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Prospects for the registering of non-  
traditional trademarks in the Republic of  
Belarus

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# Summary

Trademarks nowadays became a usual mean of representing business goodwill and reputation. Though, the major part of registered trademark consists of “traditional” ones (i.e words, figurative elements or their combination) the technological and competitive growth gave birth to existence of “non-traditional” trademarks (i.e three-dimensional, color marks, holograms, slogans, titles of films and books, motion or multimedia signs, position and gesture marks, sounds, olfactory, taste, texture and feel marks). Efficient protection of such signs for public and business benefit is important part of contemporary international and national legislation.

Republic of Belarus continues its work in development national system of intellectual property in accordance with the internationally recognized rules and standards. Broadening practice of legal protection of non-traditional trademarks should become one of the dimensions in this regard and play a great role in improving Belarusian business climate. As for today of all the variety of non-traditional signs only three-dimensional ones are registered as trademark in Belarus.

This thesis is a brief comparative research of the requirements, settled for non-traditional signs to be registered and protected as trademarks, which could be further adopted in the Republic of Belarus.

# Preface

I'd like to thank all of you,

My mother and father, for your love and belief,

My dear friends, for your encouraging and support,

My supervisor Ulf Maunsbach, for your guidance.

Yulia Mironchyk

# Abbreviations

|                            |   |
|----------------------------|---|
| CTMD                       | Directive of the European Parliament and of the Council No 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trademarks                      |
| CTMR                       | Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trademark  |
| CES                        | Custom Union and Common Economic Space (members are the Republic of Belarus, the Russian Federation and the Republic of Kazakhstan)   |
| CES trademark Treaty       | Proposal of 16.05.2013 for a Treaty on Trademarks, Service Marks and Appellations of Origin of Goods within the Countries – members of the Custom Union and Common Economic Space |
| Guidelines for examination | Guidelines for examination in the Office for harmonization in the Internal market (trademarks and designs) on community trademarks  |
| ECJ                        | European Court of Justice   |
| EU                         | European Union  |
| OHIM                       | Office for harmonization in the Internal market   |
| SCT                        | Standing committee on the law of trademarks, industrial designs and geographical indications WIPO   |
| Singapore Treaty           | Singapore Treaty on the Law of trademarks, Singapore, March 27, 2006  |
| TRIPS agreement            | Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)  |
| TLT                        | Trademark Law Treaty, Geneva, October 27, 1994  |
| WIPO                       | World Intellectual Property Organisation  |

# **1 Introduction**

## **1.1 The purpose of the thesis and research questions**

The purpose of the thesis is to study national and international systems of legal acts, regulating protection of non-traditional trademarks, that could be incorporated in the Republic of Belarus.

In this regard these questions have been analyzed:

- (i) Definition and nature of the term “non-traditional” trademark;
- (ii) Types of signs, though “non-traditional”, that could be used as trademarks;
- (iii) Requirements set up for non-traditional trademarks to be legally protected;
- (iv) Possibilities and obstacles for registering of non-traditional trademarks;
- (v) Prospective ways of improving Belarusian legislation in protecting non-traditional trademarks.

## **1.2 Method and material**

Protection of non-traditional trademarks has been studied in three dimensions:

- (i) International level set up by WIPO Treaties and Conventions. Regarding the purpose of the thesis TRIPS agreement (not yet signed by Republic of Belarus) and Singapore Treaty with its Regulation are of the major interest. Being part of national legislation signed International Treaties and Conventions became directly applicable in Belarus. Analysis and practices conducted by WIPO and SCT, though having no binding effect, are used in order to overview enforceability of international acts in different jurisdictions.
- (ii) European system of trademark protection developed by CTMD, CTMR, case law and OHIM practice.
- (iii) CES system as it is supposed to be established after signing CES trademark Treaty, including at the national level Belarusian and Russian legislation.

Methodological basis of the research constitutes of general scientific and legal methods, including comparative, historical, logical and systematic analysis.

### **1.3 Delimitation**

Three-dimensional signs as the form of the good or its packaging are currently registerable are the only one type of non-traditional trademarks that are registered in Belarus nowadays. But as the goal of the thesis is to analyze new for Belarus signs, regulations regarding registering of such marks are out of the scope of this research.



## 2 Legal background

Since the times of Roman Empire European legislation in general and trademark legal protection in particular has been progressive and in several steps forward. Blacksmiths who made swords in the Roman Empire are thought of as being the first users of trademarks.<sup>1</sup> Nowadays European system of trademark protection is well organized and could be accepted by other jurisdictions.

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) set up an idea of a trademark as ‘any sign or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings’<sup>2</sup> on the international level.

The basis for maintaining system of EU trademark protection, developing its the fundamental principles was established by the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC) which was superseded by the Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks and the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, which was amended by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark.

These acts broadened the idea of a trademark from traditional words, and pictures to 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.’<sup>3</sup>

Thus, any two- or three- dimensional marks, sounds, smells and colors *per se* and other signs fall under the above mentioned definition of a Trademark if they 1) can be represented graphically and 2) are capable of distinguishing the goods or services of one undertaking from those of other.

In a series of recent cases the European Court of Justice<sup>4</sup> requirement of graphical representation was interpreted and a list of criteria, which non-traditional marks shall meet in order to satisfy the test was set up.

Moreover, according to the Proposal for a Directive of the European Parliament and of the Council of 27.03.2013 to approximate the laws of the Member States relating to Trademarks the requirement of graphical representation of a Trademark might soon be changed to representation ‘in a

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<sup>1</sup> <https://en.wikipedia.org/wiki/Trademark> with the reference to Gary Richardson, Brand Names Before the Industrial Revolution, National Bureau of Economic Research

<sup>2</sup> TRIPS agreement, article 15, para 1.

<sup>3</sup> CTMD Article 2, CTMR, Article 4.

<sup>4</sup> Examples will be analysed more precisely later in this thesis.

manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor’<sup>5</sup>.

Republic of Belarus is a member of World Intellectual Property Organisation, party of the Paris Convention for the Protection of Industrial Property, Madrid Agreement Concerning the International Registration of Marks and its Protocol, Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, Trademark Law Treaty, Singapore Treaty on the Law of trademarks and several other Conventions.

However, the TRIPS agreement is still under consideration. The legislation of Belarus concerning non-traditional trademarks is quite conservative. Only ‘signs consisting of words, including personal names, combinations of colors, signs consisting of letters, numbers, graphics, three-dimensional signs, including the form of the good or its packaging, and also combinations of such signs may be registered as trademarks.’<sup>6</sup>

Hence, the list of types of signs is exhaustive and not wide. ‘Other signs may be registered as trademarks in cases provided by the legislative acts of the Republic of Belarus.’<sup>7</sup> But I couldn’t find such legal acts or Court decisions which let registration of other types of signs in Belarus.

The Republic of Belarus, together with the Russian Federation and the Republic of Kazakhstan are members of the Custom Union and Common Economic Space. A Proposal of 16.05.2013 for a Treaty on Trademarks, Service Marks and Appellations of Origin of Goods within the Countries – members of the Custom Union and Common Economic Space is under consideration now. A new system of common registration of trademarks in CES countries is supposed to be introduced. Legislation will be harmonized.

The Russian Federation is a party of the TRIPS agreement since August 22, 2012. Today It is the only country among the countries – CES members which has a developed system of protection of non-traditional trademarks. It was influenced much by European case law. The major part of the proprietors of non-traditional trademarks in Russia are transnational corporations.

I believe that the Republic of Belarus will also sign the TRIPS agreement soon. International, European, Russian experience in registering non-traditional trademarks will be accepted.

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<sup>5</sup> Proposal for a Directive of the European Parliament and of the Council of 27.03.2013 to approximate the laws of the Member States relating to Trademarks COM(2013) 162 final 2013/0089 (COD).

<sup>6</sup> Article 1 of the Law of Republic of Belarus No 2181-XII of February 5, 1993 (Amended as of July 9, 2012) “On Trademarks and Service Marks”

<sup>7</sup> Ibid.

# 3 Non-traditional trademarks.

## What are they?

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) defines trademarks as ‘any sign or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings’<sup>8</sup> gave the world opportunity to register other types of trademarks than traditional words, pictures and their combinations, but did not name them, giving scholars, lawyers and businessmen a field for imagination.

Such terms as “new types of marks”<sup>9</sup>, “unusual marks”<sup>10</sup>, “non-conventional trademarks”<sup>11</sup>, as well as “non-traditional marks” can be met in literature.

The Chair of the 17th Standing committee on the law of trademarks, industrial designs and geographical indications, Mr. Michael Arblaster (Australia) put the end to this variety suggesting to use ‘the terms “non-traditional marks” instead of “new types of marks”’. He noted that many of these signs were already known and used in several jurisdictions. Thus, it would not be appropriate to refer to them as “new”.’<sup>12</sup>

To categorize different signs that may be registered as a trademark, SCT grouped them according to whether they are visually perceptible or whether they may be perceived by senses other than the sense of sight:

- (a) Visible signs:
  - (i) Three-dimensional marks
  - (ii) Color marks
  - (iii) Holograms
  - (iv) Slogans
  - (v) Titles of films and books
  - (vi) Motion or multimedia signs
  - (vii) Position marks
  - (viii) Gesture marks
- (b) Non-visible signs:
  - (i) Sound marks

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<sup>8</sup> TRIPS agreement, article 15, para 1.

<sup>9</sup> SCT Report, Sixteenth Session, Geneva, November 13 to 17, 2006

<sup>10</sup> C Waelde, G Laurie, A Brown, J Cornwell, S Kheria, Contemporary Intellectual Property: Law and Policy, 2013, 3d edition, page 581

<sup>11</sup> Non-Traditional Trademarks in Europe – Shape and Color Trademarks – Common Issues with Obtaining, Exploiting and Enforcing Rights. Report of International trademark association. 2005

<sup>12</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 15

- (ii) Olfactory marks
- (iii) Taste marks
- (iv) Texture or feel marks.<sup>13</sup>

As I have mentioned before and for the aim of this thesis we will pay attention not to all of them but only to the signs, that are not considered to be trademarks in Belarus.

## 3.1 Visible signs

### 3.1.1 Color Marks

Nowadays in most of the jurisdiction combination of colors, though with some nuances, are registered as trademarks. A color *per se* is not that common for registration.

#### 3.1.1.1 International dimension

According to Rule 3(7) of the Regulation under Singapore Treaty ‘where the application contains a statement to the effect that the mark is a color per se mark or a combination of colors without delineated contours, the reproduction of the mark shall consist of a sample of the color or colors. The Office may require a designation of the color or colors by using their common names. The Office may also require a description on how the color is or the colors are applied to the goods or used in relation to the services. The Office may further require an indication of the color or colors by a recognized color code chosen by the applicant and accepted by the Office.’<sup>14</sup>

There is no “must use” list of codes for application description. SCR mentions such industry standards as PANTONE ®, RAL™, Focoltone®, RGB, etc.<sup>15</sup>

Including a color code to the application ‘may be a formal requirement, it may be recommended or simply allowed. The applicant also may be required to provide a chromatogram in addition to the color code’<sup>16</sup>. However, ‘representations that are precise but impossible to interpret without costly specialized equipment or services, place too high a burden on third parties and are likely to be rejected because they are not “easily accessible”’<sup>17</sup>.

SCT underlines different views whether reference to color codes should be supplied in addition to or instead of other representation requirements. Most

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<sup>13</sup> SCT Report, 16th Session, Geneva, November 13 to 17, 2006, para 3

<sup>14</sup> Regulation under Singapore Treaty, Rule 3(7)

<sup>15</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 3

<sup>16</sup> SCT Report, 18th Session, Geneva, 18/2, November 12 to 16, 2007, para 16

<sup>17</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 19

often color code references are recommended for the sake of precision. Preferred standard can be chosen by applicant.<sup>18</sup>

‘There might not be a requirement for the color mark to be limited to a shape or form, or to conform to any recognized system or shade classification.’<sup>19</sup>

### 3.1.1.2 EU dimension

Some first kind of color per se trademarks in Europe were registered as “figurative” in Benelux countries, for example: “pale purple or violet color” in 1982 for the goods in classes 29, 30, proprietor is Kraft Foods Schweiz Holding GmbH<sup>20</sup> and “green” in 1991 for the goods in classes 01, 04, 37, proprietor is BP p.l.c.<sup>21</sup>



The first and the major case concerning registration of a color *pe se* in Europe was ECJ Case C-104/01 - *Libertel Groep BV v Benelux-Merkenbureau*. Libertel applied to register the color orange as a trademark as regards goods in Class 9, telecommunications equipment, and in respect of services in Classes 35 to 38, the telecommunications services and physical, financial and technical management of telecommunications systems. The application form contained an orange rectangle and, in the space for describing the trademark, the word “orange” without reference to any color code.<sup>22</sup>

According to ECJ ruling a color per se could constitute a trademark, for its graphical representation application should be ‘clear, precise, self-contained, equally accessible, intelligible, durable, and objective.’<sup>23</sup>

Description in Libertel application (just a sample of a color and its description in words) could not satisfy those criteria of graphic representation.<sup>24</sup>

But ‘the designation of a color using an internationally recognised identification code may be considered to constitute a graphic representation. Such codes are deemed to be precise and stable.’<sup>25</sup>

Another important issue risen in the Libertel case was that a color *per se* constitutes a trademark only in relation to a product or a service<sup>26</sup> and if it has distinctive character.<sup>27</sup>

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<sup>18</sup> Ibid., para 18

<sup>19</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 21

<sup>20</sup> Trademark BX 00651138,

<https://register.boip.int/bmbonline/search/bynumber/perform.do?markNumber=00651138&markNumberType=APP>

<sup>21</sup> Trademark BX 0763468,

<https://register.boip.int/bmbonline/search/bynumber/perform.do?markNumber=00763468&markNumberType=APP>

<sup>22</sup> Case C-104/01 - *Libertel Groep BV v Benelux-Merkenbureau*, ECLI:EU:C:2003:244, Para 14, 15

<sup>23</sup> Ibid., para 29

<sup>24</sup> Ibid., para 31-35

<sup>25</sup> Ibid., para 37

The reason for this is ‘the fact that the number of colors actually available is limited (and) a small number of trademark registrations for certain services or goods could exhaust the entire range of the colors available. Such an extensive monopoly would be incompatible with a system of undistorted competition, in particular because it could have the effect of creating an unjustified competitive advantage for a single trader.’<sup>28</sup>

In the recent joint cases *Oberbank AG* (C-217/13), *Banco Santander SA and Santander Consumer Bank AG* (C-218/13) v *Deutscher Sparkassen- und Giroverband eV* the Court ruled “in order to assess whether that mark has acquired a distinctive character through use, it is necessary to examine whether such character was acquired before the date of filing of the application for registration of that mark. It is irrelevant in that regard that the proprietor of the mark at issue maintains that the mark has, in any event, acquired a distinctive character through use after the date of filing of the application for registration, but before the date of registration of that mark.”<sup>29</sup>

Combination of colors is registered as a trademark in Belarus, but nevertheless ECJ decision in case C-49/02 - *Heidelberger Bauchemie* should be mentioned.<sup>30</sup>

The case concerns the possibility to register combination register the colors blue and yellow as a trade mark for certain products used in the building trade. The court ruled: ‘The mere juxtaposition of two or more colors, without shape or contours, or a reference to two or more colors “in every conceivable form”, as is the case with the trademark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity.’<sup>31</sup> ‘Colors or combinations of colors which are the subject of an application for registration as a trade mark, claimed in the abstract, without contours, and in shades which are named in words by reference to a color sample and specified according to an internationally recognised color classification system may constitute a trade mark where:

–it has been established that, in the context in which they are used, those colors or combinations of colors in fact represent a sign, and

–the application for registration includes a systematic arrangement associating the colors concerned in a predetermined and uniform way.’<sup>32</sup>

One of the recent examples of color per se registrations by OHIM is trademark CTM 012886677 “Green (RAL:6038)”



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<sup>26</sup> Case C-104/01 - *Libertel Groep BV v Benelux-Merkenbureau*, ECLI:EU:C:2003:244, Para 67

<sup>27</sup> *Ibid.*

<sup>28</sup> *Ibid.*, para 54

<sup>29</sup> Joint cases *Oberbank AG* (C-217/13), *Banco Santander SA and Santander Consumer Bank AG* (C-218/13) v *Deutscher Sparkassen- und Giroverband eV*, ECLI:EU:C:2014:2012

<sup>30</sup> C-49/02 - *Heidelberger Bauchemie*, ECLI:EU:C:2004:384

<sup>31</sup> *Ibid.*, para 34.

<sup>32</sup> *Ibid.*, para 42

for the goods of 9 class. The proprietor is Bornack GmbH & Co. KG.<sup>33</sup>

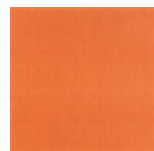
### 3.1.1.3 CES dimension

A color per se can be registered in Russia also if its acquired distinctive character through use has been proven.<sup>34</sup>

One of the examples of color per se that has been registered as a trademark - in Russia is “Pink” (Pantone 226C) – trademark RU 310048 for the goods in class 3 (Bleaching preparations and other substances for laundry use), the proprietor is a Dutch company Reckitt Benckiser. This trademark is used with bleacher “Vanish”.<sup>35</sup> To prove acquired distinctive character of the trademark the proprietor presented information on the intensity and duration of using this color for 20 years world wide and 10 years on the territory of Russia, the geography of use, data on market share, sales, advertising costs, independent opinion polls and its own surveys. Competitor’s commercials also became a provident, for they used a pink pack without labels in a comparative advertisement for assessing the quality of products. More than 60% of consumers recognized bleacher “Vanish” in this pack just because of the color.<sup>36</sup>



Another example is trademark RU 406752 “Orange” for the goods in class 17 (insulating materials), proprietor is Penoplex Spb Ltd.<sup>37</sup>



According to the Proposal for the CES trademark Treaty and Guideline to it to be registered as CES trademark acquired distinctiveness through use shall also be proven. Colors in the application or description of the sign shall be accompanied by an indication of the code of the relevant internationally recognized color identification system chosen by the applicant (for example, color catalogs of specialized organizations or color catalogs of the software image editors).<sup>38</sup>

However, Proposal for Guidelines to the CES trademark Treaty states that in order to register color mark applicant shall point “Sign constituting of combination of colors”<sup>39</sup>. The prospective practice will interpret if it should be understood that a color per se can not be registered as a CES trademark. Nevertheless I believe that the opportunity to register color per se as a trademark will be saved with the current approach of the Europe and Russia.

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<sup>33</sup> Trademark CTM 012886677

<https://oami.europa.eu/eSearch/#basic/trademarks/012886677>

<sup>34</sup> Civil Code of Russian Federation, Article 1482, 1483

<sup>35</sup> Trademark RU 310048,

<http://www.fips.ru/cdfi/fips.dll?ty=29&docid=31004800&ki=TM&cy=RU>

<sup>36</sup> M.A.Grineva. Protection of non-traditional trademarks. Patent Attorney magazine. 2014/4

<sup>37</sup> Trademark RU 406752 <http://tm.patent.su/406000-406999/tm/servlet/servlet47de.html>

<sup>38</sup> Proposal for Guidelines to the Treaty on Trademarks, Service Marks and Appellations of Origin of Goods within the Countries – members of the Custom Union and Common Economic Space, para 9

<sup>39</sup> Ibid.

## 3.1.2 Holograms

Holograms could be accepted to be registered as trademarks. But ‘since holograms may optically store and retrieve an image in three-dimensions, it may be difficult to capture the image in paper form, since depending on the angle that one looks at the image, the picture will change, and a paper print will not show the movement of the images’<sup>40</sup> and this creates a challenge for such marks to be precisely represented graphically.

### 3.1.2.1 International dimension

According to the Rule 3(5) of Regulation to the Singapore Treaty ‘where the application contains a statement to the effect that the mark is a hologram mark, the representation of the mark shall consist of one or several views of the mark capturing the holographic effect in its entirety. Where the Office considers that the view or views submitted do not capture the holographic effect in its entirety, it may require the furnishing of additional views. The Office may also require the applicant to furnish a description of the hologram mark.’<sup>41</sup>

SCT as a possible approach proposes ‘to describe the hologram in as much detail as possible, providing visual views of the holograms in various frames with descriptions of angle and appearance.’<sup>42</sup>

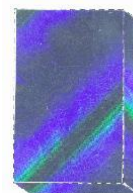
There are different opinions on the quantity of views of a hologram as representation of hologram mark for it may consist of one single view of the sign which captures the holographic effect or multiple views of the hologram from different angles. Unfortunately not always series of drawings or a single drawing can accurately represent the hologram.<sup>43</sup>

However ‘in one submission, the applicant must ensure that the hologram does not show different subject matter in the different views. Otherwise, the application may be refused on the grounds that the applicant is seeking registration of more than one mark in the application.’<sup>44</sup>

### 3.1.2.2 EU dimension

As example of hologram trademark in EU this one can be presented:

OHIM trademark registration CTM 002559144 for the goods in 34 class (cigarettes) ‘The mark consists of holographic paper that reflects the spectrum of color in a pattern of oblique, parallel lines applied to the surface of a package; the dotted lines shown in the drawing form no part of the mark, and are for 3-d illustrative purposes only.’<sup>45</sup> The proprietor is Eve Holdings Inc.



<sup>40</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 22

<sup>41</sup> Regulation to the Singapore Treaty, Rule 3(5)

<sup>42</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 23

<sup>43</sup> SCT Report, 20th Session, Geneva, 20/2, December 1 to 5, 2008. Area of Convergence No. 3, para 3.01

<sup>44</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 18

<sup>45</sup> Trademark CTM 002559144

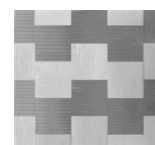
<https://oami.europa.eu/eSearch/#basic/trademarks/002559144>



### 3.1.2.3 CES dimension

According to the Guidance for CES Trademark Treaty ‘In order to indicate holographic effect as a whole (observed image reflection, brightness and contrast changes, etc.) clearly several (but at least three) images shall be provided for application of holographic trademark. Such images shall be photographed from different directions, in particular from the perpendicular direction and with an angle to the perpendicular direction. If the holographic effect changes the objects, the reproductions of each of these objects shall be provided. Different views of the hologram shall be illustrated from all angles or presented by a sequence of images revealing the holographic effect as a whole.’<sup>46</sup>

Example of such sign is Russian trademark RU 489400 for the goods in 11, 17 classes. The proprietor is Elite Strategic Union Limited.<sup>47</sup>



### 3.1.3 Slogans

Slogans can also be registered as trademarks. While graphic representation of such signs is quite simple as present visible sign consisting of words.

However, slogan shall fulfill the criteria of individualization the goods or services of one undertaking because they are not made up of signs or indications and show distinctive character.

#### 3.1.3.1 International dimension

While analyzing the problem of necessity of imagination or originality of slogan SCT stated that ‘these requirements should not form part of the assessment of a slogan’s capacity to distinguish goods of one undertaking from those of another.’<sup>48</sup>

#### 3.1.3.2 EU dimension

An example of slogan as registered trademark is French fraise “L’écologie au service de l’immobilier” for the goods and services of 9, 10, 11, 35, 36 codes. The proprietor is PIERRES D’EMERAUDE, EURL<sup>49</sup>

Slogan : " L'écologie au service de  
l'immobilier "

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<sup>46</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 16

<sup>47</sup> Trademark RU 489400

[http://www1.fips.ru/fips\\_servl/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=489400&TypeFile=html](http://www1.fips.ru/fips_servl/fips_servlet?DB=RUTM&rn=1248&DocNumber=489400&TypeFile=html)

<sup>48</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 28

<sup>49</sup> Trademark FR 4062317 [http://bases-marques.inpi.fr/Typo3\\_INPI\\_Marques/marques\\_fiche\\_resultats.html?id=FR4062317](http://bases-marques.inpi.fr/Typo3_INPI_Marques/marques_fiche_resultats.html?id=FR4062317)

The absence of distinctive character is the main reason in refusing registration such trademarks: Case T-68/13 *Novartis AG v OHIM* concerning slogan “CARE TO CARE” for services in Classes 41 and 42<sup>50</sup>, Case T-273/12 *Unister GmbH vs OHIM – de.* - slogan “AB IN DEN URLAUB” (“[lets go] on holidays”) for services within Classes 35, 39, 41 and 43.<sup>51</sup>

Moreover, ECJ ruled that ‘marks that are also used as advertising slogans may be recognized as having distinctive character and the ability to indicate to the consumer the commercial origin of the goods or services in question where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public.’<sup>52</sup>

One more criteria which was underlined in the case Case C-448/13 P - *Delphi Technologies v OHIM (INNOVATION FOR THE REAL WORLD)* is originality of the slogan: ‘the sign is not sufficiently original or resonant to require at least some interpretation, thought or analysis on the part of the relevant public, as that public is led to associate that sign immediately with goods which are capable of being marketed by any undertaking offering innovative products’<sup>53</sup>.

### **3.1.4 Titles of films and books**

Titles fulfilling necessary requirements for individualization and distinctiveness can be registered as trademark consisting of words, so its graphic representation is simple. The main challenge for trademark applicant is crossing with author copyright and publisher or promoter trademark.

#### **3.1.4.1 International dimension**

SCT notes that ‘it is generally admitted that serial titles and periodical or newspaper titles may fulfil a trademark function by identifying and distinguishing the successive issues of one publisher from those of other publishers or printers. In this case, the successive issues would be considered products (i.e. printed matter) emanating from a single commercial origin.’<sup>54</sup>

Hover it might cause problems in registering “single titles”, for ‘the public may associate, for example, a single book title with, at most, an author or a subject, but not with the source of the book, that is a publisher or printer.’<sup>55</sup>

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<sup>50</sup> Case T-68/13 *Novartis AG v OHIM*, ECLI:EU:T:2014:29

<sup>51</sup> Case T-273/12 *Unister GmbH v OHIM*, ECLI:EU:T:2014:568

<sup>52</sup> Case T-68/13 *Novartis AG v OHIM*, ECLI:EU:T:2014:29, para 16

<sup>53</sup> Case C-448/13 P - *Delphi Technologies v OHIM*, ECLI:EU:C:2014:1746, para 37

<sup>54</sup> *Ibid*, para 29

<sup>55</sup> *Ibid*, para 30

Another problem is author copyright. While trademark can be prolonged while used, copyright lifetime expires.<sup>56</sup>

#### **3.1.4.2 EU dimension**

ECJ regarding “Dr. No” title of the first film about “James Bond” in its case T-435/05 - Danjaq v OHMI - Mission Productions (Dr. No) pointed out that ‘theoretically, those facts cannot prevent the use of the signs Dr. No and Dr. NO as trademarks in order to identify the commercial origin of the films or DVDs.’ However, “Dr.No” does not ‘indicate the commercial origin of the films, but rather their artistic origin’<sup>57</sup>, thus this title does not fulfil individualisation criteria.

‘In certain jurisdictions (Germany for inst.), titles may be protected under *sui generis* systems. Such systems require that even where titles are basically understood as separate identifiers of works, they must, just like trademarks, be distinctive and not descriptive in respect of the work identified.’<sup>58</sup>

#### **3.1.4.3 CES dimension**

Trademark WO 1194781 MOSKVA SLESAM NE VERIT (“Moscow does not believe in teas”) for the goods and services of 3, 30 and 33 classes though had been previously registered in Belarus, Russia and Ukraine (Proprietor is Moskva Slezam Ne Verit OÜ) was later rejected registration in Russia on 19.03.2015 for the reasons of copyright infringement.<sup>59</sup>

### **3.1.5 Motion or multimedia signs**

Trademarks may consist of or contain elements of motion or ‘movement of a certain object (i.e., a visually perceivable combination of the object and the movement).’<sup>60</sup> With the development of TV and Internet such trademark became wide spread.

There are no common rule how to interpret its registerability. Individualization and distinctiveness should be proven. Decision could only be made on a case-by-case basis.<sup>61</sup>

#### **3.1.5.1 International dimension**

According to the Rule 3(6) of Regulation to the Singapore Treaty ‘where the application contains a statement to the effect that the mark is a motion mark, the representation of the mark shall, at the option of the Office, consist of one image or a series of still or moving images depicting movement. Where

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<sup>56</sup> SCT Report, 16th Session, Geneva, 16/5, November 13 to 17, 2006

<sup>57</sup> Case T-435/05 - Danjaq v OHMI - Mission Productions (Dr. No), ECLI:EU:T:2009:226

<sup>58</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 32

<sup>59</sup> Trademark WO 1194781,

<http://www.wipo.int/romarin/advSearch.do?ID=0&searchString=+%2FMARKGR%2FINTREGN+contains+1194781>

<sup>60</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 34

<sup>61</sup> Ibid.

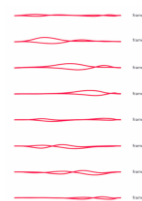
the Office considers that the image or images submitted do not depict movement, it may require the furnishing of additional images. The Office may also require that the applicant furnish a description explaining the movement.<sup>62</sup>

Also a short movie that will be deposited together with the application could be submitted. The movie can be deposited either in a material support (CD or DVD) as an electronic file where electronic means of transmittal are available.<sup>63</sup>

The written description may specify the chronological order of the images and the duration, the direction(s) and the frequency of the motion (for example “in a continuous manner”) could also be indicated.<sup>64</sup> This can be done by ‘all the stills that made up the multimedia effect, or a selection of samples sufficient to fully represent or reveal the distinctiveness of the multimedia effect, and an additional explanation of the effect in plain words.’<sup>65</sup>

### 3.1.5.2 EU dimension

Example of motion trademark is FI T200901668 “The mark is a moving image where the red line goes in waves from left to right. The animation seen in depictions of the mark.” for goods and services of 11, 20, 41 classes. The proprietor is PUNAVUORIDESIGN OY Published information consists of several images in chronological order.<sup>66</sup>



### 3.1.5.3 CES dimension

Trademark RU 296496 “The bird born by raging elements of fire. While soaring it turns into a flame printed letter “Φ” shown in the form of a bird. Image turns, becoming shining in all directions pure white flashings” for the services of 40, 41 classes. Motion is not identified in the published information and represented by only one image without recording, but video is attached to the application. The proprietor is Fenix-film Ltd.<sup>67</sup>



Trademark RU 361937 “Motion trademark as sunset is gradually moving around the sculpture “Worker and Kolkhoz Woman” sculpture. The title “Mosfilm” appears on its background. After that, images of the Spassky Tower and Kremlin wall gradually appear in the lower right corner. Red star began flashing on Spassky tower.” for the goods and services of 9, 40, 41 classes. Video file is



<sup>62</sup> Regulation to the Singapore Treaty, Rule 3(6)

<sup>63</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 23

<sup>64</sup> Ibid, para 24

<sup>65</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 35

<sup>66</sup> Trademark FI T200901668,

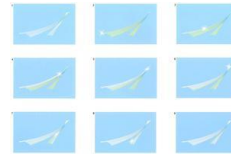
<http://tavamerkki.prh.fi/web/tietopalvelu/haku/?appNum=T200901668>

<sup>67</sup> Trademark RU 296496

[http://www1.fips.ru/fips\\_servl/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=296496&TypeFile=html](http://www1.fips.ru/fips_servl/fips_servlet?DB=RUTM&rn=1248&DocNumber=296496&TypeFile=html)

attached on CD, but published information consists only of one image. The proprietor is Mosfilm Cinema Concern.<sup>68</sup>

Trademark RU 345836 is a combination of light and moving elements: image-by-image playback consisting of 9 images of the motion of bright glare of light emanating from a single point. Characteristics of the lights element are not published. However, image-by-image playback makes clear chronology and idea of changes. Video is not attached. The proprietor is Microsoft corp.<sup>69</sup>



Also a light sign could be registered as a trademark in Russia: ‘if a light sign is applied for registration as trademark, a written description of light signal (signals), their order, length and other particularities shall be provided.’<sup>70</sup>

### 3.1.6 Position marks

These marks are specified by the position in which they appear or are fixed on a particular product. Usually position marks are registered as figurative or three-dimensional marks.<sup>71</sup>

SCT states that graphic representation could include ‘a picture or drawing showing the special position of the mark with regard to the product, as well as a description in words.’<sup>72</sup>

‘However, the reproduction of the mark must allow ... to clearly define the object of protection and to this end, the applicant may use dotted lines to indicate the part of the object that he does not wish to protect. A description defining the location of the sign (e.g. a label, pocket, button, stripe, etc.) in relation to the product will usually be required. Where the description is unambiguous, the mark will be considered as graphically represented. An indication of the type of mark may also be required.’<sup>73</sup>

But as in many other non-traditional trademarks the main challenge for applicant is to prove distinctiveness of the sign. Cases T-433/12 and T-434/12 - *Steiff v OHIM* (Étiquette avec bouton en métal au milieu de l'oreille d'une peluche. Label with metal button in the middle of the ear of a

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<sup>68</sup> Trademark RU 361937

[http://www1.fips.ru/fips\\_serv1/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=361937&](http://www1.fips.ru/fips_serv1/fips_servlet?DB=RUTM&rn=1248&DocNumber=361937&)

<sup>69</sup> Trademark RU 345836

[http://www1.fips.ru/fips\\_serv1/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=345836&](http://www1.fips.ru/fips_serv1/fips_servlet?DB=RUTM&rn=1248&DocNumber=345836&)

<sup>70</sup> Rospatent Rules ‘On filing and examination of applications for Trademarks and Service marks’, Order №4322 of March 5, 2003 para. 2.11

<sup>71</sup> SCT Report, 20th Session, Geneva, 20/2, December 1 to 5, 2008. Area of Convergence No. 5, para 5.01

<sup>72</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 37

<sup>73</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 26

Teddy Bear)<sup>74</sup> and Case C-521/13 P - *Think Schuhwerk v OHIM* (Red aglets on shoe laces)<sup>75</sup>.

Though the textual explanation of position mark is the same in all, international, EU and CES systems, the implementation practice can differ:

Example of position trademark is a ‘form of a fabric tag or decorative top stitching on the back pocket of jeans’<sup>76</sup> - trademark DD 642780 (label on the jeans pocket) for goods of 25 class. The proprietor is LEVI STRAUSS & CO. (n.d.Ges.d. Staates Delaware)<sup>77</sup>.



One more trademark, registered also in Russia and Kazakhstan is WO 695568 for goods of 25 class. The trademark is represented by “a red strip located in the heel of a men's shoe; this continuous strip crosses the sole; the other indications, shapes and/or figures appearing on the heel or the sole are not part of the trademark's representation”. The proprietor is LLOYD Shoes GmbH.<sup>78</sup>



In this regard, Christian LOUBOUTIN trademark for the goods of 25 class might be interesting, as in France it is registered as combined trademark FR 3067674 “Semelle de chaussure de couleur rouge” (red shoe sole)<sup>79</sup>. The world registration (Russia is one of the counties) of the same trademark is as individual trademark WO 1031242 “The mark consists of the color red (Pantone No. 18.1663TP) applied to the sole of a shoe as shown in the representation (the outline of the shoe is not part of the mark it is for illustration only).”<sup>80</sup> Images provided for graphic representation of these trademarks are also different.



## 3.1.7 Gesture marks

### 3.1.7.1 International dimension

Gesture marks can be registered as motion or figurative marks. Thus, graphic representation could be achieved through a single drawing or several frames depicting the gesture, accompanied by a written description.

<sup>74</sup> Cases T-433/12 and T-434/12 - *Steiff v OHIM* (Étiquette avec bouton en métal au milieu de l'oreille d'une peluche), ECLI:EU:T:2014:6

<sup>75</sup> Case C-521/13 P - *Think Schuhwerk v OHIM*, ECLI:EU:C:2014:2222

<sup>76</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 37

<sup>77</sup> Trademark DD 642780,

<https://register.dpma.de/DPMAreger/marke/register/DD642780/DE?lang=en>

<sup>78</sup> Trademark WO 695568,

<http://www.wipo.int/romarin/advSearch.do?ID=0&searchString=+%2FMARKGR%2FINTREGN+contains+695568>

<sup>79</sup> Trademark FR 3067674, [http://bases-](http://bases-marques.inpi.fr/Typo3_INPI_Marques/marques_fiche_resultats.html?id=FR3067674)

[marques.inpi.fr/Typo3\\_INPI\\_Marques/marques\\_fiche\\_resultats.html?id=FR3067674](http://bases-marques.inpi.fr/Typo3_INPI_Marques/marques_fiche_resultats.html?id=FR3067674)

<sup>80</sup> Trademark WO 1031242,

<http://www.wipo.int/romarin/advSearch.do?ID=0&searchString=+%2FMARKGR%2FINTREGN+contains+1031242>

If it is considered as a motion mark, the sign would be represented with a series of still pictures or an electronic file showing the gesture, together with a description of the mark indicating the gesture concerned. An indication of the type of mark may also be required.<sup>81</sup>

### 3.1.7.2 EU dimension



Example of such trademark is BX 00785673 (movement of fingers) for goods and services of 29, 30 classes. The proprietor is Mars Nederland B.V. (Expired)<sup>82</sup>

Trademark CTM 005952999 for goods and services of 3 class. “The trade mark consists of a moving image of a hand with a coin between forefinger and thumb being dipped into a liquid and removed / Shades of red, shades of pink, white, black, bronze, brown and flesh).” Proprietor is Reckitt Benckiser N.V.<sup>83</sup>



## 3.2 Non-visible signs

### 3.2.1 Sound marks

Sound trademarks may include musical sounds, either pre-existing or specially created to individualize goods and services, and non-musical sounds, either existing in nature or produced by man-made devices.

#### 3.2.1.1 International dimension

SCT notes, that ‘it may not be ruled out that sounds can be inherently distinctive in respect of goods and services, it may be more common for them to become distinctive through use and to be used in conjunction with other types of trademarks, such as word or device marks. In such case, both types of signs should have the potential to function as trademarks.’<sup>84</sup>

According to the Rule 3(9) of Regulation to the Singapore Treaty ‘Where the application contains a statement to the effect that the mark is a sound mark, the representation of the mark shall consist of a musical notation on a stave, or a description of the sound constituting the mark, or an analog or digital recording of that sound, or any combination thereof.’<sup>85</sup>

#### 3.2.1.2 EU dimension

Possibility to register sounds as trademarks was set up by ECJ in its famous Case C-283/01 *Shield Mark BV v Joost Kist h.o.d.n. Memex*.<sup>86</sup>

<sup>81</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 27

<sup>82</sup> Trademark 00785673

<https://register.boip.int/bmbonline/search/bynumber/perform.do?markNumber=00785673&markNumberType=APP>

<sup>83</sup> Trademark CTM005952999 <https://oami.europa.eu/eSearch/#basic/1+1+1+1/5952999>

<sup>84</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 41

<sup>85</sup> Regulation to the Singapore Treaty, Rule 3(9)

<sup>86</sup> Case C-283/01 *Shield Mark BV v Joost Kist h.o.d.n. Memex*, ECLI:EU:C:2003:641



Shield Mark hold 14 trademarks registered for various products and services in Classes 9, 16, 35, 41 and 42. Their graphical representation was different and included: a) musical stave with the first nine notes of the musical composition “Für Elise”, by Ludwig van Beethoven. Two of them also state: “Sound mark”. The trademark consists of the representation of the melody formed by the notes (graphically) transcribed on the stave, plus, in one case, played on a piano; b) first nine notes of “Für Elise”, some with the note “Sound mark. The trademark consists of the melody described”, plus, in one case, “played on a piano”; c) sequence of musical notes “E, D#, E, D#, E, B, D, C, A”, some also noted “Sound mark. The trademark consists of the reproduction of the melody formed by the sequence of notes as described”, plus, in one case, “played on a piano”; d) denomination “Kukelekuuuuu” (an onomatopoeia suggesting, in Dutch, a cockcrow), one with a note “Sound mark, the trademark consists of an onomatopoeia imitating a cockcrow”; e) a word “cockcrow” with a note “Sound mark, the trademark consists of the cockcrow as described”.<sup>87</sup>

The decision of the Court was that ‘sound signs must be capable of being regarded as trademarks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.’<sup>88</sup>

‘A trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective; in the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.’<sup>89</sup>

### **3.2.1.3 Possible means of graphical representation**

SCT notes that ‘there does not seem to be a preferred approach to the graphical representation of sound signs and different national systems apply a variety of means, sometimes used in combination’<sup>90</sup> and provides list of possible ways of graphic representation of sound trademark:

- 1) Musical notation. Though, it could be required to be certified for accuracy by a competent organization<sup>91</sup> or accepted only as a mean

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<sup>87</sup> Ibid., para 14-19

<sup>88</sup> Ibid., para 41


<sup>89</sup> Ibid., para 64

<sup>90</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 43

<sup>91</sup> Ibid. para 28



of representation ‘alternative to a written description or even less accessible to the public than the latter.’<sup>92</sup>

- 2) A written description in words. In order to understand the nature of the musical sign, the description should to the extent possible indicate the particular rendition claimed: notes, instruments, length of the sound, beat/tempo, volume or other characteristics of the sound.<sup>93</sup> Name of the specific piece of music<sup>94</sup> can also be used. However, ‘if the mark consists of a nonmusical sound, a mere description of the sound in words is not sufficient in EU. In such cases, a graphic representation consisting of an oscillogram or sonogram will be acceptable provided that it is accompanied by a corresponding sound file submitted via e-filing.’<sup>95</sup>
- 3) Specimen of the sound. A recording of the sound mark on a commonly used audio media, cassette or audio CD. Electronic file such as MP3 or .WAV may be used<sup>96</sup>. They could be made available to the public via the Internet Website of the Office or simply by allowing access to the recording at the registering office to any interested part.<sup>97</sup> However, recording alone might not be accepted as proper graphical representation of the sound mark, but only as additional to the written description. SCT underlines that for the sound like “moo of a cow” and the “sound of an automobile horn” the application had to include the characteristics of the sound or the diagram of frequencies, with the soundtrack registered on an audiocassette.<sup>98</sup>
- 4) Sonograms or oscillograms were used graphic  representation for registration of some sound trademarks, i.e. DE 395160596 for the goods of 9, 28 classes, proprietor NSM AG (registration was cancelled)<sup>99</sup>, DE 301594392 for the goods of 35 class, proprietor Top Radiovermarktung GmbH (registration was cancelled).<sup>100</sup> However, ‘technical means such as oscillogrammes, spectrograms or sonograms may not be considered adequate means to represent sound signs since they would not be easily accessible or understandable to the general public.’<sup>101</sup> In EU such method of graphic representation could be used as additional together with a corresponding sound file submitted via e-filing.<sup>102</sup>

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<sup>92</sup> Ibid.

<sup>93</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 30

<sup>94</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 43

<sup>95</sup> Guidelines for examination, para 2.1.2.3

<sup>96</sup> Ibid. para 32

<sup>97</sup> SCT Report, 18th Session, Geneva, 18/2, November 12 to 16, 2007, para 22

<sup>98</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 42

<sup>99</sup> Trademark DE 395160596,

<https://register.dpma.de/DPMAREgister/marke/register/395160596/DE?lang=en>

<sup>100</sup> Trademark DE 301594392,

<https://register.dpma.de/DPMAREgister/marke/register/301594392/DE?lang=en>

<sup>101</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 31

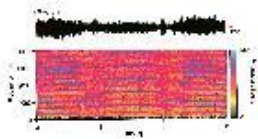
<sup>102</sup> Guidelines for examination, para 2.1.2.3

European practice on graphic representation of non-musical sounds was influenced by a Tarzan's yell case of the Board of Appeal OHIM R 708/2006-4 influenced: 'the spectrogram and the description filed did not fulfil the "self-contained" criterion since third parties, viewing the CTM Bulletin, could not easily and intelligibly understand the mark. However, the filing of the identical trademark with the addition of a sound file makes it registrable.'<sup>103</sup>

Duration of a sound may be limited dependent on the type of a sound. However, SCT notes that 'length would be important when the representation of the mark consists of musical notes, but it would seem less important in the case of digital or other forms of recording.'<sup>104</sup>

Examples:

OHIM trademark CTM 005562517  
"Lufthansa sound logo (= combination of e-piano motif, strings and sound design).<sup>105</sup>



OHIM trademark  
CTM 005090055  
(Tarzan's yell) for

the goods and services of 9, 16, 25, 28, 35, 38, 41, 42, 43 classes. The proprietor is Edgar Rice

Burroughs, Inc. Sonogram and recording are attached.<sup>106</sup>



### 3.2.1.4 CES dimension

According to Rospatent Rules "On filing and examination of applications for Trademarks and Service marks" "if a sound sign is applied for registration as trademark, a written description of constituting it sound (sounds), or musical notation, or frequency diagram with audio recording shall be provided.'<sup>107</sup>

Sound marks constitute the major part of non-traditional trademarks in Russia:

Trademark RU 262372 "Sound of a cat purring" for goods and services of 31 classes. The proprietor is Mars Ltd. Sonogram (though without scale of the time axis and the frequency axis) and recording are attached.<sup>108</sup>

Trademark RU 318691 for goods and services of 9 class. The proprietor is Intel corporation Ltd. Notation and recording are attached.<sup>109</sup>

<sup>103</sup> Case R 708/2006-4 of the OHIM Board of Appeal, Edgar Rice Burroughs, Inc., para 20

<sup>104</sup> SCT Report, 18th Session, Geneva, 18/2, November 12 to 16, 2007, para 26

<sup>105</sup> Trademark CTM 005562517,

<https://oami.europa.eu/eSearch/#basic/trademarks/005562517>

<sup>106</sup> Trademark CTM 005090055

<sup>107</sup> Rospatent Rules 'On filing and examination of applications for Trademarks and Service marks', Order №4322 of March 5, 2003 para. 2.11

<sup>108</sup> Trademark RU 262372,

[http://www1.fips.ru/fips\\_servlet/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=262372&TypeFile=html](http://www1.fips.ru/fips_servlet/fips_servlet?DB=RUTM&rn=1248&DocNumber=262372&TypeFile=html)

Trademark RU 538551 for goods and services of 9 and 41 classes. The proprietor is Twentieth Century Fox Film Corporation. Written description and recording are attached.<sup>110</sup>

Trademark RU 372556 for goods and services of 9 class. The proprietor is Microsoft corp. Notation and recording are attached.<sup>111</sup>

### 3.2.2 Olfactory marks

Olfactory marks as odor, scent or smell are less frequently forms of trademarks applied for registration.<sup>112</sup>

#### 3.2.2.1 International dimension

SCT also underlines, that for registering olfactory trademark the ‘test should be whether: (a) the applicant is the only person marketing the goods concerned; (b) the fragrance is not an inherent attribute or natural characteristic of the goods but a feature supplied by the applicant; (c) the applicant emphasized and promoted the scent mark in advertising, and (d) the applicant demonstrated that customers dealers and distributors of its products had come to recognize the applicant as the source of these goods.’ Thus, ‘the capability of a scent to distinguish an applicant’s goods or services is assessed under the same criteria as for any other trademark, namely whether other traders would want or need to use the scent in the ordinary course of their business without improper motive. However, some scents were specifically identified as not adapted to distinguish. These would include: (a) the natural scent of a product, including perfumes and essential oils; (b) masking scents, which would be seen as having a functional purpose and would therefore be considered incapable of distinguishing, and (c) scents that are functional or common to the trade, for example, lemon-scented washing products, which are used to make the product more pleasant or attractive.’<sup>113</sup>

Nevertheless, the main problem for applicant is appropriate graphical representation of the olfactory mark. Usually applicants are not required to submit a drawing of non-visual mark but its detailed written description which clearly describes the mark.<sup>114</sup>

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<sup>109</sup> Trademark RU 318691,

[http://www1.fips.ru/fips\\_servl/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=318691&TypeFile=html](http://www1.fips.ru/fips_servl/fips_servlet?DB=RUTM&rn=1248&DocNumber=318691&TypeFile=html)

<sup>110</sup> Trademark RU 538551,

[http://www1.fips.ru/fips\\_servl/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=538551&TypeFile=html](http://www1.fips.ru/fips_servl/fips_servlet?DB=RUTM&rn=1248&DocNumber=538551&TypeFile=html)

<sup>111</sup> Trademark RU 372556,

[http://www1.fips.ru/fips\\_servl/fips\\_servlet?DB=RUTM&rn=1248&DocNumber=372556&TypeFile=html](http://www1.fips.ru/fips_servl/fips_servlet?DB=RUTM&rn=1248&DocNumber=372556&TypeFile=html)

<sup>112</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 34

<sup>113</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 46

<sup>114</sup> Ibid., para 49

### 3.2.2.2 EU dimension

Scent case C-273/00 – *Ralf Sieckmann v Deutsches Patent - und Markenamt* became the first ECJ judgment on non-traditional trademark and influenced the following registration policy much. It actually made it very difficult or even impossible to fulfil graphic representation criteria for olfactory marks.<sup>115</sup>

The case concerned “methyl cinnamate” scent, which was described as “balsamically fruity with a slight hint of cinnamon” with the formula as  $C_6H_5-CH = CHCOOCH_3$ . A sample of odor was also submitted.<sup>116</sup>

The question before the Court was whether ‘the expression “signs capable of being represented graphically” covers only those signs which can be reproduced directly in their visible form or is it also to be construed as meaning signs - such as odours or sounds - which cannot be perceived visually per se but can be reproduced indirectly using certain aids? If the later, are the requirements of graphic representability satisfied where an odour is reproduced: (a) by a chemical formula; (b) by a description (to be published); (c) by means of a deposit; or (d) by a combination of the abovementioned surrogate reproductions?’<sup>117</sup>

ECJ ruled that that ‘a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.’<sup>118</sup>

‘In respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.’<sup>119</sup>

Above mentioned criteria for graphic representation “clear, precise, self-contained, easily accessible, intelligible, durable and objective” subsequently became known as the “*Sieckmann seven*” and were used in all following decisions of the Court on non-traditional trademarks<sup>120</sup>.

Previously registered in Europe trademarks of “the smell of fresh cut grass” for tennis balls, “a floral fragrance/ smell reminiscent of roses” for tyres and “the strong smell of bitter beer applied to flights for darts” have expired.<sup>121</sup>

In the later case T-305/04 - *Eden v OHIM* (Odeur de fraise mûre) concerning ‘smell of ripe strawberries’ image of



<sup>115</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 36

<sup>116</sup> Case C-273/00 – *Ralf Sieckmann v Deutsches Patent- und Markenamt* became, ECLI:EU:C:2002:748

<sup>117</sup> *Ibid.*, para 19

<sup>118</sup> *Ibid.*, para 55

<sup>119</sup> *Ibid.*, para 73

<sup>120</sup> C Waelde, G Laurie, A Brown, J Cornwell, S Kheria, *Contemporary Intellectual Property: Law and Policy*, 2013, 3d edition, page 580

<sup>121</sup> Joanna Wiszniewska, *Olfactory trade marks in the UK Trade Mark Law*, <http://blogs.sps.ed.ac.uk/sls/files/2013/08/Joanna-Wiszniewska.pdf>

strawberry was attached. However, The Court ruled that ‘the image adds no additional information in relation to the description in words. The information purportedly added, that is, the state of ripeness in which a strawberry emits the smell in question, is already contained in the description given, since that description states that it is the smell of “ripe” strawberries. Thus, since the two elements in the representation convey the same information, their combination cannot amount to more than the sum of the two parts and cannot overcome the criticisms raised against each of them individually.’<sup>122</sup>

And noted that ‘there is no generally accepted international classification of smells which would make it possible, as with international color codes or musical notation, to identify an olfactory sign objectively and precisely through the attribution of a name or a precise code specific to each smell.’<sup>123</sup>

In this regard ‘the question has been asked as to whether future developments could make it possible to reproduce olfactory marks by electronic or other means and whether such new methods of representation of marks could become acceptable by national or regional offices.’<sup>124</sup>

As a result of case law analysis in regard of olfactory marks OHIM makes a conclusion that ‘There is currently no means of graphically representing smells in a satisfactory way.’<sup>125</sup>

### **3.2.2.3 CES dimension**

Russian legislation does not contain requirements for the form of presentation of olfactory signs. According to “Answers to frequently asked questions of the Consulting and information service” of the official site of the Federal Institute of Industrial Property (FIPS) ‘if olfactory sign is applied for registration a description of the characteristics of smell or the bouquet of smells, as well as the composition or formula of a chemical compound characterizing the smell shall be submitted.’<sup>126</sup>

Patent Attorney Grineva M.A. notes that till 2014 the only application for the olfactory mark in Russia was 2011705919 “the smell of garlic”: “olfactory trade mark with the smell of freshly cut garlic” for goods and services of 3, 29, 30 and 32 classes. Subsequently, registration was rejected, what was confirmed by the decision of the Chamber of Patent Disputes. Decision was based on the article 1483 of the Civil Code – “the lack of distinctive character in relation to the reference to the properties and composition of the products 29 and 30 class and misleading as to the type and composition of other products”.<sup>127</sup>

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<sup>122</sup> Case T-305/04 - Eden v OHIM (Odeur de fraise mûre), ECLI:EU:T:2005:380, para 46

<sup>123</sup> Ibid., para 34

<sup>124</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 38

<sup>125</sup> Guidelines for examination, para 2.1.2.2

<sup>126</sup> [http://www1.fips.ru/wps/wcm/connect/content\\_ru/ru/brands\\_and\\_points/faq\\_tz](http://www1.fips.ru/wps/wcm/connect/content_ru/ru/brands_and_points/faq_tz)

<sup>127</sup> M.A.Grineva. Protection of non-traditional trademarks. Patent Attorney magazine. 2014/4

### **3.2.3 Taste**

Taste marks are also named as possible for protection as trademarks. Though ‘it continues to be debated, for example, if taste can function as a trademark and if so, what can be considered a sufficient representation of such signs.’<sup>128</sup> And ‘it could be argued that taste marks may only be applied to goods and not to services.’<sup>129</sup>

#### **3.2.3.1 International dimension**

SCT without referring to a particular case notes that ‘the graphic representation requirement was satisfied by using a written description of the taste and an indication that it concerns a taste mark.’<sup>130</sup>

#### **3.2.3.2 EU dimension**

Application to register the taste of artificial strawberry flavor for use in pharmaceutical products was rejected by the OHIM. The ground for rejection was that it did not meet the criteria for graphic representation (“Sieckmann seven”) of precision and objectivity in particular. The flavor for which registration was sought was not constant and would be ‘subject to modification owing to the type of fruit considered or the ripeness of the fruit.’ Therefore, the indication “artificial flavor” was not sufficient to create consistency, as several strawberry flavors existed and could be synthesized. The mark applied for was devoid of any objective character. It was also thought that ‘consumers were likely to see the taste as means to disguise the unpleasant flavour of medicine rather than as a trademark in other words, there was doubt over whether it functioned as an indication of origin’<sup>131</sup> and thus, the purpose of trademark for distinguishing goods was not met either.

Hence, OHIM concludes, that ‘taste mark could be argued in a similar way as olfactory marks.’<sup>132</sup>

### **3.2.4 Texture or feel marks**

#### **3.2.4.1 International dimension**

Examples of texture, feel or sensory marks marks are rare. ‘With this type of mark, it is the surface of the product that might lead to recognition, for instance because the surface touched has a specific recognizable structure or texture.’<sup>133</sup>

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<sup>128</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 39

<sup>129</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 53

<sup>130</sup> Ibid.

<sup>131</sup> OHIM Board of Appeal Case R 120/2001-2 Eli Lilly & Co’s v OHIM, para 15

<sup>132</sup> Guidelines for examination, para 2.1.2.3

<sup>133</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 55

Though, SCT notes that glass bottle of Coca-Cola was designed in 1915 to also be recognized in the dark.<sup>134</sup> Nowadays it is registered as three-dimensional trademark worldwide.<sup>135</sup>

#### **3.2.4.2 EU dimension**

As an only European example of such registration German figurative trademark DE 302598111 of the word “UNDERBERG” in embossed printing (Braille) for the goods and services of 8 class with a very detailed description of the mark<sup>136</sup> is usually mentioned.

SCT mentions German application the handle of a car chair. A national court ruled that touch or feel impressions, in general, cannot be represented graphically. However, German Federal Court of Justice in the Decision I ZB 73/05 rejected this general statement on appeal. According to the latter ruling that texture or feel marks might be capable of meeting the general requirements of graphical representation.<sup>137</sup>

### **3.3 Requirement of graphical representation of trademarks**

According to the article 15 TRIPS ‘members may require, as a condition of registration, that signs be visually perceptible’ to be eligible for registration as trademarks.<sup>138</sup>

Though, terms “visually perceptible” and “represented graphically” might be interpreted differently, nowadays legislation of European Union and Belarus, Russia and Kazakhstan state possibility for such registration dependent on appropriate “graphical representation”. European case law starting from “Sieckmann seven” created a stable algorithm in respect of evaluating each kind of such signs.

However, in order to improve and modernize existing protection of non-traditional trademarks Proposal for a Directive of the European Parliament and of the Council of 27.03.2013 to approximate the laws of the Member States relating to Trademarks the requirement of graphical representation of a Trademark is under consideration now. The definition of trademark as a sign capable “of being represented graphically”<sup>139</sup> is supposed to be changed for “being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to

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<sup>134</sup> SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, note 58

<sup>135</sup> For instance trademark CTM 002754067

<https://oami.europa.eu/eSearch/#basic/trademarks/002754067>

<sup>136</sup> Trademark DE 302598111,

<https://register.dpma.de/DPMAREgister/marke/register/302598111/DE?lang=en>

<sup>137</sup> SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 42

<sup>138</sup> TRIPS, article 15(1)

<sup>139</sup> CTRD, article 3

its proprietor”<sup>140</sup>. The reason for this proposal is that ‘requirement for “graphical representation” is out of date.’<sup>141</sup>

European Commission underlines that ‘the proposed new definition does not restrict the permissible means of representation to graphic or visual representation but leaves the door open to register matter that can be represented by technological means offering satisfactory guarantees. The idea is not to go for a boundless extension of the admissible ways to represent a sign, but to provide for more flexibility in that respect while ensuring greater legal certainty.’<sup>142</sup>

On the other hand, while trying to keep pace with technological growth by improving legal certainty in protection of non-traditional trademarks legal practitioners will face broad range of challenges in interpreting new forms of representation. However, I believe, that criteria, set out in Sieckmann case, i.e. to be “clear, precise, self-contained, easily accessible, intelligible, durable and objective” could still be applied in a new era of non-traditional trademarks.

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<sup>140</sup> CTRD Proposal.

<sup>141</sup> Ibid, para 5.1

<sup>142</sup> Ibid.



## 4 Conclusion

International and European practice in interpretation of definition of non-traditional trademarks and requirements for their registration and legal protection is broad but still it sometimes can not be clear enough for applicants.

The principle of national treatment gives different jurisdictions opportunity to develop their own systems but on the other hand might lead to legal uncertainty in using the same instruments.

However, modern dynamic technological and globalized world demands countries to improve and harmonize legislation regulating intellectual property rights and to interpret it in accordance with the latest innovations.

I believe that signing TRIPS agreement and CES trademark Treaty, implementation of the developed principles for the trademark 1) to be a sign, 2) to distinguish goods and services of one undertaking of those of another, 3) to have clear, precise, self-contained, easily accessible, intelligible, durable and objective representation will let Belarusian and foreign companies to improve their trademark portfolio with at least such types of signs as color, hologram, motion and sound which became popular worldwide.

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