Registrability of smells, colors and sounds:

How to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within European Union law?

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1. Introduction

“A trade mark can be described as a sign or symbol placed on, or used in relation to, one trader’s goods or services to distinguish them from similar goods or services supplied by other traders.”

Trademark\(^2\) is often perceived in a traditional sense as a two-dimensional word, slogan, symbol etc. employed to distinguish a product or service. Indeed, about 106,000 trademarks applications (2011) were filed at the Office for Harmonization in the Internal Market (OHIM)\(^3\) where the vast majority of Community Trademarks consists of word marks (60.79\%) and figurative marks (38.39\%).\(^4\)

In today’s world, companies have to be creative and stand out from their competitors to remain in a good market position. Companies must invest, besides a word trademark, into so-called non-traditional trademarks, such as smell, sound and color marks applied, for example, on the products packaging to make it depart significantly from the sector’s norms. Indeed, “in order to have a viable future, brands will have to incorporate a brand platform that fully integrates the five senses”,\(^5\) where “virtually any perceptible feature in the sensory world can be used to attract custom”.\(^6\) Moreover, marketing and branding methods are growing into a farfetched way as companies start to surf on the social media movement of our information society.\(^7\) Besides, traders also invest into the circulation of the brand image like Apple which registered its cube-shaped glass store in New York.\(^8\)

However, traders need to be careful, as educating consumers to associate a particular color, smell, sound, etc. with a brand demand huge expenditures in marketing and communication, where “cleverness alone does not ensure legal protection”.\(^9\) Also, non-conventional trademarks (NCTMs) pose a “marketing dilemma”, using them in a sensory marketing could sound the “legal death knell” for the trademark itself as it will not fulfill its source indicator function.\(^10\)

New technologies brought the possibility to exploit a different type of marks and globalization has stimulated the utilization of these non-verbal signs because of their autonomy from linguistic

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\(^2\) Throughout this work, trademark and mark will be used to refer to both trademarks and service marks.
\(^8\) U.S. Trademark Reg. No. 4021593.
\(^10\) See supra note 9, p. 217.
These modern marks are recurrently employed in the global market place nowadays, but a worldwide valid trademark does not exist as registration is territory-based.

On the other hand, these “new trade mark forms” represent one of the most important changes in trademark law and one significant concern for policy-makers is to guarantee that (intellectual property) laws continue to match with technological improvements.

Back to the basics, trademarks play an important role in our society. Trademarks have plenty of functions, but two are preponderant. The first is the indication of trade origin (“badge of origin” function), seen by the European Court of Justice (ECJ) as the essential function. Indeed, trademarks allow consumers to distinguish goods/services of a company from those of another. Thus, they encourage brand owners to produce high-quality goods under a certain sign. This also protects consumers from being misled into buying the wrong product. The second is the “psychological” message/brand image. This especially applies in markets where goods are not so differentiated where consumers make purchase choices relying also and mainly on the “brand image” of the mark. The European Union (EU) law protects both functions of trademarks.

At the EU level, trademarks are regulated by the Directive 2008/95/EC (TMD) and the Regulation 207/2009 (CTMR). These laws codified and repealed respectively the Directive 89/104/EC and the Regulation 40/94. The former aspires at harmonizing substantive national laws of the EU Member States and the latter established a regional system for trademark. This Community Trademark (CTM), granting exclusive rights of a unitary character enforceable in the entire Union, is managed principally by the OHIM, the Union’s trademark office. Both documents provide for the same substantive principles.

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15 Such as identification, advertising, investment, quality function and goodwill carrier.
19 No substantial modification has been brought in the articles and in the numbers of the first articles.
23 Community trademark application may be filed before the national, Benelux office of intellectual property or before the OHIM. Besides, to register a trademark internationally, the Madrid protocol
In order for a sign to be validly registered, it must be included in the definition of a registrable mark and not excluded by one of the absolute nor relative grounds of refusal.\textsuperscript{24} The definition is open-ended and thus permits the registration of unusual marks. Article 2 of the Directive and 4 of the Regulation set two requirements for an insignia\textsuperscript{25} to be considered a trademark. Firstly, the sign must be capable of being represented graphically, i.e. be visualized in two or three-dimensional form.\textsuperscript{26} Secondly, the sign must be capable of distinguishing the goods/services of one trader from those of another, i.e. enable consumers to realize that distinction (distinctive character or distinguishing capability). These, seen as “formal and substantive requirements for trademark registration”,\textsuperscript{27} are present in all states now.\textsuperscript{28} They also remain of application for NCTMs, where EU law does not provide for different nor stricter criteria to evaluate the registrability of NCTMs than with traditional marks, insofar as distinctiveness is involved.\textsuperscript{29} Nevertheless, “non-traditional marks may be less readily accepted by the average consumer as indications of trade origin”\textsuperscript{30} and face issues in practice. The comprehensive application of articles 4 and 7 CTMR is laid down in the OHIM’s Manual of Trade Mark Practice and is detailed infra.\textsuperscript{31}

Following from above, words and numbers are surely capable of graphic representation, but what about smells, colors, sounds and other NCTMs? They are abstractly registrable because of the very broad and non-exhaustive definition of a trademark, yet EU judges (OHMI, General Court and ECJ) are very restrictive in granting registration.\textsuperscript{32} Therefore, still nowadays, applicants for NCTMs have to break tremendous barriers to register them in practice, barriers comparatively rarely faced by traditional word or logo marks.

The terms non-conventional or non-traditional trademarks commonly all refer to color, sound/aural, smell/scent/olfactory, aroma, shape, motion, hologram, tactile/feel and taste marks, which may further be subdivided as visible and non-visible accordingly. These marks tend to appeal to the other

\begin{itemize}
  \item \textsuperscript{24} Articles 2, 3 and 4 of the Directive and articles 4, 7 and 8 of the regulation. The relative grounds, which refer to grounds for refusing registration (or invalidating registered trademarks) if their use conflicts with earlier rights, will not be examined.
  \item \textsuperscript{25} Note that it can be also said that another requirement is that a feature seeking trademark protection need to be a “sign”.
  \item \textsuperscript{26} This requirement should not be confused with the “visibility requirement” of a trade mark that the TRIPS Agreement offers to its Member States (art. 15(1)). In this respect, the EU law seems to be less rigid by “only” requiring of a feature to be a sign capable of being graphically represented to be registrable (plus the Sieckmann requirements).
  \item \textsuperscript{28} Ahuja, V.K. 2010. Non-traditional trade marks: new dimension of trade marks law. E.I.P.R., 32(11), p. 575.
  \item \textsuperscript{29} Case T-119/00, Procter & Gamble Company v OHIM, ECJ, September 19 2001 and Joined cases C-53/01 to 55/01, Linde AG, Winward Industries Inc. & RadoUhren AG, para. 49, ECJ, April 8 2003.
\end{itemize}
human senses than just the sense of sight\textsuperscript{33} and this fact must not render them ineligible for protection.\textsuperscript{34}

Against this background, the following research question is formulated:

\textit{Registrability of smells, colors and sounds: how to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within EU law?}

Using case-law from EU but also from various jurisdictions and a multi-disciplinary perspective, it will be sought to demonstrate ways for such trademarks to be regarded as registrable in light of EU law. Indeed, such unconventional marks today will eventually become the conventional mark of tomorrow. The following chapters respectively deal with olfactory, sight and aural senses marks.

\section*{2. Smell marks}

Olfactory memory represents one of the strongest and more reliable kinds of human memory but is in the meantime the most unused mean to link brand to consumers, where for example smell of roses may improve memory.\textsuperscript{35} Smells have also the ability to recall pictures and emotions and this may affect consumers’ comportment and purchase decision-making. It can be held that once distinctive, a smell is one of the most powerful manners to differentiate goods from one trader from those of another.\textsuperscript{36} One needs to be careful of \textit{inter alia} the ambient scent-effect on purchasing behavior (aromachology) which, while offering a potent marketing asset to the brand owners who register such scents, raises ethical issues.\textsuperscript{37} However, a 2011’s study contests the effectiveness of this scent-effect.\textsuperscript{38}

Traders successfully registered the smell marks such as the smell of freshly-cut grass\textsuperscript{39}, bitter ale and roses for tennis balls, darts’ flight and tires respectively. However, an ECJ’s ruling changed the odds.

When looking at the issues faced by NCTMs, the landmark case to thoroughly consider is the \textit{Ralf Sieckmann v Deutsches Patent- und Markenamt},\textsuperscript{40} where the criteria of graphical representation of a trademark were assessed. The applicant sought registration for a smell “balsamically fruity with a


\textsuperscript{39} Case R 156/1998-2, Vennootschap onder Firma Senta Aromatic Marketing Application, OHIM’s Second Board of Appeal, February 11 1999. Not registered anymore as not renewed.

\textsuperscript{40} Case C-273/00, ECJ, December 12 2002.
slight hint of cinnamon”. He represented its scent by three methods, namely by a verbal description, a chemical formula and the submission of a specimen of the smell.

In its assessment, the ECJ firstly held that a sign which is not able per se to be identified by the sense of sight may qualify as a trademark if it possesses a distinctive character and if it can be depicted graphically, especially using pictures, lines or characters for example. In other words, the ruling made clear that “signs capable of being represented graphically are not limited to those signs which can be perceived visually”. Hence, the graphic representativeness shoulders an important character. The Court went on to say that the graphical representation must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”. The latter is known as the Sieckmann seven-fold test, for which the Court did not provide much guidance on what they stand for and how they are satisfied in practice. Indeed, the aim behind the graphic representation criterion is to empower a sign to be depicted visually in order for the scope of protection of the mark to be precisely determined by the competent authorities, traders and the public at large, by consulting the public registry, ensuring legal certainty. Accordingly, the Court eventually held that none of the manners to represent graphically the scent was satisfactory, neither separately nor in combination. However it is argued that the combination of these methods should not be set apart, as they, together as a whole, fulfill the test even if separately each method does not comply with all the criteria.

In the aftermath of this case, the ECJ made the registration of scent marks practically almost impossible as argued by many scholars but not totally for others. Moreover, the lack of an internationally acknowledged classification system for scents renders impracticable the granting of a trademark without the smell complying with the Sieckmann test. Noteworthy, olfactory measurement methods such as spectrogram, (gas) chromatogram and electronic nose have not been deemed adequate but registration should follow this lead.

Besides all this, the smell still needs to be distinctive, in the sense that it must serve as a trade origin indicator (doubtful until now as people smell differently), not be the outcome of the nature of the product itself, creating another hindrance as this is the scent rather than the scented substance or chemical molecule.

To sum up so far, in order to qualify for registration, a feature has to constitute a sign, be distinctive (either inherently or through use), and have the ability to be graphically represented (albeit the sign

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41 Par. 45 and 46 of the judgment.
42 See supra note 27, p. 781.
43 Par. 55 of the judgment.
44 Par 46 and 47.
47 Although the ECJ did not exclude this method in Sieckmann case because being outside its seisin.
49 See Arsenal Football Club plc v Reed, Case C-206/01, ECJ, November 12 2002, at par. 48.
itself does not have to be visually perceptible), such representation has to comply with the Sieckmann test (rather questionable) and the sign may not be considered by the TMD\(^{50}\) or the CMTR\(^{51}\) to be a sign that should be freely available for everyone to use\(^{52}\) (rather unquestionable, known as the requirement of legitimacy, i.e. desirability of protection as a trademark).\(^{53}\) The depiction and description, which sustain an intertwined relationship\(^{54}\), have to explicitly display the nature of the mark, whose features are sufficiently precise to allow a suitable examination and identification of the scope of protection once registered. Already stated supra, no stricter criteria to assess distinctiveness may be applied in theory to NCTMs. However, as the average consumer\(^{55}\) is not naturally accustomed to deduce the origin of goods or services from NCTMs, the distinctiveness test may be harder to pass in comparison with word or figurative marks.\(^{56}\) For unconventional marks, an accurate description of the mark is of uppermost importance.

Although Sieckmann sought the registration of a scent mark, the decision resulting into the so-called Sieckmann requirements also apply to all intangible marks.\(^{57}\) Therefore, a closer insight on color and sound marks is given in the following chapters.

3. Color marks

3.1. Single color, a color alone, color *per se* and more\(^{58}\)

“*It’s easier to catch the consumer’s eye with color than with words*”\(^{59}\)

Color constitutes a mighty and efficient instrument for generating memory and especially corporate or brand recognition/identification, once registered.\(^{60}\) They are registrable in the abstract (i.e. not spatially defined) or as applied to the outside appearance or to the packaging of the goods.

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\(^{50}\) Article 3.(1)c.

\(^{51}\) Article 7.(1)c.


\(^{54}\) *Inter alia*, the description should refer back to the depiction and both define the nature and scope of the trademark.

\(^{55}\) Figurative person reasonably well informed and reasonably observant and circumspect (Case C-210/96, ECJ, July 16 1998, at par. 31) but who but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them kept in his/her mind (Case C-342/97, ECJ, June 22 1999, at par. 26). The average consumer’s notion is used in matters of registrability, invalidity and infringement. For further information, see: Davis, J., 2005. Locating the average consumer: his judicial origins, intellectual influences and current role in European trade mark law. *Intellectual Property Quarterly*, 2, pp. 183-203.


\(^{57}\) See supra note 6, p. 902.

\(^{58}\) A bureaucratic requirement is to specify that the mark to be registered is a color (or smell or sound) mark, otherwise it would qualify for word or figurative mark and for particular classes of goods or services. Therefore, the registration of one color does not give an exclusive right to its owner on all products or services. For example, British Petroleum does not possess such right to utilize the color green on all goods but exclusively on service stations.

As already thought by Bainbridge in 2002, in order to surmount the issue of graphic representation for a single color, two solutions would be (i) to provide a sample of the color to be registered or (ii) to identify the color employing a recognized referencing system such as the Pantone Matching System, RAL or Focoltone system. After Libertel, the United Kingdom opted for the Bainbridge’s second solution.

Less than ten years ago, the ECJ shed lights on the question of the registrability of colors as a trademark in the landmark case Libertel Groep BV v Benelux-Merkenbureau. In this ruling, Libertel, a Dutch telecommunications group, tried in vain to register the color orange as a trademark. The issue referred to the ECJ was therefore whether a color per se was capable of having distinctiveness with regard to specific goods or services.

The ECJ held, reiterating the Sieckmann requirements, that the registration cannot be accepted. In its reasoning, the ECJ assessed the two requirements for a sign to qualify as a trademark. The ECJ explained firstly that the mere reproduction of the mark consisting of the color orange in a rectangle together with a description of the mark simply as “orange” on a piece of paper is not enough, as such a color sample may damage through the years, therefore not complying with the durability requirement. It affirmed however that a written description of the color does amount to a graphical representation. Secondly, the Court acknowledged that, although color per se has few abilities to convey a precise message to the public, in theory, they could fulfill the “badge of origin” function. To conclude, the Court said that the written description of the color together with a sample of the latter is registrable, provided the other (Sieckmann) requirements are fulfilled. In the same vein, the requirements are met if the color and the relevant shade are described by mean of reference to an international identification code.

In this respect, the OHIM estimates the provision of a color sample obligatory whereas color codes are not mandatory to comply with the Sieckmann requirements as electronic files do not discolor over time. In practice, however, and in order to support the admissibility of the application, reference is made to color codes system (see supra) to represent graphically a color. Following from the latter and as electronic filing (CTM E-Filing) has now become commonplace (79.99%) within the OHIM, it is suggested that such method of application, which permits conveying electronic images, should be generalized for color marks, avoiding the fading issue.

Practically, the Court established that a single undelimited color is registrable as long as it fulfills the formal and substantive requirements for registration. The ECJ’s standpoint is fixed: a single color may function as a trademark if used with respect to goods. Nonetheless, an issue with the registration of a color is that it will face the hurdle that smell, sound and other modern marks face: single color

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62 See supra note 4.

63 See supra note 27, p. 768.
cannot be inherently distinctive and in some cases cannot acquire distinctiveness or secondary meaning through use.\textsuperscript{65}

In other words, except in extraordinary situations,\textsuperscript{66} colors \textit{per se} are registrable in principle only if there is compelling evidence of acquired distinctiveness through use as a marketing tool\textsuperscript{67} and they are widely employed so as to cease to be descriptive\textsuperscript{68} (see \textit{infra}).

Noteworthy and also valid for other NCTMs, the ECJ (both in Libertel and Heidelberger Bauchemie) stressed that attention has to be devoted to the general interest in not excessively restraining the accessibility of colors to competitors.\textsuperscript{69} Indeed, the distinctiveness test envelops the extent to which basic single colors (especially in the fashion industry) and signs in general are likely to be needed/relied upon by other traders (current and prospective) in the normal course of business.\textsuperscript{70} If signs are needed/common, they are \textit{prima facie} registrable. However, if signs are needed/common in the relevant business, their registration would be challenging and their acceptance lead to situations of monopoly and distortion of competition (though this could arguably be said for all trademarks).\textsuperscript{71} Indeed, for undertakings working in a certain type of industry (like robotic industry, see \textit{KUKA infra}), only a small range of colors is available to differentiate wares and services. Hence, granting a monopoly to use a particular color to one trader, i.e. exclusive right preventing others within the same industry to use the protected color, would constitute a restriction of the business' freedom of others companies and would also arguably be against fair competition principle. The latter refers to the color depletion theory\textsuperscript{72} under US law and to a lighter expression of the EU “need to keep free” doctrine.\textsuperscript{73} This notion needs to be taken into account but seems however to be a non-binding factor upon trademark offices which are not compelled to reject an application on the ground that there exists a risk of monopolization of a color or a drastic restriction on its availability in term of forms or variations to other businesses. Furthermore, the aforementioned doctrine, absent from both TMD and CTMR, has not been distinctly declared as being included in EU trademark law and the case-law is not coherent on this issue.

\textsuperscript{65} See supra note 9, p. 189.
\textsuperscript{66} Situations where the applicant has to show that the mark is categorically atypical in regard to particular goods, e.g. where the amount of products is restricted and the pertinent market specific. See supra note 31, Section 7.6.4.2.
\textsuperscript{68} See supra note 28, p. 577.
\textsuperscript{69} Commonly known as the requirement of availability of colors. Par. 54 and 56.
\textsuperscript{70} \textit{The Registrar of Trade Marks v W & G du Cros Ltd} [1913] AC 624, at par. 634 and \textit{American Screw Co’s Application} (TORQ-SET) [1959] RPC 344, at par. 346, where Lloyd Jacob J held that “Part B of the Register is intended to comprise marks which in use can be demonstrated as affording an indication of trade origin without trespassing upon the legitimate freedom of other traders.”
\textsuperscript{71} See supra note 59.
3.2. Combination of colors

Combination of colors does not represent a great challenge for registration and is registrable in a lot of countries. Indeed, the distinctiveness of a TM consisting of two or more colors is readily shown, as there exists a lesser need for other organizations to employ particular multi-colors marks. The requirement of availability of colors is less present here because a monopolization of a color combination does not hinder competitors from using the single colors constituting such a combination.\(^{74}\) Nevertheless, the graphic representation criterion for combination of colors still creates challenges.

In *Heidelberger Bauchemie GmbH’s Trade Mark Application,\(^ {75}\)* the central question referred by the German Bundespatentgericht (Patent Federal Court) to the ECJ was whether colors or combinations of colors formulated in the abstract and contourless are capable to qualify as a trademark and satisfy the conditions for capability of constituting a trade within the meaning of Article 2 of the TMD.

The ECJ reaffirmed that colors (single or combination thereof) in theory may function as trademarks. It further determined two requirements to assess whether undelimited combination of colors may amount to a trademark. Colors or combination of colors are registrable if they firstly depict *de facto* a sign (see *Sieckmann supra*), as colors are generally “simple property of things”, devoid of the ability to transmit any meaning. Also, applicants have to demarcate the scope of the protection sought in order to comply with the precision and durability criteria of the graphic representation. Therefore, the simple juxtaposition of colors in every imaginable way does not amount to a precise graphical representation as such “representations would allow numerous different combinations”.\(^ {76}\) Indeed, as an analogy, protection for a word mark is not secured for all the letters separately but for the letters in combination. It follows that a color mark is not enough precise if it claims to comprise all sort of combinations of color.\(^ {77}\) Secondly, combination of colors is registrable if there exists a “systematic arrangement” for utilizing the colors in a “predetermined and uniform way”\(^ {78}\) in the registration application. The reasoning behind this is that it would be tough to prove distinctiveness if two or more colors are not combined in a particular pattern. Nevertheless, the latter does not involve that contours or any kind of spatial limitation must be used for neither color combination nor color per se.\(^ {79}\)

In other words, applicants should include in their applications a sample of the colors together with a description employing a globally recognized identification code arranged in a systemic and predetermined way in which the colors’ distribution is clear from the graphical depiction and

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\(^{75}\) Case C-49/02, ECJ, June 24 2004.

\(^{76}\) Par. 34 and 35.


\(^{78}\) Par. 1 of the operative part of the judgment.

matches with it.\textsuperscript{80} Still, no clear direction was provided as to the satisfactory extent of systematic arrangement to be reached by applicants.\textsuperscript{81}

### 3.3. Acquired distinctiveness or secondary meaning

Colors’ acquired distinctiveness may be evidenced in several ways as mentioned below. In assessing the distinctive character of a mark, regards have to be given to the \textit{Windsurfing Chiemsee}\textsuperscript{82} case which remains a primary source in which the ECJ laid down some direction relating to the requirements necessary for a showing of a factual distinctiveness of a sign.\textsuperscript{83}

Simply put, a mark becomes distinctive through its use as soon as the mark achieves a point as to identify a ware as coming from a peculiar organization and therefore differentiating it from other organizations’ wares. The Court went on to state that the conditions to register a mark are met provided that the competent authority discovers that an important part\textsuperscript{84} of the relevant public\textsuperscript{85} recognizes goods as emanating from a specific company by reason of the trademark. In this respect, similar to the US Seabrook test of inherent distinctiveness, the perception of marks by the average consumer is of crucial relevance when assessing the ability of signs to serve as trademarks.\textsuperscript{86} Indeed, proof needs to be given that the relevant public has been cultured to identify the origin of the goods/services by inference from the mark \textit{in casu}. The context of the use as well as how the mark has been used must be shown. Evidence criteria of secondary meaning are \textit{inter alia} information about the market share, the advertising and the turnover figures.\textsuperscript{87}

Practically, to register a single color (but also a color combination to a lesser extent), applicants need to strengthen their chances by collecting valuable evidence, maintaining a register of everything, educating the public that the color is the applicant’s trademark, utilizing it in commercials, making sure that the branding and marketing is coherent and precluding other traders from using the color.\textsuperscript{88} Eventually, to prove distinctiveness by use in the marketplace, the most adequate and precise method is to conduct a consumer survey, \textsuperscript{89} whose outcomes mirror a link in the consumer’s spirit between the trademark and the producer. This method obviously lends itself to any other trademark distinctiveness’ assessment \textit{mutatis mutandis}. Nevertheless, proving acquired distinctiveness is

\begin{itemize}
  \item \textsuperscript{80} See supra note 77.
  \item \textsuperscript{82} Joined Cases C-108/97 and C-109/97, ECJ, May 4 1999.
  \item \textsuperscript{84} There is no fixed outcome percentage at EU level to show whether distinctiveness is demonstrated. But by analogy, one would expect a degree of awareness not inferior to 50% (as it is in Germany). For further information, see: Gevers, E., 2008. “To Prove”: Testing the Truth Evidence and Surveys in TM cases, the EU perspective. Available from: http://www.ecta.org/IMG/pdf/gevers_text_1_.pdf.
  \item \textsuperscript{85} As trademark is territorially-based, the relevant public is the one of the country in which distinctiveness of a mark is claimed, so for example the BENELUX or the EU for a BENELUX or EU application respectively.
  \item \textsuperscript{86} \textit{Procter & Gamble Company v OHIM}, Joined Cases C-468/01 P to C-472/01 P, ECJ, April 29 2004, at par. 36.
\end{itemize}
difficult and expensive and has to be done prior the filing date of the application,90 but the Max Planck Institute (MPI)’s study91 proposed that the requirements of registrability and distinctiveness must also exist at the registration date, i.e. post-filing date, secondary meaning should be accepted.92

Finally, it is argued that color marks have overcome the problem that shape marks93 still face: the average consumer is now used to infer origin of a product from its color. Indeed, consumers can differentiate a specific good or service from the color as it is the case of the worldwide famous lilac color (violet) for Milka chocolate94 and the blue color for gas cans.95 Still, the capacity of a specific single color to serve as a trademark needs to be assessed on a cautious case-by-case basis assessment. Recently, the OHIM decided that the red for high-heeled shoes outsoles96 was registrable as that color is distinctive in the sense that it deviates “significantly from the norm or customs of the sector” where outsoles for high-heeled shoes are generally black, brown or beige”.97 However, quite surprisingly, the validity of this color mark is currently being challenged in the USA.98

3.4. Conclusion

Only few cases on the registrability of single colors have been dealt with since Libertel. The EU’s restrictive approach is mirrored by recent cases such as KUKA Roboter GmbH v OHIM99 and Wilo SE v OHIM.100 The former case was seeking in vain the registration of “a shade of orange” for “articulated robots” and the later the registration of green and brown for “cosmetics”, both colors declared to be commonplace in the sector in question by the General Court. In KUKA, the Court brought anew to mind that the requirement of availability of colors is apt to represent and remain an obstacle to color mark registration.

90 Article 3(3) TMD.
92 See supra note 91, p. 79.
93 The ECJ nor the General Court are eager to allow shape marks registration as they are not convinced that the average consumer is actually able to perceive a shape as an indication of origin as some recent rulings show. See Joined Cases C-344/10 P and C-345/10 P, Freixenet SA v OHIM, ECJ, October 20 2011. See also cases T-336/08, T-337/08, T-346/08 and T-395/08 Chocoladefabriken Lindt & Sprüngli AG v OHIM and case T-13/09 August Storck KG v OHIM (shape of a chocolate bell, rabbit, reindeer and mouse).
96 OHIM’s decision in case R2272/2010-2 of 16 June 2011 (Semelle rouge), overruling the judgment of 22 June 2011 of the Court of appeal of Paris Louboutin v Zara, which annulled Louboutin French trademark.
99 Case T-97/08.
100 Cases T-282/09 and T-329/09.
However, a recent failed opposition procedure by Nestlé SA against Cadbury Ltd to register a shade of the color purple in the United Kingdom delivers valuable direction on the accurate manner to register single color. In casu, evidence of “strong market share, intensity and consistency of use of the color with the product, longevity of use and strict branding guidelines for licensees formed the foundations of Cadbury’s case”,\(^\text{101}\) keeping the same spirit as Libertel.\(^\text{102}\) The latter, though not being ground-breaking, demonstrated that if a color is used and if the public is sufficiently aware of it, this color may qualify for trademark protection, whereas acknowledging that the threshold to register a color alone is very high and not easy to satisfy. Indeed, as inherently incapable of distinguishing, numerous and thorough proofs of acquired distinctiveness will be required. The triggering element which set the balance towards Cadbury was the relevant public perception, evidenced through a consumer survey.\(^\text{103}\)

As shown supra, NCTMs face tremendous challenges in acquiring a trademark registration, especially a CTM one. Nonetheless, in a glimmer of hope, the MPI’s study provides for a thoughtful change in relation to acquired distinctiveness for NCTMs. The Institute proposes to reform the CTM system in a way that the assessment of acquired distinctiveness of NCTMs is not done by demonstrating factual distinctiveness separately for each Member State of the EU, as it is presently the case,\(^\text{104}\) but by considering the Union in its wholeness, and not simply as an addition of its Members. Moreover, the principle of unitary rights of the CTM perceiving the EU as one single market is deeply disregarded by such a country-by-country evaluation.\(^\text{105}\)

Eventually, applicants should be as precise as possible to successfully register color marks. They should make sure to comply with all the “seven steps to registration heaven”,\(^\text{106}\) especially with the precision and durability ones. However, all the work to graphically represent the color is done for nothing if the color or color combination is not able to be distinctive.\(^\text{107}\) Nonetheless, even though going beyond its international obligations by allowing registration of single color\(^\text{108}\) and conforming to the US practice, the EU is still reluctant to allow registration for colors and other unconventional marks.

### 4. Sound marks

Sound plays also a deeply significant role into the trademark recognition. Sound is everywhere, sound is present in commercials since the inception of electronic media and sound goes beyond languages.\(^\text{109}\) Indeed, for example, music jingles are frequently used in advertising and consumers do remember such sounds when it comes to buying goods and services (aural/echoic memory).

\(^{101}\) See supra note 88.

\(^{102}\) See supra note 79.

\(^{103}\) See supra note 88.

\(^{104}\) This highlights a huge pitfall of the CTM, which is both a time and money-consuming process to prove prior use from a trader’s perspective.

\(^{105}\) See supra note 91, p. 269.


\(^{108}\) TRIPS, article 15(1) mainly.

According to Kahn, the “sound can immediately convey source-indicating qualities”\(^\text{110}\) and opting for an aural source indicator appears to be a clever business decision. Moreover, to the benefit of traders using it, music is the most influential known type of sound that affects human emotional state,\(^\text{111}\) hence consumers’ behavior and purchase decision-making. Consequently, sounds, as “non-contextual source-identifiers” may not be descriptive and function as trademarks and may be perceived in that way by the average consumer.

Although being nowadays trite in the United States, sound marks in Europe are not. Indeed, as an example, famous and very effective US sound marks are the five-tone audio progression of the notes A B C E D of McDonald, joined with the sequence “ba da ba ba ba”\(^\text{112}\) and the Nokia ringtone, consisting of a classical guitar score\(^\text{113}\) played worldwide 1.8 billion times a day.\(^\text{114}\)

As a comparison, the lion’s roar of Metro-Goldwyn-Mayer has been registered in the US\(^\text{115}\) since 1986 for films, only since 2008 as Community Trademark\(^\text{116}\) and very recently in Canada\(^\text{117}\) (which constitutes a huge change towards registration of sound marks in Canada). Not a lot of sound marks are registered although being approved in those states.

At EU level, the leading case is Shield Mark BV v Kist.\(^\text{118}\) Shield Mark registered successfully \textit{inter alia} the first nine notes of Beethoven’s “Für Elise” and a Dutch-speaking cockcrow as trademarks. Kist infringed upon these marks which pushed the trademark owner to sue him. The depictions of these marks were diverse. Principally, one included a musical stave with the first notes of “Für Elise” and others merely included the words "the first nine notes of Für Elise“ and "Kukelekuuuuu".\(^\text{119}\) The questions raised by the Dutch Supreme Court were whether sounds may be trademarked and if so, whether they were able to be graphically represented and how. The ECJ held that sound signs are not \textit{per se} unfit to distinguish goods and services of one company from those of another and therefore that \textit{article} 2 of the TMD has to be understood as “meaning that sounds may constitute a trade mark, on condition that they may also be represented graphically”.\(^\text{120}\) So, the Court stated that signs embodying sounds or noises may not be refused trademark protection if they pass the distinctiveness and \textit{Sieckmann} test (and on the condition they meet the other administrative requirements).

However, applying the \textit{Sieckmann} criteria \textit{in casu}, the Court affirmed that a written description of a sound is not sufficiently clear or precise and therefore does not render possible to define the scope of the protection being sought. Therefore, the latter did not amount to graphic representation. In relation to the description of a sound merely by an onomatopoeia, the ECJ rules that such a

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\(^{112}\) U.S. Trademark Reg. No. 2939936.

\(^{113}\) U.S. Trademark Reg. No. 3288274.

\(^{114}\) See supra note 111.

\(^{115}\) U.S. Trademark Reg. No. 1395550.

\(^{116}\) CTM 005170113.


\(^{118}\) Case C-283/01, ECJ, November 27 2003.

\(^{119}\) The mark incorporated the onomatopoeia “Kukelekuuuuu,” corresponding to “cock-a-doodle-do” in English.

\(^{120}\) Par. 36 and 37 of the Shield Mark case.
description lacks of precision and clarity, thus failing to be a valid graphic representation, as uncertainty existed as to know if the protection sought was whether for the “onomatopoeia itself, as pronounced, or the actual sound or noise”. In other words, the Court eventually held that music notes on a music score may be registrable whereas an onomatopoeic description of a cockcrow will not.

The Court further stated that the Sieckmann criteria are fulfilled if the representation of a musical tune consists of 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 [sharps, flats and naturals]” and if that representation is a reliable illustration of the sequence of sounds composing the tune.

This case appears to be a victory for the proponents of sensory marks. However, depictions, encompassing musical notes, are only adequate for musical compositions. In so doing, the Court, which did not foresee non-musical sounds in its reasoning limited, in a way, the amount of prospective sound marks. Nevertheless, the high-handed character of this ruling appears to suggest that the guidance provided is comprehensive, valid for all type of sounds. Moreover, it is argued that the ECJ’s hypothesis that a musical score is easily accessible and intelligible is erroneous because it assumes, as a norm that registers’ examiners possess a musical literacy knowledge, which is short even on modern famous songwriters.

As for colors, the main obstacle to register sounds is the graphical representation requirement. Indeed, sounds are invisible and an image is thus incapable to represent them graphically. The most effective manner to illustrate a sound is by a recording, but the article 2 TMD forces candidates to illustrate it graphically as well.

Besides, different manners to comply with the graphic representation for sounds have been developed. These involve, among others, the representations using spectrum, spectrogram, sonogram and oscillogram. However, concerns have emerged as to whether they are too highly technical or not or otherwise accessible and intelligible enough for the public at large.

Until now, there is no ECJ’s ruling which involves the assessment of sonogram or oscillogram as a way of graphical representations of sounds. Nonetheless, since 2005, the OHIM, adopting a more liberal approach, partly fixed the issue of graphic depiction of a sound. It allows the graphic representation of non-musical sound marks by oscillogram or sonogram (provided they are clear

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121 Par. 60 of the judgment.
122 Idem at par. 2 of the operative part of the judgment.
123 See supra note 106, p. 8.
125 See supra note 106, p. 9.
126 See supra note 77, p 12.
enough) together with the attachment of a sound file being the sound itself in case of online applications, thus recognizing such methods as valid. This represents a valuable effort but as the Sieckmann requirements concern all kind of sounds, be it musical or not (noise), this tolerance should extent to every sound marks.

At the International level, sounds may be represented by a musical score, a written description or analog or digital recording of the sound itself, or any association of these. Like at the OHIM, an online application may be accompanied by a digital file of the sound.

While smells and colors are not inherently likely to be recognized by consumers as being employed as a trademark for a specific product (see Sieckmann), sounds, on the other hand, may serve as naturally distinctive source indicators, even though no ruling at the EU level has ascertained whether sounds are considered to be so. It can be argued that sound marks most of the time may acquire distinguishing capability through an intensive and longstanding use which allows the average consumer to memorize them, consciously or not. In this respect, the standards of evidence of factual distinctiveness explained above for colors apply mutatis mutandis to sounds and smells, for which the consumer survey is the most accurate proof (see supra).

In conclusion of this point, it can be said that the EU offers a broader protection going beyond its obligations under the TRIPS Agreement, inasmuch as it does not provide Member States with the possibility to refuse registration based solely on a sign not visually perceivable. Therefore, it can be seen that the EU case-law endorses the reality that sounds, contrasting with smells, may be graphically represented, the best way being by musical notation accompanied by a written description if needed, and may function as trademark if they uniquely identify a particular set of goods or services of one company. In practice, the “shorter, more uncommon and particular a melody, the more distinctiveness it gets”. The OHIM keeps pace with technological advances by allowing an electronic application to be joined by a digital file enclosing the sound itself in addition to the sound’s graphic representation. Sounds thus may be registered, operate as trademarks and deserve protection.

5. Conclusion

Multi-sensorial marketing, emphasizing on the five human senses for commercial purposes, is in full expansion as it leaves on consumer a valuable commercial impression. However, this marketing is

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130 See supra note 31, Part B at section 7.6.1.
132 See supra note 110.
134 Article 15(1), sentence 3 of the TRIPS.
not in pace with the legal practice, where, as demonstrated throughout the present work, the application and registration of NCTMs face great challenges in practice. This work stressed the need for adequacy of the law with technological advances.

As it has been showed, trademarks may consist of unconventional marks such as smells, colors and sounds. However, the criterion to cope with traditional\textsuperscript{137} types of mark, establishing that a mark has to be capable of being graphically represented, critically confines the registration of those modern marks.\textsuperscript{138} In order to comply with the \textit{Sieckmann} requirements, a balance needs to be found. Indeed, the techniques used to depict graphically a mark must be sufficiently specialized but not too highly e.g. chromatography, as these alike methods are likely not to be clear, easily accessible and intelligible enough to the average consumer/trader.\textsuperscript{139}

The barriers to registration for NCTMs may be surmounted by the revision of the rules governing trademarks at the EU level. Indeed, patent laws were modified\textsuperscript{140} in order to help applicants to better disclose an invention by deposing samples of it. By analogy, trademark rules could be adapted to lower the obligation to provide for graphical representations of the mark. In this regards, specimens of colors, scents and tastes may be stored in the trademark offices, renewed on a necessary basis and they may serve as satisfactory alternatives or supplements to the writing description of the mark.\textsuperscript{141}

As stated by Cohen Jehoram et al.,\textsuperscript{142} time will tell us if the ECJ, relying upon the requirements it identified, was not too severe and whether its methodology remains up to date. Arguably, the ECJ was mistaken to analogize the visual representation of a mark as demarcating the subject matter of its protection,\textsuperscript{143} as the trademark in itself is different from what is laid down into the registries.\textsuperscript{144} Ten years after \textit{Sieckmann}, it seems that the ECJ’s approach is outdated,\textsuperscript{145} according to the Max Planck Institute (MPI)’s study,\textsuperscript{146} which goes a step further and suggests the deletion of the graphical representation requirement in EU trademark law,\textsuperscript{147} ending this thorny issue. It is argued that the right attitude to follow should be to drop the graphic representation requirement because ill-advised. This is very likely to lead to the development of more NCTMs,\textsuperscript{148} one of the futures of trademark law. Indeed, as rightly argued by Devaney, the relaxation of this problematic requirement may \textit{prima facie} seem probable to be favorable to modern marks’ registration, but it would not be

\textsuperscript{139} See supra note 53, p. 118.
\textsuperscript{140} It is the case for biological and biotechnological inventions.
\textsuperscript{141} See supra note 6, p. 912.
\textsuperscript{142} See supra note 53, p. 75.
\textsuperscript{143} See supra note 137, p. 405.
\textsuperscript{145} See supra note 91, p. 66.
\textsuperscript{146} See supra note 91.
\textsuperscript{147} See supra note 91, p. 264.
the case in practice (at least not immediately) as a mark still needs to be represented in a certain way and passes the distinctiveness test.\footnote{Devaney, M. 2011. The future for non-traditional trade marks in Europe. Intellectual Property Magazine, June 2011, pp. 32-33.}

It is argued that a progressive change in the OHIM’s registration practices is a necessary evolution of trademark law, supplanting tangible registers in favor of Web-based ones, which eventually would allow smells and other unusual marks to be granted.\footnote{Depo, B. 2008. Protection of unconventional trademarks. Available from: http://amcham.pl/index.php?mod=page&page=6_c_ipc_2008_03_05 [Accessed 25 April 2012].} Indeed, an OHIM lawyer claimed that “as technology moves on we have moved too”.\footnote{Curtis, L., 2007. Outcry over Tarzan’s yell prompts trade mark clarification. Available from: http://www.outlaw.com/page-8657 [Accessed 26 April 2012].} The office has allowed, besides the provision of musical score, the e-filing of sound marks. This could extend similarly to smell marks, where computer-generated smells samples produced with equipment such as “scent dome”\footnote{Knight, W. 2004. Smelly device would liven up web browsing. Available from: http://www.newscientist.com/article/dn4705-smelly-device-would-liven-up-web-browsing.html [Accessed 15 April 2012].} could complete a written description as soon as digital scent technologies become more widespread.\footnote{See supra note 46.}

More generally, as already thought by Bainbridge\footnote{See Bainbridge at supra note 45.} and now partly suggested by the MPI’s study, transformations in the way trademarks are conserved in the registers would benefit unusual marks if computing technologies are employed in order to record these marks reliably, rendering them digitally available and playable upon request of online consultants of registers. This is possible without amending the EU legal framework while updating it undoubtedly.

In the light of the above, it is argued that no valid motive should bar the way to the registration of tomorrow’s conventional marks which are desirable, from the trader, economic and legal perspectives, except inasmuch as the need to keep free doctrine is involved, necessary in order to promote the free competition and movement within the internal market and to preserve the scope of the public domain.\footnote{Kongolo, T., 2011. Intellectual property and misappropriation of the public domain. E.I.P.R., 33(12), pp. 780-794.} But this doctrine falls short in front of the global competition. Therefore, it is suggested that the EU’s restricted approach progressively aligned itself with the US’s liberal practice.

Not explored throughout the present work, the international trademark regime, mainly structured by the TRIPS Agreement (offering an extensive trademark definition focusing on a mark’s distinctive character) and the Paris Convention\footnote{Paris Convention for the Protection of Industrial Property, March, 20 1883 as last revised at Stockholm, July 14, 1967.} (PC), is not providing many answers to the issues raised by modern trademarks to the exception of the recent Singapore Treaty (see infra). One way to register internationally an unconventional mark would not be to comply but to circumvent the graphic depiction criterion by relying on article 6 \textit{quinquies} of the PC. Indeed, pursuant this provision, a trademark registered validly in one country of the Paris Union cannot be refused registration in any other country of the Union, except under specified conditions which do not include the requirement of graphic representation. The latter involves that an undertaking which possesses valid unconventional marks in its country of establishment is entitled to receive the same protection in
other countries, notwithstanding whether the chosen state considers the marks as acceptable according to its own laws. Therefore, the commonly called “telle quelle principle” enshrined in the above article can be used as a “pipeline” to evade restrictive jurisdictions.\textsuperscript{157}

So far, the willingness to allow registration of NCTMs was not global.\textsuperscript{158} Nonetheless, the Singapore Treaty on the Law of Trade Marks, revised rules of which came in force recently, has a promising future for modern marks as it is expected to bring very laudable solutions (especially to the graphical representation issue) in approximating the international community, encompassing the first express hint to unconventional marks.\textsuperscript{159} Still, the road ahead for registration of NCTMs will continue to be a crusade.

6. Limitations and further research

The so-called modern trademarks set lots of questions to numerous jurisdictions in relation to the registration and the protection of those marks. One limitation of the work is that it aims to assess the registrability of NCTMs under the EU framework only, as EU law is virtually identical to the trademark law that must be individually implemented by Member States.\textsuperscript{160} Whereas in other jurisdiction such as the United-States, the registration is quite liberal, therefore less challenging. Indeed, the Supreme Court held that “almost anything at all that is capable of carrying meaning”\textsuperscript{161} is registrable. Or, in India which mainly copied-pasted EU rules.\textsuperscript{162}

As a necessary corollary, the enforcement of such marks poses tremendous challenges.\textsuperscript{163} Indeed, as an example, Pantone system catalogues more than 10,000 colors, whereas the human sight is not able to distinguish all of these shades. So this brings the issues of when and how an infringement does occur. Further research should then focus on that issue and on the more unusual of the unconventional trademarks, such as texture, motion marks and holograms, which are still in their infancy. Also, another challenging area of research is the way sensory marks are treated and monitored on the internet, within virtual reality environment\textsuperscript{164} and virtual world, places where the greatest challenges are to take up in the following years for trade marks’ holders.

\textsuperscript{157} See supra note 27, p. 780.
\textsuperscript{158} Karki, M., 2005. “Nontraditional areas of intellectual property protection: colour, sound, taste, smell, shape, slogan, and trade dress” JIPR, 10(6), p. 500.
\textsuperscript{160} See supra note 6, p. 899.
\textsuperscript{162} See supra note 124, p. 141.
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