

The Future for Non-Traditional Trade Marks in Europe

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The suggestion that Europe should remove the graphical representation requirement from trade mark registrations won't open the floodgates to non-traditional marks... at least not yet, says Mark Devaney a Trade Mark Attorney in the London-based firm of Gill Jennings & Every LLP.

Over the years the requirement to represent trade marks in graphical form has proved a thorn in the side of brand owners hoping to register non - traditional trade marks. After all creating a picture of a smell or a sound, for example is far from intuitive. So could removing the requirement open the floodgates for the registration of new sorts of mark, and transform the way that trade mark attorneys work?

The potential for non-traditional marks is indeed great. Forward thinking brand owners continue to look at ever more inventive ways to communicate with their consumers and have attempted to move beyond the strictly visual, traditionally through words and logos, but also shapes, into other mediums including sounds and even smells and tastes.

But protecting these so called non-traditional trade marks has proved far from simple. Quite aside from the particular difficulty of proving that such trade marks are distinctive the added burden of the graphical representation requirement has scuppered many brand owners' hopes.

Those that haven't immediately given up have been forced to attempt all manner of "graphical" ways to describe non-traditional marks in applications for registration - often opting in the end for simple verbal descriptions. However, in many cases these attempts have failed, rejected on the grounds that they are not graphical representations of the trade marks themselves or do not clearly define the scope of protection sought. Smells and tastes in particular have been near impossible to register, thereby making it difficult for brand owners to enforce them.

Assuming the graphical requirement disappeared, where would that leave us? As with sound marks, technology may one day provide a way forward provided that brand owners can find a way to represent a scent in an application, and of course that they meet the distinctiveness requirements which will no doubt still preclude many such applications.

Having said that, it is difficult to see how this might work in practice. Whilst sound files are easy to send and access electronically, media for transmitting tastes and scents are not so readily available. It is difficult to see that a digital representation of a smell (perhaps a readout from a gas chromatograph) would be intelligible to the average consumer.

Could scents and taste samples be deposited at the trade marks office? Perhaps, but even if they could, it is difficult to see how a scent could meet the requirement of durability over a period of time, particularly since a trade mark registration can remain in force indefinitely.

Practical considerations for practitioners

Still, let's assume that these problems are overcome, that trade mark owners are able to find ways to represent the types of non-traditional marks discussed above that would satisfy the respective European trade mark offices, what would that mean for trade mark practitioners?

The first step for most brand owners when considering adopting a new trade mark is to conduct an availability search. In the case of visual marks, that process is a fairly straightforward one, and there are numerous databases carrying the relevant information for brand owners to make informed decisions. However, for non-traditional marks, without visual information regarding the scope of protection, it is difficult to see how a search could easily be conducted and consequently how assessments could be made as to whether a later mark is likely to infringe an earlier one.

Perhaps even more interestingly, in the absence of graphical information, and the significant amount of case law governing the comparison of visual word or design marks or those graphically represented, how does one begin to assess similarity, and how will the scope of protection these marks enjoy be judged?

Taking the example of sound marks, the current need for graphical representation means that a visual assessment can be made, the musical notation giving a graphic indication as to the resulting sound. If the assessment is to be made purely based on the actual sound of the mark, it seems that there is likely to be much more scope for interpretation since perception of sound arguably differs according to the listener. This subjectivity in interpretation is perhaps even more applicable in the case of tastes and scents, which are even more subjective and variable human senses.

All of this makes for some interesting scenarios. How will we be assessing similarity in the future? And will advances in technology mean less of a traditional role for the trade mark practitioner in making the assessment? We already have "audio fingerprinting", where it is possible to accurately identify content by digital analysis of audio and video image signals. Perhaps we are not far from the day when we submit an audio file to an automated system and the technology returns possible or likely matches. However, it is difficult to see how the final assessment could be made in this way, and surely there would still be a need for a human ear comparison.

As far as scents are concerned, will we one day see a flood of sommeliers taking the stand as expert witnesses to testify on the similarity of two smells or a new aspect to qualifying examinations for trade mark attorneys perhaps?

Conclusion

Whilst the suggested removal of the graphical representation requirement might at first sight appear to have the potential to open the floodgates to non-traditional marks, in practice it won't... at least not yet. Any relaxation will not have much immediate impact on the registration of sounds, where musical notation and images of sound waves seem to satisfy the courts, and the technology exists to deposit samples of sounds easily. It might impact how searches and comparisons of marks are carried out however, and here audio finger-printing technology may become a part of the trade mark practitioner's armoury.

When it comes to scents and tastes, the picture is more complicated. There appears to be a fundamental tension between the requirement that the representation be intelligible, which currently appears to rule out chemical formulae or digital analysis and the requirement that the representation be durable, unequivocal and objective, which would seem to rule out deposited smell samples.

Even if these hurdles can be overcome, it is clear that trade mark owners will still need to meet the current strict requirements for registration both in terms of representation and distinctiveness. However, it seems inevitable that at some point a change will come. When it does, practitioners may well be looking at a whole new way of assessing the similarities between marks and a raft of new case law will likely follow.

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