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The registration of non-traditional trademarks from a British perspective

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Abstract:

One of the main goals of the registration process is to specify which signs are protected in which commercial domains. This reduces the likelihood of disputes and provides trademark owners with greater certainty [1]. **With the continuous development of marketing tactics, unique scents, shapes, colours, and even smells associated with products are increasingly used in marketing campaigns to distinctively represent products. This reality has sparked many debates on what could be considered a trademark and the development path for the registration system. From a doctrinal viewpoint in the United Kingdom (UK), this paper delves into the issues facing different types of non-traditional marks, including smell marks, sound marks, colour marks, and taste marks, by examining the relevant legal provisions and related cases for each type of mark. In conclusion, although the allowances for the registration of such trademarks can be problematic, mainly due to the requirements for representation and distinctiveness, there is hope that non-traditional marks could be accepted in the near future. This is due to contemporary developments in methods of representation, such as the internationally recognised Pantone colour system, and recent changes to the representation requirement brought about by the EU Directive 2015/2436.**

Keywords: **distinctiveness, intellectual property, non-traditional trademarks, representation methods, United Kingdom perspective.**

Classification numbers: **2.2, 5.2, 6**

1. One aim for the registration of trademarks is to ensure that the authorities, competitors and the public know what is being claimed as a mark

It should come as no surprise that the main goal of the registration process is to specify which signs are protected and in which commercial domains. This not only verifies what is being claimed as a mark but also fosters consumer confidence and prevents confusion by removing any doubt regarding the origin of goods sold under a trademark [2].

With the rapid development of marketing tactics and the persistent need for companies to continually advance the quality of their products, businesses today do not rely solely on traditional types of trademarks like fanciful, suggestive, or descriptive trademarks for the identification of their products and services. Nowadays, unique characteristics associated with products are increasingly used in marketing campaigns and sales to distinctively represent products, setting them apart from competitors. To some, the need for using non-traditional trademarks arises because market-savvy companies want to design and advertise their products in a manner that appeals to the consumer's aesthetic sense [2]. In a future legal system where non-traditional trademarks are registrable and widely accepted, is it still true that the aim of trademark registration is to ensure society knows what is being claimed as a mark?

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In response, yes, the registration of non-traditional trademarks is consistent with this aim of trademark registration in general. However, this is not entirely true, as the allowances for the registration of such trademarks can be problematic, particularly concerning the requirements of representation and distinctiveness. For some non-traditional trademarks, like taste and odour marks, it is nearly impossible to find a representation that can accurately and completely capture the full experience of the marks for the majority of the public, even with the changes to the representation requirement brought about by the EU Directive 2015/2436, as each person's experience with these kinds of marks is subjective in nature. Discussion regarding this legal instrument will be addressed below.

Certain non-traditional marks, like colour or sound, might not be as obvious or immediately recognisable. This could make it difficult to notify other parties about the precise elements being claimed in a clear and noticeable way. For instance, in a case involving an attempt to register the use of the colours blue and yellow together on packaging[1]. The Court of Justice of the European Union ruled that although a colour might be a sign, it is not always so; in many cases, colour is just an attribute or feature of an object. According to the Court, an applicant for a colour mark must demonstrate that the colour in question is regarded as a "sign" by consumers, to prevent trademark law from being used by one trader to gain an unfair advantage over competitors. The approval for the registration of colour trademarks is likely to provoke debates over fairness, as colours, especially basic ones, are limited, and the number of companies using colours to identify their products or services is limitless, as this occurs in almost every existing company today in Europe and worldwide. The matter can be more serious as trademark protection can be renewed every ten years; in other words, protection can last indefinitely. Some may argue that with the internationally recognised Pantone colour system, which consists of 2,161 colours, the number of combinations that could be derived from them would be almost indefinite. However, even though the colour system offers many colours, the author must consider that not all are recognisable as different to the average consumer.

Furthermore, if a non-traditional mark deviates from accepted verbal or visual representations, it might require more effort to prove its distinctiveness. More thorough evidence, such as customer surveys, may be needed to establish and preserve the uniqueness of non-traditional marks and demonstrate the connection between the mark and the providers of goods or services.

2. What are non-traditional trademarks?

Previously, under the EU Trade Mark Regulations 2009, a sign had to be capable of being presented graphically, and it had to be clear, precise, self-contained, easily accessible, intelligible, durable, objective, distinctive, and not deprive the trade or the public of signs that the directive or regulation implies should be free to all[2]. In 2015, the introduction of Directive (EU) 2015/2436 removed the requirement for graphical representation, allowing for 'non-traditional' marks such as sound marks, three-dimensional shapes, or colours to be more easily registered. The requirement of being 'graphically presentable' was replaced with broader wording, permitting signs to be registered "in any appropriate form using generally available technology".

[1]Heidelberger Bauchemie (Case C-49/02) (2004), ECR I-6152.

[2]Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark [1993] OJ L 11/1.

Paragraph 10 of the Directive nonetheless retains requirements on precision by stating that the representation "must be clear, precise, self-contained, easily accessible, intelligible, durable and objective".

In the UK, the Trade Marks Act 1994 liberalised the definition of marks, opening the floodgates for non-traditional marks to be considered for registration, such as sounds, shapes, colours, holograms, and gestures [1]. Since graphical representation was more problematic, the requirement has shifted to 'represented in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor', in harmonisation with Directive 2015/2436.

Specifically, the UK Trade Marks Act (as amended) in section 1(1) defines trademarks as 'Any sign which is capable: (a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and (b) of distinguishing goods or services of one undertaking from those of other undertakings. With the wording of section 1, Trade Mark Act 1994 (as amended), non-traditional trademarks can include an endless list of any signs that fit into the prescription of section 1. However, sound, colours, odours, shapes, and taste marks stand out as the most common types of trademarks referred to [2].

3. The registration of trademarks and the Sieckmann criteria

The issue of trademark registrability is not new; throughout Europe, scholarly publications from the 19th century have consistently discussed whether single colours and three-dimensional shapes should be protected as trademarks. Court rulings pertaining to three-dimensional shapes and the colour blue on envelopes date back to the same period in European history [3].

In the history of the formation of international Intellectual Property treaties, a clear definition of trademarks is also absent. During the debate following the adoption of the Paris Convention, the parties were unable to reach a consensus on the definition of a trademark. Additionally, the International Association for the Protection of Intellectual Property concluded in 1957 that it was not appropriate to include a definition of trademarks in the Union convention given the circumstances at the time, in response to the Congress of Washington's discussion revising the Paris Convention. This was not the first time the subject had been considered, as it had also been on the agenda for the 1952 Vienna summit. Even for the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) in 1994, the provision of Article 15(1) is broad regarding the nature of signs that can constitute a trademark[3] [3].

Given such circumstances, it is fair to say that even though non-traditional trademarks such as sound, odour, or colour marks have never been officially accepted by any jurisdictions, there is room for them in the legal systems of the world. To be legally regarded as a trademark, the subjects only need to satisfy the requirements that could constitute a mark in general.

In England today, according to section 32 of the Trade Mark Act 1994, an application for a trademark must contain:

[3]TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights 1994, Art 15(1).

(1) A request for registration, including the name and address of the applicant;

(2) A statement of the goods or services for which the mark is to be registered;

(3) A representation of the mark 1994;

(4) A declaration that the mark is being used or that there is a bona fide intention to use the mark.

To obtain a filing date, requirements (1) through (3) must be met, which means that an adequate representation of the mark is required. This demonstrates that the idea of "representative registration" serves as the foundation for the trademark system [4].

In the well-known case regarding 'representation' of *Sieckmann*[4], what was then 'graphical representations', was required to be 'clear, precise, self-contained, easily accessible, intelligible, durable, and objective', this is also only referred to as the 'Sieckmann criteria'.

Nowadays, while 'graphical' is no longer the only mode of representation, the Sieckmann criteria were incorporated into the Directive 2015/2436 and continue to be relevant when assessing other modes of representation [1].

3.1. Smell marks

On the *Sieckmann*[5] case, the European Court of Justice (ECJ), while examining whether a 'balsamically fruity smell with a slight hint of cinnamon' was registrable, concluded that, at the time in 2002, odours could not be represented graphically in accordance with legal requirements, and thus could not be considered trademarks under Article 2. The ECJ also expressed scepticism about the accuracy of the description provided in identifying the smell's unique characteristics. It also stated that a chemical formula or the deposit of a sample would frequently not be sufficient for registration, nor would a simple description of the smell.

A basic question that arises when discussing cases involving odour marks is whether a certain smell is consistently the same at all times and if an average person can distinguish between the differences in smell under varying circumstances. Natural elements such as wind, humidity, and temperature can all contribute to increasing or decreasing a scent's potency. In the case of *Dyson Ltd v. Registrar of Trade Marks*[6], the Court's reasoning suggests that subject matter will not constitute a sign when it is (i) an impermissible abstraction, as a mental concept capable of manifesting in different ways; and (ii) the concept has a purpose (in this case, technical) such that recognising exclusive rights through trademark law will bestow an unfair competitive advantage upon the applicant. It is evident that the first of these rationales overlaps with the *Sieckmann* representation requirements, emphasising clarity and precision[7].

However, the argument that all sensory perceptions are subjective, including sound, taste, and colour, is rather arbitrary, as the statement itself is subjective in nature. This presses the inquiry of how far apart individuals can experience the outer world and what is the universal way to describe a certain subjective feeling. Thus, for all practical purposes, it is almost impossible to register olfactory marks in Europe as of now until further advances are made in technology to graphically represent smells.

[4]Ralf Sieckmann v. Deutsches Patent-und Markenamt (Case C-273/00) (2002), ECR I-11754, EUR-Lex - 62000CJ0273 - EN - EUR-Lex (europa.eu).

[5]Ralf Sieckmann v. Deutsches Patent-und Markenamt (Case C-273/00) (2002), ECR I-11754, EUR-Lex - 62000CJ0273 - EN - EUR-Lex (europa.eu).

[6]Dyson Ltd v. Registrar of Trade Marks (Case C-321/03) (2007), EUR-Lex - 62003CJ0321 - EN - EUR-Lex (europa.eu).

[7]Ibid; Trade Marks Act 1994, s 1(1)(a).

Considering that most scents are not separate chemical compounds but mixtures that are so complex, accurate analysis of their components is not only very expensive but also hardly possible at the current level of scientific development.

Generally speaking, the ability to analyse human tastes stops at sour, spicy, salty, and sweet. In special cases, such as when the taste of MSG, which is used as a flavour enhancer through a combination of sour, spicy, salty, sweet, and smells of various food sources, is considered, it would be incredibly difficult to determine whether such marks are registrable. Further, proving that consumers perceive a particular scent as a source-indicating trademark rather than merely an appealing feature of the goods or services is a difficult task [5].

In the case of *R v John Lewis*[8], the UK Court refused an application for 'the smell, aroma or essence of cinnamon' as a trademark for furniture, as the verbal description of a smell was not enough to make a graphical representation. However, the case might have been different if this had been done with reference to certain standards.

Thanks to the liberalisation of the law, starting from 2015, regarding the way trademarks are to be represented, the door of possibility has been opened, though not fully, for more odour marks to be considered registrable in the future.

In the long history of the trademark registration system, successful cases of odour trademarks are very limited in number. Only two cases have been recorded in the UK [6], regarding a 'strong smell of bitter beer applied to flights for darts' and 'a floral fragrance that is reminiscent of roses applied to road vehicle tyres'. In the EU, the 'smell of fresh cut grass' for tennis balls [7] has been a trademark.

Internationally, neither TRIPS nor EC Directives address protection for scent marks. Some countries like Australia, France, and Germany do not prevent such kinds of registration, leaving the options open. However, in other jurisdictions like Mexico, South Korea, Brazil, Japan, India, etc., scent marks are neither registrable nor have the courts considered protection of scent marks under the intellectual property rights regime [8]. This can pose many challenges for businesses seeking international protection for their odour trademarks.

3.2. Sound marks

Sound marks can be considered to be composed of unique sounds, for example a piece of classical music, and common sounds, such as a cockcrow.

Before the liberalisation of the law, in the *Shield Mark*[9] case in 2003, the ECJ determined that while sound marks could be registered, they needed to meet certain requirements, including graphical representation and distinctiveness. It stated that musical notation, onomatopoeia, and written descriptions of sounds were insufficient. However, in this particular case, the Court did not specify suitable modes of representation for the sound of a cockcrow or any other sound, leaving it to nations to determine their specific requirements. Whatever the form of representation, the Court made it clear that it must be objective, self-contained, comprehensible, clear, durable, and easily accessible.

According to the EUIPO guidelines in part B [9], section 2, chapter 9(3)(7), a sound mark is defined as a trademark consisting exclusively of a sound or combination of sounds. Therefore, trademarks

[8]R v John Lewis (1857), 169 E.R. 1026, R v John Lewis - Case Law - VLEX 805636977.

[9]Shield Mark BV v Joost Kist (Case C-283/01) (1857), CURIA - List of results (europa.eu).

combining sounds with, for example, movement do not qualify as sound marks per se and should be applied for as multimedia marks. A sound mark must be represented by submitting either an audio file reproducing the sound or an accurate representation of the sound in musical notation. The audio file must be in MP3 format and its size cannot exceed two megabytes. Office requirements do not allow the sound to stream or loop. Audio files are currently not considered acceptable mark representations under the International Trademarks System, or the Madrid System. Musical notations may be submitted in one single JPEG file or on one single A4 sheet. 'Accurate musical notation' means that the representation must include all the elements necessary for interpreting the melody, that is to say, pitch, tempo, lyrics (if any), etc.

The 1994 UK Trade Marks Act in Section 103(2) does not expressly list sound marks as registrable trademarks or exclude them as non-registrable. The existence of sound marks is made possible because the Act permits a trademark to be represented in ways other than through graphical representation. Thus, the burden of proof to establish the registrability of a specific sound mark rests fully with the applicant.

3.3. Colour marks

It is not problematic to recognise a combination of colours as marks because it has been clearly acknowledged as unique on its own in legislations and cases[10]. The subject matter is however still exclusively limited and debatable to cases involving the use of a single colour.

In the *Libertel* case[11], the ECJ discussed this matter. Even though the Court rejected the deposition of a single sample of a colour, it did state that in some situations, a verbal description might be sufficient. For the first time, the Pantone code, as an internationally recognised colour identification system, was acknowledged by the Court in this case.

Furthermore, a requirement for prior use emerged since the Court established the requirement of distinctiveness for colour marks. It follows that three criteria must be met for a colour to qualify as a trademark: functionality, source indication, and distinctiveness [5].

3.4. Taste marks

In comparison, regarding the experiences that one might have on the mark, taste marks are rather similar to odour marks. It could be said, in many cases, the tastes of edibles are concentrated experiences of smelling their odours. In other words, to a certain degree, taste marks belong to another form of marks, a more concentrated form of odour marks.

Functionality is a significant barrier to the enforcement of flavour marks because it must be accessible to all competitors. Because various manufacturers use the same flavours frequently, they may also be considered generic. Only flavours that are greatly unusual, like peanut butter or caramel added to a toothbrush, would be more likely to be protected than doing the same thing for food such as cookies or bread [5]. In *Eli Lilly's*[12] case, the Board discussed and ultimately came to no decision regarding the representation of taste marks.

[10]Smith Kline and French Laboratories Ltd v Sterling Winthrop Group (1975), 2 All E R 578, Smith, Kline & French v. Sterling Winthrop, 1975.

[11]Libertel Groep BV v Benelux-Merkenbureau (Case C-104/01) (2003), ECR I-3822, CURIA - List of results (europa.eu).

[12]Eli Lilly and Company v Actavis UK Limited and others (2017), UKSC 48, https://www.supremecourt.uk/cases/uksc-2015-0181.html.

According to the EUIPO guidelines [9] in part B, section 4, chapter 2(9)(3), it is currently not possible to represent a taste in compliance with Article 4 EUTMR[13] as Article 3(9) EUTMIR[14] specifically excludes the filing of samples and the subject matter of protection cannot be determined with clarity and precision with generally available technology.

There have been arguments that technological developments regarding representative methods of taste, such as taste profiles and spider diagrams [10], which allow flavours to be presented more objectively and precisely, have paved the way for a future where taste trademarks are a reality.

4. Recommendations for Vietnam

Through discussions and examinations of relevant legal provisions on the issues facing different types of non-traditional marks, including smell marks, sound marks, colour marks, and taste, the Author has found that there is significant potential for Vietnamese IP Law to reference and develop.

With the abolishment of the requirement for graphical representation, the law could take the next step in recognising non-traditional trademarks, even though such recognition could prove problematic, even in the UK and Europe. Nevertheless, the issue for Vietnamese IP Law does not lie in whether non-traditional marks are legally recognised, but rather whether non-traditional marks and modes of recognition for them are being researched. In other words, it is the pace of legal research that should be examined, as applicable research on this topic in Vietnam is currently rather scarce.

It is arguable that the recognition of non-traditional trademarks would increase the level of protection for trademarks, potentially negatively impacting the economy of Vietnam, as overprotection for IP could harm developing nations. However, it is the alterations of Vietnamese law that are under discussion, not those of more developed foreign Western nations. Hence, apart from increasing the level of protection for Vietnamese products, which is greatly beneficial for the Vietnamese economy, such alterations that could bring us closer to the recognition of non-traditional trademarks would not restrict the free use of foreign trademarks by Vietnamese companies. Therefore, if this cutting-edge issue of trademarks could be further explored, provided that research papers propose more practical solutions, such research could prove to bring Vietnam more benefits than drawbacks.

5. Conclusions

In conclusion, it is appropriate to consider that the primary aim of the registration system is to notify society of what is being claimed as a trademark. This aim can be true, but perhaps not absolute, for the registration of non-traditional trademarks, as it could prove problematic concerning the requirement of representation and distinctiveness.

Internationally, the world is on the path of opening up to the registration of non-traditional trademarks, as the only international agreement which directly excluded the protection of non-traditional trademarks is the Trademark Law Treaty 1994. As indicated in Article (2)(1)(b): “This Treaty shall not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks”.

In the UK and the EU, thanks to the introduction of the Directive (EU) 2015/2436, the greatest hindrance to the application of non-traditional

[13]Council Regulation (EC) No 207/2009 of 26 February 2009, Art 4.

[14]Commission Implementing Regulation (EU) 2018/626 of 5 March 2018, Art 3(9).

trademarks, namely the requirement of graphical representation, was removed. Even though the floodgate is still not entirely open, and there are still numerous challenges facing the registration of non-traditional trademarks, it is fairly safe to expect that there will be more non-traditional marks entering the market and being recognised as registrable trademarks in the UK and the EU. The European Courts have adopted a strict test for trademark representation, despite attempts to broaden the scope of trademark types. This is due to the *Sieckmann*[15] approach. Although this is very helpful in preventing disputes regarding the registrability of non-traditional trademarks, it may exclude cases where the expansion of the consumer base and business competition utilises such marks [11].

COMPETING INTERESTS

The author declares that there is no conflict of interest regarding the publication of this article.

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