Attempts to register creative, non-traditional trade marks are becoming increasingly common, as opposed to applications to register traditional word or composite logo marks. There are currently hundreds of shape and colour trade mark registrations in Australia, over 30 sound registrations and, at the time of writing, one scent registration. However, it seems that shape, colour, sound and scent marks are now the “traditional” non-traditional trade marks, with even more innovative marks arriving on the scene.

Types of non-traditional trade marks

The definition of a trade mark in s 17 of the Trade Marks Act 1995 (Cth) ("the Act") specifically lists shapes, colours, sounds and scents but the definition is non-exhaustive and consequently also includes more unusual marks such as movement marks, holograms, tastes and textures ("non-traditional" non-traditional trade marks).

A search for colour, scent, shape and sound marks can be easily conducted by checking designated boxes in IP Australia's online trade marks database (ATMOSS). IP Australia published an Official Notice entitled “Glossary of Image Descriptors — Addition of new terms” in August 2011 advising that the following three terms have been added to the list of terms used to describe the non-text or visual features of a trade mark: movement, taste and feel. The Official Notice indicates that, to find trade marks with these features, one should enter the appropriate term into the “word/image” field in ATMOSS and select search option six: “exact image”. This update will make it easier to search for the more unusual non-traditional trade marks.

Examination of applications for non-traditional trade marks

There are no special examination provisions for non-traditional trade marks but there are some unique challenges for applicants seeking to register these types of marks.

Section 40: graphical representation

In order to be registered a trade mark must be represented graphically. For traditional trade marks this requirement is easily satisfied, but for non-traditional trade marks this requirement may be challenging (especially for sensory marks such as smells and tastes).

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1 Trade Mark Registration No 1241420 which consists of “a Eucalyptus Radiata scent” for golf tees.
2 Available at www.ipaustralia.gov.au.
3 Section 40 Trade Marks Act 1995 (Cth).
For moving images, holograms and gestures, the Trade Marks Office Manual of Practice and Procedure (the Office Manual) indicates that the applicant must provide: clear representations which show all of the features of the trade mark, a description of the trade mark which clearly describes all of the features of the trade mark and a copy of the actual trade mark. There are currently eleven registrations that match the movement descriptor on the Australian Trade Marks Register.

The Office Manual also provides commentary on the requirements for other kinds of non-traditional signs, including textures and tastes. The Office Manual provides an example for textures of a US registration where the trade mark is described as “the mark is flocked texture on a label to be used on a glass bottle” (Registration No 2,751,476). Another example of a texture mark that has been registered in the US is Registration No 3,155,702 where the trade mark is described as consisting of “a velvet textured covering on the surface of a bottle of wine”.

For tastes, the Office Manual indicates that the application would require the same kind of description as is expected for scent trade marks; with the taste described in words which make it clear exactly what the flavour is and how the taste will be used in respect of the goods claimed. For scent marks, the Office Manual indicates that “[t]he graphical representation must be in a form that conveys information to the ordinary person allowing them to identify the trade mark” but that “[h]ighly technical data will not be acceptable as a graphical representation”.

The rationale for s 40 is that the requirement for concise and accurate descriptions of trade marks enables adequate searching of the Register by non-experts. There are currently no registrations that match the feel or taste descriptors on the Australian Trade Marks Register.

**Section 41: capacity to distinguish**

Establishing that a mark is capable of “distinguishing” for the purposes of s 41 of the Act may be challenging for non-traditional trade marks. Section 41(2) provides that an application must be rejected if the trade mark is not capable of distinguishing the applicant’s goods or services in respect of which the trade mark is sought to be registered from the goods or services of other persons. For example, the Office Manual indicates that the textures of linen, leather, silk or fur would not be capable of distinguishing within the clothing trade and that masking flavours (for example cherry or strawberry flavouring for children’s pain relieving syrups and other medicines) have a functional purpose and are consequently not adapted to distinguish.

If a trade mark is not inherently adapted to distinguish, the trade mark may still be registrable if the Registrar is satisfied that the trade mark does or will distinguish the relevant goods or services (pursuant to sub-section 41(5)) or does in fact distinguish the relevant goods or services (pursuant to sub-section 41(6)).

When filing evidence for the purposes of overcoming a s 41 objection, it may be challenging to show that a non-traditional trade mark has been promoted as a trade mark. For example, the Office Manual indicates that statements such as “Look for the star shaped box” or “Unusual colours; exceptional

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4 Trade Marks Office Manual of Practice & Procedure, Pt 21, s 9.
5 Examples of movement trade marks that have been registered in Australia, the United States, the United Kingdom and the European Community are included in the Appendix.
6 Trade Marks Office Manual of Practice & Procedure, Pt 21, s 10.
7 Part 21, s 10 Trade Marks Office Manual of Practice & Procedure.
8 For both these US registrations, a more detailed description of the texture is included in the endorsements.
9 Part 21 s 10 Trade Marks Office Manual of Practice & Procedure.
11 Part 21, s 10 Trade Marks Office Manual of Practice & Procedure.
goods” are the type of promotional terms that may assist in demonstrating that a shape or colour has the capacity to distinguish and that evidence of advertising material that simply features the shape or colour is unlikely to be sufficient. In *Philmac Pty Ltd v Registrar of Trade Marks*, the Federal Court held that the colour terracotta was being used in respect of the connecting inserts of rural fittings in a trade mark sense, noting that the evidence included advertising materials that expressly drew attention to the colour as a point of difference by using references such as the “distinctively coloured terracotta inserts”. The *Philmac* decision can be contrasted with the decision in *Chocolaterie Guylian NV v Registrar of Trade Marks*, which involved an application by Guylian to register its chocolate seahorse shape. The court in *Guylian* considered that the shape was not being used as a trade mark on the basis, amongst other things, that the shape was being used on the packaging to attract consumers and provide an example of the box’s content. The court also considered that the use of the “Guylian” and “G” trade marks on the packaging diminished the trade mark significance the seahorse shape might otherwise have.

It seems that there will be particular challenges for establishing that a taste mark functions as a trade mark, given that the taste of a product is an inherent and essential feature of the product. The Office Manual suggests that “while ‘taste’ arguably falls within the definition of a sign, it is difficult to determine how a taste or flavour could serve to distinguish an applicant’s goods”. The Office Manual also points out that it may often not be practical (or hygienic) for a customer to taste goods prior to selection, and suggests that tasting the goods after purchase does not seem to meet the requirements of denoting a trade source. Interestingly, in the *Philmac* case the court concluded that the use of the colour terracotta applied to the connecting inserts of Philmac’s fittings was capable of distinguishing, and did distinguish, Philmac’s fittings but that the same conclusion did not apply to the split rings of the fittings, as the split ring was not a visual feature of the product in its assembled form and so the purchaser would not see the colour of the split ring until after purchase. Does this mean that a feature that is “concealed” until after purchase can never function as a trade mark? With respect to taste marks, the commentary in “Lahore Patents, Trade Marks & Related Rights” points out that, whilst taste may not function as a trade mark in respect of an initial purchase, taste may function as a trade mark for repeat purchases. The commentary in *Lahore* also refers to a decision relating to an application to register the shape of the “Kit Kat” chocolate bar noting that the hearing officer was prepared to assume that there could be use of the “Kit Kat” shape as a trade mark by way of pre-sale advertising and promotion even though the shape was concealed by the wrapping of the bar until after it was purchased.

In the United Kingdom, John Lewis of Hungerford Ltd applied to register “the smell, aroma or essence of cinnamon” for use in relation to furniture. There were problems with the description of the smell (which highlights the difficulties with providing an acceptable graphical representation for non-traditional trade marks) but it is also interesting to note that the evidence of the promotion of the

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13 Part 21, s 3.9 and 4.7 Trade Marks Office Manual of Practice & Procedure.
15 *Philmac Pty Ltd v Registrar of Trade Marks* (2002) 126 FCR 525; 56 IPR 452; [2002] FCA1551; BC200207590 at [460]–[467] and [475]–[478].
17 *Chocolaterie Guylian NV v Registrar of Trade Marks* (2009) 180 FCR 60; 82 IPR 13; [2009] FCA 891; BC200907428 at [43].
18 *Chocolaterie Guylian NV v Registrar of Trade Marks* (2009) 180 FCR 60; 82 IPR 13; [2009] FCA 891; BC200907428 at [44].
19 See commentary in: M Davison, T Berger, A Freeman, Shanahan’s Australian Law of Trade Marks and Passing Off, 4th ed, Lawbook Co, 2008 at [20.1230]. In particular, note the reference to the USPTO’s refusal to register the flavour orange for anti-depressant medication on the basis that the taste was functional and because consumers would view the flavour as an inherent feature of the product not a source of origin.
20 Part 21, s 10 Trade Marks Office Manual of Practice & Procedure.
21 *Philmac Pty Ltd v Registrar of Trade Marks* (2002) 126 FCR 525; 56 IPR 452; [2002] FCA1551; BC200207590 at [476]–[477].
23 A Duffy and J Lahore, Lahore Patents, Trade Marks & Related Rights, Butterworths, Sydney 1996, looseleaf.
24 Ibid at [53,055].
25 Ibid at [53,070].
furniture referred to including a sachet of cinnamon essence within the packaging or within drawers or cupboards of the furniture and a plan to use “scent strips” in adverts for magazines. Perhaps advertising including “taste strips” or some other means for customers to sample a distinctive taste prior to purchase would assist in establishing that the taste is being used as a trade mark? Pre-sale advertising promoting a taste by references such as “Unusual taste; exceptional flavour”, for example, may also be of assistance in securing a registration, depending on the circumstances.26

A further question is whether there could be some taste marks that are inherently adapted to distinguish, and which would consequently not attract a s 41 objection at all? With, for example, the current popularity of chefs experimenting with creating foods with unexpected tastes, perhaps there is some scope for a taste mark to be registered on this basis? Any such registration would, however, still be contingent on, amongst other things, an acceptable description of the taste being provided for the purposes of s 40.

An area of trade mark law that will continue to develop

Innovative advertising is likely to lead to increasingly innovative trade mark applications and it will be interesting to monitor the status of the Australian Trade Marks Register, and overseas Trade Marks Registers, as office practices develop around the registration of these types of marks. At this stage, it seems that there are more questions than answers in this developing area of trade mark law. There are also likely to be some interesting issues surrounding the enforcement of non-traditional trade marks that proceed to registration (and especially “non-traditional” non-traditional marks), including the question of deceptive similarity and whether allegedly infringing use constitutes use as a trade mark. The Office Manual indicates that an example of an acceptable description for a scent mark is the smell of apple blossoms applied to car tyres.27 Would the smell of cherry blossoms applied to motorbike wheels constitute an infringement of such a registration and what would be sufficient to constitute use of the cherry blossom smell as a trade mark? We will have to wait to see how these types of issues will be determined.

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26 In Philmac the Court noted that there was no evidence that the split ring was drawn to customers’ attention as a distinguishing feature of the product, either in promotional materials or by virtue of its visibility on the product: Philmac Pty Ltd v Registrar of Trade Marks (2002) 126 FCR 525; 56 IPR 452; [2002] FCA 1551; BC200207590 at [477].
27 Part 21, s 7 Trade Marks Office Manual of Practice & Procedure.