

Global

Protecting and enforcing non-traditional trademarks

Businesses work constantly to devise innovative and creative marketing strategies. The use of non-traditional trademarks by businesses may offer a new way to attract consumers to their products or services.

Non-traditional trademarks differ from the familiar words, logos, letters and numbers that are traditionally used as trademarks. Consumers are accustomed to associating a particular company, product or service with a name or logo. However, the question arises as to whether consumers will naturally make such an association between a product and a scent, three-dimensional, shape, colour, touch, holographic, motion, sound or taste mark.

Today, non-traditional marks are increasingly used in the marketplace thanks to the expansion of the Internet and the increasing use of new technologies (eg, allowing the use of motion trademarks).

This evolution has also been encouraged by national and international legislation such as the World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 and the Singapore Treaty on the Law of Trademarks 2006, which has been adopted by more than 40 member states of the World Intellectual Property Organisation (WIPO). The Singapore Treaty, which is not yet in force, will establish a standard, inclusive legal definition of a 'trademark', including all non-traditional forms, thus taking a major step forward in the quest to harmonise trademark legislation worldwide. The treaty will enter into force once it has been ratified by 10 states or inter-governmental organisations – to date, it has been ratified by Bulgaria, Denmark, Romania, Singapore and Switzerland.

However, while legislation is evolving to allow a new generation of distinctive signs, the scope for registering such trademarks still seems to be limited. Statistics reported by national, regional and international trademark offices indicate that the number of non-traditional trademark applications has not significantly

increased in recent years. It may be that trademark applicants are discouraged by the difficulties they face when attempting to register non-traditional trademarks; applicants often find it hard to comply with the complex graphic representation and distinctiveness requirements.

Among non-traditional trademarks, shape and colour trademarks are the most common signs applied for and registered.

The US Patent and Trademark Office (USPTO) first accepted the registration of non-traditional trademarks more than 50 years ago. The first sound mark was obtained by NBC for radio broadcast services (American Trademark Registration 0523616), and the world-famous lion roar of Metro Goldwin Mayer was registered with the USPTO on October 14 1986 (American Trademark Registration 1413137; the mp3 abstract is available at www.uspto.gov/go/kids/soundex/73553567.mp3).

The first moving image trademark in Australia was registered in 2006; this sign comprises a 30-second video clip of the famous M&Ms character, including a range of movements and facial expressions (Australian Trademark Registration 919012; the video clip is available at <http://pericles.ipaustralia.gov.au/epublish/video/919012.mpg>).

Non-traditional trademarks are usually classified under two main categories: visible marks (ie, colours, shapes, moving images/motion marks, holograms, positions and gestures) and non-visible marks (ie, sounds, scents, tastes and textures) (see Table 1).

As of June 2008, of approximately 500,000 international trademark registrations filed with WIPO there were only:

- 35 sound trademark registrations;
- 526 three-dimensional trademark registrations; and
- 3,000 trademark registrations presenting a colour or colours (source: www.ip-watch.org/weblog/index.php?p=1118).

Table 1

Visible marks	Non-visible marks
Appearance mark: colour, combination of colour, shade of colour Shape mark: 3D, hologram, motion, moving image	Sound mark: jingle, sonogram representing noise, complex musical notation, piece of music or sound Scent mark: perfume, product, natural smell of product Taste mark: taste of product Touch/texture mark: particular feel of product or their packaging (eg, Braille).

At European level, of approximately 426,500 trademark registrations there were:

- 114 colour trademarks; and
- 47 sound trademarks.

In addition, there was just one olfactory trademark (“the smell of fresh-cut grass”), which has recently lapsed (source: <http://oami.europa.eu/ows/rw/pages/en.do>).

Although fashionable and appealing, non-traditional trademarks may not always be worth the difficulties that prospective registrants can encounter at the application stage as often such marks enjoy a limited scope of protection, even once registered.

Protecting non-traditional trademarks: a difficult path

As with traditional trademarks, in most jurisdictions non-traditional trademarks must be capable of distinguishing the origin of the product or service, as well as being represented graphically.

An unidentifiable message? The distinctiveness requirement

To what extent is a consumer likely to link a smell, colour, taste or touch to a brand? One of the main issues regarding non-traditional trademarks is the fact that consumers find it difficult to identify such marks as trademarks *per se*. Indeed, the basic function of a trademark is to establish a link between a sign and the business, service or product which the sign identifies in the marketplace. This essential function may be difficult to achieve through non-traditional trademarks since they usually convey a decorative or even functional message, in addition to a marketing message.

A study conducted by Singaporean trademark specialists concluded that consumers are largely unable to link a smell to a brand (cited in “Non-traditional trademarks: a Singapore perspective”, *Journal of Intellectual Property Law & Practice*, 2008 Vol 3, N3).

Purely decorative or functional characters do not comply with the distinctiveness requirement. Almost all jurisdictions recognise a trademark as registrable only if it is capable of distinguishing the origin of the product or service. The functional character of three-dimensional trademarks is often called into question at registration stage by national, regional or international offices. For example, in France, the Supreme Court rejected a trademark application for the shape of the Philips three-headed razor as it considered that the sign was exclusively composed of the shape of the product, which cannot be registered as a trademark (Supreme Court, May 30 2007, W 05-16.898). Such reasoning had previously been adopted by the European Court of Justice (ECJ), which indicated that a sign exclusively composed of the shape of the product, the essential characteristics of which are necessary to obtain a technical result, may not be registered as a trademark (ECJ, C-299/99, *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*, June 18 2002).

The same issue is raised by colour trademarks. The colour adopted to identify the goods, services or company must not be essential and inherent to the goods or services which the colour identifies.

The purely decorative character of a trademark was invoked by the ECJ in a decision regarding the three ADIDAS stripes, which illustrated the necessary link that the consumer must establish with the trademark. The judges stated that if a sign is perceived purely as an embellishment, the conditions for protection set down by EU regulations are not satisfied (ECJ Decision

C-408/01, *Adidas v Fitnessworld Trading Ltd*, October 23 2003, § 41).

The graphic representation requirement

The original WIPO Trademark Treaty 1994 did not apply to non-visible signs such as sound, olfactory or hologram trademarks (Article 2(1)).

On March 27 2006 40 of the 184 WIPO member states (including Australia, Belgium, China, France, Italy, Spain, Switzerland, the United Kingdom and the United States) adopted the Singapore Treaty on the Law of Trademarks, which revised the Trademark Treaty 1994. The purpose of the Singapore Treaty is to harmonise the trademark registration process across WIPO member states.

The Singapore Treaty expressly indicates that:

- its provisions apply to types of trademark other than two-dimensional marks, such as holographic marks, motion marks and colour marks; and
- marks consisting of non-visible signs, such as sound or taste marks, may be registered as trademarks (Rule 3 of the Regulation under the Singapore Treaty on the Law of Trademarks).

At present, the Singapore Treaty does not include standardised rules regarding how such marks should be represented in applications or registrations. However, such rules will permit contracting states to lay down harmonised rules on the basis of the treaty once the treaty has entered into force and once a consensus on these standards has been reached. A recent session in Geneva (July 21 to July 25 2008) considered whether a possible consensus could be reached between the member states.

When the Singapore Treaty does come into force it is likely to allow non-traditional trademark registrations at national level. At present, there are significant differences between jurisdictions; in some jurisdictions, non-traditional trademarks cannot be registered (eg, sound and olfactory trademarks may not be registered in China).

At European level, the ability to register such signs was established by the EU First Trademark Directive (89/104/EEC), which included the following definition of a 'trademark': "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 criteria for graphic representation was clarified by the ECJ in the *Sieckmann Case* (ECJ C-273/00 December 12 2002) regarding an olfactory trademark for the smell of

cinnamon. This case clarified the criteria as "clear, precise, self-contained, easily accessible, intelligible, durable and objective". In practice, the registration of olfactory trademarks is rare as it is difficult for their graphical representation to meet these requirements.

In regard to sound trademarks, the same criteria were applied in the *Shield Case* (ECJ C-283/01, November 27 2003) in relation to graphic representation. The graphic representation of sound is usually provided by a spectrogram and musical notes. In some jurisdictions the registration of a sound trademark is conditional upon the filing of a CD or recorded sound on any format (eg, in Finland the recorded sound must be filed).

For colour trademarks, most offices allow reference to a verbal description of the colour as well as reference to an international colour code (eg, PANTONE, RAL, Focoltone, CMYK).

Taste and touch trademarks are difficult to describe and to represent graphically. Such trademarks may be clearly and precisely described verbally, although this representation may not be objective enough. For example, in France, a trademark application for the taste of strawberries was rejected on the basis that the description of the taste lacked objectivity (Paris Court of Appeal, October 3 2003).

Together with the graphic representation requirement, these difficulties may discourage the registration of such trademarks which, once registered, may enjoy only a rather limited scope of protection.

Enforcing non-traditional trademarks: limited scope of protection

Limits of non-traditional trademark rights

The registration of a trademark grants its owner the right to prevent others from using the same or similar signs in the territory of protection in relation to the same or similar products or services.

However, once a trademark has been successfully registered, owners of non-traditional trademarks may find it difficult to enforce their marks. Enforcement problems may arise because such trademarks are difficult for judges and third parties to understand. The difficulties that the owner of a non-traditional trademark may encounter mainly stem from the subjective character of such trademarks – everyone has different senses of taste and smell and different preferences regarding colours.

In fact, there is no consensus on specific smells or tastes, which renders it hard to determine the infringing character of a non-traditional trademark. Therefore, it is very difficult for the trademark owner to provide evidence of such infringement.

Determination of the infringement

Not all non-traditional trademarks are subject to this limited scope of protection. For visible trademarks, the determination of infringement is likely to be very similar to that for traditional trademarks. Subjectivity is less of an issue in relation to visible trademarks than in relation to non-visible trademarks, which appeal to very personal senses. Therefore, the infringement of a visible trademark is generally assessed according to the same standards as are applied to verbal or numeric trademarks.

As regards non-visible trademarks (eg, taste and olfactory marks), the determination of infringement is more problematic since such a determination may vary from one person to another. However, in order for the assessment of infringement to be objective, judges can use specific and analytical processes such as electronic smell captors or spectrograms to calculate the gas mass for olfactory trademarks. Unfortunately, such processes do not exist for all non-traditional trademarks, particularly for taste marks.

Although the scope of protection of some non-traditional signs can be rather limited under trademark law, protection may be available under other IP rights.

Alternative access to protection

Although trademark protection can present difficulties for legal practitioners, the advantage of trademarks is that they are renewable for indefinite successive 10-year periods. Therefore, the general trend is to seek trademark registration in order to benefit from indefinite protection, rather than seeking protection under other IP rights (eg, copyright, design).

However, in the realm of non-traditional trademarks, deficiencies in trademark protection may convince applicants to seek alternative protection, thus reversing the general trend. In fact, non-traditional signs may be protected through other IP rights such as models, designs or copyright, as well as unfair competition rules.

Nevertheless, with respect to smells or tastes, it may not be easy for rights owners to obtain protection under copyright law, as illustrated by French case law. Under French law and in most jurisdictions, copyright protection is quasi-automatic and requires no formalities along the lines of the graphic representation requirement for trademarks. Protection under copyright law requires only that the work in question be original and have acquired an effective date as to its creation.

Since it is difficult to register perfumes as trademarks, rights owners have found copyright protection to be an appealing alternative. However, in France, the courts have refused to grant copyright protection to fragrances and tastes as they are deemed to constitute basic know-how

rather than works of authorship *per se*. Recent decisions of the French Supreme Court have confirmed that perfumes may not be protected by copyright in France (Supreme Court, June 13 2006, Y 02-44.718 and Supreme Court, July 1 2008, 07-13.952).

Regarding the protection of tastes, the French courts have also refused copyright protection on the basis that a taste is composed of a succession of instructions and methods which are not protectable by copyright.

Conversely, copyright owners may seek trademark protection because the ability to renew trademark rights indefinitely is appealing. Where a work of authorship satisfies the criteria for trademark protection, it may be registered as a trademark so as to obtain perpetual protection rather than obtaining protection for just the copyright term (the life of the author plus 70 years after death).

In a decision of March 7 2007 the Paris Court of Appeal commented that allowing Hasbro to register the Monopoly game board as a trademark would allow it to benefit from a longer term of protection than that which is afforded to copyright works. However, the trademark application was rejected on different grounds (lack of distinctiveness). This case should remind practitioners that IP boundaries are not so easily surmountable.

Conclusion

Although attempts have been made to deal with non-traditional trademarks through new legislation and research, it seems that, against all expectations, the number of non-traditional trademark registrations is not significantly increasing. The lack of an international consensus and the registration difficulties appear to be key factors in this surprising situation. However, the protection of such trademarks around the world is currently being called into question, particularly by WIPO, which commissioned a study regarding possible ways to reach a consensus and steps to take to standardise registration practices for WIPO member states. Harmonisation across national legislation would likely result in an increase in non-traditional trademark registrations.

The enforcement of non-traditional trademarks remains particularly difficult for the courts. The establishment of guidelines and the roll-out of new processes in order to determine the likelihood of confusion in relation to non-traditional trademarks should be the next step in order to allow the owners of such trademarks to protect and enforce their marks. After all, the registration of a trademark is effective only if it enables the trademark owner to oppose the third-party use of similar signs.

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