

DE/CTM: Difficulties in Registering Non-Traditional TMs

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Besides traditional trademarks that consist of words, illustrations, numbers or letter combinations, nowadays companies seek to get trademark protection for three-dimensional designs, colors, sounds or even scents – so called non-traditional trademarks. The registration practice of German and European trademarks became much more liberal within in the last years. What used to be unthinkable only a few years ago, is – theoretically – possible today.

The essential purpose of a trademark is to guarantee the identity of the origin of the marked product to the consumer or end user.¹ Therefore, requirement is that the signs are capable of distinguishing the goods or services of one company from the goods or services of other companies. Consequently, marks will not be protected if they consist exclusively of signs or indications which function to indicate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or description of the service, or other characteristics of the goods or service.² Such signs cannot function as trademarks and must be kept available for the general use in trade.³ These criteria apply to non-traditional trademarks as well as to traditional trademarks.

I will hereinafter give a short overview on the different types of non-traditional trademarks and the problems that occur when trying to get them registered.

Three-dimensional trademarks

Three-dimensional marks are popular, as they make it possible to protect the shape of a product in a three-dimensional way. Protecting the shape, i.e. the design of a product, is also possible by getting a design patent. This option has disadvantages though, as protection can only be obtained for 25 years and are renewable.⁴ Trademarks, in contrast, can be protected for 10 years and are unrestrictedly renewable.

However, the jurisdiction doesn't consider three-dimensional marks as distinct and hence protectable if they simply correlate with the common shapes of the product or are conditioned by the technical requirements.⁵ Accordingly, reproductions of goods or parts of goods have been held to lack distinctiveness as three-dimensional trademarks. This applied for instance to representations of

¹ *Bender, von Kapff*, Born to Be Free - The Community Trade Mark in Practice, IIC 2001, 625, 632.

² *Klett, Sonntag, Wilske*, Intellectual Property Law in Germany, 1. Aufl., München 2008

³ *Bender, von Kapff*, Born to Be Free - The Community Trade Mark in Practice, IIC 2001, 625, 639

⁴ *Hacker*, Markenrecht, 2. Aufl., Köln 2011, S. 40, Rn. 99

⁵ *Klett, Sonntag, Wilske*, Intellectual Property Law in Germany, 1. Aufl., München 2008

bakery goods⁶, torches⁷ or a drinking glass⁸.⁹ Therefore three-dimensional marks are often registered by acquiring secondary meaning by the use of the sign in business. Secondary meaning is acquired when the mark has obtained distinctiveness through intensive use, so that customers can identify the goods or services as originating from a particular undertaking. The Porsche AG used this method to protect the shape of "Porsche Boxter". The Federal Court of Justice held that customers of automobiles are used to reason the manufacturer from the shape of a car.¹⁰

Color marks

It is also possible to protect a certain contour-free color or color combination. The registration of color marks, however, has been implemented very restrictedly, as colors are not to be monopolized. There is a common interest of all economic participants that the use of colors is not unreasonably restricted. Therefore the registration of color marks is done only under strict requirements. Also colors are usually not capable of distinguishing the goods or services of one company from the goods or services of other companies, as in general the consumer will see a color as the goods' decoration, the background of publicity, etc., and not as an indication of origin. Consequently, e.g. light green and yellow have not been considered inherently distinctive for chewing-gum.¹¹

Only if the affected sector is very specific and the holder seeks protection for a very restricted number of goods or services, the color mark can be registered.¹²

Therefore, color marks also are mostly registered by acquiring secondary meaning by the use of the sign in business, for example magenta for the "Deutsche Telekom".¹³

To satisfy the requirement of graphical representation, the color cannot be registered by simply giving a printed sample of the color, because it is not permanent, but has to be specified according to one of the common color scales.¹⁴

Olfactory marks

Generally olfactory marks are protectable, as smells or odors are suited to be used as a distinguishing feature.¹⁵ In the case *Siekmann* the Court of Justice of the European Union affirmed the possibility that trademarks consist of signs which cannot be perceived visually *per se*, but can be made visible by being represented graphically. However, in the Commission's submission, a sign is capable of being registered as a trademark only if the subject of the registration application can be precisely defined.

⁶ 38 BPatGE 89 – *Gebäckstück*

⁷ Federal Patent Court, 1999 GRUR 56 – *Taschenlampen*

⁸ Federal Patent Court, 1998 Bl.f.PMZ 533 - *Trinkglas mit Luftblase*

⁹ Ströbele, The Registration of New Trademark Forms, IIC 2001, 161, 165 f.

¹⁰ BGH, GRUR 2006, 679, 681 *Porsche Boxter*

¹¹ Decisions of the Third Board of 18 December 1998 in Case R 122/98-3, *Wrigleys Light Green*, IIC 200, 329; *Bender, von Kapff*, Born to Be Free - The Community Trade Mark in Practice, IIC 2001, 625, 637

¹² *Berlit*, Markenrecht, 1. Aufl., München 2010, S 96, Rn. 67f

¹³ v. *Schulz*, Markenrecht, Kommentar, 2. Aufl., Hamburg 2007, S. 44, Rn. 11; GRUR 1999, 730, 731

¹⁴ *Hildebrandt*, Marken und andere Kennzeichen, 2. Aufl., Köln 2012; EuGH GRUR 2003, 604, 606 *Libertel*

¹⁵ BPatG GRUR 2000, 1044, 1046 *Riechmarke*

The purpose of graphic representation is to give a clear, precise and objective image of the mark.¹⁶ It is generally possible to graphically represent a scent. However it is not enough to simply deposit an example of the scent, as it is not permanent or describe the scent with a chemical formula, as the formula can only give information about the structure, but not of the scent itself. Therefore it wasn't enough to register an olfactory mark with the picture of a strawberry and the description "Odor of a ripe strawberry", as it was neither precise nor distinct and mainly affected by the subjective sensation.¹⁷ The problem of adequate graphical demonstration hasn't yet been solved. Therefore, except for the „smell of fresh cut grass" for tennis balls, all other applications for olfactory marks have so far been rejected. The German Patent and Trademark Office has not registered a single olfactory mark so far.¹⁸

Sound Marks

The applicant for a sound mark must submit both a two-dimensional graphic and an acoustic representation of the mark. It is generally not possible to describe the sounds like "roaring of a lion" in a clear specific way. Also the pure description of "the sound of a click" for medical instruments was not considered sufficient.¹⁹ However, sound marks are protectable if they can be represented by musical notation or in the form of a sonogram if it is clear how the music is actually played.²⁰ Difficulties can result in individual cases from the fact that the acoustic and the graphic representation are inconsistent. However, only obvious differences justify the rejection of the mark, since absolute identity between sound and image cannot be achieved even using musical notation, given the differences in instrumentation or performance.²¹

A more difficult question is that of the degree of originality and memorability that individual sounds or the most simple sequences of sounds must have in order to satisfy the minimum degree of distinctiveness. Without doubt, the artistic or aesthetic requirements applied will not be high; nevertheless, in particular in the case of a single sound or a sequence of identical sounds the question may arise whether these are sufficiently recognizable and memorable. The answer to this question will depend strongly on trade practice and advertising usage in the relevant goods and services sectors.²²

Other non-conventional marks

Also generally possible is the protection of even more exotic kinds of marks, like positional marks, tactile marks (interesting for example for blind people), taste marks, motion marks and so forth.²³

The problem with most of these exotic types of marks is the graphic representation as much as the distinctive character. E.g. tactile marks failed, as the illustration of an image can only give an optical

¹⁶ EuGH Urt. V. 12.12.2002, C-273/00, Slg 2002, I-11737

¹⁷ Hildebrandt, Marken und andere Kennzeichen, 2. Aufl., Köln 2012, S. 24, Rn. 8; EuGH GRUR Int. 2006, 134, 135 f. *odeur de fraise mûre*

¹⁸ Klett, Sonntag, Wilske, Intellectual Property Law in Germany, 1. Aufl., München 2008

¹⁹ Bender, von Kapff, Born to Be Free - The Community Trade Mark in Practice, IIC 2001, 625, 635

²⁰ Hildebrandt, Marken und andere Kennzeichen, 2. Aufl., Köln 2012, S. 24, Rn. 9; EuGH C-283/01 v. 27.11.2003 *Shield Mark*

²¹ Ströbele, The Registration of New Trademark Forms, IIC 2001, 161, 171 f.

²² Ströbele, The Registration of New Trademark Forms, IIC 2001, 161, 172

²³ Bender, von Kapff, Born to Be Free - The Community Trade Mark in Practice, IIC 2001, 625, 635

impression of the mark. The tactile sensation, which is supposed to be protected, cannot be illustrated in a picture. Positional marks are characterized by the purpose of protecting a certain positioning of something, e.g. a color, on a good. They also are generally able of being registered as a trademark. The position, of e.g. a red pointy end cap of a school cone, must be precisely defined for being able to be registered and the mark has to be distinctive.²⁴ The lack of distinctiveness is often a reason for rejection of positional marks.

Conclusion

As shown above, it is generally possible to protect all new types of trademarks as long as they satisfy the requirements. However, in the practice of registration this has been difficult, as the distinctiveness or graphical representation of non-traditional marks is often not being held sufficient. Yet, applicants should not hesitate trying to get protection for their marks and be persistent, as they might be successful.

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²⁴ Nordemann, Markenrecht, 11. Aufl., Baden-Baden 2012, S. 572