

ABSOLUTE GROUNDS FOR THE REFUSAL OF REGISTRATION

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What do you think of...?



(WBV)



What does this tell you?



...and this?



How about this?



...and this?



WHAT ARE TRADE MARKS?

- Origin function BUT do we care about origin per se?
- Quality guarantee function – but not absolute guarantee, quality can be varied
- Advertising – communicate image of product , image created by investment
- Communication and investment functions

WHAT ARE TRADE MARKS?

- s.1(1) Trade Marks Act – TM = any sign capable of being represented graphically which is capable of distinguishing the goods of one undertaking from those of other undertakings

THE REQUIREMENTS UNDER THE ACT

- Trade Marks Act 1994
- Marks MUST be registered unless...
- S.3(1)(a) not a sign, not capable of graphical representation
- S.3(1)(b) devoid of distinctive character
- S.3(1)(c) descriptive
- S.3(1)(d) generic
- S.3(2) functional
- S.5 conflicts with another's marks/rights (next week)

**LACK OF GRAPHICAL
REPRESENTATION**

WHY A GRAPHICAL REPRESENTATION REQUIREMENT?

- Enable authorities to examine marks properly
- Enable other economic operators to avoid infringing
- Mark must be unambiguous to act as an indication of origin
→ Can't be subjective
- Particular problem for non-traditional marks, esp non-visual marks
- Same rules apply to all kinds of marks (in principle at least)

SIECKMANN

- $C_6H_5-CH = CHCOOCH_3$
- “balsamic, fruity, with a hint of cinnamon”
- Sample



SIECKMANN

- A trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that **the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.**

SIECKMANN

- Scents registrable in principle but...
- Chemical formula – not objective and represents substance itself, not its odour
- Sample – not graphic, not stable or durable
- Description in words – graphic, but not clear, precise and objective
- A combination of the three won't be clear and precise enough
- *Eden Sarl* – 'smell of ripe strawberries'

SOUNDS: SHIELD MARK

- ‘The first nine notes of Fur Elise’
- Sequence of letters
- Stave

<http://www.youtube.com/>

FÜR ELISE

LUDWIG VAN BEETHOVEN
K. WoO 59

Poco moto

The image displays a musical score for the first nine notes of 'Für Elise' by Ludwig van Beethoven. The score is in 3/8 time and begins with a piano (p) dynamic. The first system shows the first four measures, and the second system shows the next five measures, including a first and second ending. Fingerings are indicated by numbers 1-5 above or below notes. The bass line consists of a simple accompaniment pattern.

SHIELD MARK

- 'Kukelekuuuuu'
- 'A cockcrow'



SHIELD MARK

- Directive doesn't preclude sound marks from registration, so Member States can't either BUT *Sieckmann* rules apply.
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- Must expressly state that it's a sound sign
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- Description in words often lacks objectivity
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- Onomatopoeia – lack of consistency between way it is written and the actual sound; varies depending on where you come from
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- Musical notes in letters: neither clear, nor precise nor self-contained, does not make it possible, in particular, to determine the **pitch and the duration** of the sounds forming the melody in respect of which registration is sought and which constitute essential parameters for the purposes of knowing the melody and, accordingly, of defining the trade mark itself.
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- Musical stave – 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**. This mode of graphical representation of the sounds meets the requirements of the case-law of the Court that such representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.
- NOW DECISION No EX-05-3 OF THE PRESIDENT OF THE OFFICE of 10 October 2005 concerning electronic filing of sound marks – OHIM accepts MP3s as representations of sound marks.

SHIELD MARK

- Description in words often lacks objectivity
- **Onematopeia** – lack of consistency between way it is written and the actual sound; varies depending on where you come from
- **Musical notes in letters:** neither clear, nor precise nor self-contained, does not make it possible, in particular, to determine the **pitch and the duration** of the sounds forming the melody.
- Musical stave – 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** → ACCEPTABLE 😊
- NOW DECISION No EX-05-3 OF THE PRESIDENT OF THE OFFICE of 10 October 2005 concerning electronic filing of sound marks – OHIM accepts MP3s as representations of sound marks.

LIBERTEL



LIBERTEL

- Colour orange: sample and word 'orange' for telecommunication services.
- No problem with its being graphic, but is a problem with objectivity and durability.
- *Sieckmann* criteria apply.
- Sample itself – not durable.
- Description in words – may not be clear, precise
- Sample + description – might, in some circumstances meet requirements BUT supplementing with an internationally recognised colour code, e.g. Pantone number, will meet requirements because precise and stable.

PANTONE



THE FUTURE?

- Proposed new Article 3 TMD (replacing the old Article 2)
- “A trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours [...], the shape of goods or of their packaging, or sounds, provided that such signs are capable of:
 - (a) distinguishing the goods or services of one undertaking from those of other undertakings and
 - (b) being represented on the register in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.”

REMEMBER...

- ...graphical representation is the first hurdle
- Non-traditional marks will often also be lacking in distinctiveness

DISTINCTIVENESS & DESCRIPTIVENESS

BASIC APPROACH

- Must always ask in relation to which goods
- Through eyes of average consumer of goods in question who is reasonably well-informed, reasonably observant, circumspect
- (b), (c) and (d) independent from each other (but do overlap)

UNDERLYING POLICY

- Together they do two things:
 - S3(1)(b) – lack of distinctiveness - stop marks that can't function as TMs from being registered
 - S3(1)(c) - stop marks that other traders need to use from being registered

HOW TO DO IT

- *SAT.1*
 1. Examine from the p.o.v. of the relevant consumer of the goods in question. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect
 2. When judging distinctiveness, don't salami slice - look at the mark as a whole BUT in looking at the mark as a whole, you can pay attention to its component parts.
 3. A mark need not be inventive or original to be descriptive.

DISTINCTIVENESS & NON-TRADITIONAL MARKS

- No category of mark presumptively devoid of distinctiveness
- As a matter of law, same test applies to all marks, but in practice consumers may not be used to viewing such signs as TMs

DESCRIPTIVENESS

- Note width: descriptive of kind, quality, intended purpose, geographical origin etc. Open list: any other characteristic of goods/services
- Meaning seemingly obvious BUT must also look at public interest behind this subsection.
- Need to keep free interpreted widely

DOUBLEMINT



EXERCISE

- Consider the registrability of the following:
 1. The scent of roses for washing powder
 2. The sound of a dog barking for veterinary services
 3. The colour brown for chocolate