

United Kingdom
Royaume-Uni
Vereinigtes Königreich

Report Q.181

In the name of the United Kingdom Group by Jane Mutimear, Kathrin Vowinckel,
and Richard Abnett

**Conditions for registration and scope of protection of
non-conventional trademarks**

1. *How is the scope of what constitutes a registrable trademark defined? Does that definition list specific examples of permissible types of trademark?*

The UK Trade Marks 1994 Act (“the Act”) enacts the provisions of the First Council Directive of 89/104/EEC of 21 December 1988 to approximate the laws of Member States relating to trade marks (“the Directive”). The Act defines a “trade mark” in Section 1 in the same terms as the Directive as meaning “...any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.”

Section 1 goes on to state that a “...trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.” The use of the phrase “in particular” demonstrates that these are examples and the list is not exclusive.

2. *What categories of signs are capable of registration as a trademark? Are any categories of signs excluded from registrability as a trademark?*

In accordance with s.1 of the Act, the sign must be capable of being represented graphically and must be capable of distinguishing goods or services of one undertaking from those of other undertakings. Section 3 contains the absolute grounds for refusal of registration. This provision excludes from protection signs

- which do not meet the requirements of registrability set out in Section 1
- which are devoid of distinctive character
- which are descriptive
- which have become generic
- are contrary to public policy

Section 3(2), which concerns signs consisting of product shapes, is dealt with in detail in question 4 below. Section 4 of the Act contains details of specially protected emblems, such as the Royal arms, which are or may be prevented from being trade marks.

3. *Where applications to register a colour per se or a combination of colours per se may be accepted for registration:*

3.1 *in relation to goods, is such an application acceptable if it does not specify the outline, contours or proportions in which or the shape or object to which the colour is to be applied;*

A pure colour mark may be capable of registration – each application will turn on its own facts. It will however be difficult to prove that a pure colour mark does not fall foul of s.1(1) of the Act, due to the difficulty of graphical representation and demonstrating that the colour or colours are capable of distinguishing the goods of one undertaking from another. A lack of outline or contours around the colour(s) or any indication of proportions will increase the burden of proving factual distinctiveness. There are only a limited number of colours and strong evidence will be required to show that the public would expect goods sold under a particular colour to be the goods of one trader.

3.2 *is such an application registrable in relation to services and, if so, under what conditions;*

Services have no tangible form on which the colour can be applied, which creates an additional hurdle when trying to prove that colours per se are capable of fulfilling the functions of a trade mark and capable of sufficiently accurate graphical representation. There is no rule that colours per se are not registrable in relation to services, but in most cases acquired distinctiveness will need to be shown.

3.3 *is an applicant required to file a sample of the colour(s) applied for and/or a colorimetric reference or other colour code;*

Where an application is made to register a colour or colours per se, the Patent Office (Trade Marks Registry) has adopted the guidelines set out in *Libertel* (ECJ Case C-104/01, following *Sieckmann* ECJ Case C-273/00) and requires a written description of the colour accompanied by the relevant code or codes from an internationally recognised colour identification system. Other means will be acceptable if they can be shown to meet the *Libertel/Sieckmann* criteria. Where colour forms one of a number of different elements of the mark, the Registry is less strict, permitting descriptions as broad as “brown” and “red” provided it is clear which part of the mark is to be coloured and/or the provision of a colour sample.

3.4 *can the mark be considered inherently distinctive in relation to certain goods or services;*

Where a mark consists of a single colour, it may in theory be possible to demonstrate inherent distinctiveness. However, in practice it is extremely difficult to imagine such a situation and evidence will nearly always be required to demonstrate factual distinctiveness and overcome an objection under Section 3(1)(b) of the Act (devoid of distinctive character). A combination of colours may be registrable without evidence of acquired distinctiveness, but this will depend on individual factors, for example how the colours are applied and to what goods (or services) they are to be applied.

3.5 *will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown;*

As stated above, where the application concerns a single colour, evidence of factual distinctiveness will in practice be necessary and it may well be necessary where a combination of colours is involved. The evidence will need to show that the mark is viewed by the public as an indication of origin.

3.6 *are certain colours denied registration on the basis that there is a need to keep them free for general use;*

There is no specific rule relating to keeping colours free for general use. However, extra caution will be exercised by the Registry in considering applications for the registration of a single colour, especially when applied to packaging or get up. This caution exists partly due to the fact that there are only a limited number of colours which reduces the likelihood of the public viewing a single colour as distinctive of one trader's goods.

3.7 *to what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark?*

If the colours are within a figurative arrangement, this will help to ensure the mark is not rejected under s.3(1)(b) for lack of distinctiveness. Clearly, the more visually individual a mark, the more likely it is to satisfy the test of distinctiveness. A complex of different colours in a pharmaceutical capsule was held registrable under the old Act upon proof that it was widely recognised as a trade mark (*Smith Kline & French's Application [1976] R.P.C. 511*). This would probably apply today.

4. *Where applications to register three-dimensional signs may be accepted for registration:*

4.1 *what form of representation of the three-dimensional sign is accepted as part of the application for registration;*

Three-dimensional marks may be represented by a picture, or drawing, and/or words that describe the subject matter of the proposed registration as shown in the picture or drawing. However, attempts to put forward pictures as mere examples of the shape described in words may fall foul of the requirement that the mark be clearly understood by any person reading the register. When the subject matter of the trade mark cannot be captured from a single perspective view, multiple views of the shape should be filed (though the Registry limits the number of multiple views to six). Describing a three-dimensional article, without any pictorial representation, is unlikely to be sufficient.

4.2 *what are the criteria for assessing whether the three-dimensional sign can be considered capable of distinguishing the goods or services of one undertaking from those of another;*

Section 1 of the Act states that trade marks may, in particular, consist of "the shape of goods or their packaging". However, it is more difficult to demonstrate that signs that consist exclusively of the shape of the packaging or goods

themselves are capable of distinguishing the goods of one trader from another, without evidence of acquired distinctiveness. In addition, section 3(2) of the Act sets of a list of circumstances in which shapes as such cannot be registered, namely:

- a) shapes resulting from the nature of the goods themselves;
- b) shapes of goods necessary to obtain a technical result; and
- c) shapes which give substantial value to goods.

These exceptions are absolute and evidence of acquired distinctiveness will not overcome an objection based on section 3(2).

4.3 what are the criteria for assessing whether the three-dimensional sign can be considered inherently distinctive in relation to certain goods or services;

A three dimensional sign is inherently capable of registration if the shape is likely to be seen by the public as a designation of origin without the need to be educated that the shape is a trade mark. This is only likely to be possible where the shape is very unusual and distinctive in relation to the products in question, so that the shape immediately strikes the eye as different and therefore memorable and the differences between the applicants' shape and those used by other traders are arbitrary and not dictated by function or some other non-trade mark purpose.

4.4 will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown;

Not necessarily – although with the exception of very distinctive three dimensional marks, most applications to register shape marks will need to be supported by evidence of acquired (de facto) distinctiveness.

4.5 are certain shapes denied registration on the basis that there is a need to keep them free for general use;

There is no specific rule There has always been perceived a danger that registration of certain 3D shapes as trade marks would create a continuing right in design features which will block the legitimate use of similar elements by others. This is perhaps of more importance with regard to 3D shapes than for most other types of trade marks and this concern has been recognised in the *Linde* case before the ECJ (joined cases C-53/01 to C-55/01).

4.6 to what extent do other visual aspects of the way the mark is used affect the assessment of the distinctiveness of the mark;

Where the shape itself is devoid of any distinctive character, the sign may still be accepted if it contains additional matter such as colour, get up, words or devices. The Trade Mark Registry is, however, very clear that where the added matter is de minimis or unclear, or is itself devoid of any distinctive character, the application should be refused.

4.7 to what extent do technical or functional considerations prevent registration?

An explanation of s.3(2) has already been provided above, paragraph 4.2. It suffices to say that if the shape of the mark results from the nature of the goods themselves, or is the shape of the goods that is necessary to obtain a technical result, then the sign shall not be registered as a trade mark. The ECJ's decision in *Philips -v- Remington C-299/99* is applied by the UK Registry.

5. *Where applications to register smells may be accepted for registration:*

5.1 *what form of representation or description of the smell is accepted as part of the application for registration;*

Smell marks are the most difficult type of mark to represent graphically. The *Sieckmann* case in the ECJ ruled out the following types of graphical representations:

1. by a chemical formula;
2. by a description;
3. by means of a deposit; or
4. by a combination of the above.

Although a limited number of smell marks were registered soon after the introduction of the Trade Marks Act 1994, in the light of *Sieckman*, it is difficult to envisage how any smell could be registered, or how any of the registrations of smells previously obtained could survive an attack on validity.

5.2 *how is the capacity of the smell to function as a trademark and/or its distinctiveness assessed;*

Given the difficulty of graphic representation after *Sieckman*, the difficulties which would arise in relation to establishing that a smell functions as a trade mark, rather than as an attractive feature of the product itself is not one, which the Registry or the Courts have had to deal with. In the event that a registrant is able to overcome the difficulties faced in graphically representing their smell mark they would need to show that the public would consider the smell to be an indication of origin, which is only likely to be established by evidence of acquired distinctiveness.

5.3 *how is the mark made available to the public on publication of the trademark application and thereafter?*

Other than a very small number of smell marks which were registered shortly after the Trade Marks Act 1994 came into force, there have been no smell registrations. Those that do exist are written descriptions and are made available in the normal manner.

6. *Where applications to register a sound mark may be accepted for registration:*

6.1 *what form of graphical representation of the mark applied for is required as part of the application for registration;*

Sound marks must be capable of graphical representation to be registered. It is likely that the UK Registry will follow *Shield Mark* (ECJ Case C-283/01); musical notation will be accepted as a means of graphically representing sound marks. If the musical instrument used to produce the sound forms part of the mark, this should be stated.

Where the mark consists of a non-distinctive sound but is combined with other distinctive elements, such as words, it will be considered as a whole.

6.2 *can audio recordings of a sound mark be filed as part of the application for registration;*

Audio recordings are not accepted as part of the application, as consideration of the registrability of a mark focuses on the graphical representation of that mark. A sound recording is not a graphical representation.

6.3 *if such audio recordings are filed as part of the application for registration, how are these recordings made available to the public on publication of the trademark application and thereafter?*

N/A

7. *Where applications to register moving images or holograms may be accepted for registration:*

7.1 *what form of representation of the moving image or hologram is accepted as part of the application for registration;*

A hologram/moving image per se cannot form the basis of the representation, as this would not constitute graphical representation. Moving images can be represented by a sequence of still pictures and a written description describing the nature of the mark represented by the still pictures and the correct sequence that corresponds to the mark in use (Microsoft Explorer icon). An example of a moving image mark successfully registered in the UK is the Derbyshire Building Society's registration of a gesture made by a person by tapping one side of his/her nose with an extended finger on the side of the nose being tapped. Holograms are more problematic as it is difficult to represent the multiple features of a hologram graphically. Where this can be done, holograms are probably capable of registration in the UK. There is one decision from the Registrar where the applicant tried to rely on the holographic image itself as the mark and filed various prints for use in the journal. It was held that the prints were not sufficient to graphically represent the mark and the application was rejected (in the matter of Application No. 2031496 by Checkpoint Security Services Limited, 7 June 1999).

7.2 *how is the moving image or hologram made available to the public on publication of the trademark application and thereafter?*

The graphical representation of the moving image or hologram will be made available to the public as with any other type of graphical representation.

8. *How is the scope of protection of “non-conventional” trademarks assessed? In particular, are registrations for “non-conventional” trademarks treated any differently than registrations for “traditional” forms of trademark either in substantive or procedural terms?*

In the absence of any decided cases, one must assume that the scope of protection for non-conventional trade marks does not differ from the protection given to more traditional marks once registered. Where there are differences between the mark as registered and the sign complained of, the trade mark owner must demonstrate that despite the differences the public are still likely to be confused.

9. *To what extent is assessment of the registrability of “non-conventional” trademarks influenced by issues relating to enforcement and the scope of protection which should be afforded to those marks?*

The scope of protection given to a non-conventional mark is a factor which is in practice borne in mind, even though there is no specific consideration set out in the law in relation to this. There is a reluctance to grant trade mark protection to something more properly covered by patent or design rights.

10. *To what extent is the assessment of the registrability of “non-conventional” trademarks influenced by the fact that there may be a limited number of certain “non-conventional” marks (such as colours or shapes) available for general use?*

As described above, non-conventional trade marks have traditionally been treated with caution in the UK although there is no general rule (see paragraphs 3.6 and 4.5 above). Colour or shape marks must overcome the provisions of s.3(1)(a) and (b), and shape marks must not fall foul of s.3(2), of the Act. The ECJ’s decision in *Linde* joined cases C-53/01 – C-55/01 generally reflects the position adopted by the UK Registry, although the ECJ focuses on Art 3(1)(c) (i.e. descriptive marks) and the need to keep these free rather than a general application of this principle to all non-distinctive marks.

11. *To what extent is the assessment of the registrability of “non-conventional” trademarks influenced by the fact that consumers may be less used to understanding “non-conventional” marks as an indicator of origin?*

This concern is directly associated with the requirement for distinctiveness contained in s.3(1)(b) of the Act. Since consumers are less likely to view non-conventional marks as trade marks and thereby enable the mark to perform its required purposes, there is in practice a greater difficulty in establishing the same level of distinctiveness and evidence will be usually required to demonstrate that the mark has in fact acquired distinctiveness.

As well as stating the laws of their respective countries on the above-listed questions, Groups are invited to make any proposals for harmonisation of national laws which they consider desirable and to offer any further comments or observations of interest.

The public is used to viewing words and devices as signs, which distinguish one trader's product from another. There is no evidence to show that the public are as used to distinguishing colour, shape, sounds or smell as designations of origin in the same way. Stating that the same criteria of distinctiveness applies to all types of marks can be misleading, because in fact the Registry and the Courts consider that because of the different way in which consumers are likely to view non-conventional trade marks, in order to be considered inherently distinctive such marks need to be of a more distinctive nature than would be required of a word or device mark. Therefore although the same test is applied in relation to word and device marks and unconventional marks in relation to the fact that they all need to be capable of being seen as distinctive, in practice, this means that it is harder to establish that a non-conventional type of mark is inherently distinctive. Applicants would be given more certainty if this difference in approach in relation to conventional and non-conventional trade marks was made clearer.

In addition the evidence required to establish acquired distinctiveness to the satisfaction of the Registry varies from country to country. This places an unnecessary burden on applicants who require trade mark protection in multiple countries. Therefore steps to harmonise the evidential requirements to demonstrate acquired distinctiveness would be welcomed.

Summary

The UK Registry follows the case law and decisions from the European Court of Justice and OHIM in relation to the registration of non-conventional marks. The UK Registry is more likely to reject an application for a non-conventional mark on the basis that it is devoid of distinctive character than one for a word or device, as it is recognised that consumers often need to be educated to view non-conventional marks as trade marks. Therefore it is very often necessary to show acquired distinctiveness before non-conventional marks can be registered.

The UK group believes that it would assist trade mark owners:

- (1) if the position regarding distinctiveness of non-conventional marks was made clearer, and
- (2) if the type and amount of evidence required to establish acquired distinctiveness was harmonised.

Zusammenfassung

Das britische Eintragungsamt richtet sich bezüglich der Eintragung nicht herkömmlicher Marken am Fallrecht und an den Urteilen des Europäischen Gerichtshofs sowie des HABM aus. Die Wahrscheinlichkeit, dass das britische Eintragungsamt eine Anmeldung auf Eintrag einer nicht herkömmlichen Marke ablehnt, ist größer, wenn diese keine deutliche Eigenart besitzt, als wenn es sich um ein Wort oder ein Emblem handelt, da es als anerkannt gilt, dass Verbraucher häufig erst dazu erzogen werden müssen, nicht herkömmliche Marken als Marke anzuerkennen. Es ist daher in vielen Fällen notwendig, eine deutliche Eigenart nachzuweisen, bevor nicht herkömmliche Marken eingetragen werden können.

Die Landesgruppe des Vereinigten Königreichs ist der Ansicht, dass Markeninhabern geholfen wäre, wenn:

(1) die Position hinsichtlich der Eigenart herkömmlicher Marken deutlicher wäre und

(2) Art und Umfang der zu erbringenden Beweise für eine deutliche Eigenart harmonisiert werden würden.

Résumé

En matière d'enregistrement de marques non conventionnelles, le bureau britannique "UK Registry" se base sur la jurisprudence et les décisions de la Cour de Justice Européenne et de l'OHMI. Il y a de plus grandes chances que le bureau britannique rejette une demande concernant une marque non conventionnelle en se basant sur le fait qu'elle est dépourvue d'un caractère distinct, plutôt qu'une demande concernant un mot ou un appareil; puisqu'il a été reconnu que les consommateurs ont souvent besoin d'être éduqués avant de considérer des marques non conventionnelles comme des marques de fabrique. Il est donc très souvent nécessaire de démontrer que les marques non conventionnelles ont acquis un caractère distinctif avant que celles-ci puissent devenir des marques déposées.

Le groupe britannique estime qu'il serait possible d'aider les détenteurs de marques de fabrique:

(1) en clarifiant la position relative à la distinction concernant les marques non conventionnelles et

(2) en harmonisant le nombre et le type de justifications nécessaires pour établir cette distinction.