

## **Application of Established Trade Mark Principles to 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.

There are no separate criteria for assessing the registrability of non-traditional marks. The broad criteria laid down by existing authorities under the Trade Marks Act on how to assess a standard mark is equally applicable to non-traditional marks.

Under Australian law a trade mark must be capable of distinguishing the goods or services of one undertaking from those of another. This equates to the concept of distinctiveness.

The question of capacity to distinguish surrounds the degree to which other traders are likely to need to use the sign in the ordinary course of their business without improper motive. If other traders are unlikely to need to use a sign (i.e. it is not common to the trade, functional or otherwise required by others), it is likely to be acceptable.

### **Discussion of Specific Types of Non Traditional Marks**

#### **Shape**

Shape marks should not be objected to on the general basis that the public needs to be educated to see them as trade marks. Distinctive shapes are capable of functioning as trade marks and it is not appropriate to object *prima facie* that a shape is not a trade mark now that the legislation specifically recognizes them.

The question of whether a shape actually functions in the marketplace as a trade mark has no place in the initial examination of a trade mark. The ability of a shape to function as a trade mark will only be of issue if objections on the basis of a lack of capacity to distinguish have been substantiated and the applicant is seeking to overcome these through evidence of use.

**Common to the trade** - A shape is likely to be legitimately needed by other traders if it is commonplace for the goods in question. This conclusion should only be reached after appropriate

research reveals that the shape, or a minor variation of it, is commonly used in the relevant market.

**Functionality** - If a shape has significant functional features, there is a high likelihood that other traders will need to use the shape for their similar goods. A shape is likely to be functional if:

- it is a shape essential to the use or purpose of the article
- it is a shape needed to achieve a technical result
- it is a shape which has an engineering advantage, resulting in superior performance
- the shape results from a comparatively simple, cheap method of manufacture

The presence of functional features is not always fatal to an application. In some cases the get-up of a mark may be sufficient to allow for acceptance where it is obvious that the applicant is not seeking or gaining rights in functional aspects. If the trade mark is something extra which has been added to the inherent form of the goods, this will weigh in favour of acceptability.

In other cases, there may be so many better ways of achieving the same technical result that the functional aspects will be of limited concern.

Sometimes a functional feature may be associated with an engineering advantage that has yet to become commonplace but nevertheless because of its utility should remain open for all to use. In these cases objections are appropriate (eg new invention for opening a bottle that is easier to use than existing types but has not yet become popular).

**Aesthetics** - The fact that a shape is attractive or aesthetically pleasing is not a reason for objection. It is possible for any trade mark including a shape to be an indicator of source as well as be aesthetically pleasing.

However it should be noted that in some cases it could be the aesthetic element that is common to the trade and on which an objection will be properly based. (e.g. glass figurine incorporating the shape of a flower).

Aesthetics should play no part in a consideration of whether a shape is functional.

**Invention** - Invented shapes should be treated like invented words and are equally entitled to *prima facie* acceptance.

The question of what amounts to invention is still a difficult one. In some trades it may be difficult to "invent" a shape. For instance "toys in class 28" where many imaginable shapes are already part of the commonplace. In this class it is unlikely that a simple shape such as a "bear" or "tractor" will be registrable unless there is considerable additional get up of the sort not normally found in the market place (this would mirror practice for device marks).

In other cases a shape will be unusual enough to be viewed as uncommon in the trade and therefore be *prima facie* acceptable (eg lighthouse shaped rubbish container).

If a mark is registrable as an invented device in a two dimensional form, this may tend to support a case for registration in its three dimensional form.

### **Colour**

Colours which are common to the trade or otherwise required for use by other traders in the ordinary course of their business will be difficult to register. Other colours or colour schemes which are not typical of the product in question may be *prima facie* acceptable.

**Single colours** – a single colour applied to the surface of goods that are normally coloured will be regarded as lacking in distinctiveness since there is a high likelihood of other traders needing to use that colour in the ordinary course of their business e.g. the colour YELLOW applied to a lampshade. Such a colour will only be acceptable on submission of convincing evidence of factual distinctiveness.

**Combinations of colour** – combinations of colour are easier to register than single colours as there is generally less of a competitive need for traders to use specific colour combinations – especially if those combinations are memorable. The more complex or invented the colour scheme, the stronger the potential for registration. However the prospects for registrability will depend on the nature of the colour combination and the particular goods in question. If the goods normally feature ornate, coloured patterns, even a combination of a number of colours may be problematic e.g. an ornamental vase could be expected to be commercially available in a myriad of colour schemes and patterns. In such a case evidence of acquired distinctiveness may be necessary.

**Functionality** - there are a number of scenarios where a colour or colour combination may be regarded as "functional" and therefore lacking in distinctiveness.

**Colours providing a particular technical result** – if a colour serves to provide a particular technical result for the goods concerned it will be considered functional and *prima facie* not acceptable e.g. the colour SILVER is known for its heat and light reflecting properties and so is the colour of choice for manufacturers of building, insulation sheeting. No one trader should be able to obtain a monopoly in a colour that other traders are commonly using and objections to registration will therefore be strong.

**Colours conveying a particular meaning** – some colours have developed generally accepted meanings in particular trades and therefore are unlikely to be able to distinguish the goods of any one trader from another e.g. the colour RED is commonly used on fire extinguishers and would therefore be difficult to register in relation to “fire fighting equipment”.

**Colours which are the natural colour of the goods** – many products are marketed in the colour of the naturally occurring material from which they are made. Such colours are the obvious colours for the relevant goods and will not be able to distinguish one traders products from those of another e.g. house bricks in BROWN being the natural colour of the clay they contain.

## **Sound**

Sounds which are “functional” or common to the trade are difficult to register.

A functional sound could be one caused by the normal operation of a piece of equipment or machinery and would not be considered distinctive of that product e.g. the sound of a chainsaw motor would not be registrable in relation to “chainsaws” without evidence of factual distinctiveness.

Other sounds that could be regarded as common to the trade and required by other traders include the sound of glass breaking in relation to “windscreen repair services” or well known classical music pieces in relation to “dancing tuition” services.

However many sounds have no particular descriptive relationship with the proposed goods or services and so would be considered *prima facie* acceptable e.g. the sound of a “wolf howling” in relation to “alcoholic beverages”.

## **Scent**

Scents which are the natural scent of a product or are otherwise common to the trade are likely to be needed by other traders and are difficult to register e.g. the scent of “vanilla” - a normal ingredient in many food products, would not be registrable for “confectionery” .

Scents normally applied as masking agents in products are also lacking in distinctiveness e.g. the scent of “pine” in relation to disinfectants and the scent of “lemon” in relation to “dishwashing liquid”.

However the application of a scent to a product not normally scented has considerably more potential to be registrable.