Question Q181: Conditions for registration and scope of protection of "non-conventional" trademarks

Tuesday, June 22, 2004 (09.00 - 11.00)

Chairman of the Session: François CURCHOD (Switzerland)
Deputy Reporter General: Ian KARET (UK)

Mr François CURCHOD, Chairman of the Session (Switzerland), welcomes everyone and opens the Session.

Mr Ian KARET, Deputy Reporter General (UK), gives a short introduction to the topic. This Question was selected as a result of changes in commercial practice. Trademark owners have in recent years increasingly obtained protection for unconventional marks. The Reporter General received 36 Reports from National and Regional Groups. One of the key problems in the discussions in the Working Committee was that the mark must be capable of graphic representation. How else could the public find out what is really protected? Nowadays sounds can be easily stored. There are a number of ECJ cases on colour and sound marks, and there are some cases in the USA. The majority of the Group Reports, however, list only few court cases. In the Group Reports the same standard questions arise. Can non-conventional marks fulfil the primary function of a trademark? Can non-conventional marks be graphically represented?

Mr CURCHOD thanks Mr KARET for this introduction and calls on Mr Michael TREIS, Chairman of the Working Committee (Switzerland), to speak.

Mr TREIS then presents the Resolution which was adopted in the Working Committee. With reference to recital e) he mentions the tension between the wish to protect a mark and the difficulty in representing the mark for the purpose of informing the public. With regard to recital f) Mr TREIS emphasises the fact that colours are often used for decorative purposes and, therefore, only rarely perceived as an indication of origin. He further addresses three-dimensional shapes and the interface with design law as well as patent law and stresses that no perpetual protection is sought. Finally, he stresses the fact that many countries would allow registration of colours and three-dimensional shapes only on the basis of acquired distinctiveness (secondary meaning).

Mr CURCHOD thanks Mr TREIS for his introduction and puts the Resolution to discussion. He stresses that he would first go through the Resolution para. 1-7 and then the recitals. He reminds the Delegates of the voting rules.

Mr Ernesto O’FARRELL (Argentina) wishes to include a qualification in para. 1 to the extent that only non-conventional marks that have clear characteristics should be able to constitute registered trademarks.
Mr Jorge OTTAMENDI (Argentina) does not agree with this proposal as the recitals already sufficiently describe the limits.

Mr Richard ABNETT (UK) supports the proposal of Mr O'FARRELL, but proposes to include "in principle" in the middle of the sentence.

Both Mr Robert SACOFF (USA) and Mr KARET agree with this proposal. Mr KARET emphasises that he prefers the more positive language.

Mr CURCHOD puts the amendment to a vote.

*The amendment is carried.*

Mr CURCHOD then puts the entire para. 1 to a vote.

*Para. 1 is carried.*

Mr Alexander VON MÜHLENDAHL (Germany) proposes to delete the term "self-contained" in para. 2. He explains that for instance a colour code is not a self-contained representation, yet it is a generally accepted representation.

Mr CURCHOD puts the deletion to a vote.

*The amendment is carried.*

Mr Alexander SOLF (Germany) proposes to include the term "third parties" instead of the "public" in para. 2. Mr Geoffroy GAULTIER (France) supports this proposal. It would make clear that third parties must also be able to easily identify the trademark. Mr István GÖDÖLLE (Hungary) also agrees with this proposal. He further reminds the Delegates that the term "third parties" had already been included in the original draft Resolution.

Mr KARET reminds the Delegates that this issue also arises in the context of traditional marks and that it had already been discussed in the Working Committee which eventually opted to take it out. Mr CURCHOD confirms that "public" is broad enough to include third parties.

Mr TREIS asks Mr GAULTIER whether the language in para. 2 to the effect that "the representation must be easily accessible" takes care of his concerns. Mr GAULTIER agrees with this proposal in principle, but proposes to put the second sentence in para. 2 in front to emphasise its importance.

Ms Jane MUTIMEAR (UK) proposes to take out "and the scope" in para. 2 as scope is something for professionals to advise on. Ms Antonia RUIZ LOPEZ (Spain) disagrees and prefers to leave the text unchanged.

Mr Bo DAVIDSSON (Sweden) proposes to switch the order of sentences in para. 2, to take out "scope" and the first half of the sentence.

Mr KARET reads out the new text of para. 2 as follows: "The representation of a "non-conventional" trademark must be clear, precise, easily accessible and intelligible. The public must be able to understand the nature of the trademark."

Mr CURCHOD supports leaving in the term "public", so that consumers are included as well. He puts the suggested amendment (replacement of "public" by "third parties") to a vote.

*The amendment is not carried.*

Mr CURCHOD puts the new text to vote.
The new text of para. 2 is carried.

Mr Shane SMYTH (Ireland) and Ms Marianne LEVIN (Sweden) propose deleting "in relation to certain goods or services" in para. 3 as this language is considered superfluous.

Mr GÖDÖLLE rejects this proposal. Mr Peter Dirk SIEMSEN (Brazil) and Mr Clark LACKERT (USA) both support Mr GÖDÖLLE. Mr SIEMSEN points out that the Resolution is also addressed to GOs in which case it is important to have a clear language. Mr LACKERT prefers the current language because it includes both goods and service marks which distinction is not yet known in all countries.

Mr CURCHOD puts the amendment (deletion of "in relation to goods and services") to a vote. The amendment is not carried.

Mr VON MÜHLENDAL asks whether "colour" in para. 3 also includes colour combinations. He further points to an inconsistency in language in para. 3 (which speaks of "can be capable of registration as a trade mark") and para. 4 (which says "may be registered as a trade mark").

Mr TREIS confirms that colour only refers to single colours. Mr KARET confirms that the language in paras. 3, 4, 5 and 6 should be the same. Para. 3 therefore needs to be changed. This can be taken as a drafting point.

Ms MUTIMEAR proposes to include colour combinations in para. 3 so that the public will not misunderstand the Resolution. Ms LEVIN does not support this proposal.

Mr ABNETT enquires whether the Working Guidelines had covered colour combinations. Mr KARET says no - even though some few Group Reports did cover colour combinations. Mr KARET agrees that the Resolution should not cover colour combinations if they had not been covered by the Working Guidelines.

Ms MUTIMEAR withdraws her proposal.

Mr CURCHOD notes that there will be no reference to colour combinations. He puts the whole para. 3 to a vote. Para. 3 is carried.

Mr VON MÜHLENDAL mentions that under European law there are three possibilities of grounds for exclusion of a three-dimensional mark (nature of goods, technical necessity, substantial value to the goods). He notes that the third alternative is not mentioned and, therefore, proposes to include "or gives substantial value to the goods" in para. 4.

Mr OTAMENDI does not agree with this proposal as the notion of substantial value to the goods is not universally recognised. Mr KARET does not agree either. We do not know whether there are any previous Resolutions concerning this issue.

Mr TREIS thinks that the notion of "substantial value to the goods" is covered by the notion of "nature of the goods".

Mr CURCHOD announces that he will first discuss and put to a vote paras. 5-7 and then revert to para. 4.

As there are no comments concerning para. 5, Mr CURCHOD puts para. 5 to a vote. Para. 5 is carried.
Mr ABNETT goes back to para. 5 and enquires what graphic representation means in the context of sound. Mr VON MÜHLENDHAHL also refers to para. 5 indicating that according to the Resolution sound no longer needs to be subject of graphic representation. He asks whether a sound sample would constitute a graphic representation.

Mr KARET answers in the negative and explains that the Working Committee did not want to limit itself. The Working Committee thought that a sound sample would be better than a sonogram. The Working Committee’s intention is to change the offices’ practices.

Mr ABNETT submits a written proposal to be included at the end of the sentence and which reads: "or at least any representation complying with paragraph 2 shall be regarded as a graphical representation".

Mr KARET is not in agreement with the text as proposed by Mr ABNETT because graphical means "writing". Mr Helmut SONN (Austria) thinks that the original text goes too far and that there should be a writing requirement.

Mr OTTAMENDI and Mr SIEMSEN support the original text. A sound sampling should be sufficient; we do not want to end up stating that a mark can only be represented graphically.

Mr CURCHOD puts the amendment proposed by Mr ABNETT to a vote.  

*The amendment is not carried.*

Mr CURCHOD announces that para. 5 stands as it had already been approved.

Mr Pierre GENDRAUD (France) proposes to include "persistence over time (durability)" in para. 6.

Mr SONN does not see how a smell can be reproduced. He urges that "represented" be defined in a better way; does it only mean to include samples?

Mr KARET mentions that this had already been discussed thoroughly in the Working Committee and that the state of technology will bring about the necessary changes.

As there are no further comments, Mr CURCHOD puts para. 6 to a vote.

*Para. 6 is carried.*

Mr Felipe CLARO (Chile) notes that the Resolution lacks a paragraph on tactility marks. Mr KARET notes that tactility marks had not been covered by the Working Guidelines, the Group Reports or the Working Committee and should, therefore, be left out from the scope of the Resolution.

Mr CURCHOD puts para. 7 to a vote.

*Para. 7 is carried.*

Mr CURCHOD then goes back to para. 4 to reopen the discussion on this para.

Mr KARET mentions that Resolution Q148 on three-dimensional marks had been adopted in Sorrento in 2000. Mr KARET proposes to take out para. 4 altogether or to refer to Resolution Q148 and confirm it.

Mr SONN is against taking out the whole paragraph. Mr KARET agrees and proposes to refer to paragraph 5 of Resolution Q148 and to confirm it.
Mr CURCHOD puts this proposal to a vote.

*The amendment is carried.*

Mr CURCHOD then goes through the Recitals and the "Noting" clauses. As there are no substantial comments, he puts the Recitals and the "Noting" clauses to a vote.

*The recitals and "Noting" clauses are carried.*

Mr CURCHOD puts the Resolution as a whole to a vote.

*The Resolution as a whole is carried.*

Mr CURCHOD thanks all the participants and closes the Plenary Session.

Minutes: Thierry CALAME, Assistant to the Reporter General (Switzerland)