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**METHODS OF REPRESENTATION AND DESCRIPTION
OF NEW TYPES OF MARKS**

Document prepared by the Secretariat

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I. INTRODUCTION

1. At the sixteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from November 13 to 17, 2006, the SCT requested the International Bureau to develop a paper for discussion at its next session, setting out existing methods of representation and description of new types of marks. The paper would identify areas of convergence amongst SCT Members and any other issues, including the possibility of additional costs, particularly in developing countries (see document SCT/16/8, paragraph 9). Accordingly, the Secretariat has prepared the present document, which deals with existing methods of representation and description of new types of marks (Section II), possible areas of convergence (Section III), and other issues, i.e. special considerations on publication and the possibility of additional costs (Section IV).

2. This document is based on the preliminary findings contained in document SCT/16/2 (“New Types of Marks”), which reproduces to a large extent information provided by 73 Member States and 3 intergovernmental organizations in their Replies to the Questionnaire on Trademark Law and Practice (document WIPO/Strad/INF/1). It is also based on information submitted by the following members of the SCT, as agreed at the sixteenth session of the Standing Committee: Australia, Bulgaria, Chile, China, Croatia, Ecuador, Finland, France, Germany, Japan, Moldova, Morocco, Norway, Republic of Korea, Russian Federation, Slovenia, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, United Kingdom, United States of America, the European Community and the Benelux Organization for Intellectual Property (BOIP) on behalf of Belgium, Luxembourg and The Netherlands.

II. EXISTING METHODS OF REPRESENTATION AND DESCRIPTION

3. It is a generally accepted feature of trademark registration procedures around the world that a mark for which registration is sought must be presented to the relevant trademark registration authority. This representation very often takes the form of a graphic representation. However, in certain countries, national laws or regulations may authorize other modes of representation for particular kinds of marks¹.

4. As regards new types of marks, the application for registration must include in general a representation that demonstrates the nature of the mark and shows each feature clearly enough to permit a proper examination. A statement as to the type of mark sought to be registered is usually required² and in most cases a detailed description of the mark.

5. In principle, the form of graphic representation used should allow the average consumer to understand the nature of the mark. Therefore, highly technical descriptions or unusual technical modes of representation would not be acceptable. Descriptions should also allow any person consulting the register to identify the nature and scope of the protection granted to a particular sign.

6. In order to summarize the existing methods of representation and description of new types of marks, this document follows the same structure as document SCT/16/2, entitled “New Types of Marks”, by grouping those marks into visible and non-visible signs and providing a broad sample of means of representation of those signs. Given the rather limited scope of the present document, it should be read together with document SCT/16/2, which provides further explanations on the nature of new types of signs and includes a number of examples thereof.

(a) Visible Signs

(i) *Three-dimensional marks*

7. It appears to be most common to request the applicant to submit a picture or drawing that shows the three dimensional character of the mark³. Some submissions indicate that, a two-dimensional representation of the mark is acceptable, together with an indication that the mark is a three-dimensional sign⁴. According to one submission, a two-dimensional image or several views of the sign are acceptable⁵. Another submission points out that, the reproduction should be in perspective or show the mark from different angles⁶, and in one submission, a flat reproduction of the mark is required⁷.

8. Concerning the number of reproductions, ten reproductions of the three-dimensional mark could be required⁸, or as many representations as are necessary to determine the features and the scope of the mark. These will be published together with the mark⁹.

9. According to some submissions, the reproduction of the mark must consist of one single perspective view. If several perspectives are submitted, they will not be published¹⁰. Perspective views may be requested if according to the Office, there is obscured matter not visible¹¹.

10. The applicant may have to submit a drawing that depicts a single rendition of the mark. If this is not the case, he/she would need to file a petition requesting that the rule be waived. In addition, where the mark comprises the design of only a portion of a product or container, broken lines should be used in the drawing to indicate that portion of the product or container that is not claimed as part of the mark. The matter that is shown in broken (dotted) lines does not have to be disclaimed, because it does not form part of the mark¹².

11. A statement in the application indicating the three-dimensional character of the mark is a common requirement¹³. A written description of the mark may have to be filed as part of the application and must be coherent with the pictorial representation so as to ensure that there is no ambiguity in relation to the scope of the trade mark¹⁴. According to one submission, a written description is required only when the reproduction of the mark is not in itself clear¹⁵. Written descriptions may not be required and where submitted, they are not published¹⁶ together with the mark. More exceptionally, where the Office deems it necessary, it may ask the applicant to file the actual three-dimensional object¹⁷.

(ii) *Color marks*

12. Generally, single color and combinations of color are accepted for registration as trademarks. However, a sign consisting of a color *per se* is not necessarily accepted for registration¹⁸.

13. As to the representation of a color mark, it is often possible to provide a sample of the color on paper¹⁹. Where color combinations are registrable, there could be an additional requirement to include a systematic arrangement associating the colors concerned in a predetermined and uniform way²⁰. Other special requirements may relate to the number²¹ or the size²² of the reproductions.

14. The graphical representation of color marks may be achieved by a pictorial representation of the goods showing the color claimed²³. A description of the color(s) in words is generally required²⁴ and, sometimes, it is specifically required to make an indication or statement to the effect that the sign applied for is a color mark²⁵.

15. The designation of the color sign applied for as a mark or forming part of a mark through an internationally recognized color code may be a formal requirement²⁶, it may be recommended²⁷ or simply allowed²⁸. The applicant may be required to provide a chromatogram in addition to the color code²⁹. However, a reference to such standards may not be demanded, and the choice of industry standard, (e.g., PANTONE[®], RAL[™], Focoltone[®], RGB, etc.) if used, will remain with the applicant³⁰.

(iii) *Holograms*

16. Different views of the hologram to be illustrated from all angles, or a sequence of images revealing the holographic effect as a whole, are a common requirement³¹. The reproduction of a hologram may consist of one or several graphic or photographic representations of the holographic element or elements, excluding the hologram itself³².

17. Where the hologram is constituted by the image of one single object (which does not modify itself), the reproduction may be required to represent this object, either in three dimensions or from different angles. When, following a point of view, the hologram represents several objects or an object which modifies itself, the application form may include reproductions of each one of those objects³³.

18. As to the number of reproductions, it may be necessary to submit as many representations of the hologram as are necessary to show all the features of the mark³⁴, or e.g., ten reproductions of the hologram³⁵. In any event, according to one submission, the applicant must ensure that the hologram does not show different subject matter in the different views³⁶. Otherwise, the application may be refused on the grounds that the applicant is seeking registration of more than one mark in the application.

19. The application for registration may contain a statement or indication to the effect that the sign applied for is a "hologram mark"³⁷. The representation of the hologram mark may sometimes be supplemented with a detailed description. The description serves the purpose of precisely defining the subject matter for which protection is sought³⁸. The Office might ask the applicant to submit a description of the mark, explaining the holographic effect if the representations of the mark are not considered sufficient³⁹.

20. In some cases, hologram marks are published as two-dimensional figurative marks, although with the advent of electronic filing and publication by electronic means, it seems to be possible to publish the hologram with the number of representations and the description submitted by the applicant⁴⁰.

(iv) *Slogans*

21. Slogans are commonly accepted for registration as visible signs. They do not differ from the registration of traditional word marks and do not seem to present problems in terms of graphic representation⁴¹. However, particular requirements have been noted. The applicant may have to indicate the trademark with which the slogan is associated, since its validity is subject to the validity of the mark⁴². The length of a slogan may be limited to a

general rule that a mark must give a uniform and coherent impression. Only signs that can be perceived as a unity may be considered as trademarks. Texts that are too long would not meet this requirement⁴³. An indication of the type of mark may also be required.

(v) *Titles of films and books*

22. Titles of films and books are accepted for registration as traditional marks consisting of words or combinations of words. Their representation does not seem to pose special problems⁴⁴. Nevertheless, specific requirements applied to the registration of these signs as trademarks can be identified. Similarly to slogans, the length of a title could be limited to preserve the unitary nature of the sign⁴⁵. A written authorization from the author of the book or the film may be required to be submitted with the application⁴⁶.

(vi) *Motion or multimedia signs*

23. Marks may consist of or contain elements of motion. Where those signs are accepted for registration as trademarks, two main ways of representing them have been identified. Offices require either a series of selected still images that clearly depict the motion sign⁴⁷ or a short movie that will be deposited together with the application. The movie can be deposited either in a material support (CD or DVD) as an electronic file where electronic means of transmittal are available⁴⁸.

24. The applicant may choose between these two forms of representation⁴⁹, whereas at least one submission indicated that a sample of the motion mark must be filed with the application, in addition to the still pictures⁵⁰. A detailed written description of the mark may often be submitted with the application⁵¹ and specific aspects must be mentioned in the description. The description may specify the chronological order of the images⁵² and the duration, the direction(s) and the frequency of the motion (for example “in a continuous manner”) could also be indicated⁵³.

25. A statement or indication of the type of mark applied for is sometimes required⁵⁴. The number and form of the images to be submitted follows from the practical requirement that the images must be perceivable as a uniform sign when published. Some offices require a specific number of reproductions to be filed or determine the dimensions that the reproduction must cover⁵⁵. One submission noted that if the representation of the motion sign was submitted as a short film, it would be possible to display a film icon on the Office website to make the mark available to the public⁵⁶.

(vii) *Position marks*

26. Position marks are usually treated as figurative marks and most offices require only one reproduction with only one view of the trademark. However, the reproduction of the mark must allow the Office 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 protect⁵⁷. A description defining the location of the sign (e.g. a label, pocket, button, stripe, etc.) in relation to the product will usually be required⁵⁸. Where the description is unambiguous, the mark will be considered as graphically represented⁵⁹. An indication of the type of mark may also be required.

(vii) *Gesture marks*

27. This type of mark may be perceived and treated as another form of figurative or motion mark⁶⁰. In the first instance, representation may be achieved by a single drawing or several frames depicting the gesture, accompanied by a written description. 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 concerned⁶¹. An indication of the type of mark may also be required.

(b) Non-visible Signs

(i) *Sound marks*

28. Sound marks may comprise musical or non-musical sounds. When the trademark consists of a musical sound, musical notation is usually required as graphical representation of the mark⁶². According to one submission, the applicant must have the musical notation certified for accuracy by a competent organization⁶³. Certain Offices, however, consider that musical notation could be a means of representation alternative to a written description or even less accessible to the public than the latter⁶⁴.

29. It should be noted that in European Community countries, following a court decision⁶⁵, it has been established that if musical notation is to serve as graphical representation of a sound mark, the sound must be 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.

30. A written description of the sound may be submitted, in addition to the musical notes or a specimen of the sound. In order to help the public understand the nature of the sign, the description should to the extent possible indicate the notes, instruments, length of the sound, beat/tempo, volume or other characteristics of the sound⁶⁶. It may be required that the applicant submit a written description of the sound indicating the details of the claimed designation⁶⁷.

31. With regard to non-musical sounds, Offices usually require a detailed written description of the sound and in some cases, a sonogram. Several trademarks have been registered by fulfilling these two requirements⁶⁸. Following the above mentioned court decision, European Community countries no longer accept sonograms as suitable representation of non-musical sounds⁶⁹. In addition, 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 public⁷⁰.

32. The indication “sound mark” may be included in the application⁷¹. In some cases, the applicant may be required to attach a recording of the sound mark (either musical or non-musical) on a commonly used audio media, namely cassette or audio CD⁷². The introduction of electronic filing of trademark applications has made it possible to file the reproduction of the sound by using an electronic file such as MP3 or .WAV⁷³. Nevertheless, some Offices do not accept a recording as proper graphical representation of the sound mark⁷⁴.

33. Regarding the publication of sound marks, two submissions suggest publication of the reproduction of the sign by placing a sound icon on the Office Website where the melody or other sound would be made available to the public⁷⁵.

(ii) *Olfactory marks*

34. Olfactory marks have been accepted for registration in some countries⁷⁶ and even though they seem to be one of the less frequently utilized newer forms of registered trademarks, there has been some discussion on the possible means to represent such marks. Notably, one Court has ruled that in the case of smells, graphic representation was not satisfied by a chemical formula, by a description in written words, or by the deposit of an odor sample, or even a combination of those elements⁷⁷.

35. In that case, the competent Court set out the criteria for graphical representation as follows: (a) it must be “precise” in order to define the mark and to determine the scope of protection; (b) it must be “clear” to the authorities and to the public; (c) it must be “self-contained, easily accessible and intelligible” on the Register; (d) it must be “durable” over the lifetime of the registration and (e) it must be “objective” to avoid any doubt in identifying the sign⁷⁸.

36. This ruling has binding character on at least 27 countries and one regional office⁷⁹. The criteria, which bear the name of the applicant in the case, Mr. *Sieckmann*, have proven to be quite influential in other countries as well⁸⁰. Following the “*Sieckmann* criteria”, scent trademarks have become non-registrable or difficult to register in a number of countries, although such registrations had been accepted in the past⁸¹. It seems that to date, a form of graphic representation for scents satisfying the *Sieckmann* criteria has not yet been found in countries where those criteria are applied. Olfactory marks may also be excluded from registration, because national law bars the registration of signs that are not visually perceptible⁸².

37. In contrast to the above, it is conceivable that a written description of the scent would be sufficient to meet the requirements of graphic representation⁸³. According to one submission, where the sign is a purely non-visible sign, a drawing is not required. However, a specimen of the scented product itself should be filed immediately after the application and referencing the serial number of the application⁸⁴. There is a tendency to avoid references to chromatographic techniques or other highly specialized methods of identifying scents as these would not be comprehensible to the ordinary person⁸⁵.

38. Although, in some cases, national law may either explicitly provide for the protection of scent marks or may not exclude it, no scent registrations have yet been granted and 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 offices⁸⁶.

(iii) *Taste marks*

39. Although taste marks have been accepted for registration by some Offices⁸⁷, they seem to be quite exceptional. 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. In European Community countries, the tendency would be to make that determination on the basis of the *Sieckmann* criteria⁸⁸. A national court has recently ruled that even if the indication “the mark consists of the following taste: the artificial flavor of strawberry” could be considered a graphical representation which is accessible and intelligible to the public, it does not, however, fulfill the required criteria of precision and objectivity⁸⁹.

40. According to some submissions, it would seem that a description of the mark in words could be admissible⁹⁰ if other requirements concerning the sign itself are fulfilled. In a recent decision, a national court has ruled that a taste mark was functional but it did not rule out that taste could ever function as a mark⁹¹.

(iv) *Texture or feel marks*

41. Texture, feel or sensory marks are also exceptional and countries where these types of signs are registrable have adopted slightly different solutions to achieve the representation of the sign. According to one submission, the applicant is asked to make a statement as to the type of mark, together with a very detailed description of the sign and a Braille-like sample of the surface touched⁹². In another case, a very detailed description of the mark had to be accompanied by a drawing⁹³.

42. In assessing the suitability of the graphic representation provided by the applicant of any such signs, European Community countries would apply the *Sieckmann* criteria⁹⁴. In a recent decision concerning the handle of a car chair, a national court has held that touch or feel impressions, in general, cannot be represented graphically⁹⁵. On appeal to the highest court of that country, however, this general statement was rejected⁹⁶. According to the latter ruling, it would seem that texture or feel marks might be capable of meeting the general requirements of graphical representation.

III. POSSIBLE AREAS OF CONVERGENCE

(a) Existing International Standards

43. The issue of the representation of new types of marks has been addressed at the international level in the Trademark Law Treaty (TLT) of 1994⁹⁷ and in the Singapore Treaty on the Law of Trademarks of 2006⁹⁸.

44. The relevant provisions of the Trademark Law Treaty (TLT) are reproduced hereunder.

“Article 3
Application

(1) [*Indications or Elements Contained in or Accompanying an Application; Fee*] Any Contracting Party may require that an application contain some or all of the following indications or elements:

[...]

(x) where the applicant wishes to claim color as a distinctive feature of the mark, a statement to that effect as well as the name or names of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color;

(xi) where the mark is a three-dimensional mark, a statement to that effect;

(x) one or more reproductions of the mark;...”

45. Additional details are contained in the Regulations to the TLT, as follows:

“Rule 3
Details Concerning the Application

(1) [...]

(2) [*Number of Reproductions*] (a) [...] (b) Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than five reproductions of the mark in black and white and five reproductions of the mark in color.

(3) [*Reproduction of a Three-Dimensional Mark*] (a) Where, pursuant to Article 3(1)(a)(xi), the application contains a statement to the effect that the mark is a three-dimensional mark, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction.

(b) The reproduction furnished under subparagraph (a) may, at the option of the applicant, consist of one single view of the mark or of several different views of the mark.

(c) Where the Office considers that the reproduction of the mark furnished by the applicant under subparagraph (a) does not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, up to six different views of the mark and/or a description by words of that mark.

(d) Where the Office considers that the different views and/or the description of the mark referred to in subparagraph (c) still do not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, a specimen of the mark...”

46. The Singapore Treaty on the Law of Trademarks (Singapore Treaty) contains similar, although not identical provisions.

“Article 3
Application

(1) [*Indications or Elements Contained in or Accompanying an Application; Fee*] (a) Any Contracting Party may require that an application contain some or all of the following indications or elements:

[...]

(x) Where applicable, a statement, as prescribed in the Regulations, indicating the type of mark as well as any specific requirements applicable to that type of mark;

[...]

(xi) Where applicable, a statement, as prescribed in the Regulations, indicating that the applicant wishes to claim color as a distinctive feature of the mark;”

47. The Regulations to the Singapore Treaty read as follows:

“Rule 3
Details Concerning the Application

[...]

(2) [*Mark Claiming Color*] Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, the Office may require that the application indicate the name or code of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color.

(3) [*Number of Reproductions*] (b) Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark, a Contracting Party may not require more than five reproductions of the mark in black and white and five reproductions of the mark in color.

[...]

(5) [*Hologram Mark, Motion Mark, Color Mark, Position Mark*] Where the application contains a statement to the effect that the mark is a hologram mark, a motion mark, a color mark or a position mark, a Contracting Party may require one or more reproductions of the mark and details concerning the mark, as prescribed in the law of that Contracting Party.”

(6) [*Mark Consisting of a Non-Visible Sign*] Where the application contains a statement to the effect that the mark consists of a non-visible sign, a Contracting Party may require one or more representations of the mark, an indication of the type of mark and details concerning the mark, as prescribed by the law of that Contracting Party.

48. Article 3 in both the TLT 1994 and the Singapore Treaty provides that the list of indications and elements is exhaustive. However, it also contemplates that any Contracting Party *may* (emphasis added) require some or all of those indications and elements. Therefore, it is possible for the Office of any Contracting Party to require a statement to the effect that color is a distinctive feature of the mark or that the mark is a three-dimensional sign in accordance with the TLT 1994. Pursuant to Article 3 of the Singapore Treaty, the applicant may be required to provide a statement concerning the type of mark, which may be a color mark, a three-dimensional mark or any sign that can be registered according to the law of the Contracting Party⁹⁹.

49. It should be noted that under the Singapore Treaty, the possibility to make a statement indicating that the applicant wishes to claim color as a distinctive feature of the mark when portions of the mark are in color has been retained. However, this statement is different from a statement concerning a color *per se* mark, where this type of mark is acceptable according to the law of a Contracting Party.

50. The Regulations under both the TLT 1994 and the Singapore Treaty provide that a statement claiming color as a distinctive feature of the mark would have a consequence on the number of reproductions to be submitted to the Office. In this case, the applicant would have to supply up to ten reproductions of the mark (five in color and five in black and white).

51. During the preparatory work of the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty (i.e., the Singapore Treaty), it was mentioned that the indication of the color or colors claimed in an application may be in words or by reference to a recognized color code, it being understood that applicants are not obliged to provide the indication of an internationally recognized color code¹⁰⁰.

52. In Contracting Parties to both the TLT 1994 and the Singapore Treaty, the representation of a three-dimensional mark shall consist of a two-dimensional graphic or photographic reproduction, and the applicant will have the choice to furnish one single view or several different views of the mark. However, if the Office considers that the reproduction is not sufficient, it may request that the applicant submit up to six different views of the mark and/or a written description of the mark¹⁰¹.

53. These provisions do not impose any obligation on a Contracting Party to the TLT 1994 or the Singapore Treaty as regards the number of views it should publish. A Contracting Party is therefore free to provide that only one view of the three-dimensional mark will be published and, in such a case, it may require that where the applicant furnishes several different views, he or she indicate the view which the Office should publish. If the applicant does not give such an indication, the Office may invite him or her to do so¹⁰².

54. In cases where the Office considers that the particulars of a three-dimensional mark are not sufficiently shown by the representations or the description furnished, it may ask the applicant to submit a specimen of the mark. However, Rule 3(3)(c) and (d) would seem to indicate that the applicant may not spontaneously file a specimen instead of or in addition to the two-dimensional representations of the mark¹⁰³.

55. The Singapore Treaty contains two additional provisions regarding the representation of marks. Rule 3(5) deals with the representation of several visible non-traditional signs such as: holograms, motion, color and position marks and provides that indications as to the number and the form of the required reproductions are left to national law. Equally, Rule 3(6) provides that in the case of a non-visible sign, Contracting Parties are free to determine the form and other details concerning the representation of the mark.

56. It should be noted that the choice of the term “representation” for non-visible signs was intended to cover both the graphic or photographic reproduction of a mark and any other means of representation, for example, descriptions or electronic data files. In particular, where a Contracting Party allows the transmittal of communications by electronic means, other techniques to satisfy the requirements concerning the reproduction may be available¹⁰⁴.

57. As stated above, the provisions of the TLT would have a harmonizing effect on the form and means of representation of three-dimensional marks and color as a feature of the mark among the Contracting Parties of that treaty. The Singapore treaty contains identical provisions as the TLT for those two types of marks. It does not, however, harmonize the representation of hologram, motion, color *per se*, or position marks nor of any of the non-visible signs. In each of these cases, it is possible for the Office to require a statement in the application concerning the type of mark but the requirements concerning the reproduction or representation itself are left to the law of the Contracting Party.

58. On the basis of the summary of national and regional practices presented in Section II, it appears quite clearly that one of the most important hurdles that new types of signs have to face is their capacity to be represented graphically and whether this mandatory requirement may be either replaced or supplemented by other elements.

(b) Requirement of “Graphical” Representation

59. The requirement that a trademark should consist of a sign capable of being represented graphically appears prominently in the replies to the Questionnaire on Trademark Law and Practice (document WIPO/Strad/INF/1)¹⁰⁵. In fact, 62 out of 73 national offices and 2 out of 3 intergovernmental organizations indicated that graphical representation was an element of the definition of a trademark. In the light of the discussions concerning new types of marks, it seems less clear, however, what should be understood by “graphical”.

60. The term “graphical” is normally associated with the idea of a picture or writing which may capture the main features of the mark. This would seem quite suitable for words, names, letters, figurative elements, combinations of color, the shape of goods and their packaging, any combination or those signs, and even numerals. But it may pose certain problems for other types of signs, and in particular, for non-visible signs.

61. Article 15(1) of the WTO Agreement on Trade related Aspects of Intellectual Property Rights (the “TRIPS Agreement”) does not provide for graphic representation. Instead, it provides that “Members may require as a condition for registration that signs be visually perceptible”. Therefore, the TRIPS Agreement allows WTO Members to require the visual perceptibility of a sign as a condition of registration but it does not oblige them to do so. It has been argued that this provision could be interpreted to mean that a sign may be registered whether it can be seen or not, as long as a visually perceptible description of it can be entered in the trademark register so that people can read the register and understand the nature of the mark even if it is not visible¹⁰⁶. However, it does not seem that an authoritative view on this matter currently exists.

62. If the critical determination for a sign to be accepted for registration as a trademark is that the sign functions as an indication of source of the goods and services, there is, according to one submission, no practical need to limit eligible subject matter to only those signs that are visually perceptible. Signs that function as source identifiers to consumers, whether visually perceptible or not, are valuable and deserve protection against misappropriation¹⁰⁷

63. The graphical representation of new types of marks may pose specific challenges but should not be the sole reason for not accepting these marks for registration¹⁰⁸. Existing methods of representation for non-traditional marks in several countries already take the form of a pictorial representation, a written description or a combination of both. This, in combination with a more generalized use of new and cost effective information technologies for trademark registration procedures, may offer new possibilities for the representation of new types of signs¹⁰⁹.

64. One key factor in determining the suitability of any representation of the sign would be that it is clear enough for the public to understand the nature of the mark and that it can be recorded on the registry and published in an appropriately intelligible form so that anyone interested can access the information.

IV. OTHER ISSUES

(a) Special Considerations on Publication

65. The overview of existing methods for representation of non-traditional marks contained in Section II highlights some issues regarding the publication of these signs. Firstly, it is already possible for some offices to make available information regarding applications and registrations via the Internet, in addition to making that information available on paper through a Gazette or other similar publication by the Office. According to the Questionnaire on Trademark Law and Practice, 18 offices publish an application and/or a registration in both the Office Website and the Gazette¹¹⁰.

66. However, the type and extent of the information to be published seems to differ from country to country. The possibilities range from publishing all the images submitted¹¹¹ with the application of a three-dimensional or hologram mark to publishing only one view of the mark even if several views were submitted¹¹². In relation to motion, multimedia signs and also gesture marks when they are represented by still pictures, it has been mentioned that the number of images would be limited to as many as can fit in an A4 sheet when published¹¹³.

67. Where the application of a specific mark requires a statement of the type of mark and/or a description, they may be published as part of the representation. This may be the case of three-dimensional marks, holograms, sound, color, position, motion, multimedia marks, etc. It is less clear how such information will be treated if it is voluntarily submitted by the applicant.

68. The publication of non-visible signs seems to be non-problematic where descriptions of those signs are acceptable as sufficient graphic representation, or where other graphic elements such as musical notation may be provided. In countries that accept the deposit of material supports (CD or DVD) for music or motion signs, an indication could be published that the sound may be available to the public upon request. It has been suggested that in countries which already publish their Gazette on the Internet or make signs otherwise available through that medium, it would be foreseeable to provide a sound or a movie icon where the sound, melody or video clip may be appreciated by the public¹¹⁴.

(b) Possibility of Additional Costs

69. One of the issues that was raised during sixteenth session of the Standing Committee, in connection with the representation and description of new types of marks, was the possibility of additional costs that those types of marks could potentially cause, particularly in developing countries. The following paragraphs look into that issue from the point of view of cost potentially occasioned for trademark registration authorities when confronted with the tasks of examining and publishing applications—and eventually registrations—for new types of marks.

70. As far as visible signs are concerned, this document has identified the following categories of marks: three-dimensional marks, color marks, holograms, slogans, titles of films and books, motion or multimedia signs, position marks and gesture marks. All those signs have in common that there is no debate as to the possibility of reproducing them graphically. With the exception of motion or multimedia signs, they can be reproduced and published in a manner that would not appear to be different from traditional marks, such as

word marks or picture marks, i.e., marks consisting of figurative elements. Concerning motion marks, some methods of reproduction are described in Section II(a)(vi) of this document, such as adding a description to the graphic representation of a number of images showing the “motion” effect of the sign, or the submission of a short film or video clip.

71. It has been noted, for example, that, where three-dimensional marks are technically treated as figurative marks there is no additional cost for the Office¹¹⁵. There could be an additional cost for publication of the paper trademark gazette in color, if it was previously printed in black and white only. One possible way to overcome that problem could be in issuing regular trademark office publications in CD-ROM format, which are quite inexpensive. This could solve the problem of elevated printing costs for color illustrations.

72. Concerning non-visible signs, the document has identified sound marks, olfactory marks, taste marks and texture and feel marks. Although this point remains somehow debated, it could be argued that all those signs can be reproduced in a graphic manner, in which case the above-mentioned considerations concerning additional cost for examination and publication would apply.

73. The overview contained in Section II suggests that, to the extent possible, trademark registration authorities apply the same or similar requirements for the graphic representation of non-traditional marks as they do for all types of marks. The handling of this type of marks, thus, would not seem to necessarily entail costs that are different or additional to costs occasioned by the examination and publication of traditional types of marks¹¹⁶. If specific requirements are needed for the representation of certain types of marks, they follow the principle of accessibility. The use of sophisticated methods of representation is often avoided, as it would not be understandable to the average consumer. This trend is illustrated, for example, by the abolishment of sonograms as means of reproduction for sound marks, as described in Section II(b)(ii).

V. SUMMARY

74. This document attempts to develop in further detail the existing methods of representation and description of new types of marks, on the basis of the preliminary findings contained in document SCT/16/2, with additional information provided by members of the Standing Committee, and where applicable from other sources, such as the Replies to the Questionnaire on Trademark Law and Practice.

75. From the overview contained in Section II of this document, it appeared that certain categories of new types of marks are more frequently applied for registration than others, and thus some common thinking is beginning to emerge around the means of representing such marks. This could be the case for three-dimensional marks, holograms, color and combination of color marks, motion, position and sound marks. The representation of the other more exceptional marks would probably always require a case-by-case assessment.

76. In Section III an attempt was made to look at existing international standards in relation to graphic representation, taking additional guidance from Member State practice, as reflected in the Replies to the Questionnaire and the information made available after the sixteenth session of the SCT. Section IV tried to address issues specifically mentioned by the Standing Committee at its last session.

77. It would follow from the above, that one way in which the Standing Committee could pursue its work in this area would be to take into consideration the provisions already contained in the Trademark Law Treaty and in the Singapore Treaty and to develop the areas that are not covered by those instruments, in relation to the types of marks noted in paragraph 75, second sentence of this document, on the basis of information provided by the members of the SCT.

78. The Standing Committee is invited to consider the present document and express its preference concerning the suggestion contained in paragraph 77.

[End of document]

¹ Submission by the Delegation of Switzerland. Article 10 of the *Ordonnance sur la protection des marques (OPM)* provides that the Federal Institute of Intellectual Property may accept other modes of representation without requiring a legislative change

² Submissions by the Delegations of Germany, Norway, Russian Federation, Slovenia, Switzerland and The former Yugoslav Republic of Macedonia

³ Submissions by the Delegations of Bulgaria, China, Germany, Norway, Republic of Korea, Republic of Moldova, Russian Federation, United Kingdom, United States of America and the European Community

⁴ Submissions by the Delegations of Finland, Sweden and The former Yugoslav Republic of Macedonia

⁵ Submission by the Delegation of Japan

⁶ Submission by the Delegation of Switzerland

⁷ Submission by the Delegation of France

⁸ Submission by the Delegation of Finland

⁹ Submission by the Delegation of Norway

¹⁰ Submissions by the Delegations of Slovenia and the Former Yugoslav Republic of Macedonia.

¹¹ Submission by the Delegation of the United Kingdom

¹² Submissions by the Delegations of Australia and the United States of America

¹³ Submissions by the Delegations of Bulgaria, China, Ecuador, Finland, Germany, Norway, Russian Federation, Slovenia, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, United Kingdom, the United States of America and the Benelux Organization for Intellectual Property

¹⁴ Submissions by the Delegations of Australia, Ecuador, Japan, Russian Federation, the United States of America and the Benelux Organization for Intellectual Property

¹⁵ Submission by the Delegation of the Republic of Korea

¹⁶ Submissions by the Delegations of Norway, Slovenia and the Former Yugoslav Republic of Macedonia.

¹⁷ Submissions by the Delegations of Ecuador and Sweden

¹⁸ Submissions by the Delegations of China and Moldova

¹⁹ Submissions by the Delegations of Australia, China, Finland, Germany, Moldova, Norway, Slovenia, Switzerland, The former Yugoslav Republic of Macedonia, the European Community and the Benelux Organization for Intellectual Property.

²⁰ Submissions by the Delegations of Croatia, Germany and the Benelux Organization for Intellectual Property. In this context, reference has been made to the European Court of Justice (ECJ) decision in *Heidelberger Bauchemie GmbH*, Case 49/02 [2004]

[Endnote continued from previous page]

- 21 Up to 10 reproductions of the sign in Finland
22 Maximum 8 x 8 cm in Switzerland
23 Submissions by the Delegations of Australia, France and the United States of America
24 Submissions by the Delegations of Australia, Croatia, Finland, France, Germany, Moldova,
Sweden, United States of America, European Community and the Benelux Organization for
Intellectual Property.
25 Submissions by the Delegations of China, Finland, Germany, Slovenia, Switzerland, The former
Yugoslav Republic of Macedonia and the Benelux Organization for Intellectual Property
26 Submissions by the Delegations of Finland, Germany, Norway, Switzerland, the United
Kingdom and the Benelux Organization for Intellectual Property
27 Submissions by the Delegations of France and the European Community
28 Submissions by the Delegations of Australia, Moldova and the United States of America
29 Submission by the Delegation of China
30 See document SCT/16/2 at page 5. In this context, reference has been made the ECJ decision in
Libertel Groep v Benelux-Merkenbureau, Case C-104/01 [2003]
31 Submissions by the Delegations of Germany, Republic of Moldova and the United Kingdom
32 Submission by the Delegation of France
33 Submission by the Delegation of Switzerland
34 Submission by the Delegation of Norway
35 Submission by the Delegation of Finland
36 Submission by the Delegation of the United States of America
37 Submissions by the Delegations of Finland, Germany, Switzerland and the Benelux
Organization for Intellectual Property
38 Submission by the Delegations of Germany, Republic of Moldova and Sweden
39 Submission by the Delegation of Norway
40 Submissions by the Delegations of Croatia and Norway
41 Submissions by the Delegations of Finland, France, Slovenia, The former Yugoslav Republic of
Macedonia and the United Kingdom
42 Submission by the Delegation of Ecuador
43 Submission by the Delegation of Germany
44 Submissions by the Delegations of Finland, France, Slovenia, Sweden, The former Yugoslav
Republic of Macedonia and the United Kingdom
45 Submission by the Delegation of Germany
46 Submissions by the Delegations of Ecuador, Finland, Republic of Moldova, and Sweden
47 Submissions by the Delegations of Australia, Finland, Germany, Norway, Switzerland, United
Kingdom and the United States of America
48 Submissions by the Delegations of Australia, Finland and Norway
49 Submissions by the Delegations of Australia and Norway
50 Submission by the Delegation of Finland
51 Submissions by the Delegations of Australia, Finland, Germany, Norway, Switzerland, United
Kingdom and the United States of America
52 Submission by the Delegation of Germany
53 Submission by the Delegation of Switzerland
54 Submission by the Delegations of Finland, Germany, Switzerland and the Benelux Organization
for Intellectual Property
55 Submission by the Delegations of Germany and the United States of America
56 Submission by the Delegation of Norway
57 Submissions by the Delegations of Germany, Norway, Republic of Moldova and Switzerland
58 Submissions by the Delegations of Germany, Norway, Republic of Moldova, Switzerland and
the United States of America
59 Submission by the Delegation of the United Kingdom
60 See document SCT/16/2, p. 8
61 Submissions by the Delegations of Norway, Republic of Moldova and the United Kingdom

[Endnote continued on next page]

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- 62 Submissions by the Delegations of Bulgaria, Chile, Croatia, France, Germany, Morocco,
Republic of Moldova, Slovenia, Sweden, Switzerland, United Kingdom, Benelux Organization
for Intellectual Property and the European Community
- 63 Submission by the Delegation of Ecuador
- 64 Submissions by the Delegations of Australia, Finland, Norway and the United States of America
- 65 Reference has been made to the ECJ decision in *Shield Mark BV v Joost Kist Hodn Memex*,
Case 283/01 [2003]
- 66 Submissions by the Delegations of Australia, Germany, Norway and the United States of
America
- 67 Submission by the Delegation of the Russian Federation and the Benelux Organization for
Intellectual Property
- 68 Submissions by the Delegations of Finland, France and Slovenia
- 69 *Shield Mark BV v Joost Kist Hodn Memex*, *op cit.*, note 65
- 70 Submission by the Delegation of Switzerland
- 71 Submissions by the Delegations of Finland, Germany, Slovenia, Switzerland and the Benelux
Organization for Intellectual Property
- 72 Submissions by the Delegations of Chile, Ecuador, Finland, Germany, Slovenia and the Russian
Federation
- 73 Submissions by the Delegations of Australia, Norway, Sweden and the United States of
America
- 74 Submissions by the Delegations of Italy and the Benelux Organization for Intellectual Property
- 75 Submissions by the Delegations of Chile and Norway
- 76 See document SCT/16/2, p. 9, paragraph 47 and end notes 48 and 49
- 77 Reference is made to the ECJ decision in *Ralf Sieckmann v Deutsches Patent-und Markenamt*,
Case C-273/00 [2002] E.C.R. I-1137, final ruling
- 78 *Ibid*, at paragraph 55
- 79 The Member States of the European Union and the Office for Harmonization in the Internal
Market (Trade Marks and Designs) (OHIM)
- 80 Submissions by the Delegations of Norway and Switzerland
- 81 Submissions by the Delegations of Croatia, France, Germany, Sweden, the United Kingdom, the
European Community and the Benelux Organization for Intellectual Property
- 82 Submission by the Delegation of the Republic of Moldova
- 83 Submissions by the Delegations of Australia and Norway
- 84 Submission by the Delegation of the United States of America
- 85 Submissions by the Delegations of Australia and Sweden
- 86 Submissions by the Delegations of Ecuador, Morocco and Switzerland
- 87 See document SCT/16/2, page 10 and end note 56
- 88 Submission by the Delegation of the United Kingdom
- 89 Decision of the Court of Appeals of Paris in the Case *Eli Lilly and Co. v National Institute of
Industrial Property of France (INPI)*, Case No. 2003/02153, October 3, 2003, as stated in the
Submission by the Delegation of France
- 90 Submissions by the Delegations of Norway and the United States of America
- 91 Decision of the Trademark Trial and Appeal Board of the United States Patent and Trademark
Office in the US Trademark Application No. 76,467,774 “Orange flavor for quick dissolve
pharmaceutical tablets, by N.V. Organon, as stated in the Submission by Delegation of the
United States of America
- 92 See document SCT/16/2, p 11, paragraph 55 and end note 60
- 93 “The velvet textured covering on the surface of a bottle of wine”, US Trademark Registration
No. 3,155,702, American Wholesale Wine & Spirits, Inc., as stated in the Submission by the
Delegation of the United States of America
- 94 Submissions by the Delegations of Croatia and the United Kingdom
- 95 Decision of the German Federal Patent Court, published in *Gewerblicher Rechtsschutz und
Urheberrecht* 2005, p 770, as stated in the Submission by the Delegation of Germany

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[Endnote continued from previous page]

- 96 Decision of the German Federal Court of Justice (*Bundesgerichtshof*), decision I ZB 73/05, October 5, 2006, as states in the Submission by the Delegation of Germany
- 97 The TLT was done at Geneva on October 27, 1994 and entered into force on August 1, 1996. The list of Contracting Parties to the TLT may be viewed at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=5
- 98 The Singapore Treaty was done at Singapore on March 27, 2006 and it was concluded by the Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty. It has not entered into force, but the list of Signatories to the Singapore Treaty may be viewed at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=30
- 99 See Article 2(1) of the Singapore Treaty
- 100 Reference is made to Note R3.02 contained in document TLT/R/DC/5 “Notes on the Basic Proposal for a Revised Trademark Law Treaty and Regulations Thereunder”. See http://www.wipo.int/meetings/en/details.jsp?meeting_id=6982, p.26
- 101 Reference is made to Notes R3.06 to R3.08 contained in document TLT/DC/5 “Notes on the Basic Proposal for the Treaty and the Regulations” published in the Records of the Diplomatic Conference for the Conclusion of the Trademark Law Treaty, Geneva 1994, WIPO Publication No. 347(E), pp. 251 and 252 and also Notes R3.07 to R3.09 contained in document TLT/R/DC/5, *op cit.* note 34, pp. 26 and 27
- 102 *Ibid.*
- 103 *Ibid.*
- 104 Reference is made to Note R3.07, final part, *op cit.* note 34, p. 26
- 105 Summary of Replies to the Questionnaire on Trademark Law and Practice (SCT/11/6), document WIPO/Strad/INF/1, pp. 6 and 7, at <<http://www.wipo.int/sct/en/meetings>>
- 106 “Trademark Law, A Practical Anatomy”, Jeremy Phillips, Oxford University Press, 2003, paragraph 426, p. 65
- 107 Submission by the Delegation of the United States of America
- 108 *Ibid*
- 109 Submissions by the Delegations of Norway, Sweden, the United States of America and the European Community
- 110 Summary of Replies to the Questionnaire, *op.cit.* pp. 91 and 92
- 111 Submission by the Delegation of Norway
- 112 Submissions by the Delegations of Croatia, Slovenia and The former Yugoslav Republic of Macedonia
- 113 Submission by the Delegation of Germany
- 114 Submission by the Delegation of Norway
- 115 Submissions by the Delegations of Slovenia and The former Yugoslav Republic of Macedonia
- 116 Submission by the Delegation of Morocco