

**STANDING COMMITTEE ON THE LAW OF TRADEMARKS,
INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

– NEW TYPES OF MARKS

Document prepared by Sweden

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ANNEX

EXAMPLES OF NEW TYPES OF MARKS

ANNEX

II. SUBJECT MATTER OF PROTECTION

(a) Visible signs

A general complication with regard to graphic representation is that the official version of the Swedish Trademark Gazette (Svensk Varumärkestidning) is still edited in black/white and printed on paper whereas registration certificates are printed in colour and the on line version of the gazette is also in colour. No formal decision has been made to point out the colour web-version as the official one. On principle however, this should not affect the scope or protection and to our knowledge, this potential uncertainty has never been put to trial.

*(i) Three-dimensional marks**Representation of three-dimensional marks*

Applicants have to indicate whether a two-dimensional graphic representation of a three-dimensional object is meant as an application for protection of the object itself (three-dimensional) or a mere two-dimensional figurative mark. If it is deemed necessary, the applicant may be called upon to file the actual three-dimensional object. This is done on a regular basis with the aim of helping the examiner assess the criteria for registration. No other legal effect follows from the filing of the three-dimensional mark itself.

(ii) Colour marks

Single colour marks are generally seen as inherently non-distinctive. Furthermore, the need to keep single colours free from sole rights is mentioned by the European Court of Justice as a factor to take into consideration. One single colour mark has been registered by the Swedish Patent and Registration Office (hereafter SPRO) and this after the applicant had shown that the knowledge of the mark among the public was considerable.

Representation of colour marks

The SPRO applies the principles laid down in the Libertel case (6 May 2003, C-104/01) by the European Court of Justice. Our interpretation of the Libertel case is that some verbal description or reference to the colour is required, but that such reference does not necessarily have to be an international colour code.

Following are the principles stated in the said case:

1. A colour *per se*, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, provided that, *inter alia*, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter

condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.

2. In assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought.

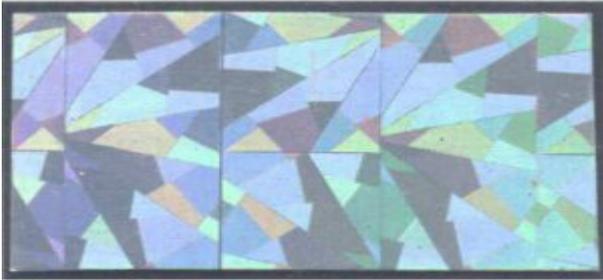
3. A colour *per se* may be found to possess distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service for which registration is sought as originating from a particular undertaking and distinguishing that product or service from those of other undertakings.

4. The fact that registration as a trade mark of a colour *per se* is sought for a large number of goods or services, or for a specific product or service or for a specific group of goods or services, is relevant, together with all the other circumstances of the particular case, to assessing both the distinctive character of the colour in respect of which registration is sought, and whether its registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

5. In assessing whether a trade mark has distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of Directive 89/104, the competent authority for registering trade marks must carry out an examination by reference to the actual situation, taking account of all the circumstances of the case and in particular any use which has been made of the mark.

(iii) *Holograms*

Representation of holograms

Reg/-application No.	Representation of the Mark	Comments
1997/01171	 <p>The representation is supplemented by the following description (translated from Swedish language): the mark consists of a hologram formed as a kaleidoscopic picture varying in colours depending on the light.</p>	Initially, the representation was refused by the Office on the ground of lacking graphic representation. That decision was revoked by the Court of Patent Appeals. The substance matter of the application is still pending before the Office.

In addition to this application, a handful of other hologram marks are valid in Sweden through registration at the Office of Harmonization for the Internal Market. All these registrations are represented in a manner corresponding to the one shown above.

(iv) *Slogans*

Older practice, supported by statements made in the *travail préparatoires* of the current Swedish Trademark Act indicated that distinctive character for slogans required a certain level of “inventiveness” or “whit”. Following the EC trademark directive, later national and European case law has clearly departed from such a notion. As with any word mark, the lexical or associative meaning of a slogan should be tested for distinctive character against the list of goods and services of the mark.

(v) *Titles of films and books*

Titles of films and books are seen as and treated as any other words mark with respect to the test for distinctiveness. According to the Swedish Trademark Act, applications to register distinctive titles and titles subject to copyright protection may be refused on relative grounds. Only the author or the successor of such a person, is entitled to register a trademark containing such a title.

(vi) *Motion or multimedia signs*

Representation of motion or multimedia signs

(vii) *Position marks*

(viii) *Gesture marks*

(b) Non-visible signs

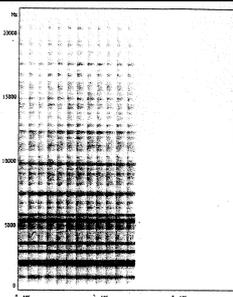
(i) *Sound marks*

Reg/- application No.	Representation of the Mark	Comments
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844076 (IR)

Description of the mark:

Sound mark. The sound is made by a small bell with a stroke frequency of approximately 1 KHz, this acoustic pattern is repeated in different rhythms in six eights and eight eights, respectively, below a likely music type for the trademark is depicted, the mark is notated in six eights and consists of a continuous ringing with six quavers per measure; the ringing of the sound is shown by the spectrogram in which the horizontal axis indicates the time in seconds whereas the vertical axis indicates the frequency spectrum as a function of time, the frequency is quoted in hertz (Hz) and is indicated in the interval 0-20 KHz; when reading the spectrogram a clear stroke frequency of approx, 1 KHz and a first overtone complex of approximately 2 KHz can be seen; the bell has two modes of vibration, which form a dissonance at the first overtone complex (broad band at about 2 and 2.25 KHz with two clear lines), higher overtone complexes are made with frequency variations of the strike note in the form of fractions of the strike note, and together they form the acoustic image of a clear ringing of a bell, which is audible across long distances in the open; as it is the



The SPRO has not yet made any decision with respect to this international registration. The SPRO has to assess whether or not the verbal description added to the image results in a graphic representation which amount to the level of clarity, precision and intelligibility required of the representation, as stated by the European Court of Justice in the Shield Mark decision (27 November 2003, C-283/01).

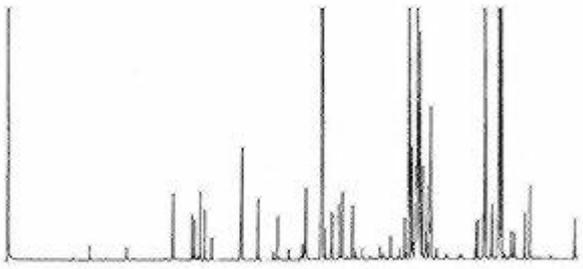
<p>situation for all music types there is a possibility that the performer of the rhythm could phrase the rhythm, thus the music type is not to be strictly interpreted.</p>		
	<p>Score Performance 0:08</p> <p style="text-align: center;">INTEL SPIRAL commercial</p> <p style="text-align: right;">Walter Werzowa BMI</p>  <p>The image shows a musical score for 'INTEL SPIRAL'. It includes staves for SFX, Glocken, Celeste, synth, Bass, and Marimba. The score is in 4/4 time and features various musical notations including notes, rests, and dynamic markings.</p>	

Representation of sounds

Electronic sound files are often attached to applications for registration of sound marks. Such files may be used by examiners when they assess other necessary criteria such as requirements for distinctive character. However, Article 2 of the EC trademark directive contains an absolute requirement of graphic representation. In the "Shield Mark" decision by the European Court of Justice, the court laid down its interpretation of this requirement with respect to sound marks:

- 1. Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that sound signs must be capable of being regarded as trade marks 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.**
 - 2. Article 2 of Directive 89/104 must be interpreted as meaning that a trade mark 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 staff divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.**

(ii) *Olfactory marks*

Reg/-application No.	Representation of the Mark	Comments
1998/00821, 1998/00822		Two applications for registration of scent marks were filed in class 3 for perfumes and bath foam respectively. The marks were represented only by simple gas chromatograms and with no other technical or verbal references. The Swedish Office issued formal office actions giving notice of intended refusal on the grounds that the marks were void of distinctive character for the goods in question. Moreover, the Office held that the attached graphs were not sufficiently clear and unambiguous representations of the applied marks. Following the office action, the applications were abandoned by the applicant.

Representation of olfactory marks

With regard to graphic representation of smell marks, the European Court of Justice, in the Sieckmann case (12 December 2002, C-273/00), gave an interpretation that corresponds to that on sound marks. In addition, the court stated that

2. 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.

(iii) *Taste marks*

(iv) *Texture or feel marks*
