

Submission from the Norwegian Patent Office relating to new types of marks

Here follows an overview of different types of non-traditional marks, some information on whether we accept such marks or not, the requirement of representation and on our examination of these marks.

1 VISIBLE SIGNS:

1.1 Three-dimensional marks:

The Norwegian practice:

We accept three-dimensional marks for registration and have registered a substantial number of such marks.

Requirement of graphical representation:

We require that the applicant submit a graphical representation of the mark which will enable us to examine the mark in its three-dimensional form. The number of representations depends on the mark; we need as many representations as necessary to clearly show all features of the mark and what the applicant seeks an exclusive right to.

An indication that the mark is a three-dimensional sign should be included in the application

We do not require that the applicant submit a description of the mark.

The examination of such marks:

This is a trademark, which in certain cases should be given legal protection by being registered as design or patent, rather than trademark. We rarely refuse a mark on the ground of descriptiveness. Such marks will more often be refused on the ground of lacking distinctiveness, the principle of functionality, and the need to keep certain signs free and available for general use.

What we require is that the mark “departs significantly from the norm or customs”, cf. C-473/01 and C-474/01, Proctor & Gamble (paragraph 37).

We accept the shape of a product and product packaging for registration as three-dimensional marks. In any event, the mark has to be distinctive and capable of being represented graphically.

The principle of functionality is an important principle in our evaluation of such marks. We will refuse registration of a product shape if it consists exclusively of a shape that is necessary to obtain a technical result. It is generally established that product shapes cannot be registered as trademarks if they result exclusively from the nature of the goods themselves

We will also refuse registration of a product shape if it solely serves the purpose of giving substantial value to the goods.

With regard to product packaging and containers, the shape of the packaging for substances which have no inherent shape of their own, such as liquids and powders, will in our practice be assimilated to the shape of the goods and thus be subject to the same tests (functionality, distinctiveness and descriptiveness). An attractive aesthetic appearance will not in itself be sufficient to enable the public to perceive the mark as an identification of origin.

If a mark is refused by the office, the applicant has the possibility to show the office that the mark has acquired distinctiveness by use. Evidence could for example be invoices, delivery slips, order slips, bills, receipts, account books, pamphlets, printed matter (newspaper clippings, magazines, catalogues, leaflets), share of the relevant market, how much is used on marketing, etc.

Publication:

The mark is published in our electronic weekly Gazette on the Internet with the number of representations submitted.

1.2 Colour marks

The Norwegian practice:

We accept colour marks for registration, but have only registered a small number of marks stating colour per se.

Requirement of graphical representation:

We require that the applicant submit a representation of the colour with the indication of the specific colour, for example the colour code (PANTONE® or other international colour system). Our practice follows the decisions regarding the cases Libertel and Heidelberg.

The examination of such marks:

Colour marks have a limited inherent capacity for distinguishing goods or services. There is a general need to keep the basic colours available for use by all market participants. As a general rule in the office, we require that the applicant show that the colour mark has acquired distinctiveness by use. This means the list of goods or services most often will be quite limited. With the requirement of acquired distinctiveness, it will be difficult to register a colour mark consisting of a basic colour.

Publication:

The mark is published in our electronic weekly Gazette on the Internet with the representation of the colour mark together with the indication of the colour code.

1.3 Holograms:

The Norwegian practice:

We have received only a very few applications for holograms.

Requirement of graphical representation:

The requirement will be the same as for three-dimensional marks. The applicant needs to submit as many representations of the hologram as necessary to show all features of the mark.

Depending on the representations of the mark submitted, the office might require that the applicant also submit a description of the mark, describing the effect of the hologram.

However, before electronic filing of applications with scanning of marks, we have registered a mark sought as a hologram. But with paper copies of the mark submitted to the office, the mark looks like a two-dimensional mark (figurative mark) and not as a hologram.

The examination of such marks:

An ordinary assessment will be carried out, to see whether the mark is registrable or not.

Publication:

The mark is published in our electronic weekly Gazette on the Internet with the number of representations submitted, and with a description of the hologram if submitted.

For discussion:

We would be interested in a discussion with the member States on what kind of representations of the mark they require for holograms.

1.4 Slogans:

The Norwegian practice:

We accept such marks for registration and have registered a substantial number of slogans.

Requirement of graphical representation:

The applicant needs to submit a representation of the mark.

The examination of such marks:

The question is whether general statements or common appreciative expressions fulfil the essential function, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user. Some times we find this not to be the case. It is also a question if someone running a business should obtain the exclusive right to make such statements or expressions, cf. the need to keep certain signs free and available for use. As a

guideline, the mark will not be registered if the mark indicate kind, quality, or consist of an ordinary statement. Our practice is in accordance with the statement in Case C-64/02, DAS PRINZIP DER BEQUEMLICHKEIT, see paragraph 35: "That could be the case in particular if it were established, when assessing the distinctiveness of the trade mark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as a trade mark, namely that of guaranteeing the origin of the product. Indeed, in such a case, the authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans".

Publication:

The mark is published in our electronic weekly Gazette on the Internet as a word mark.

1.5 Titles of films and books:

The Norwegian practice:

We do not accept such marks for registration if they are perceived as a distinguishing title.

Requirement of graphical representation:

The applicant needs to submit a representation of the mark.

The examination of such marks:

In the case of a distinguishing title of the protected artistic, literary or musical work, the office will have to consider whether the trademark is liable to be understood as the distinguishing title which is protected.

The significant question in this examination is whether the title is a distinguishing title when it is assessed in connection with the relevant goods and services. It is sufficient that the mark "includes" anything liable to be understood as the distinguishing title. The mark will consequently be refused even if it has other distinctive elements, but we will look at the list of goods compared to the type of protected copyright work as well as its contents. If the mark is not liable to be understood as the distinguishing title, the mark will undergo a normal assessment of distinctiveness.

The office does not ex officio conduct a thorough examination to see whether an applied for trademark actually can be protected by the copyright system or not. If it is famous, the examiner will know, and can refuse trademark registration if the applicant is not the owner of the copyright.

We have had a few cases in the office where the applied for mark has been, but no longer is protected by copyright, and where the applicant is not the owner – and not related to the owner – of the expired copyright. Our policy is to keep such terms or words free for the public for goods and services related to the cultural aspect. For example the term "Peer Gynt", which is the name of a famous Henrik Ibsen play, was sought as a trademark for a wide range of

goods in Class 9 and 16 (CD, DVD, books, etc) and for services in Class 41 (services in relation to theatre plays, movies, concerts, etc). Goods and services with no relation to the cultural aspect, for example for cars or shoes, will be subject to trademark registration.

Publication:

The mark is published in our electronic weekly Gazette on the Internet as a word/figurative mark; depending whether it appears as a word mark or a figurative mark.

1.6 Motion or multimedia signs:

The Norwegian practice:

We accept such marks for registration, and so far we have only received one application for a moving image mark, which is still under examination.

Requirement of graphical representation:

The applicants need to submit a representation of the mark. It will be the choice of the applicant whether he submits an electronic file showing the moving mark/motion mark, or still pictures showing the motion. The applicant will also have to submit a description of the mark in words, describing the motion.

The office would prefer the electronic file, because it will be in our register, we can publish it in our electronic weekly Gazette on the Internet if it is registered, and it will be easier for the public and for third parties to understand what the mark is.

The examination of such marks:

An ordinary assessment will be carried out, to see whether the mark is registrable or not.

Publication:

Since we haven't registered any such marks yet, the thought is that the mark will be published in our electronic weekly Gazette on the Internet with the description of the mark and with a film icon on our website to click on to see the motion mark.

1.7 Position and Gesture marks:

The Norwegian practice:

We accept such marks for registration. We have registered some position marks, for example in the form of a "shape of jeans pockets". We have not received any application for registration of gesture marks yet.

Requirement of graphical representation:

The applicant needs to submit a representation of the mark.

An ordinary assessment will be carried out, to see whether the mark is registrable or not.

The position marks we have received in the office have been figurative marks. We only require one representation of the mark.

The marks we have received and registered, have not been identified in our weekly Gazette on the Internet as position marks, only as figurative marks.

Depending on the mark, the office might ask for a description of the mark, indicating where it is to be positioned on the product in question. The applicant can always submit such description.

The examination of such marks:

An ordinary assessment will be carried out, to see whether the mark is registrable or not. This mark is not, however, seen isolated from the rest of the product. The dominant parts of the mark are given greater weight when considering distinctiveness. But the possibility of elements not possible to register cannot be discarded, as these might influence the general impression of the mark.

Gesture marks will most likely be perceived to be, and treated as, motion marks, see above.

Publication:

Position marks will be published in our electronic weekly Gazette on the Internet with the representation of the mark, and a description of the mark if required, or submitted.

A gesture mark will most likely be published in the same manner as a motion mark; that means with still pictures or electronic file showing the gesture, together with a description of the mark, describing the gesture concerned.

2 NON- VISIBLE SIGNS:

2.1 Sound marks:

The Norwegian practice:

We accept such marks for registration and so far we have received 21 applications, and registered 15 of these. Almost all the received applications have been musical marks where the applicant has submitted musical notes.

Requirement of graphical representation:

We require that the applicant submits a precise description of the sound in words (indicating the notes and instruments, the length of the sound, beat/tempo, volume or other characteristics of the sound). It is optional for the applicant to submit musical notes, but he is required to submit a sample of the sound on a Mp3- file.

We believe that the public will more easily understand a description in words, stating for example the notes, the instruments used, the volume, the beat and the length of the sound, than the notes alone.

The examination of such marks:

An ordinary assessment will be carried out, to see whether the mark is registrable or not.

Single tones or trivial sound are not perceived as distinctive marks. A lengthy play or a long conversation will normally not be perceived as a trademark.

We believe the phonetic impression of the mark as in a Mp3-file will be essential for the office in a situation where we need to determine if there is likelihood of confusion. Such examination would be difficult without a sound file.

Publication:

The mark will be published in our electronic weekly Gazette on the Internet with the description, the musical notes (if submitted) and the Mp3- file. We have a sound icon on our website to click on to listen to the sound.

2.2 Olfactory marks:

The Norwegian practice:

We have not received any scent mark applications.

Requirement of graphical representation:

We have the possibility in our Trademarks Regulations to require the applicant to submit a description of the mark. We would not require the applicant to submit a sample of the mark, because in case of a scent, all smells will deteriorate with time.

We are aware of the cases like the Sieckmann-case (C-273/00).

The examination of such marks:

Since we haven't received any applications for registration of such marks, we do not have a clear policy on the practice for such marks. Obtaining registration will probably be difficult, cf. the Sieckmann-case. The applicant would have to show that the scent has acquired distinctiveness.

Functionality can also be a question for such marks. An example here is a kitchen garbage-plastic bag with lemon scent. Could such a scent be considered as distinctive or would it be considered to be purely functional; the lemon scent will disguise or cover the smell of garbage.

It would seem to be difficult to get a registration for a scent for a product that the public will expect to have a scent to begin with. This would rule out products like perfume, soaps, detergents, lotions, etc.

Publication:

There is no clear policy on the publication for such marks, since we haven't received any applications yet. If we would accept for registration such a mark, we would publish the mark in our electronic Gazette with a description of the mark.

2.3 Taste marks:

The Norwegian practice:

We haven't identified this type of mark as an independent type of mark type in our registration system. We do not have any applications for registrations of such marks in our office.

Requirement of graphical representation:

We have the possibility in our Trademark Regulations to require the applicant to submit a description of the mark in words.

The examination of such marks:

There is no clear policy on the practice for such marks in the office yet. We would however most likely require that the applicant would have to show that a taste mark has acquired distinctiveness.

Regarding such marks, examination of likelihood of confusion represents difficult challenges: the descriptions of the relevant marks must therefore be compared.

Another problem this type of mark faces compared to other types of marks, is that one would most likely not experience the trademark until the product is purchased. It would be difficult to try out the trademark in the shop! The taste would therefore not be a relevant factor when a customer decides to buy the product. The question might be raised whether there are tastes which do fulfil the essential function, which is to guarantee the identity of the origin of the marked product.

Publication:

If we should register such a mark, we would publish it in our electronic weekly Gazette on the Internet with the description of the taste.

2.4 Texture or feel marks:

The Norwegian practice:

We haven't identified this type of mark as an independent type of mark type in our registration system. We do not have any applications for registrations of such marks in our office.

Requirement of graphical representation:

We have the possibility in our Trademark Regulations to require the applicant to submit a description of the mark in words.

The examination of such marks:

There is no clear policy on the practice for such marks in the office yet. We would however most likely require that the applicant would have to show that a taste mark has acquired distinctiveness.

Regarding such marks, evaluation of likelihood of confusion represents difficult challenges: the descriptions of the relevant marks must therefore be compared.

Publication:

If we should register such a mark, we would publish it in our electronic weekly Gazette on the Internet with the description of the mark

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