphic forms such as musical notations, written description and audio tapes attached to. Sounds, moreover, must be distinctive. This is, of course, not easy to be shown with sound marks and other invisible marks in general. However, they are registrable if the “secondary meaning” namely distinctiveness acquired by use is shown. Here the applicant should point out the evidence such as the market share held by the owner of the trade mark, the time the trade mark has been used, the amount invested by the owner in promoting the trade mark...as mentioned in Chapter 3, section 2.

In certain circumstances, similar to other trade marks, sound marks can be excluded from registration as CTM. For example, sounds can be functional; very simple pieces of music consisting of only one or two notes; children’s nursery rhymes, for goods or services aimed at children; music strongly associated with particular regions or countries for the type of goods or services originating from or provided in that area<sup>182</sup>.

## **5.4 Smell mark**

### **5.4.1 Statutory provisions and registration situation**

Smell marks are not mentioned in the EC trade mark legislation, even in OHIM Guidelines. We can find little guidance in national law of MS<sup>183</sup>. Reality also shows that it has been so hard to register smells as trade marks. We can easily count the smell marks registered by OHIM and by the Trade Mark Offices of MS. They are really scarce cases.

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<sup>181</sup> INTA 1997.

<sup>182</sup> UK Manual, chapter 6, section 6.2.

<sup>183</sup> E.g. the UK Manual, chapter 6, part 6.1.



A smell mark was first granted in the US by TTAB in 1990<sup>184</sup>. The application was for the registration of a fragrance described in the application as “a high impact, fresh floral fragrance reminiscent of plumeria blossoms”, in respect of embroidery yarn. In this case, TTAB seems to have relied heavily on the fact that the applicant was the only existing producer of scented yarn in the country and that customers, dealers and distributors of her scented yarns and threads recognised the applicant as the source of the goods.

After 9 years from the registration of the first smell mark in US, in 1999, the first and so far only one smell mark in the Community was granted to Venootschap onder Firma Senta Aromatic Marketing<sup>185</sup>. The mark related to tennis balls and was identified by the words “the smell of fresh cut grass”.

In UK, two smell marks have been successfully registered. The first was granted to Sumitomo Rubber Co, which applied to register “a floral fragrance/smell reminiscent of roses as applied to tyres”<sup>186</sup>, and the second was granted to Unicorn Products, which applied to register “the strong smell of bitter beer applied to flights for darts”<sup>187</sup>.

## **5.4.2 “Smell of fresh cut grass” decision and the recognition of smell mark**

### **5.4.2.1 “Smell of fresh cut grass” decision**

As mentioned, the “Smell of fresh cut grass” is a rare registration of a smell mark that paves the way for the protection of smell as CTM and it has been also considered a controversial decision.

In this case, The Second Board of Appeal began by setting out the purpose of the “graphic representation” requirement in art. 4 CTMR, referring to its decisions in 3D Mark<sup>188</sup> and Orange<sup>189</sup> where it held that graphic representation was an imperative necessity for conducting the examination and registration procedure. The question was then whether or not the description of “the smell of fresh cut grass” gave clear enough information to those reading it to walk away with an immediate and unambiguous idea of what the mark was when used in connection with tennis balls. The Second Board of Appeal took the view that the “smell of fresh cut grass” did indeed satisfy those requirements and overturned the examiner’s decision by stating that “the smell of freshly cut grass is a distinct smell that everyone immediately recognises from experience. For many, the scent or fragrance of

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<sup>184</sup> Re Clarke 17 USPQ 2d 1238 (1990).

<sup>185</sup> Case R 156/1998-2.

<sup>186</sup> UK Registration No. 2001416.

<sup>187</sup> UK Registration No. 2000234.

<sup>188</sup> Case R 4/1997-2.

<sup>189</sup> Case R 7/1997-3.

freshly cut grass reminds them of the spring or summer, manicured lawns or playing fields, or other such pleasant experiences”<sup>190</sup>.

After being published, this decision had been confronted with many criticisms that mainly concern the requirement of graphic representation. “It seems to have reached this conclusion with little consideration of the principal issue involved, namely, whether the mark had been properly represented graphically. The Appeal Board did not address the concerns raised by the examiner, in particular as to whether the verbal description of the mark was sufficient to fulfil the “graphic representation” requirement.<sup>191</sup> The Board of Appeal decided to interpret Article 4 widely in this case without giving much thought to the meaning of “apparatus”.

#### **5.4.2.2 The recognition of smell mark**

It seems that smells can constitute perceptible signs that are capable of distinguishing goods or services of one company from those of other companies. Smells are emanations carried by a fluid (air or water) that are perceived by the olfactory apparatus. Currently, smells play an increasingly important role, not only in the area of perfume, but also in that of food products and other promotional activities. They are even used therapeutically or as stimulants<sup>192</sup>.

From the legal aspect, a smell can be protected as a trade mark where it meets the two conditions of graphic representation and distinctiveness.

Besides the normal way of written description, in fact, there exist other sophisticated methods for graphically defining smells such as physico-chemical formulas, descriptions in analogue, spectrometric and even chromatographic forms – even though certain molecules have not yet been identified among the nearly 500,000 known substances<sup>193</sup>. Perfumes, for example, are complex mixtures of volatile compounds that give off a distinctive aroma. The volatility given off by the perfume can be analysed by gas chromatography (GC) or high-performance liquid chromatography (HPLC)<sup>194</sup>.

The question of the capability of smells to distinguish an applicant's goods or services should be decided on the same general criteria as with any other kind of trade mark. Smells can be registered as CTM where they are not essential to a natural part of goods, e.g. the use of salty and iodised smell of the sea or the ocean to designate clothing<sup>195</sup>. The distinctiveness is normally acquired more easily and smell can be registered where smells are not common in trade or when they are attached to an object that usually does not have odorous qualities or properties. A scent applied to embroidery threads, thus, would exercise a distinctive purpose<sup>196</sup>. On the contrary, smell can not be registered as CTM where they are essential to a natural part of goods. Aromas alone cannot be appropriated since they are produced by

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<sup>190</sup> Case R 156/1998-2, para. 14.

<sup>191</sup> Peter.

<sup>192</sup> Franzosi, pp. 185 - 186.

<sup>193</sup> Franzosi, p. 186. For further details, see Teranishi, Flath and Sugisawa; Theimer; Macrae.

<sup>194</sup> For further details, see Lyons, pp. 540-542.

<sup>195</sup> Franzosi, p. 186. See also Field Fisher Waterhouse.

<sup>196</sup> Ibid.

nature. Thus, the aroma of chocolate must remain available to all those in the chocolate business. Smells are also excluded from protection as trade marks where they become common in trade, e.g. pine oil is a known disinfectant and is commonly used in disinfecting and cleansing liquids. The scent of pine oil would therefore be inherently incapable of distinguishing such goods from another. The same would apply to any scent for perfumes, oils etc., as the function of such products is to give off scent and/or scent the wearer. Also the application of scents to products in order to mask their otherwise unpleasant odour would constitute a functional use of such a scent and would therefore not be inherently adapted to distinguish the goods to which they were applied.

### **5.4.3 Sieckmann case and the future of smell mark**

#### **5.4.3.1 Sieckmann case**

While the “Smell of fresh cut grass” decision has paved the way for protection of smell marks, the Sieckmann case<sup>197</sup> has put a big barrier in the path. This case was referred to the ECJ from the German Patent Office concerning the interpretation of art. 2 of the Harmonisation Directive as well as art. 4 of CTMR and the meaning of “graphic representation” in the context of smell marks.

According to AG Colomer, graphic representation must satisfy two conditions. First of all, representation must be clear and precise so that the reader knows exactly what is exclusively owned by the trade mark owner. Secondly, it must be intelligible to those who consult the register. For a sign to be registered under art. 2 of the Harmonisation Directive it must have a distinctive character and be capable of being represented graphically in a clear and precise form that is understandable to the majority of manufacturers and consumers. He did not think that it was possible to “draw” a smell with sufficient clarity and precision so that it was understandable to all.

In this case, the German Patents Court had asked for guidance on the acceptable form of graphic representation by suggesting four options: chemical formula, written description, sample or a combination of any of these. The AG rejected all four in turn. He said that a chemical formula did not represent the smell of a substance but rather the substance itself. By representing a mark as a chemical formula, applicants would only be setting out the chemical composition and the measurements needed to arrive at a pre-determined result. They would not be setting out the smell itself, and very few people would be capable of interpreting a smell from the formula. Also, the same product was capable of emitting different smells depending on outside factors such as the concentration of the chemicals, the surrounding temperature or the surface onto which the substance was applied. A written description of a sign constituted a graphic representation but it was not in itself sufficiently clear and precise. The lodging of a sample of a chemical product was not an effective graphic representation of a sign. A sample is difficult to register and be published with sufficient clarity and accuracy. Further, the AG referred to the volatility of chemical components that eventually leads to changes in a particular composition and ultimately to the

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<sup>197</sup> Case C-273/00, Ralf Sieckmann v Deutsches patent-und Markenamt Chanel’s Application.

evaporation and disappearance of the smell. And finally a combination of the above graphic representations was also objected to.

AG Colomer expressed again the objection to registering smell as trade marks by stating that there were very sophisticated ways of recording smells but, at present, no one of these systems was sufficiently clear and precise for the purposes of recording a smell as an olfactory mark. He referred to the “freshly cut grass” decision by the OHIM as a “pearl in the desert”, an isolated decision destined not to be followed<sup>198</sup>.

It is obvious that Sieckmann case, especially the opinion of AG Colomer serves as a strong objection of the registration of smell marks. Will it affects the future of this unusual mark and can it overturn the current direction into a refusal to protect smell marks as well as other invisible marks such as sound and taste marks?

#### **5.4.3.2 The future of smell mark**

In order to foresee the future of smell marks in the EC, we should again look at the three grounds of legal basis, the functionality doctrine and reality.

##### *Application of legal requirements*

The recent EC trade mark legal documents do not in principle exclude smell from being registered as CTM. From the legal aspect, therefore, application for smell marks may be accepted. It is up to the applicant to convince the Registrar that what he seeks to be protected in fact is capable of being represented graphically, i.e. capable of distinguishing goods or services of one undertaking from those of others. Difficulties become obvious when applying these requirements to smell marks.

With the colour mark, the problem comes from the competition aspect but with sound mark, smell mark and other non-visual marks, the core issue is graphic representation. Even more than with sound marks, there is a real problem with representing smell marks graphically. How can a sign incapable of being perceived visually be reproduced indirectly? If an applicant cannot draw a mark on paper or spell the mark out in words, he cannot obtain the registration. Whether the words included in the application constitute an adequate representation of the sign applied for? Even though where the applicant describes accurately and precisely the smell he seeks to register by written description or image, the certainty is not secured since the description is not smell itself and it is difficult to perceive the mark as a result of these descriptions. The barrier of graphic representation requirement has become higher and more difficult to overcome after the opinion of AG Colomer in the Sieckmann case where he rejected all ways of current representations. It is therefore likely that all smell marks are objectionable under art. 7(1)(a) of CTMR<sup>199</sup>.

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<sup>198</sup> See Legal500. See also SIB News.

<sup>199</sup> OAMI Manual, section 5-Absolute grounds, part 2.4.

The distinctiveness of smell is assessed by two elements - the smell itself and the perception ability of human nose. Only if the nature of scents and the ability of the human nose allow, can smells become distinctive for trade mark purposes. However, recently the ability to recognise smell of human beings has become controversial. Hawes concludes from research in America that people can recognise smells<sup>200</sup>. However, Bettina Elias believes that Hawes confused “recollection” with “recognition” and concludes from the same study that while people can recall smells, they cannot recognise them. Thus a person could say that the smell was evocative and they remembered it, but could not accurately identify from where or with which exact product<sup>201</sup>.

Moreover, scent is usually an ornamental or functional feature of a product and therefore non-distinctive. Many products have scents with the purpose of making the use of the products more pleasant or attractive (called product scent). Potential purchasers of these goods are unlikely to consider these fragrances as an indication of the origin of the goods. It may therefore be difficult to show that a particular smell indicates the goods of a particular trader<sup>202</sup>. With primary scents (such as perfumes, air freshener where emitting a fragrance is the primary purpose of the product), given the importance of the fragrance as the product, it may be more likely that customers concentrate their minds on the scent and therefore perhaps accuracy may be increased. But this may be counterbalanced by the range of scents and the fine gradations between them, which may be difficult for human noses to distinguish<sup>203</sup>.

### *Functionality doctrine*

According to the doctrine of functionality, both product scents and primary scents can be functional. Product scents can be added for the purpose of odour masking and thus fulfil a utilitarian function. In other cases a broad view of a product’s function may include scent performing a secondary utilitarian function. With other products, a given scent, although purely ornamental by its customary use, might become aesthetically functional by consumer demands for it. Primary scents are the product. The function of the product is to emit fragrance. Further, consumers may desire a specific scent, regardless of source, and it may be that a scent could be found to be aesthetically functional<sup>204</sup>.

### *Fragrance depletion*

With product scents, only certain scents are appropriate for certain products, e.g. “clean” or “fresh” smells for laundry detergent and since customer preference is for scented products, it appears that depletion could occur and effectively drive competitors from the market<sup>205</sup>. Moreover, the range of fragrances available for primary scents is limited by the requirement of a pleasant scent and it is a moot point how many genuinely new types of fragrance could

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<sup>200</sup> Hawes.

<sup>201</sup> Elias.

<sup>202</sup> UK Manual, chapter 6, section 6.3.

<sup>203</sup> Burton, p. 380.

<sup>204</sup> Lyons, p. 382.

<sup>205</sup> Burton, p. 381.

be found which did not overlap existing ones. Thus if similar scents are monopolised only the mark owner could produce variations on a theme<sup>206</sup>.

### *Reality*

The reality of application and registration at the Community level shows that the protection of smell marks becomes more difficult. Until recently, only one smell mark has been granted and almost all applications for registering smell marks have been refused<sup>207</sup>. The number of application even reduced to zero in 2001 after the delivery of the opinion of AG Colomer in the Sieckmann case.

#### **5.4.4 Interim conclusion**

The previous analysis helps foresee the future of the protection of smells as CTM and also answers the question that whether we should continue to protect such marks. It is uncertain whether or not smells will continue to be registered as CTM. This, certainly, affects other special invisible marks. I think that smell should not be protected as trade mark.

## **5.5 Slogan mark**

A slogan mark is a special kind of traditional word mark formed by word or words and is the normal description and statement that attaches to goods or services. Such slogans have been considered an effective marketing tool since it comes readily to mind of customer. For example “EXTEND YOUR REACH”, “FREE TO READ. FREE TO WRITE. FREE TO EVERYONE”, “GO FLY A KITE”<sup>208</sup>. Moreover, in comparison with other unusual marks, seemingly they are more easily registered. However, it must be borne in mind that slogan marks may be sought to be registered where they are non-descriptive, they are not purely descriptive characteristics or signs of the quality of goods or services they mark even if they are capable of distinguishing the goods or services of this trader with those of other ones. Thus, it is easier to obtain registration where other fanciful elements, business name or logo adds the slogans<sup>209</sup>.

Due to its characteristic, slogan mark easily becomes banal, promotional and common. Additionally, the slogan mark also normally falls in describing the character or quality of the goods or services it confers. Therefore, it is difficult to obtain the requirement of imperative distinctiveness and can not be registered. In case *Maxygen, Inc.*<sup>210</sup>, the Second Board of Appeal rejected the submission of the appellant that all slogan trade marks are inherently descriptive of the goods and services they cover. On the contrary, the Board held that a

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<sup>206</sup> Ibid.

<sup>207</sup> For example, “The trade mark is a graphic representation of a particular fragrance, a lawn green note, citrus (bergamot, lemon), pink floral (orange blossom, hyacinth), musky” – CI. 3, 5, 16, 18, 24; “The mark represents the smell of an amber, woody aroma with Virginia tobacco undernotes and a mace topnote” – CI. 3, 16, 18, 25; “Smell of ripe strawberries” – CI. 35, 41, 42.

<sup>208</sup> CTM Application Nos. 173484, 160622, 169219.

<sup>209</sup> For example, Yellow Pages “Let Your Fingers do the walking”, NIKE “Just do it”.

<sup>210</sup> Case R 435/2000-2. See also Case R 161/1998-1 for the slogan “100% Pure Goodness”.

slogan mark merely alludes to the character or quality of the goods and services without directly describing them and describing in which case the registration of the sign as a CTM should not be refused under art. 7(1)(c) CTMR. In this case, the slogan “MAXIMISING GENETIC DIVERSITY” that the applicant sought for registration of goods and services in Class 1, 5, 31, 40, 42 e.g. transgenic plants, chemical research services<sup>211</sup> is unacceptable. The indication given by the sign is immediate and direct. In other words, this slogan consists of only the direct description of goods and services that it relates to and it does not, tease the consumer by alluding to bio-diversity. There is nothing subtle or ambiguous about the sign that would cause the relevant specialist consumer to ponder the meaning of this sign<sup>212</sup>. From this perspective, the slogans “THINK TOYS” and “EXPANDING POSSIBILITIES” presented a sufficiently allusive and fanciful character to be considered not exclusively descriptive<sup>213</sup>.

However, the promotional characteristic of a slogan mark can be accepted. This is seen in case Clinique Laboratories, Inc.<sup>214</sup>, where the Board agreed with the Examiner that the slogan mark “BEAUTY ISN’T ABOUT LOOKING YOUNG BUT LOOKING GOOD” is promotional text. But in contrast to the examiner’s decision, the Board held that promotional text is “considered a positive property of the trade mark rather than a negative one, as it serves not only to identify the origin of the goods or services to which it relates but also a marketing function in that it draws attention to them”<sup>215</sup>. The Board was satisfied, upon looking at the trade mark as a whole, that this slogan mark has the capacity to distinguish its goods and services - including cosmetic product and beauty treatment services - from those of its competitors.

## 5.6 Other special marks

In principle, any sign capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of others can be protected as CTM. Therefore, besides the main special marks previously mentioned, some other marks may be registered such as hologram mark, animation mark, taste mark and gesture mark.

### Hologram mark

The only hologram mark that has been registered as CTM with the description that “The trade mark is a circular hologram, placed on the top of the packaging”<sup>216</sup>.

### Animation mark

There has been also one animation mark accepted by OAMI with description that

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<sup>211</sup> See WIPO IV.

<sup>212</sup> Case R 435/2000-2, para. 13.

<sup>213</sup> Case R 435/2000-2, para. 15.

<sup>214</sup> Case R 73/1998-2.

<sup>215</sup> Case R 73/1998-2, para. 16.

<sup>216</sup> CTM Application No. 001787456.

“Animation consisting of six sequential pictures in numerical order with an interval of 0.2 seconds beginning from picture number 1. Please note that the frames do not belong to the mark. They are used only to separate the six pictures from one another”<sup>217</sup>.

### **Taste mark**

Flavour is a quality perceived by the sense of taste. The flavour of Coca-Cola soft drink is its particular and individual flavour. It can give its origin and even allows instant identification and personalization of the Coca-Cola Co.<sup>218</sup>. Usually, due to their lack of fame, flavours are not capable of identifying or personalising the company that supplied the object. Moreover, flavours are indissociable from the object they are attached to; they even constitute the essential quality of foods or beverages, and such quality determines the consumer’s choice. Therefore, taste signs are difficult to become distinctive<sup>219</sup>. From a legal perspective, however, taste signs can be registered as trade marks where they allow consumers to recognise and identify the origin of the object, especially given its long-standing and extensive use, they could constitute a valid trade mark, since they render the object distinctive in comparison with competing foods and beverages. It should be noted that, until recently there has not been a taste mark registered at the Community or Member State level.

### **Gesture mark**

One gesture mark was registered before the UK Patent Office – Derbyshire Building Society’s “gesture made by a person by tapping one side of his/her nose with an extended finger, normally the index finger of the hand on the side of the nose being tapped”<sup>220</sup>.

Currently, these unusual marks - especially taste marks and gesture marks - are normally considered to be objectionable on the basis of graphic representation, because, like smells, “it is difficult to graphically represent the precise mark”<sup>221</sup>. The road ahead for these marks, thus, can be foreseen so ambiguous.

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<sup>217</sup> CI 35, 41, 42.

<sup>218</sup> Franzosi, p. 186.

<sup>219</sup> Ibid.

<sup>220</sup> UK Registration No. 2012603.

<sup>221</sup> OAMI Division Manual, Section 5 – Absolute grounds, part 2.6.



## 6. Conclusion

Undoubtedly, the special marks are receiving legislative support from both international conventions and the EC trade mark legislation. After the issue of the Harmonisation Directive, and especially CTMR, traders can register for unusual signs such as 3D, colour, sound, smell, slogan, hologram, taste, animation and others, which are capable of graphic representation and of distinguishing their goods or services with those of other traders as CTM. With each kind of unusual marks, the borderline between registrable and unregistrable marks differs from this of other kinds as mentioned in whole Chapter 5.

Special marks have exposed their function as essential identifiers in commercial reality. However, the EC as well as US practice warn that it is not easy for these new kinds of sign to be registered. In the Community, special marks got off to a difficult start. In fact, though introduced in 1989 in the Harmonisation Directive, they were not registered in reality by OHIM until 1996, after the introduction of CTMR. Recently, it seems that only 3D marks and slogan marks are “safe” with few problems, whereas other special marks meet with difficulties and almost all of them fall in the ensuing controversy. Colour marks face exclusion by way of the functionality doctrine as well as the competition aspect. Attempts to register sound marks, smell marks and other invisible marks has been opposed on the ground of graphic representation. Therefore, there are many obstacles ahead for these special marks.

With the recently adopted special marks, I strongly believe in the legal existence of the 3D, colour, sound, slogan, animation and hologram marks and even sound marks. As mentioned in Chapter 5, section 3, the graphic representation of sound mark can be solved. Nevertheless, I really worry about the protection of smell as well as taste marks and suppose that we should not register these marks since due to their nature, they inherently lack distinctiveness.

In the EC, the protection for special marks depends very much on the efforts of the European authorities and courts as well as the Member States. If they wish these unusual marks to continue functioning as CTM, necessary solutions must be provided. For example, the special marks should be provided for more explicitly in the EC trade mark legislation; precise and articulated methods for graphically representing invisible signs should be found out by scientific methods and recognised by both the public and the various European trade mark offices.

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<sup>222</sup> Source: OHIM III.

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# Appendix 1

## Applications for CTM, situation 1996 - 2001<sup>223</sup>

Type of Mark	Application 1996-2000	%	Applications 2001	%	Total	%
Work mark	129.381	64,50	32.262	66,03	161.643	64,80
Figurative mark	68.959	34,38	16.166	33,09	85.125	34,12
3D mark	1.871	0,93	298	0,61	2.169	0,87
Other mark	199	0,10	84	0,17	283	0,11
Colour mark	166	0,08	39	0,08	205	0,08
Sound mark	15	0,01	5	0,01	20	0,01
Olfactory mark	6	0,00	0	0,00	6	0,00
Hologram mark	1	0,00	2	0,00	3	0,00
Total	200.598	100	48.856	100	249.454	100

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<sup>223</sup> Source: OHIM VI.

### Registered CTM, situation 1997-2001<sup>224</sup>

Type of Mark	Registered Trade Marks 1997-2000	%	Registered Trade Marks 2001	%	Total	%
Work mark	59.001	62,96	24.175	62,79	83.176	62,91
Figurative mark	34.190	36,48	14.088	36,59	48.278	36,51
3D mark	452	0,48	211	0,55	663	0,50
Other mark	59	0,06	9	0,02	68	0,05
Colour mark	9	0,01	16	0,04	25	0,02
Sound mark	2	0,00	5	0,01	7	0,01
Olfactory mark	1	0,00	0	0,00	1	0,00
Total	93.714	100	38.504	100	132.218	100

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<sup>224</sup> Source: OHIM VII.

## Appendix 2<sup>225</sup>

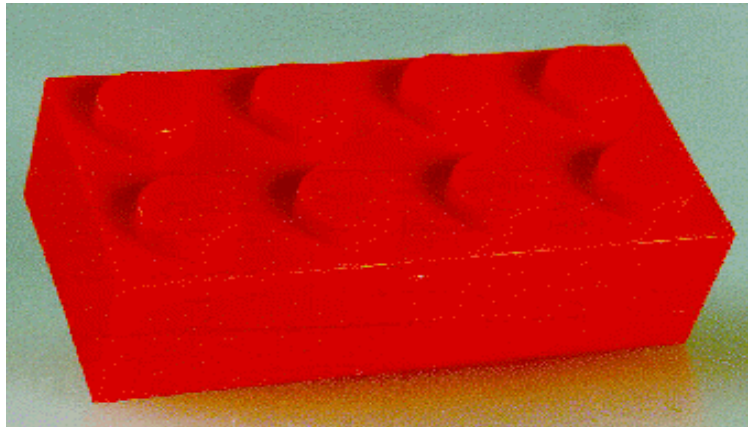


Figure 1: Shape of Lego brick, CTM Application No. 000107029.



Figure 2: Signature tune of Nokia Corp., CTM Application No. 001040955.



Figure 3: Lilac/purple colour of chocolate, CTM Application No. 000031336.

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<sup>225</sup> Source: OHIM II

