

Existing Methods of Representation and Description of New Types of Marks or Non-Traditional Marks

Background

Under Australian law, a trade mark is defined as a sign which *“includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent”*. This expressly provides for registration of *“shape, colour, sound or scent”* as a trade mark and in view of its non-exhaustive nature also allows for the possibility of a trade mark being formed in other ways.

Importantly, however it is also a requirement that a trade mark must be represented graphically so if this is not possible it cannot be considered for registration.

Representations must clearly demonstrate the nature of the mark and show each feature clearly enough to permit proper examination. When a trade mark contains or consists of a sign that is a colour, scent, shape, sound or an aspect of packaging or any combination of those features, the application for registration must include a concise and accurate description of the trade mark. The description is entered as an endorsement on the registration.

Existing methods of graphic representation for non-traditional marks typically take the form of a pictorial representation, a written description or a combination of both and must allow the ordinary purchaser to comprehend what is being claimed as a trade mark. In view of this highly technical descriptions will not be acceptable.

The form of graphic representation utilised will depend on the particular type of mark being sought, but in all cases the intent is for the trade mark to be described sufficiently clearly to enable a person inspecting the Register to identify the nature and scope of protection.

The written description that forms part of the graphic representation is not a mere formality but an essential part of the identity of the trade mark and so its wording must be considered carefully.

In those cases where both pictorial representations and written descriptions are appropriate, the written description should refer to the specific pictorial representations appearing in the application to ensure the scope of the claim is as clear as possible.

Requirements for Specific Types of Non Traditional Marks

Shape

Requirements for graphic representation can be met by providing a pictorial representation in conjunction with a written description.

The pictorial representation will need to clearly show all features of the mark. This is usually best achieved by providing different views or perspectives, e.g. if the mark is a three dimensional bottle device, views from the back, front, top and bottom may be appropriate.

In some cases a simple written description such as *“The trade mark consists of the shape of a bottle as shown in the representations attached to the application form”* will suffice. In other cases a more detailed written description may be necessary to ensure that the nature of what is being claimed as a trade mark is clear and unambiguous.

If the shape claimed as a trade mark is normally attached to, or part of another article when in use, a representation of the article as a whole should be included in the application with the material being claimed as a trade mark represented in solid lines and the other material represented in dotted lines. The distinction between what is being claimed as a trade mark and what is not, should be clearly indicated in the written description.

The combination of representation and written description should identify the trade mark and the written description should refer back to the representation on the application form to ensure that there is no ambiguity in relation to the scope of the trade mark.

Colour

Graphic representation for colour marks will need to include a clear indication of the colour being claimed and a written description outlining how the colour applies to the goods or services covered by the application. This can be achieved in a number of ways including:

(1) A pictorial representation of the goods/services showing the colour claimed in conjunction with an appropriate written description. E.g if the mark is the colour GREEN applied to a bottle cap, a representation of the bottle cap in the particular shade of green being claimed could form the pictorial element of the mark. An appropriate accompanying written description would read *“The trade mark consists of the colour GREEN applied to the cap of a bottle as shown in the representations attached to the application form”*.

(2) Another method of graphically representing the bottle cap mark described above would be to provide a line drawing of the bottle cap, a swatch of colour identifying the particular shade of green forming the basis of the mark and an explanatory description. An appropriate written description would read *“The trade mark consists of the colour GREEN as represented in the swatch of colour on the application form when applied to the cap of a bottle as shown in the representation attached to the application form”*.

(3) It would also be possible to make reference to a recognised colour matching system to further clarify the exact nature of the colour being claimed e.g. *“The trade mark consists of the colour GREEN, specifically identified as Pantone PMS 348C, applied to the cap of a bottle as shown in the representation attached to the application form”*.

It should be noted that although references to colour matching systems are acceptable they are not required.

Sound

All applications for sound trade marks must be accompanied by a recorded representation of the sound which is made available on request to members of the public.

The requirement for graphic representation can be met by providing a written description of the sound or (in the case of a piece of music) its equivalent in musical notation.

As is the case for other non-traditional marks, the written description and the recorded representations should together identify the scope and nature of the trade mark.

An example of a description that meets requirements for graphic representation is:

“The trade mark consists of a tapping sound made by a wooden stick tapping on a metal garbage can lid at intervals of 2 seconds for approximately 14 seconds duration. The sound is demonstrated in the recordings accompanying the application”.

Scent

A simple description of the scent will be sufficient to meet requirements for graphic representation e.g. *“The scent of apple blossoms applied to plastic storage boxes”*.

References to chromatographic techniques or other highly specialised methods of identifying scents are not acceptable as these are unlikely to be comprehensible to the ordinary person.

Scent is one of the least utilised of the newer forms of trade mark protection and there are currently no registered scent trade marks in Australia.

Moving Images

Recently there have been a few applications for moving rather than stationary images e.g. the movements of a cartoon character as shown in a short movie of 10 seconds duration. For such a trade mark there are two ways of meeting graphic representation requirements.

(1) Provision of a short movie showing the cartoon character moving, accompanied by a still from the movie showing the cartoon character in a typical pose. A written description outlining the nature of the character and describing its movement would also be required.

(2) Alternatively the graphic representation could be formed from a series of stills from the movie and a step by step explanation of the movement the character undertakes in conjunction with a written description. In this scenario the movie would not form part of the graphic representation.