

**Chemical Sense Marks – Expanding the Boundaries of Registrability
Frequent Concerns When Applying for Registration at the Office for
Harmonisation in the Internal Market (Trade Marks and Designs)
(OHIM)**

A thesis submitted for the degree of Doctor of Philosophy

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ABSTRACT

Chemical Sense Marks: Expanding the Boundaries of Registrability Frequent Concerns When Applying for Registration at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

The harmonisation of the European Trade Mark laws and the introduction of unconventional marks under this regime have encouraged interested parties to seek registration of chemical senses (scent and taste) as trade marks. This thesis studies the current state of affairs of these types of marks. It discusses in general, the panorama that these types of marks have when registrability is at issue.

The purpose of this research is therefore to scrutinise the trade mark legal system, including a discussion of the origins and rationale underlying it, to try to understand the burdens presented when registering chemical sense marks. The starting point of this thesis is that the European Regulation and the Directive of the Trade Mark law open the door to the protection of chemical senses under the Trade Mark law regime. Yet, despite some early successful registration, their fate is still burdened with uncertainty and therefore the rationale for this study is to try to find whether chemical sense marks are truly marks and therefore protectable under the trade mark system.

The approach chosen addresses the examination of all requirements for a sign to be protected under the trade mark system. The reason is that protection of chemical senses might be granted if such marks are recognised as signs, are graphically represented and are capable of distinguishing products of one undertaking from those of another undertaking.

By examining the aforementioned requirements, the study reveals that while chemical senses marks might be seen as marks, they find that registration is not quite feasible. The thesis emphasises that graphic representation is only one of the many issues that chemical sense marks are confronted with. Issues such as distinctiveness, the need to keep free and functionality remain problematic. Moreover, the scope of protection afforded to chemical sense marks are yet untested.

Case law will ascertain that the intent behind the trade mark regime to grant registration to chemical senses is unresolved. Still, the significant interest in chemical senses as trade marks appears to be not softening by this notion.

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AC	Law Report Appeal Cases (England and Wales)	FSR	Fleet Street Report
AG	Advocate-General	F Supp	Federal Supplement
All ER	All England Report	GmbH	Gesellschaft mit beschränkter Haftung
B & Ad	Barnewall & Adolphus' King's Bench Reports	HL	House of Lords (England and Wales)
B & C	Barnewall & Cresswell's King's Bench Reports	Inc	Incorporated
BNA	United States Law Week	IP & T	Intellectual Property and Technology
BoA	Board of Appeal	Ltd	Limited
BX	Benelux	My & Cr	Mylne & Craig's Chancery Report
CFI	Court of First Instance	OHIM	Office for the Harmonisation of the Internal Market
Ch	Chancery	OJ	Official Journal of the European Communities
Civ	Civil	plc	public limited company
Co	Company	RPC	Reports of Patents, Design and Trade Mark Cases
CTM	Community Trade Mark	SA	Société Anonyme
CTMR	Community Trade Mark Regulation	SpA	Società per Azione
EC	European Community	TEAS	Trademark Electronic System
ECC	European Economic Community	TMEP	Trademark Manual of Examination Procedure
ECJ	European Court of Justice	TRIPS	Trade-Related Aspects of Intellectual Property Rights
ECR	European Court Reports	TTAB	Trademark Trial and Appeal Board
EIPR	European Intellectual Property Review	UK	United Kingdom
Eng Rep	England Report	US	United States
ETMR	European Trade Mark Reports	USPTO	United States Patent and Trademark Office
EU	European Union	USPQ	United States Quarterly
EWCA	Court of Appeal	WIPO	World Intellectual Property Organisation
EWHC	England and Wales High Court	WLR	Weekly Law Report
EWPC	Patents County Court	WTO	World Trade Organisation
F	Federal Reporter (US)	WRP	Wettbewerb in Recht und Praxis

INTRODUCTION

Nowadays, the complex structure that trade mark law has developed has motivated law scholars and practitioners to explore the particulars of this structure in the hope of assessing its consequence on today's markets. Surprisingly, less attention has been given to the rationale of Trade Mark law. Having said that, key aspects of the investigation are the issues of trade mark registration and regulation but in order to do so, there is the need to research into the basis of trade mark protection.

The law relating to trade mark registration seems to be straightforward since it appears to be in note form and thus, a trade mark only needs to fulfil certain requirements. Yet the complexity of such requirements makes the trade mark legal system far from simple. It appears however that this latter issue has been forgotten. Manufacturers try to expand their marks and thus extend their exposure by reaching beyond the goods and services with which they are associated. Added to this is the fact that consumers are increasingly heightening their expectations of new products and so, for their 'branding'. Clearly, the pressure is on the Trade Mark law system which needs to adapt and evolve at the same pace. Because of these pressures, there has been a failure to consider that there are certain trade marks that cannot adapt and evolve at this rate.

As a result, the whole aim of this thesis is to consider the registration of chemical sense marks under the trade mark system, and to probe that chemical senses suffer from the same problem as others non-common signs, to be precise colour marks, and sound marks for example. However, through the development of the present work it is questionable if chemical sense marks should follow the same pattern as others unconventional marks or it is time to recognise that chemical sense marks do not belong to the trade mark system.

It is important to bear in mind that the legal system I am concerned with is the European Union; nonetheless, comparison with the US will be made as well with other areas of law that may protect trade mark, such as passing off.

While embarking into the discussion of chemical sense marks it is crucial to cover more general issues because one cannot depart from the rationale of trade mark law. Therefore, in order to understand the central argument of the thesis: the registration of chemical sense marks, the research starts by giving a history of the legislative framework of trade mark followed by the reasons for protection. Modern trade marks have developed beyond the concept of origin-function and now represent a variety of characteristics. Therefore, while the range of registrable signs have increased over succeeding Trade Marks Acts, it is imperative to consider if chemical sense marks are signs which were brought by the development of the trade mark system or chemical sense marks are just signs brought by capricious manufacture's and/or consumer's desire. This point will clarify if chemical sense marks accomplish with the functionality of trade mark and so, by keeping pace with society, in need of protection under the trade mark system.

Accepting sensory marks and more precisely, chemical senses (smell and taste) as marks might protect not only manufacturers but also consumers. Nonetheless, the issue that chemical senses should be protected is clearly a matter of fact, but how to register them is a matter of law. To examine this issue I start the second part of the thesis by opening with the institutional and procedural aspects of Trade Mark law in the European Union.

Consequently, I endeavour to develop answers for the matter proposed by dividing the second part in four Chapters. These Chapters examine the relevance of crucial requirements to different types of trade marks because while they should follow a pattern, the requirements appear to be modified and so adapting to new types of signs. In principle, when applying for registration, any sign must fulfil the same burden. However, by the developing of the second part of the thesis the research probes that the burden is not only different but that it must be so.

Starting with the background of the current trade mark legislation and the discussion of whether chemical sense marks are signs, it is demonstrable that while they are not indicated in the list of potential marks, they are not excluded from being one. This is demonstrate in Chapter II which opens by describing the European Union legal system as such due to the fact that most of the cases analysed in this thesis are ruled by the EU superior law. Therefore, it is important for the reader to become aware how this system

works. The Chapter continues describing the Trade Mark system as a whole, the intention is not much to analyse the law but to position the reader in front of the structure and thus to start questioning how the registration process work.

Chapter III continues to study one of the most controversial requirements applicable to non-visual marks, namely, graphical representation. To this effect, the Directive does not impose a certain manner in which a sign should be represented but unfortunately, chemical sense marks appear to have found an unreachable burden. The purpose of the requirement of graphical representation is to make the potential mark be 'precise and clear'. To investigate whether it is or will be possible for chemical sense marks to fulfil this requirement, the chapter studies the situation of others non-common signs. The reason for this is that in the past only few chemical sense marks were capable of registration but after the *Sieckmann* case, it appears that the burden for chemical senses has been raised. The argument to bring to this particular chapter is the issue that there exist some flexibility to other types of marks to comply with this requirement; therefore, it is questionable that a rigid obligation should still persist for chemical sense marks.

The next Chapter, Chapter IV deals with distinctiveness. This condition relates to consumer perception: marks can only be distinctive where the consumer perceives it immediately as an indicator of origin. The situation with chemical sense marks is that they belong to certain type of marks that are difficult to be indentify by consumers as an indication of commercial origin. The argument that brings this Chapter forms part of the central element of the thesis. Distinction is an obligation that appears to have fallen from proper discussion by officer and scholars when chemical sense marks are in place. The reason behind this situation is that once a sign has not fulfilled a preceding requirement (in this case, the graphical representation) then there is no need to scrutinise the forthcoming ones. Therefore, there is the need to study this obligation. Specifically, the Chapter analyses how distinctiveness applies to different types of mark, trying therefore, to bring a guide on how this requirement may apply to chemical sense marks.

Chapter V discusses the last requirement for a sign to be registered, namely, functionality; it embraces not only its structure but attempts to analyse its public policy by bringing into the frame other areas of Intellectual Property law such as Design law and Patent law.

Functionality is a requirement that is only scrutinised when shapes marks are in place. However, the argument that is to be brought into this Chapter is that the doctrine of functionality is a logical principle of Trade Mark law and therefore, there is no reason to limit the application to shapes only. The midpoint of this Chapter is that functional features are not explicitly implemented by shape marks. Moreover, the rationale of the doctrine of functionality can be applicable to any other type of signs because the idea is to preclude the registration of trade marks that are crucial to ensuring a function and thus, should not be directed only to shapes but also applicable to chemical sense marks as it does happen in the US.

The final part of the thesis starts with Chapter VI which endeavours to make scholars and practitioners aware that even if registration of chemical sense marks is possible, the issue of infringement is as arduous as the process of registration itself. While the thesis's aim is to investigate the frequent burdens presented to chemical sense marks at the registration process: administrative, the argument for dealing with infringement is that it relates to registration. However, the analysis brought into this Chapter gives a basic outline of how the system work because up to today there has not being any case regarding chemical sense marks infringement in the EU. Therefore, the Chapter endeavours into an etymological meaning that refers to different aspects that might be presented if a chemical sense mark is infringed.

Finally, Chapter VII discusses the nature of chemical senses and their repercussions on today's market. The difficulties that smell and taste have when intending to work as trade marks are overshadowed by the complexity of enforcing. The reason is that chemical senses nature is subjective and therefore legal analysis can differ. The Chapter also opens the debate on whether chemical senses should be protected under the trade mark system or they are more suitable in another type of system. At the end, the thesis tries to adapt or accommodate chemical sense marks into the trade mark legal system but this Chapter specifically investigates through case law different movements that can assist to protect chemical senses.

ACKNOWLEDGMENTS

Anyone who has an ambition knows that the process of reaching it is indeed full of obstacles. Now at the end of my work, I observe that not only is achieving the goal demanding but how to actually arrive at it, is the most difficult part. The complexity of researching, analysing and writing and at the same time trying to keep enough room for work, family and friends is without a doubt a challenge.

To achieve my goal I had to start by learning how to manage and organise my life. Therefore, during my PhD research I discovered how to cope with my duties (office and home) and with the dreadful loss of my father. I set myself a target, and I was determined to obtain the ultimate goal, to be a Doctor of Philosophy.

I need to recognise that all this hard work could not have been possible if I was not surrounded by wonderful people. Thus, towards this effort many individuals contributed. I am therefore grateful to those that have supported me in my quest.

At the academic level I would like to thank my supervisor Professor Peter Jaffey, who has always given me guidance and advice, ideas and suggestions. Thanks also to Caroline Wilson who was my supervisor for my Masters dissertation in 2003 and is now a superb friend. She helped me back in 2004 to prepare a proposal for what is today my PhD thesis. I am also indebted to Professor Jeremy Philips for supporting me in the present (early) stages of my academic career.

Many thanks go to all of those who have in one way or another facilitated my goal. Thanks Mum (and Dad) for making me the person who I am today and thanks to my brothers, Auntie B, parents- in- law and friends for enlightening and comforting me all these years. With all your prayers, good wishes and support (as if I were playing a football match “come on Patty, you can do it”) I can finally say, I did it!

Ultimately, I would like to credit my husband and children for all their love and patience. To my husband for his encouragement at times when I doubted that the work would ever be done and to my gorgeous girls, for being so lively and noisy but a brilliant and welcome (well, not always) distraction. I love you very much.

PART A: BASIC FEATURES

Throughout the years, the status and uses of marks *per se* have tailored made the needs and purposes of the environment. By attaining its goals, a mark must take into consideration the environment in which it operates¹ thus, fulfilling certain needs. This is reflected in the way they have been developed and protected. These days, we find marks of reputation, marks of social prestige, personal marks, merchants' marks, quality marks and so on, whose legal protection is to some extent of recent development.

The first part of the thesis will attempt to examine the evolution of marks as signs. It will start by studying marks as part of a component of everyday life. Consequently, an exploration into their validity in trade and the recognition given by the state through a formal grant is to be studied and thus the development of these -- to become legally protected by legislation.² Finally, an examination into the variety of functions that trade mark has gone through will be brought.

This first Chapter is an introduction to signs/marks and the role they play in society as well as to see how the law has evolved to incorporate new types of signs/marks. Indeed, this Chapter is intended to make the reader aware that the use of signs/marks has changed due to the conditions of the relevant civilisation. Because of this, the appearance of unconventional marks in the market is not an unexpected event.

CHAPTER I

THE NATURE, PURPOSE AND PROTECTION OF MARKS THROUGHOUT TIME

It is well known that marks have evolved drastically due to the motivation of social identification on the part of individuals or groups³ and so has its protection. Therefore, by

¹ C Morris, *Signs, Languages and Behaviour* (Prentice-Hall, New York 1946) p. 95.

² P Torremans, *Holyoaks & Torremans Intellectual Property Law* (5th edn Oxford University Press, Oxford 2008) p. 365.

³ P Mollerup, *Marks of Excellence: the History and Taxonomy of Trademark* (rev edn Phaidon, London 1998) p. 16.

studying the evolution of signs it is possible to realise that the development of marks as such and the emergence of chemical sense as a potential trade mark is not a sudden affair.

For a better understanding of the process that marks have undergone it is better to develop such a study through periods of time, namely: ancient, middle ages, the industrial revolution and finally, modern.

1.1 Historical Role

1.1.1 Ancient Times

It is reasonable to say that the exact origin of marks cannot be established. However, it is safe to assume that images such as the cave paintings originated with the need to communicate -- used for social, utilitarian, magical and/or religious purposes.⁴

Branding or marking livestock was common. It is not clear what those marks were used for, however in Egypt cattle were marked with the name of the district -- a type of ownership. Civilisations such as Mesopotamia, Egypt, China, India and Europe show interesting evidence of proprietary marks. Seal impressions on products identified the maker (origin function) and the genuinences of the product (quality function).⁵

Early pottery from China illustrates two types of mark: imperial time and/or origin (place or name of the producer) while that from the Mediterranean region contains just a simple picture,⁶ presumed to have a purpose as it was widely used in several civilised cultures. Another fine and early example of marks is possessor marks, which later became trade marks because of the way they were used.⁷ Those marks originated from a desire of men to achieve recognition for their craftsmanship.⁸

⁴ J Muller-Brockmann, *A History of Visual Communication: from the Dawn of Barter in the Ancient World to the Visualized Conception of Today* (Tiranti, London 1971) p. 7.

⁵ Muller-Brockmann, *op. cit.*, p. 10.

⁶ B Paster, 'Trademarks - Their Early History' (1969) 59 *Trademark Reporter* 551, 552.

⁷ *ibid.*, p. 127.

⁸ H Bayer and others, *Seven Designers Look at Trademark Design* (P Theodbold, Chicago 1952) Introduction.

Other examples of marks are those stamped on clay:⁹ a name (the manufacturer); the source of the clay; the construction they were destined for among others.¹⁰ In the ruins of Troy and Pompeii, stone marks are found¹¹ either indicating the source of the stone or indicating the name of the worker.¹² Seals made of clay or stone were widely used -- to stamp a mark on moist clay.¹³ Later on, they were commonly attached to documents as well as used for the amphora wine.¹⁴

Commercial trade was becoming popular and because of the expansion of trade, manufacturers felt the necessity to stamp their mark, to be recognised as a matter of pride (personal mark) and as means of distinction (manufacturer mark). Marks did indeed satisfy the purpose of indicating the source and origin of the goods, which is one of the fundamental characteristics and purposes of trade marks even today. Consequently, the commercial interaction during the Roman Empire was becoming fruitful and so did marks; these were stamped everywhere: cheese, wine, bronze, glass vessels, medicine, ointment, cloth and all ornaments.

The extension of marks was to carry to ceramics where, apart from the previous mentioned (possessor marks, stone marks and personal marks among others), the owners of factories and the name of the person in charge of the production were displayed as well. Marks were seen in the form of pictures of gods to be used as a means of dedication, and/or designs such as a wreath and palm leaf.¹⁵ Also word marks were observed such as acclamations used at public events or games¹⁶ and words like 'use this' or 'buy me' (perhaps a method of advertisement).¹⁷

Stone marks were common, not just in buildings, but they were given another use, as advertisements.¹⁸ Surprisingly, labels on medications and wines were pretty much as it stands today: on medication they carried the physician's name, the formula and the

⁹ H Bayer and others, *op. cit.*, p. 3.

¹⁰ *ibid.*

¹¹ *ibid.*, p. 10.

¹² S Diamond, 'The Historical Development of Trademarks' (1975) 65 *Trademark Reporter* 265, 269-270.

¹³ Muller-Brockmann, *op. cit.*, p. 10.

¹⁴ Bayer, *op. cit.*, pp. 40-41.

¹⁵ *ibid.*, p. 9.

¹⁶ *ibid.*

¹⁷ Paster, *op. cit.*, p. 554.

¹⁸ Diamond, *op. cit.*, p. 272.

directions for use;¹⁹ on wines they presented characteristics such as the origin of the grape, the manufacturer and the date of the pressing.²⁰

Slavery became an increasingly valuable form of trade²¹ and thus, was as common as any other goods.²² Branding, tattoos and piercing were used on their bodies to indicate that they belonged to another stratum (identification mark). Steel necklaces or collars and ankle bracelets or rings were used to identify the master and the city (mark of property).²³

After the fall of the Roman Empire Europe was almost closing down for business -- the Dark Ages.²⁴ Trade markets vanished and so did marks.²⁵

By studying the progress of signs during the early years it is noticeable the *development* of different types of signs and also their different purposes. Continuing with this study, the changes did not stop during the Middle Ages, the types of signs continued to extend.

1.1.2 Middle Ages

Gradually, a wide form of production was taking place in different trades and all sorts of goods were bearing marks. Personal marks were used frequently by farmers who later became merchants.²⁶ Family or house marks flourished in this period, and they appear to be descendants of those early personal marks.²⁷

If goods were to be shipped, it was prudent to mark them, in case of a shipwreck.²⁸ In addition, those marks were registered and certified by their guilds where the most important ones were kept in the *livre de commerce* (book of trade). In this, there was a list

¹⁹ Diamond, *op. cit.*, p. 271.

²⁰ Paster, *op. cit.*, p. 554.

²¹ J Walvin, *Slaves and Slavery: the British Colonial Experience* (Manchester University Press, Manchester 1992) p. 17.

²² *ibid.* p. 2.

²³ J Fisher, 'Tattooing the Body, Marking Culture' (2002) 8 *Body and Society* 91
<<http://www.arasite.org/kcfisher.html>> viewed on January 2008.

²⁴ Drescher, *op. cit.*, p. 310.

²⁵ Paster, *op. cit.*, p. 555. Also see Ruston *op. cit.*, p. 135.

²⁶ Ruston, *op. cit.*, p. 136.

²⁷ *ibid.*

²⁸ See further Diamond *op. cit.*, p. 273.

which contained local and foreign marks.²⁹ The practice of marking goods turns out to be a way of relying on the mark as an indication of origin. A compulsory system of marking became the order of the day.³⁰

Another famous personal mark was the heraldic symbol. Heralds registered the existing coat of arms and created certain rules which include regulations that dealt with problems concerning similarity of coats of arms.³¹ This fact asserts that the manifestation of new signs does not escape the rise of new regulations. They indeed go hand in hand.

Branding was still in use not just for cattle but also for slaves and prisoners. Origin marks extended to tapestry and wool, continuing through to wines and cheeses. European tapestry was marked with the place of origin and sometimes it showed another mark, an official stamp guaranteeing quality. Cloth from England was marked with the place of origin; silk from China was also marked in the same way.

Artists' signatures became fashionable. Diamond ascertains that they are marks of origin with 'a very personal sense', while I believe that they were used to identify the person who made the piece of art, not the manufacturer -- a personal mark.³²

In the Middle Ages a market existed that resembled the markets of Rome³³ -- the Champagne Fairs, because of its location, allowed good links with other countries.³⁴ Products became available to anyone around the known world. Clients became aware of different suppliers in the same line of goods. Therefore in the twelfth century we encounter a variety of guilds that were formed around Europe, either as a protection against competitors, to monopolise its trade in a particular city or town or to maintain quality through the standard of craftsmanship or both.³⁵ Basically each trade was supervised by a guild and each manufacturer was obliged to attach its mark. As each guild member had its own mark, the marks identified the producer not the product.

²⁹ Ruston, *op. cit.*, p. 139.

³⁰ *ibid*, p. 141.

³¹ Mollerup, *op. cit.*, pp. 17-23.

³² See further Paster, *op. cit.*, p. 557.

³³ Drescher, *op. cit.*, p. 311.

³⁴ Muller-Brockmann, *op. cit.*, p. 37.

³⁵ *ibid*.

By the sixteenth century stone cutters or stonemasons' marks were a complex art. Moreover, the commercial practice of marks became of a high standard with the boom of papermaking and printing.³⁶

An early example of the watermark came from Bologna and a hundred years later almost all papermakers used it.³⁷ It seems that quality, origin, and size of the paper could be determined by these marks.³⁸

Printer's marks were cut on wood or metal and printed on the title page or at the end of the book.³⁹ Diamond asserts that because of the rivalry among printers for the most accurate version of the work, printer's marks became an identification of origin.⁴⁰ As printers became renowned, they started to sign their books -- a personal mark. What is more, printers were often their own publisher, and when they were different, the mark of each would usually appear in the same book.⁴¹ Marks were presented in the form of: printer's name, monograms, the address of the printer's shop, or a reference to his shop-sign. Shortly after, these illustrations 'gave way on the title page to an engraved vignette'.⁴² The problem was that law neither protected copyright nor printers' marks, and thus several printers used the same mark.

As mentioned, a compulsory system of marking was required for some goods in the Middle Ages.⁴³ A fine example is 'Hallmarks' which stamp represented the description of the product and confirmation of its quality. Other examples of compulsory marking around Europe were to be imposed on loaves of bread, gun barrels, cloth, tapestry, stationery, brass working, printing, tanning, bottle making, shoe making and hat making.⁴⁴

Origin marks and compulsory marks (which carried liability), were to be displayed also in blades. Cutlers were settled in London where regular meetings were held to maintain the

³⁶ Caplan and Steward, *op. cit.*, p. 10.

³⁷ *ibid.*, p. 11.

³⁸ Mollerup, *op. cit.*, p. 23.

³⁹ Victoria & Albert Museum, *Early Printers' Marks* (Her Majesty's Stationary Office, London 1962). Also see Bayer, *op. cit.*, p. 23.

⁴⁰ Diamond, *op. cit.*, p. 275.

⁴¹ Victoria & Albert Museum, *op. cit.*

⁴² *ibid.*

⁴³ Ruston, *op. cit.*, p. 141.

⁴⁴ See further Ruston, *op. cit.*, pp. 141-144.

standard and quality of manufactured cutlery.⁴⁵ Nevertheless, note that the majority of trade marks, especially compulsory marks and more specifically cutler's marks were not truly trade marks. They were more of a police mark and/or quality mark which served only those under the regime.

As mentioned, in this particular period municipal laws established that manufacturers should be organised by guilds. The organisation of these bodies was to promote their crafts and consequently to eliminate external competition. The guild regulations basically created the 'compulsory mark'. Compulsory marks were placed as a way of guaranteeing quality, to attach responsibility for poor quality goods and thus protecting consumers.⁴⁶ The penalties brought to those offenders were, among others, expulsion from the trade, and/or pecuniary,⁴⁷ or imprisonment, even death.⁴⁸

Guild marks brought a general authority and effort to repress commercial fraud and therefore infringement of trade marks.⁴⁹ By the seventeenth century guild marks had recognised commercial conditions and an established protection. Basically, people became aware of marks and associated them with high standards.

By the eighteenth century lawyers started to pay more attention to the subject despite the definition and function of trade marks was not quite clear and their use was very vague.⁵⁰ At this stage it was no longer about quality, but that of infringement.

The *dictum* of *Southern v How*⁵¹ gave way to what seems to be one of the first cases in Trade Mark law;⁵² in the *Sandforth's* case, the defendant placed the mark of a well-known clothier on inferior cloths and sold them. Consumers' opinion as to the quality of the

⁴⁵ C Welch, *History of the Cutlers' Company of London and on the Minor Cutlery Craft. Vol I from Early Times to the Year 1500* (Printed privately for the cutler's company, London 1916) p. 119.

⁴⁶ For further information refer to C Welch, *op cit.*, p. 119.

⁴⁷ Statute of Parma (1282).

⁴⁸ Elector of Palatine.

⁴⁹ Examples of these can be seen in the following legislations: English Law protecting bakers (1266); Elector of Palatine protecting Rudesheimer wine (fourteenth century); Charles V protecting Flemish tapestry (1544); edicts of Brussels protecting tapestry designs (1525), among others. See B G Paster, 'Trademarks - Their Early History' (1969) 59 *Trademark Reporter* 551, 557.

⁵⁰ Paster, *op. cit.*, p. 564.

⁵¹ *Southern v How* (1618) Popham's Report 144.

⁵² K Stolte, 'How Early did Anglo-American Trade Mark law Begin? An Answer to Schechter's Conundrum' (1998) 88 *Trademark Reporter* 564, 590.

plaintiff's cloth changed so prejudicing him. The importance of this case lies on the fact that the unauthorised use of a trade mark was unlawful and might give rise to an action for deceit.⁵³

However, note that in *Blanchard v Hill*⁵⁴ the defendant used a mark which clearly imitated that claimed by the plaintiff⁵⁵ and yet injunction was not granted. The reason was that the action of using another's mark was not sufficient, intention to pass off inferior goods or to draw away customers as from the owner's mark was also required.

As the Court of Chancery was becoming more popular for hearing actions of infringement against marks, common law courts began to hear such actions as well. Therefore, by 1824 the case of *Sykes v Sykes*⁵⁶ seemed to come out in favour of trade marks owners in the common law courts. In *Blofeld v Payne*⁵⁷ it was established that to protect trade marks within common law it was not necessary to prove that the goods sold by the infringer were inferior to those which carried the mark in question or to prove that he has suffered special damages by the defendant's act -- previously required.⁵⁸ Moreover, in *Millington v Fox*⁵⁹ it was established that to protect trade mark in equity, deceit was not an essential ingredient of the action and thus relief would be granted even though the defendant's conduct was negligent.⁶⁰

In common law the idea of misrepresentation was gaining force, which was wider than the notion of deceit.⁶¹ Some cases demonstrated that infringement in trade marks was an action based on misrepresentation for damages caused to the right of property associated with the goodwill of the plaintiff's business, not the mark.⁶²

⁵³ Stolte, *op. cit.*, p. 569.

⁵⁴ *Blanchard v Hill* ('Great Mogul') 29 Eng Rep 692 (Ch 1742).

⁵⁵ For further understanding see C Wadlow, *The Law of Passing Off: Unfair Competition by Misrepresentation* (3rd rev edn Sweet & Maxwell, London 2004) para. 1-28.

⁵⁶ *Sykes v Sykes* (1824) 3 B & C 541.

⁵⁷ *Blofeld v Payne* 4 B & Ad 410.

⁵⁸ See *Blanchard v Hill*, *op.cit.*

⁵⁹ *Millington v Fox* (1838) 3 My & Cr 338.

⁶⁰ Reid, *op. cit.*, p. 3.

⁶¹ Schechter, *The Historical Foundations of the Law Relating to Trademarks*, *op. cit.*

⁶² *ibid.*

When the guilds began to dissolve, the enforcement and protection of those associations came from the Crown.⁶³ It was then that common law and equity took over since demands for legal protection against imitation of marks were ultimately prejudicing both consumers and manufacturers. Therefore, before the industrial revolution we can observe legislation that protected trade marks directly or indirectly.⁶⁴ Indeed, during this period not only signs developed but also their protection.

1.1.3 The Industrial Revolution

A major transformation is to be seen during the so-called industrial revolution (eighteenth to the nineteenth century) since it introduced a modification of marks. While in medieval times trade marks were more personal, in the industrial revolution they were focused on the reputation of the brand due to the contact between manufacturer and consumer being lost.

The idea of competition in a free market was flourishing and guilds were declining. The enormous growth of modern manufacturing methods replaced the handwork. Mass production required a rapid method of distribution,⁶⁵ as railways and canals. Some form of marking became more useful, helpful and valuable and according to Diamond, the modern function of trade marks as identifiers of the sources of the goods started at this time -- trade marks were the link between consumer and manufacturer.⁶⁶ Advertising took on more importance as well as shop signs and trade cards.⁶⁷

Simple marks or just a mere inscription were present in goods such as machinery. Soon marks became more elaborate, being inscribed on a brass plate with the name and address of the manufacturer. This mark as applied to machinery was to be extended to their stationary.⁶⁸

⁶³ McClure, *op. cit.*

⁶⁴ For instance: bakers' compulsory mark, the statute that granted monopoly to the Goldsmiths Company; the edict of Brussels that protected tapestry, the Letters Patent 1619; the Cutlers' Company Act 1623.

⁶⁵ Diamond, *op. cit.*, p. 280.

⁶⁶ *ibid.*, p. 281.

⁶⁷ Caplan, *op. cit.*, p. 12.

⁶⁸ *ibid.*

The production of manufactured goods was successful and this brought a wider variety of marks. The Great Exhibition of 1851 can confirm this,⁶⁹ where most of the goods were engraved or had a mark, either plain or ornamental. Every variety of goods used marks and they varied depending upon the users. According to the trade, patterns were developed. For example, manufacturers supplying agricultural materials used simple and distinctive marks; oil merchants and cake sellers often used a variant of a star; brewers and distillers regularly used a geometrical form.⁷⁰ At the time, some marks used a facsimile signature as part of the mark believing that it gave an air of authenticity.⁷¹ Another pattern was to be observed by the 1910's and 1920's with the use of figurines *e.g.* JOHNNIE WALKER.⁷² Regarding the protection of trade marks, in 1862 a Select Committee of the House of Commons was to consider several Trade Marks and Merchandise Marks Bills before Parliament. The proposals for trade mark were not approved and instead, amendments to the Merchant Bill were proposed upon which the Merchandise Act of 1862 was based. Basically, the Act was a criminal statute, which prohibited the imitation of marks and/or forging marks. However, it did not fulfil the manufacturers and competitors' expectations because suits were costly and long.

It became clear therefore, that a more formal system regulated by the central state authority was needed as the basis for protection upon which actions at equity and/or common law were unsatisfactory for the manufacturers in a society that was industrialising. It was not until after the industrial revolution that traders obtained what they were looking for, an Act which made easy the process of demonstrating their rights without any need for bringing witnesses to ascertain that the mark belonged to them.

By the introduction of the Trade Mark Registration Act 1875 those difficulties were overcome. This first statute was intended to make it easy to enforce trade mark rights. One of the most important matters was to make it less arduous for the plaintiff to prove reputation. Nonetheless, there was concern since few marks were able to be registered. For instance, words were not allowed to be registered unless they were old marks or were registered in combination with one or more particulars such as: name of individual or firm

⁶⁹ Victoria Station, 'The Great Exhibition at the Crystal Palace'
<<http://www.victorianstation.com/palace.html>> viewed on January 2008.

⁷⁰ Caplan, *op. cit.*, p. 13.

⁷¹ *ibid.*, p. 14.

⁷² *ibid.*, p. 15.

specially printed, impressed or woven in some particular and distinctive manner; or a written signature; or a distinctive device, mark, heading, label or ticket.

Trade mark legislation, after some amendments, was to be consolidated by the 1883 and 1888 Patent, Design and Trade Mark Acts (Part IV). The registrability of marks was to be extended to ‘fancy words or fancy words not in common use’. Subsequently, this wording was to be substituted by ‘an invented word’. Observe though that words having reference to the character or quality of the goods could not be registered. Nonetheless, the House of Lords held that any newly coined word could enjoy registration even if it had some reference or contained some suggestion regarding the character or quality of the good.⁷³

To sum up, it was not until the middle of the nineteenth century that trade mark was regulated by several Trade Marks Acts – not only in the UK but also around the world. Moreover, as it will be noticed in the following section, the timescale for the *amendments* had been *brought* forward due to a growing recognition of the needs of industry and commerce. Therefore, it should be no surprise to notice changes in law and practice to allow less conventional marks such as: colours, holograms and chemical senses to name a few, to be registered.

1.1.4 Modern Times

In the first years of the twentieth century, trade marks showed no development in design. On one hand, it is argued that it was because any picture or label that denoted a trade was enough to achieve their function (a guarantee of authenticity). In England, the difficulty of classifying designs was becoming unbearable for the trade mark registry, and thus emphasis was placed on wording. Therefore, as people were becoming more literate, a long custom of word marks began. Today, it is right to think that the majority of trade marks consist of words; however it is no less true that consumers are motivated by visual communication.⁷⁴ Because of this long-lasting culture it is difficult to perceive non-visual marks such as chemical sense as trade marks.

⁷³ *Eastman Photographic Materials Co Ltd v Comptroller- General of Patents, Designs and Trade Marks* (1898) HL 571.

⁷⁴ Muller-Brockmann, *op. cit.*, p. 6.

The first modern trade mark was produced in Germany by Peter Behrens. *Art nouveau*,⁷⁵ as other movements, became available in Europe⁷⁶ and because of this, different types of letters were becoming more widely used. These ideas flourished in typography and also in characters, layouts, and designs and as a consequence, in trade marks.⁷⁷ The element of movement was becoming necessary to keep up with the pace of evolution. Hence, combinations of different types of letters were used, as well as new geometrical shapes.⁷⁸

With the new advertising media (at the time this was the radio), the sound of the spoken trade mark became very important.⁷⁹ Moreover, a new era emerged with the arrival of television, combining sound and vision.

Noticeably trade marks have developed as men have. An important point is that signs, symbols and marks are types of reflections. They are indeed not just a mere evolution but the reflection of different cultures, languages and history.⁸⁰ Hence, trade marks have had different significance according to users and eras; different tendencies have been introduced throughout the years and thus been accepted by manufacturers and consumers alike. All through these pages, patterns have been mentioned *e.g.* in one period the use of a reverse '4', then the use of geometric symbols, and later on the use of different sizes and types of words among others. Therefore, it can be argued, that this is the time for another change -- calling sensory marks.

Trade marks are still very much left to human intuition (sometimes aided),⁸¹ meaning that it is the consumer who always determines either to turn to the same symbol or to change and accept others. Having said that, sensory marks and more specifically chemical senses may function as true trade marks but, can they be registered? The importance of the study of this historical process as part of this research is crucial due to the recognition that evolution and modernisation is needed due to today's consumers' sophisticated tastes.⁸²

⁷⁵ Caplan, *op. cit.*, pp. 16-17.

⁷⁶ See further C Werkman, *Trademarks: Their Creation, Psychology and Perception* (Longman, Harlow 1974) pp. 140-141.

⁷⁷ *ibid.*, p. 144.

⁷⁸ *ibid.* Also see Bayer, *op. cit.*, pp. 85-87.

⁷⁹ Bayer, *op. cit.*, p. 52.

⁸⁰ Werkman, *op.cit.*, p. 10.

⁸¹ *ibid.*, p. 10.

⁸² P Dickinson, *It's not About Size: Bigger Brands for Smaller Businesses* (Virgin, London 2001) p. 78.

A change in trade marks is already happening with the introduction of some unconventional marks. However, what is more important is that it is now time for Trade Mark law to keep abreast with the development of marks – as it has in the past done. Certainly, the development of the law in the twenty century started with the Trade Mark Act 1905 that sets a statutory definition of trade mark and its infringement.⁸³ It also introduced new provisions. Registrability was slightly extended to ‘any other distinctive mark’ but mainly it was words, invented and arbitrary, as well as designs attached to or inscribed onto the product that could be registered.

The Statute was amended by the Trade Mark Act 1919. This statute divided the register in two: Part A, was the original register, and Part B, where changes were to be seen. Basically, the distinction was made to give certain marks lesser protection and lower rights until they were used enough to overcome all doubts.⁸⁴

This division was to be brought into the following Trade Mark Act 1938 where registrability for suggestive and descriptive marks was to be accepted. The division between part A and B was based on whether a mark was ‘adapted’ to distinguish or ‘capable’ of distinguishing. On one side, s 9 referred to ‘adapted of distinguish’⁸⁵ in which case, the mark was admissible and thus to be in Part A -- with severe requirements that were valuable since those registered in this Part enjoyed better protection. On the other side, s 10 referred to ‘capable of distinguish’ also admissible but to be in Part B --⁸⁶ with a weaker test of admissibility; therefore, less protection which left some defendants free from liability.⁸⁷

Recommendations to this Act were made and the Trade Marks Act 1984 was passed. Registrability was extended to cover services marks, not covered by earlier Acts but protected by the law of passing off.⁸⁸ A clarification of the law was needed and the Trade Mark Act 1986 was made to simplify the previous Act and to look ahead for a new system

⁸³ *Yeast-Vite* case (*Irving's Yeast-Vite Ltd v Horsenail Co Ltd* (1934) 51 RPC 110).

⁸⁴ Cornish, *op cit.*, p. 609.

⁸⁵ T A Blanco White and R Jacob, *Kerley's Law of Trade Marks and Trade Names* (12th edn Sweet & Maxwell, London 1986) paras. 8-03 to 8-72. Kerley's latest edition does not mention this.

⁸⁶ *ibid.*, paras. 8-73 to 8-78.

⁸⁷ See further P Jaffey, ‘The New European Trade Mark Regime’ (1997) 28 *International Review of Intellectual Property Law and Competition Law (ICC)* 175. See also Blanco White and Jacob, *Kerley's* (10th edn), *op. cit.*, para. 1-15.

⁸⁸ D Bainbridge, *Intellectual Property* (7th edn Pearson Education Limited, Harlow 2009) p. 629.

of law to unite European trade mark accordingly.⁸⁹ Therefore, the Trade Mark Act 1994 was brought as the solution to the need for reform. This new Act was to implement the provisions of the Trade Marks Directive⁹⁰ thus approximating the laws of Member States relating to trade mark.

Following this new Act we find ourselves with the possibility of registering all manner of marks that were impossible before. There is the possibility of registering 3D shapes, containers, sounds, chemical senses, as well as other unconventional marks.

Certainly the transformation trade marks have undergone has varied according to the era and they have always had a function, a reason. That said, it leaves us with the question: do these early marks function truly as trade marks? And moreover, do unconventional marks function as so? This discussion follows.

1.2 Variety of Functions

It has been discussed that some marks such as cutler's marks were more to do with quality; however, pottery marks used in Roman times could be said to have functioned as actual trade marks since they identified and distinguished certain products from others. Another example of early marks that were not regarded as true trade marks are branding and/or ownership marks which were imposed as a need; or personal marks which were imposed as a desire and thus, not trade marks in a modern sense.

Nowadays, the functionality of trade marks goes further than those uses. They indeed have changed from being used for personal pride to indicators of origin, from indicators of quality to marketing tools.⁹¹ Hence, if we were to pose the question what do trade marks do? We expect answers such as: create distinctiveness and thus recognition of the product, indicate the origin-source, give information about the product, stimulate the desire to buy, symbolise guarantee,⁹² and give monopoly power in a market.

⁸⁹ Torremans, *op. cit.*, p. 366.

⁹⁰ Council Directive 89/104: EEC [1989] OJ L 40/1 amended by Annex XVII to the Agreement establishing the EEA [1994] OJ L 1/3.

⁹¹ T D Drescher, 'The Transformation and Evolution of Trademarks: from Signals to Symbols to Myth' (1992) *Trademark Reporter* 301, 325.

⁹² Werkman, *op. cit.*, pp. 4-9.

Nevertheless, a potential mark may be refused registration if it does not function as a trade mark. Indeed, not every mark that is recognized or associated with a business is necessarily a registrable trade mark. As said, a mark needs to function as a trade mark. The question is: do chemical sense marks function as trade marks? Or, are they just a marketing tool?

It is understood that until the industrial revolution there was a two-fold function: one, protecting the consumer (protection against deceptive use) and the other protecting the manufacturer. However, nowadays there is a third function: an economic function which is a marketing tool, an asset. Some academics refer to three main functions of marks: origin, quality and asset. In this work we will refer to two: origin and quality as one function and the second, an economic function. Now, we turn to these.

1.2.1 Quality-Origin Function, an Extended Information Function?

Above all, consumers approach products with a certain level of ignorance. The majority of consumers buy goods/services that they can truly evaluate at first hand. Thus, the product in question is reviewed by consumers. It is then that trade marks become a familiar means of identification for that particular consumer.⁹³ Certainly, after we identify a trade mark, it leaves an impression on us. Usually, consumers buy, not just as an impulse of a physical characteristic of the product; it is more than that. There is something else involved in the experience of buying a particular product; it could be memories of experience, word of mouth, feelings towards an ad, price and convenience, and so on. If we are looking for quality, financial, fashion or social status, trade marks produce such information and/or desire. Therefore, in this context, trade marks can be seen as accomplishing the informative function. They satisfy the function of identifying the product, perhaps for some consumers an origin function. In addition, as consumers rely on their past experience, this stimulates, or not, further purchases; perhaps for some consumers a quality function.⁹⁴ Both functions give assurance and are without doubt fundamental components of trade marks. Moreover, with the origin function, trade marks benefit both parties: consumers and manufacturers.

The origin function should be taken in a broad sense, meaning that it is not just about the disclosure of the manufacturer, where the product comes from (country and/or

⁹³ See further S Carter, 'The Trouble with Trademark' (1990) 99 *Yale Law Journal* 759, 770.

⁹⁴ F Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 *Harvard Law Review* 813, 824.

manufacturer) but also that it helps the consumer to realise that there is a difference between one particular product and another. This given function, a type of identification, allows consumers to evaluate the product. Also, it gives consumers information about quality and thus, can be treated as a derivative function. Drawing a line between quality function and origin function is possible but not necessary, at least for consumers, since they go hand in hand.

A clear example of how origin and quality fit together can be seen in the following question: does consumer 'X' buy MR CLEAN, FEBREZE, CHARMIN, PAMPERS, PRINGLES, OLD SPICE, and CLAIROL because he knows that they come from a specific manufacturer, PROCTER & GAMBLE? If he knows that, why does he want to buy those products? As explained, marks are representative. 'X' may buy those products because he perceives the mark as an emblem of prestige or a guarantee of quality. Nonetheless, what would happen in the case that 'X' is not aware of the manufacturer? Would he still buy the product because of its quality? As early as the eighteenth century, Lord Westbury explained that a mark could be protected even in circumstances where the public did not know the producer but used the connection with a trade source simply as a sign of quality.⁹⁵

There is no reason why protection should be given to trade marks based only on the origin function as such, if it does not indicate to consumers anything but a manufacturer. Why would they want to know a mark and distinguish it from another if they cannot associate it with quality? It is argued that in the eyes of the consumer there is an automatic association: mark equals quality. Moreover, to think that the reason to regulate marks is based only on protecting and preventing deception of the public on the source is irrational. It goes further. It is believed that the protection of the mark in this origin-quality function is also to preserve and retain the custom.

Nowadays, Trade Mark law does not protect consumers directly since they are neither capable of refusing registration of a mark nor of bringing an action against trade mark infringement. Yet, though consumers cannot benefit directly, they still can obtain some indirect benefits.

⁹⁵ *Hall v Barrows* (1863) 4 De GJ & S 150, 157.

Bear in mind that consumers are different and thus quality is not to be taken literally but according to the consumers' view. What is meant by quality is that the product, which has affixed a specific mark, is the one that a particular consumer wants, the one that fulfils his expectations. Therefore, quality is to be classified as what the consumer wants from the product, namely: high quality, good value for money, fashion, and so on. Surely, in this sense quality is subjective; it depends on the individual consumer and it is based on satisfaction. Hence, in the consumers' mind a math formula could be used:

$$\text{Mark} = \text{source} = \text{quality} = \text{guarantee of satisfaction.}$$

The question is therefore, is the primary function of trade marks to identify the source of the product? Is it what is protected and nothing more? Consumers presume that goods/services which present the same mark come from a particular source but it does not mean that he has to be familiar with the origin as such. In the public mind what is more important and what is associated with a mark is the product's quality (more than its origin).⁹⁶

To reinforce the math formula mentioned, specifically the notion that source equals quality, we do not have to look further than the possibility of trade mark licensing. If source and quality were separate, licensing would be out of the question since the mark's owners would give the mark away. Thus, a manufacture's reputation would be given to a person/dealer allowing him/it to use it without the owner having control over quality. Whether licensing is accepted, it is on the grounds that even though the source is not the same, there is a guarantee of quality.

The importance of the quality function can also be ratified by cases where the courts have denied equitable relief if the owner changes the quality of the product.⁹⁷ Would it be the same if the source changed? Suppose that the products mentioned earlier were not manufactured any more by PROCTER & GAMBLE but by UNILEVER maintaining the same quality. Could the court deny relief? Rationalising around the basis of goodwill, the

⁹⁶ B Cutter, 'The Rational Basics of Trademark Protection'; Control of Quality and Dilution - Estranged Bedfellows? (1990) 24 *Journal Marshall Law Rev* 69.

⁹⁷ See further Cutter, *op. cit.*, p. 77.

source-quality function of marks replicate very much what “goodwill reflects: integrity, economic honesty and efficiency”.⁹⁸

The selling power is clearly the association that is produced in the consumers’ mind. It is so powerful that established trade marks in one product line are transferred to another product line with a minimum effort; its reputation goes with the mark and thus, there is not the necessity for get-up.

The origin also refers to the integrity of the product that gives rights and obligations to the manufacturer. However, note that the quality function does not replace the source function but is integrated with it.⁹⁹

Two points should be addressed regarding the origin-quality function not being primary to consumers. On one hand, the mark rather than the product is what creates preference and hence, transforms the normal role of trade marks. Sometimes trade marks give an identity to the consumer, a way of life that is transferred by the ‘experience envelope’ that the mark carries¹⁰⁰ e.g. commercials patronised by pop stars, models and sports idols.¹⁰¹ In the case of marks that are of a particular financial category, they give the consumer a ‘mythical status’¹⁰² e.g. ASTON MARTIN, POLO, CARTIER. On the other hand, instead of being informative the mark is persuasive.¹⁰³ This is gained by mass media promotional propaganda. Some academics believe this action is manipulative.¹⁰⁴ In both cases though, the interest of the consumer is focused not just on the particular quality of the mark, but is based on a desire.

At this stage, it is noted that there are two types of mark: one being what the consumer needs; the other type of mark which is the one that the consumer wants. The first, is the mark that identifies the product (traditional trade mark) -- origin/quality function and, the

⁹⁸ L Altman and M Pollack, *Callmann on Unfair Competition, Trademarks, and Monopolies* (4th edn Thomson Reuters/West, Eagan 2009) Chapter 17:1.

⁹⁹ Cutter, *op. cit.*, p. 76.

¹⁰⁰ Dresher, *op. cit.*, p. 301.

¹⁰¹ L Bently and B Sherman, *Intellectual Property* (3rd edn Oxford University Press, Oxford 2009) p. 713.

¹⁰² C W Grimes and G J Battersby, ‘The Protection of Merchandising Properties’ (1979) 69 *Trademark Reporter* 431, 432.

¹⁰³ Brown, ‘Advertising and the Public Interest: the Legal Protection of Trade Symbols’ (1948) 57 *Yale Law Journal* 1165.

¹⁰⁴ Cornish, *op. cit.*, p. 624.

latter, is an economic function in which advertising, branding and merchandising do play a crucial role. This second function seems to be essential for unconventional marks. In the following chapters it will be explained that unconventional marks are not perceived at first as trade marks, and so, advertising is important. Then, the means to promote unconventional marks appears to make consumers aware of the mark but in an unusual way -- not related to origin/quality but to make consumers to desire the characteristic (the trade mark) of the product.

One thing that was not dealt with by Schechter and which contributes to an important role in the function of trade marks is culture. As mentioned in previous sections, consumers create marks. It means that because of consumer's pressure, trade mark evolution is dictated by culture, language and history. Accordingly, it is right to think that current situation of the market place has brought new types of trade marks.

1.2.2 Economic Function - Trade marks as Creature of Commerce: from Branding to Merchandising

In this subsection trade marks will be studied with regard to how manufacturers maximise the source-quality function, encouraging consumers to buy their products. In order to produce a desirable product, manufacturers use advertising and sometimes psychological campaigns.¹⁰⁵

Advertisements make consumers believe that a particular product would satisfy them. Indeed, today's adverts persuade people. Therefore, it is possible to argue that trade marks are marketing ads; however, is the trade mark function to advertise rather than to inform? It is noted how a trade mark which is being informative becomes persuasive -- a marketing strategy. Indeed, there are circumstances in which trade marks advertise products as a way of life; it creates a personality.¹⁰⁶

Consumers may buy a product because it creates feelings.¹⁰⁷ Thus, consumers try to define themselves through the trade marked product which promises to give them perhaps

¹⁰⁵ Dickinson, *op. cit.*, p. 1.

¹⁰⁶ D Aaker, *Brand Portfolio Strategy* (Simon & Schuster, London 2004) p. 179.

¹⁰⁷ Dickinson, *op. cit.*, p. 79.

prestige, power, fun or adventure.¹⁰⁸ In some cases this image is produced based on the actual features of the product.

Indeed, today, manufacturers are concerned with creating identities for their brands. Hence, trade marks tend to be used as brand names rather than simply for identifying a product, competing for consumer's attention. Nevertheless, it does not mean that trade marks do not identify the product any more. They still serve their traditional purpose but such identification is more focused on an image function in today's market. Having said that, trade marks have come to represent not only a particular product but also represent awareness of different links including politics, behaviour, environmental responsibility, and many others. It appears then that consumers mainly buy a brand rather than a product.¹⁰⁹

Observe that the notion of trade mark and brand are not synonymous. A trade mark is the legally protected sign that identifies a product. However, branding is concerned with all the surrounding areas of a trade mark, that is, how the product is presented to consumers, the products' features, packaging, name and so on.¹¹⁰ The term brand means a sign/name 'by which the consuming public can identify and relate to actual goods or services'.¹¹¹ This branding is done through a trade mark and it is the trade mark that has commercial significance; the one that is heavily protected by manufacturers.

This matter brings us to the question: does a trade mark identify a product or a brand? Or is a trade mark just a decorative symbol? With the arrival of unconventional marks this situation has become more questionable since certain marks are seen as mere ornamentations.

In addition, we have seen how a trade mark or a name of a brand can influence the consumer's purchasing decision. For instance, when products bear the image or name of pop stars, sports teams, and names of famous people, real or fictional, the function of a mark appears to vanish. In this case, those products are desirable not because of the

¹⁰⁸ K Drawnbaugh, *Brands in the Balance: Meeting the Challenges to Commercial Identity* (Reuters, London 2001) p. 231.

¹⁰⁹ *ibid.*, p. 17.

¹¹⁰ Pickering, *op. cit.*, p. 50.

¹¹¹ J Phillips, *Trade Mark Law: a Practical Anatomy* (Oxford University Press, Oxford 2003) para 1.13.

product but because of the symbol. As there is an emotional relationship, such symbols can be placed on an unrelated product¹¹² and be as successful as the main product *e.g.* FERRARI mug, HARRY POTTER t-shirt, COCA COLA towel. This is the so called merchandising rights.

A piece of merchandise does not give information about the original product.¹¹³ This view was taken in the *Elvis* case, where it was held that this type of mark would always be devoid of distinctive character.¹¹⁴ Indeed, merchandise is recognised by consumers because of the symbol which gives status or a psychological association (desirable characteristic) because of its popularity.¹¹⁵

Having said that, it seems as if this matter is to be decided by the consumer -- whether or not they see a product coming from or under the control of the manufacturer.¹¹⁶ On one hand, consumers may believe that the owner of the trade mark or brand is involved somehow in the merchandised object. This approach was accepted in the *Mirage Studios v Counter-Feat Clothing (Turtles Ninjas)*¹¹⁷ where the defendant not having a license to use the pictures of the turtles meant that there was deceptiveness (necessary for an action of passing off to succeed). However, such an approach is to be followed if the misrepresentation of the license principle is accepted.

On the other hand, Laddie J in the *Teletubbies*¹¹⁸ case refused to grant an application for summary judgement for passing off in respect of t-shirts bearing images of the Teletubbies, due to customers seeing just the artwork bearing illustrations of the characters. The judge did not have any regard as to the source of supply and thus, misrepresentation was not proved since there was no link. Nevertheless, bear in mind that both cases were examined under the law of passing off.

Therefore, it is worth noting that merchandising issues may not arise in the same way in the law of registered trade marks and in the law of passing off -- there is a difference between the two. Yet, what should be discussed is whether the use of such an image would

¹¹² Grimes and Battersby, *op. cit.*, pp. 432-434.

¹¹³ P Jaffey, 'Likelihood of Association' [2002] EIPR 3.

¹¹⁴ *Re Elvis Presley Enterprises* [1999] RPC 567.

¹¹⁵ Grimes and Battersby, *op. cit.*, pp. 432-4.

¹¹⁶ Pickering, *op. cit.*, p. 66.

¹¹⁷ *Mirage Studios v Counter-Feat Clothing(Turtle Ninjas)* [1991] FSR 145.

¹¹⁸ *BBC Worldwide Ltd v Pally Screen Printing Ltd* [1998] FSR 665.

damage the trade mark because, as established by the well known *Arsenal v Reed*¹¹⁹ case, it can no longer guarantee origin. The case concerned the sale by Mr Reed of Arsenal's football club memorabilia and souvenirs. In this case, it is established that even though consumers did not see the merchandise bearing the ARSENAL mark as indicating that the product came from or was under a license from the club, the ECJ saw how the use of the sign would affect the function of trade mark.¹²⁰ That said, merchandising rights might be protected under this idea however, the problem would be clarifying the use of the mark -- to infringe, the sign must be used as a trade mark.

Looking at the two sides of the coin, on one side it is correct to recognise the image creator's right; to profit from the reputation of his name/product and thus forbidding those attempting to take advantage of the success of his creation.¹²¹ On the other side of the coin, there is an extension of a vast monopoly, or at least promoting such behaviour; it would protect the symbol because of its meaning not because of its function.¹²² Hence, merchandising rights may restrict the use of the sign itself rather than its use as a trade mark. If so, then nobody would have a legitimate right to use a sign.

Clearly it is a controversial topic since it appears that consumers at large do not mind where the image is coming from. At the end of the day, they appear to have an interest in the merchandise because of fashion, status or other reasons. Consumers buy the product because it is what they want; they buy it because of the meaning of the image. Hence, in this case the consumer is not the direct victim of the perhaps fake merchandise. In fact, it is doubtful that consumers could be considered victims at all if they buy the product because of its image and not because of the origin-quality function. It is worth remembering that it is difficult to justify protection where consumers are not confused. In spite of this, it is unfair to take advantage of somebody else's business. It is then a question of who has the right to exploit it.

In general it is argued that Trade Mark law does not give an exclusive control over a product as such but gives control over the use of the trade mark in connection with a

¹¹⁹ *Arsenal FC plc v Mathew Reed* C-206/01.

¹²⁰ *ibid.*

¹²¹ Pickering, *op. cit.*, p. 48.

¹²² Pickery, *op. cit.*, p. 68.

product.¹²³ Yet, it is possible to argue that trade marks can be seen as a monopoly given to the manufacturer and not much of a benefit to consumers. Nevertheless, the functionality of trade marks (not Trade Mark law) has a double advantage; one to the consumer and another to the manufacturer, but why do people register?

It is important now to turn into the motivation of trade marks. Therefore, there is the need to examine the reasons for registering because at the end, the purpose of this research is to analyse the procedure when registering chemical sense marks and so, the reason behind this process deserves some account.

1.3 Benefits

It can be said that the main reasons for a trade mark registration system are: providing notices to other manufacturers that a certain mark is in use or might be used and thus avoiding the duplication of marks; conferring exclusive rights on the proprietor of the mark enabling the proprietor to prevent certain unauthorised uses of the mark by others; no longer necessary to prove that a mark has acquired reputation; facilitating the enforcement of trade mark since deceptiveness will not have to be proved; among others.

Generally we could say that there is a two-fold protection: the protection of consumers and the protection of the manufacturer. On one hand, manufacturers that produce their goods look for recognition and protection. Manufacturers that compete in a free market wish to compete on the same level trying though to limit the monopoly given by trade marks so as not to inhibit legitimate competition. On the other hand, consumers, apart from identifying the products, associate the goods with their name. On most occasions there is an association with the quality of the product and therefore the consumer does not wish to be confused by similar marks, especially if the products are of inferior quality.¹²⁴

In a more detailed way, there are several advantages that trade marks give:

- Trade marks enable a consumer to choose the product with the particular quality that has previously afforded satisfaction and thus reduces consumer searches.

¹²³ Bently and Sherman, *op. cit.*, Chapter 35.

¹²⁴ Torremans, *op. cit.*, p. 368.

Therefore, certainty can be provided by trade marks and thus trust is established. The importance of a trade mark in this sense is that consumers will distinguish between goods/services which may look identical. There may be unobservable features that cannot be perceived at first but through a mark the consumer will identify them.¹²⁵ Moreover, this will give a benefit to manufacturers since returning customers will do their marketing for them, *e.g.* word of mouth, which apparently is the best way to generate sales.¹²⁶

- Over time consumers will be willing to continue to buy the products and will buy other products from other lines bearing the same mark; this is so because he has become confident that a certain level of quality is given by the trade mark. In the same line, repeat purchases encourage the manufacturer to maintain its quality standard which in the end is another advantage to the consumer -- consistency in quality.
- Manufacturers are encouraged to compete over a wide quality and variety field. Manufacturers try to differentiate between each other in the variety and quality dimensions, and if there was no trade mark there would be no market power. As consumers can distinguish products it is up to each manufacturer to make that extra differentiation between competitors.¹²⁷ There is clearly a constant competition between manufacturers that works in the consumer's favour. Hence, a reduction in the price level can be observed since mass production decreases production costs.¹²⁸
- The advancement in technology creates challenges for manufacturers. Competitors need to become more inventive, creating challenges that develop as products become more efficient and effective.¹²⁹

Studying such advantages, it is noticed that the foundation of Trade Mark law changed from protecting the consumer to serving them.¹³⁰ At the other end of the spectrum, manufacturers also benefit from trade marks. Some of these advantages are:

¹²⁵ N Economides, 'The Economics of Trademarks' (1998) 78 *Trademark Reporter* 523, 526.

¹²⁶ Dickinson, *op. cit.*, p. 111.

¹²⁷ Economides, *op. cit.*, p. 532.

¹²⁸ *ibid.*, p. 533.

¹²⁹ Aaker, *op. cit.*, p. 160.

¹³⁰ J Cross, 'Language and the Law: The Special Role of Trade Mark, Trade Names and Other Trade Emblems' (1997) 76 *Nebraska LR* 95.

- By the time trade marks acquire reputation, manufacturers may charge a premium for its products; a premium that some consumers are willing to pay for the quality assurance.¹³¹ Moreover, some part of this premium charged will be invested and injected into the manufacture of the product.
- Once the quality of a manufacturer is indicated by the trade mark which is identified by large demand, it is then that the manufacturer will produce large quantities and benefit from economies of scale. Hence, sustained profits will give manufacturers the opportunity to invest more, allowing greater reductions in the level of cost.¹³²
- If the manufacturer has established his name well enough then it could borrow much more easily and cheaply than its competitors.¹³³
- Trade marks are indeed measurable assets without physical form; they are involved in real economic growth *e.g.* in mid 2000 COCA COLA Co reported total assets of \$21.6 billion on its balance sheet, although the stock market was giving a market capitalisation of \$142 billion.¹³⁴
- It is possible to enter into new lines of products without much effort since the reputation is there, thus, reducing the cost of entry.¹³⁵

To summarise, it is argued that in a competitive economy the consumer benefits by being able to choose among a wide variety of products -- in the quality and price range. In addition, the trade marks' owners gain an immense commercial significance due to the trade marks value as an asset.

In closing, Part A of this thesis started with the evolution of marks and their legislative protection. The need for protection was to prevent injury to both consumers and manufacturers by counterfeits. Later, with the advent of registration, trade mark owners could bring actions without the need to prove the reputation of the mark. However, as we proceed with the development of this work, the present chapter notices that such protection has gone further than a mere protection of origin-quality. To explore this, I study the

¹³¹ D Higgins and T James, 'The Economic Importance of Trade Mark in the UK (1973-1992) - a Preliminary Assessment' (1996) *The Intellectual Property Institute* 4, 5.

¹³² *ibid.*, p. 6.

¹³³ J Swann and T Davis, 'Dilution, an Idea Whose Time Has Gone; Brand Equity as Protectable Property, The New/Old Paradigm' (1994) 84 *Trademark Reporter* 267, 282.

¹³⁴ Drawbaugh, *op. cit.*, p. 174.

¹³⁵ Higgins, *op. cit.*, p. 6.

different functions that trade marks have and thus, look at both sides of the equation: consumers and manufacturers. This discussion leads to an early conclusion which sees that modern trade marks have developed beyond the concept of origin-function and now represent a variety of characteristics. Therefore the law has also developed, recognising and protecting an increasing range of signs, but how far?

Having concluded that trade marks benefit consumers, can Trade Mark law then recognise and accept smell and taste marks? Accepting chemical senses (smell and taste) as marks seems to be the right step, since they might accomplish such origin-quality function and moreover keep pace with society. Whether these chemical senses should be protected is clearly a matter of fact, but how to register them is a matter of law.

Finally, the present chapter has also brought a background into the reason for trade mark protection. It is seen therefore, that the response given by legal systems cannot be seen as baby steps but as large leaps of progress. Besides, the effort of trade mark owners to create unique and different marks is indeed attentive and thus protection should be considered. In fact, it is arguable that as the range of registrable signs increases over succeeding Trade Marks Acts, it is now time to allow those not so graphical signs to be registered as well. However, as it will be seen in Part B, formal requirements overshadow this idea and it is understandable that law and practice do not always go hand in hand.

PART B: THE SUBSTANTIVE LAW OF TRADE MARK LAW IN THE EUROPEAN UNION

In Part A it has been discussed how new types of mark are here due to current and potential future developments in the market. As a result, new legislation has been put in place in national and international arenas. Regimes such as the EU and the US have adapted new legislation but not without complications. This liberalisation that permits unconventional marks being registered has tested the boundaries of registrability.

Part B will examine the protection of unconventional marks discussing whether the problem relates to the application rather than the legislation. This part will start with the introduction of today's legislation to familiarise the reader and consequently, it will examine the substantive law of trade marks as applied to unconventional marks. Comparison will be made with the US (when necessary) to determine what the EU jurisdiction needs to learn, if anything, from the US jurisdiction. Jurisprudence of the European Court of First Instance (CFI),¹ the European Court of Justice (ECJ),² the Office of Harmonization for the Internal Market (Trade Marks and Designs) (OHIM),³ as well as any other EU national courts and the US courts.

Once familiar with the legislation, this part of the thesis will be divided into three. These three chapters will consider the elements and/or requirements of trade marks; namely: graphic representation, distinctiveness, and functionality. Each of these will be studied in turn considering that they do have serious implications for chemical sense marks.

Nonetheless, while taking these three requirements into consideration, unconventional trade marks in general will be examined, since usually, similar obstacles are presented to all of them.

¹ Hereafter CFI. Following the entrance into force of the Treaty of Lisbon on 1 December 2009, the CFI's official *name* was changed to the General Court. However, for the sake of the work, the Court will be referred as CFI.

² Hereafter ECJ. Due to the entrance into force of the Treaty of Lisbon on 1 December 2009, the *ECJ's* official *name* was changed to the Court of Justice *of* the European Communities (CJ). In this work, the Court will be referred as ECJ for consistency.

³ Hereafter OHIM.

CHAPTER II

THE SUBSTANTIVE LAW OF TRADE MARK LAW IN THE EUROPEAN UNION – PREAMBLE

In order to gain all the benefits that a trade mark may bring, it is necessary to register. Registration allows one to enjoy trade mark rights in full; registering a mark secures benefits that otherwise are not obtainable, one of the most noticeable being the evidence of ownership of the mark. Once a trade mark is registered it is protectable by an action, the same available in any other property right infringement, such as damages, injunctions and even criminal penalties.

To create a mark that is capable of registration is not an easy task since any sign can be a mark. However, bear in mind that not everything is capable of registration.⁴ Generally, a trade mark is ‘anything’ that serves to distinguish a product of one manufacturer from products of another. Most countries require that a mark must be distinctive, meaning that it should be capable of distinguishing the product of one company from the products of others.

Trade mark rights may also be gained by their actual use, meaning that without registering a mark it may still be protected under other laws *i.e.* passing off or unfair competition laws. This work however, will focus only on the structure of trade marks in the European Union (Community Trade Mark (CTM)),⁵ namely, the subjective law behind the registration of a trade mark.

The protection of trade marks in Europe is organised at two different levels. At national level, each Member State of the European Union has its own set of rules. This set of rules, arguably, has been harmonised via Directive 89/104/EEC of 21 December 1988.⁶ Each Member State has implemented in their own laws the features of the Directive, enabling

⁴ They could be rejected by the Trade Marks Registry during examination or objected by third parties during opposition proceedings.

⁵ Hereafter CTM.

⁶ OJ EC No L 40 of 11.2.1989

the creation of a level playing field. So whilst the substantive law applicable to trade marks is harmonised, procedural law is not. At community level, the community trade mark corrects some of the defects of the national systems of protection. Also note that Council Regulation No 40/94 of 20 December 1993 (Community Trade Mark Regulation (CTMR))⁷ provides a framework within which a single registration is sufficient to ensure protection in all Member States.

In this chapter an attempt is made to provide the knowledge required to navigate the European trade mark landscape in the context of registration. Whilst examining each of the steps that a trade mark must fulfil, close inspection will be made of jurisprudence in the United States, thus, comparing and hence, suggesting any changes if needed in our (EU) legislation.

2.1 The Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark (CTMR)

An application to register a CTM can be done either through the national trade mark registry or in Alicante, Spain at the OHIM. It is a separate and distinct office from that of national registration marks. A CTM offers applicants and potentially trade mark owners a unified system of protection throughout the EU with the filing of a single application (recognized in all countries of the EU). However, note that applying for a CTM does not stop businesses from also applying nationally for trade marks. For example, applications in the UK will be subject to the Trade Marks Act 1994. In Spain, applications are subject to the *Ley de Marcas Ley 17/2001* and in France it is the *Code de la Propriété Intellectuelle*, which governs substantive and procedural laws.

The community trade mark however will only require one registration with the OHIM, or one registration with a national office, which as mentioned, will then send the application to OHIM.

⁷ OJ L 011, 14.1.1994. Hereafter CTMR.

Bear in mind that the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trade Mark⁸ codifies Council Regulation 40/94 and its various minor amendments, which it repeals. The new Regulation, which is a codification and not an amendment, comes into force 20 days after its date of publication. For consistency through this research, the old version is used -- Regulation 40/94.

It seems therefore an appropriate time to provide the reader with a modest background on some of the EU institutions that are relevant to the TM system at the EU level as well as the national one.⁹ Note that the intention is to describe rather than to analyse: to have a basic understanding on how the EU institutions operate and the relation between them and the national counterparts.

2.1.1 The European Court of Justice (ECJ)

The ECJ is the ‘guardian of Community law’, establishing the European Community. It is the key institution when it comes to interpreting the Treaty and any secondary legislation (Intellectual Property law and in particular Trade Mark law is now an area very much influenced by European law). In performing this role, the ECJ interprets the meaning of the founding treaties and thus, gives effect to legislation made under them.¹⁰ Therefore, the ECJ looks at the intention behind the words rather than interpreting them literally. There is no right of appeal against a decision of the ECJ, unless new facts arise. Still, the ECJ hears appeals from the CFI points of law only (Art 225(1) EC).

It is worth noting that the ECJ is assisted by eight Advocate-Generals, who deliver in open court a reasoned and impartial opinion on most cases that go before the ECJ. It is not their role to prosecute the case nor do they take part in the Court’s deliberations. An Advocate General’s (AG)¹¹ opinion reviews both the facts and the parties’ submissions before describing the appropriate law. Observe that it has no legal force and it need not be followed by the ECJ, though it may be highly influential and will often set out the facts and relevant law more clearly than the judgement of the Court. The AGs’ opinions do play an

⁸ OJ L78/39, 24.03.2009.

⁹ See further P Craig and G De Burca, *EU Law: Text, Cases and Materials* (4th edn Oxford University Press, Oxford 2008) Chapter 2.

¹⁰ Theological approach which gives maximum effect to the spirit of EU law.

¹¹ Hereafter AG.

important role throughout this thesis when examining the requirements of registrations and also when analysing case law.

In the same line, observe that to enable the ECJ to exercise its functions of interpretation and to ensure uniform interpretation of Community law, Art 234 EC establishes a procedure for preliminary rulings; preventing though the development of national case law inconsistent with EC law. The interpretation is made by the ECJ on reference from a national court asking for clarification of a point concerning the interpretation of Community law. Then where a preliminary ruling has been made by the ECJ, its interpretation is then applied by the national court. It is indeed, the foundation of the doctrine of supremacy of EC law, whereby EC law is supreme. Therefore, the ECJ's interpretation of the point of Community law considered also binds other national courts. Preliminary references are common and thus, many national intellectual property cases are decided using this procedure and this will be observed through this thesis since the majority of cases regarding unconventional trade marks have been referred to the ECJ such as: *Sieckmann*, *Libertel*, and *Shield* for example.

2.1.2 The Court of First Instance (CFI)

The CFI is an independent court attached to the ECJ. This new institution was created to ease the pressure of work on the ECJ. It has jurisdiction over disputes between the Community and its servants and applications for judicial review and damages (Art 230 and Art 232 Treaty establishing the European Community (TEC)). From 2004, the CFI also has the competence to hear preliminary ruling procedures described above.

2.1.3 The Office for Harmonisation in the Internal Market (OHIM)

OHIM is the official European Union agency responsible for registering trade marks and designs that are valid in all 27 countries of the EU. OHIM is an independent, self-financing, non-profit-making European agency. The office is based in Alicante, Spain. The role of the OHIM is to “contribute towards the harmonious development of economic activities throughout the Community by managing a system that enables companies [...] to

acquire the rights relating to the exclusive use of signs to identify their goods or services in the vast territory of the Community”.¹²

In the same line, there is the Board of Appeal (BoA)¹³ which is responsible for deciding appeals coming from first instance decisions. The BoA is part of the OHIM and there exists a functional continuity between them. However, in deciding a case, the members of the BoA are independent and not bound by any instructions coming from the OHIM. Yet, the BoA is bound, by the law, in the interpretation given by the CFI and the ECJ.¹⁴

To finalise this section regarding the EU institutions, it is important to observe that these bodies are the spine of not only the EU but also to Trade Mark law.

We now embark with the introduction of today’s legislation -- the written law that governs trade marks in Europe. This is as said, a preamble that will bring into the light the frequent concerns when applying for registration and therefore will convey those that relate to chemical sense marks.

2.2 What Constitutes a Trade Mark -- the Definition

Article 4 CTMR defines trade marks as “any *sign* capable of being *represented graphically*, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are *capable of distinguishing* the goods or services of one undertaking from those of other undertakings”¹⁵ (emphasis added).

It is clear from the previous concept that there are three elements that a registrable mark must have. These are first of all, a sign; secondly, represented graphically; and thirdly, capable of distinctiveness. These are now explained in turn but bearing in mind that they will be parts which will be given further examination in different chapters.

¹² BEDA Report, ‘Communicating the Value of Design and Innovation for Europe’ <<http://www.beda.org/images/pdf/c2058cb2949953510bdf0b2af5edecd1.pdf>> viewed on December 2008.

¹³ Hereafter BoA.

¹⁴ OAMI, ‘Boards of Appeal’ <<http://oami.europa.eu/ows/rw/pages/OHIM/institutional/BoA.en.do>> viewed on December 2008.

¹⁵ Art 4 CTMR.

2.2.1 Sign

Article 4 CTMR gives a non-exclusive list and thus, accordingly a variety of signs can be registered as trade marks. A sign is not subject to a specific level of linguistics (in the case of words) or any artistic innovation (creativity or imaginativeness as in other intellectual property figures). Having said that, a sign could be regarded as anything that conveys information.¹⁶

In addition, it includes non-visual marks as ratified by the ECJ in the *Sieckmann* case “...a trade mark may consist of a sign which is not in itself capable of being perceived visually...”¹⁷ Then, according to AG Ruiz in the same case, a sign is any message capable of perception by the senses.¹⁸ What is more, in *Nichols*,¹⁹ a case regarding surnames, the ECJ found that Art 2 of the Directive encloses a list, described as a ‘list of examples’ and thus a list which is open. Moreover, it is explained that recital seven of the Preamble of the Directive, sets up a list of signs that may constitute trade marks, which according to the ECJ,²⁰ is just a list of examples which is non-exhaustive.²¹

The Lanham Act

The US does not have a proper concept for trade mark as such. Still, a set of elements can be extracted from the law which, if complied with, will constitute a mark. The Act defines trade marks as follows:

“§1127 The term “trademarks” includes any word, name, symbol, or any combination thereof-
used by a person, or
which a person has a bona fide intention to *use in commerce* and applies to register on the principal register established by this chapter,

¹⁶ *Koninklijke Philips Electronics NV v Remington Consumer Products* C-299/99.

¹⁷ *Ralf Sieckmann v Deutsches Patent- und Markenamt* C-273/00.

¹⁸ *ibid.*, AG Opinion, para. 21.

¹⁹ *Nichols plc v Registrar of Trade Marks* C-404/02.

²⁰ *Ralf Sieckmann v Deutsches Patent- und Markenamt*, *op. cit.*

²¹ *ibid.*

to *identify and distinguish* his or her goods, including a unique product, from those manufactured or sold by others and to *indicate the source* of the goods, even if that source is unknown”²² (emphasis added).

As in the EU legislation, some elements can be extracted; the first one that can be detected is the fact that there exists an open list of what can be regarded as a trade mark.

Comparable to the EU, non-visual marks are neither enumerated nor excluded. What is more, the Lanham Act states at §1052 that “a mark cannot be refused registration on account of its nature”.²³ By this ruling, it is observed that US law prepares the path for any other form of trade mark --anticipating the future. Contrary to this, the EU law did not establish that view from the start (neither the Directive nor the Regulation mentioned it); however, later on such presumption has been adopted by way of interpretation.

By opening with both set of rules (the EU and the US), the intention is to make the reader aware that chemical senses might be signs and so potentially marks.

2.2.2 Represented Graphically

A mark should be able to stand alone; capable of being precisely understood by anyone without referring to samples.²⁴ What is sought with this requirement is implicit. The purpose of graphical representation is to determine the precise nature of a mark thus enabling any third party to find out what the mark is. Moreover, it would help the officer in the examination process and furthermore in the publication of the application in the Community Trade Mark Bulletin. The ECJ has determined that “...the object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign...”²⁵

This requirement has attracted a lot of attention in recent years. Heated debates have been heard when non-visual marks and colours are at issue. The ECJ faced this matter in the *Sieckmann*²⁶ case; can a non-visual mark be registered? And if so, how can it be

²² 15 U.S.C § 1127.

²³ §1052.

²⁴ *Swizzels Matlow Ltd's Application* [1998] RPC 244.

²⁵ *Ralf Sieckmann v Deutsches Patent- und Markenamt, op. cit.*

²⁶ *ibid.*

represented graphically? As mentioned earlier, the ECJ confirmed that a sign that is not visually perceived may be a trade mark. Therefore, the ECJ interpreted the graphical representation issue by naming some models such as: images, lines or characters. However, it emphasises that such representation must be "...clear, precise, self-contained, easily accessible, intelligible, durable and objective."²⁷ It is observed that after the *Sieckmann* case there have not been any successful registrations regarding chemical senses. It is clear that the test closed the door to different types of representations such as: chemical formula, due to being insufficiently intelligible, not precise, unclear and thus few people would recognise it; a description, due to not being clear, precise and objective; a deposit of an odour sample, due to not being a graphic representation and not being stable.

Nowadays, when non-visual marks and/or any other unconventional mark are at issue, the CTM examiners rely heavily on cases such as *Sieckmann* and *Libertel*;²⁸ both focusing on the incapability of signs to be distinctive and being unable to be represented graphically.

However, for sound marks the path appears to have been eased after the *Shield*²⁹ case. In this case the ECJ held that the written language description of a sound, an onomatopoeia, or an individual sequence of musical notes would not be acceptable since they are not regarded as clear, precise and objective. However, it gave a suggestion as to how a graphical representation could be achieved when a sound mark is at issue. It asserted that "...a stave divided into bars and showing, in particular, a clef [...], musical tones and rests whose form [...] indicates the relative value and, where appropriate, accidentals [...] - all of this notation determining the pitch and duration of the sounds - may constitute a faithful representation of the sequence of sounds forming the melody in respect of which registration is sought."³⁰

Having said that, the Court believed that this representation (a scale), even though not immediately intelligible, would allow third parties to understand what the mark is, since it would be easily intelligible.³¹ While the Court's view is right to assert that to understand a scale (a 'representation') there will be some delay due to its intelligibility, the Court's view

²⁷ *Ralf Sieckmann v Deutsches Patent- und Markenamt*, *op. cit.*

²⁸ *Libertel Groep BV v Benelux MerkenBureau* C-104/01.

²⁹ *Shield Mark BV v Joost Kist h.o.d.n. Memex* C-283/01.

³⁰ *ibid.*

³¹ *Shield Mark BV*, *op. cit.*

that a scale is easily intelligible is questionable. Graphical representation must be straightforward and thus, it is unrealistic to think that a scale will be easily understandable. Hence, not just time would be necessary to understand it but a person who has knowledge of music.

Therefore, the intelligible character mentioned by the Court would be just simply for those who have the musical knowledge and thus, not for everyone. Moreover, as the CTM does not provide for a deposit system (like the US) then this search would become inconvenient.

Graphical representation has presented problems in other types of unconventional marks, even in those that are visual, namely colours. In *Libertel*,³² a single colour mark was disputed. The sign consisted of an orange rectangle (to be found in the application form at the reproduction section), and the word orange (to be found in the application form at the description section). The argument was whether the reproduction and description could suffice as fulfilling the requirement of being represented graphically.³³ Deciding the case, the ECJ applied the *Sieckmann* test and established that a mere sample was not durable and may fade due to the environment where it is placed or over time. The Court extended its reasoning explaining that a verbal description of a colour may pass the test as well as the combination of a sample and a verbal description. The Court even considered an internationally recognised colour identification code to satisfy the above criteria.³⁴

It is worth mentioning that before the *Sieckmann* case, chemical senses, sound and colour marks were registered without such upheaval. Graphical representation was fulfilled, in the case of smell and taste, with a simple description; in the case of sound marks, a more detailed description was to be given. Nowadays however, it is obvious that a mere description would not fulfil the *Sieckmann* test since they are not clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The issue regarding chemical senses are a dilemma and thus one may wonder, does it have to do with them being non-visual? Or is it because they do not function as a mark? Or is it just because they are subjective and difficult to assess from the legal point of view?

³² *Libertel v Benelux*, *op.cit.*

³³ *ibid.*

³⁴ *ibid.*

Certainly, much has been said implying that if the graphical representation requirement were not in place, smell marks would be granted more often in Europe. I disagree. While at first this seemed to be the barrier, by the development of this work I will question this supposition.

The Lanham Act

Neither the Act nor common law requires graphical representation. It is indeed the major difference between the US and the EU jurisdictions. However, the fact remains that although the concept of trade mark does not involve such a requirement, when the application is made, a drawing of the mark must be done. This must be a substantially accurate representation of the mark as used (or intended to be used) in connection with the goods/services.³⁵ At a later stage, the drawing is used to reproduce the mark in the Trademark Official Gazette and on the registration certificate. However, bear in mind that in the US there are two types of drawing: a special form of drawing and a standard character drawing. The former is to be applied to those marks that have partially or wholly elements such as colour, design (2D/3D), style of letters, and unusual forms of punctuation.³⁶ The latter is to be applied to all other types of marks, including the more conventional ones.

In the case of non-visual marks, the application form does not require the submission of drawings³⁷ since those marks are not capable of representation. They are only exempted if the mark consists ‘merely’ of a sound, smell or any other non-visual matter. However, this requirement must be fulfilled by a detailed description of the mark.³⁸ It is important to be aware that description is not an addition to the requirements since all marks may include it. However, in the case of a mark being unclear or ambiguous, or in the case of design, colour, motion marks or a mark being a sound, smell or any other non-visual element, such a requirement is obligatory.³⁹

The detailed description requirement may have been incited by unconventional marks that are visual. In the case of colour and trade dress not just a special form of drawing is

³⁵ 37 C.F.R. §2.51.

³⁶ 37 C.F.R. §2.52(b).

³⁷ 37 C.F.R. §2.52(e).

³⁸ 37 C.F.R. §2.52 (e).

³⁹ 37 C.F.R. §2.37.

required but an accompanying description is needed to explain unclear or vague elements of the mark (details that otherwise may not have been lucid in the drawing). The requirement of description is not a choice but an obligation. It is observed on one hand that in the case of non-visual marks the drawing is waived by a description and on the other hand, in the case of (unconventional) visual marks the principle of description does not supplant drawing but complement it. Hence, these two requirements, that of drawing and description are needed in order to establish parameters.

One can suggest that the EU ought to improve the requirement of graphic representation. There is no reason to request that a mark that is not visual as *per nature*, should be visual. Even though the reason behind this requirement is adequate and desirable, the requirement needs to be flexible enough to accommodate chemical senses. That said, I believe that the method used in the US is realistic. Nonetheless, the question of whether a description is enough because of its simplicity is open to debate. Even so, the US can fulfil such minimalist requisite by requiring a specimen, but it is important to remember that in the EU, such an obligation does not exist. Because of that: should the EU follow the US in accepting a mere description for non-visual marks? If so, a specimen ought to be required.

Specimens are required to be submitted to the United States Patent and Trademark Office (USPTO)⁴⁰ for all types of marks. Concisely, the specimen is the ‘actual example’ of the mark as it was illustrated in the drawing.⁴¹ In the case of goods, it may be a label, tag, container (for the product), a display associated with them and any other document related to the sale when it is not possible to place the mark on the goods or packaging for the goods.⁴² In the case of services, it must show the mark as it is actually used in the sale or advertising of the services.⁴³

In practice, problems seem to be presented when a mark is non-visual and no drawing can be submitted. Having said that, we should look at how other unconventional marks have resolved such issues for some guidance when in presence of chemical sense marks. For

⁴⁰ Hereafter USPTO.

⁴¹ A drawing is not the same as a specimen and *vice versa*. Neither a photocopy of the drawing, picture, nor an artist’s drawing is an adequate substitute for a specimen (Trademark Manual of Examination Procedure (TMEP) § 904.04).

⁴² 37 C.F.R. §2.56 (b)(1).

⁴³ 37 C.F.R. §2.56 (b)(2).

instance, the Register requires that the specimen should be flat or at least capable of being folded flat and to have limited measurements. In the case of 3D shapes where a specimen cannot fulfil such requirements, it may be substituted by a photograph⁴⁴ or a facsimile⁴⁵ bearing the mark. If no other alternative is found, the submission of an audio, video, or other medium may be accepted.⁴⁶ Regarding applications submitted electronically, the specimen must be a digitized image in .jpg format.⁴⁷ In the case of colour, the specimen must be submitted showing use of the claimed colour (TMEP § 1202.05(f)).

When sound marks are at issue, early cases submitted music scores,⁴⁸ cassettes and later on CDs and Internet transmission.⁴⁹ Nowadays, if the application is being made electronically a .jpg file is required which basically consists of an assertion that a ‘wav’ or ‘mp3’ file has been sent to the Trademark Electronic Application System (TEAS)⁵⁰ Support Team for processing. Moreover by August 2005 all sound mark specimens have been replaced by a ‘wav’ file or ‘mp3’ file.

In the case of chemical senses or any other non-visual marks, the Trademark Manual of Examination Procedure (TMEP)⁵¹ does not establish any specific type of specimen to be submitted. However, the proviso 37 C.F.R. §2.56 (c)(3) establishes that “...if no other alternative is found, the submission of an audio, video, or other medium may be accepted.” At first, it is noticed that the enumerated examples are visual, so transforming something which naturally is non-visual to a more convenient state (visual) is not quite feasible. Certainly, smell and taste pose a dilemma due to their nature; they do not dictate how to record them. However, at the end of the proviso it is stated that ‘any medium’ will be accepted and therefore, we can presume that the Registry is open to any submission. In

⁴⁴ TMEP §1301.02(c).

⁴⁵ 37 C.F.R. §2.56 (d)(1).

⁴⁶ 37 C.F.R. §2.56 (c)(3).

⁴⁷ 37 C.F.R. §2.56 (c)(5).

⁴⁸ Twentieth Century Fox Film Corporation registered a sound mark for entertainment services. The mark is described as “nine bars of primarily musical chords in the key flat; the chords consisting of four, eight and sixteen notes”. The specimen at the time was a sheet music, however, by 2003 the drawing was amended as “sensory mark - no drawing” and by August 2005, a specimen was submitted in mp3 format (US Trademark Registration No 2000732).

⁴⁹ AWS Convergence Technologies Inc, registered a sound mark described as “a series of five chirps similar to the chirping sound of a cricket” for software for notifying consumers of live weather conditions (Trademark (sensory mark) (USPTO) No 2827972). A sound file was submitted separately to the Trademark Electronic System (TEAS) Help Section.

⁵⁰ Hereafter TEAS.

⁵¹ Hereafter TMEP.

practice, this has been followed and thus different types of specimen have been submitted, such as: a specimen containing the goods with the smell⁵² and also a tissue impregnated with the smell. While at this stage no taste mark has been registered in the US,⁵³ there appears to exist no barrier regarding the submission of ‘any’ specimen. Moreover, by following the evolution of specimen allowed in the US it is seen how they are responding to current developments.

To conclude, whilst the US does not require graphical representation, it is observed that by other requirements such as: a description, drawings and submitting specimens, the aim of the graphical representation is satisfied -- an accurate representation of the sign. This policy and practice grant opportunities to chemical sense marks.

Having studied the second requirement we now proceed to revise the final one: distinctiveness, noting that a basic examination will be presented given that there is a Chapter that examines in full such requisite.

2.2.3 Capable of Distinguishing

The distinctiveness test has to be passed in order for a sign to be registered. A sign has to distinguish the goods/services from those of other traders. A mark should be capable of conveying information especially that of source-quality. Even though there is a wide range of signs that can be registered, it does not mean that everything is capable of being a mark. That said, if a sign is found not distinctive, it may not be registered. Distinctiveness or a distinctive mark is to be understood not as a unique, or unusual or even exceptional feature of a sign but as a sign that represents the goodwill of a trader.⁵⁴

Even though a sign may be new and visually distinctive and thus recognised as different from others on the market, it does not mean it is inherently distinctive in a trade mark

⁵² The ‘bubble gum scent’ for lubricants and motor fuels for land vehicles (*Midwest Biologicals Inc Trademark* (USPTO) No 2.568.512). Also see *re Clarke*, ‘plumeria scent’ for sewing thread and embroider yarn (US Reg No 1.639.128).

⁵³ Registration of the orange flavour for antidepressant pills and tablets was sought but did not succeed. The Trademark Trial and Appeal Board concluded that as orange flavouring performs a functional part of our lives, that it could never function as a trade mark (*re N V Organon* 79 USPQ 2d (BNA) 1639 (TTAB 2006)).

⁵⁴ P Jaffey, ‘The New European Trade Marks Regime’ (1997) 2 *International Review of Industrial Property and Copyright Law (IIC)* 153, 154.

sense.⁵⁵ Distinctiveness is a matter of fact. The assessment is based on the sign being recognised by consumers as a trade mark.

However, such a requirement brings some major problems for unconventional marks where such signs could be seen as part of the product in the case of chemical senses, or a common shape which carries the product (3D).

The general principle of distinctiveness is that the sign must make it possible to distinguish the goods/services by their business origin, and not by their quality or intended purpose. Nonetheless, public perception plays an important role, if not a definitive one. Thus, Daniel Alexander QC has mentioned that according to public perception, signs should be categorised. Starting from the most distinctive to the least, the first category should be invented words and fancy devices, followed by semi-descriptive words and devices and finally shapes. The first signs would by nature tell the consumer who made them, however the last are unlikely to convey such a message since the consumer is not used to receiving that information from a mere shape⁵⁶ or slogans.⁵⁷

In *Bongrain SA Trade Mark Application*,⁵⁸ it was held that there are differences in creating a fancy shape to sell and a fancy shape which truly in itself denotes trade origin; could the same premise be applied to non-visual marks? Regarding colours, Professor Phillips mentions that it is safer to rely upon acquired distinctiveness rather than to apply and hope for the examiner to view such a colour as distinctive.⁵⁹ He refers to the *Libertel* case where the ECJ has held that a colour will almost never be inherently distinctive. However, it is accepted that some colours may be distinctive without any prior use especially in those cases where the number of goods/services for which the mark is claimed is very restricted and the relevant market very specific.⁶⁰

⁵⁵ *Yalkut's Application* [2001] RPC 39, para. 10.

⁵⁶ *Henkel v OHIM (Ovoid dishwasher tablets)* C-144/06P..

⁵⁷ *Das Prinzip der Bequemlichkeit* T-138/00, para. 35.

⁵⁸ *Bongrain SA's Application* [2004] EWCA Civ 1690.

⁵⁹ J Phillips, *Trade Mark Law: a Practical Anatomy* (Oxford University Press, Oxford, 2003) para. 5.125.

⁶⁰ *Libertel v Benelux, op. cit.*, para. 66.

The Lanham Act

US law establishes the distinctiveness issue. Similar to the EU, there is no statutory standard; however, the strength of the mark plays an important role and thus the courts have followed a classic principle.⁶¹ This refers to a degree of eligibility for trade mark protection and thus a categorisation of marks according to their strength is as follows: in ascending order, generic, descriptive, suggestive and lastly, fanciful or arbitrary. The distinctiveness issue, as in Europe, is a matter of fact. The assessment is based on the sign being recognised; each mark, its degree of distinctiveness may be determined by considering its own merits and its context, therefore the way it is used (or intended to be used) in commerce and in connection with the goods,⁶² is evaluated.

Differences and similarities can be seen between both jurisdictions. On one hand, while the Lanham Act does not establish what distinctiveness is or classify it by type, the EU Regulation sets up the distinctiveness issue with a potential list: lack of distinctiveness, descriptive marks and customariness marks; however, observe that it is still of debate if they are types/kinds of marks. Moreover, dispute exists regarding whether the list describes the strength of the mark. Still, the point is that the EU Regulation names them (black and white) while the US follows them by way of case law. Is that important? The situation is that in practice neither the EU nor the US draw the line between those said ‘types of distinctiveness’. Both jurisdictions do not have a set procedure when a non-trivial mark is at issue.

In the Lanham Act there is an element which does not appear in the EU Regulation. It establishes that a ‘word, name, symbol or device’ needs to ‘indicate the source’. Therefore, once a mark is capable of distinguishing, it will identify its origin. What is needed is to recognise that such a product comes from a particular company even if that source is unknown since it can still indicate its origin. Whilst the EU does not require this in its legislation, it is imperative for this element to be in place. Indeed, this requirement is sought by the EU while examining the distinctive element.

Having studied the elements of trade marks, it is now time to examine the administrative process. Even though the whole administration development is not important to the present

⁶¹ *Abercrombie & Fitch Co v Hunting World Inc* 537 F2d 4 (2d Cir 1976).

⁶² *Re Omaha National Corp* 819 F 2d 1117, 2 USPQ2d 1859 (Fed Cir 1987).

work, the examination process, specifically the grounds for refusal, are crucial since it is there where the bars of registration will be imposed and then, the said sign will not be able to be registered.

2.3 Application and Registration Process

The filing in of the application is the first step, which includes: the applicant's identification, the representation of the mark and an indication of the goods/services within which the applicant intends to use the mark (the International Classification of Goods and Services -- the Nice Agreement). The application form is submitted at OHIM in Alicante, Spain⁶³ or, at the central industrial property office of a Member State or at the Benelux Trade Mark Office⁶⁴ accompanied by payment.⁶⁵ Once the application is received, a preliminary examination is made and a date of filing⁶⁶ is given which, if the application succeeds, would become the date of registration. Once the application has been filed and verified and, being in proper order and content, an officer would conduct a substantive examination which comprises the grounds for refusal of registration. Bear in mind that although the basic requirements have been fulfilled, this would not guarantee the mark being registered.

The grounds for refusal are split in two: absolute grounds and relative grounds. I will now look at these in more detail.

2.3.1 Absolute Grounds

In this situation the officer will do a substantive examination looking deeper into the sign *per se*. In particular, the Officer will assess Art 7 CTMR which provides us with trade marks that shall not be registered because they lack of distinctiveness; or they do consist exclusively of shape that achieve a technical result or are contrary to public policy for example. At this stage I will only examine the general idea under this Article thus giving the reader a notion of what an Officer deals with once presented with a sign.

⁶³ Art 25(a) CTMR.

⁶⁴ Art 25(b) CTMR.

⁶⁵ Art 26 CTMR.

⁶⁶ Art 27 CTMR.

Art 7(1)(b), (c) and (d) CTMR -- lack of distinctiveness

Starting with signs that do lack of distinctive character it is important to affirm that the requirement established in Art 4 CTMR, that of 'capable of distinguish' and the one established by Art 7(1)(b), (c) and (d) that of 'not devoid of distinctive character', is not to be seen as a separate or different requirement.⁶⁷ All these provisions inevitably focus on the issue of distinctiveness. That said, I will explore this area deeper in the next Chapter.

The distinctive character is invariable regardless of the nature of the sign concerned and thus, the criteria for assessing the distinctive character does not differ according to the type of sign.⁶⁸ However, it could be more difficult to establish distinctiveness in relation to some marks than in relation to others. Yet, it does not mean that there is a tougher test of distinctiveness to be applied to some types of marks.⁶⁹ The problem is that unconventional marks are not considered distinctive enough, because on one hand they would not be perceived by consumers as an indicator of origin and on the other, the principle of availability is in place.

In the first situation: indication of origin, it is believed that the public, in order to recognise those marks, have to be first educated to view such unconventionality as a proper mark. Accordingly, a container is not just a simple container, a packaging colour is not just an eye catching feature and a smell of a pencil is not some fanciful attribute; all of these features could be indicating origin but it is observed that it is difficult for those marks to be distinctive and thus registered. Still, nowadays the situation has changed; consumers have learnt to look for those features.

In the second situation, as the principle of availability is the key, the public interest therefore is the main concern. Having said that, signs that may serve in trade to designate characteristics of the goods/services for which registration is sought must be kept free. It is believed that the reduction of the stock of certain types of marks which are in limited supply should be avoided.⁷⁰ Certain signs must be free for all to use, maintaining therefore

⁶⁷ *West (t/a Eastenders v Fuller Smith & Turner plc* [2003] FSR 816.

⁶⁸ *Henkel v OHIM*, *op. cit.*, para. 38.

⁶⁹ *Linde AG and others v Deutsches Patent- und Markenamt* Joined Cases C-53/01, C-54/01 and C-55/01, paras. 40-41.

⁷⁰ *Bongrain SA's Application*, *op. cit.*

a healthy competition.⁷¹ This provision must be interpreted in the various grounds for refusal.⁷² Nonetheless, this principle was rejected by one of the opinions given by AG Cosmas in the *Chiemsee*⁷³ case. He affirmed that the Directive did not recognise such a principle of availability and that the only principle that the Directive did recognise was that a mark could be registered only if it was available in so far as not conflicting with earlier marks.⁷⁴ In contradiction, the ECJ affirmed the role of public interest.

Moving to descriptive marks the matter of distinctiveness is also at issue since a mark that describes the kind, quality and intended purpose of the product is not distinctive. Without doubt, word marks have been the most problematic ones. It is seen in cases such as *Baby-Dry*⁷⁵ and *Doublemint*.⁷⁶

Now then, more relevant to this work is the discussion of whether unconventional marks can be descriptive. In this matter, the ECJ established that 3D marks consisting of the product's shape could be descriptive if taking the general interest into account.⁷⁷ A shape then, may be descriptive if it is perceived by consumers as representing the product itself in its most evident or familiar form, rather than as an indicator of origin.⁷⁸ Having said that, the recognition of a general principle that certain signs should be kept free for use by other traders (principle of availability) is a key issue in determining if a mark is descriptive.⁷⁹ It seems then, that this principle applies equally to all types of marks and so including chemical sense marks.

Finally, customary marks are also bar from registration because the relevant public will not associate the sign with source. There are circumstances when a trade mark has become customary in the current language or in the *bona fide* and established practices of the trade to designate the product in respect of which that mark's registration is sought. Yet,

⁷¹ L Bently, and B Sherman, *Intellectual Property Law* (3rd edn Oxford University Press, Oxford 2009) p. 807.

⁷² *Henkel KGaA v OHIM*, Joined Cases C-456/01P and 457/01P.

⁷³ *Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots- und Segelzubehor Walter Huber & Frank Attenberger* C-108/97.

⁷⁴ A Fox, 'Does the Trade Mark Harmonisation Directive Recognise a Public Interest in Keeping Non Distinctive Signs Free for Use?' [2000] *EIPR* 1, 2.

⁷⁵ *Procter & Gamble Co (Baby-Dry) v OHIM* C-383/99P.

⁷⁶ *Wm Wrigley Jr Co v OHIM* C-191/01P.

⁷⁷ OHIM, Annual Report 2003 <<http://europa.eu.int>> viewed on Feb 2007.

⁷⁸ *ibid.*

⁷⁹ *Linde AG, op. cit.*, paras. 40-41.

relevant to chemical sense marks is the fact that the Article refers to ‘language’ and so, the question is whether this Article should be taken literally or should be extended to other types of marks. Moreover, it has also been questioned if the Article should cover only trade marks which ‘directly’ describe the properties or characteristics of the goods/services covered by them. On the latter issue, the ECJ interpretation asserts that a sign cannot be considered alone and so, it should not be limited exclusively to trade marks which describe the attributes of the goods/services covered by them but also the way they are used in the market⁸⁰ (advertisement, quality, encouragement to buy the product, etc.). If we bring to chemical sense marks we may notice that there are situations in which a chemical sense for instance will not only describe directly one characteristic of the product: orange flavour tablet, but also there are other situations in which it might symbolize quality: pine odour to a cleaning solution for floors.

The Proviso -- Art 7(3) CTMR

Close observation should be given to this proviso which establishes the following:

“Paragraph 1(b), (c) and (d) shall not apply if the trade mark has *become distinctive* in relation to the goods or services for which registration is requested in consequence of the *use* which has been made of it” (emphasis added). As seen, a distinction is made between inherent and acquired distinctiveness. The former applies if the sign itself has a distinctive character and the latter is referred to in the proviso establishing that a sign may, through use, acquire a distinctive character and thus be capable of registration. Bearing in mind that distinctiveness is a factual issue, a sign may acquire secondary significance through use.⁸¹ This is, in a way, similar to the so-called ‘secondary meaning’, a term which is used in the US. In concluding, if a sign is devoid of inherent distinctive character (precluding its registration) it still may occur that on the basis of Art 7(3) CTMR registration could be granted.

Note that whether the distinctive character has been inherent or acquired, it must be assessed in relation to the goods/services for which registration is applied for. Regarding acquired distinctiveness through use, the examiner would inspect such evidence. As mentioned earlier, an application lacking distinctiveness (Art 7(1)(b) CTMR), being descriptive (Art 7(1)(c) CTMR), and/or having a generic character (Art 7(1)(d) CTMR)

⁸⁰ *Merz & Krell GmbH & Co C-517/99*.

⁸¹ *Windsurfing Chiemsee v Boots- und, op. cit.*

will not be able to be registered unless the sign demonstrates that it has acquired distinctiveness.⁸² This proviso appears to open the door to unconventional marks in general because as said before, we as consumers do not see certain marks as source. Therefore, while there are some marks that are not distinctive *ab initio* they can become so by use.

The Examination Division in its Practice Note ascertains four important points: (1) the evidence of use is to be assessed in order to judge whether that use has produced a situation where a mark which would otherwise have to be refused on one or several of the grounds listed in Art 7(1)(b), (c) and (d) has become distinctive. It is not simply about whether and to what extent there has been use; (2) the use must be of the trade mark applied for and not of a considerable variation; (3) the use must relate to the goods/services that are the subject of the application; and (4) only objections under (b), (c) and (d) can be overcome in this fashion. An objection relating to other grounds cannot be raised under this proviso.⁸³

Overall, the evidence has to show that such use is sufficient and thus it is implied that a significant proportion of relevant consumers have come to regard the claimed mark as a trade mark.⁸⁴ However, such recognition does not have to be immediate.⁸⁵ Another important issue regarding ‘sufficiency’ is that time and considerable expenditure in advertising are also crucial points.⁸⁶ It is important to mention that established case law requires that such use must be ‘use of the mark as a trade mark’ meaning that the public has become familiar with the mark because it identifies a product as coming from a single undertaking.⁸⁷

The Lanham Act

A similar approach is taken by law in the US. The Lanham Act in its sec. 1052 establishes that “except as expressly excluded in subsection (a), (b), (c), (d), (e)(3), and (e)(5) of this

⁸² ECTA European Trade Mark Association, ‘The Changing Faces of Trade Marks’ (Conference Organised by ECTA, Rotterdam, June 13 to 16, 2001, p. 104).

⁸³ OHIM, ‘Evidence of use’ (Examination Division-Practice Note)

<http://oami.europa.eu/EN/mark/marque/practice_note.htm> viewed on January 2006.

⁸⁴ *Last Minute Network Ltd's Application* R1068/200-2.

⁸⁵ OHIM, ‘Evidence of use’, *op. cit.*

⁸⁶ *Last Minute Network Ltd's Application*, *op. cit.*

⁸⁷ J Phillips, *op. cit.*, para. 4.166.

section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce." The applicant has the burden to prove that the mark has become distinctive through the use of it in commerce. He needs to prove that exclusive and continuous use of the mark has being in commerce for the five years before the date on which he claims distinctiveness. Then, as in the EU, the US will allow a mark to be registered that otherwise was not possible if the mark had developed secondary meaning.

Moving one, Article 7 CTMR sets up a subsection that is directed to shapes only. While this objection appears to be no of relevance to the present work, there is the need of examining this because firstly, they are unconventional marks and some thoughts can be borrowed and secondly, the protection given to shapes appears to be founded on a public policy that should also be also applicable to chemical sense marks.

Art 7(1)(e) CTMR -- protecting shapes

Shapes which are intrinsic to the mark *per se* due to the nature of the goods themselves (Art 7(1)(e)(i)), and those that achieve a technical result (Art 7(1)(e)(ii)) due to their functionality cannot be registered because the risk of overlapping with other intellectual property rights. In addition, if the shape gives substantial value to the goods, it will be refused registration. However, this last exclusion is related to shapes that exclusively add some sort of value to the goods.⁸⁸ Certainly, these shape marks would not be distinctive and thus, would not be able to accomplish the source identification function. Additionally, it is observed that they cannot be registered due to the principle of availability, since other traders have a legitimate interest in using it.

Nevertheless, when the ECJ was addressed with the question of aesthetically pleasing the consumer, being related as functional, the Court went to say that such shapes should find protection in Design law.⁸⁹ However, the answer relates only to shapes and not to other unconventional marks, specifically to chemical senses. The reason being that if a smell and/or taste is indeed aesthetic they cannot be protected by Design law. Does this mean that this objection -- aesthetic, could not be applicable to chemical senses?

⁸⁸ *Philips v Remington, op. cit.*

⁸⁹ *ibid.*

Once shape marks were capable of being registered, it was necessary to impose limitations on their eligibility for registration so as to prevent the competition consequences already mentioned. This premise was reaffirmed in the famous *Remington*⁹⁰ case “...competition considerations prevail in the legislation, which implements the functionality principle. They are excluded from registration, prior to any consideration of the conventional trade mark questions of the inherent or acquired distinctiveness of a mark”.⁹¹ Will this mean that if chemical sense marks start to be registered (again) the legislation is going to draw a specific objection to them? Is it possible to realize that not only shapes need to be protected?

At last, we now embark in the final subsections from Article 7 CTMR.

Article 7 ((1)(f) (g) (h) (i) and (j) CTMR

The bar from registration covered under these subsection blocks marks that are contrary to public policy or accepted principles of morality; or they have not been authorised by the competent authorities; and/or they consists of geographical indication and/or designation of origin which protects the name of regional wines, spirits and foodstuff.⁹²

This last set of objections appears not to be relevant to chemical sense marks but yet, one can imagine a chemical sense being block from registration if contrary to public policy or morality. This objection looks straightforward but nevertheless questions have arisen due to the variableness of these topics and moreover due to different religions and cultures amongst Member States.⁹³ Those marks that are to be blocked from been registered are those that are most outrageous. Subsequently, those marks that could deceive the public are prohibited under Art 7(1)(g) CTMR. However, deception shall be in connection with the nature (quality and/or geographical origin) of the goods/services.

To finalise the administration process, once a mark has been scrutinised and has indeed succeeded, the mark would be published in the Community Trade Mark Bulletin.

Nonetheless, observe that the application could be refused even after publication (Art 40

⁹⁰ *Philips v Remington*, *op. cit.*

⁹¹ *ibid.*, para. 5.

⁹² Added by Council Regulation (EC) No 422/2004.

⁹³ *Torreman*, *op. cit.*, p. 390.

CTMR). Then it is possible that at the publication stage an opposition could be made and proceedings would be opened if a third party who is the proprietor of an earlier trade mark believes that his mark conflicts with the applicant's mark (Art 41 CTMR).

To sum up, absolute grounds for refusal look for any problem with the mark alone. The examiner needs to study the sign as a potential trade mark and this circumstance will bring chemical sense to an upheaval: are they proper signs? Can they be represented graphically? Are they distinctive enough and do they indicate source? Those indeed are the challenges that chemical sense marks do present.

While this is the initial grounds for refusal and the one that scrutinises the signs as such, there is still another ground of refusal that applicants and potential owners of trade marks must be aware of, namely relative grounds. While there has not been any case regarding chemical sense marks that were block from registration due to this ground, this does not mean that they are less likely to be confronted by it.

2.3.2 Relative Grounds

This type of bar from registration does not have anything to do with the mark's inherent problems -- absolute ground of refusal, but with those that are presented by prior rights; that is, the mark has been registered already or because it has an earlier priority date. Also, observe that relative grounds for refusal are very close to infringement.

A third party may oppose the registration of a sign if one or more of the relative grounds are presented. There are:

Conflict with an Earlier Identical Mark for Identical Goods or Services (Art 8(1)(a) CTMR)

This is a straightforward exclusion which includes cases where the applicant's mark is identical to the goods/services for which prior rights exists. However, to constitute an identical mark a high level of common characteristic is essential.⁹⁴ That noted, considering whether a sign and a trade mark are identical and added to that, considering also whether

⁹⁴ *Origins Natural Resources Inc v Origin Clothing* [1995] FSR 280.

their products are identical raises certain issues. Moreover, the term identical should not be taken literally. This view was taken by the ECJ in the *LTJ Diffusion SA v SA Sadas*⁹⁵ case which will be analysed further in Chapter VI referring to infringement. This first relative ground brings concerns when chemical senses are at issue: how to analyse a smell/taste? What are the common characteristic of a smell/taste? Because of the nature of chemical sense marks: being chemicals, once can speculate that the examination of the attributes (necessary to compare the mark with another) can be a problem.

Conflict with an Earlier Identical or Similar Mark for Identical or Similar Goods or Services (Art 8(1)(b) CTMR)

This is a more complicated issue since what is regarded as similar is still of debate. However, this diatribe was dealt with by the ECJ in the *Sabel*⁹⁶ case where both signs consisting of a feline silhouette were in dispute. The ECJ, by applying a test of ‘global appreciation’, established that the likelihood of confusion depended on numerous elements, in particular, on the recognition of the trade mark in the market. It also depended on the association which can be made with the used or registered sign and the degree of similarity between the trade mark and the sign, and between the goods/services identified.⁹⁷

In the *Canon*⁹⁸ case the same test was applied; thus similarity was assessed taking into consideration the distinctive character of the mark and in particular its reputation. In a more recent case, the ECJ confirmed the global test and clarified that ‘aural’ similarity between marks can be a factor in the test.⁹⁹ Having said that, if the public merely makes an association between two trade marks this would not in itself be sufficient for concluding that there is a likelihood of confusion. By this assertion, it is clear that even though likelihood of association serves to define likelihood of confusion, it is not an alternative.¹⁰⁰

Surely, to assess if a chemical sense mark is similar to another the same policy should apply: similarity must be assessed by applying a test of ‘global appreciation’ which takes

⁹⁵ *SA Société LTJ Diffusion v Société SA Sadas Vertbaudet* C-291/00.

⁹⁶ *Sabel BV v Puma AG* C-251/95.

⁹⁷ All these factors must be appreciated as they are evidence of deceptiveness.

⁹⁸ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* C-39/97.

⁹⁹ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* V-342/97.

¹⁰⁰ Professor Peter Jaffey asserts that likelihood of association should be interpreted as an alternative deceptiveness test which goes beyond actual deceptiveness. Yet, the rationale, he explains, is still origin deception rather than explicitly in terms of dilution (meaning the diminution in the mark’s impact on consumers -- blurring or tarnishing). P Jaffey, ‘Likelihood of Association’ [2002] *EIPR* 3, 7-8.

into consideration the distinctive character of the mark. Note that this test is based on ‘aural’ and ‘visual’ appreciation and needs to be adapted to include ‘smell’ and ‘taste’.

Conflict with a Mark of Repute (Art 8(5) CTMR)

A sign which is identical or similar to an earlier one would be refused registration in respect of dissimilar goods or services if the earlier sign is of repute and if the intended sign would, without cause, take unfair advantage or would be of detriment to the reputed mark’s distinctiveness or reputation.

This area of law -- conflict with earlier marks, will be explained and analysed deeper in Chapter VI which refers to infringement; specifically, thoughts will be given to how the law, as it stands, may apply to chemical senses.

In conclusion, relative grounds do not seek to examine a sign as a mark. It is not a process in which the mark would be scrutinised as such as it is when the Officer examines a mark for absolute grounds. It is important therefore to be aware that the examiner would not examine whether the sign applied for works as an actual mark. On the contrary, relative grounds have to do with the rights of others. In most cases, it would take ten (10) months for an application to be published.

The Lanham Act

For a mark to be registered in the USPTO, an application and a verified statement should be completed, accompanied by the set fees, by the owner of the trade mark used in commerce or a person who has a *bona fide* intention to use the trade mark in commerce.¹⁰¹ Thus, the set of requirements are pretty much the same as in the EU, that is: name of the applicant(s); listing of the goods/services; the fees. Apart from these, a verify statement¹⁰² must accompany the application form as well as a drawing.

Subsequently, once the Registrar has reviewed the minimum requirements, an examining attorney will scrutinise if the application complies with all the rules and statutes and if the

¹⁰¹ TMEP §1051 (a)(1), (b)(1).

¹⁰² A declaration stating that the mark is currently in use or that there is a *bona fide* intention to use the mark (§2.33 Trademark Law Rules of Practice & Federal Statutes).

fees are paid, a complete examination is done. The grounds for refusal of registration are found in sec 1052. The examination will include both, absolute grounds as well as relative grounds and they are very close to the limitations imposed in the EU. Thus, a mark could be refused registration if it consists of or comprises immoral, deceptive, or consists of or comprises a mark which so resembles a mark registered in the USPTO, or a mark or trade name previously used in the US and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive; consists of a mark which, when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them; when a mark is used on or in connection with the goods of the applicant and they are primarily geographically descriptive of them;¹⁰³ among others.

Once the application has been examined it will be published in the Official Gazette; at this stage third parties will have the opportunity to object to the mark. Subsequently, a Certificate of Registration will be issued if the application was based on actual use or, a Notice of Allowance will be issued if the application was based on intended purpose. Usually, an applicant will receive a filing receipt approximately six months after filing and a response from the Patent and Trademark Office would be given within six to seven months of filing the application. The total application processing time may be anywhere from a year to several years.¹⁰⁴

To end this chapter, it is certain that not only a matter of administration impedes certain marks being registered but also practice limits marks too. On one hand, it is observed that the EU and the US have their similarities and they do appear to be straightforward, but the way the law applies may vary. The US does not seem to have any major problem with the registration of non-visual marks and the law and practice are indeed responding to current market development. That said, there has always been the issue of different conception or perception of law between Europe and the United States, one being more conservative than the other.

¹⁰³ Except when the mark is an indication of regional origin (registrable under section §1054 of this title).

¹⁰⁴ Legal Zoom Trademarks Education Center, 'How long does it take for a mark to be registered?' <<http://www.legalzoom.com/trademarks-faq/how-long-register-trademark.html>> viewed on Jan 2008.

On the other hand, the key difference between the EU and the US seems to be based only on the graphical representation. The US does not require it; however, as said, a drawing is required when filling a US application. While it is debatable to affirm that they are equal, the resemblance is there. Another key issue that appears to differentiate both jurisdictions is the submission of a specimen. However, questions arise: how much weight is given in the US to this requirement? Moreover, if this requirement is set aside, would the other requirements alone complement the description of the mark? Clearly, transporting such a procedure to the EU would be practical but only to non-visual marks. This affirmation is however based on the case that the barrier to registering such a mark is only graphical representation, and as I will debate in the following chapters, chemical senses suffer from other limitations.

To end, the substantive law of trade mark in the EU legal system is a superior law and all Member States need to follow the policies and regulations; moreover, case law has a binding effect. Therefore, with this introductory chapter, the reader has become aware how the trade marks system operates and also obtained a description of the trade mark system as a whole -- positioning the reader in front of the structure and thus to start questioning how the process works when chemical sense marks are sought to be registered. Therefore, given that the reader will have at this stage a basic background, this will help to understand what will follow: an analysis of the major upheaval that chemical sense marks do have, namely, graphical representation, distinctiveness and functionality.

CHAPTER III

GRAPHIC REPRESENTATION

Before the Directive was put into place most of the EU Member States did not require graphic representation as a prerequisite. Nevertheless, it could be thought that there was no need since the only marks permitted to be registered were the traditional ones (visually perceived).

The Directive has opened the doors to new types of signs including chemical sense marks. As mentioned in the previous chapter what is needed is for the said sign to convey information. However, while it seems that the Directive has opened the doors for chemical senses to be trade marks, it also appears that has closed the doors by requiring the signs to be graphically represented. This is noticeable because after the *Sieckmann* case the burden for chemical sense marks have been raised.

Nevertheless, it is important to note that the Directive does not impose a certain manner in which a sign should be represented graphically, although this appears to be one of the most difficult requirements related to chemical sense marks. To examine this, the present Chapter studies the situation of others unconventional marks (visual and non-visual). The reason is that there exists some flexibility to comply with this requirement when other types of marks are at issue; therefore, it is disputed why a rigid obligation should persist for chemical sense marks.

3.1 Why a New Legal Framework?

The introduction of graphical representation into the European Community Trade Mark law, has brought the EU trade mark system in line with the World Trade Organization (WTO) Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement.¹ The referred requirement has been welcomed by some academics and practitioners due to the belief that this will give a more adequate searching facility on the Trade Mark Registry. In

¹¹ World Trade Organization (WTO) Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement from now on referred to as the TRIPS Agreement.

others words, as the ECJ explains: it “...avoid[s] any element of subjectivity in the process of identifying and perceiving the sign...”²

The requirement of graphical representation aims to perform the principle of ‘certainty’; it requires a clear representation of the sign. The purpose of this obligation is therefore, to have a clear and precise portrayal of the mark to be registered.

The ECJ mentions some purposes of this requirement which can be simplified and named as follows:³

- definitional purpose; determines the precise subject of the protection;
- bureaucratic function; allows the authorities to identify with clarity and precision the sign in question and therefore to accomplish their administrative duties more coherently; and
- informational function; benefits two parties:
 - a. the owners of earlier rights can, by knowing precisely what the mark is, oppose registration, and
 - b. other undertakings can determine what they can or cannot register or in other circumstances, can be aware of what signs can or cannot be used.⁴

For the above statement, there is indeed a welcome feeling to this requirement.

3.2 What Exactly Is Graphical Representation?

As mentioned, the Directive does not restrict on the manner in which a mark can be represented graphically. The only condition established is that it should be identifiable: anyone inspecting the register should actually be able to understand it.

In the EU unconventional marks follow the *Sieckmann* decision criterion and thus graphical representation is generally resolute by this case. In short, the case establishes

² *Ralf Sieckmann v Deutsches Patent- und Markenamt*, *op. cit.*

³ R Burrell and M Handler, ‘Making Sense of Trade Mark Law’ [2003] *Intellectual Property Quarterly* 388, 393.

⁴ *ibid.* See further *Ralf Sieckmann v Deutsches Patent- und Markenamt* C- 273/00, para. 48 onwards.

“that graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters...”⁵

To analyse whether this assertion blocks completely non-visual marks from registration, it is important to start by studying those unconventional marks that can successfully be represented graphically, for instance 3D shapes and colours. The reason is that even though they are visually perceived, they still suffer some problems. Therefore graphical representation is not an ease burden for unconventional marks regardless of being visual or not. This analysis will be followed by the examination of sound marks that, although non-visual, graphical representation is not as difficult as it seems.

Finally, an examination of chemical sense marks will be undertaken trying to adapt preceding thoughts and ideas. Mostly this section disputes that the requirement of graphical requirement, now appearing to be somehow flexible, should also be so when chemical sense marks are at issue -- or, in any case, this requirement needs to be applicable in a more consistent manner.

3.3 Visual Marks

Whilst the thesis refers to chemical sense marks -- non-visual marks, it is crucial to ascertain that not only they have the burden to be represented graphically but also other unconventional marks face with this as follows:

Usually, for 3D shapes marks and colours marks verbal descriptions might satisfy this requirement; however it is recognised that they are not quite as satisfactory as a design, drawing and/or picture may be. Verbal descriptions of pictorial marks tend to be unsatisfactory since they will not convey the precise look of the mark⁶ and because of that there will be the requirement for samples.

However, making a sign visually perceived does not guarantee that the graphical representation requirement is fulfilled. Graphical representation on the contrary appears not to have anything to do with vision but with ‘accuracy’. The case of *Swizzels Matlow*

⁵ *Ralf Sieckmann*, para 46.

⁶ J Phillips, *Trade Mark Law: a Practical Anatomy* (Oxford University Press, Oxford 2003) p. 771.

*Ltd*⁷ reinforces the principle that graphical representation should indicate the mark with precision and without the need to consult extraneous material. Nothing is said with respect of visualisation. In this case ‘a chewy sweet on a stick for non-medicated confectionery’ was sought to be registered by way of a description.⁸ This application was rejected on the grounds that the words suggested an infinite range of marks and therefore it was not possible to know exactly the nature of the mark without referring to samples.

Nonetheless, practice indicate that graphical representation of shapes, being goods *per se* and/or packaging, does not present problems due to its representation being fulfilled by drawings.⁹ This is indeed the way most of shape marks are represented in the application form.

Moving on to colours, common practice indicates that they may be represented by a written description accompanied by reference to a code. Hence, any of the internationally recognised colour identification systems such as PANTONE®, RAL® and FOCOLTONE® will suffice.

The consideration of colours needs further analysis since it is noticed that the need to rely on something, which is not *per se* (in) the graphical representation, appears to be accepted. Here, we can start to perceive the flexibility of the graphical representation requirement. In the case mentioned above, *Swizzels Matlow Ltd*,¹⁰ it was held that a graphical representation needed to be precise and without the need to consult extraneous material. Therefore, colour marks are the turning point: when flexibility started. Because of this statement, a possibility for chemical senses may arise: can an identification system be the solution?

Note that the approval of single colour marks in the EU was not smooth. At first, the intention was to approve colour marks as required under International law, precisely Art 15.1 TRIPS which establishes that “combination of colours...shall be eligible for registration as trademarks.” It is open then to discussion whether a single colour (by logic)

⁷ *Swizzels Matlow Ltd's Application* [1998] RPC 244.

⁸ *ibid.*

⁹ In Patent law, drawings can be used to interpret the claims.

¹⁰ *Swizzels Matlow Ltd's Application, op. cit.*

is unsuitable of registration. The reason being that by not including single colours, they therefore are excluded. One need to remember that TRIPS establishes just the minimum standards of protection to be followed by its subscribers and to register or not single colours will not make TRIPS's members to violate their obligations.

The *Libertel*¹¹ case provides us with the application of the correct procedure when presented with a single colour mark, a case brought before the Benelux Trade Mark Office. An application to register a single colour, for various telecommunications for goods and services, was sought. The graphical representation was a written description as follows: 'orange' and by a sample of the colour, reproduced by an orange rectangle. The application was rejected by the Office and, on appeal, by the *Gerechtshof*. LIBERTEL appealed further to the *Hoge Raad*; observe that at this stage neither the national Registry nor the Court of Appeal focused on the issue of graphic representation but on the sign lacking distinctive character. The Dutch court referred to the ECJ for preliminary ruling and AG L  g  r considered that distinctiveness should not be dealt with if the graphical representation was not tested first.

Following this AG proceeded to establish that a single colour cannot be represented graphically. Yet looking at the criteria for graphical representation established in the *Sieckmann* case as 'clear, precise, self-contained, easily accessible, intelligibly durable and objective', it is believed that such a conclusion, the one given by AG L  g  r, was drawn due to the submission of the applicant: the bare description 'orange'.¹² Certainly, from the application it was not possible to know how the colour was used in relation to the product. The ECJ agreeing with the AG explained that when presented with an application for a colour sign what the Registry ought to do first, is question if the sign is capable of being represented graphically; if so, the distinctiveness element will be tested next. By determining whether a single colour can be represented graphically the ECJ disagreed with the AG's opinion however. The Court consented that a written description of a colour may satisfy the *Sieckmann* criteria and what should be considered is the need to identify the 'exact shade' and its use in conjunction with the specific goods/services.

¹¹ *Libertel Groep BV v Benelux MerkenBureau* C-104/01, AG Opinion.

¹² The AG's opinion can be said to follow the same line as *Sieckmann*, even though at this time such criteria was not yet adopted by the ECJ.

Moreover, the ECJ rejected the sample of the colour alone (previously accepted in some EU countries) as a proper graphical representation due to not being durable.¹³

Nevertheless, the ECJ went further and explained that if an application is made containing both the written description and the sample, it is possible to clarify the application by adding a reference to a colour code (internationally recognised) because it is precise and stable. Nonetheless, nowadays as data in the OHIM can be presented and preserved electronically, the necessity of a colour code is questioned.

To complicate matters, the enquiry of not fixed colours in a basic geometric figure needs further analysis: do they fulfil the principle of ‘certainty’? In principle, the intention is to register colour in its own right and not be limited to colours with contours. Nevertheless, there is the need to clarify how the colour is used in relation to the product. This brings us to the situation of chemical sense marks, a sign that cannot be fixed as such due to its nature; yet, if we follow the criteria of colour marks, it appears that by indicating how the marks will be used in relation to the product, the certainty criteria is satisfied. For instance, ‘the fragrance of (x) applied to containers’.

In the case of the combination of abstract colours, the representation should follow the criteria described above: a written description and the relevant code. Nonetheless, an additional requirement is set out when the combinations of colours is in the abstract. In *Heidelberger Bauchemie GmbH*,¹⁴ the ECJ held that the representation must be in “a systematic arrangement associating the colours in a predetermined and uniform way.”¹⁵ The ECJ has not given any illustration as to what this means.

Studying some successful applications it can be suggested that submitting two (or more depending on how many the application is for) coloured rectangles might suffice.¹⁶ An illustration can be seen in the *Gugelfuss GmbH Application*.¹⁷ The applicant sought to register the colours blue: RAL 5015, and red: RAL 2002. In the description, the distribution and ratio of the colours to each other was quoted as “is 50 - 50”; it was followed by the

¹³ For further assistance see C Schulze, ‘Registering Colour Trade Marks in the European Union’ [2003] *EIPR* 55.

¹⁴ *Heidelberger Bauchemie GmbH* C-49/02.

¹⁵ *ibid.*

¹⁶ *Gugelfuss GmbH Trade Mark* CTM No 2177566. See also *Yellow/Green II’s Application* (German Federal Supreme Court, 05 October 2006, case I ZB 86/05).

¹⁷ *ibid.*

way the colours were to be used, “... whereby the colour blue runs horizontally above the colour red, forming a striped whole.”¹⁸ It appears that the last addition complies with two matters: first, the principle of certainty and second, with distinctiveness.

In *Red Bull GmbH*,¹⁹ the applicant opted to place in the application form the whole mark, meaning that apart from the colours to be claimed as a mark, the graphical representation included words as well as any other figurative elements. Words and figurative elements, even though not claimed, were used to “... show the systematic arrangement of the colours concerned in a predetermined and uniform way”. Still, the application contained the approximate ratio of the colours as well as the indication of the colours.²⁰

Note that with colours in the abstract we are referring to a much wider market since colours will not be bound by a particular form of use. By contrast, in the case of a single colour, a third party is aware of the colour to be used but in the case of a combination, uncertainty will arise. Therefore, when there is no knowledge of how these colours are to be used and in what proportion, it will be difficult for competitors to determine what remains outside the scope of protection. Consequently, when a combination of colours is used without establishing proportionality, a business can start using either colour in a greater or lesser proportion. Then, the business will not have just one mark, but a mark that has three signs: the combination of both colours and each of the colours separately.

That said, it is imperative to know the precise sign and thus, to establish the proportionality of the colours. In this way, third parties will know if they can use just a single colour or even, if they can use the same combination of colours but in different proportions.

It is acceptable that colour combinations can be used not only in shapes but in the abstract. It is also suitable that colour combinations can be changed in the object and the contour where they appear.²¹ However, they must keep the proportionality. It is not acceptable that colour combinations can be swapped as pleased. If combinations are not proportional every time they are used, then how much of those colours can be used by a third party?

¹⁸ *Gugelfuss GmbH Trade Mark, op. cit.*

¹⁹ *Red Bull GmbH Trade Mark* CTM No 004381554.

²⁰ *ibid.*

²¹ M C Caldarola, ‘Questions Relating to Abstract Colour Trade Marks: Recent Developments in Germany’ [2003] *EIPR* 248, 249.

Colour combinations bring us to the idea of combinations of odours. One can speculate that when combinations of odours are claimed there is as well the need of proportionality. To analyse this idea further, see the case of ‘a balsamically fruity with a slight *hint of cinnamon*’.²² By claiming for example the smell ‘fruity’ and ‘hint of cinnamon’ proportionality is not established; therefore: can a third party use in its mark ‘fruity with a considerable hint of cinnamon’? To make a sign precise, proportionality must be presented.

While this section refers to 3D shapes and colour marks one can see certain issues that can be brought into discussion when chemical sense marks are in place, especially in the case of colour marks. The reason for this is that they test the boundaries of a written description, which was before accepted as a graphical representation for chemical sense marks. Moreover, colour marks bring into the graphical representation the acceptance of an external source. Now, I bring into discussion these two principles.

Testing the Potential of a Written Description

The notion of registering colours has differed between EU Members, especially the idea of whether a mere description would be adequate. The *Sieckmann* criterion provides guidance as to how this issue should be resolved and thus, even though every case must be examined according to the circumstances, practice indicates that a verbal description alone will not suffice since it will not represent the colour sign.

A written description will name a colour but not the shade of the colour; consequently, there will be uncertainty. The fact is that even if a written description summarises how intense the colour is, for example ‘dark red’, it still will not be specific enough to represent the mark.

*Ty Nant Spring Water Ltd’s*²³ *Trade Mark Application* might clarify this. Application was sought for a ‘blue bottle’. The application was for the sign described as a “blue bottle of optical characteristics such that if the wall thickness is 3 mm the bottle has, in air, a dominant wavelength of 472 to 474 nanometres, a purity of 44 to 48%, and optical brightness of 28 to 32%.”²⁴ This description indicates and illustrates what the colour is.

²² *John Lewis of Hungerford plc Trade Mark* CTM No 2000169.

²³ *Ty Nant Spring Water Ltd’s Application* [2000] RPC 55.

²⁴ *ibid.*

However, it requires the Registry, as any other third party, to use a spectrophotometer to understand what the colour actually is. Consequently, this application was refused due to its complexity.

This test could be compared to using a spectrogram for music which even though gives an objective, clear and precise description of what the sign is, there is still the need for further aid. The same could be said for a gas chromatograph for smell. Because of this, if *Ty Nant Spring Water* had been decided after *Shield*,²⁵ where it was claimed that comprehension did not need to be immediate, would the outcome be the same? Moreover, if the application was accompanied, apart from the description, by an international code, would it have succeeded?

It is possible to understand what ‘cobalt blue’ is or ‘ruby red’ or ‘snow white’ terms are but, even though understood, it appears that they are not quite precise. Questions will remain: is the ruby pure? Is white the colour when the snow is falling, or when it has settled? The precise colour is ambiguous. When reading the application or when researching the Journal one can see and have an idea what the colour is, but not exactly. Thus, it does not comply with the *Sieckmann* criterion.

In comparison, in the case of word marks, applications will describe the sign as for example ‘apple’, but is it precise? One may ask: what font are the letters? Are they italic? Are they bold? Do they have colour? Are they written horizontally? As to certainty, one must look at the graphical representation that will clarify the way the word is written. When looking at signs in the abstract, even in the case of word marks, they may not be reasonably precise.

It is indeed recommended by the OHIM, as many other EU national Trade Mark Registry Practice notices, that applications for colour marks should include, apart from the description, a designation from an internationally recognised identification code. By this, it is suggested that a description alone will not suffice as graphical representation for colours. However, note that in the case of any unconventional mark, this is appears to be the same: a description alone does not suffice. It is observed that in practice, a drawing accompanies

²⁵ *Shield Mark BV v Joost Kist h.o.d.n. Memex C-283/01.*

the description, *e.g.* 3D shapes marks, gesture marks, hologram marks and even colours marks. However, if this is so, what happen with non-visual marks? They cannot be represented by drawings.

However, in colours marks as explained, a written description suffers from uncertainty and a drawing is not stable. Therefore, these two principles were in need of further help. The next section brings into place the ‘external source’. This flexibility brings doubtfulness to the stricter treatment applicable to chemical sense marks.

International Code

The OHIM and the ECJ have been consistent with the principle that the element of graphic representation denotes clarity. Added to this, they have explained that because of its transparency the Register or any other third party does not and will not need an external source to understand the sign: a sign must stand on its own to be understood. It has been established that graphic representation must be ‘self-contained’. However, where colour is concerned, we observe that the graphical representation is in need of an external source (code identification).

Looking at the written description, one may understand what the sign is but not with precision. For example reading the description ‘Blue: RAL 5015’ third parties need to look up the colour code due to the need for certainty, even though they know what blue is. One may argue that the representation of the mark is not self-contained since the third party needs to look at an external source, do research to find out what RAL 5015 is -- the code. However, the colour may be printed in the application as well as in the Journal; but a printed colour is not reliable and this is the reason why the drawing of the colour was not accepted in the first place.

Apart from the Registry, those wishing to register afterwards a blue colour or similar, are the ones that need to do the research and not other parties who wish to register, for example, a word mark or even another colour such as yellow. Such extra exertion (looking to an external source) is only needed by those wishing to register a colour mark that is the same or similar to one already registered.

It is worth mentioning that the term ‘self-contained’ has not been directly dealt with by the OHIM or the Court as it seems that the term is clear and should be taken literally -- the sign needs to be independent. It reminds us what graphic representation is after all: a sign needs to stand alone, free of any external source. Having said that, why look for an extra source if the sign must be self-contained, the sign/mark needs and must be there. AG L  g  r in *Libertel* also finds that an external source will demand unreasonable effort from competitors that would like to know what sign is registered.

Nevertheless, it is understood that a certain degree of flexibility is allowed. Seemingly, the amount of flexibility is minimal because anyone at first will understand and see what the sign is, and those looking for certainty can do so by looking at the international code. However, there are two matters in this issue, firstly the certainty of a code and secondly, its accessibility.

With regard to the certainty of a code, these codes allow one to colour match the specific sign but, does it mean that recognition is 100% certain? For example, the PANTONE code (the company that manufactures the colour cards) publishes annual editions. The reason for this being that the inks in each edition will fade over time; thus it is recommended that the guides are replaced yearly. Moreover, it is established that PANTONE prints vary depending on the quality of paper used. In the case of the code RAL the same problem occurs. Also, it is worth remembering that they are still expanding palettes. In general, there is an important issue that should be considered and that is that colours may vary depending on the surface they are applied to. Referring to the previous example, if ‘blue RAL: 5015’ is applied to a wrapping paper (cellophane) and also applied to metal, it will produce a similar colour but not the same.

Finally, regarding the issue of accessibility, there are three recognised colour identification systems and although the list is not exhaustive it gives us an idea what problems might arise. For example, if the graphical representation indicates one of the systems, this is the one that the third party should be looking at. Thus, accessibility will depend on the system used. However, the majority are found on the Internet and on software, giving though a more accurate colour match but only on computers. Consequently, the system opted for, can be accessible by downloading it from the Internet and by printing it; but problems such

as calibrating the printer properly and quality of paper can emerge. Other code guides can be found in designer fabric shops or in a paint retailers; in those cases matters such as new editions and paper quality would be an issue. Nevertheless, what is implied in this requirement is that if it does not require excessive effort, then it appears to be accepted.²⁶

Two conclusions can be drawn from this: external sources are permitted if they are relatively easy to access (and understand) and secondly, that even though an external source is needed on some occasions, uncertainty will always exist. By the first opinion it is clear that allowing external sources such as spectrograms for colours marks and gas chromatographic for chemical sense marks are not to be considered since they are complex and their accessibility difficult.

However, allowing an external source brings into attention the fact that the requirement of graphical representation appears to respond to current development: would chemical sense marks have the same fortune? Now we turn to study non-visual marks and to revise the possibilities that this type of marks have when fulfilling the graphical representation requirement.

3.4 Non-visual Marks

Graphical representation brings one of the most problematic burdens to marks that are not perceived by sight. The *Sieckmann* principle explains that this requirement may be represented by images, lines or characters. Thus, it seems that this requirement is to be understood literally. To make things worse, the principle claim that graphical representation must be 'clear, precise, self-contained, easily accessible, intelligible, durable and objective'. One may question: what technique or method can be used to represent a non-visual mark in such a manner?

We now turn to study the possibilities that this type of marks do have when fulfilling the requirement of graphical representation by starting analysing sound marks. The reason is that by being part of the same group of marks: unusual and non-visual, the same concerns appear to exist for chemical sense marks.

²⁶ *Libertel v Benelux, op. cit.*

3.4.1 Sound

In *Shield*²⁷ the ECJ discussed whether sounds are capable at all of registration and if so, whether graphical representation can be fulfilled by: a note bar, a description in words, a voice picture or sonogram, a sound carrier, a digital recording or a combination of these. The marks in question were two signs: the first nine notes of Beethoven's melody 'Für Elise' and the crowing of a cock.

The *Für Elise* was represented in three ways: first, the successive musical notes E, D#, E, D#, E, B, D, C, A; second, by a written description 'the first nine notes of Für Elise'; and last, by a musical score of the melody. This latter description was accompanied by a statement that the notes were as played on a piano. The crowing of a cock was represented in two ways: the written description 'the crowing of a cock', and the onomatopoeic 'kukelekuuuuuu'.

AG Ruiz-Jarabo Colomer, giving the opinion in the case, stated that sounds can be registrable because they are not excluded from the definition set up in the Directive. Regarding the issue of graphic representation he concluded that it was for the national court to decide whether a particular sign satisfied the *Sieckmann* criteria, due to its better position. He went on to suggest that a written score accompanied by a clef, fixed tempo and a statement of instrumentation would satisfy the criteria. Extending his opinion, he said that its comprehension does not need to be 'immediate' referring though to the fact that not everyone can read a music score.

The ECJ agreed with the AG's views and followed his assessment. It sustained that a description indicating the notes making up a musical work *i.e.* E, D#, E or an indication that is the cry of a particular bird *i.e.* cockerel, and/or onomatopoeia were not sufficient. Continuing the same approach taken by the AG, it determined that a stave divided into measures, showing in particular a clef, notes and other musical symbols would meet the requirement of graphical representation since they are a faithful reproduction of the sounds forming the melody for which registration is sought.²⁸

²⁷ *Shield Mark BV, op. cit.*

²⁸ J Smith, 'EC: Trade Marks - Cock A Doodle Do! Sounds Represented Graphically can be Registered as Trade Marks' [2004] *EIPR* N87, N87.

Today, the majority of sound marks which have been applied for registration at the OHIM are graphically represented by a stave where all musical symbols are placed. However, it is noticed that few marks are represented graphically by a spectrogram or sonogram without an accompanying description and if so, the description refers to the graphical representation (literally). Indeed, there are certain sounds that are not capable of being expressed by musical notes *i.e.* the cry of a baby.

Furthermore, it is observed that there are two main forms that fulfil the graphical representation requirement at the OHIM. They are a musical stave and a spectrogram, both in need of further consideration since it is dubious that they are 'clear and easy accessible'. Moreover, we can see once more the flexibility of allowing certain graphical representations for some marks but yet, for chemical senses flexibility is not seen.

In *Shield* the ECJ, following the AG's opinion, ascertained that a sound mark can be graphically represented by musical notations. Conversely, the title of a piece of music will not identify the melody as such and besides, it will need previous knowledge. Regarding musical notes *per se* the same does happen, they do not identify the melody; just writing notes even in sequence does not identify with clarity what the sign is. Thus, the title or simple notes are as suggested by the AG, vague and unclear.²⁹ Nevertheless, musical notes placed in a stave determined by a clef and the time signature will indicate the pitch, order and timing. It indeed describes perfectly the piece of music and as a result there will be no room for doubt.

Musical staves are clear, precise, self-contained, durable, objective and easily accessible, but for whom? A stave can be read by musicians and even those who may have some knowledge of music. However, it is one thing to read notes and another to actually read a stave where time and pitch will count. Because of this, there will be certain amount of people (majority) that do not have a clear understanding of what the melody or jingle is about. Nevertheless, AG Ruiz-Jarabo Colomer in the *Shield* case ascertains that the fact that it is not intelligible to everyone does not render it a failure in terms of graphical representation. According to him, the perception does not need to be immediate; the reason

²⁹ *Shield Mark BV*, *op. cit.*, para. 38 onwards.

being that what is essential regarding the requirement is that "...by means of objective and reliable instruments of interpretation, of execution or reproduction, anyone seeing the entry on the register acquires precise knowledge of the distinctive sign..."³⁰ It appears then that it does not matter whether the person looking at the entry on the register recognises it. The AG's justification is that "...when the score is read by an expert the uninformed are able to understand the sound sign without risk of confusion as to its identity..."³¹ The ECJ agreed with this view.

Once again, flexibility of the graphical representation requirement is seen, but one need to question the elasticity of this requirement for certain marks. By this case not only an external source is needed as in colour marks, but also establishing that understanding of the mark needs not to be immediate, is of concern. There is I believe, the need to revisit the rationale of graphical representation, or is it that after the *Sieckmann* case such rationale was taken too severe and now is in need of flexibility? If so, then it is worry to see that such flexibility is not yet seen in the case of chemical sense marks.

There is no doubt whether staves fulfil the *Sieckmann* criterion. Nonetheless, disagreement does not relate to whether the stave, as graphical representation, is 'objective' and 'certain' once displayed by the expert or instrument. The problem is that a third party intending to register a sound mark (and not wanting to conflict with an earlier mark) and also an Officer when examining the mark, need to refer to an external source since the knowledge is not immediate. In this sense the sign is not clear and self-evident. Certainly, the sign is there, it is a sound, is objective, but what is the sign? The sound mark is not directly known until it is listened to.

Comparing this with colour marks, it is realised that a certain degree of flexibility is and should be allowed. Does it mean therefore, that for sound marks such flexibility should allow complex features? In the case of colours, everyone will see at first-hand what the sign is and how it looks, even though for reasons of certainty there is the need to look at and find out the international code. However, as we are considering a non-visual mark that would be impossible -- would this be the reason for allowing graphical representations that are not instantaneously understood? If so, and following the same pattern, flexibility and

³⁰ *Shield Mark BV*, *op. cit.*, para. 40.

³¹ *ibid.*, para. 41.

allowing complex features should be the correct approach for graphical representation of chemical sense marks.

Surely flexibility is needed to accommodate modern markets. However, the main issue remains in giving to non-visual marks the same simplicity of visual ones when searching for external sources. Thus, if the same criterion followed in *Libertel* is transposed to non-visual marks, what is required is that the external help must not involve excessive efforts. However, this cannot be seen in the case of sound marks where the degree of help, as opposed to the example with colour signs, is not simple.

Additionally, as mentioned at the start of this section, there are sounds that are not capable of being represented by a melody. The Commission Regulation (EC) No 2868/95 Rule 3 (6) opens the door to other type of representations. It is assumed then that for those kinds of sounds such as onomatopoeic ones, the aforementioned Rule allows spectrograms to be sufficient.

A spectrogram or sonogram, as it may be called, is a diagram in which phonetic sounds are analysed; time, frequency and intensity are indicated. To set up a sound as a spectrogram, a sonograph (the instrument used) is needed which converts the sound into a digital image. There are different formats and they are quite complex to understand. The most common graphic is the one that is represented by a horizontal axis and a vertical axis representing the time and frequency, respectively. Thicker lines and intense colours frequently represent the intensity. Few people are able to understand spectrograms. For those that do however, understanding does not mean that they will know what the sound will be at the end. To fully appreciate the sound it has to be processed. Hence, the diagram, which is no more than a digital picture, ought to be converted into a sound by means of a program. Certainly, spectrograms may comply with the *Sieckmann* criteria; it is asserted by analogy through the AG's opinion in *Shield*. Logically, as the perception does not need to be immediate but when "... read by an expert the uninformed... (be) able to understand the sound sign without risk of confusion as to its identity..."³² then we could say that this criterion will apply. In fact, the OHIM has allowed the registration of the 'yelling of a

³² *Shield Mark BV*, AG Opinion, *op. cit.*, para. 41.

fictitious person characterised by a shrill cry'.³³ It also has allowed the 'acoustic rendition of the belling of a stag'.³⁴ That said, an early conclusion will be that under this criterion a spectrophotometer should be allowed for colours marks as well as a gas chromatograph for chemical sense marks.

At this stage however, the idea of spectrograms being submitted as a sign is a problem, not because they are not proper graphical representations but because they do not fulfil the term 'clear'. The *Sieckmann* criterion is based on the fact that the graphical representation must be 'clear and self-evident'. However, this concept has become more flexible as seen with the acceptability of international codes for colours and music staves for music, but accepting spectrograms is going too far.

However, what is meant by the term 'clear'? Is it clarity as to be understandable, meaning intelligible by a person looking at the Register? Or clear implying that the graphic must be a precise sign, meaning objective? By analysing the AG's opinion in *Shield* it seems that what is sought is that any person looking at the Register will acquire the precise knowledge of the distinctive sign. This is the conclusion drawn even though such a person will not at that moment understand the sign. Moreover, he establishes that to get to such knowledge, resources can be used if they are objective and reliable instruments of interpretation, of execution or reproduction.³⁵ However, it is questioned: will the uninformed be able to understand the sign or the graphical representation?

To say that what is needed is to understand not the graphical representation but the description of the mark appears to be wrong. It is worth remembering the primary function of the graphical representation which is to inform. Then, is "vertical axis: frequency, horizontal axis: time in seconds"³⁶ giving clarity or explaining what the mark is? Does the officer at the Register and/or a third party understand the sign? This also will create uncomfortable situations in the court rooms when dealing with infringing actions. To conclude, a spectrogram even though clear and precise, is not indeed a self-evident way to represent a sound graphically and still allowed as a graphical representation.

³³ *Ubisoft Entertainment SA Trade Mark* CTM No 005424171.

³⁴ *Mast-Jägermeister AG Trade Mark* CTM No 004928371.

³⁵ *Shield Mark BV AG Opinion, op. cit.*, para. 40.

³⁶ *Inlex Conseil Trade Mark* CTM No 004901658.

In *Shield*, AG Ruiz implies that what is sought with the requirement of graphical representation is to acquire precise knowledge, even if it means at a later stage; so I question: why, in the *Ty Nant Spring Water Ltd's Trade Mark Application*, was the description refused? We may recall that application was sought for a 'blue bottle' that was described in a way in which a spectrophotometer was needed to understand what the colour actually was. I submit that if flexibility is to be given, it should be to all types of marks and more importantly, it should depend on the conditions of the sign at issue. Surely if a more simple method is available, that would be preferable but, it does not mean that a spectrophotometer is unable to comply with the *Sieckmann* criteria. The same can be said for the acceptance of a gas chromatograph in the case of chemical sense marks.

Now then, if we compare a colour mark and a sound mark, one might say that the colour is captured and understood at first sight without needing an external resource. In the case of a sound there is the need of the external source to understand what the mark actually is. Nonetheless, the problem is that we are comparing a visual mark with a non-visual one. Thus, it is presumed that for non-visual marks a greater amount of flexibility is allowed. It confirms the fact that in order to allow for changes in the market, the trade mark system is becoming increasingly complex.

Still, since electronic applications are allowed, sound marks have become easy to listen to. The comparison between clicking the play button and needing to do a spectrogram test is indeed extreme. However, observe that before the electronic application, it was possible to leave a specimen *e.g.* CDs, cassettes. That said, in these circumstances it is suggested that to add the requirement of a specimen will be of help.

At this point there is the need to review some terms towards sound marks since it appears that the graphical representation requirement is taken another path: flexibility is getting too far. Starting with the term 'self-contained' as applicable to stave and spectrograms, it appears that even though we know that a sign is a sound mark and that its representation is precise, objective and durable, there is still a dubious part: not knowing of the mark as such until it is heard. Then I ask: are a stave and/or spectrogram self-contained? The answer is in the negative.

In regards to the term ‘easily accessible’, the *Libertel* case set up some guidelines establishing that a sign should not require excessive effort from the interested party in order to know what the mark is. The question is therefore if a stave and/or spectrogram are easily accessible. The key factor remains in what excessive effort means; it could mean either what follows or combinations of these: are any sources readily available? Is it easy to get to the source and search for a specific sign? And finally, how much will it cost to get to the source and to get the translation? The burden put onto the officer/examiner and third parties seeking to know a particular colour shade will be to find the colour palette. Nevertheless, this is not that easy for sound marks.

Another consideration that needs to be brought is uncertainty. A person who is not familiar with music cannot recognise how similar a piece of music is to another. Would the Register be able to distinguish them? Moreover, will an applicant do it?

Conclusions can be drawn that ‘easily accessible’ is not to be taken literally in the case of sound marks. This is so because it is neither easy nor accessible after all. What is more, when analysing staves it was established that as sound signs were non-visual marks, then to treat them with the same flexibility as visual marks would not be realistic. However, how much flexibility is to be given?

Still, the accessibility of a sound mark does not seem to be a problem because usually the applicant will insert an electronic file which would contain the sound mark. Moreover, the Commission Regulation recommends that where the application is filed through electronic means, it may be accompanied by the aforementioned sources. This is indeed the easy way of knowing what the sign is; otherwise the questions of ‘easily accessible’ and ‘self-contained’ are at issue. Thus, while examining or finding out what the sign is, the officer or any third party would go directly to the file to hear the sound; it will not be necessary to make a translation of the graphical representation. Why then the need for graphical representation for sounds marks to be in written form? Is this a worthless effort since nobody will look at them?

By studying the flexibilities and complexities of graphical representation which are allowed for colour marks and sound marks we can now proceed to analyse with more understanding the case of chemical sense marks.

3.4.2 Chemical Senses

Although chemical senses can be signs, it is observed that registrations accepted have been for smells that are commonly known by the public; does it mean that they are more easily identifiable? Or is it something to do with description and representation? In the case of the US, practice indicates that registrable smells are the commonplace ones which provide a straightforward description. However, in the EU this view has changed after the *Sieckmann* case which dealt directly with the issue of olfactory marks. Specifically, the application sought was for a fragrance described as ‘fruity balsamic with delicate hints of cinnamon’ for services.³⁷ In this case, the ECJ was asked by reference for a preliminary ruling whether a smell could be graphically represented. The AG’s view, supported by the ECJ, concluded that even commonplace ‘unadulterated smells’ are incapable of being identifiable by description. Subsequently, the change of practice determined by the ECJ and followed by the OHIM, is the one that makes national registries find themselves revisiting their own practice and altering it.

By this decision two premises were established. Firstly, a sign which is not in itself capable of being perceived visually can be registered if it is capable of being represented graphically. Secondly, to represent a smell, the following are not capable of satisfying the first premise: a chemical formula, a description, a deposit of a sample, or a combination of these.

Humans perceive signs in different ways taking into consideration where and/or when it is observed. Obviously, signs that are perceived by sight are more comprehensive than those that are not, due to the alleged delineation. Seemingly, at the moment of description, those signs that are not perceived in a proper form, will encounter the problem of subjectivity.

³⁷ *John Lewis of Hungerford plc Trade Mark, op. cit.*

Graphical representation requires describing the sign by means of symbols that can be seen. How can a non-visual sign be represented? This requirement in sound marks could be fulfilled by either staves or spectrograms. However, in *Sieckmann* the applicant used different types of representation, namely: a chemical formula, a description, a deposit of a sample, or a combination of these; to meet with the requirement of graphical representation.

These alternatives were neither accepted by the AG nor by the ECJ due to the sign not being clearly identified by these representations. This needs further analysis and while it applies to smell marks, the same can be said for taste marks.

Starting with chemical formula, the AG ascertained in *Sieckmann* that they do not represent the smell of a substance but the substance itself. The reason being that a formula represents just the chemical ingredients that form the substance.³⁸ In addition, very few people would be able to interpret the chemical formula and be able to obtain the same result because of variable factors (concentration, ambient temperature or the material containing the smell).

This view was also supported by the UK Government and followed by the ECJ. Basically, a formula seems to be insufficiently clear and precise and moreover, is unintelligible. All the opinions, including the AG, the UK Government, the Commission and the ECJ, noted that few people would be able to understand and recognise the smell; thereby casting an unjustified burden on those consulting the Register, a thought that I have in the case of spectrograms.

Through this statement the reservations are comprehensible, since the only people who would be able to understand and recognise the chemical formula is a small proportion of the population, namely: scientists, chemists, and such like.

However, if we compare chemical formulas to staves and spectrograms would they not be similar? The music is there, written but not displayed and thus only a few will understand it. In other words, chemicals are to smell and taste as notes are to music. In the same line,

³⁸ *Ralf Sieckmann, op. cit.*, para. 40.

sound marks can be represented by a spectrogram, but are there enough people who can recognise it? Nobody will recognise what the sign is because there is not human recognition! A sonograph is needed to perform the sound.

In the *Libertel* case the AG and the ECJ agreed that what is needed is a representation that even though not intelligible at first, once given to the experts they will use “objective and reliable instruments of interpretation, of execution or reproduction.”³⁹ Thus, under this premise, chemical formula should suffice; it is durable and objective.

However, focusing on the fact that a chemical formula will result in a substance and not a smell *per se* is another concern. Indeed, it is true that the formula will result in a substance, but no less true is the fact that the substance will expel the smell. A smell *per se* is impossible without a substance, there has to be something that will produce that particular smell. An object or action is needed in order to produce an odour. For example, in the case of the smell of freshly cut grass, the action of cutting the grass needs to occur to produce the odour. Hence, some activity is always necessary to produce the fragrance; the same as in music, an instrument or voice is needed. In the case of a chemical formula, what is sought is the smell of it, not the substance.

Going back to the *Sieckmann* case, the Austrian and the UK Governments as well as the Commission had a valid opinion. They believed that the identification of odours lacked certainty; however, they were referring only to chemical formulas. They found that different characteristics such as concentration, quantity, temperature or the substance bearing the odour, could change the odour.⁴⁰ Although this statement is true the same could be said for any other form of graphical representation when chemical senses are at issue. There is not precision. Even supposing that the smell and/or taste remain the same, its concentration may change due to factors previously mentioned -- same conclusion mentioned for colours: a colour may fade; colours may vary depending on paper, or ink; and, colour may appear differently depending on the perception of the human eye.

There are indeed reasons to doubt that a chemical formula can satisfy the *Sieckmann* criteria. However, I strongly believe that they are not as uncertain as other graphical

³⁹ *Libertel v Benelux*, AG Opinion *op.cit.*, para. 40.

⁴⁰ *Ralf Sieckmann*, *op. cit.*, para. 63.

representations already accepted for other type of marks. By the previous sections it is noticed the acceptance of external sources and moreover, the said that immediate recognition is not needed. Therefore, it is argued that such flexibility should be allowed for chemical sense marks: a chemical formula will succeed as much as a spectrogram does for a sound mark.

Another way of graphical representation is by description. This method has been previously studied when studying visual marks and it was thought that there were some circumstances that did not fulfil the requirement. Therefore, will this view change when applied to chemical sense marks? After all, successfully registered chemical sense marks have been by way of a description.

Nonetheless, in the case of unconventional marks, there is the problem of clarity and precision.⁴¹ The ECJ is clear when it stipulates that one of the purposes of the representation is to avoid the element of subjectivity. Literally, the terms ‘clear and precise’ are contrary to that of subjectivity.

Looking through the evolution of graphical representation when common unconventional marks are at issue, we notice that colours and sounds can be perfectly described without much criticism but yet they were in need for further assistance. In the case of colours marks, even though visual, need the help of an international code. The same happened with sound marks. A description is not enough, so staves or spectrograms may be required. Can these ideas be transposed to chemical senses marks?

The problem with chemical sense as such is that this non-visual sign is subjective. Thus, to describe this type of mark, there is the need for other factors such as: previous experience; the person that reports (describes); the person who receives (receptor); among others. Smell and taste are like feelings, not everyone has the same emotions. Yet, concepts such as love and hate are known by everyone but the intensity of those feelings will vary depending on other factors.

⁴¹ *Ralf Sieckmann*, AG Opinion, *op. cit.*, para. 41.

There are many issues involved in chemical senses; thus, it would be impossible to precisely describe what a particular smell or taste is. However, observe the statement made by the BoA when it allowed registration of the smell of fresh cut-grass, "... [the smell of fresh-cut grass] is a distinct smell which everyone immediately recognises from experience."⁴² Whether the smell is pleasant, or awkward, or repulsive is not under discussion.

Moreover, taste marks have also been successfully registered but before the *Sieckmann* case. In the Benelux a mark was registered for paper goods and printed matter. The graphical representation was fulfilled by a written description: "the trade mark consists of the taste of liquorice applied to goods in class 16 (taste mark)."⁴³

However, note the following: formerly, smells were registered as 'it smells like...' which seems to be the most precise way of specifying an odour or taste; nowadays we realise that previous knowledge is needed. Moreover, explanations such as pleasant, sweet and so on, will continue the problem of subjectivity. For example, a person may believe that the smell of popcorn is enjoyable whereas others may believe that it is repulsive. The AG remarks in the case of 'a balsamically fruity scent with a slight hint of cinnamon',⁴⁴ that there are grey areas in the description. In this particular case, what does balsamically mean? What should be understood by fruity? How intense is the slight hint of cinnamon?⁴⁵ The conclusion in this case was that it would be impossible, by such description, to identify the olfactory sign for which the applicant is applying. However, I believe that the mark was not registered because the description was not clear and precise as in the case of *Swizzel Matlow Ltd*.⁴⁶ When analysing the situation of combinations of colours, it was explained that to make a description to work, there was the need of proportionality. In the case in question: 'a balsamically fruity scent with a slight hint of cinnamon', we notice that the smell sought to be registered is a combination of odours and there is not a proper ratio of one smell to another, especially the ratio of a part compared to the whole. Therefore, for this reason the chemical sense mark was rightly not allowed to be registrable.

⁴² *Ralf Sieckmann, BoA op. cit.*

⁴³ *De Smaak Van Drop Trade Mark BX No 625971.*

⁴⁴ *John Lewis of Hungerford plc, op. cit.*

⁴⁵ *ibid.*, AG Opinion, para. 41.

⁴⁶ *Swizzel Matlow Ltd op. cit.*

I do believe that a description may fulfil the requirement of graphical representation for chemical sense marks. However, I incline to believe that the practice of the US in this respect is the correct one. In the US, non-visual marks are exempted from submitting a drawing (37 C.F.R. §2.52(e)) since these marks are incapable of such representation. However, this requirement must be fulfilled by a ‘detailed description’ of the mark,⁴⁷ and so a meticulous description will do.

Mentioning the practice of the US, Mr Sieckmann also enquired if a deposit of a sample will fulfil the graphical representation requirement -- a practice that is acceptable in the US. However, the situation is that even if depositing a sample were permissible, the problem with chemical senses is that because of its nature, the substance would fade over time,⁴⁸ or as the Court found, “... it is not sufficiently stable or durable.”⁴⁹ Further, issues such as ‘clarity and precision’ will not be resolved and moreover publication of the mark would be a problem.⁵⁰

Finally, the Court attended the question of whether combinations of different representations will suffice. A question that is adequate since as it has been observed in some circumstances a determined representation alone does not satisfied the requirement but instead a few do, *i.e.* colour marks. However, according to the AG in the case, it is impossible for the sum of all of the above examples to suffice as graphical representation. The rationale is that any of them alone are capable of fulfilling the requirement of graphical representation.⁵¹ In the case where a photograph of a strawberry with the description ‘odour of ripe strawberry’ was introduced as graphical representation, the OHIM stated that the figurative representation of the strawberry and the description did not provide, either individually or in combination, an objective, clear and precise graphical representation. Moreover, the AG explained that a combination of different representations “...increases the number of messages intended to identify the sign and therefore the risk of different interpretation...”⁵² If this is so, why in the case of colours the ECJ claimed that a

⁴⁷ 37 C.F.R §2.52 (e) and therefore such a requirement is an obligation ((37 C.F.R. §2.37).

⁴⁸ *Ralf Sieckmann, op. cit.*, para. 67

⁴⁹ *ibid.*, para. 71.

⁵⁰ *ibid.*, AG Opinion, para. 42. See also, the UK’s opinion on the case at para. 68.

⁵¹ *ibid.*

⁵² *Ralf Sieckmann*, para. 43.

written description ‘and’ a sample (two types of representations) may be clarified by adding another representation, namely a colour code.⁵³

By analysing all possible types of graphical representation presumed to work for chemical sense marks it is doubtful whether the approach taken is too strict or is justified. Apart from that, it is also of worry to see that potentially this can mean closing the door to this type of marks. Nevertheless, the *Sieckmann* criterion has been flexible and adaptable in some circumstances and because of this I believe that there are hopes for chemical sense marks. Yet, the problem with chemical sense and its potential graphical representation is that they not only have a smaller impact on the sensory world but their understanding is quite limited and complex due to the combination of biologic and psychophysics sensors.⁵⁴ Even though it is known that there are various systems that are used to record smells, they do lack clarity and precision. Yet, technology is immature and there is not a proper definitive method which deals with them. There are of course novel techniques which do read some odours and print it into a digital format but, this is early days.

Basically, as seen in colour and sound mark cases, what is asked for in the graphical representation is for the sign to be able to be understood by the Register and third parties. That said, there appears to be not much trouble regarding simplicity since external sources have been allowed and immediate understanding is also not required.

However, in the case of chemical senses, there are two problems to be solved; first, reading them and second, printing them. In order to do both, the communication system must be resolved. When smell is at issue, there is a developed odour communication system; thus, to facilitate this method a sniffer and a whiffer are needed. A sniffer is a physical device which records odours and a whiffer emits the smell imitation, a kind of an odorant palette. However, at the Office the application form will literally need the printing of the odour, so further reference is needed. However, what is worse is that knowledge is required to understand sniffers.

⁵³ *Libertel*, op. cit.

⁵⁴ D Harel, L Carmel and D Lancet, ‘Towards an Odor Communication system’ (2003) 27 *Computational Biology and Chemistry* 121, 122.

Going back to the odour communication system, the representation of odour is made possible by sniffers. At the moment there are some devices that measure odours, the most common methods being a gas chromatograph and a mass spectrometer. However, these are used more to identify the compound of mixture which is used for analytical chemistry purposes and thus suffers from the problem of smell perception. Added to this, the machine is expensive and large and what is more, the mechanism used is complicated: need for trained operators.⁵⁵

Still, there is one contender which should be born in mind: electronic noses (e-noses). They are used for detecting chemical vapours.⁵⁶ An e-nose works with analytical devices that stimulate many sensors in the range. By this process, it obtains a distinctive response, a pattern. This method or machine is widely used for quality assessment of food, medical diagnostics, and environmental control and in the automobile industry.⁵⁷

This type of graphic representation can be compared with sounds; the recording made by the sniffer would be quite similar to the one given by the spectrogram. As previously concluded, what is important is the fact that a sign should be construed as a printed version of what the mark is, even in circumstances where the sign cannot be understood immediately.

Moreover, if an odour palette exist, would it not be possible to classify it as an international code similar to colours? For example, if in the application the words written are 'strawberry odour palette No 32', would it be acceptable? The burden would be quite similar to the one imposed on those seeking colour registrations: they need to look for and find the palette (the code). In both situations, the palette and the odour print, the similar problems determined and studied previously in international code and spectrograms would be presented.

⁵⁵ Harel, Carmel and Lancet, *op. cit.*, p. 5.

⁵⁶ See further Brezmes and others, 'Application of artificial neural networks to the design and implementation of electronic olfactory systems' (Neural Network Applications in Electrical Engineering, NEUREL 2000, Proceedings of the 5th Seminar on Meeting Date: 09/25/2000 - 09/27/2000, 2002, pp. 75-80).

⁵⁷ Harel, Carmel and Lancet, *op. cit.*, p. 126.

Finally, there is no doubt that by the developing of new technology there will be a more suitable representation of chemical sense marks quite soon. For example, Japanese scientists from Keio University developed a technology that allows a modified ink-jet printer to shoot jets of scented fluid onto a sheet of paper.⁵⁸

To complete this chapter, it is clear that the requirement of graphical representation is in need of flexibility and modernity. However, this statement is far from simple. Should external sources be allowed or should they not? Moreover, should this flexibility be applicable to all marks, specifically to smell where an odour palette exists? Likewise, should the acceptance of unreadable prints *e.g.* spectrograms be allowed? And in the same vein, should a report for an e-nose be accepted?

The conclusion of this chapter is therefore, that there must be flexibility when fulfilling the requirement of graphical representation depending on the sign. Corroborating this view the Austrian Government considered, in the *Sieckmann* case, that graphical representation should be determined according to the degree of the sign.⁵⁹ In addition the UK Government, in the same case, recognised that the Directive does not impose a certain manner in which a sign could be represented, and so leaving the possibilities open.⁶⁰

While many believe that graphical representation for chemical sense marks is the only burden, this analysis is short because whilst this requirement has been one of the most controversial, it is not the only burden that chemical sense marks have. The purpose of the requirement of graphical representation is to make the potential mark being 'precise and clear' but this does not guarantee the mark to be registrable. Therefore, in the next Chapter we start to study the requirement of distinctiveness and so, if consumers identify chemical sense marks as an indication of commercial origin.

⁵⁸ Techworld online magazine at <<http://news.techworld.com/personal-tech/3246250/japanese-scientists-create-smell-printer/?intcmp=ft-mdb-rtd>> viewed on October 2010.

⁵⁹ *Ralf Sieckmann, op. cit.*

⁶⁰ *ibid.*, paras. 29 -30.

CHAPTER IV

DISTINCTIVENESS

Distinctiveness is one of the central elements of the registration process. The term denotes that a “mark must be capable of identifying the product as originating from a particular undertaking and thus distinguishing it from other undertakings.”¹ It protects on one hand, consumers who play an important if not crucial role and on the other hand, manufacturers since it establishes competition fairness.

Overall, distinctiveness relates to consumer perception: marks can only be distinctive when the consumer perceives it immediately as an indicator of origin. The focus of this Chapter is to examine the situation with chemical sense marks and its position in a market where this type of mark seems difficult to be identified by consumers as an indication of commercial origin. Additionally, when chemical sense marks are in place distinctiveness appears to have fallen from proper discussion by officer and scholars. The reason is that once a sign has not fulfilled a preceding requirement (in this case, the graphical representation) then there is no need to scrutinise the forthcoming ones.

Therefore to examine how distinctiveness applies to chemical sense marks different types of marks need to be scrutinised in order to bring a guide on how this requirement may apply to chemical sense marks.

Moreover, there is also the need to consider the availability of signs in the market place: the ‘need to keep free’ argument.² This is without doubt, where major difficulties can be found. Courts have struggled to figure out whether the test for distinctiveness should focus exclusively on the mark as an indicator of origin, or the mark as potential monopoly: public interest policy.

¹ *Linde AG, Windward Industries, Rado Watch Co Ltd*, Joined Cases C-53/01, C-54/01 and C-55/01.

² Discussed under section 4.6 The Need to Keep Free.

Distinctiveness and Devoid of Distinctiveness Character: are these interchangeable terms?

The main purpose of the requirement of distinctiveness is to exclude signs that do not fulfil the ‘distinguish function’.³ Thus, Art 4 CTMR sets out a positive requirement ‘capable of distinguish’ and Art 7 CTMR sets out the negative ones (not eligible for registration *i.e.* descriptive and generic marks). Therefore, the requirement of distinctiveness laid down by Art 4 CTMR (be ‘capable of distinguishing’) does not impose a separate requirement as the one established by Art 7 (1)(b) CTMR (devoid of any distinctiveness).

For a better understanding of the term distinctiveness, this Chapter will examine the term and the obstacles to registration concealed not only under Art 7(1)(b) CTMR but also under Art 7(1)(c) and (d) CTMR. The first section of this chapter contains a basic introduction to distinctiveness, followed by the study of signs that are devoid of distinctive character, namely those covered by Art 7(1)(b) CTMR. At this stage, when examining signs that lack distinctiveness, this section will cover only distinctiveness *ab initio*. The third and fourth sections will cover descriptive signs (Art 7(1)(c) CTMR) and customariness signs (Art 7(1)(d) CTMR) respectively, since they are considered to prevent a sign from being distinctive and therefore registered. Once the relevant grounds of refusal covered by Art 7(1)(b), (c) and (d) CTMR have been examined, I will study distinctiveness acquired through use, the proviso that applies to all three grounds. Lastly, the ‘need to keep free’ policy will be analysed not only for the sake of completeness but because there are certain signs (specially those related to the main topic of this work) that need to be available for everyone to use in certain industries.

4.1 Distinctiveness

Basically, a non-distinctive sign shall not be allowed protection under the trade mark regime in order not to distort the respective market. Therefore, Art 4 CTMR imposed a requirement regarding signs - the mark must be ‘capable of distinguishing’. In *Philips v Remington*⁴ the ECJ has made it clear that Art 3(1)(a) of the Directive (Art 7(1)(a) CTMR)

³ This statement appears to go hand in hand with the protective function - need to keep free argument. Due to this double function, the distinctiveness requirement has its faults. See M Handler, ‘The Distinctive Problem of European Trade Mark Law’ [2005] *EIPR* 306, 312.

⁴ *Koninklijke Philips Electronics NV v Remington Consumer Product C-299/99*.

“does not constitute a separate ground for refusing registration in connection with lack of distinctiveness.”⁵ In *West (t/a Eastenders) v Fuller Smith & Turner plc*,⁶ the UK court also clarifies this point, which diverges from earlier views.⁷

It is worth noting that Community Trade Mark law is rooted not only in the Directive⁸ but also in the Regulation.⁹ All Member States must have or have transposed into their national law this requirement (Art 2 of the Directive and Art 4 CTMR).

Nowadays, the terms distinctiveness and descriptiveness are very much European terms. Preliminary rulings have been dealt with by the ECJ where the harmonisation of such terms has been at issue. *Chiemsee*¹⁰ and *Baby-Dry*¹¹ are two of the cases that have dealt with the concept of lack of distinctiveness. However, the cases refer directly to descriptiveness but by implication the term of distinctiveness has been studied. More recently also, the ECJ in *SAT.1*,¹² has had the opportunity to revise the distinctiveness (as grounds for refusal) concept.

Yet, as a start point, we need to be aware that in principle, trade marks' applicants do not need to declare that the sign in question has a distinctive character. Nevertheless, if the examiner considers that the sign is not distinctive or in other words he challenges the sign regarding its distinctiveness, then the burden is for the applicant to prove otherwise.

⁵ *Koninklijke Philips Electronics NV, op. cit.*, para. 46.

⁶ *West (t/a Eastenders) v Fuller Smith & Turner plc* [2003] FSR 816.

⁷ Bainbridge suggests that “... (this section) must provide an additional barrier otherwise there would be no need for the proviso”. He also sees this as an overlap. D Bainbridge, *Intellectual Property Law* (5th edn Longman Group, United Kingdom 2002) p. 557. However, in following editions the author does not make any comments, see D Bainbridge, *Intellectual Property Law* (7th edn Pearson Education Limited, Harlow 2009) pp. 650-651.

⁸ Directive 89/104/EEC of 21 December 1988.

⁹ Council Regulation No 40/94 of 20 December 1993 (CTMR). Observe that the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ L78/39, 24.03.2009) codifies Council Regulation 40/94.

¹⁰ *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* Joined Cases C-108/97 and C-109/97.

¹¹ *Procter & Gamble Co (Baby-Dry) v OHIM* C-383/99P.

¹² *SAT.1 SatellitenFernsehen GmbH (SAT.2) v OHIM* C-329/02P.

4.2 Devoid of Distinctive Character

When a mark's inherent distinctiveness is at issue there are two possibilities, in each case however the mark must perform the main function (indication of origin). On one hand, a mark can perform such a function (to be distinctive) even before the public has come into contact with it, known as distinctiveness *ab initio*; and on the other hand there are signs which are not *prima facie* distinctive but nevertheless have become associated by the public with a particular product and thus, have become distinctive through use (proviso established in Art 7 (3) CTMR).¹³ The logic thinking is that unconventional marks are more difficult to possess distinctiveness *ab initio* because consumers do not perceive them as an indication of origin. However, registration of colours, 3D shapes and sounds appears not to show so. Yet, the situation with chemical sense marks, as previously mentioned, is that this type of marks have not be fully scrutinised by neither examiners nor judges because if the *graphic representation requirements* are not met then there is no need to continue to examining the sign.

4.2.1 Distinctiveness *ab initio*

A mark must identify and be capable of distinguishing the applicant's goods/ services from those of others. However, when assessing distinctiveness recent practice has not drawn the line between two theories. On one hand, the perception of distinctiveness is based upon the 'need to keep free' policy. On the other hand, distinctiveness is supported by the fact that consumers distinguish the product of one undertaking from those of others - an indication of origin. Certainly, the origin function remains the most essential function of all; for minimal as it may be, it will ensure the identity of the source.¹⁴ I will focus therefore on the latter as I consider this to be the modern view.

Basically, to decide whether a sign lacks distinctiveness there is a need to assess two issues: first at all, the goods or services to which it refers and second, the perception which the relevant public or average consumer has of it. These will be discussed as follows:

¹³ A sign that initially (*ab initio*) lacks distinctive character, can nevertheless acquire distinctiveness through use.

¹⁴ Indication of origin remains the essential function of Trade Mark law; reaffirmed by the ECJ in the *Baby-Dry* case, *op. cit.*

The Assessment Must Relate to the Goods and Services Subject of the CTM

Application (as the guidelines of the OHIM notes)

The examiner must consider the sign in relation to each and every category of goods/services included in the application. In the case of shapes, for example, the ECJ explicitly ascertained that a product cannot be assessed without considering the competitive environment in which the product is to be used according to the classification of goods. It is clear therefore, that the sign applied for has to be different (notably) from that environment.¹⁵ According to the ECJ, just a mere departure from a common shape is not sufficient to imply that the mark is not devoid of distinctive character.¹⁶ The same could be said in reference to colour marks and by implication to chemical sense marks. For example, a scent mark for candles and a scent mark for DVDs: the former being common on the trade and the latter particular different from the business in question.

Depending on how the sign is perceived the examiner will find whether the sign falls into one of the grounds for refusal (Art 7(1) CTMR), namely, the sign is devoid of distinctive character (Art 7(1)(b) CTMR), the sign is descriptive (Art 7(1)(c) CTMR), and/or the sign is generic (Art 7(1)(d) CTMR). As each of the grounds for refusal to register listed in Art 7(1) is independent of the others,¹⁷ they will be studied separately in the following sections.

Considering the Term Average Consumer

The expression average consumer can be said that it has been ever-present in the ECJ decisions. The term is also common in cases of unfair competition and misleading advertising. That said, when average consumer in Trade Mark law is used, it has been allegedly evident; thus, it has being rarely questioned.

Nonetheless, the position of the term is not clear. Indeed, when average consumer is an issue, there are two assumptions: on one hand the average consumer's perception observed by evidence and on the other, what the administrative and judiciary bodies believe from their common sense. It is observed that the latter is the one used. Therefore, it is

¹⁵ *Linde AGs*, *op. cit.*

¹⁶ *Mag Instrument Inc v OHIM C-136/02P*.

¹⁷ See further *Linde AG, Windward Industries Inc and Rado Uhren AG.*, *op. cit.* Also see *BioID AG (in Liquidation) v OHIM C-37/03P*.

understood that assessing consumer perception through opinion polls or surveys raises questions: how much of the given percentage is needed? In the UK for example, there is reluctance to allow litigants to supply as evidence what a typical relevant consumer may view as a particular sign.¹⁸

In *Lloyd*,¹⁹ it was said that judges should focus on what the average consumer of the relevant goods/services at issue would see as distinctive rather than what they (as judges) regard as being distinctive. The reason being that consumers normally perceive a mark as a whole; they do not analyse its details. It does not mean that consumers are not observant, on the contrary, as a general rule, consumers are 'reasonably well informed and reasonably observant and circumspect.'²⁰ Thus, either judges act as consumers or they try to imagine what a consumer would think of a product. In both situations there is a limited knowledge on the judges' part. The only solution which may solve such a problem would be to allow evidence from marketing agencies.

In *Linde AG's Trade Mark Application* the ECJ established that in order for a sign to be factually distinctive one must consider the ordinary use of trade marks not only as a badge of origin in the sector concerned but also by the perception of the relevant public.²¹ Still, who or what should establish what the relevant consumer perceives as distinctive is at issue. Moreover, in *Lloyd* the ECJ detected that referring to given percentages according to the recognition attained by a mark within the relevant public will not actually determine if the mark has a strong character.²² Professor Jeremy Phillips establishes that in cases where marks are recognised by one hundred per cent (100%) of consumers we will have a strong mark and the opposite will be the case if no one recognises it. However, he agrees that there is no cut off point in absolute percentage terms - when a mark is or is not distinctive.²³

Products that are not everyday purchases *e.g.* a car, white goods, funeral services; or products that target particular consumers *e.g.* musical instruments, sports gear, child care

¹⁸ *Bach Flower Remedies Ltd v Healing Herbs Ltd* [1999] IP & T 146 (CA).

¹⁹ *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* C-342/97.

²⁰ *Gut Springenheide GmbH and Rudolf Tusky v Oberkreisdirektor des Kreises Steinfurt-Amt für Lebensmittelüberwachung* C-210/96.

²¹ *Linde AG*, *op. cit.*

²² *Lloyd*, *op. cit.*

²³ J Phillips, *Trade Mark Law: a Practical Anatomy* (Oxford University Press, Oxford 2003) para. 4.92.

agencies, are less likely to be known by the general public. In addition, the average consumers' attention to a sign not only varies depending on the type of product, *e.g.* soap, beans, car, washing machine, but also on the type of sign used, *e.g.* words, logos, colours. There are marks that consumers do not associate as such and thus, the perception of the relevant public is therefore not necessarily the same for each category of trade mark.²⁴ Another relevant point is the fact that products that relate to brands will have the advantage of being more recognised than ones that do not. However, as Professor Jeremy Phillips clarifies "...the degree of actual recognition is not a measure of capacity to distinguish."²⁵

Another point that must be considered is whether the term relevant consumer relates to not only the consumer but also intermediaries in the chain of distribution. If so, all traders involved in the traffic of the product must be considered.²⁶ In *Procter & Gamble* (the bone-shaped soap),²⁷ the ECJ upheld the CFI's view; the average consumer referred to in the case at issue was the end-consumer, those who would buy the product and were not engaged in commercial or professional activity. That said, the relevant public is not necessarily the same for each product.

In the case of chemical sense marks, this type of marks seems not to be perceived as indicating source. Moreover, as we will see, due to their inherent nature, smell and taste marks cannot be said to be distinctive *ab initio* - only quite a narrow market could apply successfully for these marks, since many everyday products *i.e.* toiletries, cleaning products, food and beverages and perhaps stationery will be automatically excluded. In the case of taste for example, products need to be testable (if not edible) and thus, the marketplace is limited, unless people are willing to be tasting cars, computers and so on (an odd situation and unhygienic). In any circumstance however, consumers will not immediately perceive and distinguish the product as coming from a particular undertaking.

In *Myles Ltd's Trade Mark Application*²⁸ the 'scent of raspberries' for "fuels, including motor fuels, particularly diesel as heating fuel, fuel and engine fuel" was sought. The Office agreed that the sign neither guaranteed to the consumer the identity of the source:

²⁴ *Nichols plc v Registrar of Trade Mark* C-404/02.

²⁵ Phillips, *op. cit.*, para. 4.93.

²⁶ *Björnekulla Fruktindustrier AB v Pocodia Food AB* C-371/02, paras. 24-26

²⁷ *Procter & Gamble Co v OHIM (Soap bar shape)* C-107/03P.

²⁸ *Myles Ltd's Application* R711/1999-3.

distinctive character, nor can it enable him to recognise the trade mark independently of the product. There is no doubt that there are circumstances that consumers will consider the smell to be an attempt to make the smell of these goods more pleasant and thus, not as a trade mark. Consumers will indeed, recognise the smell as an improvement, a decorative element, and not as a sign acting as an indication of origin and a distinctive feature.²⁹

Basically, these products will have an indication of quality or an appeal function; thus, not only lacking distinctiveness but being banned under other absolute grounds of refusal. Hence, these types of marks not only battle with the issue of being adequately graphically represented but the doubt that they would be capable of distinguishing goods/services of one undertaking from those of another undertaking - at least *ab initio*.

The Problem with Unconventional Marks

Many cases have confirmed that for the purposes of Art 7(1)(b) CTMR no distinction should be drawn between different types of marks. Moreover, it is said that there is no application of a severe criterion³⁰ when assessing the distinctiveness of unconventional marks. However, even though this may be true, practice indicates that unconventional marks need stronger characteristics in order to demonstrate that they are distinctive.

We should therefore study some unconventional marks in more detail with the purpose of paving the way for examining non-visual marks and more specifically, chemical sense marks.

- **Signs Perceived by Sight**

Colours

In *Wrigley Jr*³¹ the light green colour applied to chewing gum was denied registration due to lack of distinctiveness. The reasoning in this case confirmed what has been implied until now - there are marks that consumers are not in the habit of recognising. In this particular case the packaging of the product, which had the sign on it (light green), was to be seen as part of the look of the product, not as the trade mark. In principle then, it was believed that colours *per se* without any unusual or fanciful features were devoid of

²⁹ *ibid.*, Headnote 11.

³⁰ *Linde AG, op. cit.*

³¹ *Wm Wrigley Jr Co's Application (Light Green colour) R122/98-3.*

distinctive character unless it has become distinctive through use (Art 7(3) CTMR). Hence, colours were not capable of distinctiveness *ab initio*. The reasons behind this statement were: firstly, following a public domain policy, colours were a type of sign available to all traders; and secondly, colours were not to serve the basic function of trade mark. These were confirmed in *Ty Nant*.³²

However, the ECJ in *Libertel*³³ established that colours *per se* ‘might’ be devoid of distinctive character but still be capable of registration if they become distinctive through use. When using the term ‘might’ the court did not immediately deny the possibility of colours being distinctive *ab initio*. The reasoning in this case followed along the same lines as *Wrigley Jr.* That said, although the Court denied registration *ipso facto*, it extended its view as to set the availability criteria - giving rights over colours would give an unjustified competitive advantage. Moreover, the court believes that “distinctiveness without any prior use is inconceivable save in exceptional circumstances and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific”.³⁴ Hence, in a way, the court is accepting the possibility of colour having distinctiveness *ab initio* but is still showing reluctance to accept it.

The exception that the court was referring to, can be seen in *KWS Saat*.³⁵ The OHIM granted registration of a shade of orange in relation to products in Class 42 “technical and business consultancy services in the area of plant cultivation, in particular the seed sector.” However, it denied registration of such a sign for products in Class 7 and 11, namely “installations for drying seeds, agricultural, horticultural and forestry products.” It is observed that registration was granted to a particular product only because of the quite narrow scope of the specification to which the mark related.³⁶ On appeal, the CFI and subsequently the ECJ stated that if a sign, in this case the colour, does not present a sufficiently perceptible difference with respect to the shades commonly utilised for such types of product, then it would be rejected for not being distinctive. The CFI clearly stated that “in the case of a colour *per se*, distinctiveness without any prior use, within the

³² *Ty Nant Spring Water Ltd's Application* [2000] RPC 55.

³³ *Libertel Groep v Benelux Merkenbureau* C-104/01.

³⁴ *ibid.*, para. 66.

³⁵ *KWS Saat AG v OHIM* C-447/02P.

³⁶ *Bently, op. cit.*, p. 824.

meaning of Article 7(1)(b) of that regulation, is inconceivable save in exceptional circumstances...” Indeed, the court declared an identical position in *Libertel*.

Then, it is settled that registration might be granted to colour marks if the number of goods/services for which the mark is claimed is very limited and the relevant market very specific. This can be seen in a later application when the BoA refused to register ‘shades of plum or red colour’ for alcoholic drinks, in particular wine of French origin.³⁷

To recapitulate, the rejection of colours as being devoid of any distinctive character have been based usually on two points: first, that colour does not serve properly as an indicator of origin; and second, that colour belongs to the public domain and needs to be kept free for competitors to use.

Colours are not easily interpreted by consumers as indicators of origin; they are not accustomed to assuming that colours are indicators of source. In practice, colours are not used alone, they always accompany another sign, either words or graphics or both; or they are delineated by contours. Accordingly, it is presumed that consumers, in the absence of those signs, will not be able to identify the product as coming from a particular undertaking. In *Wm Wrigley Jr Co’s Trade Mark Application (Light Green colour)*³⁸ the Court re-emphasised that “...the essential function of trade mark is to guarantee the identity of the origin of the marked product to the consumer.”³⁹ Moreover in *Aral Aktiengesellschaft (Blue)*,⁴⁰ the court accentuated the fact that colours are interpreted by consumers as being used for advertising campaigns rather than indicators of origin.⁴¹ This last statement should especially be considered when the sign is to be registered for services - there is the absence of material form to attach to the sign.

The same situation can be said when combinations of colours are sought to be registered. That said, when combinations of colours are not arranged in any particular format they are not distinctive *per se*. In *Orange/PaleGrey*⁴² the Board explained that a colour combination

³⁷ Even though the mark was applied more to champagne, still the BoA denied registration. R 0287/2001-1, para. 18.

³⁸ *Wm Wrigley Jr Co’s Application, op. cit.*

³⁹ *ibid.*

⁴⁰ *Aral Aktiengesellschaft (Blue) Application R0342/1999-2.*

⁴¹ *ibid.*

⁴² *Orange/Pale Grey R 477/2000-1, July 24, 2001.*

without concrete indication as to the distribution of the colours was not distinctive *per se*.⁴³ Further, in *Viking-Umwelttechnik GmbH (Green/Grey)*⁴⁴ the CFI held that the juxtaposition of a particular shade of green and a shade of grey was “abstract and imprecise in relation to the goods in question”. It held that the sign “will not be noticed and recognised, because displaying the colours on the products in a non-ordered way may mean that there will be a variety of different formats, which will not enable consumers to take in and commit to memory a particular combination on which they could draw to make a repeat purchase directly with certainty”.⁴⁵ Generally, if a sign is not precise it will not only lack distinctiveness but also will (potentially) fail the graphical representation test.

To sum up, it is accepted that colours and colour combinations are capable of being distinctive. However, in practice they are usually successful due to the submission of evidence of acquired distinctiveness; the exception being when the specification to which the mark relates is quite narrow and so, it is granted *ab initio*. In comparison, the US trade mark practice is straightforward; it establishes that colours are not inherently distinctive and thus, are in need of secondary meaning.⁴⁶

Note that all the principles establish when colours are sought to be registered appear to be the same as the situation with chemical sense marks do present and will confront. Indeed, chemical sense marks do not serve properly as an indicator of origin because consumers are not used to them to be so: devoid of distinctiveness, and also, chemical sense belongs to the public domain and there is the need to keep them free for other competitors.

However, it does not mean that chemical sense marks do not work and will never work as a trade marks because there may be circumstances in which they could potentially work as such. It is observed that as in colour marks, chemical sense marks if applied in a very narrow market and making the public aware of the chemical sense status (trade mark), they could be a trade mark.

⁴³ Note also that the ‘need to keep free policy’ was at issue.

⁴⁴ *Viking-Umwelttechnik GmbH, op. cit.*

⁴⁵ *ibid.*, para. 34.

⁴⁶ Colour marks are said to never be inherently distinctive (TMEP §1202.05(a)). It is considered that colour should be a separate element of the product that can give a commercial impression on its own (TMEP §1205.05(c)).

Now we turn to study another unconventional mark to examine if there is any other principle that is applicable to chemical sense marks, namely shapes.

Shapes

So far we understand that the ECJ has recognised that there are some signs that could be more difficult to establish as distinctive due to the public not expecting them to be marks as such -- consumer perception is different. There are signs that do not communicate not because they are incapable of doing so, but because consumers do not think that they do. This applies in the case of shapes. In *Procter & Gamble*⁴⁷ the tribunal established that there are two assessments presented in shape marks: firstly, whether the shape is a variant of the original used in that environment and secondly, whether consumers would recognise that the sign at present determines source. These two assessments can also be applicable to chemical sense marks because being unconventional consumers do not see them as indication of origin. These principles appear to be exactly the same as those suffered by colour marks, however by the end of this section it is noticed that the situation with shapes goes further than these.

Starting with the first principle: a shape is a variant of the original used, it is understood that this requirement relates to whether the shape is unusual or eccentric so that the relevant consumer would not only notice but also remember it. Slight changes do not suffice as set by the CFI in the *Procter & Gamble*⁴⁸ case. In this case the applicant sought to register a soap bar with a bony shape that according to the CFI was a slight variation on the shape commonly used for soaps. The same standard is followed in subsequent cases.

Moreover, in *Mag*⁴⁹ the ECJ ratified the CFI view and set that “...Only a mark which departs significantly from the norm or custom of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of that proviso.”⁵⁰ Observe that this assessment implies that a mark should be unique or a novelty, an issue that is not required in theory by Trade Mark law.

⁴⁷ *Procter & Gamble v OHIM (washing tablets)* Joined Cases T-241/05, T-262/05 to T-264/05, T-346/05, T-347/05, T-29/06 to T-31/06.

⁴⁸ *Procter & Gamble (soap bar shape)*, *op. cit.*

⁴⁹ *Mag Instrument Inc*, *op. cit.*

⁵⁰ *ibid.*

Common place shapes are not to be admitted such as the pouch drinks case,⁵¹ the square tablets for washing powder⁵² and the sweet wrappers.⁵³ Nonetheless, looking at the criteria of individuality, which in other words means uniqueness and why not novelty, is too close to the line of others intellectual property rights. Logic indicates that there should be a balance between the two extremes (common shapes and novel/original ones) but the problem of establishing the boundary persists.

If we bring these thoughts to chemical sense marks the same will happen. Frequent scents on a particular trade will not be admitted, for instance an eraser that smell like strawberry. Therefore, potentially an eraser that smells like whisky will do, or any 'new' invented fragrance. Chemical sense marks do suffer from a narrow range, being the more common ones referring to fruits, and flowers. Therefore, they will easily fall under this ban unless they are unusual, for instance the smell of liquors. Still, as said the range is extremely limited and business if wanting to use this type of marks, they will have to come with something new, peculiar: a made up smell.

The second principle attached to the situation of shapes marks in consumers' recognition; once the first criteria has been fulfilled (shape is a variant of the original used *i.e.* has individuality) then, the concern is whether the consumer would think that the shape indicates source. There is the problem of whether consumers regard the shape as a mere decorative attribute of the product or even as a characteristic that is functional. For example, basic geometric shapes will not be detected by consumers as conveying any information and thus would be inept at indicating source. There must also be consideration regarding different marketing and strategies which vary from sector to sector and thus, a particular shape may be common in one particular field but not in others.

This principle also is applicable to chemical sense marks. For instance, in the pharmaceutical industry it is common to add flavour to children vitamins. Moreover, there is the tendency to use flavour in this trade and therefore consumers would not think that the taste is a trade mark. This is indeed a straightforward example, but if we move to another trade, for instance stationary, will consumers think that the taste is a trade mark? The

⁵¹ *Deutsche SiSi-Werke v OHIM C-173/04P.*

⁵² *Procter & Gamble (washing tablets), op. cit.*

⁵³ *August Storck KG v OHIM C-24/05.*

reality is that consumers might regard this attribution as a marketing strategy and/or a decoration and/or a function.

Nonetheless, recent practice indicates that there are certain signs that are becoming to be regarded as trade marks, especially shapes. For example, bottles in the marketplace of non-alcoholic drinks; the reason being that traders have, over the years, instructed consumers to treat them as trade marks. Hence, if the shape of a bottle is not usual, has a certain striking design and is easy to remember, then the public would be able to distinguish that product from others.⁵⁴ For example in *Bipod Design*⁵⁵ the examiner held that the design of an inverted 'Y' (used only by the company JOCKEY) placed on the front section of a pair of underpants was distinctive. It explained that the public is used to distinguishing underwear according to certain design elements, such as the inverted 'Y' design.

In reference to the test being stricter for shapes than for any other type of marks, the ECJ has clearly stated that the authorities that examine signs and grant trade marks are 'obliged' to treat all signs equally and that there is not a more stringent test of registrability for product shapes than there is for any other type of sign. However, in *Procter & Gamble Company* (the washing tablets saga)⁵⁶ the OHIM appears to think the contrary. It declared that when applying the distinctiveness criteria with this type of mark, it has to take into account the fact that perception of the average consumer is 'not necessarily the same'.⁵⁷ Clearly, it could prove harder to establish distinctiveness in relation to 3D shapes than in relation to other types of mark.

Bear in mind that the burden falls on the applicant to demonstrate the distinctiveness of his mark. In *Unilever plc's Trade Mark Application* the Office implies that "it is for the applicant ... to show that consumers' habits in the relevant market are different";⁵⁸ meaning that consumers see a particular sign as an indication of origin.

Finally, examining the principles followed by visual unconventional marks to be distinctive a pattern can be seen. For instance: the sign needs to be different from the trade that is going

⁵⁴ *Nestlé Waters France v OHIM* T-305/02.

⁵⁵ *Jockey International Inc (Bipod design)'s Application* R608/99-3.

⁵⁶ *Procter & Gamble Co (washing tablets), op. cit.*

⁵⁷ *ibid.*

⁵⁸ *Unilever., op. cit.*

to operate; the market where the sign is going to work is narrow; and, consumers need to be instructed that the said sign is a trade mark (indicating source). Distinctiveness therefore appears to be tricky for visual unconventional marks. Therefore having studying the first troubles that unconventional marks have, we now proceed to study those that are non-visual.

- **Signs Not Perceived by Sight**

Because of the nature of non-visual signs, while potentially inherently distinctive, it would be more likely that evidence of distinctiveness acquired through use will have to be provided. Remarkably, this statement does not seem to be the reality. The majority (if not all)⁵⁹ of sound marks registered as a CTM have been inherently distinctive; acquired distinctiveness has not been claimed. The same is also observed for smell mark applications. Moreover, neither the examiners nor the judges have discussed whether chemical sense marks can be inherently distinctive or in need of acquired distinctiveness.

Surprisingly enough it means that in the case of sound marks we as consumers do perceived them as being indicators of source. The rationale appears to be based on the fact that the majority of sound marks registered, identify business and/or services, *i.e.* PC WORLD, MCDONALDS, insurance, film makers, banking and so on. As consumers, when observing a service, we notice more than a name, we notice its trade dress. Indeed, when we enter a building society or a travel agency, we do not actually see only the word mark, we look for everything else, for a mark that can identify the service. We are more cautious, we see everything that surrounds the said building society *i.e.* colours, uniforms, lay out. In the case of chemical senses however, the same does not apply; I believe we need to be taught.

As mentioned the situation of distinctiveness for chemical sense marks have not been fully studied. However, before the *Sieckmann* case the examiners at the OHIM did indeed assess this requirement. In the case of the ‘scent of raspberry’⁶⁰ as applied to engine fuels, the BoA dismissed the action because the sign applied for could not act as an indication of

⁵⁹ One hundred sound marks have been applied for at the OHIM, none of which has claimed acquired distinctiveness. Last updated on 01 November 2008.

⁶⁰ *Myles Ltd's Application, op. cit.*

origin and as a distinctive feature. It was explained that consumers would not recognise the sign independently of the goods.

After the *Sieckmann* case examiners and courts have not examined at length the distinctiveness requirement. Basically, since only one of the absolute grounds for refusal listed needs to apply for the sign not to be registrable (graphical representation), there is no need to examine the ground linked to the lack of any distinctive character of the trade mark. Although, it is observed that in the ‘smell of ripe strawberries’⁶¹ for soaps, face cream, stationery, leather goods and clothing, the OHIM rejected the application on the grounds, *inter alia*, that it was devoid of any distinctive character within the meaning of Art7(1)(b) CTMR in respect of some of the goods claimed.⁶² The examiner did not deeply explore this issue however. Still, it was obvious that some of the goods, as those in Class 3 (toiletries, cosmetics), the smell was regarded as common characteristics by consumers. An appeal was filed and the BoA dismissed it on the grounds that the mark applied for was not capable of being represented graphically within the meaning of Art 7(1)(a) CTMR; nothing was mentioned regarding the sign being devoid of distinctive character. The applicant brought another appeal, this time to the CFI, focusing only on the matter of graphical representation; the Court dismissed the action.⁶³

Certainly, for this type of sign it would be very difficult to demonstrate that they are distinctive *ab initio*, unless as in colours, the sign applies to a very limited market. This can also be seen in those smell marks that are registered; they do belong to a narrow market *i.e.* darts, tennis balls, yarn, among others. It is clear therefore, that smell signs working as trade marks would be limited, since everyday products are more likely to be expected to smell; hence the sign would be deemed usual and in some circumstances even functional.

Another situation which could arise is a case where the product is expected to smell but the supposed sign is a variant of those smell. In these circumstances, I suggest that the path followed by shapes would apply: a mere variant would not be considered distinctive.

⁶¹ *Eden SARL's Application* R0591/2003-1.

⁶² *ibid.*

⁶³ *ibid.*

Taking into consideration all of the above, the focus is not on the registrability of smells of products which are noted for this feature *i.e.* perfume,⁶⁴ eau de cologne and any other smelled household product. Indeed, the focal point is those goods/services that no one has ever used a fragrance on or if they have, at least not as a trade mark. The main question and crucial one is therefore whether consumers would recognise a smell/taste as a trade mark or they will see this feature as an embellishment.

To sum up this subsection, it is clear that the benchmark rests with the traders; they are the ones who have to educate the consumers to view a particular sign as a trade mark. Consequently, consumers will start to see certain signs as implying origin. Undoubtedly, unconventional marks' proprietors will have to work harder to inform consumers that they are trade marks. Nonetheless, there is still the problem of 'availability' and 'functionality', but as far as distinctiveness is concerned, it seems that by educating (over years) the relevant public, this issue will not present much difficulty. That is, it appears so with shapes. Would it be the same with smells and even taste? I believe it would; marketing is a powerful tool. The major problem however is that because of the chemical sense nature, it is difficult to separate a sign from the product.

4.2.2 Distinctiveness -- the Test

Throughout previous pages it is noticed that distinction is a quality. This central element of registration is for examiners and judges to assess, but how. There is not a single test or a straightforward assessment that would give us the certainty that a sign is or is not distinctive.

Nevertheless, case law has established that originality and/or novelty are not a requirement of distinctiveness; neither is uniqueness.⁶⁵ The ECJ in *Philips v Remington*⁶⁶ has also said that "the addition of capricious elements and embellishments is not a precondition for registration..."⁶⁷ In practice this is not straightforward, however. There are cases where

⁶⁴ In Sweden and Denmark the smell of perfume for a perfume (goods in Class 3) has fallen to be registered due to the smell not being recognised as a trade mark - not considered distinctive for the applied goods.

⁶⁵ *Associated Newspapers Ltd and another v Express Newspaper* [2003] EWHC 1322 (Ch).

⁶⁶ *Philips v Remington*, *op. cit.*

⁶⁷ *ibid.*

both sides of the spectrum are observed. On one side, rejecting marks for being ‘banal’⁶⁸ and on the other, allowing signs that are non-original affirming that trade marks are not to be measured with a stick of creativity.⁶⁹

Nowadays it can be said that consumers have come to understand that signs such as colours, packaging and shapes may be trade marks but, it does not lead to the conclusion that all of the aforesaid have a distinctive character.

AG Colomer said that Article 7(1)(b) CTMR excludes those signs that the average consumer “does not identify as reliably indicating the commercial origin of the product.”⁷⁰ In *Libertel*, the ECJ implies that those signs that are not perceived to communicate any message do lack distinctiveness.⁷¹ Then I believe that examiners and courts do treat and must treat unconventional marks with a different yard stick.

The test is not a mechanical one. It is not just a question of law; on the contrary, it heavily relies on what is happening in the market place and most specifically in the consumers’ mind and attitude. Hence, the test must study the sign in whether it involves issues such as: impression (is the sign striking enough in the eyes of the consumer?) and, nature of the sign and whether it is common, or, it contains something that makes it unusual in the trade that the sign is to be placed. The result of this test or study is unpredictable since it depends on an ever changing market and consumer.

To conclude this section: distinctiveness *ab initio*, case law has long established that there is no distinction between different categories of trade mark. The threshold of distinctive character requires no variability between the types of marks. In *Linde*, the ECJ reaffirmed that the Directive does not imply, neither in its scheme nor in its wording, that a stricter criterion ought to be followed when assessing (shape) marks.⁷² Logic indicates that the same might apply to all other unconventional marks. Nevertheless, practice cannot be and is not the same. This situation is presented due to the reality of the market and its consumers.

⁶⁸ *Black & Decker Corp’s Application* R99/1999-1. *Taurus-Film v OHIM (Cine Action)* T-136/99.

⁶⁹ *Clinique Laboratories Inc’s Application* R73/1998-2.

⁷⁰ *Nichols, op. cit.*

⁷¹ *Libertel, op. cit.*

⁷² *Linde AG, op. cit.*

History reveals that consumers used to identify a trade mark by its label or words and even in early years by its figurative sign (due to illiteracy). Nowadays however, we could say that consumers are more aware; there is a knowledgeable audience that understands that signs are not just mere words. Yet, it is worth noting that there is not a preconception of recognising trade marks by other meanings if the consumer has not been encouraged to do so; thus marketing campaigns play a crucial role. This is a clear indication that we as consumers, need to be educated when presented with unconventional trade marks. Having concluded this, we understand that an equal test of distinctiveness is not feasible or realistic. Definitively, it will involve a greater, if not automatic burden for the applicant to show that a sign is distinctive.

Continuing this Chapter, we now embark to further study distinctiveness, to be more precise, to analyse situations in which signs are not distinctive enough because they do describe a feature of the product. This circumstance appears to be common in word marks but the situation with unconventional marks is not frequent. Does it mean that they cannot describe? We now turn directly to answer this question by studying first what is covered under this absolute ground of refusal.

4.3 Descriptiveness -- Art 7(1)(c) CTMR

This term refers to the refusal of signs that describe the nature and/or qualities of products associated with them. Indeed, case law has pointed out that purely descriptive terms are barred from registration.⁷³ These types of marks are usually favoured by business since they do not require much expense. Indeed, the mark would form an immediate link in the mind of the public thus saving on expenditure on marketing resources.

The bar to registering descriptive signs does apply when the sign ‘exclusively’ describes the good/service. Article 7(1)(c) CTMR refers to a sign which cannot be registered if it “consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the service, or other characteristic of the goods or service.”⁷⁴

⁷³ Observe that misleading description is also prohibited.

⁷⁴ Both Council Directive 89/104 Art 3(1)(c) and Council Regulation 40/94 Art 7(1)(c) bar the registration of descriptive marks.

However, it is important to be aware that this ground for refusal is very seldom used. It is usually brought as a subsidiary of lack of distinctive character (Art 7(1)(b) CTMR).⁷⁵

The expression ‘exclusively’ should not be taken literally since it refers to a sign which would be perceived as being descriptive of one of ‘any’ of the goods/services characteristics.⁷⁶ Needless to say, a trade mark cannot be taken in the abstract; it needs to be considered in the light of the goods/services specified by the applicant. The key is whether the sign used as a mark is an essential characteristic of the good/service at issue and if so, whether it is regarded as such by the relevant consumer. This extension can be seen in *Doublemint*⁷⁷ when the ECJ considered that the CFI had erred by examining whether the term was ‘exclusively descriptive’. According to the ECJ the judgement should be whether the term is capable of being used by other economic operators to designate a characteristic of their goods/services: the need to keep free policy.

Relevant to this discussion is whether the Article refers only to ‘terms’. If so, it will leave unconventional marks out of this exclusion and especially chemical sense marks. However, the law as it stands tries to protect the interests of other traders: public policy. Therefore, to believe Art 7(1)(c) only applies to ‘words’ can be an aberration of the law.

For a mark to be descriptive it has to be assessed firstly, by reference to the goods/services in respect of which registration is sought and secondly, on the basis of the target market’s perception of the sign.

Discrepancies can be found when assessing marks containing combined words or combinations of descriptive words. Thus, nobody in the trade mark arena can avoid cases such as *Baby-Dry*, *Doublemint*, *SAT.2* to name a few; specifically the *Baby-Dry* decision which has increasingly been criticized for setting a very low threshold. Indeed, the case raised concerns that ordinary language would be monopolised by a few traders. However,

⁷⁵ In two recent cases namely *Koninklijke KPN Nederland NV (Postkantoor - the Dutch term for Post Office) C-363/99* and, *Campina Melkunie BV v Benelux MerkenBureau (Biomild) C-265/00*, the ECJ confirmed that there exists an overlap between 7(1)(b), (c) and (d); still the court stated that those grounds for refusal must be examined separately. Subsequently, the court identified that if a mark is descriptive it is then necessarily devoid of distinctive character. In both cases the court was referring to word marks.

⁷⁶ This was the opinion reached by AG Jacobs in *Wm Wrigley Jr Co v OHIM C-191/01P*.

⁷⁷ *ibid.*

on the other side, owners disagree, arguing that already the criterion should be whether the mark is capable of functioning as a guarantee of origin and nothing more.

Bearing in mind that the ECJ has previously acknowledged the public interest underlying the provision restricting the registration of descriptive signs, it is, at least in practice, difficult to see what criterion is to be followed. Hence, the extent or the clarity of what is implied in the Article is what creates debate: whether it limits more or less rigorously the scope of the exclusion of signs that are *exclusively* descriptive.

Nonetheless, a descriptive term may well carry indications of quality or other characteristics, or positive associations of many kinds and still be registrable. This is the case, if it can be shown that they are capable of indicating source. Having said that, descriptiveness is typically brought in cases of word marks (complications are seen in cases of compound words). Some examples of OHIM and the CFI decisions are as follows:

- word mark ‘Petit Bebe’ for children’s clothes - refused for being descriptive of the intended purpose of the goods⁷⁸;
- slogan ‘looks like grass...feels like grass...plays like grass’ for synthetic surfaces for athletic activities - refused because the mark directly informed the public that the goods had qualities similar to those of natural grass.⁷⁹
- figurative mark consisting of the word ‘Montana’ and a depiction of a mountain for alcoholic beverages - refused because Montana is the name of an American state and as such it was geographically descriptive of the origin of the goods. Bear in mind that the article does not in principle preclude the registration of geographical names if they are unknown to the relevant group of persons, or are at least unknown as the designation of a geographical location. Or if, with respect to the geographical names used, such persons are unlikely to believe that the category of goods concerned originated there (*Windsurfing Chiemsee case agreed so*).
- words ‘weisse seiten’ (white paper in Dutch) in respect of paper and printed matter - refused due to its descriptive character in the sense of white-coloured pages.⁸⁰

⁷⁸ *Marks & Spencer plc’s Application* R95/1998-3.

⁷⁹ *Fieldturf Inc v OHIM* T-216/02.

⁸⁰ *Telefon & Buch Verlagsgesellschaft v OHIM* T-322/03.

Guidance on how this ground for refusal is dealt with can be seen in two cases decided simultaneously by the ECJ (*Postkantoor*⁸¹ and *Biomild*,⁸² both cases were banned from registration on the grounds of Art 7(1)(c) CTMR). The ECJ delivered these two major judgments in February 2004 which clarified the registrability of descriptive signs as trade marks in harmonised EU jurisdictions. The ECJ reaffirmed that the *Baby-Dry* principle was still good law by starting with the presumption that if a mark is composed exclusively of descriptive elements, it is itself descriptive, unless ‘there is a perceptible difference’ between the word and the mere sum of its parts. It appears therefore, according to the court, that if a word has acquired its own meaning which is not itself descriptive for the purpose of the same provision, then the word is not descriptive as such and thus capable of being registered.

Another point that the ECJ clarified is that if a mark is to be considered as consisting exclusively of descriptive signs or indications, the fact that there are synonyms capable of indicating the same characteristics is irrelevant.⁸³ Moreover, it stated that signs which may designate characteristics of goods or services should remain freely available for all. As observed, these principles that were indeed a codification of principles already established, left some controversial theories.

Firstly, it considers that if the mark is a word mark, destined to be as much heard as read, registration should be refused if the descriptive character of the mark is either visually perceptible, or aurally perceptible. Nonetheless, observe that since this decision took place the CFI has made no reference to this ‘double’ condition. The BoA has not followed and did not follow such criteria when accepting the mark WRIGHT TOOL⁸⁴ (as in ‘right tool’) for tools and tool boxes.

Secondly, the ECJ considers that a mark can be descriptive with regard to both ‘essential and ancillary’ characteristics of the goods/services: “...the Directive does not draw any distinction by reference to the characteristics which may be designated by the signs or indications of which the mark consists. In fact, in light of the public interest underlying the

⁸¹ *Koninklijke KPN Nederland NV, op. cit.*

⁸² *Campina Melkunie (Biomild), op. cit.*

⁸³ Confirmed in *Doublemint, op. cit.*

⁸⁴ *Wright Tool Co's Application R0603/2003-2.*

provision, any undertaking must be freely able to use such signs and indications to describe any characteristic whatsoever of its own goods, irrespective of how significant the characteristic may be commercially.”⁸⁵

This view is a contradiction of its famous case *Baby-Dry*.⁸⁶ We may remember that PROCTER & GAMBLE’s application to register the compound word ‘baby-dry’ as a CTM for nappies was originally refused on the grounds that it was descriptive. On appeal, the CFI dismissed the action due to concluding that the sign simply conveyed to consumers the intended purpose of the goods and conveyed no additional feature to render the sign distinctive. PROCTER & GAMBLE appealed and the ECJ allowing the appeal argued that the question was whether the word-combination could be viewed as a normal way of referring to the goods or their essential characteristics. It disputed that while the word ‘baby-dry’ alluded to the goods’ function, and each of the words were used in everyday speech to designate the function of nappies, nonetheless, “their syntactically unusual juxtaposition is not a familiar expression in the English language, either for designating babies’ nappies or for describing their essential characteristics”.⁸⁷ Thus, the court concluded that when the word was taken as whole, such word combinations do not exhibit descriptive character.

The criticism is not whether *Postkantoor* and *Biomild* were correctly decided, but that they have not been followed by later cases. On the contrary, it appears that the *Baby-Dry* decision is the criterion to be followed.⁸⁸ Thus, it seems that in order to be descriptive, a sign must either ‘directly’ describe the goods and services, or designate one of their essential characteristics. There is not consideration as to ‘ancillary’ characteristics of the goods/services.

⁸⁵ *Campina Melkunie (Biomild)*, *op. cit.*

⁸⁶ *Procter & Gamble Co (Baby-Dry)*, *op. cit.*

⁸⁷ *ibid.*

⁸⁸ See cases such as: *Telepharmacy Solution’s Application* R0108/2001-4; *Lissotschenko Mikrooptik GmbH’s Application* R0363/2000-2; and *Applied Molecular Evolution Inc’s Application* R0108/2002-2.

4.3.1 Suggestive Words -- Do They Describe?

The word ‘exclusively’ does not extend to cover those signs that merely ‘suggest’ one of the characteristics of the sign. In *Easybank*⁸⁹ the CFI pointed out that the word suggests the idea of easy banking, but that suggestion was ‘weak and allusive’ since it did not explain how it was going to be achieved;⁹⁰ thus the mark was registrable. Ambiguous marks have the same fortune since the relevant consumer would not immediately be able to identify a specific meaning from the mark and so they will be registrable.⁹¹

There is no dividing line to indicate when a sign might designate a characteristic of goods/services and when a sign merely suggests it, however. In *Doublemint*, the AG proposed an assessment which would establish a greater degree of objectivity and as such it would be less difficult to establish whether the sign is a mere description or just a suggestion. Thus, the consideration goes as follows:

A Term that Relates to a Product or One of Its Characteristics; on one side stands those terms that have an objective link and thus are likely to be used as a designation of trade: prohibited by Art 7(1)(c) CTMR. On the other side, terms that have a subjective link and thus are potentially acceptable for registration.

An Apparent Term; if it is an ordinary, clear-cut and practical term, consumers will pick up any designation of a characteristic and thus, it will be banned from registration. At the other end of the scale however, if consumers need any great skill for detecting any link with the designated characteristic, then it will potentially be registrable.

How Significant is the Characteristic in Relation to the Product, in Particular in the Consumer’s Mind? if the characteristic designated is vital or central to the product, or if it is important to consumer’s choice, refusing registration is feasible. On the other hand, if the characteristic designated is just incidental or arbitrary, registration may be viable.⁹²

⁸⁹ *Bank für Arbeit und Wirtschaft AG v OHIM* T-87/00.

⁹⁰ *ibid.*

⁹¹ Phillips, *op. cit.*, para. 4.139

⁹² *Doublemint*, AG Opinion, *op. cit.*, paras. 62-64.

This assessment suggested by the AG in *Doublemint*, covers three different issues, each of them having two possible solutions. When the term inclines to any of the outcomes, it will determine whether it is registrable or not. Note that all three aims do not need to be accomplished, only one of them is necessary. Referring to the AG's proposal, Professor Phillips argues about the complexity of the test due to the subjectivity of the person applying it.⁹³ I believe that any test which studies the market and the consumer will indeed involve subjectivity.

Yet, the ECJ did not take into consideration the test suggested by the AG. Instead, the Court criticised the CFI for applying a test based only on whether the mark was 'exclusively descriptive' and thus, failed to ascertain whether the mark at issue was capable of being used by other economic operators to designate a characteristic of their goods/services:⁹⁴ the public interest aim (need to keep free). Moreover, the Court made some points: "firstly, that a term does not have to be in current descriptive use to be precluded from registration but that a reasonable apprehension that it may be so used in the future suffices and second, that the fact that more than one term can be used to describe the characteristics of particular goods does not mean that those terms cease to be descriptive."⁹⁵

For all of the above, to assess descriptiveness appears to be a subjective test. It involves subjectivity due to variables such as: market conditions, the consumer and the person applying the test. Clearly, the test is subjective *per se* and the ideal would be that persons applying such a test should not add further subjectivity. Examiners and judges should, for the sake of the test, be realistic and more unbiased.

However note that a certain margin of appreciation is given; a mark that does not seem eligible for registration to one examiner might appear to be registrable to another, even if examiners try to be consistent. This is acceptable. I believe that a simple question would prevent certain terms from being registered; added to this, examiners and judges should be more straightforward. The question then should focus on: is the term being applied for 'used by' other economic operators to designate a characteristic of their goods/services? If

⁹³ Phillips, *op. cit.*, para. 4.142.

⁹⁴ *Doublemint*, *op. cit.*, para. 35.

⁹⁵ *ibid.*

the answer is ‘*Oh yes*’⁹⁶ then, it will fall within Art 7(1)(c) CTMR. My point being that for a simple question, a simple answer must be given: either positive or negative.

4.3.2 Unconventional Marks -- Can They Be Descriptive?

In trying to see how descriptiveness may affect unconventional marks, it would be inevitable to establish that the test is the same. The ideas given by the AG in the *Doublemint* case are an exceptional guideline. I believe that what needs to be assessed is whether the sign at issue is material to the consumer’s decision to purchase the goods/services to which it is attached.⁹⁷ However, there is a lack of cases regarding descriptiveness and how it applies to signs other than word signs and what is worse there is just one a case relating this issue in chemical sense marks. Yet, it does not indicate that this absolute ground of refusal only applies to words.

An early case sought in the UK courts was *Reckitt & Colman Products Limited (Jif lemon)*.⁹⁸ Even though the case was regarding passing off and get up issues, the court held the lemon shape and colour assisted in conveying information as to the content of the containers; thus, they were descriptive.⁹⁹ Later on, the UK saw again another case of descriptiveness in a case of a shape; although the case was not related to trade mark registration but trade mark infringement, the issue of descriptiveness was discussed. In *Julius Sämaan Ltd and others v Tetrosyl Ltd*,¹⁰⁰ air fresheners in the form of a fir tree were questioned. SÄMAAN created the small, card sized scented cardboard cut-out in 1952. Since then, the tree has been marketed under the MAGIC TREE trade mark and the tree shape itself, being both registered trade marks. Proceedings were brought against TETROSYL for selling an air freshener in the shape of a fir tree covered in snow and with flashing lights. The defendant denied infringement and argued that the registration of such a mark should be invalidated on the grounds *inter alia* that the mark consisted exclusively of indications served to designate the kind, quality or other characteristics of the goods: descriptive. TETROSYL explained that, when first registered, the mark would have been perceived as merely descriptive. It was in the shape of a fir tree because it was pine-

⁹⁶ *Churchill Insurance Company Ltd (Sonogram ('Oh Yes'))* CTM No 006534887.

⁹⁷ Phillips, *op. cit.*, para. 4.143.

⁹⁸ *Reckitt & Colman Products Ltd v Borden Inc and Others* [1990] RPC 341.

⁹⁹ Added to the functionality issue presented by the product.

¹⁰⁰ *Julius Sämaan Ltd and others v Tetrosyl Ltd* [2006] EWHC 529 (Ch).

scented. However, the court rejected the argument, saying that there was no ‘normal’ shape for air fresheners and that the shape (fir tree) had been used with other smells and air freshening products, so that consumers had come to associate the tree shape with the brand. The court therefore held that the tree trade mark was valid.

One may speculate that, if at the time the fir tree was registered as being only pine-scented, the issue of whether it was descriptive could have been questioned. The key issue was, as mentioned by the judge, that at the time of registration the shape was not common; the sign applied for was different from that environment (at that time). However, such statements will not release the sign from being descriptive (Art 7(1)(c) CTMR). Those in trade and/or average consumers of the said goods (air fresheners) when faced with a card sized scented cardboard cut-out will know that the functions and characteristic of it is to smell. Then, what is submitted is that if the shape expresses the smell, it will be descriptive. In this particular case, the mark in question, the fir tree, clearly appoints the characteristic of the good. It does indeed reinforce the designation of a quality or characteristic of the shape: indicating specifically the smell that the air-freshener is going to deliver.

In another shape case, this time in Germany, the issue of descriptiveness was questioned.¹⁰¹ HENKEL sought to register a 3D shape in respect of liquid wool detergent: the mark consisting of a tall bottle. The German Patent and Trade Mark Office rejected the application on the grounds that the mark was a usual form of packaging for the goods concerned, which did not display an indication of the origin of the product and so the mark was devoid of distinctive character. HENKEL appealed to the *Bundespategericht* which considered, *inter alia*, that HENKEL’s packaging might be capable of describing its contents, and as such, the goods applied for. However, the *Bundespategericht* stayed the proceedings and referred some questions to the ECJ, one of them relating to the issue of descriptiveness. It asked whether “the packaging of the goods may serve to designate the (external) quality of the packaged goods for the purpose of Art 3(1)(c) of the Directive?” Subsequently, the ECJ referring to the question, answered that 3D “marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packing thereof must be assimilated to the shape of the goods, so that the packing may constitute the shape of the goods within the meaning of Art 3(1)(e) of

¹⁰¹ *Henkel KGaA v Deutsches Paten- und Markenamt* C-218/01.

Council Directive 89/104 and may, where appropriate, serve to designate characteristics of the packaged goods, including their quality, within the meaning of Art 3(1)(c) of that directive.”¹⁰² Thus, the ECJ has recognised that 3D shapes (including packaging) can be descriptive.

The OHIM also has dealt, on a few occasions, with the issue of non-word marks being descriptive. In *Mag*,¹⁰³ the three dimensional shape of a torch was sought as a trade mark. The OHIM refused the application on the grounds that the mark applied for was devoid of any distinctive character (Art 7(1)(b) CTMR). On appeal, the second BoA confirmed the Examination Division’s decision that the application should be rejected on the basis of Art 7(1)(b) CTMR. In addition, it raised the fact that the shape of the torch was likely to be perceived by consumers as a representation of the product itself rather than as an indication of its origin. Hence, according to the BoA, the shape of the torch was descriptive within the meaning of Art 7(1)(c) CTMR in the same manner as a word mark is descriptive when consisting of the name of the product itself. On appeal, the CFI did not support this view and did not even examine the alleged descriptive character of the shape; nevertheless it dismissed the appeal by confirming the lack of distinctiveness (Art 7(1)(b) CTMR).

In a subsequent case, the issue was, once again raised by the second BoA.¹⁰⁴ Thus, applying the same reasoning as before: shape marks can be descriptive within the meaning of Art 7(1)(c) CTMR in the same manner as a word mark is descriptive when consisting of the name of the product itself. In this case the packaging for sausages was at issue.¹⁰⁵ According to the BoA, the packaging was considered ordinary to such a point that it immediately evoked the idea of its content. However, note that while the 3D mark application was refused on the ground that “what is descriptive cannot be perceived by the consumer as distinctive *per se*” the BoA brought forward Art 7(1)(b) CTMR instead of Art 7(1)(c) CTMR.¹⁰⁶

¹⁰² *Henkel KGaA op. cit.*

¹⁰³ *Mag Instrument Inc, op. cit.*

¹⁰⁴ *Wim De Waele’s Application* R488/1999-2.

¹⁰⁵ *ibid.*

¹⁰⁶ The CFI confirmed the BoA rejection, *Wim De Waele v OHIM* T-15/05.

Another case which highlights descriptiveness as it applies to non-word marks is that of the Spanish cards. In *Naipes v OHIM*,¹⁰⁷ the Office questioned whether figurative signs were descriptive of playing cards. In particular, NAIPES submitted three applications for CTMs at the OHIM. The first application consisted of a figurative sign in blue, pale blue, yellow and red representing a sword. The second application consisted of a figurative sign in red, yellow, green, ochre, brown, blue and pale blue representing a knight on a horse (knight of clubs). The third and last application was for a figurative sign in yellow, ochre, white, red, blue and green representing the king of spades. All these applications were filed for Class 16, namely playing cards. These signs were successfully registered in 1998.

However, in 1999, France Cartes applied for the invalidation of those marks on the grounds, *inter alia*, absolute grounds for refusal laid down in Art 7(1)(c) CTMR; descriptiveness. Nonetheless, the OHIM's Cancellation Division refused the application on the grounds that the registration of those marks was well founded in law. Mr Cartes appealed and OHIM's BoA decided to annul the decision brought by the OHIM's Cancellation Division. It therefore, decided that the marks at issue were devoid of distinctive character, but what is more, that they were descriptive under Art 7(1)(c) CTMR due to being seen by the average consumer (those who play cards) as representing characteristics of Spanish playing cards.

Consequently, NAIPES brought action before the CFI asking to annul the decision of OHIM's BoA. The Court assessed these signs regarding two issues:

- First, the goods/services for which registration of the sign was sought; the goods at issue were playing cards. In particular, they were the ones called Spanish playing cards. The four suits in the Spanish cards are coins, cups, clubs and swords. It was clear that two of the three signs referred to represented two of the Spanish cards, namely the knight of clubs and the king of swords; and,
- second, the perception of the target public; it included not only professionals or card game enthusiasts, but anyone who was likely at some point to acquire such goods either regularly, occasionally or as a one-off.

¹⁰⁷ *Naipes Heraclio Fournier SA v OHIM* Joined Cases T-160/02, T-161/02 and T-162/02.

The target public was the average reasonably well-informed consumer who on this particular occasion, lives in Spain.

Once the Court identified the relevant goods and public, it considered the descriptive nature of the signs. There was the need to observe whether there was a sufficiently direct and specific association between the figurative signs and the ‘playing cards’. The figurative signs of the knight of clubs and the king of swords did indeed invoke the idea of playing cards for the relevant public. It is established that persons who had played with any type of cards, identified in those signs (the knight and the king) the representation of a playing card. The fact that a section of the relevant public will not be acquainted with Spanish playing cards and furthermore with the signs in questions, does not override the fact that they are certainly descriptive.

The Court extended this view by explaining that any manufacturer producing and marketing Spanish playing cards will need to use the sword to identify the cards of that suit (need to keep free approach). Moreover, when one of the grounds for refusal is held in part of the Community, this will be enough to justify refusal of registration of a mark applied for. Therefore, in the case in question, it was sufficient that the figurative mark was descriptive in one country namely, Spain. The Court rightly concluded that the marks in question were descriptive of the characteristic of the goods applied for.¹⁰⁸

A more recent case and directly related to the aim of this thesis was the ‘taste of artificial strawberry flavour’ to be applied to pharmaceutical products.¹⁰⁹ The OHIM, after rejecting the sign due to fall out of Art 7(1)(b) CTMR, raised a further objection under Art 7(1)(c) CTMR. It argued as follows: “The mark would appear to be descriptive of characteristics of pharmaceutical preparations...The taste of artificial strawberry flavour is obviously an ingredient widely used in the pharmaceutical and food industries. The mark consists entirely of a desirable characteristic for such goods. In particular, the mark as a whole without any distinctive alteration or addition merely indicates that pharmaceutical and dietetic substances adapted for medical use contain or have the taste of artificial strawberry flavour. Such a sign or indication is legitimately required by other traders to indicate

¹⁰⁸ *Naipes Heraclio Fournier SA, op. cit.* The ECJ dismissed the appeal C-311/05 P.

¹⁰⁹ *Eli Lilly's Application R-120/2001-2.*

characteristics of their competing goods.”¹¹⁰ While this case has been the only one that has scrutinised chemical sense marks being descriptive, it indeed clarifies many issues. These matters however, have also been followed by other cases and not only word marks and therefore, many of the situations brought under those, can be applicable to chemical sense marks. One of the elemental issues is that this case ratifies that chemical sense marks can be descriptive. Secondly, it raised the fact that even though the characteristic is not used by every trader, it is still a characteristic of the good (the characteristic enjoyed popularity); thirdly, the case brings again the basic idea of distinctiveness: a sign without any variation, is a common characteristic of the goods: lacking distinctiveness; and lastly, the case affirms the aim of the Article: the need to keep free.

To sum up, there are certain markets in which chemical sense marks will be seen as describing the product: toiletries, perfumes, potpourri, medicines, food industry and the like. Therefore, not only chemical sense will suffer from not being perceived as trade marks as first, but there is also the concern that some products cannot use chemical sense as trade marks because they will describe one of the features of the product. To make things worse, distinctiveness can also being tainted by another matter: customariness, which cover those signs that are habitual in a particular trade. This other ground from registration can also be applicable to chemical sense marks and we now turn to this.

4.4 Customariness -- Art 7(1)(d) CTMR

The Article appears to be straightforward; marks “which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade” are not to be registrable on the basis of absolute grounds of refusal. It is understood that in deciding whether a word has acquired a special trade meaning, evidence must be provided.¹¹¹ The point to observe is if this Article only applies to ‘current language’ and so, only brought against word marks.

This issue was examined indirectly in a case regarding the rose emblem on rugby jerseys. Even though the case relates to licence agreements, the issue of customariness was

¹¹⁰ *Eli Lilly's Application*, *op. cit.*

¹¹¹ *International Business Machines Corp and IBM United Kingdom Ltd v Web-Sphere Ltd*, Richard De Serville, David Markson [2004] EWHC 529 (Ch).

discussed. Cotton Trader argued as a defence that the ‘red rose emblem’ cannot be a trade mark due to evidence which demonstrated that the relevant public associated the rose primarily with England in general or with the England rugby team. Therefore, in the light of the use that had been made of the rose emblem it is no longer capable of being distinctive. The Court agreed that the emblem was primarily a descriptive or generic sign and was accordingly excluded from registrability under one or both of the absolute bars to registrability: Art 7(1)(c) and (d) CTMR. It went on to explain that the sales over the years of classic English rugby jerseys by undertakings operating without authority from the Rugby Football Union (RFU) proved that it had become *bona fide* customary within the trade to use the rose by way of association with the England rugby team.¹¹²

This case may have answered the question: can customariness be applicable to chemical sense marks? Indeed, there can be signs that because of the use given in the market, they can become habitual. For example, the case of ‘taste of artificial strawberry flavour’ to be applied to pharmaceutical products, one can see that applying flavour to medicines has become usual in that trade.

Studying more generally the situation of customariness it is observed that there exist an overlap between Art 7(1)(b) and (d), since if a sign is commonly used in the trade this is a *prima facie* indication of lack of distinctive character. Note also that this grounds of refusal is hardly ever used, and if so, it is usually brought as contributory to lack of distinctive character (Art 7(1)(b) CTMR). Moreover, if a trade mark has already been declared invalid under Art 7(1)(b) and (c), practice indicates that examiners and Courts will not need to examine whether that mark is customary for all or part of the goods/services for which registration is sought under Art 7(1)(d) of the CTMR.¹¹³

There exists however some uncertainty with this Article because there are two versions: the German version and the European version. Paragraph 8(2)(3) of the *Markengesetz*, refers to trade marks that consist exclusively of signs or indications which have become customary in current language or trade practices ‘to designate the goods or services’. However, Article 3(1)(d) of the Directive (Art 7(1)(d) CTMR) contains no such

¹¹² *Rugby Football Union and Nike European Operations Netherlands BV v Cotton Traders Ltd* [2002] EWHC 467 (Ch).

¹¹³ *Fédération Internationale de Football Association, op. cit.*

qualification: to ‘designate’. Therefore, the necessary link to the goods/services is contained in the German version but not in the European version.

None of the other European Members have adopted other versions but the European one. Bear in mind however, that the fact that the link to the goods/services is not presented in other versions, does not imply that it should not be. On the contrary, we have seen throughout this chapter that the whole concept of distinctiveness can only be discussed with regards to the product at issue. The fact is that when examining a sign it cannot be done in the abstract and separately from the goods/services that are intended to be represented.

The point to be studied then is whether Article 7(1)(d) CTMR applies to ‘only’ those goods/services applied for, or to elements which are used in advertising without any special descriptive statement but which serve mainly to attract customers. Examples that come to mind would be the colour green for organic products and recycling. The ECJ, in the *Bravo*¹¹⁴ case looked at this issue. The case started in Germany when MERZ & KRELL sought to register the word mark ‘bravo’ in respect of writing implements. The application was refused by the German Patent and Trade Mark Office on the grounds that the mark at issue was no more than a term of praise and an advertising slogan devoid of any distinctive character, thus banned from registration.

MERZ & KRELL appealed before *Bundespategericht* on the grounds that the term ‘bravo’, even though a common term, had no connection with the goods, namely writing implements. Still, the *Bundespategericht* decided to stay proceedings and referred the following question to the ECJ for a preliminary ruling: “is Article 3(1)(d) of the European Council Directive 89/104/EEC to be interpreted restrictively, contrary to the wording thereof, as meaning that only signs or indications which directly describe the specific goods and services in respect of which registration is sought, or the essential characteristics or features thereof, are affected by the bar to registration? Or is the provision to be construed as meaning that, in addition to generic signs and names, signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade in the relevant or a similar sector as advertising slogans, indications

¹¹⁴ *Merz & Krell GmbH & Co C-517/99*.

of quality or incitements to purchase, etc., without directly describing specific characteristics of the goods or services in respect of which registration is sought, may likewise not be registered?”

The ECJ answered that even though the Article must be interpreted as ‘only’ precluding registration of a trade mark where the sign has become customary in the current language or in the *bona fide* and established practices of the trade to designate the product in respect of which that mark’s registration is sought, yet for the Article to be effective, the Court’s interpretation should not be limited exclusively to trade marks which describe the properties or characteristics of the goods/services covered by them. Therefore, the ECJ leaned towards the traditional interpretation that signs cannot be considered alone. They need to be considered with regard to the product that the sign is intended to be used upon.

As a result, the ECJ found that, where in the current language or *bona fide* and established practices of the trade, the use of the signs or indications concerned have become customary for the designation of the goods/services covered by the mark, it is immaterial whether they are used as advertising slogans, indications of quality or encouragement to buy those goods/services.¹¹⁵

This interpretation appears to make chemical sense marks less attractive for businesses. The reason is that smell and taste are used in many industries to embellish and to attract consumers. For example Abercrombie & Fitch and Hollister are clothing shops that use smell to decorate their shops. However, note the following, while spraying smells can become customary in that particular trade it does not mean that an individual smell in a shop cannot be distinctive. Otherwise it will be the same as saying that as words have become customary in the trade of chocolates, they cannot identify them anymore!

Coming to the end of this section, chemical sense marks are treated the same as any other type of mark when studying distinctiveness. There are analysed similar to those that are visual. However, in reality the problem with chemical sense marks is that they are unconventional and customers are not used to rely on them as indicators of source. However, according to legislation, lack of distinctiveness can be overcome. Thus, the

¹¹⁵ *Merz & Krell GmbH & Co, op. cit.*

chance of chemical sense marks to defeat this burden appears to increase because of this proviso.

4.5 Distinctiveness through Use (Art 7(3) CTMR) -- the Proviso

The ban established by Art 7(1) subsections (b), (c) and (d) can be defeated. In order to do so, the applicant must show that, by the date of the application, the mark has in fact acquired distinctive character by its use.

Normally, acquired distinctiveness is gained by familiarisation of the relevant public over a long period following various intensive advertising and sales campaigns.¹¹⁶ In the early case of *Windsurfing Chiemsee*,¹¹⁷ the ECJ set up directions as to the conditions that ought to be present when considering that a mark has acquired a distinctive character. This in particular refers to evidence and how much is needed. At this stage there is no need to separate the types of marks since the proviso applies irrespectively from these. However notice that the quantity of evidence to be submitted would vary depending on the reason why the mark was not registered in the first place. At the end, the key issue is to prove that the mark operates as a trade mark: indicative of source. How much evidence is needed would depend on the particular sign. The more descriptive or non-distinctive a mark appears, the more evidence would be needed.¹¹⁸ It can be thought that unconventional marks need more evidence than the other types of mark but this will be just a mere guess. I believe that a more precise statement will be the fact that it will be more common for unconventional marks to use this proviso because they are less recognised as trade marks. We now turn to analyse evidence of use of a trade mark.

It is clear that there are different types of evidence that may be used to support a claim for registrability under the circumstances that the sign has acquired distinctiveness through use. In *Windsurfing Chiemsee*¹¹⁹ the ECJ produced a list: the market share held by the mark; how intensive, geographically widespread and long-standing the use of the mark has

¹¹⁶ *Wm J Wrigley Co's v OHIM*, *op. cit.*

¹¹⁷ *Windsurfing Chiemsee*, *op. cit.*

¹¹⁸ The Patent Office - the UK refers to more evidence in terms of length of use or amount of turnover.

¹¹⁹ *Windsurfing Chiemsee*, *op. cit.*

been;¹²⁰ the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from the chamber of commerce and industry or other trade and professional associations.¹²¹ There is not an aversion to consumer surveys; they are indeed of value. Moreover, the ECJ establishes that when the competent authority has difficulty in finding the connection between consumers and the trade mark, it should “under the conditions laid down by its own national law, to an opinion poll as guidance for its judgement”.¹²² This list given above is neither exhaustive nor cumulative. It is important to be aware that the evidence submitted should come from an independent source which must contain information regarding the method followed, namely the kind of questions used in that particular research.

Additionally, in the case the ECJ established that “if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.”¹²³ This statement gives just a preliminary guidance because there are issues that derive from it: first of all, what is to be considered the ‘relevant consumer’ and secondly, what is to be regarded as ‘use’. I will now proceed to examine each of these in turn.

4.5.1 The Concept of Relevant Consumer

It is established that to acquire distinctiveness through use the key issue is to show that the public has come to think of the sign as coming from a particular source. When referring to ‘the public’, this term refers to the average consumer who is reasonably well-informed and reasonably observant and circumspect. A well-known conception used by the ECJ early on in cases relating to unfair competition.¹²⁴ Basically, this term refers to a customer who is to be competent and capable of choosing from different products. Moreover, the relevant consumer is the one who is significant in the trade circle.

¹²⁰ In the *lastminute.com* decision the appellant argued that distinctiveness could be acquired quickly through the Internet. The BoA refused the argument, arguing that four months was not sufficient. It is not clear how much time is required. *Last Minute Network Ltd's Application* R1043/2001-2.

¹²¹ *Windsurfing Chiemsee*, *op. cit.*, para. 51.

¹²² *ibid.*, para. 53.

¹²³ *Windsurfing Chiemsee*, *op. cit.*

¹²⁴ *Gut Springenheide*, *op. cit.*

Note that consideration needs to be given to the attention of the relevant public since it is likely to vary according to the category of goods/services proposed.¹²⁵ Basically, when referring to purchases of everyday goods/services *e.g.* soap or to specific products *e.g.* a car, the degree of deliberation varies and thus the attention given by the consumer is different. There is therefore the necessity to establish the nature and kind of consumer and their attitude towards the product. It is indeed a correct approach since the market is made up of a mixed public. Still, the concept appears to be quite clear and moreover the concept of relevant consumer does not vary according to the type of marks.

Finally for the sake of completeness it is important to mention that while average consumer and relevant consumer appear to be interchangeable terms the difference is that they are used in different matters and thus different tests are provided accordingly. For instance average consumer relates to proving distinctiveness *ab initio* whereas relevant consumer applies to proving distinctiveness through use.

4.5.2 Use of the Mark

When assessing if a mark acquired distinctiveness through use there are two issues that we must bear in mind. Firstly, that the mark has to be used as a mark and secondly, the use of the mark as part of or as a component of another mark. These two situations need to be carefully considered specially when examining chemical sense marks. The reason being that smell and taste are used very much in trade as being part of a product, and not as an indicating source (no used as a mark). Moreover, it is important to observe that there is a third issue which must be taken into account when examining either of the above, which is territoriality. Each of these will be studied in turn.

Use of the Mark as such – Monopoly v Use as a Trade Mark

The concern has been raised as to whether a sign could acquire distinctiveness where a trader has been the only supplier of particular goods to the market. At present, there are two well-known cases regarding that issue. Both relate to shapes, namely a three-headed shaver (*Philips*), and a transparent collecting bin (*Dyson*).

¹²⁵ *IVG Immobilien AG v OHIM* T-441/05, para. 63.

In the first case, there was evidence that PHILIPS operated a monopoly since it was the only seller of three-headed shavers. Because of that, the public associated the shape with the trade mark. The difficulty was that it had not been possible to ascertain how consumers would have understood the three-headed shape if traders, other than PHILIPS, had presented it to them. Referring to this enquiry, the ECJ replied that extensive use of the shape 'may be sufficient to give the sign a distinctive character'.¹²⁶ In the same line, it suggested that it may be difficult to demonstrate that a substantial part of the relevant consumers has associated the shape with a specific trader, however. Professor Bently implies that if familiarisation and/or association existed, it was not gained by the use of the three-headed shape as a trade mark because distinctiveness can only be obtained as a result of the use of the sign as a trade mark, the shape in this case has not acquired distinctiveness.¹²⁷

We can apply this assumption to the following example; it is said that one of PLAY-DOH's most notable compounds is its scent. Thus, in 2006 Hasbro Inc bottled eau de PLAY-DOH smell.¹²⁸ Hence, does it mean that the aroma is distinctive? The theory of use applies because distinctiveness can only be obtained as a result of use of the sign as a trade mark, the smell as such has not acquired distinctiveness. However, the situation with monopoly is quite tricky. If the only modelling compound known to you is PLAY-DOH, when opening a bottle of eau de PLAY-DOH you will recognise it, the smell is distinctive to you.¹²⁹ The problem resides in the fact that there is no other product with the same status for comparison. Now, if there were a group of similar products (no monopoly) then, the smell would not distinguish or differentiate one good from another and therefore you will not distinguish it. This example is just a presumption, but if we look at an actual case, perhaps it will come clearer.

In *Dyson*,¹³⁰ the High Court of Justice (England and Wales) observed, when referring the case to the ECJ, that the sign in question had not been actively promoted as a trade mark by DYSON. It was, according to the court, the fact that consumers were informed by

¹²⁶ *Philips v Remington, op. cit.*

¹²⁷ Bently, *op. cit.*

¹²⁸ Business Wire, 'Play-Doh(R) Brand Modeling Compound Makes a "Scent-Sational" debut as It Celebrates 50 years' < <http://home.businesswire.com> > viewed on May 2006.

¹²⁹ Recognition is not the same as distinguishing in Trade Mark law.

¹³⁰ *Dyson Ltd v OHIM, C-321/03.*

advertising and the lack of any rival products on the market (a *de facto* monopoly) that consumers associated the sign with a single undertaking. The High Court of Justice emphasised that until the date of application, the applicant had a *de facto* monopoly and following this statement it asked the next questions: first, was it sufficient, in order for the sign to have acquired distinctiveness within the meaning of Art 3(3) of the Directive, that a significant proportion of the relevant public has by the date of application for registration come to associate the relevant goods bearing the sign with the applicant and not another undertaking?

In the second question, the referring court also questioned if that was not sufficient, what else is needed in order for the sign to have acquired distinctiveness and specifically, if it was necessary for the person who has used the sign to have promoted it as a trade mark.

The ECJ did not answer the questions directly, however. In fact the court based its decision on whether the mark was actually a sign (Art 2 CTMR). It followed with a discussion on the issue of distinctiveness concluding that the sign in question was not capable of acquiring distinctive character due to the fact that registration was refused under Art 3(1)(e) of the Directive and as such, it did not fall within the proviso.

Even though the ECJ did not answer the question as such, the point was clear: should the fact that consumers are familiar with the shape coming from a particular source be sufficient without concern as to how it was obtained? In principle it should not, the statement should be followed literally: distinctiveness can only be obtained as a result of the use of the sign as a trade mark. However, we may question: is not the purpose of distinctiveness that a mark shall be recognised as coming from a particular undertaking? If so, as it is, why should the resources be questioned? What matters is the result. It is understandable that in both cases there was the issue of giving monopoly to certain manufacturers over functional and technical issues and in this situation registration must not be allowed.

Signs are understood as indicating that a product emanates from a particular source due to the particular sign being employed by a trader. As a result, the sign has come to be associated with the business. The situation is however that Art 7(1)(b) CTMR not only

claims distinctiveness in a good/service because the good/service is distinctive on its own. A trade mark, for which registration is sought, has distinctive character if it serves to distinguish the goods/services from those of other undertakings. If the Article is to be understood literally, for a mark to be distinctive it needs to be assessed not only on its own but also in comparison with others. It is clear then that if a product has a monopoly, it cannot fairly be compared and thus, cannot be considered to be distinctive.

Now, taking a more objective point of view, what would happen to those products that are the only ones in the market but not because of monopoly? For example, if the three-headed shaver was something that competitors did not want to engage in. I believe that in this case there is not a situation of monopoly but of exclusivity and thus, the product as such is distinctive. It is logical to assume that a mark can become distinctive in its own right and alone; the contrary would be unsound. Having said that, just because a mark, which is attached to a product, does not have any other product to compare with, it cannot be said to lack distinctiveness.

Returning to the cases mentioned, *Dyson* and *Philips*' signs, the three-head shaver and the transparent bin or collection chamber, were known as being part of a particular product and so not necessarily meaning that they were known as a trade mark. Nevertheless, I believe that there is a misconception. For example, even though consumers do not know that the sign is a mark, still consumers distinguish it as coming from a particular undertaking and also they distinguish it from others. There is indeed a situation in which the concept of trade mark has been developed: a sign which is capable of 'distinguishing' the goods/services of one undertaking 'from' those of other undertakings.

This is an important point that needs to be considered if businesses start using new type of signs in the market. For instance, if a trader starts to use smell marks for its products and nobody else in the market uses smell marks for the same type of product does it mean that such a mark cannot rely on acquired distinctiveness? Moreover, if consumers by seeing the mark know that it comes from a particular source but do not know that such a sign is to be the mark does it mean that such a mark cannot rely on acquired distinctiveness? In these examples I believe that the sign in question even though not use as a 'mark' by consumers, it is indeed a mark in fact and in law. If we bring the definition brought by Article 4 CTMR

a trade mark is a sign which is capable of being distinctive, and in here we have a sign that conveys information and is indicating source. Therefore the question is: do consumers need to know that the sign is in fact a trade mark?

Certainly, to determine when a sign, because of its monopoly, is understood by consumers as being the sign is difficult. A sign is in fact the trade mark, rather than part of the product and a common or even a fanciful or capricious feature of the product to make it more appealing to consumers. Nevertheless this is for the applicant to prove; my point being that the examiner should not be persuaded by the fact that the goods and/or services hold a monopoly on the market. Indeed, the focus must be whether the questioned mark is recognised by the average consumer as coming from a particular undertaking.

Use of the Mark as Part of or in Combination with Other Marks

It is possible to acquire distinctive character even when a mark has been used as part of another mark. In this situation two circumstances can be seen. On one hand, when the mark is used as part of a registered mark, as a component thereof and on the other hand, when the mark is used as a separate mark but in conjunction with a registered trade mark. In *Société des Produits Nestlé SA v Mars UK Ltd (Have a break)*,¹³¹ the phrase ‘HAVE A BREAK’ was denied registration due to the words being used to advertise KIT KAT rather than as an indicator of origin. Both the examiner and latter on the Court of Appeal held that the words were devoid of distinctive character. Regarding acquired distinctiveness consideration was based on the fact that the words ‘HAVE A BREAK’ had always being used as a part of the phrase ‘HAVE A BREAK, have a KIT KAT’ and therefore, such use could not establish acquired distinctiveness for the three words ‘HAVE A BREAK’. The court referred the case to the ECJ for a preliminary ruling and while the ECJ concluded that it is for the national court to determine whether the mark had come to identify the product or service concerned, it held that “the mark seeking registration may not need to have been used *independently* and Art 3(3) of the Trade Mark Directive does not place such a restriction upon the mark and only refers to use which has been made of the mark...”¹³² (emphasis added).

¹³¹ *Société des Produits Nestlé SA v Mars UK Ltd (Have a break)* C-353/03.

¹³² *ibid.*

Therefore, use of the mark as part of or a combination with other appears resolved: the mark in respect of which registration is sought need not have been used independently. The *Have a break* case goes along the same lines as a previous one already decided by the ECJ. In *Philips* the court approved that a sign may acquire distinctive character as a consequence of the use of that sign ‘as part of’ or ‘in conjunction with’ another mark.¹³³

However, the case in question related to combination of same type of marks. Will combination of different type of marks be the same? For example when there is a combination of a word mark with a colour mark, or a word mark with a chemical sense mark does use of the secondary mark acquire distinctiveness by use with or as part of a primary mark?

In the *Have a break* case, one can see the combination of the marks literally; ‘HAVE A BREAK, have a KIT-KAT’ they were tied together as a slogan. It is however difficult to see that link when two totally different types of marks are combined. The problem is that they will be seen not as a combination as such but as a primary mark and a secondary one. For example when registering unconventional marks we have observed that they have indeed another mark, usually a word mark, such as, DYSON, TOBLERONE, ORANGE and so on.

Hence, when approached with a product with multiple trade marks, it is still possible to doubt whether a particular secondary mark has acquired distinctive character when the use of such a mark has been as part of another mark. Certainly, consumers tend not to rely on the new second mark but on the primary one.

The situation arose in *Cabot Safety Intermediate Corporation's Application*.¹³⁴ The applicant sought to register a 3D mark consisting of a product packaging, used in conjunction with other marks. The office rejected the application on the grounds that the trade mark was devoid of any distinctive character because it consisted of the three-dimensional image of the common packaging used for the particular trade. Moreover, the examiner observed that there was no evidence that the mark had become distinctive since it was used in conjunction with other marks. On appeal, the BoA found this issue interesting due to the fact that very few products are sold without labels containing words or figurative

¹³³ *Philips v Remington, op.cit.*

¹³⁴ *Cabot Safety Intermediate Corp's Application* R381/2000.

elements. Thus, the Board believed that the examiner's opinion was not correct with regards to a mark being considered in an isolated way.

In deciding, the Board sets the following principle: the use of the 3D mark in combination with additional word or figurative elements is not *prima facie* flawed as long as these additional elements do not divert the consumers' attention from the shape of the packaging or from the product itself. The Board went on to explain the daily experiences of a consumer and concluded that it was normal for undertakings to use not only verbal marks but also logos, colours and shapes for products or packaging in order to create a distinctive visual image.¹³⁵ It is said that many consumers identify the products on the basis of their overall appearance and thus, nothing prevents the consumer from recognising a product on the basis of its shape simply because they see it invariably accompanied by a word mark or by a coloured logo.¹³⁶ To this end, the Board established that although a shape is used jointly with words, it does not necessarily mean that the shape as such cannot acquire distinctive character through use.

Accordingly then, the question to answer is whether consumers, when seeing the naked shape of the applicant's packaging, without word marks or logos, whatever the colour(s) of the packaging, would recognise it and would associate it with a particular commercial origin.¹³⁷ In this case, the Board rejected the application on the grounds that the figurative elements surpassed in attractiveness the shape itself. Thus, because the colour combination was dominant, the shape of the packaging played only a minor role, if any, in the identification of the product's origin.

This decision gives us an insight into how the recognition of uncommon marks has progressed. On one hand, early decisions and opinions did refuse registration of a mark, specifically in the case of shape marks, because it was not enough to prove that the public recognises shape marks as the product of a particular undertaking. There must also be evidence that consumers regard the shape as a badge of trade origin in the sense that they would rely on that shape 'alone' as an indication of trade origin.¹³⁸ On the other hand, in

¹³⁵ *Cabot Safety Intermediate Corp's Application* R381/2000, para. 20.

¹³⁶ *ibid.*

¹³⁷ *ibid.*, 21.

¹³⁸ *Société des Produits Nestlé SA v Unilever plc (Vienetta)* C-07/03P..

the light of recent case law, there is no need to demonstrate that the public has come to regard the mark ‘alone’ as a mark of trade origin; this does not and should not matter since the mark need not have been used independently.¹³⁹ Certainly, the evolution of ideas are observed which are very helpful in cases of chemical sense marks since as noted, unconventional marks are more of a secondary marks.

Area of Recognition -- Territoriality

In principle, the Community is to be considered as a whole and thus, distinctiveness must be demonstrated by the use of the mark in the substantial part of the Community where it was devoid of distinctive character. That said, it is important to be aware that when referring to consumers they must be in that particular area. Therefore, a claim for distinctiveness in the Community, meaning the submission of documents relating to the ‘single market’ and not to the situation in each Member State, is to be the commonly accepted position.¹⁴⁰

It is important also to be aware that when the objection relates to part of the Community only, the evidence merely needs to relate to a precise area.¹⁴¹ The problem is, if distinctiveness must be proved in that particular part of the Community where it is lacking, then how can it be proved if the evidence quotes the Community as a whole? In theory, (and also in practice) ‘part’ of the Community relates to identifiable Member States and as such, these are the ones where distinctiveness must be proved. Evidence that relates to ‘the Community’ must not be accepted since it will be referring to various Member States and perhaps not the one where the mark is lacking distinctiveness. Indeed, it does not provide precise information as to the Member State which is really affected.

In the OHIM Annual Report¹⁴² it is recognised that “...neither the letter nor the spirit of Art 7(3) CTMR seem to be opposed to a claim for distinctiveness in the Community being based on documents relating to a single market as a whole (all territories together), without

¹³⁹ *Société des Produits Nestlé SA v Mars UK Ltd (Have a break)*, *op. cit.*

¹⁴⁰ OHIM, Case law from the Boards of Appeal <http://oami.europa.eu/bulletin/ctm/ctm_bulletin_en.htm> viewed on December 2008.

¹⁴¹ ECTA European Trade Mark Association, ‘The Changing Faces of Trade Mark’ (Conference Organised by ECTA Rotterdam, June 13 to 16, 2001).

¹⁴² OHIM, Annual Report 2003 <<http://europa.eu.int>> viewed on Feb 2007.

analysing in depth the situation in each Member State.”¹⁴³ Even though this is so, I believe that evidence can be too general if referring to the single market. In my opinion, evidence must be submitted addressing particularly those Member States where the sign lack distinctiveness.

This view can be observed in the *Corona*¹⁴⁴ case (long-necked beer bottle) when the CFI observed that the applicant’s evidence was referring in a general way to various Member States and such evidence was not clear. The Court made the subsequent comment: “the financial results...do not distinguish between the different trade marks used by that company or between different geographical markets...does not provide any precise information as to the market share held by the mark applied for and as to amounts invested by the company to promote it. It cannot therefore be deduced from that document that at least a significant part of the relevant section of the public within the Community perceives the mark applied for as indicating the commercial origin of the products and services in question”.¹⁴⁵

Critics see that the applicant’s evidence referred to a number of different marks and that the Court could not be clear as to which mark the evidence was referring. Such a statement, even though accurate, does not diminish the fact that the court also implies that evidence from different geographical markets must be established. However, seeing the argument from both sides of the spectrum, on one hand it is possible to submit evidence referring to the ‘single market’. This is implied by the Court when it mentions that it is not clear that the relevant section of the public ‘within the Community’ perceives the mark as an indicator of origin. On the other hand, it is possible to refer to some Member States since a sign can acquire distinctiveness in some Member States due to market share held by the company and also the amounts invested by the company to promote it. Moreover there is, as the examiner suggests in *BP plc (Green Striplight)*,¹⁴⁶ the possibility of over-spill reputation.¹⁴⁷

¹⁴³ OHIM, Annual Report 2003 <<http://europa.eu.int>> viewed on Feb 2007, p. 34.

¹⁴⁴ *Eurocermex SA v OHIM (Forme d'une bouteille de bière)* T-399/02.

¹⁴⁵ *ibid.*, para. 50.

¹⁴⁶ *BP plc's (Green Striplight) Application* R15/2001-4.

¹⁴⁷ *ibid.*, para. 27.

However, if we take a look at the Directive it says ‘in the substantial part of the Community’; that said, the view that the requirement implies ‘all Member States’ will seem extreme. The Directive does not literally imply the whole community. Nevertheless, the question remains: is it possible to draw a conclusion at Community level on the basis of figures from some of the Member States?

This view can be seen in *BovemijVerzekeringen NV v Benelux-Merkenbureau*.¹⁴⁸ In this case, the ECJ agreed that a Benelux trade mark could only be found to have acquired distinctiveness through use where this use was accepted in a substantial part of the ‘Benelux’ territory rather than just in the Netherlands. Consequently, the term ‘use’ must be taken literally. It is not possible to overcome an objection under Art 7 (1)(b),(c) or (d) CTMR by demonstrating that the mark applied for has acquired a distinctive character within just a particular locality or region.

Certainly, to believe that evidence from the whole Community (27 Member States) is needed when claiming distinctiveness through use, seems to be impractical.¹⁴⁹ Yet, practice indicates that when referring to a ‘substantial part’ it refers only to those Member States where the sign lack distinctiveness and thus evidence from those must be presented: not the whole Community. Note however that if a sign lack distinctiveness in just one member state, it will impair the CTM application.

Finally, it is important to remember that some Member States’ prior registrations may be significant only in the context of those countries (nationally).¹⁵⁰ It does not involve other Member States and even less likely ‘the Community’. Having said that, OHIM is not legally obliged to ensure that its decisions are consistent with national decisions.¹⁵¹

To summarize distinctiveness through use it appears that the OHIM and the courts’ view is that there exist situations where it is more difficult to assess the distinctive character in certain trade marks. It does not mean that such marks are *a priori*, devoid of distinctive

¹⁴⁸ *BovemijVerzekeringen NV v Benelux-Merkenbureau (Europolis) C-108/05*.

¹⁴⁹ A Folliard-Monguiral and D Rogers, ‘The Protection of Shapes by the Community Trade Mark’ [2003] *EIPR* 169, 172.

¹⁵⁰ *Ty Nant Spring Water Ltd’s Application, op. cit.*

¹⁵¹ *Telefon & Buch, op. cit.*

character or could not acquire distinctiveness through use.¹⁵² In any event however, the mark must have acquired distinctiveness at the time of application¹⁵³ and must be present at the time of the decision.

Coming to the end of this Chapter, there has been criticism regarding the absolute grounds of refusal and if there is any difference between ‘devoid of distinctive character’ (paragraph (b)), ‘descriptiveness’ (paragraph (c)), and/or ‘customariness’ (paragraph (d)). Moreover, the issue is whether these grounds are directed at distinctiveness only, or whether they are also related to public policy. We now therefore turn to this situation considering that both bar from registration chemical sense marks: firstly because chemical senses marks appear to lack distinctiveness and secondly, they do belong to a very narrow variety and so the theory of depletion appears to be applicable.

4.6 The Need to Keep Free

The ECJ has not always explained the reason for keeping some signs free for all to use. Moreover, criticism has been made of those grounds (paragraph (b), (c) and (d)) believing that they need to be only explained under the principle that they do not serve to distinguish the goods/services and not under the principle that, as a matter of public interest, they need to be free for use by all. This is controversial, and thus there is a continuing debate over these two arguments - origin function and protective function.¹⁵⁴

The dispute stems from the fact that some countries are more free market-oriented. Registering certain signs mean a monopoly and so, restriction of trade.¹⁵⁵ In the same vein, the CFI has made reference to the underlying policy built into the Directive to prevent some signs from being taken as monopoly rights and thus, being used to impede competition between businesses. This reference has come after the *Libertel* case which, as mentioned before, refers to the application for registration of colours. We may recall that the ECJ held that the public interest underlying Art 3(1)(b) of the Directive (Art 7(1)(b) CTMR) was directed at the need not to restrict unduly the availability of colour for other

¹⁵² *Nichols plc, op. cit.*

¹⁵³ *Windsurfing Chiemsee, op. cit.*

¹⁵⁴ *Handler, op. cit.*, p. 307.

¹⁵⁵ J Bergquist and C Duncan, ‘Shape Trade Marks and Fast-moving Consumer Goods’[2008] *EIPR* 17, 17.

traders. Thus, in *Deutsche SiSi-Werke GmbH 7 Co Betriebs KG* (stand-up pouches)¹⁵⁶ the CFI did not question the BoA for mentioning the risk of a monopoly. Moreover, the CFI has referred to the underlying policy behind Art 7(1)(b) CTMR and has gone further, explaining that in the interest of competitors there could not be monopoly for certain signs.¹⁵⁷

Basically, decisions regarding this issue have been contradictory. On one hand, the ECJ in *Windsurfing* and *Baby-Dry* appears to be confused as to whether the public interest policy plays any role when assessing paragraph (c) -- descriptiveness. The Court appears to focus more on whether consumers would perceive the sign as a designation of origin (overlooking the public policy). On the other hand, in other cases, especially after *Libertel*, the ECJ has been keener to extend the purpose of paragraph (c) to include not only the origin function but the protective function -- public policy.

Moreover, discrepancies can be seen with regard to applying the public policy and if it should be applicable to all three paragraphs ((b), (c) and (d)). Thus, in the case of *SAT.1*¹⁵⁸ AG Jacobs recommended that while there was a reason for applying such a policy to paragraphs (c) and (d), that was not the case for paragraph (b). According to him, there was “no obvious reason why signs which simply lack any distinctive character...should be kept free for general use”.¹⁵⁹ Basically, the point is that paragraph (c) and (d) refers to a sign that has a close relationship with the product sought to be registered, and therefore there is a clear understanding of the reasons why the sign at issue needs to be kept free. There is a prevention from using some signs to avoid monopolisation and thus, avoiding putting other traders at a competitive disadvantage. This statement does not have anything to do with paragraph (b).

However, this view seems not to acknowledge that there are signs that even though not descriptive and/or customary, still need to be available *i.e.* single letters, numerals, and colours. It is said that these most basic but commercially indispensable signs still may be caught under a very narrow public interest and still be prevented from being monopolised.

¹⁵⁶ *Deutsche SiSi-Werke GmbH 7 Co Betriebs KG v OHIM*, *op. cit.*

¹⁵⁷ *ibid.*

¹⁵⁸ *SatellitenFernsehen GmbH v OHIM* C 289/10.

¹⁵⁹ *ibid.*

The justification being that if these commercially indispensable signs are used, then traders would potentially incur an onerous cost.¹⁶⁰ In my view, preserving signs that are not related to the product seems to be a primitive approach. Moreover, this idea called the depletion theory is no longer in use. Therefore Art 7(1)(c) and (d) CTMR should rely on the public policy - protective function, as well as origin function. However, Art 7(1)(b) CTMR should and must focus only on the capability of the sign to work as a sign: origin function.¹⁶¹

On the whole, if we transpose these ideas to chemical sense marks, logic indicates that the same would apply. For example, in the *scent of raspberry* case, the grounds for refusal was based on Art 7(b) CTMR and the same can be said for the *smell of ripe strawberries* case; both were considered purely on the grounds that they did not distinguish: an origin function. However, in the latter case, even though the examiner did not look at this issue in depth, it was mentioned that some of the goods were to be regarded as common features by consumers (Art 7(1)(d) CTMR) and, it also mentioned that the issue of public policy was relevant. Therefore, I believe that there are situations in which distinctiveness goes hand in hand with the need to keep free argument.

Another point that needs to be considered is if Article 7(1)(b), (c) and (d) Reflect the Same Public Interest. Therefore, at issue is whether each paragraph must be interpreted in the light of the particular public interest underlying each of them or whether the public interest is the same for all. There is, up to now, no clarification as to whether there is a difference between paragraphs (b), (c) and (d) on this issue.

In *Libertel* for example, colour was banned from registration under Art 7(1)(b) CTMR. The ECJ observed that there is a public interest in not unduly restricting the availability of colours for others offering goods/services of the same type - a depletion theory. However, I must say that this early case did follow the American jurisprudence where colours alone were not allowed registration due to the depletion principle. In following cases such as *Europolis*, as well as in *Postkantoor*, among others, the ECJ remarked upon the public

¹⁶⁰ Handler, *op. cit.*, p. 311.

¹⁶¹ See further I Simon, 'What's Cooking at the CFI? More Guidance on Descriptive and Non-distinctive Trade Marks' [2003] *EIPR* 322.

interest in respect of descriptive signs (Art 7(1)(c)) without mentioning the depletion theory as such but basically focused on the monopoly of signs that every trader needs.

My observation is however that by prohibiting the registration of certain trade marks, specifically descriptive and customariness, these paragraphs pursue a goal which is in the public interest. Whether they target specifically the protection of descriptive signs or indications relating to the characteristics of goods/services, or whether they protect signs that have become customary in the current language or *bona fide* and established practices of the trade in respect of which registration is sought, is trivial. In the end, the aim is the same: the sign may be freely used by all. Therefore, what is highly significant from these paragraphs is that they prevent such signs and indications from being reserved by one undertaking alone if they had been registered as trade marks.¹⁶²

The overall view is that due to the inherent difficulties that a consumer has in identifying certain marks as an indication of its commercial origin, those marks can only be distinctive where the consumer perceives it immediately as an indicator of origin.¹⁶³ Therefore, we must conclude that the need for distinctiveness is related to the fundamental function of a trade mark as a guarantee of origin¹⁶⁴ but considering the public interest -- the need to keep free argument. These two issues must be in placed when assessing chemical sense marks as in any other type of marks. Yet, one can see that because of the nature of chemical sense marks: not usually recognised by consumers as indicating source, and belonging to a narrow range, they suffer to comply with the requirements of distinctiveness.

A final said to finish this Chapter is that although this part of the thesis focus on what a trade mark is and thus the requirements, namely a sign, graphical representation and distinctiveness, I believe that there is another matter that must be in place when analysing chemical sense marks, that is functionality. Whilst functionality appears to relate only to shape marks I strongly believe that such policy should be applicable to chemical sense marks too. Therefore, the following chapter is dedicated to this matter for considering that chemical sense marks may have an extra bar from registration.

¹⁶² *Koninklijke KPN Nederland NV, op. cit.*

¹⁶³ G Humphreys, 'Proof of use, Continuity of Functions in *inter partes* Proceeding, and Three-dimensional Marks: Europe in Review' (2007) 2 *Journal of Intellectual Property Law & Practice* 240, 247.

¹⁶⁴ *Procter & Gamble v OHIM* Joined Cases C-473/01P and C-474/01.

CHAPTER V

FUNCTIONALITY

Signs are not only evaluated with respect to their lack of distinctive character but also as to whether they are functional. That said, a sign is functional if it performs some role other than identifying the product. The functionality theory goes further than a distinctiveness feature. It is indeed, a principle of Trade Mark law that goes hand in hand with a public policy.

The introduction by the Directive of signs that shall not be registered if they consist exclusively of shapes which either result from the nature of the good themselves, or are necessary to obtain a technical result,¹ or gives substantial value to the goods,² do establish a new ban on shapes due to public policy. Thus, this exclusion from trade mark registration is intended to ensure effective competition. However, the situation that remains controversial is whether the functionality theory should apply only to shapes. Clearly, EU legislation implies that it does but this Chapter will bring the argument that there is no reason to limit the application to this, only to shapes.

Moreover, while matters surrounding the functionality theory started by focusing merely on those purely mechanical features, later on it has become broader. Therefore, issues such as technical and aesthetic functionality as well as value added to the goods are at issue. This chapter explores the policies underlying the functionality exclusions of the EU Regulation and Directive; it highlights the tension between the nature and operation of this doctrine and looks towards a wider approach. Thus, while seeking to find a balance, functionality as a theory in the US Trade Mark law shall be studied since it appears to be more developed than the European one and what is more, it is applicable to other types of marks and not only to shapes as in the EU. Therefore, to start this Chapter we need to answer the following question: is the doctrine applicable only to shapes? Or can and should it be applicable to other types of marks, for example chemical sense marks?

¹ Art 7(1)(e)(ii) CTMR.

² Art 7(1)(e)(iii) CTMR.

The functionality principle ensures a legitimate competition in the relevant market. The ability to register the shape of goods as a trade mark did not exist in many EU countries until recently. Hence, the introduction of the Directive was to make this happen. It is worth noting that the functionality principle imposed restrictions based on unfair competition.

By going through the Regulation and Directive, it appears that the only type of mark that the EU legislation protects is shapes. There is no other type of mark that is protected alone, but as explained, they are protected by way of one of the grounds already studied namely, lack of distinctiveness, the mark being descriptive, and so on. Having said that, the doctrine of functionality seems to be covered in the EU legislation but only protecting shapes. Yet when assessing this doctrine, I will bring examples where I believe that the same issues may arise when in presence of chemical sense marks.

The first hurdle encountered when examining shape marks is whether the shape falls foul of Art 7(1)(e) CTMR. If any of the criteria listed in this Article is satisfied, the sign cannot be registered as a trade mark. Moreover, they cannot be saved by proof of distinctiveness acquired through use.

Whilst examining the sign and its potential registrability, the officer will look for the features of the product. Then, he will study whether one of the essential characteristics are attributable solely to achieving the intended technical result. At the first stage, practice indicates that the test that should be applied is whether the feature has a distinctive visual impact. Subsequently, considerations of the pure functionality of the good will be evaluated; the test to apply is then whether the feature is necessary to obtain a technical result. There is a clear line between the aesthetic and the functional.

Under this premise, what follows is logical: it appears that the only sign that is capable of having a technical (mechanical) result is a shape. This subject matter is supported by the fact that EU legislation does not refer to any signs other than shapes.³ Moreover, there appears not to be a further classification as in the US, namely, utilitarian functionality and aesthetic functionality. Then, to take the approach that the functionality theory may apply in the EU to other types of marks, and specifically to this work, to non-visual marks, seems

³ Art 7(1)(e) CTMR.

not clear cut. I however believe that such a theory may be feasible and ready to be applicable to other types of mark.

Seeking to apply the functionality theory to other types of marks, one must delve into the restrictions set out under Article 7(1)(e) CTMR which is similar to the second indent of Article 3(1)(e) of the Directive. This Article is the only one that covers the functionality doctrine. It mentions shapes that cannot be registrable due to being exclusively the result of the nature of the goods, or if the shape is such that it exclusively achieves a technical result, or if the shape exclusively gives substantial value to the goods.

However, it is observed that of the three bars there is just one which refers to functionality as such -- technical result. Note that the term functional is not used in any EU legislation, but is indeed used by its institutions. The other two bars observed under the Article, a shape that is a result of the nature of the goods themselves, is said to not belong to any functionality doctrine at all; the other type of shape, the one that gives substantial value to the goods, is not understood as functional in the EU but is treated as such in the US. Because of these matters, the nature of the goods will be considered briefly while the remaining two will be studied extensively.

5.1 Shapes Which Result from the Nature of the Goods Themselves

The nature of the goods refers to their innate characteristics or qualities; the 'goods' being any of the goods in the specification viewed as an article of commerce.⁴ Therefore, the exclusion prohibits shapes resulting from the nature of the goods since it dictates the shape of it. For example, the shape of a magazine file is dictated by the need to accommodate the shape of magazines. Furthermore, it is not concerned with preventing the registration of marks consisting of the shape of the goods themselves. For example, if the shape has been the subject of substantial design input, then this objection no longer applies. Basically, this bar objects to the registration of basic or generic shapes and thus, accordingly with case law, it should be interpreted narrowly.

⁴ A Firth, 'Shapes as Trade Marks: Public Policy, Functional Considerations and Consumer Perception' [2001] *EIPR* 86, 92.

In Singapore, the test used to assess whether a shape is one which results from the nature of the goods, considers the following:

- (i) the extent to which the shape is regarded as the normal shape of the goods;
- (ii) where the goods have a uniform shape, whether the shape is a variation from the uniform shape;
- (iii) where the goods come naturally in a range of shapes, then any one of the usual shapes will be open to objections.⁵

While in the EU there is not such a test, one cannot avoid seeing the pattern followed by the OHIM and national registries.

As seen, the exclusion evaluated does not merge with the functionality theory. On the contrary, there is some overlap between this bar and those that prohibit marks which are devoid of distinctive character or where the mark is descriptive of the goods/services. For example, where the trade mark is a container in the shape of a hive for honey, objections can also be made that the mark is descriptive and thus, not distinctive.⁶ This criteria could be applied to chemical sense marks for instance: smell which result from the nature of the goods themselves e.g. perfume, potpourri, air freshener, etc. However as said, I believe that this type of bar is already covered by absolute grounds of refusal.

5.2 Shapes Which Are Necessary to Obtain a Technical Result

Article 7(1)(e)(ii) CTMR provides that “signs which consist exclusively of ... the shape of goods which is necessary to obtain a technical result ... shall not be registered.” Similarly, according to the second indent of Article 3(1)(e) of the Directive, “signs which consist exclusively of ... the shape of goods which is necessary to obtain a technical result ... shall not be registered or if registered shall be liable to be declared invalid.” This objection rules out registration of purely functional shapes. As mentioned, EU legislation does not refer to functionality as such but it is indeed widely used by the ECJ, national courts, academics and the like.

⁵ Intellectual Property Office Singapore, Work Manual, Shape Marks
<<http://www.ipos.gov.sg?NR/rdonlyres/E12B59C5-FFF1-4482-80C1>> viewed on April 2009, pg 7.

⁶ Professor Jeremy mentions that there is no grounds for refusal of a trade mark for product shapes which directly corresponds to descriptiveness. J Phillips, *Trade Mark Law: a Practical Anatomy* (Oxford University Press, Oxford 2003) para. 5.86.

The objection excludes shapes which are motivated by and are the result of technical considerations; the shape has indeed an exclusive functional task. The ECJ in the *Philips v Remington*⁷ case ruled that a sign consisting exclusively of the shape of the goods is unregistrable if the essential features of that shape are attributable only to the technical result. This point has not arisen in Trade Mark law before. Thus, the starting point regarding functionality in trade mark is the aforesaid case.

The well-known case even though not related to registration but a case of infringement, relates to three-headed rotary shavers. PHILIPS has been in the business of manufacturing shavers since 1939 and introduced the three-headed rotary shaver in 1966. By 1985 PHILIPS registered a trade mark consisting of the picture of a face of the three-headed rotary shaver in Class 8 (electric shavers). By 1993, PHILIPS registered a variant of the first mark, a picture of the face of the three-headed rotary but with the three heads sitting within a raised faceplate of clover leaf design, also in Class 8. In 1995 REMINGTON, another manufacturer in the shaver industry started selling a three-headed rotary shaver in the UK. Infringement proceedings were brought by PHILIPS against REMINGTON alleging trade mark infringement on the first mark. Remington denied any wrong doing and challenged the validity of the PHILIPS trade mark by way of a counterclaim. REMINGTON succeeded in both instances. The legal point was based on the grounds covered by s 3(2)(b) of the 1994 Trade Mark Act which is derived from the Directive. This subsection excludes from registration ‘the shape of the goods which is necessary to obtain a technical result.’

In the first instance, Jacob J referred to and relied on a functional design case due to this point not being previously raised in Trade Mark law. The case relied upon was *Amp Inc v Utilux Pty Ltd*.⁸ This case refers to the registration of electrical terminals used in washing machines which were shaped so as to hold electric leads. The judge in the case, relying on the Registered Designs Act 1949 (RDA),⁹ rejected the registration on the grounds that the features of the design were dictated solely by function and thus invalid. The RDA sets as a grounds of refusal “...features of appearance of a product which are solely dictated by the

⁷ *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* C-299/99.

⁸ *Amp Inc v Utilux Pty Ltd* [1972] RPC.

⁹ Hereafter RDA.

product's technical function'.¹⁰ The Court went on to explain that the shape at issue was not there to 'appeal to the eye' but solely to make the article work and thus, was excluded from statutory protection. The design therefore was not registrable due to the fact that it contained features of shape which were dictated solely by the function - to perform.¹¹ The judge observed that the legislation (referring to the RDA) is intended to prevent granting a proprietor a monopoly for functional characteristics.¹²

One might query this decision since it is based on Design law; can a trade mark case safely rely on a case decided by other law? Certainly, there are differences between the nature and purpose of trade mark protection and design. At the time, there was no case law regarding the doctrine of functionality as applied to trade marks. As a result, was it proper to apply Design law to Trade Mark law? I believe it was. It is clear that Trade Mark law intends to fulfil a source-distinguishing function. Then, the judgement proposition that Trade Mark law intends to prevent the competitive use of utilitarian features of products is not at all a deviation. Certainly, in modern jurisprudence one must create a balance between monopoly rights and free competition. Therefore, it is indeed of greater significance that the court confirmed that the doctrine of functionality applied the same in Trade Mark law as in Design law. Moreover, it is of even more significance that Trade Mark law protects functional shapes.

Going back to *Philips v Remington*, the Court of Appeal agreed with the lower court and for clarification, sent the case to the ECJ for preliminary ruling. Asking a number of questions, the Court of Appeal requested elucidation regarding s 3(2)(b) of the Trade Marks Act 1994 (Art 7(1)(e)(ii) CTMR). The ECJ held that "a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to technical result."¹³ The objection is not overcome by showing that other shapes are capable of producing the same technical result, *i.e.* even if it is not the only shape possible that will yield the same technical result. In the *Philips* saga, this issue was explicitly set. The fact that there are other shapes which allow the same technical result to be obtained is no defence; a shape

¹⁰ s 1C (1) RDA.

¹¹ *Amp Inc v Utilux Pty Ltd*, *op. cit.*, para. 109.

¹² This was mentioned in *Philips v Remington*, *op. cit.* See further J Clark, 'Adorning Shavers with Clover Leaves: Koninklijke Philips Electronics NV v Remington Consumer Products Ltd' [2006] *EIPR* 352, 353.

¹³ *Philips v Remington*, *op. cit.*, para 84.

does not perform a technical function any less than it could have if it looked different while achieving the same technical result.¹⁴

Note that the objection brought by PHILIPS, the fact that there were other shapes capable of producing the same result, is not out of order. The situation is that the objection set up by Trade Mark law is brought by Design law. Both of them bar from registration shapes (products) which are designed in that way because the shape contributes to the use of it; the form adopted plays a key role. That said, both laws refer specifically to ‘technical function’. Having brought the functionality doctrine from Design law to Trade mark law, the assumption is the same. However, in Design law the objection runs against the product when it is the only possible design in which the product will be able to perform its function.¹⁵ Hence, understandably, PHILIPS tried to draw attention to this issue.

In 2000, PHILIPS started infringement proceedings once again against REMINGTON for the use of an identical or confusingly similar mark (the ‘clover leaf’ mark).¹⁶ The position of this case was that the only difference between this mark and the earlier one (already declared invalid) was the clover leaf feature. Once more REMINGTON successfully challenged the validity of the PHILIPS trade mark. The judge held that the registration of the device marks were invalid by undertaking an assessment of the shape and identifying its essential characteristics and features. By doing so, the judge considered that the mark consisted exclusively of features of the shape of the goods which were necessary to obtain a technical result.

The addition of the clover leaf feature did not produce a valid registration since by removing it, all that was left was the previous invalid functional mark. Thus, the whole area of the clover leaf did in fact perform a function in the technical shaving operation. By considering evidence, Rimer J went on to study the function of the whole area. It was explained that the area where the clover leaf was placed performed the function of stretching the skin and raising the hairs for effective and painless shaving; moreover the residual part of the faceplate contributed to a smooth shaving operation.

¹⁴ *Philips v Remington, op. cit.*

¹⁵ The words ‘solely dictated’ used by the RDA means that the product is the only one by which a particular function can be achieved (*Bailey v Haynes* ([2006] EWPC 5)).

¹⁶ *Philips v Remington, op. cit.*

The court concluded that despite the presence of the clover leaf, the mark was still invalid under s 3(2)(b) Trade Mark Act 1994. Rimer J went back to the ECJ judgement in the previous *Philips* case in which the Court gave guidance on the scope of Art 3(1)(e) of the Directive. His approach therefore followed two steps. The first step was to identify the ‘essential characteristics or features’ of the shape of the goods at issue. After that, it was necessary to determine whether the essential characteristics or features consisted ‘solely’ of the shape of the goods which are attributable only to the technical result. Furthermore, Rimer J concluded that the clover leaf, as a feature of the overall shape of the goods, did not have any distinctive ‘eye impact’ on potential purchasers and consumers.¹⁷ Therefore, the clover leaf was not an essential feature of the shape of the goods. By the second step, the functionality of the shape mark was at issue. By considering the functionality of the shape mark, the judge went over PHILIPS’ argument - the clover leaf and the lower residual areas of the faceplate performed no technical function but were merely aesthetic.

Then, it was argued that the shape of the faceplate was not attributable ‘solely’ to obtaining the technical result. The judge however, rejected the arguments and moreover refused the argument that there was the need to examine every part of each essential feature of a shape in order to see if it performed a technical function. Furthermore, the court established that what was needed was to look at the faceplate as a whole and thus, whether it achieved a technical result.¹⁸ Clearly, while considering the shape as a whole, there is no need to see or separate aesthetic embellishment since it forms part of the shape. Therefore, the key is to consider whether the shape is functional or not. The judge considered the sign as functional and thus, the mark was invalid.

The claimant appealed. The two grounds that were admitted by the Court of Appeal were based on the judge’s misapplication of the test set by the ECJ case, namely, first whether a feature of the shape represented in the mark was essential and second, whether a feature of a shape was attributable ‘solely’ to obtaining a technical result. By scrutinising the first test, PHILIPS argued that the clover leaf should not have been single out and then, it questioned whether the clover leaf was or was not an essential feature. Moreover, it argued that any feature which contributes to the overall impression was an essential feature. The

¹⁷ Clark, *op. cit.*, p. 353.

¹⁸ *Philips v Remington*, *op. cit.*

Court of Appeal disagreed however. It held that the judge did not err. The question of essential feature was one of fact and degree for the judge to evaluate.

Regarding the second test, PHILIPS argued that the ban operates only when all the essential features of the mark are attributable to a technical result. Having said that, not all of the parts of the shape were functional and thus, it could not be concluded that the essential features of the shape are attributable only to a technical result. The Court of Appeal once again disagreed. It rejected the proposition that the court needed to slice the mark so as to determine what role each part has - wholly or partly functional; the reason being that the court supports a global approach when considering functionality. It concluded, by supporting the lower court, that PHILIPS' shaver was a piece of electrical equipment whose purpose was to perform a particular function. In light of this, the Court of Appeal held that the clover leaf mark was invalid.

Recent case law developments have focused on the meaning and application of two phrases, namely: 'consists exclusively of' and 'necessary to obtain a technical result'. The technical result objection was discussed in depth by the CFI in *Lego*¹⁹ which dealt with LEGO's registration for their famous brick shape for construction toys and other items (Class 9 and 28). The CFI, backing a 2004 decision of the OHIM Board of Appeal cancelled LEGO's trade mark registration. The background of the case goes as follows: in 1999 LEGO applied to make its traditional brick a registered trade mark in Europe. Two days later, competitor toy brick company MEGA BRANDS filed an objection to the registration.²⁰ The Cancellation Division had stayed the proceedings, pending delivery of the judgment of the ECJ in *Philips*;²¹ when resumed, the Cancellation Division rightly declared the registration invalid with respect to 'construction toys' in Class 28, on the basis of Article 7(1)(e)(ii) CTMR, finding that the mark at issue consisted exclusively of the shape of goods which was necessary to obtain a technical result.

LEGO filed an appeal and the case went to OHIM's Grand Board of Appeal. That Board said that LEGO could not be given a trade mark because the brick's shape performed a technical function and to give someone a monopoly over the shape would give them a

¹⁹ *Lego Juris A/S v OHIM* T-270/06. Ratified by the ECJ in September 2010.

²⁰ *Lego Juris A/S's Application* R0856/2004-6.

²¹ *Philips v Remington*, *op. cit.*

monopoly over that function. In full, the Grand Board observed that Article 7(1)(e)(ii) CTMR is designed to bar from registration shapes whose essential characteristics perform a technical function, hence allowing them to be freely used by all.²² It took the view that a shape does not escape that prohibition if it contains a minor arbitrary element such as a colour.²³ Moreover, it dismissed the relevance of the existence of other shapes which can achieve the same technical result.²⁴ Regarding the word ‘exclusively’ used in Article 7(1)(e)(ii) CTMR, the Board went on to explain that what is meant is that the shape has no purpose other than that of achieving a technical result. In regard of the word ‘necessary’, used in that same provision, it explained that it means that the shape is required to achieve that technical result, but that it does not follow that other shapes cannot also perform the same task.²⁵

LEGO disagreed and brought an appeal to the CFI arguing that the Grand Board misinterpreted the scope of Article 7(1)(e)(ii) CTMR. In particular, it argued that the scope of the terms ‘exclusively’ and ‘necessary’ were wrongly interpreted by considering that the existence of functionally equivalent alternative shapes using the same technical solution is irrelevant for the purposes of the application of that provision.²⁶ Thus, according to LEGO, the only shapes which should be barred would be ones that create a monopoly on a technical solution. The CFI disagreed however and confirmed the Board’s finding. It held that the word ‘exclusively’ must be read in the light of the expression “essential characteristics which perform a technical function.”²⁷

Elaborating on the point, the CFI explained that it is apparent from that expression that the addition of non-essential characteristics having no technical function does not prevent a shape from being caught by that absolute grounds for refusal if all the essential characteristics of that shape perform such a function.²⁸ Subsequently, the CFI moved on to the word ‘necessary’ where it held that it did not mean that it applies only if the shape at issue is the only one which could achieve the intended result. Furthermore, the existence of other shapes which could achieve the same technical result cannot overcome the grounds

²² *Lego Juris A/S, op. cit.*, para 34.

²³ *ibid.*, para. 36.

²⁴ *ibid.*, para. 58.

²⁵ *ibid.*, para. 60.

²⁶ *ibid.*, para. 37.

²⁷ The Court was referring to *Philips, op. cit.*, paras. 79, 80 and 83 respectively.

²⁸ *Lego Juris A/S v OHIM, op. cit.*, para. 38.

for refusal.²⁹ Continuing, the court explained that registration of a sign consisting of the shape in question is precluded, even if that technical result can be achieved by other shapes.³⁰ That said, in order for the ban to apply, it is sufficient that the essential characteristics of the shape combine the characteristics which are technically causal of, and sufficient to obtain, the intended technical result. Then, it is clear that the EU considers functionality to be only a technical function. However the EU only applies this theory to shapes. The main concern is: can a chemical sense mark have a technical function? Throughout the studies of the two main cases, Phillips and Lego, the objection brought by this Article excludes shapes which are motivated by and are the result of technical considerations. Furthermore, if the essential features of the shape are attributable to the technical result, it is unregistrable.

If we bring these principles and thoughts to chemical sense marks, one can affirm that there are certain smells/tastes that are essential features which purpose is to have a function. The mark in question has no other purpose but to achieve a result, for example: a household cleaner and a medicine that taste like orange. In the case of the cleaning product the added smell symbolizes freshness, but would a smell make the product to clean better? In the latter example, the added flavour might make the medicine to be more pleasant, but would it make the tablet to be swallowed easily? Strictly speaking in both cases and questions, the answers will be in the negative. The function appears to be no mechanical, but should it be? What is mechanical? When the courts refer to 'technical function' shall we be looking at a mechanical function?

To understand this point it is helpful to examine the US jurisdiction which appears to be more mature in this issue: the functionality doctrine. For instance, as mentioned, in the US the functionality doctrine is separated into two: utilitarian functionality and aesthetic functionality. On one hand, the utilitarian functionality would exclude those marks that contain elements of mechanical construction that are necessary to a product's use or manufacture.³¹ In this case, the burden is to prove that the said feature is essential to the

²⁹ *Lego Juris A/S v OHIM*, *op. cit.*, para. 81.

³⁰ *ibid.*, para. 83.

³¹ N Clarke, 'Issues in the Federal Registration of Flavors as Trademarks for Pharmaceutical Products' (1995) *University of Illinois Law Review* 105, 110.

product. On the other hand, there is the aesthetic functionality where the sign is the one that determines the buyer's choice.³²

These two doctrines of functionality cover not only shapes but also colours, and moreover it appears to be extending to chemical senses. Regarding colours for example, the TTAB rejected the registration of a brownish-pink coloured line on a contact lens due to the colour allegedly reducing the light reflection and refraction—utilitarian function, a technical one.³³ Also, in an infringement case the court refused to protect the blue coloured dot on the plaintiff's flash bulb, for the reason that the colour served to indicate which bulbs had suffered air leakage and were unsuitable for use.³⁴ In the pharmaceutical area, courts have found coloured capsules functional on the basis of their psychological and identification utility.³⁵

It is possible to apply the functionality doctrine to smell and taste, especially if the product feature serves a primarily utilitarian purpose *e.g.* potpourri, car freshener, and perfumes. However, if the product feature is only incidental and not essential, then utilitarian function cannot be shown and thus it will be potentially registrable *e.g.* stationary, automobiles, and some services. Nonetheless, where the product feature is not seen as primarily utilitarian it still can be regarded as having a utilitarian function. An illustration can be noted in *Norwich*, where the court considered *in dictum* the possible functionality of the colour pink in PEPTO-BISMOL, a medicine use for upset stomachs. The issue discussed was that the colour may have a psychosomatic and therapeutic effect valued by the consumer.³⁶ Another case brought appeared to have protected the cherry smell, taste and colour of vitamin liquids.³⁷ Bear in mind that both cases have been brought under Unfair Competition laws and not Trade Mark law and thus it would be a matter of speculation how the functionality doctrine would apply if registration is sought.

As mentioned, smell and taste might mask an odour or bad taste and therefore may be performing a function. This theory applies in pharmaceutical cases where palatable

³² N Clarke, 'Issues in the Federal Registration of Flavors as Trademarks for Pharmaceutical Products' (1995) *University of Illinois Law Review*, p. 122.

³³ *re David Crystal Inc* 296 F 2d 771, 132 USPQ 213 (TTAB 1961).

³⁴ *Sylvania Electric Products Inc v Dura Electric Lamp Co* 274 F 2d 730, 114 USPQ 434 (CA 3 1957).

³⁵ *Ives Lab Inc v Darby Drug Co* 601 F2nd 631 (2nd Cir 1979).

³⁶ *Norwich Pharmacal Company v Sterling Drug Inc* 167 F Supp.

³⁷ *Smith, Kline & French Laboratories v Broder* 125 USPQ (BNA) 299.

solutions are preferred.³⁸ Moreover, studies reveal that the use of fragrances can provide physiological and psychological effects and thus, it can be perceived as a therapeutic agent, a function which may be barred from registration.³⁹ Constance Classen explains in her book that aromatherapy and fragrances ‘are no longer aesthetic, they are functional’.⁴⁰ This theory can be seen in the following examples. The Chicago firm Inscentivation Inc, made a formula for smell that induced casino gamblers to increase their betting on slot machines; the HOTEL HILTON in Las Vegas used the smell called ‘Odorant 1’, in a slot machine pit which saw 45% more action than usual.⁴¹ Another illustration can be seen in the BODYWISE odorant which makes debt collection more efficient.⁴² Hence it appears that effects such as: psychology, therapeutic, physiologic and the like are counted as ‘technical’.

When officers, examiners and judges consider technical functionality, they have also considered other issues which appear to surround the doctrine of functionality *per se*. Now we turn to examine what is, or could be covered under the word ‘technical’, *i.e.* ornamental and economic function.

Ornamental

The aesthetic functionality is well developed in the US. In Australia also, the adoption of such doctrine can be seen. Nonetheless, in the EU the issue is not quite clear. One of the arguments brought in the *Phillips* case is the presumption that because a shape contains aesthetic embellishment then, it is not functional. Even though the *Phillips* case did not study this point directly as to whether technical function included ornamental function, the issue was mentioned.

The CFI, analysing the point of functionality said that trivial embellishments applied to a basically functional shape do not make the shape registrable,⁴³ *e.g.* a bone shape for a bar

³⁸ See *William R Warner v Eli Lilly & Co* 265 US 526 (1924). Clarke mentions that both doctrines, utilitarian and aesthetic functionality, merge in cases of medications. Clarke, *op. cit.*, p. 132.

³⁹ C Classen D Howes and A Synnot, *Aroma – The Cultural History of Smell* (Routledge, London and New York 1994) p. 196.

⁴⁰ C Classen, *op. cit.*, p. 197.

⁴¹ A Hirsch, ‘Effects of Ambient Odors on Slot-Machine Usage in a Las Vegas Casino’ (1995) 12 *Psychology of Marketing* 585.

⁴² Social Issues Research Centre, ‘The Smell Report - work’ <http://www.sirc.org/publik/smell_work.html> viewed on February 2009.

⁴³ *Phillips v Remington*, *op. cit.*

of soap to allow better handling when the soap is wet.⁴⁴ Certainly, there would be a better grip and due to the fact that the shape consists exclusively of a shape necessary to achieve that technical result, registration was not allowed. Then, aesthetic shapes if functional are considered under the objection. However, the case does not answer whether a shape containing only aesthetic or ornamental functions would be considered as a technical function.

The question seems to be answered by a national court. The Court of Appeal in Hertogenbosh (The Netherlands) held that a trade mark for a triangulated shape of chocolate shavings was improperly registered.⁴⁵ The decision was based upon the fact that the chocolate shavings were intended to be sprinkled on to edible food, enhancing the appearance of it. Indeed, the ornament was their function.

Note that in Design law ‘eye appeal’ is not considered as a function. Nonetheless, this will in fact be a transformation of the nature of Design law. Registered Design legislation protects only designs that do have ‘appearance’⁴⁶ but excludes utilitarian and functional designs. Would ornamentation be considered as a function? Clearly, in Design law the answer is negative but what about Trade Mark law? Is ornamentation considered a function? It cannot be confirmed or otherwise whether it is considered to come under the technical function issue in the EU. Nonetheless, it can be speculated that if the answer is in the affirmative, then it may be applicable to any other type of marks (not just shapes). If so, chemical senses, because of their nature, will be seen as aesthetic embellishments and thus accomplishing an important function -- not capable of being registered. Indeed, if we transfer the theory that shapes decorate by pleasing the ‘eye’, in the case of non-visual signs, they might be decorative by pleasing the ‘smell’ and/or ‘taste’. Moreover, they may achieve a physical function which is to mask an unpleasant odour or taste. That said, I strongly believe that there is no reason to limit the functionality doctrine to shapes only.

Nonetheless, the problem resides in the fact there is not a statement of what technical function covers. For example, in Design law technical function does not include function

⁴⁴ *Procter & Gamble Co's Application* R74/1998-3.

⁴⁵ *Luijckx BV v ECC* [2000] ETMR 530.

⁴⁶ ‘Eye appeal’ is not longer in use (RDA 1949, s 1(2)).

alone.⁴⁷ This could be the reason why in *Lego*, the applicant asked for a delineation of the term technical function used in Patent law as compared to Trade Mark law but as said, there is not a clear understanding of whether the technical function includes ornamental function or not. If so and applicable to other types of marks, chemical sense marks have found another burden.

While it appears that ornamental functionality may be considered as a technical function there is another matter that may also be considered under this doctrine, that is: economic efficiency. That say we now turn to examine this.

Efficiency Gains in Manufacture

A shape which makes its manufacture more economical is regarded as functional in the US. The utilitarian (as it is usually referred to in the US) function suggests that if several shapes work equally well as far as the use of the product is concerned but one is significantly cheaper to produce, the shape will be barred from registration under the doctrine of functionality.⁴⁸ In the EU however, there is not such a belief. The functionality doctrine is not evaluated or measured in monetary terms. Yet, it restricts from registration those shapes that add value to the goods; however, observe that it does not refer to economical issues. Note however that this bar from registration is separated from that of ‘technical function’ which will be examined later on.

To proceed with a further examination of the ‘technical’ term it is crucial to identify the characteristics of the mark correctly. In order to do so, there is the need to consider if consumers are taken into consideration (the same as when studying distinctiveness) and secondly, if a mark has characteristic which are invisible, how can this features be identified.

Starting with consumers, when the examiner and or/judge examines the functionality of the essential characteristics of a shape, the perception of the target consumer is not relevant.⁴⁹ In *Lego*, the CFI explained that “...the target consumer may not have the technical

⁴⁷ It also includes ‘must-fit’ function.

⁴⁸ A A Horton, ‘Designs, Shapes and Colours: a comparison of trade mark law in the UK and the US’ [1989] *EIPR* 311, 314.

⁴⁹ *Lego Juris A/S v OHIM*, *op. cit.*, para. 70.

knowledge necessary to assess the essential characteristics of a shape and therefore certain characteristics may be essential from his point of view even though they are not essential in the context of an analysis of functionality and vice versa.”⁵⁰ The Court went on to determine that the essential characteristics of a shape must be studied objectively and to do so, the study must be carried out on the basis of its graphic representation and any descriptions filed at the time of the application for the trade mark.⁵¹ Explaining this matter further, the AG notes that “essential characteristic must be understood as referring to the most important element of the sign”.⁵² If we bring these ideas to chemical sense marks it implies that what needs to be studied is the said smell/taste as such and the essential characteristic of it. This therefore involves scrutinising the graphical representation. Whilst I support the view that the functionality doctrine can be applied to chemical sense marks, I can see that this matter can bring difficulties. For instance, what are the essential characteristic of an e-nose report? To analyse this, it is necessary to have certain knowledge and background in areas such as: chemistry, biology and psychology for example. This is so, because this is only way to understand the essential characteristic and therefore certain features of chemical sense marks which might produce a function.

To make the matter of essential characteristic more complicated but yet more relevant to chemical sense marks, there is the situation of identifying characteristic that are not visible – the invisible features. In *Lego*, the applicant argued, among other things, that the Board of Appeal failed to identify the essential characteristics of the shape concerned. They argued that it did not examine the shape, but the LEGO brick as a whole instead. Hence, it appears that the Board included in its analysis invisible features such as the hollow underside the brick and the secondary projections.⁵³ The CFI, clarifying the point explained that “only the shape as reproduced [...] above must be the subject-matter of the examination of the application for registration [...] Since the function of the graphic representation is to define the mark, it must be self-contained, in order to determine with clarity and precision the precise subject of the protection afforded by the registered mark to its proprietor [...] In the present case [...] it is on the basis of that representation alone that the essential characteristics must be identified.”⁵⁴ Thus, even though the Board did identify

⁵⁰ *Lego, op. cit.*

⁵¹ *ibid.*

⁵² *Lego, op. cit.*, AG opinion at 63.

⁵³ *Lego, op. cit.*, para. 72.

⁵⁴ *ibid.*, para. 73.

LEGO's invisible hollow underside and secondary projections as essential characteristics,⁵⁵ the analysis included all the visible elements of the graphic representation. Therefore, there was no need to query the accuracy of the identification of those characteristics as essential characteristics of the shape at issue.⁵⁶

The Court quoted that there was nothing wrong with, when considering whether the *visible essential* characteristics were functional, taking into account invisible features. Clearly, the fact that invisible features were presented in the sign, did not make the shape in its entirety, less functional. Moreover, the Court clarified that the reliance on invisible features is relevant to determining the functionality of the essential characteristics but not the characteristics themselves. Meaning that the examiner and/or judge need to identify the essential features by considering those that are visible. However, when considering whether the shape is functional all features must be taken into account.

Understandably, the question of essential features is one of fact and degree for the examiner and/or judge. The identification of essential characteristics of a particular shape is important due to the fact that if they are attributable only to the technical result, then, the shape mark would not be registrable.⁵⁷

The approach taken by Rimer J going back to the ECJ judgement in the *Philips* case followed two steps. They are: first, to identify the 'essential characteristics or features' of the shape of the goods at issue; and second, to determine whether the essential features consisting 'solely' of the shape of the goods are attributable only to the technical result. It appears that one follows the other. The following question is brought to mind: what would happen if some of the features are not essential (or as in *Lego*, invisible)? Rimer J in *Philips* considered that the clover leaf was not an essential feature of the shape of the goods due to lack of eye impact.⁵⁸ Still, when examining the second step, that of functionality, the court established that what was needed was to look at the faceplate as a whole and thus, whether it achieved a technical result. Indeed, it can be seen that the same theory was followed by the *Lego* case. There is no need to study each feature of the shape

⁵⁵ *Lego, op. cit.*, para. 74.

⁵⁶ *ibid.*, para. 75.

⁵⁷ *Philips v Remington, op. cit.*

⁵⁸ Clark, *op. cit.*, p. 353.

separately (slicing the product) but to consider the shape as a whole and whether the shape mark is functional or not.

It is noticeable that this theory can be applicable to non-visual marks. Thus, it can be presumed that the analysis brought by the BoA in *Lego* might be applicable to non-visual marks. Smell and taste functionality cannot be perceived by sight and thus by the Board examining both visible and non-visible features, makes the theory applicable to these. Observe that the CFI disagrees with this view though but there is a clear understanding that the examination must be objective and thus there is the need to examine just the graphical representation issue.

This is indeed a valid argument when examining a visible sign and specifically shapes, since what is evaluated is a tangible product. Hence, to 'see' and 'look' for the essential features does not seem to be a difficult task. In the case of a sign that is not visible the product cannot be evaluated because the product is not the sign. What needs to be evaluated is the sign but how do you do this? How do you look for the essential features of it? The essential feature of a smell and/or taste is basically components, natural or chemical. Unquestionably, examiners and/or judges cannot be expected to examine this and thus, it is difficult if not impossible to apply the doctrine of functionality as it stands to non-visual signs. The reason being that, as explained, an examiner/judge needs to have some understanding in this topic: chemical science.

Examining this theory further, if this theory applies to chemical sense marks that have been previously registered, the examination of essential features must be, according to what has been mentioned, directed towards the description of the mark (graphical representation allowed before *Siekmann*) e.g. 'the scent of freshly cut grass'.⁵⁹ This theory I believe, is not appropriate because there is not possibility to examine from the wording what is the essential feature of the sign.

Following the law, as it stands today, smell and taste cannot be graphically represented. In any case however, even if they were, examining the essential features would be more of a puzzle since all features in non-visual signs are unseen. One can say that it is not important

⁵⁹ *Vennootschap onder Firma Senta Aromatic Marketing Trade Mark* CTM No 000428870.

though, because when examining the functionality issue, as mentioned in the cases of *Philips* and *Lego*, the whole sign must be examined.

Article 7(1)(e)(ii) CTMR provides that “signs which consist exclusively of ... the shape of goods which is necessary to obtain a technical result ... shall not be registered”. As discussed before, this is the only Article in Trade Mark law that bans the protection of products which have a function: the doctrine of functionality. Therefore, if one rearranges the article as ‘signs which consist exclusively of ... the smell/taste of goods which is necessary to obtain a technical result ... shall not be registered’, the fact that the essential characteristics (features) are invisible are of no importance. This is established by case law in reference to shape marks: tangible and visible; however one cannot make the same presumption if an examiner/judge if in presence of a mark that all characteristics and essential features are invisible.

To study the potential of non-visual marks as registrable marks there is the need to be open minded. The Board rightly studied these features, because examining a sign, as learned, requires that it is studied as a whole. In the case of *Lego*, the invisible features as well as the visible ones do play an important role in the whole functionality doctrine. For example, if the hollow underside of the brick did not exist, the bricks could not be used for construction and therefore there will be no functionality. I believe that the view taken by the Board is anticipating the future. If we follow this belief, then when smell and taste are registered, their function can be examined against the doctrine of functionality without barriers about their visibility.

To sum up this subsection, when examiners and/or judges are identifying the essential characteristics of the product, they must do so objectively by relying on the graphical representation. Therefore, consumers and invisible features are regarded as being of no importance.

As any intellectual property researcher there is always the tendency to seek other intellectual property rights. While they are different, they contain also similarities in certain matters, as well as being sometimes very much related. Because of this issue, I bring in the next section a study of the technical function in other areas of intellectual

property law to seek further analysis of the question what is meant by technical, and moreover, to examine how this doctrine can be applicable to chemical sense marks.

5.2.1 Trade Mark Technical Function as Opposed to Design Law Technical Function and Patent Law Technical Solution

Design Law

As mentioned earlier, the doctrine of functionality was first used in Trade Mark law by taking an earlier case brought by Design law. In previous years, trade mark legislation did not mention the doctrine of functionality at all. The reason for this being that shapes were not registered (although protected by intellectual property rights), and thus were not regulated by Trade Mark law. Furthermore, once the figure of shapes, and not only 2D but 3D shapes was accepted, the issue of its functionality was of concern. Up to that time, registration of shapes as designs was possible.

Nonetheless, manufacturers were looking forward, registering shapes as trade marks. There were benefits to this, one of which is that a registered trade mark protection compared to registered design protection does not have a finite term (so long as renewal fees are paid). While examining the subject of technical functionality in Trade Mark law, certain matters are brought to mind due to the term ‘technical function’ not being clear. As explained, there is not an obvious presumption of what should be included or excluded from it.

Even so, there are two issues that have been well developed and what is more, do separate the concept of technical function used in Trade Mark law from that of Design law. Firstly, in Trade Mark law when the shape sought to be registered, which achieves a technical function, has alternative shapes that achieved the same technical result, this is of no importance. The fact that there are others in the market that achieved such a goal does not exclude it from the objection. On the contrary, in Design law the issue of whether the product is the only possible design with which the product will be able to perform its function is of crucial importance. It is stipulated as such in the RDA when the grounds for exclusion only applies to features of appearance ‘solely’ dictated by the technical function;⁶⁰ if there is at least one alternative the exclusion will not apply. Secondly, the

⁶⁰ *Ampel 24 Vertriebs-GmbH & Co KG v Daka Research Inc* Case R 196/2006-3.

must-fit function is excluded by Design law; however, it is not applicable to Trade Mark law.

Patent Law

In *Lego*, the CFI was asked to draw a comparison between Trade Mark law and Patent law, regarding the issue of technical solution. Cautiously, the CFI declined to take up this thrilling jurisprudential challenge.⁶¹ Is it worth making the comparison? Clearly both laws cover the issue of technical solution; however whether the term was borrowed by Trade Mark law from Patent law so as to apply it in the same way remains to be seen. Will its application accomplish any clarification of the way technical function must be interpreted in Trade Mark law? By analogy, it might help to clarify the concept. At first, it is noted that in Patent law the technical solution forms part of the requirement for being registered, that of being inventive, while in Trade Mark law the technical function is an exclusion from registration. Yet, this does not answer the matter.

Therefore, examining further the technical issue, in Patent law if the invention is a method (although not a mathematical one) it is required that the claimed subject matter has a 'technical character'.⁶² Nonetheless, there is no definition of this. Yet, when the legislation refers to 'technical effect' it appears that, according to case law, the term refers to industrial application. Bainbridge mentions that the expression denotes the fact that when one uses or works the invention it produces some tangible and physical consequences⁶³ -- the effect of the invention is a technical one. Bear in mind that the majority of inventions in Patent law operate accordingly with basic principles of physics, chemistry and/or other sciences and because of this, I incline to believe that in this case Patent law is more closely connected to chemical sense marks.

Furthermore, if we speculate and transfer these thoughts to Trade Mark law when a sign is used and as a result produces or achieves a function which is tangible and physical, we will observe a 'technical function'.

⁶¹ *Lego Juris A/S, op. cit.*, paras. 40-43.

⁶² Art 52 of the European Patent Convention.

⁶³ See further D Bainbridge, *Intellectual Property* (7th edn Pearson Higher Education, Harlow 2009) p. 426.

To conclude, it could be argued that technical effect and technical function achieve a purpose. Then, if that purpose produces some tangible and physical consequences we will have a technical result. However, it is a technical effect for patent and technical function for trade mark. The term of technical is needed in both, patent and trade mark. In Patent law, the technical issue is needed for registration purposes, and in Trade Mark law, the technical issue will on the contrary, bar the registration.

Finally, we need to bear in mind that a shape (or a chemical sense mark) which is necessary to obtain a technical result is also likely to indicate the intended purpose of the goods, or it may be customary in the trade and therefore, non-distinctive. Thus, the grounds under Art 7(1)(b) (sign/shape is devoid of distinctive character), Art 7(1)(c) (sign/shape exclusively designates the intended purpose or a characteristic of the goods) and, Art 7(1)(d) (sign/shape that is customary in the *bona fide* and established practices of the relevant trade) would also apply.

There is no doubt that when examiners/judges scrutinize shapes, they are inclined to study further the technical result topic. However, it does not mean that it is the only bar from registration and there is also the need to look others. We therefore now turn to study the final bar from registration when shapes are at issue.

5.3 Shape Which Gives Substantial Value to the Goods

As mentioned at the start of this Chapter, this bar from registration applies only to shapes but I will examine throughout the next pages that this principle can be also applicable to other types of marks, and more specifically to chemical sense marks. Article 7(1)(e)(iii), “the shape which gives substantial value to the goods”, is limited to shapes which exclusively perform an aesthetic function and in particular has nothing to do with the commercial value of the goods. Hence, the ban excludes aesthetic-type shapes from registration.⁶⁴ It refers to shapes which appeal to the eye compared to the common shape of a product *i.e.* shapes which are purchased primarily because of the eye appeal, for example, novelty soaps, ornaments, figurines, box of chocolates, etc.

⁶⁴ *Philips v Remington, op. cit.*

A key point that appears to be clear is that the term ‘substantial value’ does not refer to monetary terms. Firth claims that if this were the case, then the objection would be made only towards high-priced goods and therefore the bar would be stricter for luxury goods than for ordinary ones.⁶⁵ Neither the legislation nor the case law elucidate in this matter. In Hong Kong for example, a jurisdiction which contains similar trade mark legislation to the EU, when there is any value attributable to the shape as an indicator of source, the sign is to be ignored. While examining the sign, the examiner should ask himself what compels customers to select the particular shape over other competing shapes, leaving aside any value attributable to better materials used or to any technical or functional feature. In order to do so, the examiner will observe firstly, whether the mark comprises anything but shape, irrespective of whether the shape also conveys indications of origin; secondly, the shape must have eye appeal, or one or more of the other qualities of desirability or worth judged subjectively through the eyes of actual or potential customers, or to the applicant through more sales or more profitable sales; and thirdly, by examining the shape as a shape which adds substantial value to the goods; this requires the shape sought to be registered, to be actually compared to the shapes of equivalent articles.⁶⁶

In the EU the case *G-Star v Benetton*,⁶⁷ even though related to trade mark infringement, tries to resolve the issue of ‘substantial value to the goods’. G-STAR, the owner of a Dutch trade mark consisting of the shape and stitching of jeans, brought an infringement action against BENETTON after they produced similar jeans to G-STAR. BENETTON counterclaimed for invalidity of the trade mark arguing that the shape at issue gave substantial value to the goods. G-STAR on the contrary claimed that the shape had acquired distinctiveness through an advertising campaign which pre-dated its registration.

The *Hoge Raad der Nederlanden* (High Council of the Netherlands which is the Supreme Court of the Netherlands) referred the following question to the ECJ: firstly, whether Art 3(1)(e) of the Directive (Art 7(e)(iii) CTMR) must be interpreted as meaning that the prohibition contained within, permanently precludes the registration of a shape as a trade mark where the nature of the product is such that its appearance and shaping determine its

⁶⁵ A Firth, ‘Shapes as Trade Marks: Public Policy, Functional Considerations and Consumer Perception’ [2001] *EIPR* 85, 93.

⁶⁶ Any other value such as use of better quality materials should be disregarded. See *Movado* (Hong Kong Trade Marks Registry, 31 December 2002).

⁶⁷ *G-Star International BV v Benetton Group SpA* C-371/06.

market value entirely or substantially as a result of its beauty or original character, or does the prohibition apply where prior to the application for registration, the attractiveness of the relevant shape to the public has been determined predominantly by the recognition of it as a distinctive sign? And if the latter, to what extent must this attractiveness have prevailed for the prohibition no longer to apply? The ECJ, answering the question, corroborated what has been previously established: under no circumstances could a mark barred under Article 3(1)(e) of the Directive be registered by virtue of Article 3(3) of the Directive.⁶⁸ Therefore, acquired distinctiveness through use is not relevant.

The ECJ did not directly deal with the issue of substantial value to the goods since there was no clarification of what is meant by the term. Whether the question was directly addressed by the *Hoge Raad* is of debate. Still, there are many queries surrounding the topic, for example the first question raised by the *Hoge Raad*: does appearance relate to attractiveness because of its beauty or because of its originality or because it is the latest fashion as imposed through advertising?

Unquestionably, the matter of substantial value to the goods relates to the appearance. That said, one may wonder whether this objection fits into that of functionality. In the previous section, we examined the possibility of ornamental functionality being part of technical functionality. Clearly, the line is too fine to distinguish between them. In other jurisdictions' case law, the functionality doctrine has two branches: utilitarian and aesthetic; thus, I believe that the EU legislation tried to cover both by introducing utilitarian functionality as technical functionality, and aesthetical function as substantial value to the goods.

Illustration of aesthetic functionality can be seen in Australia and the US. Nonetheless, whilst it is argued that the aesthetic functionality theory is well developed in US, the USPTO has not adopted this concept. Moreover, there are courts that interpret functionality as only utilitarian.⁶⁹ Yet, there are other courts that have extended the doctrine of aesthetic functionality to cover even colours. In *Brunswick Corp v British Seagull*,⁷⁰ MERCURY, a

⁶⁸ *Philips v Remington, op. cit.* In 1983, the TTBA (US) noted that evidence of secondary meaning cannot transform a utilitarian shape into a registrable trade mark.

⁶⁹ J McCarthy, *McCarthy on Trademarks Law and Unfair Competition* (4th edn Thompson West, United States 2008).

⁷⁰ *Brunswick Corp v British Seagull*, 28 USPQ2d 1197 (TTAB 1993).

manufacturer of black outboard marine engines, filed a trade mark application for the colour black applied to the outboard motor of boats. The court held that the colour was functional, since firstly, the motor appears to be of smaller size and secondly, the black colour was attuned to the other colours of the boat -- aesthetic function.

In Australia the shape of GUYLIAN sea-shell chocolates were denied registration. One of the judges claimed that the sign sought to be registered was “understood by the public to be no more than to provide an aesthetically pleasing shape that will attract buyers”. Moreover, it added that the shape was perceived as ‘value adding’ or ‘market appealing’. That said, there has been some negative response in the Australian courts as regards the ‘aesthetic functionality’ when it applies to non-functional shapes.⁷¹ There is not an exception for registering shapes or signs that add value to the goods but this exclusion appears to be included as a functionality doctrine although not technical but aesthetic.

In the case of chemical sense marks the issue of substantial value to the goods can be seen as a direct bar from registration due to its nature. Moreover, I believe that they may be even considered as serving a utilitarian function as well as an aesthetic function. On one hand, we can observe that a smell can block an odour or a taste can disguise a flavour and thus serve a technical function. On the other hand, there is no question as to whether the function of such signs would be to appeal to the market in general. Therefore, the doctrine of functionality will prove to be the ultimate obstacle to trade mark protection of smell and taste signs.

While I try to extend the functionality doctrine to chemical sense marks by way of hypothesis and examples, I believe that this point can be clearer when studying the reason behind this public policy. This section which follows is the last point under this Chapter.

5.4 The Rationale behind the Doctrine of Functionality

The functionality doctrine is a public policy that can be seen in any intellectual property right. Moreover, it is indeed a principle that is widely used in Unfair Competition laws throughout not only the EU, but in many other countries. As understood, if a trade mark is

⁷¹ See J McCutcheon, ‘The Registration of Sounds and Scents as Trade Marks under Australian Law’ (2004) 2 *Intellectual Property Quarterly* 138.

granted, a perpetual monopoly (if renewal is made) would be given. Therefore, as mentioned in a previous chapter, the public policy is based on the fact that there are certain signs which are best left in the public domain in order to permit the free use of it by other competitors.

Developments in European case law have made it clear that obtaining trade mark protection for shapes is not to be seen as a way round the limited term of protection under Design law and Patent law. The focus has been on the fact that registration of certain shapes as marks would create a perpetual monopoly in that particular shape where other forms of intellectual property rights, such as registered designs or patents, grant a shorter duration of protection.

In *Philips*, the Court explains that when assessing a shape mark, each grounds for refusal must be interpreted in the light of the public interest underlying it.⁷² Moreover, the Court went on to elucidate that there is the need to “prevent the protection conferred by the trade mark from [forming] an obstacle preventing competitors from freely offering for sale products incorporating such ... functional characteristics in competition with the proprietor of the trade mark”.⁷³ Likewise, the Court assured that the Directive “pursues an aim which is in the public interest, namely that a shape whose essential characteristics perform a technical function ... may be freely used by all”.⁷⁴ In *Lego*, the Court explains that the aim does not relate exclusively to the technical solution incorporated in such a shape, but to the shape and its essential characteristics themselves.⁷⁵ Hence, by the public policy, what is protected is not the function but the shape as such so that it may be used by anyone.

Certainly, the main goal of the functionality doctrine is to prevent producers monopolising useful product features under the guise of Trade Mark law. In some jurisdictions however, there is more resistance than others, even between European countries. For example, the LEGO brick has been protected in Germany, Denmark and Italy but has been refused as a CTM and individually in the US, UK, Sweden, France and also Canada.

⁷² *Philips v Remington*, *op. cit.*, para. 77.

⁷³ *ibid.*, para. 78.

⁷⁴ *ibid.*, para. 80.

⁷⁵ *Lego Juris A/S*, *op. cit.*

There is no reason why the theory should be applicable only to shapes. I believe that the extension is not just anticipating the future but a reasonable one. Nonetheless, the actual situation is that the law is clear: the bar is for shapes. Still, the proposition to extend the law will not do any harm; as a matter of fact the doctrine of functionality is as said a doctrine that can be applicable under public policy to any unfair competition issue: to keep certain marks free for all to use. Moreover, in the case of chemical sense marks there are certain traders and products where competitors should freely use some signs, e.g. strawberry smell to shampoos, orange flavour to children tablets, and mint flavour to chewing gum

At last, the doctrine of functionality is a logical principle of Trade Mark law. That said, there is no reason to limit the application of it to shapes. Functional features are not explicitly implemented by this type of mark and thus, the rationale of the doctrine can be applicable to any other type of sign. The scheme is to preclude the registration of trade marks that are crucial to ensuring a function and thus should not be directed only to shapes. The reason behind the policy and its relevance to Trade Mark law is to protect shapes. However, why only to shapes? Throughout the pages of the present Chapter the matter of functionality has been scrutinised, and has brought the attention that chemical sense marks might in some circumstances have a ‘technical’, ‘ornamental’ function and what is more, they can add value to the product. This brings us to the conclusion that the public policy should be applicable to all type of marks because the rationale is to protect (any) signs from producers that may or even wish to monopolise useful features.

PART C: THE SCOPE OF PROTECTION AFFORDED TO CHEMICAL SENSES

The first two parts of this thesis examine trade marks and their registratability. These set the path to focus on whether chemical sense marks can be registered as the legislation stands to date. In general, we have seen how these types of unconventional marks are challenging the law. The last part of the thesis will explore enforcement and where chemical sense marks stand. The first chapter will start by studying infringement actions and the difficult issue of deceptiveness, likelihood of confusion and trade mark use among others. By discussing the complications that appear when assessing these matters in the case of chemical senses, it will seem that they are unlikely to be protected. The following and final chapter will focus on the protection of chemical senses as marketing tools. In order to do so, I will study chemical senses for what they are, and whether they could function as signs or just as marketing tools. In the same vein, I will bring earlier chapters into discussion and consider particular features of chemical senses. Overall, this part of the thesis will endeavour to study chemical senses as products and signs and therefore, the question of protection will be examined.

CHAPTER VI

ADDRESSING THE QUESTION OF INFRINGEMENT

As a result of the immense growth in competition and businesses, the introduction of new types of trade marks has arrived without surprise. While manufacturers have seen this as a development, it has been noted how legislation and even consumers have not been prepared for the change.

From previous chapters it is noted that the process of registration is far from simple. For that reason the concerns of exploiting and enforcing trade mark rights are brought to mind. The rationale being that efficient protection encourages investment.

Overall, as mentioned in Chapter I, manufacturers look for recognition and protection of their goods/services. The function of trade mark law is to protect these and as a consequence, consumers.¹ Indeed, trade mark owners enjoy exclusive rights and thus, the law will prevent certain unauthorised uses of a mark by third parties.

Moreover, as mentioned in Chapter II, trade marks may enjoy an exclusive right granted by registration. Trade marks constitute a property right, as any other form of intellectual property does. Proprietors have the exclusive right to certain forms of use of the mark but only in the territory where the mark was registered. In the case of a CTM, it would have rights in the Community as a whole. Hence, the Directive and the CTMR respectively, entitle the proprietors of registered trade marks to a certain monopoly -- the commercial use and exploitation of their sign in the goods/services for which they were registered.²

Having said that, trade marks can be infringed by certain forms of unauthorised use. As a result owners are entitled to prevent all third parties not having his consent from 'using in the course of trade' his mark.³ Nevertheless, note that there are justifications for a third party to make unauthorised commercial use of the proprietors' mark when the former's use is in accordance with honest practices in industrial and commercial matters.⁴

Also, it is important to mention that many authors believe that there is a certain similarity between relative grounds for refusal and infringement due to the relationship of the trade mark subject (the sign for which registration is sought and/or the mark that is potentially infringing) with an earlier trade mark. Thus, when approaching infringement the relative grounds for refusal to registration comes to mind.⁵

Finally, the protection of smell and taste as trade marks has not yet been tested. Undoubtedly, difficulties assessing infringement are expected. Specifically, one can speculate on the way confusion might be assessed between two sensory marks or between a non-visual mark and a visual one. Such reasoning can be one of a kind; yet, legislation is

¹ For more information refer to section 1.2 Variety of Functions.

² For more information refer to Chapter II.

³ Art 9 CTMR.

⁴ Yap P, 'Honestly, neither Celine nor Gillette is Defensible!' [2008] *EIPR* 286.

⁵ While this subsection refers to infringement, opposition cases will be considered when necessary.

established and it is expected that when resolving a question of infringement the issue can be dealt with using the same reasoning presently applied to other types of marks.

This chapter therefore, will examine the protection of chemical senses under Trade Mark law. Thus, putting aside whether smell and taste may function as trade marks and whether they should be or should not be entitled to registration, this chapter will study the question of infringement and how (chemical senses) marks are assessed.

Certainly, the subject of infringement raises matters discussed exhaustively by authors, lawyers and judges, to name a few. However, there are certain matters that are still not settled. That said, the chapter will examine those Articles that condemn infringement; each issue will be discussed in turn, and matters such as likelihood of confusion, likelihood of association and the use requirement will be debated.

That said, infringements of a registered trade mark are covered by Art 9(1)(a) and ((b) CTMR (Art 5 (1)(a) and (b) of the Directive). However, Art 9(1)(c) CTMR (Art 5 (2) of the Directive) provides the scope for the protection of trade marks with a reputation. The law identifies therefore, three categories. Nonetheless, before going further with the complexity of what appears to be straightforward Articles, it would be appropriate to look at them literally and then, analyse them.

6.1 Article 9(1) CTMR

“The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

- (a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;
- (b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark”.

It appears that for infringement of a trade mark to occur, the third party needs to use the sign in the ‘course of trade’. We now examine this term.

6.1.1 Using in the Course of Trade -- the Use Requirement

There is not a 'trade mark use' term in any of the European legislation. Thus, the use requirement arises from the words 'using in the course of trade' which is employed in the Art 9(1) CTMR heading. Discrepancies exist with regard to whether the 'use requirement' applies to all or some of the subsections of Art 9(1) CTMR and even if it extends to Art 9(1)(c) CTMR. This idea is debatable due to the fact that both share this specification.⁶ To make things worse, as said, neither the Directive nor the Regulation further explains this matter.

The ECJ has been steadily building up jurisprudence that leads us to believe that the 'use' requirement means to be used in 'commercial exploitation'. Consequently, it is believed that the relevant consumer needs to perceive such use as 'trade mark use'. At present, it has been settled that for an alleged infringer, using a trade mark as an indicator of the trade origin of their own goods/services is needed for an action to succeed.⁷

The starting point which launched an examination of whether a defendant must take into account trade mark use of a mark in order to infringe a trade mark was the case of *Arsenal Football Club plc v Reed*.⁸ In this case, ARSENAL the famous football club sued Mr Reed under s 10(1) of the UK Trade Mark Act (Art 9(1) CTMR and Art 5(1) of the Directive) for selling memorabilia marked with the former's trade marks. Reed disputed the infringement arguing that the marks were used on his goods not as an indicator of trade origin but as a 'badge of loyalty' to the ARSENAL team. The High Court of England referred for a preliminary ruling to the ECJ asking *inter alia* whether a third party use of a registered mark which did not indicate trade origin was infringing. The ECJ responded that "the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him without any possibility of confusion, to distinguish the goods, or services from others which have another origin".⁹

⁶ A Griffiths, 'The Trade Mark Monopoly: an Analysis of the Core Zone of Absolute Protection under Art 5(1)(a)' [2007] *Intellectual Property Quarterly* 312, 333.

⁷ Yap P, 'Essential Function of a Trade Mark: from BMW to O2' [2009] *EIPR* 81.

⁸ *Arsenal Football Club plc v Matthew Reed* C-206/01.

⁹ *ibid.*, para. 48.

The ECJ established after “having regard to the representation of the word Arsenal on the goods at issue in the main proceedings and the other secondary marking on them, the use of that sign is such as to create the impression that there is a material link in the course of trade between the goods concerned and (the plaintiff)”.¹⁰ It seems therefore, that there is the need of a link in the minds of consumers that the product comes from the said registered mark for an infringement to be considered. This appears to be a straightforward answer based though, on the origin function.

The ECJ clarified that, for example, uses for purely descriptive purposes are allowed, thus referring to Art 6 of the Directive. However, Mr Reed appears to have used the trade mark as a pure ‘badge of allegiance’ rather than as an indicator of origin -- no use in trade mark sense. Therefore when the case returned to the national court (the High Court) it ruled in favour of Mr Reed. Arsenal appealed and the Court of Appeal ruled that Mr Reed’s use of the trade mark satisfied the use requirement. It said “the trade marks, when applied to the good, were purchased and worn as a badge of support, loyalty and affiliation to Arsenal, but that did not mean that the use by a third party would not be liable to jeopardise the functions of the trade marks, namely the ability to guarantee origin”.¹¹

Andrew Griffiths explains that due to the ambiguity of the ECJ’s judgement it become difficult when the Court of Appeal needed to rule the case.¹² While there is no doubt that the different formulations expressed by the ECJ were difficult to combine, it is important to bear in mind that the point to be settled and of interest in this part of the thesis, is whether there was or there was no use of trade mark. Moreover, much has been written about whether this decision came after the ECJ did overstep by deciding on the facts of the case rather than interpreting the law.

¹⁰ *Arsenal v Reed, op. cit.*, paras. 55-56.

¹¹ *ibid.*, para. 48. Nonetheless, observe that the plaintiff claimed infringement of Trade Mark law and passing off. Regarding the latter claim, the Court held that merchandising which is labelled as ‘not official’ will not be catalogued as ‘false claim’ and/or ‘false representation’; the defendant made clear that his goods were not official ARSENAL merchandise. Thus, an action of passing off did not succeed due to failure to establish one of the elements, that of misrepresentation.

¹² Griffiths, *op. cit.*, p. 344.

Yet to be discussed was the meaning of use. By analysing the case, there appears to be two principles. On one hand, the use must be in a trade mark sense;¹³ and on the other hand, the use that challenges the functionality of a trade mark.

With the first principle -- use must be in a trade mark sense, the ECJ tried to innovate such a term. In the *Anheuser-Busch Inc v Budejovický Budvar Národní Podnik* decision the ECJ stated: "... [U]nauthorised use by a third party of a company name, trade name or shop name which is identical to an earlier mark in connection with the marketing of goods which are identical to those in relation to which that mark was registered constitutes use which the proprietor of that mark is entitled to prevent in accordance with Article 5(1)(a) of the Directive, where the use is in relation to goods in such a way as to affect or be liable to affect the functions of the mark."¹⁴ The ECJ visibly asserts that the use requirement involves considering if the third party's use of the sign affects, or is liable to affect, the function of the trade mark.

The use-based approach appears to be focused on the 'link' between a mark and its consumers. However, the rule indicates that the third party needs to use the sign in the course of trade and says nothing about such a link. Nevertheless, there has always been the presumption that there must be a connection between the trade mark and the consumer. Such a belief appears even when analysing use as in the pure trade mark sense. Subsequently, there are reasons to believe that because of the formulation of the previous cases, trade mark use implies that once used, if it may affect the essential function of the mark, then the use requirement would be fulfilled. In other words, this condition involves any use of a trade mark by a third party in any way that jeopardises the function of the trade mark.

¹³ The principle 'use in a trade mark sense' was earlier applied in the UK under the 1938 Act. In the footballers' cards case (*Trebor Bassett Ltd v The Football Association* [1997] FSR 211) the plaintiff sold sweets in packets with picture cards of footballers wearing the England strip with the England logo, registered though by the FA. The plaintiff sought a declaratory injunction that there was no infringement. The judge held that "Trebor Bassett is not even arguably using the logo as such, in any real sense of the word 'uses', and it is certainly not...using it as a sign in respect of its cards". The same view was followed in the '*Wet Wet Wet*' case where the plaintiff registered the words Wet Wet Wet as trade mark for books, among other things. The defendant used those words on a book cover and this was not infringement since the book was about the band (defence s 11(2)). Moreover, the trade mark was not used in relation to 'goods within the registration, instead it was used to refer to the pop group'. This case appears in *Bravado Merchandising Services v Mainstream Publishing Ltd* [1996] FSR 205.

Much of the merchandising material has been published as a handout distributed to students as part of the course of Intellectual Property Law run by the author in the University of Buckingham in 2008.

¹⁴ *Anheuser-Busch Inc v Budejovický Budvar Národní Podnik* C-245/02.

Po-Jen Yap while examining the case, mentions that Art 5(1) of the Directive did not afford any protection to trade mark owners if a third party uses their mark in ways other than to indicate the trade origins of the infringer's goods concerned.¹⁵ While this view appears correct, I urge to add that today's trade mark function is not only based on origin function and thus Yap's view should be extended.

In the discussed case, focus appears to be on the function of the mark rather than the use of the mark. Contrary to this, the following case appears not to apply this theory. In *Adam Opel AG v Autec AG*,¹⁶ OPEL had a registration of its trade mark logo not only for cars but also for toys. AUTECH, was a manufacturer of scale model toy cars, one of which was an Opel Astra V8 Coupé on a scale of 1:24. The OPEL logo was affixed to the car's radiator grille, in the same way as on the original vehicle. OPEL, seeking to invoke its trade mark rights to the OPEL logo, went to court. The national court referred to the ECJ a number of questions; relevant to the use requirement was: "Does the use of a trade mark registered also for 'toys' constitute use as a trade mark for the purpose of Article 5(1)(a) of the Trade Mark Directive if the manufacturer of a toy model car copies a real car in a reduced scale, including the trade mark as applied to the real car, and markets it?" The ECJ considered the following: "... [T]he affixing by a third party of a sign identical to a trade mark registered for toys to scale models of vehicles cannot be prohibited under Article 5(1)(a) of the directive unless it affects or is liable to affect the functions of that trade mark..." According to this statement, the ECJ reiterated what it previously held in the *Arsenal* case, use is reflected in the functionality of the mark.

In the case however, the ECJ continues to say that: "If ... the referring court intended to emphasise that the relevant public does not perceive the sign identical to the Opel logo appearing on the scale models marketed by Autec as an indication that those products came from Adam Opel or an undertaking economically linked to it, it would have to conclude that the use at issue in the main proceedings does not affect the essential function of the Opel logo as a trade mark registered for toys." The ECJ appears to combine both principles and concludes that there is no infringement if the relevant public does not think that the toy

¹⁵ Yap P, 'Essential Function of a Trade Mark: from BMW to O2', *op.cit.*, p. 83.

¹⁶ *Adam Opel AG v Autec AG* C-48/05. On 14 January 2010, the German Federal Supreme Court (*Bundesgerichtshof*) denied an infringement of the claimant's logo.

cars originate from OPEL or an entity economically linked to it¹⁷ -- use in a trade mark sense. If there is not trade mark use then the functionality of the mark cannot be jeopardised. This also implies that infringement only exists if the consumer is confused. This latter case supports the criteria that the sign concerned must constitute trade mark use in a trade mark sense.

While analysing the use requirement as use in a trade mark sense, there is a certain connection between trade marks (Art 9(1) CTMR and Art 5(1) of the Directive) and passing off because key factors are related. Both appear to be based on how the market reacts to the defendants' activities. Having said that, misrepresentation and the need for the existence of a trading link between the defendant's product and the claimant's, appears to be needed. While there is a similarity however, Art 9(1)(a) CTMR and Art 5(1)(a) of the Directive do not require confusion and thus this principle would not apply.¹⁸

How Far Does the Use Requirement Go?

In the situation of *Arsenal* and *Opel*, even though there appears to be no link in the mind of the consumer, the studied link is based on the origin function. However, I believe that there is a link with the image of the trade mark. The consumers are purchasing the product because they would like to become part of what the trade mark represents. If the said scarf and model toy cars did not contain the affixed trade mark, consumers would not buy them (at least not in the same quantity). Certainly, from this point of view, the trade marks were not intended for purely descriptive purposes and/or to create the impression of a link with the owner of the mark, but were used with the 'image' of the trade mark in mind thus affecting one of the modern functions of trade mark.

Note that one problem which is reflected in the *Arsenal* and *Opel* cases, is the situation of the market, specifically merchandising. The point then is whether merchandising should be protected under Trade Mark law. As explained in Chapter II, merchandising is designed to appeal to consumers by associating the product with a determined character/object or as in the *Arsenal* case, with a particular football club. Thus, it is understandable that when a consumer buys any memorabilia based on a well-know club he will do so because it depicts the character and not because of the origin-quality trade mark function. The

¹⁷ *Adam Opel AG, op. cit.*

¹⁸ See the *Arsenal* case above.

difficulty is that this technique, long used, allows a company to take advantage of a name or image to promote and sell goods/services.¹⁹ Usually, the owner of the company does not commence trading operations using the trade mark on products other than its primary one. However, this is changing, and consumers have become familiar with the practice of licensing.

Certainly, in the two cases it is observed that the owners were protecting the trade mark not only because of its origin function, but were trying to protect the trade mark as an image. Then, revisiting the function of trade mark, it is observed that today's origin theory of trade mark is not just giving evidence of the origin/source of a product. Indeed, there are other functions which I believe derive from the main one.

Still, the situation in *Arsenal* and *Opel* was peculiar since both trade mark owners had started in the memorabilia business. They were not in fact trying to extend their rights as in other more familiar cases of merchandising.²⁰

Now in concluding, in order for Article 9(1) CTMR and Art 5(1) of the Directive to operate, they need to establish the use requirement. However, one must bear in mind that the use requirement is as yet not settled. I therefore, believe that when use is at issue, the sign has to be used as a trade mark in a trade mark sense. Nonetheless, trade mark sense has to be seen not only as a guarantee of origin but also as a product identifier (including image function though).

Hence, having established what the use requirement implies or might be, the position of chemical senses is at risk. Smell and taste are not catalogued as strong marks and thus, trade mark owners would be confronted with the complexity of demonstrating that the smell/taste has been used as a trade mark. The difficulty can be perceived in both principles.

¹⁹ For more information refer to Chapter I.

²⁰ Many critics believe that by recognising merchandising it would indeed be an extension of their rights, giving though a vast monopoly to trade mark owners. See reviews of cases such as *Wombles Ltd v Wombles Skips Ltd* [1977] RPC 99; *BBC Worldwide v Pally Screen Printing* [1998] FSR 665; *Mirage Studios v Counter-Feat Clothing Co Ltd* [1991] FSR 145. Section 1.2.2 Economic Function, studied this topic.

On one hand, in the case of use as a trade mark sense (the origin function), the situation is that today there is the dilemma that consumers do not rely on smell/taste as a trade mark due to them not being recognised as identifiers. It can be predicted that when consumers get used to seeing chemical senses as trade marks there will always be the fact that those signs can still be seen when used by others as an embellishment, for decoration purposes and/or technical function, among others.

On the other hand, in the situation of ‘use’ as challenging the function of trade mark, the problem exists in that chemical senses will always be used in the industry to embellish or to decorate. One cannot expect manufacturers using these to be stopped by trade mark owners -- it is a matter of public policy. This concern was studied when assessing colours. However, I must say that in the situation of chemical senses the spectrum seems to be narrower.

There is indeed the need to balance the interests of trade mark owners and the interests of third parties who wish to make fair use of the mark.

Use Requirement Territoriality – the Spill over Advertising

Advertisements in newspapers, magazines and on the Internet, which are intended for customers in one country but reaches consumers in another country may be said not to be used in the course of trade. This use can be said to be passive use and thus, it does not constitute use in the country where infringement is claimed, even though such a newspaper, magazine or website can be accessible from the country in question.²¹

The same premise will apply to chemical senses. At the moment, it seems absurd to apply this to ads on the internet, but as technologies goes, I can imagine that in the future, computers will deliver chemical senses with just a click of a button. There is indeed, an increase in the so-called virtual reality and thus, the idea of interacting through a computer does not sound after all absurd.

Having examined the issue involved by the Headnote in Art 9 CTMR (Art 5 of the Directive), we will proceed to study each of the subsections in turn.

²¹ *Euromarket Designs Inc v Peters and Crate & Barrel* [2000] ETMR 1025.

6.2 Article 9(1)(a) CTMR

When a mark is identical to a registered one and is used for identical goods/services infringement is present. This exclusive right is also reinforced in the relative grounds for refusal of registration. Thus, considerations as to whether the sign and the trade mark are identical and also whether there is the identical product requirement are at issue.

Identical Sign Requirement

In *LTJ Diffusion v SA Sadas*²² the ECJ was asked by the *Tribunal de Grande Instance de Paris* whether the signs ARTHUR ET FÉLICIE and ARTHUR applied to similar clothing were identical. It is important to note that the word Arthur was written in a very distinctive form (handwritten signature) and with a dot below the initial 'A'. Specifically the national court asked: Does the prohibition in Article 5(1)(a) cover only identical reproduction, without addition or omission, of the signs constituting a mark or can it extend to: (1) reproduction of the distinctiveness element of the mark composed of a number of signs; (2) full reproduction of the signs making up the mark where new signs are added? The ECJ held that a sign is identical if "... it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."²³

By this approach, the ECJ seems to deviate from the view that the term identical should be perceived literally. That said, the ECJ extended the term to cover those marks that even though not exactly identical, if the difference is trivial and thus not perceived by consumers as the trade mark in question, then it would fall under this section. On the contrary, if the addition is significant, then the sign may be treated as similar rather than identical.²⁴

In *Reed Executive v Reed Business Information*²⁵ the Court of Appeal of England followed this criterion. The plaintiff ran an employment agency and had registered the trade mark

²² *SA Société LTJ Diffusion v Société SA Sadas Vertbaudet* C-299/00.

²³ *ibid*, para. 54.

²⁴ This case succeeded the various UK decisions where they delivered on the topic of 'identical marks'. For example *British Sugar v James Robertson & Sons* [1997] ETMR 118.

²⁵ *Reed Executive plc and another v Reed Business Information Ltd, Reed Elsevier (UK) Ltd, Totaljobs.com Ltd* [2003] RPC (12) 207.

REED in respect of its business which was used on the business premises and through their own website *www.reed.co.uk*. REED EXECUTIVE brought proceedings against the defendants for running a recruitment website (Reed Business Information (RBI)) using in its composite name the mark REED. The meaning of ‘addition’ can be perceived in the order of the name. The national Judge went on to observe that “one word can qualify another so as to change its impact...It is particularly in the recognition that additions can change identity that the ECJ has moved on from the rather rigid view taken under the old UK law.”²⁶

The same view was followed in *Compass Publishing v Compass Logistic*²⁷ when Laddie J rejected that the phrase ‘Compass Logistic’ was identical to the trade mark COMPASS. The Judge noted that “there is nothing in *LTJ* or *Reed* to suggest that noticeable differences should be ignored because they have only limited trade mark significance. To avoid infringement, the addition must not only be more than insignificant...it must have trade mark impact.”²⁸

Added to this, the average consumer plays a crucial role. In the following decision such a consideration is at issue. ESURE applied to register the image of a computer mouse with eyes and wheels for insurance services. DIRECT LINE opposed, based on its earlier mark, a telephone with wheels also for insurance services. The Officer considered that a degree of similarity was present. The visual, aural or conceptual similarity between the two was likely to be recognised by the average consumer since both marks had the unusual juxtaposition of wheels attached to electronic communication devices.²⁹

To sum up, to amount to an identical mark a high level of similarity between the marks is required.³⁰ There is no need to show likelihood of confusion yet it is crucial to determine whether the mark is identical or merely similar to the complainants’ trade mark.

²⁶ *Reed Executive plc and another*, para. 26.

²⁷ *Compass Publishing BV v Compass Logistic Ltd* [2004] EWHC 520 (Ch).

²⁸ *ibid.*, para. 21.

²⁹ *Esure Insurance Application* CTM No 2372783.

³⁰ *Origins Natural Resources v Origins Clothing* [1995] FSR 280.

Likelihood of Confusion

This requirement does not need to be met by Art 9(1)(a) CTMR (Art 5(1)(a) of the Directive). In *Société LTJ Diffusion AG* Jacob's opinion goes as "the protection afforded to trade mark proprietors under the relevant provisions is predicated essentially on the existence of a likelihood of confusion, proof of which is superfluous where both the marks (or the mark and the sign) and products covered are not merely similar but identical...since likelihood of confusion can be presumed without further investigation".³¹

AG Colomer appears to support the same view in *Arsenal*. While explaining the issue of likelihood of confusion as to apply to Art 5(1)(a) of the Directive, he follows an identical rationale; he expresses that "absolute means that protection is afforded to the proprietor irrespective of whether there is a likelihood of confusion because in such situations there is a presumption that there is such a likelihood."³² Art 16(1) of TRIPS also notes that "... In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed."

In *Arsenal* the judge mentioned the advantage of Art 5(1)(a) of the Directive as releasing the plaintiff from having to address the issue of confusing similarity but, it ascertained that this advantage is only secured in cases where the mark and sign are so extremely close that one can be considered a counterfeit of the other. Yet it is explained that such identity may still exist where the marks 'look and sound' identical, save to the eye or ear of an expert.³³ The reasoning is not far from true. However, it gives an idea of the problem that a non-visual mark may have when assessing similarity.

In the case of chemical senses, the plaintiff will not enjoy much of the said advantage -- release from probing likelihood of confusion, since it would be only limited to those that are so close as to believe that it is indeed an imitation. Having said that, to perceive odours and tastes is somewhat subjective. As a result the question of how close the mark and the sign are would be difficult to assess. Indeed, odour and taste are poor stimuli and thus, to establish similarities between chemical senses is quite tricky as would be demonstrated in the following chapter.

³¹ *LTJ Diffusion SA v Sadas Vertbaudet SA* C-291/00, paras. A36-A39.

³² *Arsenal v Reed*, *op.cit.*, para. 51.

³³ *Compass Publishing BV*, *op. cit.*, para. 20.

Another point that must be observed is that ‘look and sound’ similarities do not play any role in chemical senses due to the perception being by different stimuli. Consequently, the ‘look and sound’ proposal needs to be adapted. Observe that the AG notes the same deficiency when giving opinion in *Fitnessworld*. He said that as the ECJ recognised the registrability of smell marks, national courts might in the future be called on to determine the degree of olfactory similarity between a mark and a sign.³⁴

In 2006, a UK court also seems to have noted such an absence. In *L’Oréal*,³⁵ the national court while considering that the smell of the product in question was an important characteristic of the product, it was not to be considered. The court held that the smell should not be taken into account when assessing similarity in the case since it was neither the mark nor the sign. That said, I believe that this is a clear invitation to judge features such as smell and taste if the case requires it.

The ‘smell and taste’ test would be without doubt, extremely complicated. It needs to be run cautiously due to the subjectivity of the signs in question. There is however, the presumption that when a solitary odour/smell is at issue, such a test might be simpler. Yet, it can be said that in the event of mixtures, they could be analysed in the same way as visual signs. Note that what is intended, is to have a global test rather than a salami slice one.

For example, if the sign in question is the smell of strawberry and the disputed sign is the smell of strawberry and vanilla, it seems that the addition may provide a new identity to the sign. Another illustration can be seen if the sign in question is an odour which is composed of a mixture of tropical fruits including mango, pineapple and orange and the third party’s trade mark is also a mixture of tropical fruits but in addition including lemon. Certainly, to set both signs apart is quite difficult from the smell perspective.

However, following the *Diffusion* case there is reason to believe that the addition may be considered so insignificant that they are not perceived by consumers -- the sign is seen as identical. Conversely, observe that if the lemon obstructs the other smells or is the

³⁴ *Adidas Salamon AG & Adidas Benelux BV v Fitnessworld Trading Ltd* C-408/01, AG opinion, para. 43.

³⁵ *L’Oréal SA v Bellure NV* [2006] EWHC 2355.

principal smell in the sign, then we may be in the presence of a different sign which is perhaps similar but not identical. Yet, this is a hypothesis which on paper does not look complex; nonetheless in practice it is difficult to imagine the elaboration of such a test by the Office, AGs and Judges. Indeed, they could not be asked to smell/taste each product and thus the necessity of professionals in the area, surveys and any other prerequisites like sniffers or any other machine are likely to be required.

To say that the issue of likelihood of confusion is clear when applying Art 5(1)(a) is not right. The fact is that on certain occasions the element of confusion seems to be present and thus diminishes the absolute protection given by this Article.³⁶ *Opel v Autec* appears to be one of those cases since the ECJ explored making the trade mark owner prove the confusion element. As mentioned in the use requirement section, the Court seemed to require confusion when analysing this Article. There is no doubt that consumers may or may not think of a link between the trade mark owner and the third party with regard to trade marks; however, the comparison of ‘identical signs’ applied to ‘identical goods/services’ appears to lack any questioning by consumers. It seems to be a matter of fact.

Another point that needs to be made is that evidence of harm is not required. On 18 June 2009, the ECJ responded to a preliminary question brought by the Court of Appeal of England and Wales that “Article 5(1)(a) of Directive 89/104 must be interpreted as meaning that the proprietor of a registered trade mark is entitled to prevent the use by a third party... even where such use is not capable of jeopardising the essential function of the mark, which is to indicate the origin of the goods or services, provided that such use affects or is *liable to affect* one of the other functions of the mark” (emphases added).³⁷

When considering chemical senses, this later idea suggests that smell and taste will enjoy a vast monopoly. The reason being that an owner of a chemical sense mark could prevent the use of its mark by a third party if it affects or is liable to affect one of the functions of trade mark. As studied, smell and taste do have a wide market and on many occasions they are used as decoration, embellishment and even as a functional element (blocking bad odours

³⁶ C Gielen, ‘Adidas v Marca II: undue Limitations of Trade Mark Owner’s Rights by European Court of Justice’ [2008] *EIPR* 254, 255.

³⁷ *L’Oréal SA and others v Bellure NV and others* C-487/07. This case will be discussed in Chapter VII.

and/or tastes). Thus, to stop third parties using a particular chemical sense for their product does not seem right.

Identical Sign Must Indicate Origin

Another point which raises concern is that not only should the average consumer perceive the sign as identical to the trade mark but they should also perceive it as indicating origin.

While assessing the core zone of absolute protection under the Article, AG Colomer in the *Arsenal* case goes on to say that a third party must be using an identical sign in the course of trade. It is indeed necessary for the sign to be used. The reasoning is based on the fact that whilst examining the Directive it must be read in accordance with the aim and purpose of Trade Mark law. As explained earlier, the use requirement is far from clear, but making things worse is the fact that whether such use is required for Art 5(1)(a) as well as Art 5(1)(b) of the Directive, or any of them at all is controversial.

The ECJ in the *LTJ Diffusion* case ruled that when considering the rationale of the core zone it should be restricted to what is necessary to protect the functions of a trade mark, however. Andrew Griffiths, whilst analysing the case, believes that the use must be as in a trade mark sense because otherwise the core zone would entitle a trade mark's owner to prohibit any use at all. Thus, a monopoly over all commercial exploitation would be granted although limited to the goods/services for which the trade mark is registered.³⁸

Identical Goods and/or Services

The presumption that comes to mind is that goods and services which are registered in the same class of the Nice Agreement are considered to be identical for the purposes of either grounds for refusal or infringement. However, actual practice seems to examine what traders (trade mark owner and applicant or alleged infringer) actually do. Hence, even when goods/services are not registered in the same class they may still be identical.³⁹ As a result, such registration does not make the goods/services dissimilar. The reason is that

³⁸ Griffiths, *op. cit.*, p. 332.

³⁹ H MacQueen, C Waelde and G Laurie, *Contemporary Intellectual Property, Law and Policy* (Oxford University Press, Oxford 2008) p. 623.

there are situations in which traders do not operate according to what has been claimed at the time of registration.⁴⁰

To sum up, to establish infringement under Art 9(1)(a) CTMR (Art 5(1)(a) of the Directive) it must be proven that a third party has ‘used’ a sign which is ‘identical’ to a trade mark for ‘identical’ products; thus, a comparative stage of determining this must be followed.

6.3 Article 9(1)(b) CTMR

The Article is based on similarity. Therefore, starting with the similarity of the signs, the threshold level is found in any visual, aural or conceptual similarity between the two marks (a similar test is held in opposition cases). Subsequently, due to similarity, infringement depends on the existence of likelihood of confusion on the part of the average consumer. This however, needs to be adapted so as to include non-visual marks.

Assessing Similarities

Similarities between Marks

It can be said that the ECJ has given some guidance as to how best to assess the degree of similarity. In cases such as *Sabel* and *Lloyd*, the ECJ establishes that in order to assess the degree of similarity between a mark and a sign for the purpose of Article 9(1)(b) CTMR (Art 5(1)(b) of the Directive) and in consequence whether they are sufficiently similar to give rise to a likelihood of confusion for the purpose of that provision, the national court must determine the degree of ‘visual, aural or conceptual’ similarity between them.

In *Sabel v Puma*⁴¹ the ECJ established that the comparison of trade marks should involve a “global appreciation of the visual, aural, or conceptual similarity of the marks in question, bearing in mind, in particular, their distinctive and dominant components”.⁴² It continues to explain that “the average consumer normally perceives a mark as a whole and does not

⁴⁰ *Avnet Inc v Isoact Ltd* [1998] FSR 16.

⁴¹ *Sabel BV v Puma AG* C-251/95.

⁴² *ibid.*, para. 23.

proceed to analyse its various details”.⁴³ This assertion encourages a global assessment test and thus, the rejection of any salami slice evaluation.

An assessment of the similarity between marks is based on the overall impression which is created by the whole mark.⁴⁴ For that reason, a global appreciation test is needed involving though, the ‘distinctive and dominant components’ of the signs in question. Moreover, Professor Jeremy Phillips mentions that the comparison should examine how far the signs share characteristics that may confuse consumers. In the same line, he says that we should not focus on the differences presented.⁴⁵

It is asserted that the comparison is ‘mark for mark’⁴⁶ or ‘mark for sign’;⁴⁷ extraneous added material or circumstances should be ignored.⁴⁸ In *Julius Sämaan Ltd v Tetrosyl Ltd*, the judge argued that when assessing infringement, if the mark and sign are confusingly similar, the third party (the defendant in the case) cannot escape liability by showing that by adding something outside the actual mark he has distinguished his goods/services from those of the proprietor.⁴⁹

Still, there are certain circumstances where it is necessary for a court to examine those extraneous materials. In *O2 Holdings Ltd and O2 (UK) Ltd v Hutchison 3G UK Ltd*,⁵⁰ the High Court of England and Wales assessed all elements involved. In this case, 3G used one of the O2 marks (bubbles) as part of an integrated audio-visual presentation. The judge in the case considered that the extraneous elements did indeed need to be taken into account. The reason being that to gain a proper assessment of the impact on the consumer, it was necessary to consider all the basics of the presentation.⁵¹

Now then, visual, phonetic or conceptual differences between two signs may neutralize aural similarities between them.⁵² DAIMLERCHRYSLER applied to register the mark

⁴³ *Sabel BV v Puma, op. cit.*

⁴⁴ *Matratzen Concord GmbH v OHIM C-3/03P.*

⁴⁵ J Phillips, *Trade Mark Law: a Practical Anatomy* (Oxford University Press, Oxford 2003) para. 10.26.

⁴⁶ *Wagamama Ltd v City Centre Restaurants plc* [1995] FSR 713, 731-732.

⁴⁷ *United Biscuits (UK) Ltd v Asda Stores Ltd* [1997] RPC 513, 535.

⁴⁸ *Origins Natural Resources Inc v Origin Clothing Ltd* [1995] FSR 280.

⁴⁹ *Julius Sämaan Ltd v Tetrosyl Ltd* [2006] EWHC 529 (Ch), para. 48.

⁵⁰ *O2 Holdings Ltd and O2 (UK) Ltd v Hutchison 3G UK Ltd* [2006] ETMR 55.

⁵¹ *ibid.*

⁵² *Ruiz Picasso and others v OHIM C-361/04P.*

PICARO as a CTM for automobiles and their parts. The Picasso family opposed based on their earlier CTM for the word PICASSO, covering identical goods. The CFI upholding the BoA's decision held that there was no likelihood of confusion since the conceptual differences overcame any visual or phonetic similarities. AG Colomer was satisfied with the global assessment made by the CFI and rejected the Picasso's argument. He considered that it was irrelevant in assessing whether that conceptual difference can have the effect of counteracting visual and phonetic similarities between the sign at issue.⁵³

As a final note, if we apply the global appreciation test to chemical senses, it is obvious that the 'visual and aural' similarities cannot be established. In *Marc Browns' Trade Mark Application* the OHIM asserted that "customer's attention is caught mainly by means of visual perception".⁵⁴ Indeed, the visual impact of trade marks is very advantageous. Moreover, a visual element would have an advantage over any other element.

In the same vein, assessing aural similarity in chemical senses does not work. The reason being obvious, chemical senses do not belong to any audio discipline. This would leave us with a test only for conceptual similarity. In this way, the concept and the idea behind the sign is what is examined. It is assumed therefore, that the global appreciation test will include other disciplines which need to put aside the 'visual and aural' ones.

Similarities between Goods and Services

As explained previously, the fact that goods and services are registered in different classes of the Nice Agreement does not rule out that they may be similar. As indicated, all factors must be taken into consideration, especially the nature of the goods/services, end users, method of use, whether they are in competition, among others.⁵⁵

In *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc*, a case which involved the registration of the mark CANNON by MGM for video film cassettes, CANON opposed the mark on the basis that it infringed its trade mark registered for picture cameras and projectors. The ECJ indicated that in assessing similarity of goods/services, the distinctiveness of the mark would be an important factor. According to the decision, the

⁵³ *Ruiz Picasso and others, op. cit.*, AG's opinion at para. 16.

⁵⁴ *Marc Browns' Application* [2002] ETMR 653..

⁵⁵ H MacQueen, *op. cit.*, p. 630

more distinctive the mark the wider the protection. As a result, if the products in question contain a lesser degree of similarity this can be counterbalanced by a greater degree of similarity between the marks.

The case has been criticised due to linking the similarity of the goods/services with the distinctiveness of the mark. Certainly, I believe that regardless of the distinctiveness of the mark, goods and services must be identified and studied in their own right. These are different tests and as such must be kept separate when assessing Art 9(1)(b) CTMR (Art 5(1)(b) of the Directive).

As a final note, observe that when the goods/services in question are not similar, one of the conditions necessary in order to establish a likelihood of confusion is lacking⁵⁶ and therefore infringement cannot be proven.

Likelihood of Confusion

There is not likelihood of confusion when the public do not believe that goods/services come from the same undertaking. For instance, the mere registration of a domain name identical to a registered mark cannot be prevented by the trade mark owner.⁵⁷ There is the need for comparison which must be established in order to see if there is actually a threat of confusion.

When considering likelihood of confusion, one must take into account all relevant factors; likelihood of association needs to be considered. Note that if the public merely makes an association between two marks this would not in itself be sufficient for concluding that there is a 'likelihood of confusion', however.⁵⁸ In the *Wagamama* case, Lord Hugh claimed that when consumers see a mark as similar, as in this case, but believe that it is not connected to the trade mark owner, then confusion is not proved.⁵⁹

⁵⁶ *Waterford Wedgwood plc v Assembled Investments (Proprietary) Ltd v OHIM C-398/07P*.

⁵⁷ In the High Court of Nanterre the Court held that infringement of a trade mark can occur when a domain name is registered for a website only if the activities of the website are similar or identical to that which is designated in the trade mark. See N Dalton, 'France: Trade and Service Marks - Domain Names' (2002) 13 *Entertainment Law Review* N99.

⁵⁸ *Sabel v Puma, op.cit.*

⁵⁹ *Wagamama Ltd, op. cit.*

Some elements that may be looked at include: the recognition of the trade mark in the market, the association which can be made between the registered trade mark and the sign, the degree of similarity between the mark⁶⁰ and the sign and the goods/services. Moreover, the distinctive character of the mark and in particular its reputation must be taken into account.⁶¹ Nonetheless, these elements shall be appreciated if they are relevant to the evidence of deceptiveness.

Consumer perception plays a decisive role in the global assessment. Obviously the term consumer refers to the average consumer. The average consumer is considered to be a person who is reasonably well informed and reasonably observant and circumspect; this concept has now been widely adopted.

However, observe the decision recently given by the Republic of Poland Supreme Court. The case, which examines misleading advertising of pharmaceutical products, establishes that the assessment of whether advertising can be deemed as misleading should refer to the model of the average recipient of that kind of advertising. That said, the model of an average consumer could not be defined and considered in isolation from the conditions of this specific case and the realities concerning recipients of specific products to which the advertising is directed. In the case, the target consumers are often very ill and thus, with reduced capacity of perception and limited ability of reasonable and critical evaluation. There is also the case of the elderly, which is also a significant group of consumers of medicines. Hence, while assessing the possibility of confusion, the characteristics of this kind of audience should be taken into account as the average consumer.⁶²

For that reason, the average consumer cannot be defined and considered in isolation from the conditions of the case. Products are directed to a particular audience and thus, such an audience must be viewed as the average consumer. There are specific products aimed at recipients who would not be so reasonably informed, observant and circumspect.

⁶⁰ Aural similarity between the marks can be a factor. *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* C-342/97.

⁶¹ *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* [1998] ECR I-5507.

⁶² T Rychlicki, 'Poland: Average Consumer and Advertising of Pharmaceutical Products' (Class 46 – for your European trade mark news) <<http://class46.eu/2009/05/poland-average-consumer-and-advertising.html>> viewed on 7 May 2009.

Having examined the concept of the average consumer for the purpose of infringement, debate will progress to consider the likelihood of association. When considering likelihood of association it is said that it should be interpreted as an alternative deceptiveness test that goes beyond actual deceptiveness -- origin deception rather than explicitly in terms of dilution as blurring or tarnishing. Professor Peter Jaffey calls this form a sort of deemed deceptiveness which serves “the same purpose as the deceptiveness test by overcoming evidential difficulties in proving deceptiveness.”⁶³

The dispute that likelihood of association is not a separate test but included in the likelihood of confusion has been considered in a number of cases.⁶⁴ The matter however has been settled in the European decision *Sabel v Puma*.⁶⁵ SABEL’s sign was a device composed of a bounding cheetah with the name SABEL in respect of jewellery and leather goods. The cheetah appeared to be similar to the signs registered by PUMA namely a bounding puma, and leaping puma. The German Supreme Court held that the marks were not sufficiently similar to give rise to a likelihood of confusion as to origin; however the similarity of the bounding felines may give rise to a likelihood of association. The German court referred to the ECJ for clarification in the matter of non-origin association and marks confusingly similar. The ECJ in return explained that likelihood of association is only part and one element of likelihood of confusion based though on origin. For this reason, likelihood of association is not a separate element.

To finish, the application of Art 9(1)(b) CTMR when relating to chemical senses has the same conflict as any other type of sign. However, one can imagine that when smell and taste are at issue, likelihood of association for example will be more common than in the other types of marks. As mentioned and as it will be studied in the following chapter, smell and taste are becoming useful tools in marketing strategies. Even though, likelihood of association alone will not amount to infringement, yet to own a mark that can be easily associated in the market will make the smell/taste mark weaker.

⁶³ P Jaffey, ‘Likelihood of Association’ [2002] *EIPR* 3, 7.

⁶⁴ *Edor Handelonderneming BV v General Mills Fun Group* Nederland jurisprudentie 1978, 83. *Wagamama Ltd v City Centre Restaurants plc* [1995] FSR 713.

⁶⁵ *Sabel v Puma*, *op. cit.*

Added to that would be the complexity of providing an objective ‘smell and taste’ test which is to form part of the global assessment. As known, this is based only on sight and hearing and thus its extension is needed to provide protection to chemical senses. Yet, similar fragrance blends can be difficult to distinguish without expert assistance;⁶⁶ if lacking, a mere global assessment would fall outside any straight evaluation.

6.4 Article 9(1)(c) CTMR

The Article offers additional protection to owners of trade marks with reputation by preventing all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, his trade mark in relation to goods or services which are not similar to those for which the mark is registered. The mark however, must have a reputation in the Member State and use of the sign must be done without due cause, taking unfair advantage of, or being detrimental to, the distinctive character or the repute of the trade mark. However, bear in mind that Member States have the option of including this third category into their national legislation.

When a Member State has granted such an option, they must do so in respect of identical and similar as well as dissimilar goods/services.⁶⁷ The ECJ rightly argues that the protection of this provision should be stronger than that afforded where consumer confusion was a prerequisite.⁶⁸ The case seen as an overprotection for marks having a reputation was affirmed in *Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*.⁶⁹ The ECJ was presented with a mark of repute and in the absence of confusion, held that ‘where the sign is used for identical or similar goods or services, a mark with a reputation must enjoy protection which is at least as extensive as where a sign is used for non-similar goods or services.’⁷⁰ While the wording of the European legislation clearly refers to dissimilar goods and services, protection must be also granted to similar ones. Marks of reputation must benefit from this measure regardless of whether they are for similar or dissimilar goods/services. The reason being that Recital 9 of the Directive

⁶⁶ B Elias, ‘Do Scents Signify Source? – an Argument Against Trademark Protection for Fragrances’ (1992) 82 *Trademark Report* 475, 488.

⁶⁷ *Adidas-Saloman AG and Adidas Benelux BV v Fitnessworld Trading Ltd* C-408/01.

⁶⁸ *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* C-292/00, para. 30.

⁶⁹ *Adidas v Fitnessworld*, *ibid*.

⁷⁰ *ibid*.

provides ‘extensive protection to those marks which have a reputation’. Consequently, the purpose of the Article is to stop third parties from taking unfair advantage of a mark which has substantial goodwill.⁷¹ This application has been settled by case law.

Likelihood of Confusion

The Article seems to be silent in reference to this requirement; is likelihood of confusion needed? In order to show unfair advantage or detriment, some evidence that the public associate the two marks in question is required though.⁷² Yet this is not the same as confusion.⁷³

The ECJ is clear that a link between the earlier mark and the later mark which must be assessed globally is necessary. In *Oasis Stores Ltd’s Trade Mark Application*, the applicant intended to register the mark EVER READY for condoms. EVER READY opposed and the Registrar held that merely being reminded of a mark does not itself take unfair advantage of the repute of the mark.⁷⁴ Clearly, if such an idea is allowed, the monopoly enjoyed by trade mark owners would be exceptionally broad.

In *Adidas*, the ECJ explained that while Art 9(1)(c) CTMR (Art 5(2) of the Directive) does not require likelihood of confusion on the part of the public, it indeed expects a degree of visual, aural or conceptual similarity between the mark with a reputation and the sign used.⁷⁵ That said, the relevant section of the public may need a connection or to establish a link between the two but there is not the need of confusion *per se*.⁷⁶ More recently, in *L’Oréal v Bellure*, a case heard in the UK courts⁷⁷ and also in France,⁷⁸ the dispute of ‘smell alike’ was under scrutiny. Relevant to this section is the fact that the absence of likelihood of confusion did not matter for the courts to uphold infringement. The High Court of England and Wales suggested though that there were three types of link, anyone

⁷¹ MacQueen, *op. cit.*, p.639.

⁷² *Premier Brands UK v Typhoon Europe* [2000] FSR 767.

⁷³ In the UK greater protection was given to dissimilar goods/services if likelihood of confusion was not needed. This requirement has been ruled out by the ECJ in *Adidas v Fitnessworld*, *op. cit.*

⁷⁴ *Oasis Stores Ltd’s Application* (Eveready) [1998] RPC 631.

⁷⁵ *Adidas v Fitnessworld*, *op.cit.*

⁷⁶ *ibid.*, para. AG24.

⁷⁷ *L’Oréal SA v Bellure NV*, *op. cit.*

⁷⁸ *Société Bellure v SA L’Oréal et al.*, Cour d’appel de Paris, 25 January 2006.

of which may be sufficient for Art 5(2). The link is somewhere between being reminded (more than that) and likelihood of association (less than that in the strict sense).⁷⁹

Now, referring to such a link, the ECJ has indicated in *Intel* that a link can be said to be when the later mark calls the earlier mark with a reputation to mind.⁸⁰ Grammatically speaking, is being reminded not the same as to cause to remember? If something is called to mind, is that not the same as remembered? Therefore, it is difficult to have a clear idea of what 'link' means. For example, in the *L'Oréal* case, it is explained that the link is more than being reminded. On the contrary, the ECJ appears to have settled for just a recall to mind. In both cases, I believe we require remembering. However, how much? I believe that with the sole action, or fact of remembering, this requirement is fulfilled (regardless of the power or length).

Nonetheless, note that the existence of a link in the public's mind is necessary but it is not a sufficient condition if presented alone in a case of an infringement.⁸¹

Other Requirements

There are some important points arising from the wording of Art 9(1)(c) CTMR (Art 5(2) of the Directive). This Article refers to other requirements which must be fulfilled. On one hand, there are the cumulative conditions: there must be an earlier mark and a later mark or sign which must be identical or similar, the earlier mark with 'reputation' and the use of the later mark 'without due cause'. On the other hand, the Article continues with the alternative requirements which are the consequences of the first mentioned -- they refer to unfair competition or detriment relating to the distinctive character or repute of the mark.

Nonetheless, some terms or requirements have being controversial with regard to their exact meaning. Case law has been building in this area and it appears to be settled. Starting with the reputation concept, a mark is reputable if it is known by a significant part of the public concerned for the goods/services covered by the trade mark in a substantial part of the Member State where it is registered.⁸² Factors considered are: the product's market

⁷⁹ *L'Oréal v Bellure*, *op. cit.*

⁸⁰ *Intel Corp Inc v CPM United Kingdom Ltd* C-252/07, para. 2. Note that the ECJ was referring to Art 4(4)(a) of the Directive which is regarding opposition.

⁸¹ *Intel Corp Inc*, *op. cit.*, para. AG43.

⁸² *General Motors Corp v Yplon SA* C-375/97.

share, the degree to which it has been promoted, the amount and duration of the trade mark use. AG E Sharpston observed that the ECJ, while delivering in the case of *General Motors Corp v Yplon SA*,⁸³ referred also to the fact that the stronger the earlier mark's distinctive character and reputation, the easier it will be to accept that detriment has been caused.⁸⁴

Referring to the matter of 'without due cause', the ECJ has not addressed this point as yet. Nevertheless, in *Premier Brands UK Ltd v Typhoon Europe Ltd*⁸⁵ it was held that 'without due cause' is an objective test. The defendant's intention and/or his subconscious desires should not be taken into account. Such a phrase does not mean an absence of good faith or that the use is contrary to good honest commercial reasons, however.⁸⁶

Lastly, the requirement of detriment is said to include dilution. As known, dilution may occur in two circumstances: blurring, and/or tarnishing. The former refers to detriment to the distinctive character of a mark, while the latter refers to detriment to a mark's repute.⁸⁷ However, it is worth bearing in mind that it is not necessary to demonstrate the actual and present harm. It is sufficient to show that there is a risk of unfair advantage or detriment in the future.⁸⁸

Transposing the present knowledge to chemical senses, it is observed that if a smell/taste becomes protected under this Article, the theory of depletion may apply.

The Practice

An application of Art 5(2) can be seen in *Adidas* where the situation of likelihood of confusion and the use requirement were present. The famous ADIDAS' trade mark is characterised by three vertical stripes of equal width, running parallel and appearing on the side and down the whole length of articles of clothing; the motif may be executed in different colour combinations and in different sizes but always contrasting with the basic colour of the clothing. FITNESSWORLD TRADING Ltd ('Fitnessworld') is in the

⁸³ *General Motors Corp, op. cit.*

⁸⁴ *Intel Corp Inc, op.cit.*, para. AG 23.

⁸⁵ *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] ETMR 1071.

⁸⁶ D Bainbridge, *Intellectual Property* (7th edn Pearson Education Limited, Harlow 2009) p. 719.

⁸⁷ This complex area will not be studied further due to going outside the scope of the thesis.

⁸⁸ *Aktieselskabet v OHIM* C-197/07.

business of marketing fitness clothing. A number of the articles of clothing which are offered for sale do bear a double-stripe motif. Those stripes run parallel, are of equal width, contrast with the main colour and are applied to the side seams of the clothing.

ADIDAS sought a court order at the Zwolle District Court to stop FITNESSWORLD using, in the Benelux countries, any sign similar to the triple-stripe motif of Adidas, such as the double-stripe motif. The Court granted the order and FITNESSWORLD appealed to the Regional Court of Appeal which set aside the judgment and dismissed ADIDAS' claims. ADIDAS appealed and the Dutch Supreme Court referred some questions to the ECJ for advice. One of the questions asked was related to the likelihood of confusion and thus whether it makes a difference if the relevant public sees the sign as an indication of origin or as an embellishment.

The ECJ held that “the fact that a sign is viewed as an embellishment by the relevant section of the public is not, in itself, an obstacle to the protection conferred by Article 5(2) of Directive 89/104 where the degree of similarity is nonetheless such that the relevant section of the public establishes a link between the sign and the mark”.⁸⁹ This sentence clarified that if a sign is seen as an embellishment it does not diminish its protection. By contrast, the court in the same paragraph continues “...where, according to a finding of fact by the national court, the relevant section of the public views the sign purely as an embellishment, it does not necessarily establish any link with a registered mark, with the result that one of the conditions of the protection conferred by Art 5(2) of Directive 89/104 is then not satisfied.”⁹⁰ In this sentence, the court, even though it did not directly hold that a pure embellishment is not to be caught by Art 5(2) of the Directive, once again went on to mention the necessity of a ‘link’, meaning that if consumers do not think of the mark as a trade mark but rather as an embellishment or decoration, then there is no ‘use’ of the trade mark and as such would not be an infringement.

The answer appears to be that while a sign can be seen as an embellishment, that embellishment needs to be regarded, in the consumer’s eyes, as a mark. Yet, the idea appears to be that the use of a mark as an embellishment cannot result in a successful Art 5(2) of the Directive. That said, the AG rejects the idea that even in situations where a later

⁸⁹ *Adidas v Fitnessworld*, *op. cit.* para. 3.

⁹⁰ *ibid.*

mark is used as decorative, consumers will not connect the use with an earlier mark because there are some situations that an embellishment can bring a sign to mind. Jacobs, the AG on the case, extended his view looking at the monopoly that could be granted if trade mark owners could prevent the use of common decorations and motifs such as the stripes.⁹¹ To reach this conclusion the AG brought into discussion Art 5(5) of the Directive which covers the protection of other non registered marks under national measures. The ECJ however, did not follow this approach and focused on the ‘link’ between the marks and the consumer, even though the court does not explain the issue around it.

Yet, the AG explained that the lack of a link between the two marks could not be the reason for Art 5(2) of the Directive to apply. Based on the facts, the AG considers that the determining factor as to whether any particular use fell within Art 5(2) was if the later mark was ‘used for the purpose of distinguishing goods or services’. Yet, the ECJ rejected the AG’s idea but still reached the same conclusion.

Ilanah Simon explains that the distinction between these approaches does matter.⁹² She bases her explanation on the fact that trade mark use by a later user is a concept that is specific to infringement and thus should not be susceptible to opposition in registration cases. She went on to explain that the ECJ reasoning is based only on association rather than trade mark use. Indeed, I do concur that the use requirement is not a requirement to be considered in Art 5(2) of the Directive. The reason being that Art 5(2) of the Directive does not require likelihood of confusion but still requires association. Though not considered the same as confusion there is still the need for the ‘link’ between consumer and sign. In this illustration a pattern can be seen. Even though the use requirement is not sought, there is still the need of association and in consequence there is the need to assess the use given to the sign.

At the beginning of the section the similarity between absolute grounds for refusal and Art 9 CTMR (Art 5 of the Directive) was noted. That said, in some cases the OHIM may look into a case of infringement for directions. However, even though they are similar they are not the same. In the case of Art 9 CTMR and Art 5 of the Directive, while association

⁹¹ *Adidas v Fitnessworld, op. cit.*, para. 63. Note that the same discussion was raised in this thesis when studying chemical senses and the issue of the use requirement.

⁹² I Simon, ‘Embellishment: Trade Mark use Triumph or Decorative Disaster?’ [2006] *EIPR* 321, 324.

works for both, it does not mean that in cases of infringement the link referred to by the Court needs to be implied as association alone and thus, not including the use of the mark.

When referring to the link, Ilanah mentioned that the rationale behind the ECJ's approach may be similar to that taken in descriptive terms due to consumers seeing a sign not as an indicator of origin.⁹³ Consumers would associate the sign with the product because of the descriptiveness of the sign. Nonetheless, observe that in such cases use of the mark is considered *ipso facto* since, because of the use given to the mark by traders and consumers alike, consumers come to associate it with the product. For this reason, even though she observes the fact that consumers do not associate the sign with the trade mark (an association approach), the use given to the sign plays a crucial role.

I believe therefore, that if we are to look for the rationale of the ECJ in an infringement case, then, there is the need to look further and beyond the registration process and thus the use given to a sign should always be at issue in infringement cases.

In *Fitnessworld*, the AG concluded that “it is a condition of the application of Article 5(2) that the allegedly infringing sign is used as a trade mark, that is to say for the purpose of distinguishing goods or services”.⁹⁴ In the case, he believes that as the sign was viewed purely as a decoration by the relevant section of the public, then there was not such use.⁹⁵

As explained previously in the use requirement section, trade mark use refers not only to the origin function but goes further than that. The AG's opinion in *Adidas* resembles the *Arsenal* case in which the sign was viewed as a ‘badge of alliance’ but as the national court put it, even though it was used in that way, still it could impinge upon a mark's function.

The same approach can be said for *Fitnessworld*, while the mark can be seen as an embellishment, still it could jeopardise the function of the trade mark. In *Bellure*, the ECJ, while analysing Art 9(1)(a) CTMR (Art 5(1)(a) of the Directive), mentioned that the proprietor of a registered trade mark may stop the use of its trade mark where such use is not jeopardising the essential function of the mark (referring to origin), but providing that

⁹³ I Simon, ‘Embellishment: Trade Mark use Triumph or Decorative Disaster?’ *op. cit.*

⁹⁴ *Adidas v Fitnessworld*, *op.cit.*, para. 64.

⁹⁵ *ibid.*

such use affects or is liable to affect one of the other functions of the mark.⁹⁶ That said, the issue would protect not only the primary function but modern ones too. Nevertheless, the AG's opinion can be interpreted in two ways. On one hand, it can be said that the AG was referring to the use requirement and thus implies that Art 9(1)(c) CTMR (Art 5(2) of the Directive) needs it. On the other hand, it can be said that he was referring to the fact that use of the mark is required in the sense that consumers need to associate the mark with the origin. I concur with the latter.

Hitherto trade mark owners would like to extend this Article to include 'any' use. Particularly as lookalikes are becoming commonly used by supermarkets, for example. They sell products under their own brand alongside the goods of another brand owner. Usually, the supermarket's packaging would resemble that of the famous brand, known as 'free riding'. Yet, this is not protected under Trade Mark law in any of the European countries.

Note that some continental European countries do have specific laws that oppose this misrepresentation however. In Italy for example, a lookalike product placed near to its more familiar (and more expensive) trade rival has been caught under Unfair Competition law.⁹⁷ The same view is followed in Belgium where lookalikes represent parasitic/slavish imitation, exploitative of another's valuable commercial achievement. In the UK, passing off remains the action to be brought. However, as in any other passing off action, the issue of misrepresentation is difficult to prove, especially if the consumers are aware of such practice, and moreover they know they are buying the supermarket's product.⁹⁸

Yet, it is important to remember that the UK follows the idea of being competition friendly. The view is that free market economies improve consumer welfare. However, this idea is based on a perfect competition atmosphere where there is no dishonest behaviour, no monopoly and so on.⁹⁹

⁹⁶ *L'Oréal SA and others v Bellure NV and others*, *op. cit.*

⁹⁷ *R v CH*, Tribunal of Rome (reported in English *EIPR* 2006 28 (11) N212-2).

⁹⁸ However, observe *United Biscuits (UK) Ltd v Asda Stores Ltd (Penguin/Puffin)* *op. cit.*, as illustration of a successful case.

⁹⁹ H Rosler, 'The Rationale for European Trade Mark Protection' [2007] *EIPR* 100, 104.

Returning to Art 9(1)(c) CTMR (Art 5(2) of the Directive), bear in mind that the need to keep free is not to be considered. In *Adidas II*, the ECJ ratified what was previously established in *Adidas I*. The requirement of availability is extraneous both to the assessment of the degree of similarity between the mark with a reputation and the sign used by the third party and to the link which may be made by the relevant public between that mark and the sign. It is, indeed, a factor which is not relevant to determine whether a sign has taken unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.¹⁰⁰ The availability criteria cannot be an argument used as a defence; it is a concept that is the preserve of registration.

In closing, assessing infringement is not a straightforward act. There are many issues that need to be settled when studying all that is involved in the process. One can presume that the courts are not ready to examine smell and taste under the global assessment. Firstly, because chemical sense marks are not visible and secondly, due to their use in the marketing arena. Overall, chemical sense marks' owners can find themselves with a mark that even though registered, will not prevent most uses of it by third parties. Therefore, it will be difficult to prevent the mark from being diluted by similar marks.

There is indeed, a heavy burden for the owners to establish confusion and use. However, all is not gloomy for these owners, since as explained, under Art 9(1)(c) CTMR they can have a good monopoly over a chemical sense. Is it worth?

The fact that chemical senses are becoming commonly used in the market, it means that it is harder to protect them. That is not to say that a chemical sense mark will not have a great success in developing a highly successful brand. Nevertheless, as far as this chapter is concern, it is worth noting that the possibility of taking successful legal action against infringement seems to be particularly restricted.

¹⁰⁰ *Intel Corp Inc, op. cit.*, para. A25.

CHAPTER VII

CHEMICAL SENSES – DO THEY NEED PROTECTION?

This last chapter will examine chemical senses and where they belong in the market. Indeed, the main proposal of this thesis is to examine, upon other matters, whether chemical senses could ever work as true trade marks. If this is so, then undoubtedly they do deserve protection under this legal system. On the contrary, if chemical senses do not act as signs, the question is: can they still be protected?

This chapter therefore will begin by studying the problem caused by the subjective nature of chemical senses. It will continue by analysing how chemical senses are perceived in the market and it will study the kinds of smell and taste that may work as trade marks. Overall, it will be argued that chemical senses do clash with the obstacles they meet *i.e.* being seen as trade marks by consumers.

Yet, owing to the significance of modern trade marks as desirable symbols it is important to examine the influence of chemical senses on markets and consumers. Thus, to finalise, regardless of what the future holds for chemical senses as trade marks, there is always the possibility of protecting them through alternative rights, namely, passing off, unfair competition and even copyright. That said, if chemical senses are to be protected, they need justification, and so, the final section will examine the market development and social changes for future prospects in the area of chemical senses.

Throughout previous chapters it has been discussed that the majority, if not all unconventional marks, do have the same problem -- working as trade marks. Generally, discussions surrounding any conventional trade mark would be relevant to chemical senses since the same or similar issues do arise, namely graphically representation, distinctiveness and functionality. Throughout these pages, it has been illustrated that colour marks, three-dimensional shape marks and even sound marks have difficulty in being registered but not as much as chemical sense marks.

The most frequent reason for the refusal of chemical senses has been that of graphical representation. Because of this, the debate about lack of distinctiveness and functionality has been put aside. I do believe however, that these issues are as difficult to overcome as the issue of graphical representation.

A general overview, especially from manufacturers, favours registrability of unconventional marks. Yet, it seems that chemical senses may not function as trade marks at all due to their subjective nature.

7.1 Chemical Senses -- Subjective Nature

Whilst assessing smell and taste, the presence of chemical interactions is at issue. Therefore, to discuss chemical senses is challenging due to this topic being poorly understood. Indeed, smell and taste are among the least accessible sensory stimuli to the methods of science.¹ No one is certain as to how many or what kind of basic chemical senses there are.² For example, the most commonly accepted smell sensations are: fruity, flowery, spicy, resinous, burning, and putrid. For taste it would be: salt, sour, bitter, and sweet.³

Added to this is the fact that our olfactory and taste stimuli are based on our reactions to particular chemicals. Moreover, taste sensations vary depending upon temperature. An illustration can be observed in the following example: sensitivity to bitter tastes increases as temperature decreases; conversely, sensitivity to sweet tastes increases as temperature increases. Adaptation also plays a crucial role. The intensity of an odour seems to decline the longer we are exposed to it. In the same line, adaptation to the taste of one substance may either enhance or reduce our sensations of another taste.

Bearing in mind that many odours can be recognised, they are therefore charged with emotional and social content.⁴ To complicate matters, every day we are confronted with a

¹ C Classen, D Howes and A Synnott, *Aroma – The Cultural History of Smell* (Routledge, London 1994) p. 88.

² J Ludel, *Introduction to Sensory Processes* (W.H. Freeman, San Francisco 1978) p. 339.

³ J Gibson, *The Senses Considered as Perceptual Systems* (Greenwood Press, 1983) p. 149.

⁴ Classen, op. cit., p. 113.

variety of olfactory and taste stimuli at the same time and thus, the combination of these can produce unique results that cannot be described as the sum of separate sensations.⁵

In *John Lewis of Hungerford's Application*,⁶ the appointed person considered the words 'the smell, aroma or essence of cinnamon' to lack precision due to its subjectivity. It is indeed a description that while intelligible by anyone, does not give the precise smell. The situation is very simple; not everyone is familiar with a determined smell. Moreover, as mentioned in the previous paragraphs, chemical senses stimuli vary depending on temperature, adaptation, emotions and so on.

It is indeed impossible to try to create a sign that is objective which in nature is subjective. However, observe the following: art work is very much subjective but this subjectivity does not make the work any more or less artistic. The question is: would the same apply to chemical senses? The subjectivity of a smell and/or taste will make the sign more or less distinctive. This, as explained in Chapter V, will result in a sign being barred from registration *ab initio*. Moreover, as also mentioned in Chapter VI, subjective marks are bound to be problematic when assessing infringement. Therefore, because of the subjective nature of chemical senses, I am concerned about their potential for protection under the trade mark system.

7.2 Chemical Senses – Aptitude to Function as Marks

Without doubt, the senses that dominate our lives are sight and hearing. However, manufacturers have realised the commercial potential of odour and taste and have started to promote these.⁷ For example, scratch and sniff have been used in advertising/marketing for years. Indeed, the market has developed in response to these conditions and now the commercialisation of smell as well as taste is in place *i.e.* PLAY-DOH's smell; JOHNSON's baby shampoo smell; ABERCROMBIE & FITCH clothes' fragrance; and flavoured medicines, among others.

⁵ Ludel, *op. cit.*, p. 361.

⁶ *John Lewis of Hungerford's Application* [2001] ETMR 1193.

⁷ Classen, *op. cit.*, p. 176.

Hence, this section will examine the use of chemical senses in products which might be perceived in some cases as part of the product, or a complement to it, or an embellishment. The question is: do chemical senses act as trade marks?

7.2.1 Examination of Socio-Economic Problems: the Market Conditions

In a previous chapter it was explained that there exist certain occasions where consumers do not buy a product because of its primary function - origin, but because of the commodity, fashion and style associated with it.⁸ Unquestionably, in the area of smell, advertisement of perfumes and deodorants induce new identities by evoking fantasies.⁹

Smell and taste not only have targeted the usual toiletries market but have become more present in pharmaceuticals, foods, stationary and are also used in services as part of their trade dress. Therefore, from being just an essence of material culture they have risen as an indication of social status.¹⁰ There is a vast range of products where chemical senses have become crucial to consumers. That said, smell and taste are starting to be used in products to make them more desirable and worth buying.¹¹ These reasons make chemical senses less likely candidates for signs as trade marks. Moreover, if registered, it will be difficult for the owners to prevent the use of these signs by third parties because they are used just as marketing tools and not as a trade mark as mentioned in the previous chapter.

From this point of view, undoubtedly the function of these signs is to sell a product rather than to distinguish it. For instance, the practice of adding aroma to products and to some extent taste to edible products might increase their appeal. According to marketers, the smell has a direct connection to the brain whereas the other senses only communicate messages to the brain through intermediary synapses.¹² The situation is that consumers generally prefer smelled products due, not only to being perceived as more pleasant, but also to being perceived as more efficient and of better quality. This latter statement gives rise to a chemical sense mark being caught by Art 7(1)(c) CTMR (descriptive signs) as explained in Chapter IV.

⁸ Refer to Chapter I.

⁹ Classen, *op. cit.*, p. 186.

¹⁰ *ibid.*, p. 182.

¹¹ *ibid.*, p. 181.

¹² Classen, *op. cit.*, p. 192-193.

It is worth noting however, that the rationale for affording protection to these new types of signs is evident. Chemical senses are indeed good commodities and thus are worthy of protecting due to the investment of traders in building up the image. Nevertheless, it cannot be forgotten that the basic function of a trade mark is to distinguish the goods/services of one business from those of another. Hence, what has to be assessed is whether the sign serves to convey information as to the origin of the product or, is just a commodity and thus not considered to be a trade mark.

In Chapter I, we observe that the function of trade marks go beyond origin and quality. In today's market they do indeed perform an economic function. Yet, whilst protection of trade marks as an economic asset becomes rational, there is an urgent need to not undermine the historical function of trade marks. The point is that trade marks not only seek to protect the reputation of the sign alone – the new figure of dilution, but they seek mainly, to protect the source. Therefore, encouraging undertakings to only rely on the economic function of their trade marks is not right. Trade marks must, at least, be able to serve as a guarantee of origin.¹³

Retaking the subject of market conditions, note that these new signs, although thought to be used for attracting consumers' attention, have problems of their own (not referring to Trade Mark law). That said, it is important to bear in mind that not all manufacturers can easily take advantage of all five senses. For example, taste marks cannot be placed in many products, only in those that are edible and/or meant to be tasted and/or in contact with the mouth *i.e.* tablets, liquids, threads, some stationary, stamps. As demonstrated, the market is quite limited.

Consequently, for those manufacturers who can use smell and taste as trade marks it is important to evaluate whether they would draw attention to the fact that the sign (smell and/or taste) is an added feature of the product. If so, when consumers perceive this as an added characteristic it could destroy the illusion that the feature is an integral part; it would be perceived as superficial and trivial.¹⁴ Afterwards, consumers would not perceive the odour/taste as an essential quality and thus potentially the product would lose its appeal.

¹³ P Torremans, *Holyoaks & Torremans Intellectual Property Law* (5th edn Oxford University Press, Oxford 2008), p. 380.

¹⁴ Classen, *op. cit.*, p. 194

Due to this factor, marketers may lose customers. However, by manufacturers indicating that the chemical sense sign is not a component of the product but a trade mark, they may obtain an indicator of source and therefore, the distinctiveness requirement.

Additionally, in some product lines, chemical sense signs may be seen as interchangeable characteristics.¹⁵ For example, smell in the toiletries industry and taste in the pharmaceuticals industry. After that assertion we could question whether it may be possible for these marks to be capable of distinguishing.

Note that the problem of asserting distinctiveness in unconventional marks is common in 3D shapes and packaging. The ECJ has repeated on several occasions that a shape or packaging can only be distinctive where the consumer perceives it immediately as an indicator of origin.¹⁶ It is expected that chemical senses will follow with similar controversies and that they will pursue the same outcome. One can predict that when a feature occurs which is not common or just trivial, it can then potentially be considered to have distinctiveness *ab initio*. Yet, it is important to remember that what is looked for is not the uniqueness of the mark, because the mark does not need to be unique. A mark can be distinctive without being unique. Moreover, consumers can be taught to recognise certain features as trade marks, as has happened in the case of 3D shapes. Could the same happen to chemical senses? I believe so.

Now, while the earlier focus has been on the problem of chemical senses being capable of being distinctive -- a social dilemma, one needs also to assess the problem of chemical senses as potential anti-competitive feature, an economic setback. In this sense, smell and taste marks can be seen as an element of the product. If so, it is essentially valuable to traders. While the concept of functionality in terms of registrability appears only applicable to shapes, there is a body of case law that tries to accommodate this problem looking at the requirement of availability. There is indeed, an obvious justification to keep certain signs free. As known, public interest and trading interest may not always go hand in hand.

¹⁵ Classen, *op. cit.*

¹⁶ G Humpreys, 'Proof of Use, Continuity of Functions in inter partes Proceedings and Three-dimensional Marks: Europe in Review' (2007) 2 *Journal of Intellectual Property Law and Practice* 240, 247.

Giving indefinite protection to functional features restricts competition and therefore goes against public interest.¹⁷

Understandably, where there are a limited number of possible ways of presenting a product, the idea of granting a monopoly over that feature which will keep other traders out of the market, is indeed dramatic.¹⁸ Policy considerations are indeed a significant factor in the interpretation of Trade Mark law and therefore, the perceived monopolisation of a sign needs to be carefully balanced.¹⁹ This concern was assessed by the courts when the protection of colours *per se* was at issue. In these cases, it was considered that because of the limited number of colours, to grant such a monopoly could distort competition and it could even stop new traders entering a particular market -- depletion doctrine.²⁰

Usually, the general interest is observed in cases of colour marks and shape marks and therefore, it can be predicted that the same doctrine will be applicable to chemical sense marks. The public interest is examined for instance in Art 7(1)(c) which regards descriptive signs as barred from registration and adds that they need to be free for all to use. The same provision is seen in Art 7(1)(e) which sets up that shapes which perform a technical function may be freely used by all.²¹

To recap, in view of the above, chemical sense marks may function in practice as a feature which has a natural importance to traders and for this reason they should be properly balanced in the light of public interest -- preserving the availability of a sign.

7.2.2 At the Point of Sale

One of the major problems presented by chemical senses is that usually a consumer will not have access to the product's smell and flavour prior to purchase. It cannot therefore be expected that a consumer will distinguish one product from another if the presence of the

¹⁷ J Davis, *Intellectual Property Law* (3rd edn Oxford University Press, Oxford 2008) pp.190-191.

¹⁸ L Bently and B Sherman, *Intellectual Property Law* (3rd edn, Oxford University Press, Oxford 2009) p. 832.

¹⁹ S Maniatis, *Trade Marks in Europe: a Practical Jurisprudence* (Sweet & Maxwell, London 2006) p.71.

²⁰ *Qualitex* 514 U.S. 159 (1995).

²¹ Maniatis, *op. cit.* p. 118.

mark is lacking. That said, it seems as if it is not possible for them to be indicator of source either.

Yet, it can be observed that smells (no taste) have more potential in pre-sale. A case in point would be if packaging blocks the smell, then strips can be placed on the outside; another example would be if packaging is not restrictive at all, access to the sign, namely the smell, can be achieved. If the above is not possible, the opportunity for smell to work as a trade mark at the point of sale is lost.²² These examples however, exist when referring to scented goods. For services, there is immediate access to the sign.

To sell, businesses need different market strategies. They call upon all five senses to create brand experiences for customers. One of the advantages of smell as a sign is that consumers, at any moment, could forget the product's name but characteristics of the product may be remembered *e.g.* it smells like fresh cut grass.

Note that recognition is not to be confused with recall, however. It is believed that human beings are not good at naming odours, even if they are recognisable.²³ Yet, an odour or taste can be familiar but it does not guarantee that there is an immediate recognition of where it comes from (not in the trade mark sense - the origin function). That said, there is no guarantee that there is a straightforward link between odour/taste and subject/source. Even in cases where a consumer may be able to differentiate between the smell of a DOVE soap bar and an IRISH SPRING soap bar but he will not use this stimuli at the moment of purchase.²⁴

Chemical senses do not have a settled market condition. Marketers need to examine the balance between rewards and drawbacks if using them as trade marks. Consider however, that because of the amount of money spent on this features, small manufacturers may be overshadowed.

²² Elias B, 'Do Scents Signify Source? – an Argument Against Trademark Protection for Fragrances' (1992) 82 *Trademark Report* 475, 480.

²³ Elias B, *op. cit.*, p. 480.

²⁴ *ibid.*, p. 479.

7.2.3 Revisiting the Function of Trade Marks

Notwithstanding the argument of legislation for the registration and protection of chemical senses, there has been little in-depth discussion about their functionality as trade marks. Evidently, after examining the influence of chemical senses on the market and consumers, one may wonder if chemical senses would work as trade marks.

The legal point of view is that the only function of trade marks is to give evidence of the origin from which goods/services come; the so-called origin function. In the same vein, the traditional rationale for trade mark protection is to protect consumers. The reason being that trade marks denote the origin and source of the goods/services. Trade marks tell the consumer where a particular product comes from and assure the consumer that a particular product comes from or is at least associated with, the same undertaking, as other goods/services sold under the same trade mark. Hence, consumers indeed expect that it has the same quality. It is therefore perfectly correct to say that a trade mark is a badge of origin or source. It functions to distinguish one company source from goods/services having a different company source.

However, note that in the present state of the market it appears that trade mark protection is just to create property and thus only benefits the trade mark owner. It is true then that in today's market setting, trade marks are signifiers. They often carry out functions that go beyond connecting goods/services to a source. Because of this, we need clear thinking about what the trade mark function is.

In Chapter I the actual purpose of a trade mark was studied and as a consequence, the multi functionality that has been assigned to it was disclosed. By revisiting this, one can say that trade marks do have a powerful image attached to them. It involves not only the quality of the product but also it represents an image of fun, adventure, exclusivity and any other good life style that is desired by consumers. Eventually, the recognition of a trade mark can be so high that the mark will sell the product. Hence trade marks are not necessarily associated with experiences of the product as such. While this is clearly a deviation of the effect of trade marks, one cannot turn a blind eye to the situation.

The protection granted to trade marks goes beyond the prevention of consumers' confusion to protecting trade marks' reputation.²⁵ This has been recognised in today's legislation.

Having said that, currently there is a tendency to misunderstand brands and trade marks. Therefore, there is the need to ratify that brands are not the same as trade marks. Whilst brands may use trade marks for identification, they cannot be treated as the same. Branding is the myth, the power that attracts consumers due to strong marketing. It refers to the totality of the image that a product represents. It has been described as "a collection of intangible values as perceived by consumers which are attributed to a name, symbol or design used to identify a product or group of products or services".²⁶

Chemical sense marks can be seen as an attempt, from the manufacturers, to build an image or lifestyle around a product. Businesses spend a lot of money in promoting their goods/services. Nonetheless this is not the historical function of trade marks. Moreover, the fact that businesses spend money advertising their image is not indeed in the public interest.²⁷

While I disagree that the only function of a trade mark is the origin-function, it does not mean that I support the idea that a trade mark's image and/or advertising function alone must be counted as rendering a sign worth of registration. Certainly, the key function of a trade mark is to act as a badge of origin and although I also believe that certain marks do have an image function, but this is, I consider, as a result of the origin function.

The idea is that in order to register a mark, it must be recognised as indicating that the product is the same as others bearing the mark. That said, if we are to register a trade mark which has an image function, such a mark must be distinctive. It has to engender goodwill.²⁸ In that way, the trade mark regime may protect the image of a trade mark alone. However, note that in order to register the said mark (which has an image function), the legislation requires that mark to be distinctive. The Registration Office will not proceed

²⁵ H MacQueen, C Waelde and G Laurie, *Contemporary Intellectual Property, Law and Policy* (Oxford University Press, Oxford 2008), p. 544.

²⁶ *L'Oréal and others v Bellure and others* [2006] EWHC 2355 (Ch) para. 79.

²⁷ Lord Hoffmann's Conference, 'The Function of a Trade Mark - Hugh Laddie and the European Court of Justice' <http://www.ucl.ac.uk/laws/ibil/index.shtml?events_past> viewed on July 2009.

²⁸ Lord Hoffmann's Conference, *op. cit.*

to register a mark which is not distinctive even if it has an image function. Furthermore, if a trade mark does not perform the historical function of the mark, it cannot and must not be registered. In the end, trade mark law is not designed to protect the ‘commercial magnetism’ of the mark in itself.

Yet, the ECJ has made it clear that the trade mark system also protects this advertising and investments function.²⁹ However, as explained before, it is one thing to protect a function of a trade mark and quite another to register a mark because of the investment put into it.

Now, referring to the issue of investment, there are effective ways available to owners of a sign to protect that asset such as passing off and unfair competition.³⁰ For instance, in the *Jif Lemon*³¹ case, the court considered that traders’ interests are deemed to be sufficiently protected by other regimes. The facts of the case protected the claimant’s selling of lemon juice in a yellow plastic lemon shaped container granting a *quia timet* injunction for considering that ‘no man is entitled to steal another’s trader by deceit’.³² Nevertheless, note that this type of tort will not protect the sign as such but the goodwill.³³

To sum up, while there is an incentive to proclaim chemical senses as trade marks, I do not believe that chemical senses alone act as such. In today’s society, the role of smell and taste does not allow chemical senses to work as indicators of source, at least not in the current marketplace; although they may work in branding as part of the image of the product.

7.3 Protection of Chemical Senses: Is It an Overprotection of Intellectual Property Rights?

The emergence of added smell and taste to products has prompted the law respond. In the US for example, courts have protected chemical senses, especially in the pharmaceutical

²⁹ W Cornish and D Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (6th edn Thompson Sweet & Maxwell, London 2007), p. 625.

³⁰ Lord Hoffmann’s Conference, *op. cit.*

³¹ *Reckitt & Colman Products Ltd v Borden Inc and others* [1990] RPC 341.

³² Lord Oliver delivering his speech. *Reckitt & Colman, op. cit.*

³³ Cornish, *op.cit.*, p. 631.

business under Unfair Competition laws. However, as studied in Chapter VI, there has not been any case of trade mark infringement regarding chemical senses.

Here in Europe, chemical senses also have shaking up the law. Perfumes have been protected under Trade Mark law but regarding their marks, not their smell.

The *L'Oréal*³⁴ case is a good illustration. L'ORÉAL owned several UK and CTM word and device trade marks. It claimed that BELLURE had distributed and sold copies of some of its perfumes thus infringing its trade mark and passing off its products as L'ORÉAL's. The products sold by BELLURE had been commissioned to smell like L'ORÉAL's and their packaging had been designed to give a 'wink of an eye to existing branded products'. The court held that smell should not be taken into account when assessing similarity as it was neither the mark nor the sign. It considered that the smell was an important feature of the product but the product as such was not what was at issue in the case of trade mark infringement. In this case what was of concern was the packaging, namely, the box and bottle where some of the products claimed did take unfair advantage of the character or reputation of L'OREAL marks. BELLURE was free-riding and thus taking unfair advantage, amounting to infringement under s 10(3) of the UK Trade Mark Act. However, referring to the smell, the court explained that the smell of a perfume was not protected by the tort of passing off, clarifying that the smell was part of the characteristic of the product. Hence, it can be speculated that the law of passing off may protect a smell if it is not the product.³⁵ For instance, if the trader has goodwill and the other requirements are also fulfilled, an action of passing off may protect chemical sense marks.

There is also another area of law that has protected smells, specifically perfumes. In the Netherlands and France for example, perfumes as fragrances have been protected under copyright. Starting with France, L'ORÉAL and BELLURE were also in dispute.³⁶ As before, L'ORÉAL argued infringement by BELLURE. In this case however, not only trade

³⁴ *L'Oréal SA v Bellure NV, op. cit.*

³⁵ Chemical senses cannot form part of the product. In the case of a smell trade mark, the product's scent needs to be affixed to the product which must have a different primary function other than scenting.

³⁶ *Société Bellure v SA L'Oreal et al, Cour d'appel de Paris, 25 January 2006.* Note that this case confirmed what has been protected early on by lower courts. In 1999 the Tribunal de Commerce de Paris held that perfumes could be protected by copyright as long as they were original; the case concerned the perfume 'Angel' by T. Mugler. The same was decided in 2002 by the Tribunal de Première instance de Paris in a case concerning the perfume 'Le Mâle' by J.P. Gaultier.

mark infringement was sought but also copyright and design right. As in the UK, the court found BELLURE liable for infringement of the claimant's shapes and colours of their packaging and flask for some of their perfumes, some of BELLURE's packaging being either identical or similar to L'ORÉAL's figurative marks (the word marks were different).

Added to this, the court found that BELLURE was liable for unfair competition. The court also held infringement of L'ORÉAL's design right despite BELLURE's claim that the design was not new. This latter argument was not considered since the defendants did not produce any proof of previous designs so as to build the case. Now, regarding copyright it was claimed that protection of a perfume should be granted under this legal system. In the case, BELLURE argued that French Copyright law only protects works accessible to sight or hearing and thus smell and/or taste could not be protected by this intellectual property right. The *Cour d'appel de Paris* observed that Article L 112-2 of the Intellectual Property Code does not have an exhaustive list and so, it does not exclude smells. The court ratified that the Article provides that 'all works of the mind are protected whatever their genre, form of expression, merit or purpose'. As a result, it was held that a fragrance could be protected by copyright as long as it fulfils the requirement of originality.

The case is seen as an attempt by the court to clarify what is to be regarded as original in the perfume industry. It was concluded therefore that 'fragrances are protected if they are the fruit of an original combination of oils in such proportions that their smells reveal the creative contribution of the author'.³⁷

In the Netherlands, the case of look-alike perfumes was no surprise since a similar issue had been dealt with by its own courts. In *Lancôme*³⁸ the perfume TRÉSOR was declared to have an original character of its own, bearing the personal stamp of the maker and therefore, considered to be a work that might be protected under Copyright law.³⁹ Subsequently, examining whether KECOFA infringed the perfume, the court admitted a report which contained *inter alia*, a physical chemical analysis. The judge, when describing the report, went on to explain that both perfumes did have olfactory compounds

³⁷ *Société Bellure v SA L'Oreal et al, Cour d'appel de Paris, op. cit.*

³⁸ *Lancôme Parfums et Beaute et Cie SNC v Kekofa BV*, Case C0200726/MA, Court of Appeal, Den Bosh, The Netherlands, Hof (NL), 8 June 2004. Reported in English at [2005] ECDR 5.

³⁹ *ibid.*, H6.

in common either in an identical manner or in the form of a substitute.⁴⁰ It then relied on mathematic probabilities comparing the case to winning the lotto.⁴¹ By this analysis the court concluded that KECOFA had indeed reproduced the perfume TRÉSOR thus infringing LANCÔME's copyright.⁴²

Note that only these two countries have granted copyright to perfumes. The UK for instance, might not follow this approach since the law of copyright requires the work to be fixed in order to be protected, the so-called fixation.⁴³ The importance of these cases to trade marks lies in the fact that the court relied on sensory and physico-chemical analysis of the alleged infringing perfumes. It also relied on surveys of members of the public to ascertain the similarity of the perfumes. It can therefore be speculated that the admittance of chromatographic evidence may be a potential objective prove. Considering this, in the near future one can expect the acceptance of this method as graphical representation as well as when examining the question of infringement. If so, the subjectivity of the mark will become scientifically objective. Hence, the premise that the subjective nature of chemical senses makes this type of mark lack distinctiveness, will no longer exist.

In closing, one has to bear in mind that these other forms of protection have their own peculiarities. For instance, with other intellectual property rights such as design, patent and/or copyright, the trader protects his rights for limited periods of time. By contrast, trade marks if renewed, can last forever. In the same line, other forms of protection such as passing off and unfair competition claims will require proving deceptiveness and this is confidently, narrower than the protection granted to registered trade marks. Indeed, keeping this in mind there is a clear understanding why undertakings are looking forward to protecting chemical sense marks under the trade mark system. In the end, they are looking to secure the exclusivity of the mark.

On one hand intellectual property rights are never said to be overprotected by manufacturers who are gaining the benefits. The decisions followed by the court in France and The Netherlands regarding the protection of perfumes by copyright are to be

⁴⁰ *Lancôme Parfums et Beauté et Cie SNC*, para. 29.

⁴¹ *ibid.*

⁴² *ibid.*, para. 31.

⁴³ E Derclaye, 'One of the Nose of Bellure: French Appellate Court Confirms that Perfumes are Copyright Protected' (2006) 6 *Journal of Intellectual Property Law & Practice* 377.

welcomed. These decisions certainly have protected the creation of a perfume as an author's rights. Nonetheless, whether this has been a step too far or even the right path, must be questioned. On the other hand, others can see how the market is being strangled due to monopolist operators. It is therefore important to remember that to grant a particular company an exclusive right to the use of a particular sign must not indeed obstruct the ability of rival companies to compete.⁴⁴ The key aim of the Directive is to promote competition.

7.4 Adaptation to Social Change, Is It Wise?

Advertising campaigns to promote smell and taste do target life style.⁴⁵ It is believed that an aroma works as an indicator of a product's ability to deliver benefits.⁴⁶ Certainly, it can be observed that marketers regard smell and taste not as a novelty issue but as a good method of promoting sales. However, in spite of the commercial value, smell and taste are not well protected under the law. Here then, we find the link with the first chapters of the present work, namely, the evolution of signs, the function of trade marks and the reason for their protection and the need for registration. By studying these, it is noted that there is indeed a rationale for protection.

The cost of maintaining trade marks is not justified if trade mark owners are not protected. Otherwise, competitors could reproduce the smell and taste of a particularly successful product. Thus, if a particular smell is created for and becomes identified with a product, it is important for the producer to secure it so as to stop others from using it. This practice of imitation is observed in recent cases regarding knock-off fragrances. Therefore, a potential threat to smell marks can be seen. Yet, these cases of infringement have been dealt with under Copyright law and Unfair Competition laws, so it is speculated that chemical senses, if indicative of origin, will only be protected under passing off and/or Unfair Competition law (if not previously registered).

One may question whether after all, chemical senses do work as trade marks. Then, approaching this question it may be said that apart from the fact that chemical senses are

⁴⁴ Refer to section The Need to Keep Free.

⁴⁵ Classen, *op. cit.*, p. 182.

⁴⁶ *ibid.*, p. 192.

subjective they do present two other major issues: first, consumers do not rely heavily on olfactory and taste information in their daily lives because they are considered as product ornamentation and/or functional rather than an indicator of product source;⁴⁷ and second, no one knows how to begin indentifying and classifying all the possible olfactory and taste stimuli.⁴⁸

Additionally, the difficulties that smell and taste have when intending to work as trade marks are overshadowed by the complexity of enforcing. That said, if chemical senses manage to work as trade marks because they indicate source, their protection becomes problematic to enforce. The reason is that, as mentioned early in this chapter, chemical senses nature is subjective and therefore legal analysis can vary.⁴⁹ The subjectivity assessment in determining the similarity of chemical senses will be indeed difficult. I therefore believe that while Trade Mark law allows the registration of chemical sense marks, it is not yet suited to give the protection that they need.

⁴⁷ Elias, *op. cit.*, p. 477.

⁴⁸ Ludel, *op. cit.*, p. 360.

⁴⁹ Elias, *op. cit.*, p. 475.

CONCLUSION

Carrying out the task of researching in chemical sense marks, for the most part, an unexplored area of judicial debate, has provided a number of interesting ideas and suggestions which I hope will contribute to simplifying the chemical sense marks arguments. The most important conclusions for this thesis are as follows:

First, it is a fact that chemical senses have developed in the market to become 'signs'. As history reveals, different signs and marks have been witnessed over time due to changes in commerce and marketing. From symbols to signs, and from social to legal instruments, the development of marks has undergone different transformations. This can be observed for example in cases where marks symbolised ownership (*i.e.* shipwreck and branding on animals), or where they guaranteed quality or product authenticity (*i.e.* hallmarks and silversmiths), or where they just followed a pattern from the trade as in the Industrial Revolution. It is arguable therefore, that in today's market producers and consumers are aware of a variety of trade marks. What is more, with the introduction of new technologies like radio, TV and so on, the visual and sound receptiveness has evolved and so have marks. As a result, the usual trade mark patterns is once more being extended and we as consumers see more marks that are not common. The question is, how familiar are we, as consumers, with the fact that trade marks indicate that a product comes from a certain undertaking and not another?

Facts reveal that marks, and specifically trade marks, appear to have a variety of functions. They represent not only quality and/or origin but also they are indeed a company's assets -- economic function. Added to this is the consumers' fascination with becoming connected to a famous figure or just being in fashion. Throughout this work, I projected that trade marks are being misunderstood by many consumers as being more of a tool of fashion or a style of living. Facts reveal that marks, and specifically trade marks, appear to have a variety of functions. Certainly, by this deviation it has become more difficult to determine if these new types of marks, chemical senses, are truly trade marks. This is due to the fact that chemical sense marks can be seen as part of the image of a product and also as a marketing tool.

Bearing this in mind, trade marks do not have a unique function in today's markets but a few different functions. Yet when registration is sought for a trade mark there is, it appears, only one function that the trade mark has to accomplish -- the origin function. By doing so, a trade mark will, in most cases, achieve the fundamental purpose of a trade mark -- to distinguish goods/services of one undertaking from those of other undertakings.

Secondly, in order to protect trade marks and therefore preventing others from using the mark or a similar one, traders may register a sign as a trade mark. If registered a trade mark will grant a monopoly over the use of that particular sign for only specified goods/services in one or more classes of goods/services. Protection as said is by registration which is obtained through an application at the Trade Mark Office (application can be for a national, community or international trade mark). National trade marks systems are harmonised by the trade marks Directive but they continue to be a separate systems. Therefore, while I mainly centre the discussions on CTMs, the same principles apply to national registrations.

Third, focusing more on what the legislation has to say about chemical senses and therefore facing the issue of whether or not legislation recognises chemical senses as signs that can be protected under the trade mark regime, it is not surprising that the EU legislation as well as the US (as many others), do cover these unconventional marks. However, the EU legislation does not specifically mention chemical senses as potential marks. Despite that, it would not necessarily be correct to believe that they are not included.

It appears that legislation is open to any sign and in consequence not discriminatory. This argument therefore allows chemical sense marks as potential trade marks. Moreover, not only is this implicit in the legislation, it is also the recognised practice. Chemical senses have actually been registered in some European countries. This leads us to the conclusion that chemical senses can be regarded as marks under the law and consequently, protected under the trade mark regime.

Nonetheless, while changes in trade mark legislation have paved the way for the registration of chemical senses eventually flows have emerged. The thorny question to answer will be: is it the law or the practice?

Fourth, the requirements for registrability are identical through the European Union. Thus, I observe that as for any other trade mark, chemical senses are subject to a significant number of requirements. One of the most discussed in the area of chemical senses has been, without doubt, 'graphical representation'. The reason lies in the fact that because of the nature of chemical senses (non-visual), it is impossible for them to be represented in this way. This is not however necessarily correct since other non-visual marks are able to be registered and thus have satisfied this requirement *i.e.* sound marks can be graphically represented by way of a score.

As mentioned throughout this work, chemical sense marks did have a good start -- registration was seen in different EU jurisdictions. The graphical representation requirement was in those cases, fulfilled by a detailed description. Nevertheless, after the *Sieckmann* case, a number of potential graphical representations, such as a chemical formula, a sample and/or descriptions, were submitted but they were not accepted on the grounds that they either represented the chemical sense rather than the sign and/or were unclear and subjective. Therefore, today's concern is to find and adopt a reliable method of representation for these types of marks. As simple as it sounds, the work has not been done and appears to be full of controversy.

The requirement of graphical representation requires that the sign be represented. The odour communication system that represents odour appears to do so by 'e-noses'. There are different devices; some appear too complicated since the digital format used by the process is a compound which is used for analytical chemistry purposes. Trained operators are needed to understand them. Nonetheless, there are others which are more user-friendly. Indeed, while e-noses appear to be a novel technique for us, there are types that are commonly used in the food and medical industry as well as other industries. Moreover, e-noses have been recently used in the courts of France in cases of infringement, and I believe therefore that this type of communication system is a reasonable start. E-noses do represent adequately the sense of a smell.

Fifth, distinctiveness is a requirement which has its own particular problem. Yet the majority of cases examined by the Registries and/or courts, when presented with a chemical sense, do not seem to have explored this issue in depth. The distinctiveness of a mark goes together with the primary function of a mark -- origin function. The problem is that chemical senses are not easily interpreted by consumers as indicators of origin. The way that chemical senses have been presented to consumers (marketing tools), and moreover, the way they are commonly used (to appeal and/or disguise a bad taste or odour), suggests they lack distinctiveness *ab initio*.

Certainly, a mark must be capable of identifying a product thus indicating that the product comes from a particular source; therefore, if consumers do not perceive this, the mark is not inherently distinctive. There is however a small market in which chemical senses may be distinctive. For example, a mark could be considered distinctive in situations where the specification to which the mark relates is quite narrow.

It is also important to remember that a mark can acquire distinctiveness through use and thus lack of distinctiveness can be overcome. I do not doubt that by familiarising the relevant public over a period of time, and following intensive advertising and sales campaigns, this proviso can work for chemical senses. In the end, the distinctiveness assessment in the context of registration requires the relevant consumer to perceive the sign as a trade mark. Therefore, if a Registry or a court considers that according to an 'overall assessment' the mark has come to identify the product concerned as originating from a particular source, then the mark has acquired distinctiveness through use.

Sixth, albeit there is not to date a single trade mark case in the EU which has raised the issue of functionality other than with respect to shape marks, I believe that chemical senses do not escape controversy in this field. It has been ascertained that functionality must in principle be extended to cover all marks and not only those that have a technical function. Looking at the broad spectrum, technical should be understood as not only mechanical but involving other types of functionality as in the US. The reason being that this exclusion is intended to ensure effective competition as a matter of public policy.

Thus, it is controversial that the principle of functionality is not extended to other types of marks. In the end, in many situations chemical senses provide an aesthetic function and/or add value to the goods. For instance, a smell or taste can be seen as making the product fanciful, or decorative. Quite apart from the fact that this will mean that the sign is not a proper trade mark because it will not be perceived as such - it is not capable of distinguishing - it will indeed mean that the sign has a technical and/or aesthetic functionality.

Seventh, infringement, while outside the main purpose of the thesis, cannot escape consideration. The registration of smell and taste marks is not totally effective if the law cannot ensure protection. Without a doubt, the consideration of infringement affects the correct functioning of chemical sense marks. One can expect that a case of a chemical sense mark infringement will be resolved using the same test and approach as with any other type of mark. This logic is apparent in many cases in which the court emphasise that all types of trade marks should be measured and examined in the same way.

However, addressing the similarities between chemical sense marks seems to be more problematic when comparing conventional marks. The task of making comparisons when assessing infringement can be extremely challenging for judges when chemical sense marks are at issue. For example, by applying a global appreciation test, the 'aural and visual' examination is obviously void. Therefore, only a conceptual similarity can be assessed. Evidently, this is not enough and so, to this test, the 'smell and taste' examinations needs to be added.

Currently, to conduct a proper assessment, judges need to rely on the graphical representation and thus we appear to be back at square one. There is not a reliable graphical representation for chemical senses. Yet, I believe that e-noses communication, although considered as an external source, can be a convenient an objective test. At the end of the day, assessing colour marks and sound marks also requires external sources. Hence, we can work on the assumption that e-noses as an external sources will not be a problem either.

Finally, having observed all of the above, the question is: what is left for chemical sense marks? Certainly, one might think that this research challenges the validity of these types of marks, but on the contrary, I believe that chemical sense marks are, in limited situations, able to act and function as trade marks. The point is that, sooner rather than later, measures need to be in place going beyond graphical representation. Legislation needs to accommodate chemical sense marks as it has in the case of shape marks and sound marks.

The difficulty remains though that the problem of chemical sense as marks is still unresolved. This situation, in my personal opinion, is for the most part due to their complexity and technicality. Until now, we have seen how consumers, academics and judges, to name a few, have a long way to go in understanding and interpreting them. It is therefore the right time to start believing in chemical senses as trade marks. Hence, it is necessary to build a path for them. By doing this, chemical sense marks could be assessed by their real significance and not merely by good marketing.

The true aim is simply to give guidance to whoever would like to commence in using chemical senses as marks of commerce. While I declare that my ideas may be wrong, what is of importance is that these ideas will help others to develop good or better ones.

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