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**The Evolution of the Definition of Trade Mark from Directive
2008/95/EC to Current Day**

Bachelor Thesis

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I hereby declare that I am the sole author
of this Bachelor Thesis and it has
not been presented to any other
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Abbreviations

CJEU Court of Justice of the European Union

EC - European Community

OHIM - Office for Harmonization of the Internal Market (currently known as EUIPO - European Union Intellectual Property Office)

ECHR - European Court of Human Rights

ECJ - European Court of Justice

WIPO - World Intellectual Property Organization

Introduction

Trademark legislation in the European Union is currently in a great change. Author is curious to study the most recent European Union Directive on trademarks, which brings freshness to the field of intellectual property law, as the trademarks that have earlier been considered as "non-conventional" are now accepted as well, in the eyes of law as valid trademarks, without needing any special permission to be accepted by the registering officials as valid trademarks.

The research question is what are the underlying reasons for changing the definition of trademark from 2008/95/EC¹ definition to the new 2015/2436/EU definition? In practice this means including not only trade names or graphically presented logos, but also colors, the shape of goods or of the packaging of goods, or sounds.²

How did the practical usage of trademarks and case law judgements in the European Union regarding the definition of trademarks lead to the change of the definition of trademarks to include more varied features in the directive 2015/2436/EU Art. 3.

The objective is to study whether or not a change in the practical usage of trademarks created the current legal culture that allowed the case law to be more favorable towards non-conventional trademarks, and if the change in the practical usage and court judgements eventually lead to the re-definition for what a trademark may consist of, in the official European Union directive.

The hypothesis is, that the earlier definition for trademark, consisting only of visual elements, that could be graphically presented in the trademark application, were not up to date with the *de facto* legal culture of trademark protection of goods and services. The issue is important, because it will most likely create both old and new trademark holders opportunities to include more distinct qualities as parts of their official trademarks, and it could be assumed, that due to accepting non-conventional trademarks alongside with

¹ DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks, Art. 3

² DIRECTIVE (EU) 2015/2436 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 16 December 2015 to approximate the laws of the Member States relating to trade marks, Art.3

conventional trademarks, there would not be the need for as vast amount of bureaucracy or future court cases for the European Trademark's Office to accept the non-conventional trademarks as well.

Non-conventional trademarks, of which now have been officially accepted especially colors and sounds as "new traditionals", contain such interesting features as scent, taste, motion, position, touch, and many others, that some scholars have even described the situation with trademarks becoming as parts of the products themselves, and not merely signs of origin.³

The change of position of trademarks in the European Union arena and their significance for trade, consumers and undertakings, require a certain amount of studying the functions of trademarks, as is done in this bachelor's thesis, because the day of trademarks only as signs of origin have been left far in the past, because they have proven to perform a very significant economical purpose as well.

The bachelor's thesis study will be conducted using legal research in terms of studying directives 2008/95/EC and 2015/2436/EU as well as the European Union case laws related to the issue. One of the research methods will be qualitative research, in the sense of studying peer reviewed legal articles and finding the reasoning for the need of a new directive.

For comparison The United States legislation's occasionally mentioned, because it has to do with a bigger picture of the western legal culture, because even though as it might seem like the European Union legislation would be an island, when studying closely European Court of Justice judgements and the earlier 2008/95/EU directive. However, in most fields of law, for a long time already, both United States and the European legislation and court rulings have had an influence of a certain level to each other. There is no reason why this wouldn't hold true in relation to trademark law, as especially it was harmonized in the European Union by the earlier directive 2008/95/EU and the European Union legislation can be now compared as a whole to the United States rulings.

³ Kozinsky A., Trademarks unplugged, N.Y.U. Law Review Vol. 68, 1993, p.960

the US by amending the Lanham Act⁴ in 1988 the wordings "symbol" and "device" were retained from, in order not to prevent the registration of non-conventional trademarks, such as colors, shapes, smells, sounds or other non-conventional trademarks. So It could even be argued, that European Union is enabling thee qualities to be registered in terms of wording of the directive almost 30 years after the United States. ⁵

⁴ Lanham (Trademark) Act, 05.07.1946/ 15 U.S.C. §1051, United States of America

⁵ Friedmann, D., Trademarks and Social Media Towards Algorithmic Justice, Edward Elgar Publishing, Cheltenham UK, 2015 p. 31

1. What are trade marks and how do they differ from other intellectual property rights?

1.1. Brief history of trademarks

The original purpose of trademarks has been acting as sign of origin of the product. As Paster mentions, pieces of the earliest knowledge of human history include trademark usage.⁶ Thus, when speaking of trademarks, we are not talking about a new phenomena, and even though here the study is focused to the time between directives 2008/95/EC and 2015/2436/EU, it is good to understand, that the history of trademarks extends way further in the past than the European Union, or even most of the European nation states as we know them today.

1.2. What is a sign?

The World Intellectual Property Organization (WIPO), has defined trademarks as signs capable of distinguishing goods or services of one enterprise from those of other enterprises.⁷ Trademarks consist of signs. A sign is any appearance that, not only manifests itself in some form, but in addition to just itself also represents something more beyond the mere sign, as defined by Sandri and Rizzo.⁸ The curiosity of a trademark is, that it is a sign, that does not only represent the sign itself or the product itself, but actually a producer of the product. According to the earlier directive 2008/95/EC a trademark could consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging. Currently in the recent directive 2015/2436/EU, a trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds. The new, different parts to extend the definition of sign in relation to trademarks being colors and sounds, as well as having removed the requirement of the capability of being graphically represented.

⁶Paster, Benjamin G., Trademarks - Their Early history, p. 551, 59 Trademark Rep. 551 1969, accessed on HeinOnline Sat Sep 24 07:14:24 2016

⁷ <http://www.wipo.int/trademarks/en/> 25.02.2017 12.48

⁸ Sandri, S. Rizzo. S. Non-conventional Trademarks and Community Law, p.5. MARQUES (The Association of European Trademark Owners), printed by Print Partnership Ltd., Nottingham UK, 2003

1.3. Functions of a trademark

In the new trademark directive 2015/2436/EU, just as in the old directive 2008/95/EC trademarks have several functions. To better understand the significance of the change of the wording between the directives, it is important to understand the several functions of the trademark functions as well.

1.3.1. Guarantee of origin function

Origin of the product or service is at the same time the oldest, and the most established function of a trademark, telling by whom the product or service was produced by. The idea is that consumers are able to distinguish the product or service from other similar products or services of another origin on the market based on the trademark, and that the trademark really guarantees that the product or service is of the origin stated in the trademark.⁹ The guarantee of origin function was already established within the European Community already in 1978 in case 102/77 between *Hoffmann - La Roche v. Centrafarm* judged by the European Court of Justice in 1978¹⁰.

1.3.1.1 Origin function of trademark in relation to branding

Branding is a word, that has its greatest significance in the area of economics, and in principle, not such a great legal significance. However, the issue of branding should not be overlooked in regards of non-conventional trademarks, as branding has to do with the image of a company or a product, and not that much with the origin¹¹. As it has been mentioned above, early on, the (CJEU) European Court of Justice considered that the main function of a trademark was the origin function, for the consumers to be able to distinguish products or services from another, and reliably know that the product comes from a certain source of origin. However, later on also economic perspectives of the trademark started to be protected by the Court, and such terms as dilution of trademark, blurring, tarnishing or unfair advantage started to carry a meaning in the European Union justice system as well.

⁹ Cohen Jehoram, T., van Niespen C., Huydecoper, T. *European Trademark Law - Community Trademark Law and Harmonized National Trademark Law*, Kluwer Law International, printed in Britain in 2010, p. 9

¹⁰ European Court of Justice 102/77 1978

¹¹ Desai, D., R., Lianos, I., & Weber Waller S., *Brands Competition Law and IP*, Cambridge University Press, Cambridge 2015, p.218

This is important, as the non-conventional trademarks, such as sounds, smells, tastes, or colors have the most to do with the image of the company, product or service, and even though they do act as a part of the origin function by helping the consumers to identify the source of those products or services, they have even more economic value in the sense of advertisement function and good will for the trade mark right holders, in terms of the image of the company, than origin identifying qualities for the consumers.

1.3.2. Quality Guaranteeing function

The guarantee of origin function was established by the ECJ in 1978 C-102/77 *Hoffmann - La Roche v. Centrafarm*, and in the same case the function of quality guarantee of a trademark was established. This function is based on the fact, that when a consumer sees a trademark, which's most important function is to communicate the source of origin of the product or service, the consumer will expect, that if they acquire a product or service from the same trademark, the same origin, in the future, the quality of the product or service will keep consistent.¹²

1.3.3. Goodwill function or investment function

Goodwill would firstly need some kind of explanation, even though as an intangible asset, it's exact and short description is hard for even more experienced scholars. Goodwill has to do with the reputation that the consumers associate with the product or service. This reputation can be identified by the consumers through trademark usage, as consumers find a trademark associated with a business that has a good reputation as a sign of goodwill.¹³ Goodwill is the concept that differentiates well established businesses from new businesses. It is how the consumers perceive the product or service, and the trademark as a sign of origin tells the consumer that "oh this is a product or service from this reputable source". Goodwill is something that requires some time to build, and it is formed through the quality of the products that creates positive image of the product or service among consumers. Goodwill is also the function of the trademark, that is associated with customer loyalty. It is not rare, that a

¹² Cohen Jehoram, van Niespen, Huydecoper, *supra* nota 8, p. 12

¹³ Griffiths, A., *An Economic Perspective on Trade Mark Law*, Edward Elgar Publishing Limited, p. 49, Cheltenham UK, printed by MPG Books Group, UK 2011

consumer who found certain product or service to be of a high quality, keeps continuing the use of that certain product or service.

Well-known trademarks, as they are more established, than many other businesses trademarks, have more goodwill than other trademarks. As a result of this, well-known trademarks are more inclined to protect their reputation among consumers. For example, in the case Case -337/95 *Dior v. Evora* 1997, where Dior, a trademark owner of a luxury perfume line sued Evora, a company owning a chemist's shop chain, for damaging Dior perfumes' reputation by advertising that was not up to the standards of official Dior resellers. Evora was selling parallel imported Dior perfumes completely legally, but in Dior's view they were damaging the well-known trademark of the well-known luxury brand in the course of their marketing, by using Dior's trademark protected pictures of the products in Evora's advertisement leaflet. The significance of this ECJ ruling is that luxury products can be sold in non-luxury environment, but that the advertisements of the non-luxury seller are not allowed to harm the trademark proprietor's reputation, this being one of the first times, that the European Court of Justice recognized the goodwill function of trademarks. This was before harmonizing the European Union trademark legislation by directive 2008/95/EC, but in practice the function has kept on existing even after the harmonization, and will keep on existing also with the new trademark directive 2015/2436/EU.

The reason why goodwill function of trademarks is protected, is that by protecting goodwill, which is created by the trademark owner's investment in the business and the quality or marketing of the product or service, thus protecting goodwill in a sense indirectly protects this investment.¹⁴ Investment function is mentioned separately from goodwill function by the European Court of Justice in their judgement of the C-487/07 *L'Óreal v. Bellure* decision from 2009, but those two functions tend to overlap strongly in protecting the investment in the trademark, thus they are here mentioned as the same thing.¹⁵

¹⁴ Cohen Jehoram, van Niespen, Huydecoper, *supra* nota 8 p. 13

¹⁵ *Ibid*, p. 10

1.3.4. Advertising function

The advertising function is fairly tightly tangled with the goodwill function. You cannot reasonably advertise a product or service without the trademark of that product or service, because without the trademark the consumers wouldn't know which business is being advertised.¹⁶ However, if a business has a trademark, but that trademark is not advertised, the consumers do not know about that business, and then it will be difficult to exploit the economic potential of a trademark. Advertisement function in a sense is linked to the trademarks communicative properties, whereas the goodwill function has more to do with the products or services of the business. These two functions are often called together as economic functions of trademark, and even though from a consumer point of view the sign of origin and guarantee of quality are important, from the intellectual property holder point of view the economic functions are vital, and these two are looking for a balance between them.

2. The definition of Trademark in directive 2015/2436/EU and directive 2008/95/EC

2.1. Wordings of the directives

The wording of Article 3 has significantly changed between the previous and new directive, as we can notice from the following: In directive 2008/95/EC a trademark could consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging. For comparison, in directive 2015/2436/EU a trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds.

The new, different parts to extend the definition of "sign" in relation to trademarks being colors and sounds, as well as having removed the requirement of the capability of being graphically represented.

¹⁶ *Ibid*, p. 13

2.2. Color trademarks

In the European Union area as soon as the directive 2015/2436/EU comes to force, colors can be registered as trademarks through the normal trademark application procedure. The earlier argument why colors should not be possible to register as part of a trademark has been that no one should be given a monopoly over one single color.¹⁷ Colors should be free for everyone to use.

Even though *Louboutin v. Yves Saint Laurent*¹⁸, from 2012 is not an ECJ, but an United States Court of Appeal for the Second Circuit case, it has a high significance and a great exemplary value in the field of color trademarks. Louboutin sued YSL for using red outer soles in YSL shoes, which has been registered in the US as Louboutin's trademark. US district court held, that single color could not be registered as a trademark, but the Court of Second circuit held in its judgement that red, lacquered outsole of a woman's high fashion shoe, has acquired limited "secondary meaning" as a distinctive symbol that identifies the Louboutin brand.¹⁹

In *Louboutin v. YSL*²⁰, color is protected as part of the product's visual representation, that is not serving any functional purpose, but is there merely for the consumers to identify the origin of the product, in other words the shoes being the product of Louboutin. This protection of visual presentation is called protection of "trade dress"²¹ of the product.

In the future, the European Union trademarks registration offices will accept single color marks as trademarks, in accordance with the directive 2015/2436/EU. There will no longer be need for cases like the *Louboutin v. YSL*, in the sense of questioning whether or not a color can be registered as a valid trademark. It can.

¹⁷ Foo Yeow Yang, G., Seeing Brand in a Flash of Colour and a trademark in a red outsole: Registering Single-Color Marks In the Fashion Industry, Singapore Law Review 2013 vol. 31 p.171

¹⁸ Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc, docket number 11-3303-cv U.S. Court of Appeal Second Circuit, accessed on 12.02.2017 15.33 at <http://www.ca2.uscourts.gov>

¹⁹*Ibid*, p.4

²⁰ United States Court of Appeals, 2nd Circ., 05.09.2012, 696 F.3d 206, No. 11-3303-vc, *Louboutin v. YSL*

²¹ Debrow Cornett, R., A., Seeing Red: A Critical Analysis of Christian Louboutin S.A. v. Yves Saint Laurent America Inc., Alabama Law Review 2013, Vol. 65:2:539, p.543

2.3. Sound trademarks

The earlier interpretation of the "graphical representation" made it possible to only trademark protect tunes that could be presented graphically in the trademark application. Then however, when the trademark applications could be made online, also MP3 attachments of noises have become acceptable, without the need to represent the sound with musical notation, but it can be represented by a graphic representation consisting of an oscillogram or sonogram will be acceptable provided that it is accompanied by a corresponding sound file submitted via e-filing.²²

2.4. Requirement of graphical representation

Theoretically according to the Sieckmann judgement, it was ruled by the European Court of Justice, that a trademark could consist of sign which in itself wouldn't be possible to for the consumer to perceive by visual means, as long as it could still be presented graphically with enough accuracy and precision, leaving no possibility to confusion in the case of distinguishing the trademarks from each other. It is considered by Hildebrandt, that the function of graphic presentation was to define the mark itself to in order to determine the precise subject of the protection afforded by the registered trademark to its proprietor.²³

Now that the requirement of graphical representation of a trademark has been abolished from the new trademark directive 2015/2436/EU, it can be questioned, if for example with sound marks there is anymore need to submit graphic representations of oscillograms or sonograms, or if only the e-file containing the registrable sound file is enough to conduct the registration, as long as the sound file meets the requirement of distinctiveness.

²² European Union Intellectual Property Office, Trademark guidelines, The Manual Concerning Proceedings Before the Office for Harmonization in the Internal Market – Part B – Examination p.11

²³ Hildebrandt, U., Harmonized trademark law in Europe Case Law of the European Court of Justice, 2nd edition, Carl Heymans Verlag, Wolters Kluwer Company, Munich 2008, p. 51

3. Analysis on the types of nonconventional trademarks practically and theoretically enabled by 2015/2436/EU

3.1. Colour

Three land mark cases in regards of using colors as part of trademark are Libertel, Heidelberger Bauchemie and Louboutin v. YSL, even though the last one is not ECJ case, but concerning two Europe originating companies, it could be said that the case has also had its impact on the global legal culture, affecting European Union rulings as well. Due to different wording of the United States Lanham Act²⁴ that is concerned with trademarks, the most court cases about non-conventional trademarks in the United States have been related with possibilities to register colors in one way or another.²⁵

As the western legal culture does have a tendency to take influence from each other in many things, this also applies with the field of the development of legal thinking, and it also applies with trademarks, thus we could argue, that also American legal writing on the matter or court arguments for or against registering colors applies just as well in European Union. In the United States, there has traditionally been three theories for barring of the usage of colors as trademarks. These theories are color depletion, shade confusion and functionality.²⁶ According to Vana, in the color depletion means that as there is a limited spectrum of colors visible for the human eye, by registering one color or shade of it, the registration blocks all the later registration applications on that color, and theoretically there is a possibility of eventually running out of color shades to register. This same issue has also been noted in the chapter about the competition point of view of trademarks. The registration of color shades could theoretically lead in the kind of situation where in after a certain longer amount of time, for certain services or products there would not be left color shades to be registered. However, in practice it could be considered that as the European Union now with the directive 2015/2436/EU has accepted color trademarks officially, and even before that made case law

²⁴ Lanham (Trademark) Act, 05.07.1946/ 15 U.S.C. §1051

²⁵ Port, K., L., On Non-traditional Trademarks, Northern Kentucky Law Review Vol. 38:1, 2011 p. 20

²⁶ Vana, J., L., Color Trademarks, Texas Intellectual Property Journal, Vol. 7:3, p.388, 1998-1999

rulings in favor of these kinds of trademarks, that at least in Europe the depletion of colors is not really considered as more than a mere theoretical threat, that has little practical value.

Shade confusion is another theoretical legal issue Vana mentions in his article on the topic of color trademarks. Shade confusion has to do with the principle, that use of similar marks on similar products that are likely to cause confusion among consumers should not be permitted, and this could happen by the usage of for example two different shades of yellow on two different companies' corn flakes packagings, where the trade mark protected color could not act as a way of distinguishing the products from one another, as the consumers would with a high likelihood confuse the shades of yellow with each other, thus the shades of color could not serve the origin function of a trademark in a reliable manner.

The functionality argument listed by Vana, has to do with trying to keep trademark law separate from patent law, as functional qualities of things registrable under intellectual property legislation ought to be protected with patents. Thus, for example desirable natural color of a product should not be protected as a trademark, as it is simply a naturally occurring or a desirable characteristic of a products, but hasn't got much to do with actual trademark legislation. This could be imagined in a situation, where a chocolate manufacturer would want to protect a deep dark brown color as a trademark for their dark chocolate, even though out of the functional purpose of the cocoa powder in the product, without which it would not even be allowed to be marketed or sold as chocolate, the dark brown color of the dark chocolate is only a functional quality of the product.

It could be assumed that as happened in the United States in the *Qualitex* case in 1995²⁷, as the Supreme Court ruled, that a single color can be registered as a trademark, if it has already gained an association with the product or service by usage in the eyes of the consumers²⁸. In the future of the European Union legislation, it would be fascinating to know whether the color trademarks that will now be accepted as valid trademarks if applied for and being

²⁷ United States Supreme Court, 28.03.1995, 514 U.S. 159, *Qualitex Co v. Jacobson Products Co. Inc.*

²⁸ Traina, L., Seeing red, spending green: The costly process of registering and defending color trademarks, California law review, Vol. 87 2014 p. 1323

distinctive enough, would need to first acquire the distinctiveness by use, or if it is enough that an applicant will only file an application that contains the international identification of color shade they would like to register, and then that would be enough for the registration officials, and the undertaking registering the color could start using it after having registered the color shade.

However, interestingly enough there is one remarkable difference in registering colors in the European Union and in the United States; Whereas the European Union requires and accepts for colors the international identification codes for colors as descriptive enough for the registration application, due to the stability of the color codification, the United States system does not require the international color identification code for registration, but the color to be registered is described by other means, thus not providing the same kind of legal certainty or clarity as the European Union system does with the new directive 2015/2436/EU.²⁹

3.2. Scent

Some academic writers consider, that as long as the EU holds on to the requirement of graphic presentation, it is impossible to register scents as trademarks.³⁰ However, as the requirement of graphic presentation was removed from the new directive 2015/2436/EU, this could be interpreted as enabling the registration of scent trademarks within the European Union area in the near future, despite not being separately mentioned in the directive. In 1999 the first olfactory (smell) mark was registered in the European Union, the smell of freshly cut grass in relation to tennis balls. The requirement for graphic presentation was fulfilled with mere description "smell of freshly cut grass". The case is interesting as it has been also questioned if the decision was right and fulfilled the European Union criteria for a trademark.³¹ This far the smell of freshly cut grass is the only registered olfactory community

²⁹ Roth, M., E., Something old, Something new, something borrowed, something blue: a New Tradition in Nontraditional Trademark Registrations, *Cardozo Law Review* Vol. 27 p.479

³⁰ Bartkowski, M., New Technologies, New Trademarks, *Journal of Contemporary Legal Issues*, Vol. 19: 431, 2010, p. 436

³¹ Sandri, Rizzo, *supra* nota 7, p.262

trademark in the European Union, even though the case gave the impression that it could pave way for the glorious future of scents as trademarks.³²

In 2002 when Mr. Sieckmann³³ tried to register his "balsamically fruity with a slight hint of cinnamon" it turned out that in the opinion of the European Court of Justice, scents would not be presented graphically precisely enough. Because the Sieckmann criteria is widely in use and well-known among trademark law area, it is interesting that the court could rule in that way after the European registration office accepting the smell of freshly cut grass as a valid trademark. It would have been in a sense understandable, if the issue had been about not being original and distinctive enough, with a capability for consumers to distinguish the scent and associate with the products and services in relation which it was registered for, but the consideration of lacking the ability to be graphically presented was a curious decision after the smell of freshly cut grass. Even though, most people recognize the scent of freshly cut grass when smelling it, and probably can memorize how the scent smells like, it does not mean that smell of freshly cut grass would be in any way an absolutely exact and precise description of the nature of the scent. It could be also interesting to know if the registration authorities decision on registering freshly cut grass could have been contested after the Sieckmann criteria, based on the old directive 2008/95/EU, due the lack of graphic presentation for which a verbal description of the scent is not enough.

Additionally in the future, as Sieckmann criteria could be assumed to stay in force as European Union case law set principle in the registration of community trademarks, until it has been overruled by a contrary decision by the European Court of Justice, it could be thought that before a contrary court decision, receiving a trademark registration for a scent will be extremely difficult even if the requirement of the graphic presentation is a thing of the past in the new directive 2015/2436/EU, because one could assume, that the trademark ought to still be registered in such a manner, that it does not leave any question of the exact nature of the trademark, and this is for the protection of the legal certainty of both, of the intellectual property right holders, and for the new trademark registration applicants. The right holders are

³² Karapapa, S., Registering scents as community trademarks, Trademark Reporter Vol. 100 2010, p. 1336

³³ Sieckmann v. Deutsches Patent- und Markenamt C-273/00

able to protect their registered intellectual property better, because they have the ability to contest potential trademark infringements when the trademark is defined precisely enough, but also the new applicants have enough information based on which they can conclude which trademarks are already taken, and their registration applications are not up to guessing, "this tennis ball scent of ours that we would like to register, might or might not smell like the freshly cut grass that has been registered earlier". In addition, the preciseness of the trademark registrations enables the registration officials to determine already during the application process whether the olfactory trademark is either infringing an already registered trademark, or if it is just not original enough.

It is interesting to note, that already even before the new directive 2015/2436/EU there existed a school of thought, that any sign capable of being presented graphically, including smells could be registered under trademark legislation³⁴, even though it was fairly explicitly stated in the Sieckmann case, that will be handled next, how any reasonable means of presenting a smell accurately and graphically, such as chemical formula did not consist a precise enough graphic presentation in the view of ECJ.

What is important to note when studying scents as trademarks, is that it is not the scent itself that is being registered, but rather the association of the scent with a certain product or service. The formula of the scent is protected by trade secret, patent or copyright.³⁵ What makes the question of whether or not it will be possible to register scents as trademarks when the directive 2015 comes into force, is that from the point of view of trade and marketing, scents are important because they enable consumers to for example tell one hand lotion apart from another based on the scent, and it is of reasonably general knowledge, that the better a product smells the better it sells³⁶, thus the matter of being able to register as trademarks such financially valuable assets is actually quite important, and keeps up the legal interest in the issue that is currently fairly unclear before new case law on the registration of olfactory signs after the enforcement of 2015/2436/EU.

³⁴ Jolly, A. The Handbook of European Brand rights Management How To Develop, manage and protect your trademarks, domains, designs and copyrights, Kogan Page Limited 2011. p. 48 printed in the UK

³⁵ Karapapa, S., Registering scents as community trademarks, Trademark Reporter Vol. 100 2010, p. 1336

³⁶ Hawes, J., E., Fragrances as Trademarks, Trademark Reporter Vol 79, p. 135, 1989

3.3. Sound

It is considered by M.E. Roth, in her article about registrations of non-traditional trademarks, that both the European Union system and the United States systems are faulted when it comes to seeking for registration for a sound trademark. In her mind, the problem with the European Union acceptance of sonograms and musical notations was, that despite being very exact definitions of sound trademarks, not everyone can read musical notation, and even less people can read sonograms³⁷. For this reason it would be good for the system, to allow also more comprehensible verbal descriptions of the sounds being registered, for laymen to understand, such as for example "lion roar" in the MGM case so that a person who is not deeply personally invested in reading sonograms can at least get an idea of what the sonogram is supposed to present, instead of just seeing the figure on paper. The verbal descriptions are not precise enough to be the only instrument of describing the sound, but those help when used together with for example a sonogram or notation or a recording of the sound. The person reading the verbal description will not probably know how the exact sound sounds like, only based on the description, but they still have a better idea of the contents of the sonogram than by merely looking at a figure they cannot read.

Even though it turned out in *Shield*³⁸ case it turned out that at least melodies were possible to register in the European Union there was still a difficulty with the sounds that could not be described by musical notation.

³⁷ Roth, *supra* nota 24, p.487

³⁸ *Shield v. Kist* C-283/01

4. Case Law Studies on what trademarks may consist of -Evolution during time?

4.1. Colour

4.1.1. Libertel case C-104/01

Libertel tried to register an orange rectangle and the word "Orange". the question of the case was whether the color was registrable. The requirements set out in the reasoning of the decision were, that the trademark to be registered, must be a sign, capable of graphic representation and contain the capability of distinguishing the business from other goods or services based on the trademark. The judgement held, that a color that is described by the internationally recognized identification codification of shades is a precise and stable description of the color, and thus the color can be registered as a trademark.³⁹ However, the consumers must be able to differentiate that color shade from other shades, which has to do with acquired distinctiveness.

4.1.2. Heidelberg case C-49/02

In the case of Heidelberg the German court brought a case to ECJ, in which there was an attempt of trying to register a rectangle, and it's upper half was blue and lower part was yellow. The application Heidelberg Bauchemie GmbH had made was for the usage of the color combination in every conceivable form, in particular on packaging and labels. This did not satisfy the ECJ, but not because they would've thought that registering colors would be unacceptable, but rather because the application was not precise enough and it lacked uniformity in the description of the relationship of the colors. In Heidelberg case it was ruled that colors could constitute a trademark if they are systematically arranged by associating them in a predetermined and uniform way. However, the court did not specify what they meant by systematic arrangement.⁴⁰

³⁹ ECJ, 06.03.2003, C-104/01, *Libertel*

⁴⁰ ECJ, 24.06.2004, C-49/02, *Heidelberg*

4.2. Sound

5.2.1. MGM lion's roar (R781/1999-4)

MGM tried to register the lion roar, that could be described as well-known for most of the people who have ever watched MGM's films and heard the lion roaring in the beginning of the film. The first time MGM tried to register the sound, or "noise" as lion roaring cannot be described by musical notation. However, the reason the sound could not be registered on the first time of the application: the application was rejected by OHIM, due to lacking any way to measure the relativity of the noise in regards of other noises, or sounds, even though they had an otherwise accurate sonogram, they just didn't have a scale on it. Later on MGM has been able to register the lion roar as a trademark of theirs. The point in this case initially was, that the sound lacked ability to be accurately graphically represented, due to lacking the relativity scale.⁴¹

4.2.2. *Shield v. Kist* C-283/01

In *Shield v. Kist* there were two sound trademarks. The first consisted of first nine notes of Beethoven's für Elise, and the second one was the crowing of a cock. In the course of the case, it turned out, that the court held in it's reasoning a very strict line, about how a sign must be capable of graphic representation, which the crowing of a cock in the court's minds was not. However, the court thought, that a sound mark can be a trademark, because even when the mark itself cannot be represented graphically, it can be accurately and objectively be described graphically, in writing, or by musical notes, or by sonograms for example. The requirement for distinguishing the product or service is naturally present here as well. When it came to the crowing of a cock, the court considered, that the mark had not been presented graphically accurately enough. The court decided, that in the case that the mark itself cannot be represented graphically, it can nevertheless be registered, if it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.⁴²

⁴¹ OHIM, 25.08.2003, R781/1999-4, *MGM*

⁴² ECJ, 27.11.2003, C-283/01, *Shield v. Kist*

The court also defined, what kind of descriptions are not capable of constituting a sound sign:, sounds described in written language, such as describing it as a sound of a certain animal, or by onomatopoeia or by sequence of musical notes without more. However, even "noises" could be registered, if the "noise" would be represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.⁴³

4.3. Shape

In the past it has also been questioned, whether or not allowing the registration of three dimensional trademarks, such as product and packaging shapes would provide the trademark owner a too wide area of monopoly over a shape⁴⁴, for example by blocking others from using the same packaging shape. However, in the case law practice, it has been proved by the European Union case law, that the court has been in favor of registering three dimensional shapes, and it has not been a problem even in the earlier directive 2008/95/ EC.

4.3.1. *Reckitt and Colman Products v. Borden Inc* [1990] 1 All E.R. 873

This British case, also known as the Jif Lemon case⁴⁵, was one of the most notable occasions in the European Community area, when shape of the packaging was considered to be able to constitute a trademark. Reckitt was a company producing and selling lemon juice in lemon shaped packagings with name "Jif Lemon". The case was brought to court, after a competitor Borden Inc, started selling lemon juice in a lemon shaped container as well, and Reckitt considered this action to be an infringement of their trademark. Reckitt won the case, as the British court considered that the lemon shaped packaging of the product enjoyed of goodwill and was easily recognized by the consumers as Jif lemon juice.⁴⁶

⁴³ *Ibid*

⁴⁴ Dawson N., Firth A., Perspectives on Intellectual Property Trade Marks in Retrospective, Volume 7, Sweet & Maxwell, London 2000 p. 139

⁴⁵ Michaels, A., A Practical Guide to Trademark Law, 2nd Edition, Sweet & Maxwell, p.119, London 1996

⁴⁶ House of Lords, 08.02.1990, 1 All E.R. 873, *Reckitt and Colman Products v. Borden Inc*

4.3.2 *Philips v. Remington* 2002 (C-299/99)

Philips had registered as a trademark the three-headed shaver in 1985, and in 1995, Remington began to produce and sell a shaver with a similar kind of three-heads. Philips sued Remington, whereas Remington counter-claimed for revocation of the trademark.

An important issue in the case was, whether or not the three shaver heads were a functional matter or a matter of design. This was due to the ruling, that features of the product, that are of technical nature, and vital for the functioning of the product cannot receive trademark protection.

The criteria in addition to the mere technical function of the trade mark seeking or already by mistake trademark protected quality, the three heads of the shaver, were considered to have the ability to distinguish the Philips shavers from other shavers, in case an average consumer who is reasonably well-informed and reasonably observant and circumspect⁴⁷ is able to distinguish the origin of the product based on the three heads, or if it is a thing so general, that the consumers do not associate the three-headedness of a shaver with only one business.

The court in the case of *Philips v. Remington* considered, that the three-headed shaver was not a valid trademark protectable feature of the product, as the three heads were only for achieving a technical result. Philips tried to argue, that any other shape as three-heads would create the same end result, and their three-round heads were special and thus too be protected under trademark legislation, but the court did not find the argument convincing enough. One could also pose a question: which one was Philips trying to protect mainly: the three heads of the shaver, or the round shape of those heads? The court also noted, that the refusal or invalidity of a registration cannot be overcome by establishing that there are other shapes which allow for the same technical result.

⁴⁷ ECJ, 18.06.2002, C-299/99, *Philips v. Remington*

4.3.3 Lego R 856/2004

Lego tried to register the shape of the Lego brick as a trademark, due to its distinctive nature. Originally, the shape was registered by OHIM, but then the registration faced the Cancellation Division due to the application of a competing company Mega Brands Inc.

In further inspection it turned out, that the shape of a lego brick actually fully serves a functional purpose, to achieve a technical result, which enables the product to work in the way it is supposed to for the purpose that it is meant for. Products which are designed the way they are, to achieve a technical result are supposed to be protected by patent, and not by a trademark, and thus the court found, that the registration of the Lego brick was void, due to the purely technical nature of the brick.⁴⁸

4.4. Smell

4.4.1. Vennootschap onder Firma Senta Aromatic Marketing R 156/1998-2

This case was the first one in which an olfactory trademark was accepted for registration in the European Union. The reasoning of the Board of Appeal was, that the object for which the registration was sought for, the smell of freshly cut grass, was distinctive and original, in the sense that everyone would immediately recognize the scent by the description. The registration for the quality was sought after in relation to tennis balls.⁴⁹ It could be argued, that despite being accepted for registration by the OHIM, it must be noted, that the compliance with the registration criteria is questionable, because even though not all tennis balls smell like freshly cut grass, so the idea of trademark in itself is original and distinctive, it is not necessarily the case, that the scent could be described objectively, despite being very familiar for most people. It could be described through an analogy as similar situation if a book printer would try to register a trademark of books smelling like freshly ground coffee. Everyone knows what freshly ground coffee smells like, and even if the trademark would pass the criteria for originality and being capable of describing the origin of the product, could it still be, that the scent of freshly ground coffee fulfills the criteria for graphic presentation?

⁴⁸ OHIM, 10.07.2007, R 856/2004, *Lego*

⁴⁹ OHIM, 11.02.1999, R 156/1998-2, *Vennootschap onder Firma Senta Aromatic Marketing*

This was something considered problematic by some with the grass smelling tennis balls. Though, now with the new directive 2015/3624/EU, the old requirement of graphic presentation is not stopping undertakings from registering scents as trademarks anymore, and the controversiality of the tennis ball case is not as big issue anymore. It is still interesting to see in the future, how the requirement for objective and precise presentation of the trademark in the application is going to happen, even when it is not needed anymore to graphically present the trademark.

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

Mr. Sieckmann wanted to register a trademark scent, for services in several classes of the EU classification system, varying from business administration to cultural activities to veterinary and agricultural services to scientific and industrial research. Mr. Sieckmann's application looked like this: chemical substance methyl cinnamate (= cinnamic acid methyl ester), with structural formula $C_6H_5-CH = CHCOOCH_3$. Additionally, the trademark that was applied for, was verbally described as "balsamically fruity with a slight hint of cinnamon." by Mr. Sieckmann, and additionally he deposited an odor sample with his registration application.

This was a landmark case, because the odor could not be registered, as it could not be graphically described, even though it was described verbally, by its chemical composition, and even by an odor sample, and the scent could not be registered due to its lack of sufficient distinctive character, even if it under the new directive 20152436/EU could have been registered if found to enable consumers to distinguish Sieckmann's services from other services.

However, in their decision, the registration office had stated, that in theory odors may be capable of being accepted in trade as an independent means of identifying an undertaking. After the registration office decision a German court to which referred the case for the ECJ, saw, that the mark deposited would be capable of distinguishing the above mentioned services and would not be regarded as purely descriptive of the characteristics of those services. In the final decision on the matter, ECJ considered that trademarks are capable of consisting of signs which are not possible to be perceived visually, but the sign must be possible to be graphically

represented, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.⁵⁰

4.4.2.1. Sieckmann criteria

The Sieckmann case resulted in so called "Sieckmann criteria" drawn by the ECJ, to apply for trademarks that were constituted of scents or different odors, and the according to OHIM guidance, the same criteria also applies to applications of taste trademarks.

The Sieckmann criteria consists of the requirements set out for non-visual signs graphical representation in the application. For example when considering a smell, the requirement of graphical representation is not fulfilled with a chemical formula, a description written in words, by a deposit of an odor sample, or even by the combination of those elements.⁵¹

However, as the court decided, which cannot be stressed enough, trademark registration applications with trademarks that are not possible to be perceived visually can be accepted, in case the sign is graphically represented by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

4.5. Taste

As there is very little cases in the European Union about taste apart from Eli Lilly's attempt to register "artificial strawberry flavor"⁵² it could be considered that American legal writing on the matter is just as valid in the attempt of trying to analyze the legal difficulties registering flavor or taste brings, as the registrations or registration attempts are very rare on the other side of the Atlantic as well. The difficulties include the precise description of the taste for the registration application, as it faces the same issue as with scent. Another problem is defining whether or not the taste is merely part of the product's functionality⁵³, for example it would be

⁵⁰ ECJ, 25.01.2003, C-273/00, *Sieckmann v. Deutsches Patent- und Markenamt*

⁵¹ *Ibid*

⁵² OHIM, 04.08.2003, R 120/2001-2, *Eli Lilly*

⁵³ Gallagher T., A., Commentary, Nontraditional trademarks: Taste/ Flavor, Trademark Reporter Vol 105, 2015 p. 806

insane to allow a n undertaking that is manufacturing milk chocolate to register the taste of milk chocolate, as the whole point of milk chocolate is to taste like milk chocolate, and despite of small taste variations in the product's of different manufacturers, the taste is fairly generic, and not really that original either.

4.5.1. Eli Lilly R 120/2001-2

There have not been that many cases about taste in relation to trademark, as very often taste of a product is protected as a trade secret. However, of these few cases, Eli Lilly is potentially the most widely known one.

In Eli Lilly case the applicant tried to register as a trademark the taste of artificial strawberry flavor for pharmaceutical preparations and sanitary products. This application was rejected by the OHIM, as the Sieckmann criteria was applied to the case. Even further notion by OHIM was, that the application's part for sanitary products will not even be considered further, as those products are not supposed to end up into the mouths of consumers anyway. The case could be compared to Sieckmann, and noticed, that the applicant did not provide any other explanation for the trademark they were applying for than mere verbal description of taste of artificial strawberry flavor, which itself was quite minimal explanation for the mark applied for when compared to combination of chemical formula, verbal description and odor sample.⁵⁴

However, as in the Sieckmann criteria it was ruled, that the requirement of graphic representation is not fulfilled with a chemical formula, a description written in words, by a deposit of an odor sample, or even by the combination of those elements⁵⁵ it ought to have been reasonably clear for an observant applicant, that their application does not meet even the more advanced description for the criteria for rejection. OHIM also considered, that in regards of pharmaceutical products, artificial strawberry taste is devoid of any distinctive character, as it is used in many pharmaceutical products to mask the unpleasant taste of the product, and thus not registrable additionally for that reason.

⁵⁴ OHIM, Second board of appeal, 04.08.2003, R 120/2001-2, *Eli Lilly*

⁵⁵ ECJ, 25.01.2003, C-273/00, *Sieckmann v. Deutsches Patent- und Markenamt*

4.6. How has the case law changed during time?

4.6.1. Affects on legal culture

One could argue, that the greatest change in the surrounding legal culture, that has enable the definition for what trademark may consist of has been enabled by the case law, as the ECJ has ruled year by year in a more favorable way for the non-conventional trademarks. In *Libertel* case it was defined that certain colors can be protected by trademark, as long as they have been described in enough detail, such as by using the international codification for identifying color shades, thus keeping a color trademark from affecting competition adversely, as an undertaking cannot trademark all the shades of orange, but a specific shade, to be used in relation to the services or products it is providing for the consumers, as colors still are so widely used that it is of public interest to keep them available for everyone.

Thus, registering one exact shade, will not affect the competition too much, as the undertaking can use the color only in relation to the services or products that it has applied a trademark for according to the European Union classification system for products or services. Naturally, as it turned out in the *Heidelberg* case, an undertaking cannot register a color or colors for all services and products imaginable, as it would distort competition and be contrary to the public interest, but still, as it turned out, registering colors has been made possible by the case law, even if it has not been earlier mentioned in the Trademarks directive, the way it is now mentioned in the new trademarks directive. Could be argued that colors are easy from the point of view of the authorities, as they can be very objectively and accurately graphically described by the international color identification coding.

In *Shield v. Kist*, the ECJ ruled that if the sound can be described in the way of musical notation for example, that is a graphical description enough for the registration. IT was important for the point of view of the development of the legal culture, that this case established the fact, that yes, sounds can be registered if they fulfill a certain criteria set out. This is important, but to the fact, that sounds are one of the major things that have a drastic impact on human perception, but they just aren't possible to perceive visually.

However, the Shield case limited the registration of sounds only to registering tunes that could be described through musical notes, whereas sounds that could not be described by notes were not possible to register as trademarks, even if they had been very original and recognizable in relation to the product and its origin. So called "noises" were not possible to register before, as they could not be accurately enough graphically described, but interestingly enough, the possibility to register them did not change in the first place by a court ruling, but by the change in the guidance of OHIM for the absolute grounds for rejection of the trademark application, where it is said, that a voice could be registered if it is described with a sonogram with a relativity scale and by adding a sound file of the sound to the application. Thus, it has reached also the new directive: by the definition what a trademark may consist of, sounds are included as possible to register in the new wording of the directive.

In the grass smelling tennis ball case of *Vennootschap's*, the first scent mark in the European Union area was registered in 1998. It is fascinating to notice, that even though The *Vennootschap* case could have given trademark registration applicants hope of the change of legal culture and the potential of scents as trademarks also in the European Union, the joy and hope of that was short lived, as it only took a few years, until in the *Sieckmann* case it was ruled that even combination of chemical formula, verbal description or a deposited scent sample would not be enough to fulfill the criteria of graphic presentation. In this sense, it is fairly curious, that despite that criteria not yet being laid down at the time of the registration of freshly cut grass smelling tennis balls, based solely on a verbal description of the scent in relation to the product, one could imagine, that the European Court of Justice would not have changed their mind so radically on the topic within only a time of a few years.

Sieckmann case created the *Sieckmann* criteria to define further that even if odors could be trademark protected in theory, there was no ECJ accepted way to protect them by a trademark. However, the future will show us, now that the requirement of graphic representation has stepped aside from the requirement of trademark protection, if the *Sieckmann* criteria applies any longer, as it was firmly based on the lack of graphical representation in the first place. An odor sample may not be stable enough for the application being submitted, but for example verbal description combined with a chemical formula of the trademark odor looking for a

registration could theoretically fulfill the requirements for the description of a trademark, now that it does not need to be graphically described anymore. However, theoretically as long as the trademark registering sought for manages to apply for the smell trademark in a manner that satisfies all the requirements set by the ECJ, it should be possible to register a smell mark.⁵⁶

The evolution is remarkable in relation to the old directive which let the interpreter along by the first impression that only trade names and product shapes and packagings could be protected. However it is interesting to consider, that already the earlier directive contained the notion of the possibility to protect shape, even though it could have gone under the protection of industrial designs, even though they do have the potential of origin distinguishing function, and have for that reason a vast economic value for the trader with high good will. It is left to be seen whether the new directive proves itself to be foresightful with removing the requirement for graphical presentation, or whether in the future there will there be added also separately that rest of the non-conventional trademarks, such as odor, taste or motion could be trademark separately protected as well, will the new directive suffice and automatically cover the currently still non-conventional trademarks as well as a part of not requiring graphic presentation if described in enough detail. Potentially in the future, due to the change in legislation there will be new cases on the subject of whether or not those could be protected under the trademark legislation.

5. Competition point of view

It has been taken into consideration several times both by the Court of European Union, and academic writers⁵⁷ whether trademark protection of colors (Libertel), shapes or smells (Sieckmann) would have negative effects on the internal market competition. However, by accepting the trademark protection for shapes of packagings and products already in the earlier directive 2008/95/EC, with conditions that the shape is not a merely essential for the technical functioning of the registrable product or packaging, it turned out that the European

⁵⁶ Gastinel, E., Milford, M., *The Legal Aspects of Community Trademark*, Kluwer Law International, 2001, The Hague Netherlands, printed and bound in Great Britain by Antony Rowe Limited p. 70

⁵⁷ Dawson, *supra* nota 35, p. 139

Court of Justice did not find the registration of shapes too limiting from the competition perspective.

Same applies to colors, as they can be now registered as valid trademarks according to the new directive 2015/2436/EU, and they can be reliably presented by the international identification code, in which case an undertaking can register a certain shade of a color in relation to a certain product or service, and not the entire color with all its shades, as that would be strongly against the public interest as colors are widely used. This was set in the *Libertel* case with the registration of a shade of orange in relation to telecommunications services provided by the undertaking. The court did not see registering one shades as being contrary to the European Union competition policies.

6. Problems that were faced with Directive 2008/95/EC in practice

One of the major issues with the old directive 2008/95/EC in comparison to the new one 2015/2436/EU was how the system was considered outdated, and how it excluded non-traditional trademarks. On the other hand, the inclusion of non-conventional trademarks to the European registration system requires balancing with the requirements laid down in the *Sieckmann* case, the requirements of being clear, precise and objective.⁵⁸ Graphic representation proved itself to be a massive issue for the registration of non-conventional trademarks that were not separately mentioned in the directive Article 3.

The theoretical possibility to register olfactory trademarks existed, but in practice it was extremely difficult due to the requirement of graphic presentation and the *Sieckmann* criteria, even though in the United States the wording of their trademark legislation allows for scents as trademark, and it has not proven to cause any special problems. In the European Union the reasoning for the requirement of graphic presentation was to secure legal certainty for the trademark owners and applicants, so that everyone would be immediately able to recognize the smell being registered. It is left for the future show, if dropping out the requirement for graphic presentation results in more scent trademarks, or potentially even in some kinds of trademarks no one has even thought of yet.

⁵⁸ Engin-Deniz, E., *EU Challenges and Solutions in the field of Trademarks, Overview of Challenges and Solutions in the Field of Trade Marks in the EU*, 1 Soc. Persp. - J. Legal Theory & Prac. 2014 p. 301

Also the fact that colors were not separately mentioned in the earlier directive 2008/95/EC formed a problem in the sense, that even though colors have been widely accepted in the European Union jurisdiction for a trademark if it is been described in a detailed manner enough by international identification code, and by telling in relation to which services or products the color will be used. Despite this, the lack of having color separately mentioned in the official definition of what a trademark may consist of resulted in several court cases that could have been avoided, and thus the bureaucratically workload eased up by having mentioned the registrable aspect readily, without having to spend time and resources for getting the registration. However, it could be said, that without those court cases earlier on, that stemmed from the not detailed enough wording of the earlier directive 2008/95/EC that has been fixed in the directive 2015/2436/EU, could be said to have had a significant impact on the development of the new directive, as this kind of court cases will be reduced with it being officially clear that colors can be registered, just as many other features.

Also as it was proven in the Shield case, graphic presentation proved itself once again problematic, as it required an ECJ case to agree that melodies could be registrable, but that verbal descriptions of other sounds, that could also be called noises were not registrable, even though nowadays we know a lot of non-melodic sound trademarks, such as for example MGM's lion roar or the specific kind of "plim" sound Apple's computers make at starting. Now thankfully sounds have been added to the definition of what trademarks may consist of in the directive 2015/2436/EU, and it could be expected that there is no need anymore to bring cases about sounds in front of the ECJ again.

It could be argued that when the earlier directive was enforced computers were not yet as advanced as they are today, which limited the scope of potential registrable trademarks, and made the requirement for graphic presentation as important as it was. For example this could be noticed from the new inclusion of sounds that do not consist of musical notes, as nowadays the registration application can be done online and the applicant can just upload a sound file as an attachment to the application. Fairly similar logic would apply to colors as well, today the international identification codes for colors can be effortlessly searched from the internet, and the code of the shade can be added to the application, and the color will not fade in the

course of time of being archived, like it could have done in the times when the only possible way of trying to register a color as a trademark was by attaching a physical color sample to the paper application, which could not be trusted to maintain the exact color when being stored in the filing system for years.

7. Further non-conventional trademarks not yet separately included in 2015/2436/EU

7.1. Position mark

position marks are one type of three dimensional trademarks, but they are just not as obvious as the shape of product packaging or goods, and thus they count as non-conventional trademarks.⁵⁹ One significant case as an example of this was in R-983/2002-3⁶⁰, where scissor blades were connected with a red "dot" and the undertaking tried to register the red dot as a trademark. The registration of that kind of quality should theoretically be stopped by the earlier requirement of graphic presentation, but the first decision of the registration authorities was that the red dot in the scissors served a technical purpose, a decision which was later on turned upside down in the OHIM Board of Appeal, and coined as a "position mark".⁶¹ However, having needed to actually struggle with registration of this kind of feature earlier, could be seen in the way, that it is a trademark type on its own account.

7.2. Taste

Taste mark has been discussed for a long time, and it was brought forward in the Eli Lilly case when the undertaking tried to register the artificial strawberry taste in relation to pharmaceutical products, but was rejected both because it did not fulfill the Sieckmann criteria, and the mark was not sufficiently distinctive or original. Technically, just as scent marks, taste could be registered with a distinctive and thorough enough application, especially now that the wording of the directive 2015/2436/EU is not stopping the registration with a requirement of graphic presentation. However, the problem with taste marks is, that they are very difficult to describe accurately and objectively enough. Perhaps in the future taste can be

⁵⁹ Sandri, Rizzo, *supra* nota 7 p.153

⁶⁰ OHIM, 20.11.2002, R-983/2002-3 *Roter Punkt*

⁶¹ *Ibid*

registrable as a trademark, but at least for the moment, in the light of earlier cases of trying to register taste in the European Union, it seems unlikely, that taste marks would be a significant new area of trademark legislation any time soon.

7.3. Tactile

Touch is an important sense for a human being, and thus it can be used, and it is an integral part of most products as well, and thus there is certain amount of interest for different undertakings to register trademarks that can be perceived through sense of touch. There is not much case law about the sense of touch registered as trademarks, and theoretically earlier on before the directive 2015/2436/EU those could have been registered under the graphical presentation of the trademark as the shape of the product or packaging, though it is slightly questionable still, as the usually shape of a product or packaging has to do with in a sense more easily recognizable entity than the surface of the product or of the packaging.

In any case, there is one occasion where use of touch of a product has been sought for registration for, in the Five Ribs⁶² decision, where the undertaking was applying for registration for their contact lens and the feel of that, as inside the lens there were these five rib like things, that could be perceived by the sense of touch. The registration was applied for by using a three dimensional description of the product. The reason the application was dismissed, was rather similar to Eli Lilly case reasoning: as the product was a specialized contact lens, and not available to consumers freely without prescription, and it would require one to have a hands on (or a tongue on) experience on the product to perceive the original feature of the product, it could not be considered as a trademark that could be perceived without being directly in touch with the product.

7.4. Sensation

In the United States a famous person has a right on all products or services carrying their name. In the European Union the French Law supports a celebrity's right to control the usage of their name like it is intellectual property right, or trademark to be more exact, in the United

⁶² Five Ribs R-448/99-2, 21st March 2001

Kingdom famous people's names are not as protected, and the approaches of Germany and Netherlands are somewhere between the French and British approach on the matter.⁶³

The question of commercial appropriation of a personality is an interesting one, as it could be asked if a person in themselves who is mostly a vehicle of marketing for example in celebrity perfumes, has a name to be used as something that could be registered as a trademark. The marketing power, in more legal terms interpreted as economic value, and thus called economic function, comes from the goodwill the consumers relate to the celebrity and to their name, and for example the products they endorse. This area of legislation for trademarks is also tightly linked with the right for privacy, which makes it even more complicated. A landmark case for this was in 2001 the wedding of Catherine Zeta-Jones and Michael Douglas, for which the famous couple had sold the exclusive photography rights for a magazine, despite this a paparazzi managed to take unauthorized photos of the wedding. The paparazzi sold the photos for another magazine, and a court in the UK ordered both the magazine and the paparazzi to pay damages for the couple. The court treated the wedding in a similar manner they would've treated a trade secret, a product that could be sold⁶⁴. This has to do with the fact that celebrities and their publicity is in a sense a product, and thus the parts of their lives that are public, ought to be treated as products, and products have trademarks, in other words, names and sources of origin with economic value. This case that has occurred in the EU area, leaves to be seen whether the directive 2015/2436/EU will include sensation in its sphere of protection.

7.5. Motion/gesture

Trademarks could at least in the view of United States legislation can consist of movement, as for example the unique movement of the doors of Lamborghini car have received a protection for trademark in the United States. It is said, that motion marks have been accepted as trademarks in the European Union as well⁶⁵, but due to their rarity, they have maintained their

⁶³ Vaver D., Recent Trends in European Trademark Law: Of Shape, Senses and Sensation, Trademark Reporter Vol. 95 p. 907

⁶⁴ European Convention on Human Rights Art. 8 (1)

⁶⁵ Matthey L., Rock, Paper, Scissors, Trademark? A Comparative Analysis of Motion as feature of trademarks in the United States and Europe p. 557 Cardozo Journal of Intellectual and Comparative Law Vol. 14:557, 2006

position as non-conventional. Movement can be described graphically, even though that is not a requirement anymore in the new directive 2015/2436/EU for a trademark application to be taken into consideration. Motion has technically been possible to protect with trademark even in the time of the old directive 2008/95/EC, due to its nature of being possible to present graphically. It would be interesting to see in the future, if motion trademarks would receive a more established position as intellectual property rights, and if the new directive gives trademark applicants for example a possibility to attach a video of the movement as part of their applications.

However, interestingly there are not too many well-known court cases in the history of the ECJ concerning motion trademarks, from which it could be deduced, that the capability of motion to be graphically presented has not been really contested by the European trademark registration offices. In the United Kingdom the Derbyshire Building Society has been able to register gesture as a trademark, with the description: Gesture made by a person tapping one side of his/her nose with an extended finger, normally the index finger of the hand on the side of the nose being tapped.⁶⁶ Even if and when this trademark has been accepted for registration, it is questionable how original the mark in the end is, and if it is of much useful purpose or benefit for the trademark holder.

8. How is the new directive considered to improve the situation?

Being released from the need of asking for advice from the European Court of Justice, every time there is a slightly different case with a trademark application featuring a color, sound or shape than there has earlier been, should help with the amount of bureaucracy required to manage to register a trademark of non-conventional nature. Giving up on the requirement of graphical presentation of the trademarks can be considered also to lubricate making the applications online, as online it is possible to attach easily and effortlessly for example sound files that cannot be described in the manner of musical notation. The cases about graphical presentation could theoretically be solved by registration offices, however Sieckmann criteria poses a question, whether it is still in force, despite the requirement for being capable of

⁶⁶ Registration number 2012603

graphic representation has passed. In the future the cases potentially handle about what constitutes a clear, precise and exact presentation of the trademark that cannot be perceived visually, such as scents.

In the United States it has been noted, that it is difficult to find trademarks that do not consist of words from trademark registration databases⁶⁷ thus it shall remain for the future to show, whether or not this could cause problems in the European Union trademark registrations as well, with the passing of requirement of graphic presentation in the new directive 2015/2436/EU.

One of the ways the new directive 2015/2436/EU has been worded with a strong foresight, as now the European Union allows for the creativity of the trademark registration applicants to attempt presenting the trademarks they would wish to register in a clear and precise manner, even though they could not necessarily present the trademark by graphical means. This could be considered as official encouragement for creative ways of thinking and finding solutions for the trademark applicants to try and create new ways of registering the non-conventional trademarks.

Additionally, the new directive improves the situation of non-conventional trademarks, and by loosening the exact definition laid down in the directive, it widens the opportunities for new areas of trademark registrations. Even though colors and sounds have been possible to register earlier on as well, and those registrations have been based on caselaw, now they are also mentioned separately in the directive, which could be considered to move both colors and sounds away from the category of non-traditional trademarks, and into the category of traditional trademarks, as it is rare that anything officially admitted to would be in a serious manner considered a marginal activity anymore.

What is important to note with the new European Union Directive is, that the wording of Article 3 is so wide scoped, that by abolishing the requirement of graphic presentation, was also simultaneously abolishing the greatest obstacle in registration of non-traditional

⁶⁷ Burge, D., A., Patent and Trademark Tactics and Practice, 3rd Edition, John Wiley & Sons Inc, 1999, Printed in US, p.147

trademarks as well, and it could be imagined, that even though in the now freshly amended trademarks directive, there could and probably will turn out to be issues and wordings to be fixed and amended in the future, the Article 3 is written with such foresight and inclusion of all kinds of trademarks that, if they just fulfill the criteria of precise presentation and distinctiveness, it could be considered that there would be no serious reason why those could not be registered in the future. Also based on this it could be imagined that there probably would not be a big reason to amend the Article 3 of the trademarks directive anytime soon.

An interesting notion about the European Union Directive 2015/2436/EU, when compared to the United States legislation is, that even though United States has been the first of the two areas compared to accept more non-traditional trademarks, such as colors, sounds and even scents, not being too strict about the exact and precise definition of presentation of the trademark registration applied for. Whereas in the European Union the legal certainty has been an underlying principle in all rulings of the European Court of justice, and that principle has been the base on which the earlier directive 2008/95/EC was based on with the requirement of graphical presentation. Now that European Union has changed it's definition of the registrable trademark, it could be thought, that with the highest likelihood, European Union is still going to stick to the requirement of principle of exact and precise presentation of the trademark registration sought for, but additionally if there is a trademark that can be precisely presented, it could be considered that now European Union is slightly tilting towards the United States way of handling the issue of non-conventional trademarks, by giving them more space to flourish, in the form of changing the wording of the trademarks directive in a surprisingly radical manner, as can be noticed, when looking at the Article 3 of 2015/2436/EU from a closer distance, and analyzing it more in depth. Additionally, most of the biggest companies seeking after a registration of something generally considered as a non-traditional trademark, such as color, shape of packaging or product, sound, or even a scent, are most likely seeking after a global trademark, meaning that they would like to register the same thing in both United States and European Union, which is the moment when it brings out interesting and also rather difficult situations, when something can be protected by a trademark in the United States, but not in the European Union.

It could be considered, that the new directive 2015/2436/EU is limiting the scope of what have earlier on been considered as non-traditional trademarks, as they are turning more traditional by being more widely accepted in the legal community. This is a development of legal culture that has been going on for more than two decades in the European Union area. Slowly more and more non-traditional trademarks have been in the focus of discussion after several trademark cases, and the view of the courts have significantly evolved during this time.

9. The significance of the changes in the new directive

In general, the changes made from the 2008/95/EC directive to the new directive 2015/2436/EU in the definition of a trademark are in line with the European Union case law, and they are enforcing the settled case law on the issues of color and sound trademarks. Those are fairly easy to register, due to sonograms and international color identification codes. These can be precisely presented. However, even more fascinating aspect in the wording of the new directive than colors and sounds which were earlier on already quite established trademark material based on the case law, has been the abolishment of the requirement of graphic presentation.

Requirement of graphic presentation has caused severe difficulties in defining whether or not such trademarks as scents or tastes would be registrable in the European Union, as by the currently existing means, those are relatively difficult to register, or at least present graphically in a precise manner which would enable the registration. Even if the principle of precision is not forgotten in the course of the registration process, naturally in addition to the principle of distinctiveness, it will be left for the future to show, whether or not the abolishment of the requirement of graphic presentation will enable the registration of scents and tastes. However, the change in the wording in the new directive 2015/2436/EU in terms of graphic presentation carries a high significance, as it includes, or at least stops excluding, the kind of potential trademarks that are perceived by human senses, but just not by visual means. This could potentially carry a high value for a change in the future, as based on this, the "smell of freshly cut grass" might not end up being the only registered olfactory trademark in the European Union area anymore, but rather a landmark case for the future.

When it comes to the Sieckmann case in which it was established that for scent trademarks precision of description is the key, and theoretically they could be registered, but chemical formula, verbal description and scent sample are not enough to fulfill the criteria of graphic presentation. Perhaps in the future a chemical formula is enough for a registration, if the trademark fulfills the requirement of distinctiveness and originality?

The greatest significance to be expected from the the new directive 2015/2436/EU is allowing and making possible the future development in the field of non-traditional trademarks. Now it is assumed that even though the trademark needs to be precisely presented in the application, the preset supposition is not anymore that graphical presentation is the only precise manner to present something, and it leaves more room for the creativity for the future applicants in their attempts to precisely and accurately describe the trademarks they would like to apply for, even if this would not happen by graphical means, and the new inventive ways of describing those marks are not anymore instantly disqualified from the application process based on the requirement of graphic presentation, which has had an important role in the past.

The role and content of trademarks will most likely keep on growing in the future, especially from the economic point of view, when it shall be interesting to note, if it will be either for the technological development, that nowadays theoretically registrable trademarks could be described better and in an accurate manner, by for example using computer "noses" to analyze and catalogue registrable the scents more objectively than human beings ever could, and thus fulfilling the precision requirement of the registration application, or if it will be for the loosening of the European Court of Justice judgements, which will affect and allow non-visual trademarks, such as scents, and even tastes to be registered with a clear and objective enough description added to the application.

However, one legal instrument limiting the development of the scent trademarks, is the Sieckmann criteria. Before that one has been abolished by further European Union Court of Justice rulings on scent trademarks, in relation to the requirements for the contents of the

precise and clear enough presentation of the trademark, the new wording of the Directive 2015/2436/EU will not have too much affect on the field of scent trademarks.

The reason author finds scent trademarks so interesting, is that as it is clearly stated out in the directive 2015/2436/EU, that now colors and sounds have been separately mentioned as registrable, it in a sense dresses all the questions of the controversiality of those two types of trademarks. Then there are the scent trademarks, that have been under an intense discussion during the past decade or two, because theoretically they could be registered, and in the European Union one has even been registered, but despite that one hope reviving trademark registration it was later on ruled in a way that makes it extremely difficult to register olfactory trademarks.

Now that the requirement of graphical presentation has been removed from the wording of the new directive, one could expect, that it could be possible maybe after all to register olfactory trademarks, or that at least now there might be a new chance. And olfactory trademarks are not a point of interest only due to their rarity, but for the fact, that they have been a growing way of distinguishing businesses from one another in the recent past, and for example a scent of a clothing shop X or the scent of a interior design boutique Y are not anymore the kind of very special occurrences, but the businesses are actively trying to use scents in their services in order to distinguish themselves from others, so that when a consumer smells a scent X they would recognize it as being part of a trademark, by being reminded of that specific business that is using the scent. The other non-traditional trademarks are not as widely in use of business, and thus even though their registration will potentially turn into being easier in the light of the new wording of the new trademarks directive Article 3, those are still fairly marginal activities in comparison to the factual trade-relate usage of scents as signs of origin, also acting in the function of adding economic value to the trademark.

Conclusion

The author's aim while writing this bachelor thesis was to study, whether her hypothesis that the earlier definition for trademark, consisting only of visual elements, that could be graphically presented in the trademark application, were not up to date with the *de facto* legal culture of trademark protection of goods and services could be said to hold true. The wider aim was to study in general some underlying reasons for changing the definition of trademark from 2008/95/EC Art. 3 to 2015/2436/EU Art. 3.

The author does believe, that in this bachelor's thesis it was clearly pointed out how the European Union trademark legislation has changed through OHIM and ECJ decisions through time. I found that OHIM decisions on allowing or omitting the registration of a certain trademark, with certain kind of description at a certain point of time, were a source that the author did not imagine to be as important for the research, as it turned out to be.

The cases of registration that went through the ECJ procedure have gained the most attention and created their own legal formulas, such as the Sieckmann criteria. Curiously enough, now with the implementation for the new directive Art. 3, it is left to be seen whether Sieckmann criteria will leave in the history as a formula of the past. Author could argue, that even though the requirement of graphical presentation was abolished by the new directive, the principle of legal certainty is still requiring some kind of very exact way of presenting the trademark that is being applied for.

The findings with the study turned out to boil to one single point that rose above all the others: requirement for graphical presentation. In the European Union trademark legislation it could be described as the most significant change in the field of trademark law in decades.

The question of graphical description of the trademark also seemed to always lead to a second notable issue: non-traditional trademarks. Earlier on colors, sounds, scents, tastes, and the others have been perhaps slightly overlooked in terms of their goodwill and advertisement functions to the trademark, and those functions of the trademark have seemingly raised in value over time,

even if trademark's primary function still officially is the guarantee of origin function. However, it could be described, that if one would want to buy what is being protected by a trademark today, most likely one would want to buy the goodwill and advertising functions of the trademark, and not the factory where the product is originated from, because the products can be produced in an identical factory of nearly identical materials elsewhere, but the idea a consumer has of the product, being the goodwill and advertising functions, are very, and perhaps even more important for the potential future revenue in the eyes of a person buying a trademark.

Author could also note that trademark legislation is an extremely fascinating branch of law, as it is in the intersection of law and business, and a person with a legal education does not necessarily see the functionality of the trademark the same way as a person involved in business does. This might also lead to what people call interesting court decisions with an ironic tone of voice. Nowadays it is well established, that certain businesses use certain unique scents, and that people associate those scents with those businesses. With a slight hint of common sense, it would seem that in that case a business ought to be able to get a registration for their scent trademark. This has not been the case earlier on, and this could be dramatically changed soon, as the requirement of graphic description is abolished.

It could be described, that both the court and OHIM cases, that have been described above in the thesis, have shown, that the word of the law is very strong. However, as new kinds of trademarks emerge, the word of law has in some cases been followed to a certain extent only figuratively, because it has made no sense to completely ban something that has been in practice proved itself to be a functional trademark. It could be described, that law adapts to changing situations and to the modern reality by the usage of common sense of the judiciary, and that is the key to the change of the legal culture from the grass level. Usage of common sense.

Graphical presentation and it's link to non-traditional trademarks turned to be the carrying forces of this writing, and when the author started the project, she did not expect it. The author assumed the topic to be more focused in trademarks in general, and thus it was a surprise, when in the course of looking for sources graphical presentation and different types of non-traditional trademarks were mentioned over and over again.

The author first imagined, if the bachelor's thesis relies too much on non-traditional trademarks, but then she realized, that to fully make a thorough study on the topic, for the investigation of the change of the *de facto* legal culture, the only way was to find out as much as possible on non-traditional trademarks, as the most significant change in the directive applies to them, and to find out from the past, how favorable the registering authorities have been towards all possible types of non-traditional trademarks.

During the course of this work, the author personally became very fascinated especially with scent and taste trademarks, as they are still on the grey zone of registrability, despite the new directive 2015/2436/EU. Naturally, it is rather difficult to tell what will happen in the future, but the author will be interested in following the future ECJ and EUIPO decisions on these fields, as the object that has been applied registration for is not too complicated in itself, but the set of rules for trademark registration end up being extremely complicated when combined with these kinds of novel trademarks, taste and scent.

To conclude, it could be stated, that the hypothesis has been proven to hold true to some extent, as it can be noticed how especially regarding color, sound, shape and smell, OHIM and the courts have given decisions that vary when it comes to the registrability of the trademark that is being sought for. Even though the cases could be studied as single events, that have been considered only based on the particular case's facts, but when it comes to the thesis at hand, it can be seen that the decisions have been different throughout time, and it could be noted, that when reading this thesis, the reader should not limit oneself to only inspect one certain type of trademark registration application, but to look at the decisions as a whole, because in the eyes of the author it gives a wider and more general perspective on the change that has been going on in the legal culture in the European Union, and how it has both taken affect and given it to for example the United States courts as well.

It will be left for the future to show, how the EUIPO and ECJ will interpret the new wording of the Directive 2015/2436/EU Art. 3, and if the new wording will have even further effects on the non-traditional trademarks becoming more common, or if the change will only open up

a possibility, that will not be utilized by the mainstream trademark registration applicants any time soon. Also it could be an interesting further research question, whether or not this change from 2008/95/EC Art 3. to 2015/2436/EU Art. 3 will affect to the amount of non-traditional trademark applications, or whether it will stay stable.

An additional interesting question to find out would also be, that if a relatively similar research as this thesis right here was made in some years from now, what kinds of trademarks would be considered non-traditional and impossible or extremely difficult to register, and what kind of further amendments the next trademark directive after 2015/3624/EU would require to adapt to the changing needs of the industry? Author would be personally curious whether the taste, scent and tactile trademarks will gain a more established status in the future, or whether they will stay very difficult to register until the end of time, only because they are not possible to sense through vision, of all senses.

All in all, initially in the dawn of trademark legislation, the author would imagine, the functions of trademarks were much more limited. the purpose of a trademark was to separate one merchant from another. In the modern times, trademark registrations have turned into fireworks for all the human senses, the parties seeking for registrations are trying to win each other by being more unique and more novel in their registration applications, and the law makers are only trying to hold onto their hats and keep up with the times.

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