



FACULTY OF LAW
University of Lund

**Master of European Affairs programme,
Law**

Muhammad Sarwar Chaudhry

SCOPE OF TRADEMARK PROTECTION

Master thesis
15 points

Supervisor
Ulf Maunsbach

Field of study
Intellectual Property Law

Semester
Spring 2007

Contents

SUMMARY	1
PREFACE	2
ABBREVIATIONS	3
1 INTRODUCTION	4
1.1 Statement of Purpose	5
1.2 Basic Research Question (s)	5
1.3 Research Methodology	5
1.4 Delimitations	6
1.5 Disposition	6
2 EVOLUTION AND HISTORY OF TRADEMARKS IN ENGLAND	8
2.1 Historical Trademarking	8
2.2 Protection of Trademarks at Law and Equity	9
2.3 Basic Features of Trademarks	13
2.3.1 <i>Functions</i>	13
2.3.2 <i>Distinctiveness</i>	14
2.4 Rationale underlying Trademark Law	15
3 TRADEMARKS: INTERNATIONAL DIMENSION	17
3.1 Paris Convention	17
3.2 TRIPS Agreement	18
3.2.1 <i>Criteria for Trademark Protection</i>	19
3.2.2 <i>Overview of Subject Matter of Trademark Protection</i>	19
3.2.3 <i>The Scope of Trademark Protection</i>	20
3.3 Joint Recommendation on Trademarks	21
3.4 Trademarks and Territoriality	22
4 TRADEMARKS: EU DIMENSION	24
4.1 Legal Framework and Basic Features	25
4.1.1 <i>Mandatory Grounds of Exclusion</i>	29
4.1.2 <i>Non-Mandatory Grounds for Exclusion</i>	31
4.1.3 <i>Use and Non-use of Trademarks</i>	33
4.2 Trademarks and Territoriality	34

4.3	Scope of Trademark Protection: Extended Discourse	35
4.3.1	<i>Protection of Non-conventional Trademarks</i>	35
4.3.2	<i>Recent Cases on Non-Conventional Trademarks</i>	38
4.3.2.1	Smell /Scent as Trademark	39
4.3.2.2	Sound as Trademark	41
4.3.2.3	Shape as Trademark	42
4.3.2.4	Surnames as Trademarks	45
4.3.2.5	Colour as Trademark	46
4.3.2.6	3-D Marks	50
5	TRADEMARKS LAWS IN THE US	52
5.1	Early American Trademark Jurisprudence	52
5.2	Lanham Act	54
5.2.1	<i>Trademarks under Lanham Act</i>	54
5.3	How to Receive Protection?	61
5.3.1	<i>Scope of Protection</i>	62
5.3.2	<i>Duration of Protection</i>	64
5.3.3	<i>Effects of Registration</i>	64
5.3.4	<i>Should a Trademark be Federally Registered?</i>	66
5.3.4.1	Federal Registration	67
5.3.4.2	State Registration	67
5.3.5	<i>Infringement</i>	68
5.3.6	<i>Enforcement</i>	69
5.3.7	<i>Anti-Dilution</i>	70
5.4	Trademarks and Territoriality	70
5.5	Scope of Trademark Protection: Extended Discourse	71
5.5.1	<i>Protection of Non-Conventional Trademarks</i>	71
5.5.1.1	Colour as Trademark	71
5.5.1.2	Sound as Trademark	72
5.5.1.3	Scent as Trademark	73
6	COMPARATIVE ANALYSES	74
6.1	Scope of Protection	74
6.2	Protection of Non-conventional Trademarks	76
6.3	Dilution of Trademark	77
6.4	Registerability	80
6.5	Infringement Protection	82
6.6	Use and Non-use of Trademark	82
6.7	Territoriality	83

7 EPILOGUE	85
BIBLIOGRAPHY	90
TABLE OF CASES	93

Summary

The rationale behind trademark law is to protect business goodwill and reputation, but the ultimate benefactor is the public. The trademark as a badge of origin serves as identifier of quality of the products, and thereby facilitates the public in eliminating the confusion about the source of products.

Over the last two decades or so, the trademark law in many jurisdictions of the world has significantly expanded in several different ways. Eventually, the scope of rights afforded to a trademark owner has been extended to prevent non-competing uses by others that are not likely to cause consumer confusion but which may dilute the distinctiveness of the trademark owner's mark.

In the wake of ongoing technological revolution in the communication and the enhanced process of globalization, the business enterprises seem inclined to show more interest in protecting non-conventional marks such as colour marks, shape marks, smell marks, sound marks, trade dress etc. to capture the competitive global market. Not only has it widened the scope of trademark protection, but it has also provided the business enterprises different options of mark protection. Hence, the scope of trademark protection has attained pivotal importance in the trademark regime.

This thesis is an attempt to make a systematic analysis of the scope of trademark protection in different jurisdictions, with a mention of the functions of trademarks and the purpose of the law protecting trademarks.

Preface

I am highly indebted to Prof. Ulf Maunsbach for his valuable guidance and inspiration in the accomplishment of my thesis. Despite his gruelling schedule, he was always receptive to provide me guidance on my research work. I am not non-committal to admit that the work I have completed could not have been that much productive, hadn't my supervisor spurred me on.

I would also like to tacitly acknowledge my own scholastic limitations in the writing of this thesis. Hence, my research work might be having some lacunae and/or apparent deficiencies, but I would rather like to customarily leave this task to be accomplished by my succeeding researchers to make up those inadequacies.

I would also like to thank the Juridicum, the Faculty of Law, to give me an opportunity to complete my Masters of European Affairs programme. In general, I owe my thanks to Swedish Government for providing me an opportunity of tuition-free education with conducive environment, highly trained faculty and co-operative administrative staff.

Chaudhry, Muhammad Sarwar
Lund University,
Spring, 2007

Abbreviations

CFI	Court of First Instance
CTMR	Community Trademark Regulation
EC	European Community
ECJ	European Court of Justice
EU	European Union
FTDA	Federal Trademark Act
INTA	International Trademark Association
ITU	Intent-to-Use
OHIM	Office for Harmonization in the Internal Market
PTO	Patent and Trademark Office
TLRA	Trademark Law Revision Act
TRIPS	Trade-Related Aspects of Intellectual Property Rights
WIPO	World Intellectual Property Organisation

1 Introduction

Ever since the capitalism emerged, honest traders have sought to identify their goods from the goods produced by other persons by appending distinguishing signs to them. It has also been a usual trade practice on the part of dishonest traders to consciously imitate such signs with a view to passing off their goods as the goods of a more successful trader with an established reputation. Therefore, the basic function of trademarks is to indicate the origin of goods. Moreover, trademarks afford a mechanism to the traders by which they can effectively protect their commercial reputation or goodwill.

It might indeed be true to state that trademarks are at the heart of competition in a developed market economy. Of course, trademarks are the means by which enterprises establish direct contact with the ultimate consumers of goods. Without trademarks, manufacturers may not be encouraged to produce goods of high quality because the consumers may not be skilful to distinguish goods emanating from a particular source. Hence, the consumers may not be able to remunerate a supplier of quality produce with their continued patronage.

A law protecting marks, accordingly, seems unavoidable in a capitalist economy. In many ways, however, these laws have tended to develop in such a manner that they may appear to confer power without responsibility. For instance, the trademark owner procures the pre-emptive right to stop imitations of his indication of source, but his own use is checked by few limitations or positive requirements. Nevertheless, the trademarks law is primarily concerned with the prime function of the trademarks, which is to designate the trade origin of goods.

1.1 Statement of Purpose

The purpose of this study is aimed to research into the scope of trademark protection in the EU, the US and at international level. The paper is also expected to make a comparative study among these jurisdictions, and finally make some viable suggestions for trademark protection in the EU and elsewhere.

1.2 Basic Research Question (s)

The major research question to be answered by this research is:

- What is the scope of trademark protection at the international level, in the EU, and the US?

The following sub-questions also arise:

- i) What protection did trademarks hold at common law and equity?
- ii) At international level, what is the scope of trademark protection?
- iii) What is the legal framework of trademark protection in the EU, and the U.S.?
- iv) What are the basic features of trademark protection in the EU and the US?
- v) How does the scope of trademark protection in the EU differs from those of the US, and International level, and what are the similarities and dissimilarities among these regimes?

1.3 Research Methodology

This study can best be described as a `desk-based research` to the extent that the research is generally based on already existing legal instruments that have to be thoroughly scrutinized, with a view to discerning and isolating therefrom, specific provisions relating to trademarks. Therefore, the researcher will examine legal documents, reports, commentaries, decisions, and judgments.

The research has involved the perusal and analysis of existing academic literature and scholarly writings on the subject at hand. A multitude of textbooks, research studies, law journals and other materials on the subject have to be consulted, both in hard copy and from the Internet.

1.4 Delimitations

As the title indicates, the thesis mainly focuses on the scope of trademark protection. I will make every possible endeavour to research into the trademark protection in the EU, the US and at the international level. From the research findings, I will make comparative analyses among the different options of mark protection in these jurisdictions.

Owing to the paucity of time and resources, I cannot research into the administrative issues related to trademark law, which I intentionally leave for the later researchers to look into. So I am bound to delimit myself only to the notion of scope of protection of trademark.

1.5 Disposition

This thesis is divided into seven chapters, throughout which the chosen topic for the sake of research purpose is analyzed from a relatively broad towards a narrow perspective. The first chapter introduces the subject and further dilates on the purpose of study, research methodology to be adopted, and overall significance of study. The subsequent chapters are structured as under:

The second chapter attempts to review the relevant literature, focusing specifically the early history and evolution of trademarks, protection of trademarks at common law and equity, and highlight basic features of trademark in general.

The third chapter of thesis will deal with the trademarks laws at the international level.

The fourth chapter will cover trademarks protection laws in the EU, centering around both the Trademark Directive and CTMR. A special mention will be made of registerability of trademarks in the EU.

The fifth chapter will deal with the history of trademarks in the US and early court jurisprudence. It will also focus on the trademark laws in the US and recent case law on protection of trademarks.

The sixth chapter will make a comparative analysis of the scope of trademark protection in different regimes, highlighting similarities and dissimilarities among the various jurisdictions.

The final chapter of the research paper draws a conclusion on the basis of research findings, and thereby briefly answers the research questions tailored in the first chapter.

2 Evolution and History of Trademarks in England

This chapter will briefly examine the evolution of the law of trademark protection, and culminate in a more detailed manner the protection of trademarks at common law and equity. The object of this brief historical overview is to demonstrate the fact that the functions of trade symbols are constantly evolving. From this starting point, it is possible to trace the continual evolution of the modern trademark in the subsequent part of this chapter. The reason why I have chosen the development of trademark protection in England only is that the protection of trademark at common law still holds relevant in many countries of the world.

The second part of this Chapter will dilate on the functions of trademarks so as to provide the basis for further discussion in the subsequent chapters.

2.1 Historical Trademarking

The practice of marking goods for various purposes has been known since prehistoric times, and indeed for centuries before legal protection was even an issue. Examples are cited of cattle branding and pottery-bearing markings from as long ago as 5000 BC. Trademarks (in the general sense) attained particular importance as a result of widespread trade in the ancient world, especially from Egypt, and later within the Roman Empire. Because of the long distances over which trade took place and the hazards of such journeys, these ancient trademarks functioned in the main as proprietary marks which conclusively indicated the ownership of goods, for example in cases of shipwreck and piracy, as well as assisting the illiterate who came into contact with these goods.¹

The twelfth and thirteenth centuries saw resurgence in trade and revival in the use of marks on all manner of goods. Two distinct, but not necessarily

¹ Pickering, C. D. G, *Trademarks in Theory and Practice* (Hart Publishing, 1998), pp. 36, 37.

mutually exclusive, types of mark could be identified during this time: the proprietary mark and the regulatory or production mark².

It does not seem worthwhile to further go into details about the history of trademarks in this period. However, it seems in fitness of things to directly embark upon the protection of trademarks at law and equity in England, which is the primary purpose of this chapter.

2.2 Protection of Trademarks at Law and Equity

Initially, trademarks were not generally seen as something needing legal protection until around the time of the industrial revolution. Consequently, neither the Common Law nor Equity troubled itself with the issue of trademark protection until relatively later on; with the result, that many writers were originally quite content to presume that the law of trademark protection was the sole creation of the late eighteenth and early nineteenth centuries. When the need for a general protective law did arise, it was met in three ways: initially at common law alone, then additionally through trademark registration and finally on an international and Community level.³

The root of trademark protection in the English common law is generally said to be the findings of the Court in an unreported case *Southern v. How*⁴. After this, there came silence in the law reports on the matter until the case *Blanchard v. Hill*⁵. Injunctive relief in this case was actually refused because of the fear of allowing an unfair monopoly (a more detailed comment on this case will follow in later part of this section).

It is also important to note that the trademark law developed from an early form of passing off. Long before the establishment of a formal system of registration of trademarks, it was usual for the courts to restrain the use by one trader of another trader's mark. The first ever-reported case *Sykes v*

² *Ibid.*

³ Pickering, *see supra* n. 1 at p. 2.

⁴ (1618) Popham 143.

⁵ (1742) 2 Atk. 484.

*Sykes*⁶ shows that the courts were treating a trademark as a form of proprietary right which depended upon the deceptive use of a similar mark for its enforcement. In *Sykes*, the plaintiff carried on the business of a shot-belt and powder-flask manufacturer, and made and sold for profit a large quantity of shot-belts and powder-flasks. The plaintiff was accustomed to mark his products with the words “Sykes Patent,” in order to denote that they were manufactured by him. One of the defendants argued that he had as much right to use ‘Sykes Patent’ as his name was also Sykes. The court allowed an action for damages but based primarily on proof of deliberate deceit.

Subsequently, in *Millington v. Fox*⁷ a remedy was allowed in Equity even in the absence of any fraudulent intent on the part of the defendant. The essence of liability was a likelihood of public deception arising from the defendant’s misrepresentation.

A second line of equitable cases dating from the time of Lord Westbury L.C. indicate that liability actually arose on the basis of the protection of property right in the mark. Nevertheless, in spite of the readiness of judges to recognise and protect trademarks, it was not until 1862 that the matter was first considered by Parliament. Resultantly, in 1875 a provision was made for the protection of trademarks by registration.⁸

Looking back, we come to know that the first reported English decision clearly involving a claim based on use of a party’s trademark was the court of equity’s 1742 decision in *Blanchard v. Hill*.⁹ In that case, the plaintiff, a maker of playing cards, sought an injunction restraining the defendant from making use of the *Great Mogul* as a stamp upon his cards, to the prejudice of the plaintiff. The plaintiff further said that he had the sole right to this stamp as a result of the charter which was granted to the card makers’ company by King Charles the First.¹⁰

⁶ 3 B. & C. 541 (K.B. 1824).

⁷ (1838) 3 Myl. & Cr.338.

⁸ Pickering, *see supra* n. 1 at p. 3.

⁹ *See supra* n. 5.

¹⁰ *Ibid.*

The factual context of *Blanchard* is particularly noteworthy; the plaintiff was seeking protection of a mark for playing cards pursuant to a royal charter, and charters granting exclusive rights to card makers had been at the centre of a long political struggle between Parliament and the Crown.¹¹

Lord Hardwicke noted that he believed that “the intention of the charter [under which the plaintiff claimed rights] [was] illegal,” and said the court would “never establish a right of this kind, claimed under a charter only from the crown, unless there ha[d] been an action to try the right at law.”¹² Relying on the earlier court jurisprudence, Lord Hardwicke implied that when the defendant intended to pass off its goods as those of the plaintiff, an injunction might be appropriate.

Despite the initial reluctance of courts of equity to recognize exclusive rights in trademarks and Lord Hardwicke’s suggestion that claimants first pursue their claims in courts of law, the first reported trademark decision by an English common law court was the 1824 decision in *Sykes v. Sykes* (as already mentioned quite briefly). After specifically noting that the plaintiff’s sales had decreased after the defendants began selling their identically labelled products, the court concluded that the defendants had violated the plaintiff’s rights by marking their goods so as “to denote that they were of the genuine manufacture of the plaintiff” and “[selling] them to retail dealers for the express purpose of being resold as goods of the plaintiff’s manufacture.”¹³

A number of common law cases following the *Sykes* decision recognized claims in similar circumstances, imposing liability when a competitor sought to pass off its goods as those of the claimant. Those cases generally were brought as actions on the case, in the nature of deceit. Yet one must be careful not to read those cases through modern lenses – despite the form of

¹¹ See Thomas Nachbar, “Monopoly, Mercantilism, and the Politics of Regulation,” 91 *VA. L. REV.* 1313 (2005).

¹² Mark P. McKenna, “the Normative Foundations of Trademark Law,” *Notre Dame L. Rev.* Feb., 2007.

¹³ See *supra* n. 6 at p.543.

action, courts in these early cases invariably described the defendant as having practiced fraud on the plaintiff.¹⁴

Courts of equity also became more solicitous of trademark claims in the first part of the nineteenth century. Of particular significance, courts very early on concluded that, where a claimant could demonstrate an exclusive right to use a particular mark, equity intervened to protect a property interest and evidence of fraudulent intent was not necessary.¹⁵

As Lord Westbury said in *Leather Cloth Co. v. American Leather Cloth Co.*¹⁶, rejecting any contention that courts of equity based their jurisdiction on fraud, [t]he true principal [sic], therefore, would seem to be that the jurisdiction of the Court in the protection of trademarks rests upon property, and that the Court interferes by injunction, because that is the only mode by which property of this description can be effectually protected.

Scholars opine that demands for legal protection against the imitation of marks and names were being made and acceded to from the early years of industrialization. The courts of equity took the lead because plaintiffs wanted injunctions. They intervened when one trader represented to the public that he was selling the goods or carrying on the business of another. By the 1850s, public agitation about the extent to which food, drugs and other commodities were sold in an adulterated state was beginning to run high. It mixed with the complaints of established competitors that they were being undercut by such practices, by cheap imports that did not declare what they were and by the false imitation of brands, marks and names. To some extent, purchasers found a market remedy but there were also calls on their behalf for legal protection.¹⁷

By the 2nd half of the nineteenth century it was clear that marks applied to goods that had become distinctive, had an intrinsic value and were worthy of some form of legal protection. Such protection was available through the

¹⁴ McKenna, *see supra* n. 12.

¹⁵ *Ibid.*

¹⁶ *Ibid.*, *see also* 4 De G.J. & S. 137, 141 (1863).

¹⁷ Cornish, W.R., *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights*, 2nd edition (Sweet & Maxwell, 1993), pp. 392, 393.

use of Royal Charters and court action.¹⁸ So, statutory forms of trademark law only made their appearance late in the second half of the nineteenth century, even though trademarks had been in use for much longer¹⁹. As the English courts had developed protection for trademarks through the action of passing off²⁰, this proved to be unsatisfactory and statutory systems of trademark registration began to make their appearance in Europe: England 1862 and 1875, France 1857, and Germany 1874²¹.

The Trademarks Registration Act 1875 was passed to overcome the difficulties encountered in such infringement actions. The Act established a statutory Register of trademarks that is still in use today. Entry of a mark on the Register is *prime facie* evidence against the unauthorised use by third parties. The Act of 1875 also laid down the essentials of a trademark, giving practitioners and the courts the criteria for determining what could legally amount to a trademark and, therefore, benefit from registration.²²

2.3 Basic Features of Trademarks

2.3.1 Functions

Traditionally, the function of a trademark has been perceived as being a reliable indicator of the origin of goods to the consumer, so that the owner of the mark should be able to bring an action against a competitor who uses a similar mark so as to confuse the consumer as to the origin of the competing goods. However, the modern advertising methods have changed the usefulness of marks as a means of communicating to the public, and the functions of marks have grown as a result.²³ This was noticed as long ago as

¹⁸ Tina Hart, Linda Fazzani & Simon Clark, *Intellectual Property Law*, 4th edition (Palgrave Macmillan, 2006), at page 83.

¹⁹ F. Schechter, "The Rational Basis of Trademark Protection," 40 (1927) *Harvard Law Review*, pp. 813-833.

²⁰ S. Ricketson, *the Law of Intellectual Property* (Law Book, Sydney, 1984) p. 599.

²¹ S. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, Vol. 1, (Harvard University Press, Cambridge, 1975) p. 8.

²² Tina Hart, *see supra* note 18 at page 84.

²³ Terence Prime, *European Intellectual Property Law*, (Ashgate Publishing Company, 2000), p.76.

1927 by Frank Schechter in his ground-breaking article ‘The Rational Basis of Trademark Protection’²⁴, published in the *Harvard Law Review*.

In the modern world, the functions of a trademark are no longer perceived by business and economists as limited to the signification of origin and the identification of the goods or services to which the mark is attached, but also to indicate the quality of the goods and promote them in the minds of consumers.

Moreover, at its best, ‘the benefits of trademarks in reducing consumer search costs require that the producer of trademarked goods maintain a consistent quality over time and across consumers. Hence trademark protection encourages expenditures on quality.’²⁵

Among the other possible functions of trademarks, it is important to note that a good trademark can be an essential tool for selling goods. As such, it is invaluable to the producer. In a market swamped by competing goods, the trademark is a shorthand description for the product. The trademark is useful to the consumer as she will choose goods based on personal or vicarious experiences of a product, and the trademark allows easy identification of the product which previously gave satisfaction, thus leading to repeat purchases. This leads to another possible function of the trademark: its guarantee function.²⁶

2.3.2 Distinctiveness

The very purpose of a mark is to distinguish the goods or services of one trader or businessman from those of another.²⁷ In order to qualify as a trademark under the definition, the sign must be capable of distinguishing the goods and services of the applicant from other goods or services with which it must compete. Clearly, a mark can only do this if it is distinctive. The distinctiveness of a mark can arise either naturally, or because the public has been made to perceive the sign as distinctive by its actual use in

²⁴ (1927) 40 *Harv. LR* 813.

²⁵ Prime, *supra* n.23 at p. 72.

²⁶ Tina Hart, *see supra* n. 18 at page 82.

²⁷ Cornish, *see supra* n. 17 at p. 440.

advertising. In the first case, the only meaning which the sign bears is in the context of the goods or services to which it is applied as in the case of an invented word such as Xerox. In the second case the sign does have an ordinary significance such as a lemon shape or the words “Golden Harvest”, but the ordinary meaning has been supplanted into the public consciousness by the application of the shape to particular products such as the *Jif lemon* or bread from a particular source.²⁸

2.4 Rationale underlying Trademark Law

By giving the right to trademark owners to prevent competitors from using protected distinctive signs, trademark law ensures that trademarks can be applied to identify the commercial source of a product or service. Trademarks indicate that the products or services to which they are attached have been put on the market by, or under the authority of, a particular commercial entity. The function of indicating the commercial source presupposes that the trademark distinguishes the goods or services of a given enterprise from those of other enterprises. In consequence, consumers can individualize the different offers in the marketplace and express their preference by selecting a specific product or service. This, in turn, will help the public’s preferred suppliers, products and services to prevail in the marketplace. The protection of trademarks thus contributes to the proper functioning of market economies. It encourages transparency and fair competition in the market.²⁹

The core function of distinguishing goods and services of undertakings in the course of trade has important ramifications. On the one hand, it may be said that, by clearly identifying the source from which a given good or service originates, a trademark gives an incentive for undertakings to maintain the quality of their products or services. The consumer will perceive the trademark, indicating that certain goods or services have the

²⁸Terence Prime, *see supra* n. 23 at p.89; *see also* York Trademark (1984) RPC 231.

²⁹ Document prepared by the Secretariat, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *World Intellectual Property Organization*, Sixteenth Session, Geneva, November 13 to 17, 2006, page. 5.

same commercial origin, as a guarantee of similar quality. The producer remains free to vary the quality of the goods or services bearing a particular trademark. However, he or she will suffer the consequences of any decline. Although not offering any legal guarantee of quality, trademarks, therefore, are able to fulfil a quality function in economic terms.³⁰

On the other hand, a trademark's reputation may go beyond the qualities and characteristics of the goods or services to which it is applied. Besides indicating origin and denoting quality, a trademark may be associated in the minds of consumers with a specific style of life. Like a guarantee of quality, a trademark may become, for instance, an emblem of prestige. The "mark image" will most often result from substantial investment in the promotion and advertising of the products or services on which the trademark is used (investment function).³¹

The rationale of preserving the distinctiveness of marks used in trade safeguards the exclusive link between a trademark and the producer using it on goods or services. To the extent to which investment in product quality and promotion leads to a particular reputation of the trademark, this exclusive link also ensures that the producer will reap financial rewards accruing from that investment. Moreover, consumers will be protected against confusion as to the commercial origin of goods and services, and the quality and reputation associated with a trademark. In sum, trademarks are protected because they individualize the goods or services of a given enterprise and distinguish them from the goods or services of competitors (origin and distinction function), symbolize qualities associated with goods or services (quality function) and are used as reference point for investments in the promotion of a product or service (investment function)³².

³⁰ *Ibid.*

³¹ *Ibid.*

³² *Ibid.*

3 Trademarks: International Dimension

Trademarks, like all other intellectual property rights, are national rights. This means that a trademark, once registered, only offers protection against unauthorized use by third parties within the country of registration. Unlike copyright, there is no automatic extension of a national trademark to other countries. There are, however, a number of international conventions and arrangements that give some international recognition to national trademarks. These are the Paris Convention, and the TRIPS agreements. There is also a Community Trademarks System that creates a trademark that gives rights throughout the European Community³³, which will be discussed in the next chapter of this thesis.

3.1 Paris Convention

The Paris Convention was established in 1883 to create some interaction and recognition between various countries of each other's national intellectual property rights. For all intellectual property rights of a registerable nature, this was achieved by the concept of priority. The priority recognises the first filing date for a particular intellectual property rights in any Convention country as the filing date for all other filings in any Convention country in respect of the same intellectual property by the same proprietor made during the priority period. The period of priority differs from intellectual property right to intellectual property right, but in the case of trademarks the period is six months. This has given a level of international protection for trademarks, because the first to file a trademark application is, in most countries, the person with the better claim to a trademark.³⁴

This is not the case in the United Kingdom, because rights in passing off can be built up through sufficient use of a trademark without registration and

³³ Tina Hart, *see supra* n. 18 at p. 150.

³⁴ *Ibid.*, at pp. 150-1.

those rights can act as an obstacle to any subsequent application to register the trademark by a third party.³⁵

Another provision relevant to trademarks is Article 6bis, which give international protection to ‘well-known’ trademarks. A person can own a ‘well-known’ mark in registered or unregistered form even in countries where the action of passing off does not exist. Ownership of a well known mark will prevent a third party from applying to register the same or a very similar mark in any other Convention country that has implemented Article 6bis into its national laws and allows cancellation of an existing registration for such an identical or similar mark during the first five years after registration on the application of the owner of the well-known mark to the relevant authority.³⁶

This international recognition of national trademarks is of limited application because it only applies to trademarks that have become ‘well-known’ in other Convention countries. The Paris Convention gives no definition of the phrase ‘well-known’ and therefore countries of the Paris Union have devised their own guidelines from case law. The World Intellectual Property Organisation (WIPO) has commented that this is unsatisfactory for a provision having international effect.³⁷

3.2 TRIPS Agreement

Article 15(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as the “TRIPS Agreement”) contains a now widely accepted definition of trademark, namely “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings.”³⁸

This definition reflects the origin function as well as the distinction function of trademarks.

³⁵ *Ibid.*

³⁶ See Paris Convention, article 6bis.

³⁷ Available online at <<http://www.wipo.int>>.

³⁸ 15(1) TRIPs.

3.2.1 Criteria for Trademark Protection

The requirements that a sign must fulfil in order to serve as a trademark are reasonably standard throughout the world. The first requirement relates to the core function of trademarks, namely to denote the commercial source of goods or services and thereby distinguish them from the goods or services of competitors. It follows that a trademark must be distinctive. As stipulated in Article 15(1) of the TRIPS Agreement, it must be “capable of distinguishing the goods or services of one undertaking from those of other undertakings.” Lack of distinctiveness may particularly result from the fact that a given sign is generic in the sense that it defines a category or type to which the goods or services belong (e.g. use of the term “chair” for chairs, or “drinks” for alcoholic beverages). A further reason for lacking distinctiveness may be the descriptive character of the sign concerned.³⁹

3.2.2 Overview of Subject Matter of Trademark Protection

It follows from the preceding discussion that a wide variety of signs may be considered eligible for trademark protection. Virtually any sign that is capable of distinguishing goods or services of undertakings in the marketplace may serve as a trademark, provided that further conditions are fulfilled, such as compliance with standards of morality or public order.

Practically all national trademark laws provide for the protection of visually perceptible signs⁴⁰, in particular the following types:

- words, including personal names;
- letters, numerals;
- figurative elements and devices;
- combinations of colours;
- pictorial devices, such as logotypes, paintings, figures, drawings;
- combinations of the above.⁴¹

³⁹See *supra* n. 29.

⁴⁰ See “Summary of Replies to the Questionnaire on Trademark Law and Practice,” Available at <http://www.wipo.int>.

⁴¹*Ibid.*

Under many national trademark systems, three-dimensional signs relating, for instance, to product packaging or product shape, also enjoy protection as trademarks. New types of trademarks, such as colour marks, multimedia marks, sound marks and olfactory marks, may evolve in the market on the basis of new marketing and advertising strategies and changing consumer perceptions.⁴²

3.2.3 The Scope of Trademark Protection

Article 16 of the *TRIPS Agreement* defines the scope of protection, to allow the holder to oppose the use without its consent in the course of trade of an identical or similar sign on identical or similar goods or services, where such use would result in a likelihood of confusion. The use of an identical sign on identical goods or services raises a presumption of likelihood of confusion.

The definition of the scope of trademark protection in Article 16 allows Members a considerable degree of flexibility regarding the level of protection that will be provided. For example, the basic requirement is that a “similar” sign may not be used on “similar” goods. This might be construed strictly, such that signs and goods must be nearly identical to justify protection, or this might be construed liberally, such that signs and goods need only be within a category or class to justify protection. In fact, different legal systems, and different courts within the same legal system, may differ on the way these concepts are applied. There are other flexibilities built into Article 16. Furthermore, Article 16 of the *TRIPS Agreement* supplements Paris Convention rules on “well known” marks, essentially limiting the class of persons to whom a trademark or service mark must be well known in order to qualify for protection.⁴³

⁴² *Ibid.*

⁴³ Report on United Nations Conference on Trade and Development, “Dispute Settlement under WTO,” New York and Geneva, 2003, page 15.

3.3 Joint Recommendation on Trademarks

In 1999, general assemblies of the World Intellectual Property Organization ('WIPO') and the Paris Convention⁴⁴ jointly recommended better protection for well-known trademarks ('Joint Recommendation').⁴⁵ The Paris Convention (in article 6bis had since 1925 forbidden the registration of copies or imitations of well-known marks where confusion was liable to result.⁴⁶ TRIPs pushed protection of well-known marks closer to U.S law, which itself goes well beyond the requirements of the Paris Convention. Well known marks for services, not just goods, must now be protected. A mark's notoriety is to be judged by reference to "the relevant sector of the public" (not necessarily everyone), and notoriety may come from advertising the mark, not just using it. More importantly, TRIPs extended the reach of well-known registered brands to catch use on dissimilar goods or services if the use would indicate a connection between the mark and the registered owner, and the owner's "interests" were "likely to be damaged".⁴⁷ The *Joint Recommendation on Trademarks* extended and elaborated the dilution concept. Among other things, it removed the distinction between registered and unregistered well-known marks. Moreover, *the Joint Recommendation* conceded that the TRIPs article 16.3 might be read restrictively to cover only cases of likely confusion, so it added two provisions, drawn from an amalgam of US and EU law, which explicitly protected well-known marks from dilution. The mark owner could take action where:

⁴⁴ 20 March 1883, last revised at Stockholm, 14 July 1967, 828 U.N.T.S. 305 [*Paris Convention*]

⁴⁵ *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the WIPO (September 20 to 29, 1999) WIPO Doc. No. A/34/13, online: WIPO http://www.wipo.int/documents/en/document/govbody/wo_gb_ab/doc/a34_13.doc [*Joint Recommendation*].

⁴⁶ David Vaver, "Unconventional and Well-Known Trademarks," *Singapore Journal of Legal Studies*, July 2005, p. 13.

⁴⁷ *TRIPs*, arts. 16.2 and 16.3.

- (ii) the use of that mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;
- (iii) the use of that mark would take unfair advantage of the distinctive character of the well-known mark.⁴⁸

3.4 Trademarks and Territoriality

Trademark law is territorial in part because the initial IP conventions of the late nineteenth century, the Paris Convention and the Berne Convention for the Protection of Literary and Artistic Property, were based on the principle of national treatment.⁴⁹ A signatory state was obliged to offer protection to nationals of other signatory states that matched the protection afforded its own nationals. It has to be taken into account that law is contextual, and geography is a central part of context. Trademark rights have been defined territorially. Trademark rights that have been defined territorially flowed logically from the intrinsic purpose of trademark law. Whether viewed as an instrument to safeguard producer goodwill or to protect consumers against confusion, the purpose of trademark law was served by recognizing rights in the local producer. The area in which a mark was used was the vital determinant of the geographic reach of rights, as indeed one might expect in a use-based trademark system.

Territoriality reflects efforts to protect goodwill to the extent of its geographic reach. On the other hand, global markets and digital communication have encouraged a need for more effective international enforcement of rights and the motivation of cross border trade.⁵⁰ The Paris Convention imposed very few obligations regarding the substantive content of national laws. The national treatment principle ensured that nationals of Paris Union countries were able to seek national rights in foreign countries on equal terms with national applicants.⁵¹ Regardless of the development and growth of the international trademark system, both with respect to

⁴⁸ See *Joint Recommendation*, art. 4(1)(b).

⁴⁹ *Berne Convention for the Protection of Literary and Artistic Works*, 24 July 1971, 1161 U.N.T.S. 31; also see *supra* n. 44.

⁵⁰ Georgios I. Zekos, "Trademarks and Cyberspace," Riga Graduate School of Law, *the Journal of World Intellectual Property* (2006) Vol. 9. No. 5, p. 506.

⁵¹ *Ibid.*

substantive harmonization and procedural matters, the crucial proposition that trademark laws are national remains principally intact as a theoretical matter. Trademark rights are classically acquired through national mechanisms but territoriality requires a producer to obtain separate rights for each territory (country) in which it desires protection.⁵²

⁵²*Ibid.*

4 Trademarks: EU Dimension

Trademark is the first area of intellectual property law which falls to be examined since it is in this area that ‘Europeanization’ by the Community may be said to be most complete, and which therefore may be said to provide the model which Europeanization of other areas of intellectual property law will be likely to follow.⁵³ In fact, Trademarks Law within the EU has just been the beneficiary of a massive programme of reform and innovation under the stimulation of the single market initiative. Prior to this, protection depended on the varied system of the national protection of Member States under the international umbrella of the Madrid Agreement, which is neither a Community initiative nor gives rise to any unified Community system of trademark protection. As a result there were ten systems for trademark protection within the Community with the rights conferred by registration varying from country to country which produced uncertainty, confusion, and unnecessary expense as well as having the potential to act as a potential restriction on the free movement of goods and services.⁵⁴ Due to this defective legal regime, a massive restructuring was needed. Eventually, the working party was established in 1964 to consider the problems of trademark protection with the Community. The first text of proposals was published in 1973 followed by a memorandum from the Commission in 1976. There followed some seventeen meetings of experts and interested parties to discuss the proposals, which led to a modified proposal in 1980. It was this proposal which the Commission submitted to the Council of Ministers after consultation with the European Parliament. The proposal was twin-pronged in its attack, consisting of a Directive to harmonise national laws, and a Regulation to create a European Community wide trademark.⁵⁵

⁵³ Terence Prime, see supra n. 23 at p.75.

⁵⁴ *Ibid.*, at p. 77.

⁵⁵ *Ibid.*, at p.78.

4.1 Legal Framework and Basic Features

At the end of the 1980s, the European Community (EC), acting also under the stimulus of the jurisprudence of the Court of Justice, adopted the Directive harmonising national legislation concerning trademark issues to eliminate the normative differences between national systems, which were preventing the internal market from working properly. However, this approximation of various national legislation was unable, alone, to remove the obstacles presented by the territorial nature of those rights that laws of Member States conferred on trademarks. To allow businesses to conduct their economic activity without further limitations within the whole area of the Common Market, it was necessary to institute a Community-based system of trademarks.⁵⁶

If the Community Trademark sets up a system for the registration of a trademark on a European Community wide basis which fully integrates into the Protocol, it was also desirable that the national systems should integrate both with the Community Mark and with one another. One of the fundamental ways in which such an integration can be accomplished in a transnational regional community is to ensure that as far as possible the various systems, both national and Community, are as similar to one another as possible. In the two-pronged approach to trademark reform adopted by the Community, it was the Directive which was the prong around which the harmonization of the domestic national laws of the Member States is to be accomplished. However, the drafting of the Directive and the Regulation were accomplished in parallel, and the provisions detail closely so that, for instance, what is registerable trademark under one is likely to be a registerable trademark under the other.⁵⁷

The Community Trademark was instituted through Regulation (EC) No. 40/94. However, the rules of said CTM did not find concrete application until 1 April 1996, when the Office for Harmonization in the Internal

⁵⁶ Steano Sandri, and Sergio Rizzo, *Non-conventional Trademarks and Community Law* (Marques, 2003), p. 1.

⁵⁷ Terence Prime, *see supra* note 23 at p.85.

Market (OHIM) (Marks, Drawings and Designs), which is in charge of managing the new Community title of intellectual property and is located in Alicante, Spain, began functioning. The Community Trademark is acquired solely through registration at the OHIM, and produces the same effects throughout the Community's territory (i.e. is a unitary feature). The two instruments share the same long-term objective, according to the "two-track system" that was subsequently included in the Community Design Law. However, in spite of the fact that the laws in the Directive and the CTMR are, in material law, identical, the two instruments differ as to nature and application modes, which, in turn affect the solutions of various interpretational problems. Concerning this issue, the most significant differential datum of the CTMR emerges from Recital No. 1 where it said that the new intellectual property title has been called for and created to meet the needs of firms. Recital No. 1 reads in part, "... whereas in order to create a market of this kind and make it increasingly a single market, not only must barriers to free movement of goods and services be removed and arrangements be instituted which ensure that competition is not distorted, but, in addition, legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community."⁵⁸

The Community Trademark cannot substitute for the national trademark. It is, actually, tailored to suit the needs of businesses that are interested in the European market or at least have a propensity to operate within the European Union. Therefore, in the choice and use of marks, one may easily imagine the short-term implications of commercial strategies of transnational character, which had been sought and which are protected by the Community legislation.⁵⁹

The specific function of the Regulation is to provide for a single trademark covering all Member States as a single territory coexisting with a harmonized system of national laws. Whereas the harmonisation process was undertaken by means of a Directive, the provision of a CTM is by means of a Regulation. The legal basis of the Regulation is Art. 235 of the

⁵⁸*Ibid.*, at page 2; *See* also Art. 10(6).

⁵⁹ *Ibid.*

Treaty of Rome. A Regulation is directly applicable, while a Directive requires implementation by national legislatures, an entirely appropriate mechanism for harmonisation where *national laws* have to be altered in detail to meet the harmonising requirements of the Directive. By contrast the Regulation has automatic legal force without the need for intervening national legislation, as is well suited to be the basis of a largely autonomous Community creation.⁶⁰

The Directive prescribes a two-stage process for securing registration of a trademark. First, it is necessary to establish whether or not the mark is registerable (Art. 3), and, second, to establish whether it conflicts with third party rights (Art. 4). This establishes a two-stage process to registration. The first requires enquiry as to the registerability of a mark, the second into conflicting prior rights if any.⁶¹

Under the Directive a trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods, or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.⁶²

The absolute grounds for refusal are:

- a) signs which cannot constitute a trademark;
- b) trademarks which are devoid of any distinctive character;
- c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods;
- d) trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bonafide and established practices of the trade;
- e) signs which consist exclusively of:

⁶⁰ Terence Prime, *see supra* note 23 at pp.109-10.

⁶¹ *Ibid.*, at page 87.

⁶² *Trademark Directive*, Art. 1.

- the shape of goods which is necessary to obtain a technical result, or
 - the shape which gives substantial value to the goods;
- f) trademarks which are contrary to public policy or to accepted principles of morality; trademarks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service.⁶³

It is important to note that no type of sign is automatically excluded from registration as a Community Trademark. Art. 4 lists the types of signs used most frequently by undertakings to identify their goods or services, but is not an exhaustive list. It is designed to simplify the adoption of administrative practices and court judgments to business requirements, and to encourage undertakings to apply for Community Trademark. Depending on the circumstances, therefore, the Trademarks Office, the national courts, or in the last resort, the Court of Justice will be responsible for determining whether, for example, solid colours or shades of colours, and signs denoting sound, smell or taste may constitute Community trade-marks.⁶⁴

However, one important possible limitation on sounds, smells and taste is the requirement that the mark must be capable of being represented graphically. This does not mean that the mark itself has to be graphic, but it must be capable of graphic representation. It should be remembered that the protection of trademarks, the subject of the harmonisation effort, is based on a registration system. The requirement of graphic form appropriate for publication also enables existing mark owners to keep an eye on new applications to spot any potential conflicts with their existing rights against which they can take opposition proceedings. The requirement may well give rise to some problems. Three dimensional objects can be the subject of a two dimensional graphic representation, and indeed commonly are in both patent and design law, and should give rise to no problem. Music can be represented by its notation. However, other sounds or smells give rise to much greater problems.

⁶³ *Ibid*, Art. 3.

⁶⁴ Terence Prime, *see supra* note 23 at p.88.

The Directive is quite clear that the distinctiveness of a mark may be either inherent or arise through accumulated public perception. In addition, the Directive provides grounds for refusal of registration for declarations of invalidity of a mark, but some of the grounds are mandatory, and others are optional only. Thus, individual Member States may choose to have differing grounds for refusal or invalidity, although all of them will have as a central core those which are mandatory. The mandatory grounds are numerous and have no obvious principle underpinning them except public policy and the demands of a coherent registration system. They may be listed as follows:⁶⁵

4.1.1 Mandatory Grounds of Exclusion

i) **Signs which cannot constitute a trademark:** Some signs cannot constitute trademarks under the terms of the Directive, such as signs which cannot be graphically represented, or signs which are not capable of distinguishing the goods of the applicant from those of competitors. Such signs should be refused registration, and, if registered, should be declared invalid.⁶⁶

ii) **Trademarks which are devoid of any distinctive character:**⁶⁷ A trademark which is inherently non-distinctive, may acquire distinctiveness through use subsequently. If this is done prior to the application for registration, registration must be effected and maintained. Further, any Member State may, in addition, provide that this saving proviso shall also apply where the distinctive character was acquired after the date of the application or even after the date of registration.⁶⁸ Actually, the Directive is quite clear that the distinctiveness of a mark may be either inherent or arise through accumulated public perception.

iii) **Descriptive trademarks:** These are trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or

⁶⁵ *Ibid.*, at page 90.

⁶⁶ Art. 3(1)(a).

⁶⁷ Art. 3(1)(b).

⁶⁸ Art. 3(3).

the time of production of the goods or of rendering of the service, or their characteristics of the goods or service.⁶⁹

iv) Generic trade terms: These are trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bonafide and established practices of the trade.⁷⁰ Often the generic trade term concerned will have become the name of a type of product within the trade such as *linoleum*, *shredded wheat*, or *gramophone*, but it can equally apply to other terms such as generic trade colours or picture marks.

v) Signs consisting exclusively of certain shapes: The shapes concerned are (1) shapes which result from the nature of the goods themselves (such as the shape of a football) (2) the shape of goods which is necessary to obtain a technical result such as the shape of an electric plug or a cricket bat and (3) the shape which gives substantial value to the goods such as fashion items of interior home decoration which are usually chosen for their eye appeal. This provision is based on Benelux trademark and is aimed at preventing those goods, the shape of which is dictated by the function they fulfil, from obtaining a monopoly of a shape and thereby prevent other traders from copying the shape to compete effectively.⁷¹

vi) Public policy and accepted principles of morality: Trademarks which are contrary to public policy or to accepted principles of morality may not be registered, or if registered, are liable to be declared invalid.⁷² One particularly useful function for the public policy exclusion in the modern world has been suggested in preventing the use of a mark containing the name or representation of a person without their consent.⁷³ The use of public policy exclusion to deal with contemporary problems is entirely logical because public policy inevitably changes with the evolution of society itself.

⁶⁹ Art. 3(1)(c).

⁷⁰ Art. 3(1) (d).

⁷¹ Terence Prime, *see supra* note 23 at p.91.

⁷² Art. 3(1) (f).

⁷³ Ruth Annand and Helen Norman, *Blackstone's Guide to the Trademarks Act 1994* (Blackstone Press Ltd., 1994).

vii) Deceptive trademarks: Trademarks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origins of the goods or services are excluded from registration.⁷⁴

viii) Trademarks to be refused pursuant to the Paris Convention: The Directive recognises the obligations of Member States under the Paris Convention by providing for the exclusion of trademarks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Art. 6 of the Convention.⁷⁵

ix) Anti-dilution: The final ground for refusal of registration arises where a trademark is identical with, or similar to, an earlier Community trademark which has a reputation within the Community, and where later trademark is to be, or has been registered for goods or services which are not similar to those which the earlier mark is registered, provided that the use of the later trademark without due cause would take unfair advantage of, or be detrimental to the distinctive character or repute of the earlier mark.⁷⁶ Of course, if the later mark were to be used for similar goods and services there would be no need to rely on this anti-dilution provision.

4.1.2 Non-Mandatory Grounds for Exclusion⁷⁷

The grounds which Member States can choose to adopt for exclusion are five in number.

- i) Prohibition by provisions of law other than trademark law. A Member State may provide that a trademark shall not be registered, or, if registered, shall be liable to be declared invalid where, and to the extent that, the use of that trademark may be prohibited pursuant to provisions of law other than trademark law of the Member State concerned or of the Community.⁷⁸

⁷⁴ Art. 3(1) (g).

⁷⁵ Terence Prime, *see supra* note 23 at p.93.

⁷⁶ Art. 4(3).

⁷⁷ Terence Prime, *see supra* note 23 at p.96.

⁷⁸ Art. 3(2) (a).

- ii) Signs of high symbolic value: A Member State may provide that a trademark shall not be registered, or if registered, shall be liable to be declared invalid where and to the extent that the use of the trademark covers a symbol of highly symbolic value, in particular a religious symbol.⁷⁹
- iii) Badges emblems and escutcheons: A Member States may provide that a trademark may not be registered, or if registered, shall be liable to be declared invalid where, and to the extent, that it covers badges, emblems and escutcheons (other than those covered by Art. 6 of the Paris Convention) and which are of public interest, unless the consent of the appropriate authorities to its registration has been given in conformity with the legislation of the Member States.⁸⁰
- iv) Applications made in bad faith: A Member State may provide that a trademark shall not be registered, of if registered, shall be liable to be declared invalid, where and to the extent that the application for registration of the trademark was made in bad faith by the applicant.⁸¹ An obvious example of bad faith would be if registration had been sought despite that fact that the applicant was well aware that he was not entitled to the mark. While the Directive has a clear aim that trademarks should be used,⁸² it has no requirement that at the time they are registered there should be a declared intention to use, although Member States are entitled to adopt such a condition for registration if they choose.⁸³
- v) Earlier Rights: As well as the mandatory requirements in respect of earlier rights Member States have the right to create exclusions for trademarks where, and to the extent, that they conflict with other earlier rights in certain situations. First, the

⁷⁹ Art. 3(2) (b).

⁸⁰ Art. 3(2)(c).

⁸¹ Art. 3(2)(d).

⁸² Recital 8.

⁸³ *Ibid.*

Member State may create an anti-dilution provision similar to the one previously discussed where the existing reputation of the earlier mark is in the Member State concerned. Second, a trademark may be excluded to the extent that rights in marks, which have not been registered, but are used in course of trade and were acquired prior to the date of application for registration of the subsequent mark (or its date of priority where applicable), and the right arising from the earlier unregistered right allows the proprietor to prohibit the use of the subsequent mark. Third, Member States are allowed to recognize earlier rights arising under provisions of their own law. The Directive gives particular illustrations as a right to a name, a right of personal portrayal, a copyright, and an industrial property right. Fourth, the mark may be excluded by the Member State where it is identical with, or similar to, an earlier collective trademark expiring up to three years preceding the application, or the mark is identical with, or similar to, an earlier guarantee or certification mark expiring with a period to be fixed by the Member State of the application. Fifth, a Member State may exclude a trademark identical with or similar to an earlier trademark registered for identical or similar goods or services, which has expired due to a failure to renew up to two years before the application in respect of the later mark, unless the proprietor of the earlier mark either gave his agreement to the registration of the later mark or does not use the mark. Finally, a Member State may exclude trademarks liable to be confused with a mark in use abroad on the filing date and still in use there, provided that at the date of the application the applicant was acting in bad faith.⁸⁴

4.1.3 Use and Non-use of Trademarks

The Directive is built around the principle that trademarks should be used. Use was to be in connection with the goods or services in respect of which it

⁸⁴ Terence Prime, see supra note 23 at p.98; see also Arts. 4(4)(a)(b)(c)(d)(e)(f)(g).

is registered.⁸⁵ The use of the mark does not have to be in the identical form in which it is registered for use is recognized in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered.⁸⁶ The affixing of the trademark to goods or to their packaging in a Member State solely for export purposes also constitutes use.⁸⁷ Further, the use of the trademark with the consent of the proprietor or by any person who has authority to use a collective mark or guarantee or certification mark shall be deemed to constitute use by the proprietor.⁸⁸

If, within a period of 5 years following the completion of the registration procedure the proprietor has not put the trademark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if the use has been suspended during an interrupted period of five years unless there are proper reasons for non-use.⁸⁹

4.2 Trademarks and Territoriality

Trademark rights are territorial and effective only in the country or territory where they are registered causing no problems and if an undertaking requires protection in other territories, it can apply to register the trademark elsewhere. The Community trademark applies to the whole of the European Community but the rights afforded by registration apply only within the Community.⁹⁰

Infringement involves use of a sign within a territory where the trademark in question is registered and signs identical to or similar to the registered trademark cannot be used. The rationale for trademarks is that they function as badges of origin in that they designate the source of goods or services to the consumer and trademark rights preclude others taking advantage of the

⁸⁵ Art. 10(1),

⁸⁶ Art. 10(2) (a).

⁸⁷ Art. 10(2)(b).

⁸⁸ Art. 10(3).

⁸⁹ Terence Prime, *see supra note 23* at p.104; *see also* Art. 10(6).

⁹⁰ *See supra* n. 50 at p. 506.

reputation associated with a trademark and diverting trade away from the trademark owner's selling.⁹¹

According to article 6 of the EU Directive, the scope of the right is limited so as to preserve its essential function of a trademark, being to act as a guarantee of origin.⁹²

Trademark laws, the group of legal norms that determine the availability and scope of trademark rights, are mainly territorial; indeed, they are generally national promulgated predominantly by national law-making institutions, whether courts or legislatures.⁹³

4.3 Scope of Trademark Protection: Extended Discourse

4.3.1 Protection of Non-conventional Trademarks

The trademarks can be classified into two main categories: conventional trademarks, and non-conventional trademarks. Among the new forms of non-conventional trademarks, the most important ones are colours. In fact, marketers have long realised that colour is a powerful and effective tool for creating brand identification.⁹⁴ Leaving aside the use of a colour as part of a more complex design, a company may want to use a colour as a mark for a variety of reasons. The first is the need to pursue new means of communication in an economy submerged by a sea of advertising, which actually results in a dulling of a consumer's capacity to react effectively. The predominance of the media and competition restrictions do the rest. This phenomenon provides the basis for the advent of the "new mark".⁹⁵

⁹¹Case T-79/00, *Rewe-Zental v OHIM (LITE)* [2002] ECR II-705, para. 26 and Case T-128/01 *Daimler-Chrysler Corp. v OHIM*, 6 March 2003, para. 31. Article 5(1) and (2) of the First Council Directive 89/104/EEC.

⁹² See supra n.50.

⁹³ *Person's Co. v Christman* 900 F.2d 1565, 1569-9 (Fed. Cir. 1990): "The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme".

⁹⁴ Steano Sandri, see supra n. 56 at p. 70.

⁹⁵ *Ibid.*, at p. 73.

Again among various genres of non-conventional trademarks, colour is undoubtedly the one that recently has been the focus of most of the attention of entrepreneurs, and consequentially, of legislators and courts. Unlike olfactory marks, in the case of colour signs, there are no great problems from the viewpoint of graphical representation. Instead, more problems arise concerning their distinctive capacity.⁹⁶

About the protection of non-conventional trademarks, a question arises: Can a colour, a smell, or a sound qualify as a “mark” according to CTMR regulations? The answer of this question can be found in Article 4⁹⁷, which states: “A Community Trademark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”⁹⁸

In *Siekmann case*⁹⁹, the thesis, according to which a smell cannot be registered as a trademark because of its subjective appreciation, was raised by some States on the occasion of the discussion which led to the ECJ decision of 12 December 2002.

It is important to note, however, that AG Philippe Leger, in the *Case ORANJE*¹⁰⁰ before the ECJ, has again proposed the argument of the liability of perception to deny the protectability of colour marks. However, the Court has rejected the argument that colour trademarks cannot *per se* be eligible for registration. In this regard, it must be noted that the ECJ emphasised for the first time, even within the limits of this non-conventional trademark, the nature of the trademark as a sign. Colour, to be capable of constituting a trademark, “must be a sign”. Specifically, the Court stated, “... In that regard it must be pointed out that a colour *per se* cannot be presumed to constitute

⁹⁶ *Ibid*, at p. 74.

⁹⁷ CTMR.

⁹⁸ Steano Sandri, *see supra n. 56* at p. 3.

⁹⁹ C-273/00.

¹⁰⁰ *Libertel Group BV v. Benelux-Merkenbureau* Case C-104/01, [2002] E.C.R. II-3843 E.C.J. (E.C.J.).

a sign. Normally a colour is a simple property of things. Yet it may constitute a sign.”¹⁰¹

The European (and indeed global) business community did indeed respond to the opportunities of the new legislation. In addition to filing applications for existing distinguishing features, many innovative trademarks were developed and applications filed, both at national registries and for the new CTM. Examples of United Kingdom applications are “The Sound of A Dog Barking”; a musical stave showing a jingle; “The Strong Smell of Bitter Beer”; and the gesture of tapping the side of one’s nose.

However, a review of recent trademark decisions of the European Community Courts shows that disputes are continuing, between competing brand owners and between brand owners and national registries, as to what is in fact now capable of registration as a trademark. Areas being considered include smells, sounds, shapes, and surnames, involving questions as to meaning of the terms “graphic representation” and “devoid of distinctive character”.

Although, as noted above, comparatively few applications for smells, sounds and shapes are filed, it is important for these questions to be clarified. As consumers and the commercial world become increasingly sophisticated and aware of brands, a key business strategy is innovative brand development – a simple word in stylised script may be considered to no longer suffice. These cases suggest, however, that before unusual new brands are developed; it should be ensured that they will in fact be capable of receiving trademark protection. In respect of surnames, there are concerns as to the unjustified reservation to one trader of a name which others may be properly entitled to use – see, for example, perpetual complaints by McDonalds about cafes owned by Mrs McDonald (usually met by public outcry).¹⁰²

¹⁰¹ Steano Sandri, *see supra n. 56* at pp. 8-9.

¹⁰² Abbe E.L. Brown, “Illuminating European Trademarks”, *Script-ed*, Vol. 1, Issue 1 (March 2004).

4.3.2 Recent Cases on Non-Conventional Trademarks

The European Court of Justice (ECJ) addressed non-traditional trademark registration and established procedures that tackle many of the concerns raised by non-traditional trademarks in the United States,¹⁰³ and the European Union's strict graphic representation requirement for non-traditional trademark registrations provides legal certainty and accessibility.¹⁰⁴

Two initiatives combine to create European Union trademark law—the First Council Directive and the Community Trademark Regulation. The Directive defines what may be registered as a trademark, the grounds for refusing or invalidating a trademark, and the rights conferred by a trademark. In the European Union, any mark, including a sound, scent or color mark, is registrable, as long as it is capable of graphic representation and distinguishes the goods or services of one undertaking from the goods or services of another.¹⁰⁵ Graphic representation is not purely a technical requirement for registration in the European Union but it embodies the “principle of precision”.¹⁰⁶ Graphic representation ensures that the scope and nature of the mark are plainly defined and comprehensible so that searchers checking the registry can readily ascertain what is registered. The ECJ¹⁰⁷ requires graphic representation by “means of images, lines or characters, so that [the mark] can be precisely identified”. European Union trademark law acknowledges that while consumers often recognize traditional marks such as words and logos as readily indicating source, this may not be the case with colors, sounds and scents.¹⁰⁸

¹⁰³ Case C-447/02 P, *KWS Saat AG v OHIM* 2004 WL 59751 (21 October 2004); Case C-283/01, *Shield Mark BV v Joost Kist* H.O.D.N. 2004 E.T.M.R. 33; Case C-273/00, *Sieckmann v Deutsches Patent- und Markenamt* 2003 E.T.M.R. 37.

¹⁰⁴ See *supra* n.50.

¹⁰⁵ *Shield Mark BV* at 34–41.

¹⁰⁶ Case C-49/02, *Heidelberger Bauchemie GmbH* 2004 E.T.M.R. 99, at 13.

¹⁰⁷ *Sieckmann*, at para 46: “[Graphic representation] ensure[s] that infringement rights can be determined and third parties can understand, from the graphical representation, the nature of the mark”].

¹⁰⁸ *Libertel*, at 40–1. The ECJ noted: [W]hilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used,

It is worthwhile to note that the rulings on registrability are important because, once on the register, trademarks get broad protection against confusion and dilution—typically wider protection that is extended to unregistered marks at common law.¹⁰⁹ In the EU, all marks—whether traditional word or design marks, or some other differently perceptible feature—are in theory examined for registrability according to the same criteria. Consumers may nevertheless view features such as scent, sound, colour and shape differently from standard marks, and this perception is key when the capacity of these features to act as a trademark is assessed.¹¹⁰

4.3.2.1 Smell /Scent as Trademark

Most would agree that smells are distinctive: but can they be represented graphically? Would we all agree exactly how rotten eggs smell, much less how to prepare a trademark application for the smell? In addition, smells are highly subjective – the smell of freshly brewed coffee is appealing to many, but may invoke an extreme negative reaction in some. When it is considered that registering a smell means that that smell or in some circumstances a similar smell cannot be used by others in respect of the same or similar goods or services, the need for clarity in defining the scope of protection is evident. From this perspective, does the “Strong Smell of Beer” referred to above indeed suffice?

In the light of this, the decision of the ECJ in *Sieckmann*¹¹¹ is revealing. An application was filed in Germany for a “balsamically fruity scent with a hint of Cinnamon” for various services. In addition to providing this verbal description, *Sieckmann* also provided the chemical formula which created the smell and a sample of the smell. The dispute as to whether these, or any

because of their appeal, in order to advertise and market goods or services, without any specific message. . . [However], [t]he possibility that a colour per se may in some circumstances serve as a badge of origin of the goods or services of an undertaking cannot be ruled out. It must therefore be accepted that colours per se may be capable of distinguishing the goods or services of one undertaking from those of other undertakings....

¹⁰⁹ Compare William Cornish, *Intellectual Property: Omnipresent, Distracting, Irrelevant?* (Oxford: Oxford University Press, 2004) at 96: “caution before grant [of registration] is needed because of the wide consequences after grant”.

¹¹⁰ *Procter & Gamble v. Office for Harmonization in the Internal Market (OHIM)* (29 April 2005), joined cases C-468/01 P to C-472/01 P (E.C.J.) at para. 36 [Procter].

¹¹¹ C-273/00 [2002] E.C.R. I-II737.

of them, constituted “graphic representation” was ultimately referred to the ECJ. The ECJ held that the sample and description were inadequate as they were not sufficiently precise; the formula was not sufficient as few would actually know, from reading the formula, what it meant; and the combination was also unsatisfactory.

The ECJ did hold that smells could be registered as trademarks, even though the smell was not in itself capable of being perceived visually, provided it could be represented graphically. This could be by means of images, lines or characters, and should be clear, precise, self-contained, easily accessible, intelligible, durable and objective. In the light of the introductory comments above, it is apparent that it will be difficult to apply this test to smells, particularly with the need for the representation to be “intelligible”, as this may remove more scientific or technically based means of description.¹¹² It remains to be seen how many further applications will be made for smells.

Later on, the European trademark registries decided to reject a scent as trademark.¹¹³ The main legal sticking points were the mark’s lack of distinctiveness and its non-compliance with the requirement that any registrable sign had to be “capable of being represented graphically”. So a raspberry scent applied to motor fuel was found not to create a trademark for the scent: consumers would just think the smell was added to mask the (for some) otherwise unappealing scent of the product.¹¹⁴

The current E.C.J. jurisprudence shows that she is willing to accept the registration of non-visual marks if they could be represented graphically “particularly by means of images, lines or characters” in a way that was “clear, precise, self-contained, easily accessible intelligible, durable and objective.” Whether any form of description of a scent mark can satisfy these criteria in the EU is therefore doubtful.¹¹⁵

Having said that, this may not be a significant problem. As mentioned above, a key aim of trademark protection is to be able to enforce the trademark against competitors and protect consumers from confusion as to

¹¹² See *supra* n. 56.

¹¹³ *Sieckmann*, the Advocate General’s Opinion (6 Nov 2001), see *supra* n. 111.

¹¹⁴ *Myles Ltd.’s Community Trademark Application* R 711/1999-3, [2003] E.T.M.R. 56 (OHIM Board of Appeal).

¹¹⁵ David Vaver, see *supra* n. 46 at p. 7.

the source of the products. Given the subjective and ephemeral nature of smells, query whether it is likely that many trademarks for smells would actually be the subject of infringement proceedings.

4.3.2.2 Sound as Trademark

Sound marks are registrable in the EU, but under quite restrictive conditions. The seven-fold requirement of graphic representation as interpreted by the E.C.J. for scent marks—a “clear, precise, self-contained, easily accessible, intelligible, durable and objective” representation—applies across the board to all marks. It therefore constrains both what sound marks may be registered and how, if registrable, they may be described.¹¹⁶

The leading case is *Shield Mark BV v. Kist* (‘Shield’) in 2003.¹¹⁷ The facts of this case are that a Dutch firm held a set of registered sound marks comprising the opening bars of Beethoven’s “*Fur Elise*” and another set of a cock crowing, all for a wide range of services, including (appropriately enough) providing education on intellectual property issues (including no doubt the registrability of sound marks). The registrant sued a communications consultant who used those marks to advertise seminars on intellectual property, including trademark law. The Dutch courts upheld an unfair competition complaint but dismissed trademark infringement claims on the basis that sound marks were not registrable.

The case was referred to the E.C.J. on the trademarks point. The court ruled that sound marks were registrable but must comply with the requirement of graphic representation already mentioned. The marks were registered in a variety of forms except, oddly enough, by reference to any sound recording or sonogram; so the E.C.J. did not rule on two of the more obvious methods of representing a sound mark. As regards “*Fur Elise*”, it ruled that representing the sound as notes in ordinary lettering –E, D#, E, D#, E, B, D, C, A—was inadequate: the lack of any indication of pitch and duration left the mark fatally undefined. The court however accepted the validity of a description of the mark by means of sheet music in bar and stave notation with tempo, accidental, and rest marks: this form, it said, satisfied the

¹¹⁶ *Ibid*, at p. 8.

¹¹⁷ *Shield*, see *supra* n. 103.

requirement of graphic representation.¹¹⁸ The other marks in issue in the case—the crow of a rooster—were all found to be unregistrable in the forms presented. Simply saying “cock crowing” is no description because roosters crow differently.¹¹⁹

4.3.2.3 Shape as Trademark

The functional and ornamental features—elements that are integral to a product or that make it attractive—should not usually be accepted as trademarks.¹²⁰ A large miscellany of product shapes and feature has sought to establish itself in the EU as a three-dimensional trademark: cakes, candy, watches, forklift trucks, flashlights, soap, detergent capsules, bottled shapes and other packaging.¹²¹ Again, although in theory such features are not subjected to stricter criteria for registration than traditional marks are, in practice registration is tougher. The shoals on which shapes and designs have typically foundered in the EU are a lack of distinctiveness and a statutory prohibition on the registration of certain shapes.¹²² Even if a shape is found distinctive, it must pass two further threshold: it must not designate the kind, quality or intended purpose of the product or service and it cannot consist exclusively of “the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods.”¹²³

The leading case involved Remington’s imitation of the three-headed rotary design of the Philips electric shaver, an expired design registration that had since been re-registered this time as a trademark. The E.C.J. confirmed that product shapes, though not usually inherently distinctive, can become distinctive through use. In practice, however, proof that consumers recognize a shape as a trademark signifying single source is difficult to

¹¹⁸ *Ibid.*

¹¹⁹ *Ibid.*

¹²⁰ David Vaver, *see supra* n. 46 p. 12.

¹²¹ *See generally* Jeremy Phillips, *Trademarks Law: A Practical Anatomy* (Oxford: Oxford University Press, 2003) at 142-155.

¹²² *Procter, supra* note 110.

¹²³ *Trademark Directive, supra* n. 62, art. 3.1(c) & (e).

achieve. But if the feature is designed to achieve a technical result, it is unregistrable even if other shapes could also achieve the same result.¹²⁴

Generally, manufacturers often use packaging to distinguish their goods from those of competitors. Packaging is particularly important in respect of beverages, as the product itself cannot be sold alone. Accordingly, in *Nestle Waters France v OHIM*¹²⁵ the CFI decided an issue of great importance to the entire beverage industry. This case involved an application for a CTM for a particular three dimensional shape of bottle in relation to non-alcoholic beverages.

The key issue before the CFI was whether the shape of the bottle was devoid of distinctive character – as such, it could not distinguish the goods from those of any other manufacturer and was therefore incapable of registration. There was also consideration of whether bottles for beverages could have the necessary distinctive character.

OHIM, who had refused to grant the application, argued that the bottle was not distinctive, being made up of common elements and also being, as a whole, a common shape. Nestle argued that the bobbin like upper part of the bottle was distinctive, as were the decorative elements cut into the bottle, which sought to represent “the upper part of a woman’s body draped in a light veil”.

There was also debate about whether distinctiveness should be considered in relation to beverages (in respect of which the trademark was sought, and which have no inherent shape) or in relation to bottles (on the basis that there may be similar bottles on the market and as such this design was not distinctive). The CFI held that distinctiveness was to be assessed in respect of the goods or services for which registration was sought – here, non-alcoholic beverages. However, as these goods could not be sold on their own, it was appropriate to consider the distinctiveness of the bottle as a container for beverages. The CFI held that as the drinks market was competitive, if the shape held the consumer’s attention, they were quite

¹²⁴ *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd.* [2003] Ch. 159 (E.C.J.), aff’d [1999] EWCA Civ 1340 (C.A.).

¹²⁵ Case T-305/02. Decision 3 December 2003.

capable of perceiving the shape of the packaging as indicative of commercial origin. Thus, bottles for beverages could, in principle, have the necessary distinctive character to be registerable. In terms of the bottle in question, distinctiveness was to be assessed on the basis of the perception which the general public (as purchasers of non-alcoholic beverages) had of this bottle, taking into account the presumed expectation of a reasonably well informed, observant and circumspect consumer. Would they perceive it as being indicative of the origin of the beverage, taking into account the overall impression produced by the bottle¹²⁶ (even if, according to OHIM, some elements of it were common place)? Here, the CFI was satisfied that there was concrete evidence that the bottle was more than the sum of its parts,¹²⁷ was not commonplace and distinguished the beverages inside from those of other manufacturers. Thus, this shape was registerable.

The CFI stressed that the conventional registration criteria¹²⁸ were to be applied, and that a more stringent test should not be applied to three dimensional marks. This was consistent with previous case law,¹²⁹ and rejected OHIM's argument that to be registerable the bottle should be unusual and of arbitrary configuration.

This is a helpful judgment for the beverage industry and also for all those involved in packaging. There will be some elements of packaging which will likely be commonplace. This does not mean that the whole cannot be distinctive. This is also consistent with the approach in relation to more traditional trademarks – phrases and logos may contain common features, but it is a question of whether the whole is distinctive. However, the position of OHIM in the shape cases suggests that further disputes may be likely in relation to the registerability of shapes. As this reluctance does not seem to be mirrored by national trademark offices, this may be an area for future uncertainty.

¹²⁶ Test in Case C-251/95 *SABEL* [1997] ECR I-6191.

¹²⁷ Test in Case T-86/01 *Bosch v OHIM* (Kit Pro and Kit Super Pro) [2002] ECR II-4881.

¹²⁸ Capable of graphic representation and not devoid of distinctive character.

¹²⁹ T-88/00 *Mag Instruments* (Torch Shape) [2002] ECR II-467.

4.3.2.4 Surnames as Trademarks

Finally, in *Nichols plc v Registrar of Trademarks*, the ECJ Advocate-General considered the requirements for registration of surnames, on a reference from the English High Court¹³⁰.

An application had been made to register “Nichols”. The UK Registry had refused the application, applying its long standing practice of not registering surnames if they are common (in the sense of appearing 200 times or more in the local telephone directory) and the market of the applicant (for example plumbing) is large, with many competitors. If the market is small, then the UK Registry considered that it was more likely that the average consumer would perceive even a common surname to be capable of distinguishing goods and services of one plumber from those of others.

Jacob J. noted, with approval, that this was because there was a risk of monopoly in names, which may be misleading. As a result, the UK Registry assumed that common surnames were devoid of distinctive character,¹³¹ unless this was shown to have been acquired. Jacob J asked the ECJ if a trademark consisting of a single name could be refused registration as being devoid of distinctive character and, if so, the appropriate principles to be applied in determining this. Jacob J. also asked about the relevance of the provision in the Directive that it will not be infringement of a trademark to use one’s own name in accordance with honest practices in industrial and commercial matters.¹³² In our example of a plumber, this would mean that the existence of a trademark registration for “Smith” in relation to plumbing services, would not enable the trademark owner to stop a plumber named Smith trading as “Smith’s Plumbers”, unless the trademark owner had a substantial presence in the area, and “Smith’s Plumbers” was conducting itself in a way as to suggest a connection with the business of the trademark owner. Does this restriction on infringement mean that a registration for the surname should be granted; on the basis that it would not in fact give rise to the feared power and attacks on those with the same name? This question

¹³⁰ Case C-404/02, Opinion 15 January 2004.

¹³¹ And as such incapable of registration, Directive article 3(1)(b).

¹³² Directive, article 6(1)(a).

was posed on the basis of indications by the ECJ in “*Baby Dry*”,¹³³ that this restriction on enforcement of the trademark should be assessed together with the basic registration requirements in considering whether the application should be accepted.

As was seen in relation to shapes, the Advocate General considered that the basic test for registration of a surname was the same as for any other potential trademark. In particular, he noted that whereas there are some specific exclusions from registration in the Directive, these do not include surnames. He disapproved of the “arbitrary threshold” UK approach, which he considered had no basis in law.

Accordingly, the Advocate General proposed that the ECJ hold that the key question is whether the consumer would consider that the surname identifies the goods or services of one business rather than others; the fact that it is a frequently occurring name is relevant, but not decisive.

It is submitted that this is a sensible decision, which will enable relevant factors in the market in question to be taken into account, without creating an unjustified blanket exception to the registration requirements.

4.3.2.5 Colour as Trademark

Although the aspect of registerability of trademarks falls under the administrative control of trademark protection, it does not, however, seem impertinent to make a mention of registerability of colour marks in the EU in this part of thesis. The reason for special mention of registration of trademarks is aimed at making a comparative study of different regimes in the second last chapter of this paper.

The registration of colours as trademarks (which is not the same as saying coloured trademarks, although some significant overlapping does take place,) is in theory possible in the CTM system.¹³⁴

However, the difficulty of colours is that colour is popularly thought of as an inherent property of matter (although technically, it is the brain’s reaction

¹³³ This was in accordance with the pragmatic view expressed by Jacob J, when he stated that he felt that such a use of article 6 would simply involve more disputes, time and expense (although such a situation did seem to be contemplated by “*Baby Dry*”).

¹³⁴ A Report, “Non-Traditional Trademarks in Europe—Shape and Colour Trademarks—Common Issues with Obtaining, Exporting and Enforcing Rights,” *2004-2005 Europe Legislation Analysis Subcommittee*, March 2005.

to light reflecting off matter). Added colour is often used simply for functional purposes (a red traffic light) or to decorate products or make them more attractive. Colours are therefore not inherently trademark material, but can become so by use.¹³⁵

The more common the colour, the less likely it is that the consuming public will regard it as a trademark, but this factual assumption can be overcome by evidence. The broader the range of goods or services applied for, the greater care is needed before deciding whether to register the mark, lest other traders be stopped from using colour simply as a selling feature of their goods.¹³⁶ This general stance is common to Europe and elsewhere. In one leading case, the colour orange was sought to be registered for a variety of products and services relating to seed preparation and marketing: seed preparation machinery, seed consultancy services, and seeds themselves when sold to the public. The E.C.J. accepted that orange was in principle registerable, but only exceptionally in the absence of use. Registration was confirmed for consultancy services, but not for machinery and seeds: there the market did not treat colour as distinctive of particular producers, and orange was indeed used simply, as a colour for other producers' products.¹³⁷ Of course, if a colour is trademark material, it has to satisfy the graphic representation requirement. Just providing a sample of the mark and describing it as "orange" is not enough.¹³⁸

Combinations of colour usually work better as a mark than do single colours because buyers may more readily recognize combinations as trademarks and allow them to become distinctive. But the description must be more precise than just "blue and yellow for adhesives" even if the shades of blue and yellow are specified and sample attached: "Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know

¹³⁵David Vaver, see *supra* n. 46 at p. 10.

¹³⁶*Ibid.*

¹³⁷*KWS Saat AG v. (OHIM) (Trademarks and Designs)*, Case C-44/02 P (E.C.J., 21 October, 2004).

¹³⁸*Libertel*, see *supra* n.100.

the scope of the protection afforded to the proprietor of the trademark.”¹³⁹

What is true for single colours is equally true for combinations of colour such as two-tone capsules.¹⁴⁰

Trademarks consisting of "combinations of colours" should be registerable within certain parameters. Single colour's protection (i.e., a colour *per se*) is still the subject of heated debate but the European Court of Justice (E.C.J.) has so far set the applicable standard in the *Libertel*¹⁴¹ case.

According to the *Libertel* decision, the correct way to file colour trademark is to indicate their Pantone code: "A colour *per se*, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1) (b) and Article 3 ... provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, equally accessible, intelligible, durable and objective.

The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognized identification code. This indicates that the scope of protection granted by single colour marks is extremely limited and should be construed quite narrowly.

In light of the *Libertel* case and principles, and in particular considering that "the fact that registration as a trademark of a colour *per se* is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of the particular case, to assessing both the distinctive character of the colour in respect of which registration is sought, and whether registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought", there is a strict interdependence between colours and goods, but not much attention has been paid to it.

The ECJ also paid special attention to the inherent distinctiveness of the colour sign. The ECJ considers that colours possess little inherent capacity

¹³⁹ *Re Heidelberger Bauchemie GmbH* (24 June 2005), Case C-49/02 (E.C.J.) at para. 35.

¹⁴⁰ David Vaver, *see supra* n. 46 p. 11.

¹⁴¹ Case C104-01 of May 6, 2003.

for communicating specific information, in particular as to the origin of a product or service (grounds 39-40). Nonetheless the ECJ rules that a colour *per se* may be found to possess distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of the Directive, provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service for which registration is sought (ground 69). This means that a colour sign must have acquired distinctive character before it can be registered.¹⁴²

The ECJ furthermore acknowledges a public interest in not unduly restricting the availability of colours for competing companies who offer for sale goods or services of the same type as those in respect of which registration is sought.¹⁴³ According to the *Libertel case*, the graphic representation of a colour mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Merely reproducing the colour in question on paper does not satisfy these requirements, whereas using an internationally recognized colour code does. Colour signs have little inherent distinctive character and must therefore have acquired distinctive character before they can be registered.

Libertel has been further confirmed by the *Heidelberger case*¹⁴⁴, where the ECJ confirmed its reticence regarding the registration of signs consisting of combinations of colours. It ruled that the applicant will have to prove that it has been established that, in the context in which the colours or combinations of colours are used. Those colours or combinations of colours in fact represent a sign, and that the application for registration should include a systematic arrangement associating the colours concerned in a predetermined and uniform way.

In conclusion, under current ECJ case law, colour *per se* registrations, which might have been granted without a showing of acquired distinctiveness, are strongly suspect and most likely invalid.

¹⁴² *Shield*, see *supra* n. 103.

¹⁴³ *Libertel*, grounds 55 and 60.

¹⁴⁴ ECJ 24 June 2004, C-49/02.

4.3.2.6 3-D Marks

The registerability of (Shape) 3D marks under art. 3(1)(e) of the Harmonization Directive is subject to the evidence that the sign does not consist exclusively of a shape imposed by the very nature of the goods, of a shape of goods, which is necessary to obtain a technical result or of a shape which gives substantial value to the goods.¹⁴⁵

The standard has been set by the ECJ in *Philips v. Remington*¹⁴⁶ wherein the ECJ ruled that Article 3(1)(e) pursues an aim which is in the public interest, namely that a shape whose essential characteristics perform a technical function and were chosen to fulfil that function may be freely used by all. This provision prevents such signs and indications from being monopolized by one undertaking alone because they have been registered as trademarks.¹⁴⁷

The ECJ furthermore held that Article 3(1)(e), second indent, of the Directive must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable pursuant to that Article, if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes that allow the same technical result to be obtained.¹⁴⁸

In a recent case regarding a bottle containing liquid detergent for wool, the ECJ ruled that three-dimensional (3D) marks, consisting of the packaging of a product, which for reasons related to the nature of the goods (no intrinsic shape) are put on the market in a packaged form, the packaging of the goods is to be considered equivalent to the shape of the goods in the meaning of Article 3(1)(e).¹⁴⁹ The exception of Article 3(1)(e) has an absolute character. It applies even if a 3D sign has (acquired) distinctive character. If a 3D sign passes the test of Article 3(1)(e), its distinctive character still

¹⁴⁵ See *supra* n. 134.

¹⁴⁶ Case C-299/99, *Philips v. Remington* of 18 June 2002.

¹⁴⁷ *Ibid.*, ground 82.

¹⁴⁸ *Ibid.*, at ground 84.

¹⁴⁹ ECJ 12 February 2004, C-218/01, *Henkel.*, see ground 37 of the case.

needs to be proven before it can be registered (Article 3(1)(b)). The same goes for the other absolute grounds for refusal of Article 3(1)(c) and (d).¹⁵⁰

The criteria for assessing the distinctive character of 3D trademarks are no different from those to be applied to other categories of trademarks (Philips, ground 48 and Linde, ground 49). However, in practice it appears to be more difficult to prove distinctiveness due to the fact that 3D trademarks are less capable of distinguishing goods or services than word or figurative trademarks (Linde, ground 48). In *Henkel* (ground 52) the ECJ adds that only a trademark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character. As it did in *Libertel*, the ECJ stresses the public interest that all 3D shape of product trademarks, which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of Article 3 (1)(c), should be freely available to all.¹⁵¹

In short, if one of the absolute grounds of refusal of 3D marks applies, the sign is unregistrable, even if it has (acquired) distinctive character. These absolute grounds of refusal cannot be overcome by establishing that with other shapes the same technical result can be obtained.¹⁵²

In conclusion, the ECJ has been willing to accept the registration of non-visual marks if they could be represented graphically “particularly by means of images, lines, or characters” in a way that was “clear, precise, self-contained, easily accessible, intelligible, durable and objective.”

¹⁵⁰ ECJ 8 April 2003, C-53/01 to C-55/01, *Linde*, ground 45.

¹⁵¹ *Ibid.*, ground 77.

¹⁵² *Ibid.*

5 Trademarks Laws in the US

5.1 Early American Trademark Jurisprudence

Like its English predecessor, American trademark law was predominantly a product of judicial decisions. Prior to the first Federal Trademark Act in 1870, statutory protection, to the extent it existed, was at the state level and highly trade-specific.¹⁵³ In the beginning, American courts were singularly focused on the harm to a producer from improper diversion of their trade, and they worked with existing forms of action to remedy that harm. While deciding trademark cases, they had the same focus and thereby they repeatedly made clear that the purpose of trademark law was to protect a party from illegitimate attempts to divert its trade.¹⁵⁴

In *Coats v. Holbrook*,¹⁵⁵ for example, the court said that “a person is not allowed to imitate the product of another and ‘thereby attract to himself the patronage that without such deceptive use of such names would have ensured to the benefit of that other person.’”¹⁵⁶ Likewise, in *Partridge v. Mench*,¹⁵⁷ the court proceed[ed] upon the ground that the complainant ha[d] a valuable interest in the good will of his trade or business, and that having appropriated to himself a particular label, or sign, or trademark, ... he [was] entitled to protection against any other person who attempt[ed] to pirate upon the goodwill of the complainant’s friends or customers, or of the patrons of his trade or business, by sailing under his flag without his authority or consent.¹⁵⁸

Francis Upton recognized this foundational principle when he wrote at the beginning of his 1860 Treatise that the whole purpose of adopting a

¹⁵³McKenna, *see supra* n. 12 at p. 25.

¹⁵⁴*Ibid.*

¹⁵⁵ 2 Sand. Ch. 586, 7 N.Y. Ch. Ann. 713 (C.C.N.Y. 1845).

¹⁵⁶*Ibid.*

¹⁵⁷ 5 N.Y. Leg. Obs. 94, 2 Barb. Ch. 101, 5 N.Y. Ch. Ann. 572, 47 Am. Dec. 281 (C.C.N.Y. 1847).

¹⁵⁸ 2 Barb. Ch. at 103.

trademark was to “enable [the merchant] to secure such profits as result from a reputation for superior skill, industry or enterprise.”¹⁵⁹

In *Delaware & Hudson Canal Co. v. Clark*,¹⁶⁰ Justice Strong stated the premises of trademark law with certainty:

[I]n all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and thus it is only when this false representation is directly or indirectly made that the party who appeals to the court of equity can have relief. This is the doctrine of all the authorities.¹⁶¹

The goal of traditional American trademark law then was clear – it sought to protect a producer’s interest against illegitimate trade diversion. Moreover, as further elaborated below, American courts concluded very early on that this protection in many cases was based on a property right, following essentially the approach of English courts of equity. Thus, even in English law and equity decisions did reflect a deeper disagreement about the basis of trademark protection; decisions of American courts reveal no similar disagreement.¹⁶²

From the early history of trademark protection in the U.S, we also come to know that the development of trademark protection in the beginning of 19th century was rather slow. The reason was that the trademarks were not in common use in those days. Nor did they receive much attention from Congress or state legislatures. It was with the speedy growth of trade and industrial activities that they attained popularity. Gradually, the manufacturers sensed the need for trade identity and thereby started using trademarks quite often. Hence, came in the need of protection of trademarks from any sort of infringement. This led to the enactment of the first federal

¹⁵⁹ See Francis H. Upton, *A Treatise on the Law of Trademarks With a Digest and Review of the English and American Authorities* 11-12 (1860), p. 2.

¹⁶⁰ 80 U.S. 311 (1871).

¹⁶¹ *Ibid.* at 322-23.

¹⁶² McKenna, *see supra* n. 12 at p. 27.

trademark law, the act of July 8, 1870 which was called “an Act to revise, consolidate, and amend the Statutes relating to Patents and Copyrights”.¹⁶³

The Supreme Court declared the law *ultra vires* soon after it was phased in. The grounds of declaring it unconstitutional were, inter alia, that it was based improperly on the patent and copyright clause of the Constitution¹⁶⁴. After several revisions, with active support and advice by the International Trademark Association (INTA), the Lanham Act was finally adopted in 1946 under the auspices of Fritz Lanham, congressman of Texas¹⁶⁵.

5.2 Lanham Act

The Lanham Trademark Act of 1946, found at 15 U.S.C. Sections 1051 *et seq.* is the federal statute governing trademark rights. It was extensively amended, effective November 1989, and has been amended since then, often to create comity with non-U.S. trademark laws in the context of trade negotiations.¹⁶⁶ In particular, the Act defines the scope of a trademark, and lays down the process by which a federal registration can be obtained from the Patent and Trademark Office for a trademark, and penalties for trademark infringement.

5.2.1 Trademarks under Lanham Act

Lanham Act defines a trademark as “any word, name, symbol, or device or any combinations thereof-(1) used by a person, or (2) which a person has a bonafide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by

¹⁶³ Available at the Homepage of the IP Mall, Pierce Law Centre, http://www.ipmall.info/hosted_resources/lipa/patents/Patent_Act_of_1870.pdf, last visited on 16-06-07.

¹⁶⁴ U.S.C. Art. I, Section 8, Clause 3.

¹⁶⁵ Homepage of INTA, <http://www.inta.org/about/lanham.html>, 16-06-07.

¹⁶⁶ Anne Hiarig, Lynn S. Fruchter, *Understanding Basic Trademark Law* (San Francisco: Practising Law Institute, 2004), p. 10.

others and to indicate the source of the goods, even if that source is unknown.”¹⁶⁷

This provision quite succinctly requires that a mark being proposed to serve as a trademark must be distinctive. Here, distinctiveness of a mark is aimed at the identification of the source of a particular good.

While determining the question of distinctiveness of a trademark, the court looks into whether the relationship between the mark and the underlying product falls into the following categories:

(1) generic, (2) descriptive, (3) suggestive, (4) arbitrary and (5) fanciful¹⁶⁸

(1) A generic mark is a mark that describes the general category to which the underlying product belongs. For example, the term ICE PAK for reusable ice substitute for use in food and beverage coolers was held generic.¹⁶⁹ Moreover, generic marks are not entitled to protection under trademark law.¹⁷⁰ Thus, a manufacturer selling "Ice Pak" brand ice (or "Orange" brand oranges, etc.) would have no exclusive right to use that term with respect to that product.

Trademark law does not protect generic terms because they comprise goods or services of several manufacturers and therefore lack the required distinctiveness. Under some circumstances, even terms that are not originally generic can become generic over time and thus become unprotected.¹⁷¹ This happens if a mark has developed in a way that the relevant public associates the term with any product of a kind. Then the trademark owner is a victim of his own success and loses trademark protection because the mark is no longer distinctive.¹⁷²

(2) A descriptive mark describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services.¹⁷³

Merely descriptive marks are not inherently distinctive and therefore may

¹⁶⁷ § 45 *Lanham Act*, 15 U.S.C. § 1127.

¹⁶⁸ See also *Two Pesos Inc. vs. Taco Cabana Inc.*, 505 US 763 et seq., 768.

¹⁶⁹ See *In re Stanbel Inc.*, 16 USPQ2d 1469 (TTAB 1990).

¹⁷⁰ See § 14 (3) *Lanham Act* (15 U.S.C. § 1064 (3)) and § 15 (4) *Lanham Act* (15 U.S.C. § 1065 (4)).

¹⁷¹ *Ibid.*

¹⁷² See for example: "Aspirin" (*Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921)) or "Cellophane"

(*DuPont Cellophane Co., Inc. v. Waxed Products Co., Inc.*, 85 F.2d 75 (2d Cir.1936)).

¹⁷³ *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

not be registered on the principal register.¹⁷⁴ For example in the case *Viking Umwelttechnik GmbH*¹⁷⁵ the colour green for garden equipment was held to be merely descriptive. Also the colour green for peppermint chewing gum¹⁷⁶ or the colour orange for orange juice is merely descriptive.

An exception is made, however, if the mark has acquired “secondary meaning”.¹⁷⁷ A descriptive mark acquires secondary meaning when the consumer primarily associates that mark with a particular source.¹⁷⁸ Thus, for example, the term "Holiday Inn" has acquired secondary meaning because the consuming public associates that term with a particular provider of hotel services, and not with hotel services in general.

Proof of substantially exclusive and continuous use of a mark for five years can be considered prima facie evidence that the mark has become distinctive.¹⁷⁹ For example in the case *Qualitex vs. Jacobson*¹⁸⁰ the Supreme court held that the green-gold colour of dry cleaning press pads had acquired secondary meaning because it has been sold in that special shade for more than thirty years.

(3) A suggestive mark is a mark that evokes or suggests a characteristic of the underlying good but does not specifically describe it.¹⁸¹ For example, Coppertone as a mark for sun tan oil may suggest the colour of a deep tan. It does, however, not mean sun cream. Suggestive marks are inherently distinctive and therefore subject to protection.¹⁸² Nevertheless, the difference between descriptive marks and suggestive marks is often not easy to define. For this reason, suggestive marks are hard to defend.

(4) Arbitrary or fanciful marks have no relation to the particular product. For example the word “Mars” bears no inherent relationship to the underlying product (candy). Arbitrary or fanciful marks are capable of

¹⁷⁴ § 2 (e)(1) *Lanham Act* (15 U.S.C. § 1052 (e)(1)).

¹⁷⁵ *Viking Umwelttechnik GmbH vs. OHIM*, 25.09.2002, T-316/00.

¹⁷⁶ *Wrigley Company vs. OHIM, LIGHT GREEN*, R 122/98-3.

¹⁷⁷ § 2 (f) *Lanham Act* (15 U.S.C. § 1052 (f)).

¹⁷⁸ *Boston Beer Co. Ltd. Partnership v. Slesar Bros., Brewing Co., Inc.*, 9 F.3d 175, 181 (1st Cir. 1993).

¹⁷⁹ *See supra n. 144.*

¹⁸⁰ *Qualitex Co. v. Jacobson Products Co.*, 514 US 159 (1995).

¹⁸¹ Kristen Sowade, *Markenschutz in den U.S.A.*, p. 80.

¹⁸² Caldarola, “Protection of a colour under the law of the US, Germany and Japan,” <http://www.law.washington.edu/casrip/newsletter/Vol6/newsv6i2Caldarola.html>, 18-06-07.

identifying a product and therefore inherently distinctive. They are given a high degree of protection.

Furthermore, in the US, the owner must establish that its trademark is valid and, consequently, deserving of the exclusive right to protection.¹⁸³

Trademark law permits a high level of protection for arbitrary¹⁸⁴ trademarks (a common word or phrase that is used in an uncommon way) and descriptive trademarks that have acquired secondary meaning with a relatively lower level of protection.¹⁸⁵

Arbitrary and fanciful trademarks receive the highest level of trademark protection because these words themselves do not possess any relation to the accompanying goods or services to which the words are affixed.¹⁸⁶ Fanciful, arbitrary and suggestive marks are inherently distinctive, and as a result receive the greatest protection against infringement. The level of trademark protection for a suggestive trademark is less than that for an arbitrary or fanciful trademark because a suggestive trademark requires the customer to use imagination, thought and perception to arrive at or connect the mark to a characteristic of the good or service.¹⁸⁷ Descriptive words such as “Vision Center” and “Fish-Fri” are only entitled to protection if they have acquired secondary meaning in the mind of the consumer,¹⁸⁸ conveying information

¹⁸³ *America Online, Inc. v AT & T Corp.* 243 F.3d 812, 819 (4th Cir. 2001) (stating that a plaintiff in a trademark infringement action must prove “the validity and its ownership of the mark as part of its larger burden in a trademark infringement action”). The work that a trademark owner puts into developing a mark to identify the source of goods will result in goodwill and enhanced reputation. Generally, trademark law protects an intangible property interest, which is the value of the association between an identifiable mark or symbol and its source.

¹⁸⁴ *Champions Golf Club, Inc. v The Champions Golf Club, Inc.* 78 F.3d 1111, 1117 (6th Cir. 1996) (stating that “[a]n arbitrary mark has a significance recognized in everyday life, but the thing it normally signifies is unrelated to the product or service to which the mark is attached,” such as CAMEL cigarettes or APPLE computers”).

¹⁸⁵ *Brother Records, Inc. v Jardine* 318 F.3d 900, 905 n. 1 (9th Cir. 2003): “The law conceptually classifies trademarks along a spectrum of increasing distinctiveness: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful”; *Filipino Yellow Pages, Inc. v Asian Journal Publ’ns, Inc.* 198 F.3d 1143, 1147 (9th Cir. 1999) (describing the different categories of distinctiveness recognized under trademark case law). Noting that trademarks are classified along the distinctiveness spectrum with the most distinctive marks, such as arbitrary, fanciful and suggestive, being always protected, and the least distinctive marks, such as generic, being unprotectable.

¹⁸⁶ *Interstellar Starship Servs* 304 F.3d at 943 n. 6 (noting that “Exxon” and “Kodak” are nondictionary words and examples of fanciful trademarks).

¹⁸⁷ *Thane Int’l, Inc. v Trek Bicycle Corp.* 305 F.3d 894, 912 n. 14 (9th Cir. 2002).

¹⁸⁸ *Two Pesos, see supra* n. 168 (stating that the presumption that an inherently distinctive trademark represents the source of a product does not attach to a descriptive word and

concerning a quality or characteristic of the associated products or services to which the trademarks are affixed, and there is a need to demonstrate that because of extensive use of the word in commerce, the consumer has come to associate the word with a source for the products or services. It is worth mentioning that a fair use defense is available to competitors, forbidding the trademark owner to appropriate a descriptive term for exclusive use and to prevent others from describing a characteristic of their goods or services.¹⁸⁹

A trademark that is arbitrary, fanciful, suggestive or descriptive with acquired secondary meaning, even though it is entitled to protection, is not unavoidably a strong mark in the marketplace if it does not achieve broad public recognition.¹⁹⁰

Merely descriptive terms often identify the characteristics of things and can gain trademark protection if they acquire secondary meaning. Generic trademarks (referred to as “common descriptive” terms) deserve no protection because are incapable of functioning as source identifiers in the mind of the consumer.¹⁹¹

Trademarks express source and quality information to consumers through the use of brand names, logos or symbols adorning goods and services. A trademark signifies that goods bearing the mark come from the same source and are of consistent level and quality.¹⁹²

Moreover, the 1946 Lanham Act served to strengthen a producer’s confidence in their national use of a mark and decrease marketing risks.¹⁹³

An applicant has to demonstrate that the mark was used to market goods in

therefore the owner of such a trademark could “obtain relief only if he first showed that his [trademark] did in fact represent not just the product, but a producer”).

¹⁸⁹ *Herman Miller, Inc. v Palazzetti Imps. & Exps., Inc.* 270 F.3d 298, 319 (6th Cir. 2001): “Under the doctrine of “fair use,” the holder of a trademark cannot prevent others from using the word that forms the trademark in its primary or descriptive sense’.

¹⁹⁰ *Homeowners Group, Inc. v Home Mktg Specialists, Inc.* 931 F.2d 1100, 1107 (6th Cir. 1991): “HMS may indeed be arbitrary and hence inherently distinctive, yet have little customer recognition or “strength” in the market, or perhaps have high recognition which is limited to a particular product or market segment’.

¹⁹¹ *Park 'N Fly, Inc. v Dollar Park & Fly, Inc.* 469 U.S. 189, 194 (1985): “A generic term is one that refers to the genus of which the particular product is a species. Generic terms are not registerable . . .”.

¹⁹² Georgios I. Zekos, see *supra* n. 50 at p. 500.

¹⁹³ *Ibid.*

interstate commerce, and was distinctive.¹⁹⁴ The applicant acquires enforceable rights in the mark upon commercial use and a priority conflict between two applicants is decided based on the earlier user of the mark. Under traditional trademark law, relief was granted on the basis of a competitor passing off his or her products as those of another competitor. The Lanham Act recognized the need for providing a uniform system of protection for false advertising and misrepresentation claims and other “wrongful acts that generally fall under the rubric of “unfair competition””, in addition to common law trademark and trade dress infringement.¹⁹⁵ The Lanham Act expanded the common law by granting a right to federal registrants to exclude others in geographical areas where they had not actually used their mark.¹⁹⁶

The mark must be notified by displaying “s” or the phrase “Registered in US Patent and Trademark Office” by the mark because failure to notify the public limits the remedies that are available to the registrant of the mark under the Lanham Act.¹⁹⁷ Trademark registration benefits both the producer and consumer, protecting producer goodwill through safeguarding expansion of a mark. The Lanham Act governs trademark registration and infringement. The Lanham Act permits the senior user of a distinctive mark to impose exclusive rights in that mark against junior users of an identical or confusingly comparable mark.¹⁹⁸ Section 1114(1)(a) provides a basis of action for federal trademark infringement against anyone who uses a mark that is identical or analogous to a mark registered on the principal register, when such unauthorized “use is likely to cause confusion, or to cause mistake, or to deceive”.¹⁹⁹

¹⁹⁴ *20th Century Wear, Inc. v Sanmark-Stardust, Inc.* 747 F.2d 81, 87 (2d Cir. 1984).

¹⁹⁵ Explaining that the common law rule “limits the action for unfair competition to cases of passing off, that is where the junior user is competing with the senior user and has imitated the mark in order to trade on the senior user’s goodwill” (Long, 1993).

¹⁹⁶ *Burger King of Florida, Inc. v Hoots* 403 F.2d 904, 908 (7th Cir. 1968);

¹⁹⁷ *Polo Fashions, Inc. v Extra Special Products, Inc.* 208 U.S.P.Q. 421, 427 (2nd Cir. 1980)

¹⁹⁸ 15 U.S.C. §§ 1114(2), 1117.

¹⁹⁹ *Wal-Mart Stores, Inc. v Samara Bros.* 529 U.S. 205, 209 (2000) (stating that a mark holder may sue infringers under 15 U.S.C. § 1114 once the mark is registered under 15 U.S.C. § 1052).

In other words, unauthorized use in commerce of the unregistered yet distinctive mark first used by another is actionable under § 1125(a)(1)(A) if such conduct “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person. . .”. Therefore, to prove trademark infringement under § 1114(1) or § 1125(a)(1)(A), the plaintiff has to ascertain that it owns a “valid and legally protectable mark”—a distinctive mark—and the defendant’s use of an identical or alike mark is likely to cause consumer confusion. As mentioned earlier, trademarks help consumers to identify the creator of an object while creating a connection between the quality of the product and the creator’s name. The “strength of the mark”, relatedness or “proximity of the goods”, “similarity of the marks”, “evidence of actual confusion”, “marketing channels used”, “the degree of care likely to be exercised by the purchaser”, “defendant’s intent in selecting the mark” and “likelihood of expansion of the product lines” are relevant factors examined by the court’s analysis of whether a likelihood of confusion exists due to the defendant’s conduct.²⁰⁰ It has to be taken into account that trademark law allows a defendant to use another’s trademarked term to illustrate its own goods, as long as the defendant uses the “words in their primary descriptive and non-trademark sense”.²⁰¹ The Lanham Act protects distinctive marks from infringement, unfair competition, and it also protects famous marks from dilution caused by unauthorized commercial use of the mark. Dilution is “the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—(1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception”.²⁰² Moreover, under §

²⁰⁰ *A & H Sportswear, Inc. v Victoria’s Secret Stores, Inc.* 237 F.3d 198, 210 (3d Cir. 2000): “To prove either form of Lanham Act violation, a plaintiff must demonstrate that (1) it has a valid and legally protectable mark; (2) it owns the mark; and (3) the defendant’s use of the mark to identify goods or services causes a likelihood of confusion”.

²⁰¹ *Cosmetically Sealed Indus., Inc. v Chesebrough-Pond’s USA Co.* 125 F.3d 28, 30 (2d Cir. 1997)

²⁰² 15 U.S.C. § 1127.

1125(c)(1) of the FTDA, the owner of a famous mark can stop others from using the mark in commerce in a way that “causes dilution of the distinctive quality of the mark”. Some courts hold that descriptive marks are not satisfactorily distinctive and famous to come within the protection of the FTDA but some others allow dilution actions based on rights in descriptive marks that have become distinctive.²⁰³ Additionally, § 1125(d)(1) of the ACPA provides a cause of action against “cyber pirates” or “cyber squatters” who, with “a bad faith intent to profit”, register or use a domain name that “is identical or confusingly similar to” another’s distinctive or famous mark. On the other hand, the mark-holder cannot succeed unless it establishes that its mark was distinctive or famous at the time the defendant registered the domain name.²⁰⁴

The Trademark Law Revision Act 1988 (TLRA) upgraded US treatment of intellectual property by conferring on producers earlier protection of their marks before they had been used and goodwill had been created.²⁰⁵

5.3 How to Receive Protection?

If a person wants to receive protection for his mark, he has two different possibilities which are mentioned as under:

In general, protection can be received by using the mark in commerce.²⁰⁶ It is necessary that the person requesting for protection is the first to use the mark in commerce. “Use in commerce” means that the product actually has to be sold to the public with the mark attached.²⁰⁷ The scope of protection, however, is - in the case of being the first using the mark in commerce - limited to the territorial area where the mark is used.

²⁰³*Times Mirror Magazines, Inc. v Las Vegas Sports News, L.L.C.* 212 F.3d 157, 164–8 (3d Cir. 2000), cert. denied, 531 U.S. 1071 (2001) (holding that the plaintiff’s descriptive mark was entitled to protection against dilution as the mark had acquired distinctiveness through secondary meaning and was famous in its niche market and that the FTDA did not require an additional test of distinctiveness).

²⁰⁴ 15 U.S.C. § 1125(d)(1)(A)(ii)(I)–(II).

²⁰⁵ *Trademark Law Revision Act of 1988*, Pub. L. No. 100-667, 102 Stat. 3935 (1988).

²⁰⁶ Sowade, *see supra note* 181, p. 68.

²⁰⁷ § 45 *Lanham Act* (15 U.S.C. § 1127 (definition no. 14)).

Another possibility to seek protection for the trademark is to file an application with the Patent and Trademark Office (PTO)²⁰⁸ in Arlington, Virginia.

The mark filed for protection can already be in use or be one that will be used in the future (so-called intent-to-use application)²⁰⁹. The applicant does not have to be domiciled in the U.S. but there must be a local representative of the applicant, to whom notices may be sent.²¹⁰ After filing the application the trademark will initially be examined and, if approved, published in the Official Gazette of the trademark office.²¹¹ Within 30 days after the publication, any person who believes his right would be infringed by the pending registration may file an opposition to the PTO.²¹²

If the examiner finds the mark non-registerable or the applicant is for any other reason unsatisfied with the final decision of the examiner, the applicant has the right to take the Appeal to the Trademark Trial and Appeal Board.²¹³

5.3.1 Scope of Protection

Trademark rights in the United States are fundamentally concerned with:

(a) **Deception.** Protection of the public from confusion, mistake or deception as to the origin and/or quality of goods, services or commercial identity arising from the use of a confusingly similar mark or name on the same or similar goods/services.

(b) **Goodwill.** Protection of an owner's investment in goodwill associated with the mark or name. Trademark laws protect the owner's commercial identity against use by a newcomer of a trademark confusingly similar to the owner's established mark. From an economic focus, trademark law protects the value of the trademark owner's reputation and his investment in advertising. Although relief against poachers and outright pirates under principles of trademark law -- relief against counterfeiters -- is well-

²⁰⁸ § 1 *Lanham Act* (15 U.S.C. § 1051 (a)).

²⁰⁹ *Ibid.*, at § 1051 (b)).

²¹⁰ *Ibid.*, at § 1051 (e)).

²¹¹ § 12 *Lanham Act* (15 U.S.C. § 1062 (a)).

²¹² § 13 *Lanham Act* (15 U.S.C. § 1063 (a)).

²¹³ § 20 *Lanham Act* (15 U.S.C. § 1070).

publicized, trademark protection is much more comprehensive. Accordingly, it is essential for the trademark owner to exercise vigilance in trademark usage to avoid challenge by others, as well as to challenge infringing use by others.²¹⁴

In *United Drug Co. v Theodore Rectanus Co.*,²¹⁵ the Court characterized a trademark as “a convenient means for facilitating the protection of one’s goodwill in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold”. Hence, if there is no protection, a third party could steal the goodwill of a mark by copying it and passing off goods under it as if they emanated from the mark’s owner, by this means misleading consumers as to a product’s source, and potentially decreasing the reputation of the mark if the third party’s good suffers from inferior quality.²¹⁶

(c) Distinctiveness as requirement of protection:

Under US trademark jurisprudence, distinctiveness is a requirement to registration on the federal principal register and protection of exclusive trademark rights but the word “distinctive” is not defined anywhere in the Lanham Act.²¹⁷

(d) Use and non-use of trademarks

Trademarks possess the aptitude to communicate meaning to consumers.²¹⁸ Trademark use is a more basic concept than confusion. Under the Lanham Act, a trademark registration cannot be obtained and maintained without a showing of authentic use of the mark in connection with the goods or services set forth in the trademark registration; and the criteria of use for establishing trademark rights and the criteria of use for establishing trademark infringement are the same—use of the mark by the rights holder,

²¹⁴ Leed-Protecting Your Invention Brochure. Available at

<http://www.msu.edu/unit/oip/LEED/protectingyourinvention.htm#Scopeofprotection>

²¹⁵ 248 U.S. 90 (1918); *Coca-Cola Bottling Co. v Coca-Cola Co.* 269 F. 796, 806 (Del. 1920) (describing a trademark as a “visible medium” “by which the good will is identified, bought, and sold, and known to the public”).

²¹⁶ *Mishawaka Rubber & Woolen Mfg Co. v S.S. Kresge Co.* 316 U.S. 203, 205 (1942).

²¹⁷ *Federal Trademark Act*, 15 U.S.C. §§ 1051–127 (2000).

²¹⁸ *Qualitex*, see *supra* n. 180.

or use of the symbol in question, or a similar symbol, by the alleged infringer.²¹⁹

Evidently, in the United States trademark rights arise from use, not registration. Thus, a trademark owner can acquire substantial common law (unregistered) rights in a trademark or service mark in the geographic area of actual use. The pivotal question in evaluating competing trademark claims is one of priority -- who was the first to use the mark in connection with the designated goods/services in the relevant geographic area. Innocent infringement is not a defence -- first in time is generally first in rights. While unregistered trademark rights are protected to a certain extent, the savvy trademark owner can and should enhance and extend trademark protection through registration.²²⁰

5.3.2 Duration of Protection

If the trademark has been registered, the registration generally remains in force for 10 years. Exceptionally, the mark can be cancelled by the Director of the PTO for certain reasons before expiration of this time limit.²²¹ Each registration may be renewed for periods of 10 years at the end of the expiring period. The application for renewal may be filed at any time within 1 year before the end of each successive 10-year period.²²²

5.3.3 Effects of Registration

A trademark registered under the Lanham Act effects nationwide protection unless someone else within a particular geographic area is already using the mark. In that case, the prior user of the mark retains the right to use that mark within that area. The person registering the mark, however, can use the mark everywhere else in the territory of the USA.

In general, after using the mark in commerce for five consecutive years subsequent to the date of registration, the right to use the mark is

²¹⁹ Georgios I. Zekos, see supra n. 50, p. 499.

²²⁰ Available at www.spi.org/bkprime.pdf.

²²¹ § 8 *Lanham Act* (15 U.S.C. § 1058).

²²² § 9 *Lanham Act* (15 U.S.C. § 1059).

incontestable.²²³ Nevertheless, the protection can be lost at anytime by reason of any of the grounds of cancellation stated in § 14 (3), (5) Lanham Act (15 U.S.C. § 1064 (3), (5)) (inter alia generality, functionality, abandonment or fraudulent registration).

A mark becomes generic, if it has developed in a way that the relevant public associates the term with any product of a kind. Then the trademark owner is a victim of his own success and loses trademark protection because the mark is no longer distinctive.²²⁴

A mark is functional, where it is the natural colour of a product or where it affects the cost or quality of a product, it is simply a naturally occurring or desirable characteristic of the product which should not be exclusive to one manufacturer.²²⁵

So, for example, the U.S. Supreme Court decided, that competitors might be free to copy the colour of a medical pill where that colour services to identify the kind of medication.²²⁶

If abandonment occurs, the trademark is “dead” and no longer pending.²²⁷

This can happen under several circumstances. The most common reason is when the USPTO does not receive a response to an Office Action letter²²⁸ from an applicant within 6 months from the date the Office action letter was mailed. Another instance is when the USPTO does not receive a statement of use (or request for an extension of time to file a statement of use) from an applicant within 6 months from the issuance of a notice of allowance²²⁹.

Regarding fraudulent registration, § 38 of the Lanham Act (15 U.S.C. § 1120) provides that “any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a

²²³ §15 *Lanham Act* (15 U.S.C. § 1065).

²²⁴ *See supra n. 172.*

²²⁵ James L. Vana, “Colour Trademarks,” Available at <http://www.utexas.edu/law/journals/tiplj/volumes/vol7iss3/vana.pdf>, p. 389, last visited 18-06-07.

²²⁶ *Inwood Laboratories v. Ives Laboratories*, 456 U.S. 844 (1982).

²²⁷ <http://www.uspto.gov/main/glossary/>, last visited 18-06-07.

²²⁸ This is a letter from a trademark-examining attorney setting forth the legal status of a trademark application.

²²⁹ A written notification from the USPTO that a specific mark has survived the opposition period and has been allowed for registration.

civil action by any person injured thereby for any damages sustained in consequence thereof.” Accordingly, any fraudulent means in order to get a false registration will be prosecuted.

5.3.4 Should a Trademark be Federally Registered?

The registration of a trademark in the United States Patent and Trademark Office is highly desirable but not mandatory. The owner of a trademark may file an application to register its trademark if either (a) the mark has been used on goods or services in interstate commerce, or (b) the owner has a good faith intention to use the mark in interstate commerce with respect to specified goods or services - the latter has become known as an intent-to-use or "ITU" application. Applications to register trademarks are filed with the United States Patent and Trademark Office. Approximately 3 to 6 months after the application is filed, a Trademark Examiner reviews the application to determine whether it is in proper form and whether the mark conflicts with any other prior registered or pending trademark., If the Trademark Examiner raises an objection or issues a refusal to register (usually via a written "Office Action" sent to the applicant's attorney), the owner has six months in which to overcome the objection or rejection by submitting an argument that the Examiner Attorney's view is incorrect, or by amending the application (if possible) to comply with the Examiner Attorney's requirements. If the Trademark Examiner approves the application, it is published in a weekly publication, the Official Gazette, and other parties have thirty days in which to oppose issuance of a registration. If no such opposition is filed, or the differences between the owner and a third party are resolved, the Patent and Trademark Office will issue a certificate of registration.

In the case of ITU applications, the process is similar, but instead of initially receiving a registration, the applicant is given a "Notice of Allowance," providing for a six-month interval within which the mark must be placed into use. If the mark cannot be used in that time period, the applicant is allowed up to five successive six-month extensions of time within which to

use the mark by paying appropriate fees and filing the necessary documents. Thus, for intent-to-use applications, the applicant has a total of three years from the allowance of the application to place the mark into actual use. Once the mark is registered, the registrant's rights in the mark automatically relate back to the date on which the ITU application was filed even though the mark was not actually used until much later.²³⁰

5.3.4.1 Federal Registration

If possible, an owner should register a trademark or service mark in the U.S. Patent and Trademark Office if (a) the owner has used the mark in interstate or foreign commerce, (b) the mark is distinctive, and (c) the mark is not confusingly similar to a mark owned by another when used in association with the goods or services they identify. Federal registration provides significant advantages for protection and enforcement and extends the registrant's common law rights nationwide.

Under the *Trademark Law Revision Act* of 1988, an owner may file an application for federal registration of a mark based on a bona fide "intent to use" the mark in interstate or foreign commerce. If an owner files an application based upon an "intent to use" the mark, the filing date of the application becomes the constructive date of first use for the purpose of establishing priority. The mark will not be registered, however, until the applicant submits proof of actual use to the U.S. Patent and Trademark Office. This procedure allows the applicant to "test the waters" and lay claim to a mark before launching a costly marketing program which may precede actual use.²³¹

5.3.4.2 State Registration

If an owner uses a trademark or service mark only locally, and does not operate in interstate commerce, the owner may file an application to register the mark with the appropriate state agency. State trademark applications must be based upon use -- not an intent to use -- and the registration protects

²³⁰ "The Basics of What is a Copyright/Trademark/Patent and How to Protect them," *Stimmel, Stimmel & Smith-a Professional Law Corporation*. Available at http://www.stimmel-law.com/articles/copy_trademark.html#t7.

²³¹ See *supra* n. 220.

the owner's rights only within the state borders. Since a federal registration extends the owner's rights nationwide, it is not necessary to obtain additional registrations in each state if there is a federal registration. There are some situations, however, where a state registration may be the most appropriate protection available.²³²

5.3.5 Infringement

If someone infringes a registered mark, the holder of that particular mark can sue the infringer.²³³ Trademark infringement is the non-permitted commercial use or intended commercial use of the same or similar mark in connection with goods or services with which such use is "likely to cause confusion".²³⁴

To determine the likelihood of confusion, many factors are relevant:

These factors are, for example, the similarity of the marks as well as the similarity of the underlying goods or services, the similarity of marketing channels, the sophistication of purchasers, the strength of the registered mark, the number and nature of similar marks in use on similar goods or services, and the degree of actual confusion.²³⁵

The defendant in an infringement claim, however, can assert two types of affirmative defence: (1) fair use or (2) parody.²³⁶

Fair use occurs when a descriptive mark is used in good faith and does not relate to its secondary meaning but to its primary meaning so that confusion is not likely. Therefore, for example, a cereal manufacturer can describe its cereal as consisting of "all bran," without infringing Kellogg's rights in the mark "All Bran." That use is just descriptive and does not apply to the secondary meaning of the mark.²³⁷

Also, certain parodies of trademarks can be allowed if they are not too closely bound to commercial use. The reason is that parodies of trademarks

²³² *Ibid.*

²³³ §§ 32, 43 *Lanham Act* (15 U.S.C. §§ 1114, 1125).

²³⁴ § 32 (1) *Lanham Act* (15 U.S.C. § 1114 (1)).

²³⁵ Homepage of INTA, http://www.inta.org/info/basics_infringement.html, 18-06-07.

²³⁶ *Ibid.*

²³⁷ *Ibid.*

serve a valuable critical function and that this critical function is entitled to some degree of protection.²³⁸

Parody is a defence to trademark infringement. It is argued that there is no likelihood of confusion because the parody will not be taken seriously. It simply is a non-commercial humorous take-off on the original.²³⁹

However, the line between likelihood of confusion and parody is rather small. This is the case because it is the nature of a parody to copy a famous original in such a way that the public recognizes it. But, on the other hand, it has to be distorted in such a manner that the public does not believe the parody and the original were connected in any way. Otherwise there is not a valid parody, but an infringement of the original trademark.

5.3.6 Enforcement

Both state and federal courts hear trademark suits, but the federal courts have jurisdiction only if the suit is based on a federally registered mark. Successful plaintiffs will be granted injunctions against further infringement.²⁴⁰ Relief in trademark litigation includes:

- (a) Preliminary injunctive relief to enjoin infringement during litigation.
- (b) Money damages after trial on the merits.
- (c) Permanent injunctive relief, after trial on the merits.
- (d) Destruction of offending products or packaging.
- (e) Increased damages and attorney fees in exceptional cases.

Most trademark cases focus on injunctive relief -- requiring the infringer to stop all use of the infringing mark. Trademark suits generally are not "revenue producing."

The trademark owner may also protect against infringing foreign source goods by recording a federal trademark registration with the United States Customs Service. Customs has the power to exclude clearly infringing items at the port of entry.²⁴¹

²³⁸ *Ibid.*

²³⁹ For example the rock group "aqua" was allowed to use the Barbie trademark for the name and the lyrics of a song on the basis of parody (*Mattel Inc. v. MCA Records*, 296 F.3d. 894 (9th Cir. 2002)).

²⁴⁰ § 34 (a) Lanham Act (15 U.S.C. § 1116 (a)).

²⁴¹ See *supra* n. 220.

5.3.7 Anti-Dilution

In the United States, Federal Trademark Dilution Act 1995 (“FTDA”) modified the 1946 original version of the Lanham Act, which did not afford trademarks protection against dilution.²⁴² In its post-FTDA version, section 43(c)(1) of the Lanham Act provides that “[t]he owner of a famous mark shall be entitled . . . to an injunction against another person’s commercial use in commerce of a mark . . . if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark.”²⁴³

Section 45 of the Lanham Act defines the term “dilution” as “the lessening of the capacity of a famous mark to identify and distinguish goods, regardless of the presence or absence of competition between the owner of the famous mark and other parties, or likelihood of confusion, mistake, or deception.” Among the factors that the law considers relevant to the inquiry into whether a mark is famous or not are “the degree of inherent or acquired distinctiveness of the mark” and “the duration and extent of advertising and publicity of the mark.”²⁴⁴

Section 43(c) of the Lanham Act applies to “famous” marks. But what makes a mark famous? In answering this question, one should bear in mind that the concept of “fame” is a term of art. Accordingly, it derives its scope from the law. Section 43(c) of the Lanham Act provides a list of factors that courts are required to take into account in deciding whether a mark is famous. Interestingly, the provision speaks of factors that determine whether a mark is “distinctive and famous”, which suggests that the fame of a mark is linked to its distinctiveness.²⁴⁵ The distinctiveness of the famous mark is thus the object of protection.

5.4 Trademarks and Territoriality

Trademark rights are enforced on a national basis and so the use of a foreign trademark in connection with goods and services sold only in a foreign

²⁴² Mathias Strasser, “the Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context,” *Fordham Intell. Prop. Media & Ent. L.J.* 2006, p. 406.

²⁴³ Lanham Act, s. 43(c)(1).

²⁴⁴ Mathias Strasser, at p. 407.

²⁴⁵ Strasser, at pp. 408-09; *see also* Lanham Act, s. 43(c)(1).

country by a foreign entity does not constitute “use of the mark” in United States commerce adequate to merit protection under the Lanham Act in the USA. Consequently, territoriality as implemented by national laws giving rise to national rights remained the governing principle, even in a global economy. Although the Lanham Act contains a list of what considerations are relevant to the question of fame, it does not contain any definition of the standard that must be met before a mark is famous for the purposes of dilution protection. The Lanham Act represents a compromise between different conceptions of territoriality balancing the territoriality fundamental to the purpose of trademark law with the politically grounded values of territoriality that pay tribute to national borders.²⁴⁶

5.5 Scope of Trademark Protection: Extended Discourse

5.5.1 Protection of Non-Conventional Trademarks

The protection of non-conventional trademark in the US is fraught with some apprehensions shown by the U.S courts. Nonetheless, in addition to word marks and designs or logos, trademark rights can be created in colour, sounds, scents, packaging design and product design, as long as certain requirements are met.

5.5.1.1 Colour as Trademark

For over a decade, the U.S. Patent and Trademark Office (“PTO”) has accepted applications for registration of marks that consist solely of a colour, following the 1985 decision of the U.S. Court of Appeals for the Federal Circuit in *In re Owens-Corning Fiberglas Corp.* However, other courts of appeal did not agree with the Federal Circuit’s ruling, leading to a split in the circuits that was resolved by a unanimous 1995 decision of the U.S. Supreme Court in *Qualitex Co. v. Jacobson Products Co.*²⁴⁷. That

²⁴⁶ Georgios I. Zekos, *see supra* n. 50, pp. 506-7.

²⁴⁷ 514 U.S. 159, 115 S. Ct. 1300 (1995).

decision firmly established that colour is freely protectable and registerable, as long as certain conditions are met.

First, the colour sought to be protected must not be functional. That is, the colour cannot have a utilitarian purpose and cannot be one that others in the field have a competitive need to use. *Second*, the colour sought to be protected must be distinctive under traditional trademark analysis. That is, it must either be inherently distinctive or it must have acquired distinctiveness or secondary meaning. Acceptable evidence of secondary meaning includes consumer surveys that establish consumer recognition of the colour as a mark, length and exclusivity of use, sales success, advertising expenditures and unsolicited media coverage.²⁴⁸

5.5.1.2 Sound as Trademark

The PTO's Trademark Rules of Practice and the Trademark Trial and Appeal Board have long permitted registration of marks that are not used in written or printed format. Sound marks that are unique, different, or distinctive are registerable without proof of secondary meaning, but sounds that resemble or imitate commonplace sounds require proof of acquired distinctiveness. Among sound marks that have been registered, or preliminarily approved for registration, are the NBC chimes and the Harley Davidson engine sound. By and large, because of the somewhat different nature of sounds used as marks, it is likely that the PTO will generally require proof of acquired distinctiveness before a sound mark will be accepted for registration. In addition to providing proof that the sound has acquired distinctiveness and functions as an indicator of source, applicants for registration must be able to show that their sounds are not functional but rather serve as a mark.²⁴⁹

Sound trademarks are now commonplace in the U.S., where Metro-Goldwyn-Mayer's mark of "a lion roaring" has long been registered for

²⁴⁸ Morgan, Lewis & Bockius, *Intellectual Property Handbook*, 5th ed., (Washington D.C: 2000), p. 58.

²⁴⁹ *Ibid.* at p.59.

movies. Unlike scent marks, their validity has been expressly accepted in the federal courts.²⁵⁰

5.5.1.3 Scent as Trademark

In 1990, the PTO first permitted registration of marks consisting of fragrance. That ground-breaking application was for a mark identified as “a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms,” which was used to identify sewing thread and embroidery yarn. In its decision permitting registration of the fragrance, the Trademark Trial and Appeal Board instructed that registration was not permitted for scents or fragrances of products which were primarily sold for their scent, such as perfumes, colognes or household products; these types of scents would necessarily be functional. Additionally, the PTO has instructed that evidence required to establish the trademark significance of a scent is substantial.²⁵¹ Practice within the U.S. Patent and Trademark Office and professional opinion is however favourable, and the U.S. Supreme Court, in adopting a broad view on the registrability of colour trademarks, supported its holding by referring with apparent approval to the practice of registering scents (as well as shapes and sounds).²⁵²

²⁵⁰ *Oliveira v. Frito-Lay* 251 F.3d 56 (2d Cir. 2001), approving *Re General Electric Broadcasting Co.* 199 U.S.P.Q. 560 (T.T.A.B. 1978).

²⁵¹ Morgan Lewis, *see supra n.* 248.

²⁵² *Qualitex*, Referring to *Re Clarke*, *ibid.*

6 Comparative Analyses

The comparative study of scope of trademark protection in different IP regimes is primarily dependant on what has already been said in the preceding chapters of this thesis. However, it is deemed quite necessary to look into the similarities and dissimilarities of trademarks laws, especially scope of trademark protection, in the U.S., the EU and at International level.

6.1 Scope of Protection

U.S.

- The owner of a trademark must establish that its trademark is valid and, consequently, deserving of the exclusive right to protection. Trademark law permits a high level of protection for arbitrary trademarks and descriptive trademarks that have acquired secondary meaning with a relatively lower level of protection. So, in the U.S., arbitrary and fanciful trademarks receive the highest level of trademark protection because these words themselves do not possess any relation to the accompanying goods or services to which the words are affixed. Fanciful, arbitrary and suggestive marks are inherently distinctive, and as a result receive the greatest protection against infringement. A trademark that is arbitrary, fanciful, suggestive or descriptive with acquired secondary meaning, even though it is entitled to protection, is not unavoidably a strong mark in the marketplace if it does not achieve broad public recognition.
- Merely descriptive terms often identify the characteristics of things and can gain trademark protection if they acquire secondary meaning. Generic trademarks deserve no protection because are incapable of functioning as source identifiers in the mind of the consumer.
- Under US trademark jurisprudence, distinctiveness is a requirement to registration on the federal principal register and protection of

exclusive trademark rights but the word “distinctive” is not defined anywhere in the Lanham Act.

EU

- On the other hand, under the EU Directive, a trademark will be denied protection if it is devoid of any distinctive character. And the Directive is quite clear that the distinctiveness of a mark may be either inherent or arise through accumulated public perception. In addition, it provides grounds for refusal of registration for declarations of invalidity of a mark, but some of the grounds are mandatory, and others are optional only. Thus, individual Member States may choose to have differing grounds for refusal or invalidity, although all of them will have as a central core those which are mandatory. The mandatory grounds are numerous and have no obvious principle underpinning them except public policy and the demands of a coherent registration system
- It is important to note that no type of sign is automatically excluded from registration as a Community Trademark. Art. 4 lists the types of signs used most frequently by undertakings to identify their goods or services, but is not an exhaustive list. It is designed to simplify the adoption of administrative practices and court judgments to business requirements, and to encourage undertakings to apply for CTM. Depending on the circumstances, therefore, the Trademarks Office, the national courts, or in the last resort, the Court of Justice will be responsible for determining whether a trademark is entitled to be given protection as a Community trademark.
- Again, it is worthwhile to note that E.C.J has deduced other characteristics of EU trademarks that may not be immediately evident from the wording of the EU Trademark Directive and its complementary Trademark Regulation. It may be relatively uncontroversial to accept the E.C.J.’s view that the essence of a trademark is its distinctiveness, i.e., it must guarantee to consumers the identity of one product source from all others. But, the conditions obligatory for trademarks are that they (1) must be “clear, precise,

self-contained, easily accessible, intelligible, durable and objective”; and (2) must not deprive the trade or the public of signs that should be free to all. And both of these features imposed by the ECJ are said to flow from the interpretation of the relevant Directive and Trademark Regulation as a whole.

- Clearly the first requirement, as given in the previous paragraph, might narrow down the scope of trademark protection if applied in strict sense. Hence, this condition seems to be far-fetched and controversial.

International Level

- Article 15 of the TRIPS Agreement embarks upon the trademarks to be given protection through registration at international level. It reads:

"Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks."

The comparative discussion in this section suggests that the scope of trademark protection at the international level is wider enough to accommodate a variety of signs sought to be protected through registration.

6.2 Protection of Non-conventional Trademarks

U.S.

- The protection of non-conventional trademark in the US is fraught with some apprehensions as shown by the U.S courts judgments.

Nonetheless, in addition to word marks and designs or logos, trademark rights can be created in colour, sounds, scents, packaging design and product design, as long as certain requirements are met.

EU

- In the EU, any mark, including a sound, scent or color mark, is protectable, as long as it is capable of graphic representation and distinguishes the goods or services of one undertaking from the goods or services of another. Graphic representation is not purely a technical requirement for registration in the European Union but it embodies the “principle of precision”. Graphic representation ensures that the scope and nature of the mark are plainly defined and comprehensible so that searchers checking the registry can readily ascertain what is registered.
- In short, the ECJ has been willing to accept the registration of non-conventional marks if they could be represented graphically “particularly by means of images, lines, or characters” in a way that was “clear, precise, self-contained, easily accessible, intelligible, durable and objective.

International Level

- At the international level, TRIPs quite succinctly says that “any sign or combination of signs” may be registered as a trademark, although a condition may be imposed that the mark be “visually perceptible”.

The crux of discussion in this section is that the ECJ addressed non-traditional trademark registration and established procedures that tackle many of the concerns raised by non-traditional trademarks in the United States, and the European Union’s strict graphic representation requirement for non-traditional trademark registrations provides legal certainty and accessibility.

6.3 Dilution of Trademark

U.S.

- That the concept of “distinctiveness” is in fact a key to understanding the dilution doctrine becomes clear when we take a closer look at the harm which the dilution doctrine seeks to prevent. Section 45 of the Lanham Act prohibits the “dilution of the *distinctive* quality of the mark,” and defines dilution as “the lessening of the capacity of a famous mark to identify and distinguish goods.” Among the factors that the law considers relevant to the inquiry into whether a mark is famous or not are “the degree of inherent or acquired distinctiveness of the mark” and “the duration and extent of advertising and publicity of the mark.” The distinctiveness of the famous mark is thus the object of protection.

EU

- The EU Directive does not specifically mention the term “dilution”. In substance, however, it is clear that the entitlements that it affords trademark owners are aimed at protecting them against dilution.
- In the EU, one ground of refusal of registration arises where a trademark is identical with, or similar to, an earlier Community trademark which has a reputation within the Community, and where later trademark is to be, or has been registered for goods or services which are not similar to those which the earlier mark is registered, provided that the use of the later trademark without due cause would take unfair advantage of, or be detrimental to the distinctive character or repute of the earlier mark. Of course, if the later mark were to be used for similar goods and services there would be no need to rely on this anti-dilution provision.

International Level

- At the international level, the “Joint Recommendation on Trademarks” extended and elaborated the dilution concept. Among other things, it removed the distinction between registered and unregistered well-known marks. Moreover, the Recommendation

conceded that the TRIPs article 16.3 might be read restrictively to cover only cases of likely confusion, so it added two provisions, drawn from an amalgam of US and EU law, which explicitly protected well-known marks from dilution. The mark owner could take action where (1) the use of that mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark (2) the use of that mark would take unfair advantage of the distinctive character of the well-known mark.

- Retrospectively, Article 6bis of the Paris Convention had since 1925 forbidden the registration of copies or imitations of well-known marks where confusion was liable to result. TRIPs pushed protection of well-known marks closer to U.S law, which itself goes well beyond the requirements of the Paris Convention. Well known marks for services, not just goods, must now be protected. A mark's notoriety is to be judged by reference to "the relevant sector of the public", and notoriety may come from advertising the mark, not just using it. More importantly, TRIPs extended the reach of well-known registered brands to catch use on dissimilar goods or services if the use would indicate a connection between the mark and the registered owner, and the owner's "interests" were "likely to be damaged" ..

To compare and contrast the three jurisdictions, it can be said that the relevant provisions in each jurisdiction are aimed at preventing dilution, but still they sound quite different. For instance, section 43(c) of the Lanham Act applies to "famous" marks. Article 5(2) of the Trademark Directive requires that a mark, in order to be eligible for protection, have a "domestic reputation." Apart from the difference in language, the dilution doctrine in the EU is restricted to famous marks.

But the answer as to what is a famous mark can be complex and subjective. However, Section 43(c) of the Lanham Act provides a list of factors that courts are required to take into account in deciding whether a mark is famous, which of course is objective criteria. So, the provision suggests that the fame of a mark is linked to its distinctiveness.

To sum up the discussion on anti-dilution provisions in these jurisdictions, it can be said, that the “Joint Recommendation” has virtually extended the scope of dilution. The TRIPs article 16.3 added two provisions, from an amalgam of the U.S. and the EU law.

6.4 Registerability

Registrability, being an administrative issue, apparently seems outside the scope of our thesis. Practically, the notion of ‘trademark protection’ and registrability are inseparable. Hence a special mention of registrability in these jurisdictions is sought to be made in this part of the discussion.

Clearly, the rulings on registerability are important because, once on the register, trademarks get broad protection against confusion and dilution—typically wider protection that is extended to unregistered marks at common law.

U.S.

- If an owner uses a trademark or service mark only locally, and does not operate in interstate commerce, the owner may file an application to register the mark with the appropriate state agency. State trademark applications must be based upon use -- not intent to use -- and the registration protects the owner's rights only within the state borders.
- The registration of a trademark in the United States Patent and Trademark Office is highly desirable but not mandatory. The owner of a trademark may file an application to register its trademark if either (a) the mark has been used on goods or services in interstate commerce, or (b) the owner has a good faith intention to use the mark in interstate commerce with respect to specified goods or services - the latter has become known as an intent-to-use or "ITU" application.

- A trademark registered under the Lanham Act effects nationwide protection unless someone else within a particular geographic area is already using the mark. In that case, the prior user of the mark retains the right to use that mark within that area. The person registering the mark, however, can use the mark everywhere else in the territory of the USA.

EU

- In the EU, all marks—whether traditional word or design marks, or some other differently perceptible feature—are in theory examined for registerability according to the same criteria. Consumers may nevertheless view features such as scent, sound, colour and shape differently from standard marks, and this perception is key when the capacity of these features to act as a trademark is assessed.

International Level

- The International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, administers the international registration system. The Madrid Protocol allows countries that are not party to the Madrid Agreement to participate in the international registration system without requiring that they radically alter their trademark laws. The Madrid Protocol thereby removed barriers that had prevented several countries, including the United States, from joining the IR Register.

In comparison, in the US, the initial registration period is 10 years from the registration issue date. A CTM registration is valid for a period of 10 years from the date of filing and may be renewed indefinitely. As per requirement of CTM registration, use-need is required to be demonstrated in one EU country. Similar to CTM registrations, the initial registration period is 10 years from the date of filing the application. The registration may be renewed with a single application for renewal for additional 10-year periods by paying a renewal fee to the International Bureau.

The registration of trademark in either of the jurisdictions has its advantages and disadvantages, which are not deemed important to mention here.

6.5 Infringement Protection

In U.S., EU and at International Level

- In the U.S, registration at the state level gives narrow infringement protection. The same applies to the registration of a trademark at state level within EU.
- Whereas, a trademark registered under the Lanham Act, or EU Regulation grants broad Infringement protection to a trademark.
- At the other end of spectrum, Paris Convention and Trips give narrow infringement protection to a trademark.

6.6 Use and Non-use of Trademark

U.S.

- Again, under U.S. Trademark law, “use” is a more basic concept than confusion. Under the Lanham Act, a trademark registration cannot be obtained and maintained without a showing of authentic use of the mark in connection with the goods or services set forth in the trademark registration; and the criteria of use for establishing trademark rights and the criteria of use for establishing trademark infringement are the same—use of the mark by the rights holder, or use of the symbol in question, or a similar symbol, by the alleged infringer.
- The pivotal question in evaluating competing trademark claims is one of priority -- who was the first to use the mark in connection with the designated goods/services in the relevant geographic area. Innocent infringement is not a defence -- first in time is generally first in rights.

EU

- The EU Directive is built around the principle that trademarks should be used. Use of the mark in a single EU Member State will suffice to retain protection for the mark throughout the EU.
- CTM registration becomes vulnerable if the mark is not used for a period of 5 years or more.

International Level

For an international registration, “use” must be demonstrated in the home country and each designated extension country that requires use.

Comparatively, at the international level, the “proof of use” must be demonstrated in each home and designated extension country that requires use. Whereas, in the EU “proof of use” need only be demonstrated in one EU country. Likewise, under U.S. Trademark Law, the proof on the use of a trademark need to be established in one State.

6.7 Territoriality

One of the fundamental principles of trademark protection is territoriality. Trademark laws, the group of legal norms that determine the availability and scope of trademark rights, are mainly territorial. Undoubtedly, they are generally national, promulgated predominantly by national law-making institutions, whether courts or legislatures.

U.S.

- In the U.S., trademark rights are enforced on a national basis and the use of a foreign trademark in connection with goods and services sold only in a foreign country by a foreign entity does not constitute “use of the mark” in United States commerce adequate to merit protection under the Lanham Act.

EU

- The Community Trademark applies to the whole of the European Community but the rights afforded by registration apply only within the Community. According to article 6 of the EU Directive, the scope of the right is limited so as to preserve its essential function of a trademark, being to act as a guarantee of origin.

International Level

- Under the Paris Convention, very few obligations were imposed regarding the substantive content of national laws. The national treatment principle ensured that nationals of Paris Union countries were able to seek national rights in foreign countries on equal terms with national applicants. Regardless of the development and growth of the international trademark system, both with respect to substantive harmonization and procedural matters, the crucial proposition that trademark laws are national remains principally intact as a theoretical matter.

In short, trademark rights are classically acquired through national mechanisms but territoriality requires a producer to obtain separate rights for each territory (country) in which it desires protection.

7 Epilogue

The long-run history of the law of trademarks has been one of expanding subject-matter and scope of trademark protection. The trademarks that were traditionally protected were (as has been discussed in the preceding chapters) words and graphic designs. With the passage of time, the subject-matter and scope of protection of trademarks widened to include as a trademark any perceptible feature in the sensory world that could be used. In principle, any feature of a product or service becomes protectable against imitation if consumers come to recognize the feature as pointing to a particular product source. Many jurisdictions treat as wrongful any suggestion that misleads consumers into believing that an offered product or service originates from a particular producer or source.

From the discussion in the forgoing parts of this thesis, it is quite evident that the scope of trademark protection at the international level is encapsulated in article 16 of the TRIPS Agreement. The said article allows the holder to oppose the use without its consent in the course of trade of an identical or similar sign on identical or similar goods or services, where such use would result in a likelihood of confusion. Apparently, Article 16 allows Members a considerable degree of flexibility regarding the level of protection that will be provided. In fact, different legal systems, and different courts within the same legal system, may differ on the way these concepts are applied. Moreover, Article 16 of the TRIPS Agreement supplements Paris Convention rules on “well known” marks, essentially limiting the class of persons to whom a trademark or service mark must be well known in order to qualify for protection.

In the EU, the Trademark Directive says that a trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods, or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

The Directive provides absolute grounds of refusal for trademark protection. According to these grounds, the signs which cannot constitute a trademark, and trademarks which are devoid of any distinctive character are refused protection. Moreover, there are also mandatory and non-mandatory grounds of refusal of trademark protection. About the distinctiveness of a mark, the Directive is quite clear that it may be either inherent or arise through accumulated public perception.

It is also pertinent to remark that with the “use” of trademark in commerce, one obtains what are known as “common law” rights. These common law trademark rights can be effective in obtaining an injunction or a judgment against someone infringing your trademark, but they do not provide all of the benefits associated with other form of protection. In the U.S. for instance, a mark holder is entitled to common law rights simply by using a mark in connection with goods in the geographic area of use. These trademark rights, according to 15 U.S.C. §1127, arise through use and continue as long as the mark is used in interstate commerce.

In so far as the trademark protection at federal level is concerned, the Lanham Trademark Act of 1946 defines the scope of a trademark, and lays down the process by which a federal registration can be obtained from the U.S.P.T.O for a trademark. Nonetheless, in order to qualify for trademark protection, a trademark must meet two criteria: a) it must be distinctive i.e. the mark must distinguish the goods made by one person from those of another person; b) it must not present a likelihood of confusion with another mark.

Trademarks qualify for legal protection immediately upon use when they are “inherently distinctive.” For marks that are not “inherently distinctive,” the owner must establish a “secondary meaning” or “acquired distinctiveness” to receive legal trademark protection. Inherently distinctive trademarks fall into three types, “fanciful,” “arbitrary,” and “suggestive” trademarks. Marks that are merely descriptive terms for a good or its features or purpose do not qualify for legal protection.

Fanciful, arbitrary and suggestive marks are inherently distinctive, and as a result receive the greatest protection against infringement. The level of trademark protection for a suggestive trademark is less than that for an arbitrary or fanciful trademark because a suggestive trademark requires the customer to use imagination, thought and perception to arrive at or connect the mark to a characteristic of the good or service. Descriptive words are only entitled to protection if they have acquired secondary meaning in the mind of the consumer, conveying information concerning a quality or characteristic of the associated products or services to which the trademarks are affixed. Likewise, U.S. Trademark law does not protect generic terms because they comprise goods or services of several manufacturers and therefore lack the required distinctiveness.

It is also worth mentioning that trademark rights in the United States are fundamentally concerned with: a) Protection of the public from confusion, mistake or deception as to the origin and/or quality of goods, services or commercial identity arising from the use of a confusingly similar mark or name on the same or similar goods/services; b) Protection of an owner's investment in goodwill associated with the mark or name. Trademark laws protect the owner's commercial identity against use by a newcomer of a trademark confusingly similar to the owner's established mark.

Legal evolution empirically evidences that trademarks are today protected not only to avoid consumer confusion, but also to reward manufacturers with an adequate return on investments made to procure strong brands. The rational basis of this sort of development is subject to question and review. As the notion of trademark dilution may reduce the incentive to invest in trademarks, the existence of trademark protection does not, per se, create an incentive for continuous improvement in product quality.

The discussion in the preceding chapters suggests that two fields of trademark law which have expanded in recent years are well-known trademark and non-conventional trademarks. Unconventional trademarks involving sounds, smells, and shapes have started appearing on trademark registries in the EU and the US. They are even, when unregistered, gaining

protection in both common law and civil legal systems. About the protection of non-conventional trademarks, a question arises: Can the non-conventional trademarks such as a colour, a smell, or a sound qualify as a “mark” according to CTMR regulations? The answer of this question can be found in Article 4, which states: “A Community Trademark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

The protection of non-conventional trademark in the US is fraught with some apprehensions shown by the U.S courts. Nonetheless, in addition to word marks and designs or logos, trademark rights can be created in colour, sounds, scents, packaging design and product design, as long as certain requirements are met. It also seems as if the scope of trademark protection at international level has widened in consonance with the “Joint Recommendation on Trademarks” which has expanded dilution concept.

Against the background of previous discussion, it appears that the European trademark protection system, which is based on Trademark Directive and the CTMR, offers a broad scope of protection in the following two ways:

First, it allows for trademark protection without imposing many restrictions or strict demands. The dicta of the E.C.J. and the liberal approach adopted by the Court amply endorse this view. For instance, the E.C.J. has been liberal enough while looking into the conditions for securing registration and assessing the validity of the trademark, such as the capacity to distinguish. It is also evidenced from the large possibilities left to protect shapes, colours, sounds and even scents. *Second*, the scope of infringement can extend over uses of a mark for dissimilar goods or services. Now it is a growing tendency within the EU to show readiness, at least in principle, to extend the protection of scope of marks into the field of dissimilar goods and services. So, it seems evident that EU is stretching and widening the trademark protection system.

It does not imply that we should belabour our point that the European Trademark System is definitely the most flexible one. This situation of trademark system in the EU might change in the coming-up days as a result of the E.C.J. jurisprudence. It would be sufficient, for instance, for the Court to decide that single colour marks in principle are excluded, for the EU trademark system to show quite a different face. Alternatively, the legislator can intervene to adapt its system to new needs or to meet the exigencies of times. Despite these probabilities, it can be said that the expanded protection accorded to the non-conventional trademarks is not self-evidently a good thing in public policy terms.

Bibliography

Books

Anne Hiarling, Lynn S. Fruchter, *Understanding Basic Trademark Law* (San Francisco: Practising Law Institute, 2004).

Cornish, W.R., *Intellectual Property: Patents, Copyright, Trademarks and Allied Rights*, 2nd edition (Sweet & Maxwell, 1993).

Cornish, W.R., *Intellectual Property: Omnipresent, Distracting, Irrelevant?* (Oxford: Oxford University Press, 2004).

Francis H. Upton, *A Treatise on the Law of Trademarks with a Digest and Review of the English and American Authorities* 11-12 (1860).

Jeremy Phillips, *Trademarks Law: A Practical Anatomy* (Oxford: Oxford University Press, 2003)

Morgan, Lewis & Bockius, *Intellectual Property Handbook*, 5th ed. (Washington D.C: 2000).

Pickering, C. D. G, *Trademarks in Theory and Practice* (Hart Publishing, 1998).

Ruth Annand and Helen Norman, *Blackstone's Guide to the Trademarks Act 1994* (Blackstone Press Ltd., 1994).

S. Ladas, *Patents, Trademarks, and Related Rights: National and International Protection*, Vol. 1, (Cambridge: Harvard University Press, 1975).

S. Ricketson, *The Law of Intellectual Property* (Law Book, Sydney, 1984).

Steano Sandri, and Sergio Rizzo, *Non-conventional Trademarks and Community Law* (Marques, 2003).

Tina Hart, Linda Fazzani & Simon Clark, *Intellectual Property Law*, 4th edition (Palgrave Macmillan, 2006).

Terence Prime, *European Intellectual Property Law* (Ashgate Publishing Company, 2000).

Articles

Abbe E.L. Brown, Illuminating European Trademarks, *Script-ed*, Vol. 1, Issue 1 (March 2004).

David Vaver, "Unconventional and Well-Known Trademarks," *Singapore Journal of Legal Studies*, July 2005

F. Schechter, "The Rational Basis of Trademark Protection," 40 (1927) *Harvard Law Review*.

Georgios I. Zekos, "Trademarks and Cyberspace," Riga Graduate School of Law, *the Journal of World Intellectual Property* (2006) Vol. 9. No. 5,

Mark P. McKenna, "the Normative Foundations of Trademark Law," *Notre Dame L. Rev.* Feb., 2007.

Mathias Strasser, "the Rational Basis of Trademark Protection Revisited: Putting the Dilution Doctrine into Context," *Fordham Intell. Prop. Media & Ent. L.J.* 2006

Michelle R. Watts, "International Trademark Protection: An Overview of the Options," *California Business Law Practitioner*, Vol. 22, No. 1, Winter 2007.

Rashida Y.V. MacMurray, "Trademarks or Copyrights: Which Intellectual Property Right Affords its Owner the Greatest Protection of Architectural Ingenuity?," *North-Western Journal of Technology and Intellectual Property*, Volume 3, Number 2 (Spring 2005).

Thomas Nachbar, "Monopoly, Mercantilism, and the Politics of Regulation," 91 *VA. L. REV.* 1313 (2005).

Legislative Material

Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

Berne Convention for the Protection of Literary and Artistic Works.

European Council Regulation (EC) No. 40/94.

Federal Trade-Mark Act of 1946 (LANHAM ACT)

OHIM Guide.

Paris Convention for the Protection of Industrial Property.

Trademark Directive 89/104/EC.

Reports/Documents

Document prepared by the Secretariat, Standing Committee on "the Law of Trademarks, Industrial Designs and Geographical Indications," *World*

Intellectual Property Organization, Sixteenth Session, Geneva, November 13 to 17, 2006.

“Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks” adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the WIPO (September 20 to 29, 1999) WIPO Doc. No. A/34/13.

Report on United Nations Conference on Trade and Development, “Dispute Settlement under WTO,” New York and Geneva, 2003.

Report, “Non-Traditional Trademarks in Europe—Shape and Colour Trademarks—Common Issues with Obtaining, Exporting and Enforcing Rights,” 2004-2005 Europe Legislation Analysis Subcommittee, March 2005.

Internet Resources

<http://oami.europa.eu/en/mark/role/brochure/br1en.htm>.

http://www.inta.org/index.php?option=_content&task=view&id=56&Itemid=48&getcontent=1.

<http://oami.europa.eu/en/mark/aspects/default.htm>.

<http://oami.europa.eu/en/mark/rile/raisons.htm>.

<http://www.uspto.gov/web/trademarks/madrid/madridfaqs.htm>.

<http://www.pillsburylaw.com/bv/bvisapi.dll/portal/ep/paPubDetail.do/pub/2007321172113937/channelId/-8595/tabId/5/pageTypeId/9208>.

http://www.inta.org/info/basics_infringement.html.

<http://www.uspto.gov/main/glossary/>.

http://www.stimmel-law.com/articles/copy_trademark.html#t7.

<http://www.inta.org/about/lanham.html>.

http://www.ipmall.info/hosted_resources/lipa/patents/Patent_Act_of_1870.pdf.

<http://www.law.washington.edu/casrip/newsletter/Vol6/newsv6i2Caldarola.html>.

<http://www.msu.edu/unit/oip/LEED/protectingyourinvention.htm#Scopeofprotection>.

www.spi.org/bkprime.pdf.

<http://www.utexas.edu/law/journals/tiplj/volumes/vol7iss3/vana.pdf>.

http://www.wipo.int/documents/en/document/govbody/wo_gb_ab/doc/a34_13.doc.

Table of Cases

Ale House Management, Inc. v. Raleigh Ale House, Inc., 205 F.3d 137, 142 (4th Cir. 2000).

Bayer Co. v. United Drug Co., 272 F. 505 (S.D.N.Y. 1921).

Blanchard v. Hill (1742) 2 Atk. 484.

Boston Beer Co. Ltd. Partnership v. Slesar Bros., Brewing Co., Inc., 9 F.3d 175, 181 (1st Cir. 1993).

C-104/01, *ORANJE, Libertel Group BV v. Benelux-Merkenbureau*.

C-404/02, *Nichols plc v Registrar of Trademarks*. Opinion 15 January 2004.

C-299/99, *Philips v. Remington* of 18 June 2002.

C-283/01, *Shield Mark BV v Joost Kis h.o.d.n Memex*.

C-273/00 [2002] ECR I-11737. *Siekmann Case*.

Coats v. Holbrook, 2 Sand. Ch. 586, 7 N.Y. Ch. Ann. 713 (C.C.N.Y. 1845).

Coca-Cola, Co. v. Alma-Leo, U.S.A., Inc., 719 F. Crawshay v. Thompson, 4 Man. & G. 357, 385-86 (1842).

Delaware & Hudson Canal Co. v. Clark 80 U.S. 311 (1871).

DuPont Cellophane Co., Inc. v. Waxed Products Co., Inc., 85 F.2d 75 (2d Cir.1936).

Ferrari S.P.A. Esercizio Fabriche Automobile Corse v. Roberts, 944 F.2d 1235 (6th Cir. 1991).

Hanover Star Milling Co. V. Metcalf (1916) 240 US 403.

Heidelberger Case, ECJ 24 June 2004, C-49/02.

In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

In re Stanbel Inc., 16 USPQ2d 1469 (TTAB 1990).

Inwood Laboratories v. Ives Laboratories, 456 U.S. 844 (1982).

John H. Harland Co. v. Clark Checks, Inc., 711 F.2d 960, 980 (11th Cir. 1983).

Mattel Inc. v. MCA Records, 296 F.3d. 894 (9th Cir. 2002).

Millington v. Fox (1838) 3 Myl. & Cr.338.

Partridge v. Mench , 5 N.Y.Leg.Obs. 94, 2 Barb.Ch. 101, 5 N.Y. Ch. Ann. 572, 47 Am.Dec. 281 (C.C.N.Y. 1847).

Procter & Gamble v. Office for Harmonization in the Internal Market (OHIM), joined cases 468/01 P to C-472/01 P (E.C.J.) [Procter].

Qualitex Co. v. Jacobson Products Co 514 U.S. 159, 115 S. Ct. 1300 (1995)

Sieckmann v Deutsches Patent- und Markenamt 2003 E.T.M.R. 37.

Southern v. How 2 Popham 144 (K.B. 1618).

Sykes v. Sykes (1824) 3 B & C 543.

T-86/01 *Bosch v OHIM* (Kit Pro and Kit Super Pro) [2002] ECR II-4881.

T-88/00 *Mag Instruments* (Torch Shape) [2002] ECR II-467.

T-305/02. *Nestle Waters France v OHIM*.

Two Pesos Inc. vs. Taco Cabana Inc., 505 US 763.

Viking Umwelttechnik GmbH vs. OHIM, 25.09.2002, T-316/00.

Wrigley Company vs. OHIM, LIGHT GREEN, R 122/98-3.