Introduction

For the answers of several questions it is relevant that - according to the European Trademarks Directive - all trademarks should be capable of graphic representation. This does NOT imply that trademarks themselves should be capable of visual perception (see infra 2.2). This opens the possibility that sounds and smells can be valid trademarks. However, all trademarks should be represented graphically in the trademark filing, which means that they will have to be described in a sufficiently clear, precise, self-contained, easily accessible, intelligible, durable and objective manner (Sieckmann, ECJ 12 December 2002, case C-273/00). The Sieckmann case has shown that the standards to meet are high. In fact so high that it might be practically impossible to register olfactory trademarks (although they are NOT excluded by art 2 of the Trademarks Directive). For sound marks there still seem to be good possibilities, on the basis of the Opinion of A-G Juiz Jarabo Colomer (3 April 2003, case C-283/01). He concludes that the same requirements as in the Sieckmann case should be met, and that - although the appreciation should be left to national courts - these requirements seem be met in case of a musical notation. He also considers that descriptions in words would usually not meet the requirement of being sufficiently clear and objective. The Libertel case (ECJ 6 May 2003, case C-104/01) has shown that the requirement of durability leads to practical implications, at least for colour marks; one should use an internationally recognised identification code. It remains to be seen what the consequence will be for other trademark registrations, which include colours.

The Libertel decision furthermore shows that a colour per se (without any spatial delimitation) can have sufficient distinctive character and that it may be represented graphically in such a way that it is described in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner. As for distinctiveness the court stresses the public interest to keep colours free for use by other traders, which would have to be taken into account when assessing the distinctiveness of the trademark. In this respect, also the number of goods and services for which registration is sought, should be taken into account; the more there are, the stronger the public interest to keep the colour free for use by other traders. The answer to the fifth question and consideration 66 in this case indicate that in case of colour marks distinctiveness should usually be acquired through use.

As for three-dimensional trademarks and distinctive character, guidance can be taken from the decision of the ECJ in the joint cases Linde, Winward, Rado/DPMA (ECJ 8 April 2003, cases C-53/01, C-54/01 and C-55/01). The general basis is that all signs capable of graphic representation that can distinguish the goods or services of one undertaking from those of other undertakings, can be a trademark. There is no ground to apply a stricter criterion when three-dimensional trademarks are concerned. The limitation of art 3 par. 1 under c of the Trademarks Directive has
relevance next to the limitation of art 3 par 1 under e, which applies to three-dimensional trademarks specifically. In particular the ECJ stresses that one should take into account the public interest, which is that all three-dimensional shape of product trademarks which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of that provision should be freely available to all. A similar approach can be found in the decision Philips/Remington (ECJ 18 June 2002, case C-299/99). There the public interest was mentioned (cf. consideration 78) as the background for the limitation of Article 3(1)(e), second indent, of the trademarks directive. The court concluded that this provision must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained. However, in the same decision the court stressed that in order for a three-dimensional to have sufficient distinctive character, it is NOT necessary that the shape has any capricious addition, such as an embellishment which has no functional purpose. Also, three-dimensional marks can acquire distinctiveness. No harsher requirements apply on the ground that a three-dimensional trademark is involved.

Questions

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

   Art 1 Benelux Trademarks Act defines trademarks as follows. As individual trademarks will be considered: the names, drawings, prints, stamps, letters, numerals, shapes of goods or packaging, and all other signs, that serve to distinguish the goods of an undertaking.

   Art 2 of the Trademarks Directive - on which art 1 of the Benelux Trademarks Act is based - contains the following definition. Trademarks can consist of all signs which are capable of graphic representation, in particular words, including personal names, drawings, letters, numerals, shapes of goods or of packaging, provided that these can distinguish the goods or services of an undertaking.

   As will be clear from the above, certain examples are mentioned (words, (personal) names, drawings, prints, stamps, letters, numerals, shapes of goods or packaging, but this list is not exhaustive.

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

   First of all it should be noted that all signs which are capable of distinguishing the goods or services of one undertaking from those of another undertaking and which are capable of graphic representation (see above Introduction) are capable of registration as a trademark. This is not only based on art 1 Benelux Trademarks Act and art 2 of the Trademarks Directive, but can also be derived from Court of Appeal Den Haag 27 May 1999, BIE 1999/71 and IER 1999/32 (Für Elise soundmark) and Sieckmann, in particular consideration 44, which states that the list in art 2 of the Trademarks Directive is not limitative (consideration 45 adds that even signs which are not capable of visual perception, can be valid trademarks).

   As follows from the above, there are no categories of signs excluded from registration as trademarks. Only some particular limitations apply to three-dimensional trademarks (see infra question 4).

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?

According to the ECJ in Libertel a colour per se is, in relation to a product or service, capable of constituting a trademark. To be registrable the application of the colour trademark needs to comply with the requirements that were laid down in the Sieckmann decision of the ECJ (see 0, 5 and 6). The circumstances under which an application of a colour per se, with no specification of the outline, contours or proportions in which the colour is to be applied, is acceptable for registration are set out under 3.3.

3.2 Is such an application registrable in relation to services and, if so, under what conditions?

Although there is a clear difference between the use of colour marks for goods and for services - in case of goods the colour can be applied to the goods while in case of a service mark one can not apply the colour on the services - the ECJ in Libertel does not lay down any special requirements for services. The same requirements as for goods can therefore be applied for services.

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?

If the application does not specify the outline, contours or proportions in which or the shape or object to which the colour is to be applied a mere sample of a colour does not satisfy the requirements set out in Sieckmann (and repeated in Libertel consideration 28 and 29). In particular a sample of a colour may deteriorate with time. Therefore it does not possess the required durability (see Sieckmann, consideration 53 and Libertel consideration 32 and 33) and does not constitute a graphic representation within the meaning of Article 2 of the Directive.

However, a verbal description of a colour, in so far as it is composed of words which themselves are made up of letters, does constitute a graphic representation of the colour (see Libertel, consideration 35). Whether a description in words of the colour will indeed satisfy the conditions set out in Sieckmann and Libertel is a question which must be evaluated in the light of the circumstances of each individual case.

The same can be said for a combination of a sample of a colour with a description in words and for the designation of a colour only using an internationally recognised identification code (see Libertel, consideration 36 and 37). Whether these applications will indeed satisfy the conditions set out in Sieckmann and Libertel is a question which must be evaluated in the light of the circumstances of each individual case.

Where a sample of a colour, together with a description in words, does not satisfy the conditions laid down in Article 2 of the Directive in order for it to constitute a graphic representation because it lacks precision or durability, that deficiency may, depending on the facts, be remedied by adding a colour designation from an internationally recognised identification code (Libertel consideration 38).

3.4 Can the mark be considered inherently distinctive in relation to certain goods or services?

According to the ECJ in Libertel (consideration 66) in case of a colour per se, distinctiveness without any prior use is inconceivable safe in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific. It must therefore be accepted that colours per se can in certain cases be inherently distinctive.

3.5 Will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown?
According to the ECJ in Libertel it must be accepted that colours per se may be capable of distinguishing the goods or services of one undertaking from those of other undertakings, within the meaning of Article 2 of the Directive. Although in most cases the distinctiveness of a certain colour will only be present after the colour has been used for a considerable amounts of time and/a with great exposure to the relevant market time, the ECJ accepts under exceptional circumstances distinctiveness (and following registration) of colour mark without prior use (see 3.4).

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

No. However, according to the ECJ in Libertel (consideration 55 and 56) it must be acknowledged that there is, in Community trade-mark law, a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought. The greater the number of the goods or services for which the trademark is sought to be registered, the more burdensome the exclusive right which it may confer is likely to be, and the more likely is that right to come into conflict with the maintenance of a system of undistorted competition, and with the public interest in not unduly restricting the availability of colours for the other traders who market goods or services of the same type as those in respect of which registration is sought.

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?

Since the competent authority for registering trademarks has to satisfy itself that the sign is not devoid of distinctive character for the goods or services of the undertaking seeking its registration as a trademark, it must consider the actual use made of the trademark. That examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trademark registration is sought (Libertel consideration 76). Therefore, in our opinion the way a mark is used can effect the assessment of the distinctiveness of the mark. The extent of it must be evaluated in the light of the circumstances of each individual case.

Additional comments and questions of the Working Group Q181

Combination of colours

The answers above refer to colour marks per se and to a combinations of colours per se. However, we have some doubts whether an application for registration of a combination of colours per se complies with the requirements that were laid down in the ECJ Sieckmann decision (see 0, 5 and 6). One has to bear in mind that Libertel only deals with a single colour mark per se and not with a colour combination per se. The question is whether an application for a combination of colours per se, which does not specify the proportions and division of both the colours, is clear, precise, self-contained and objective (Sieckmann, consideration 47 to 55). For example, is it clear and precise what kind of protection is sought by filing a square colour sample with the upper side red and the lower side yellow? Does this mean that protection is claimed for a trademark in which the lower part is always yellow and the upper part is red? and in which the use contains a 50/50 ratio?

Meanwhile, after Libertel, there is one decision about a trademark combination of colour per se (Stihl, Court of First Instance). In the Stihl-case the CFI just seems to consider it an established fact that a colour combination per se complies with the requirements laid down in Sieckmann. It is striking to see that in this decision the CFI has made no reference at all to the Libertel decision, although the Stihl decision was handed down after the Libertel-decision (i.e. on July 9, 2003).
**Requirement of durability: also to be applied to device registrations in colour?**

With regard to the requirement of durability the question can be raised whether this requirement should also be applied to other device trademark registrations which contain colours (for example a colour label of a packaging). According to the ECJ in Libertel a sample of a colour may deteriorate with time. In our opinion the same can be said with regard to a device mark that contains colours. Does this mean that one can doubt about the validity of a registration of a device mark in colour, as far as no internationally recognised identification code is used to identify the colours?

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?**

Article 1 (4) of the implementing regulations of the Benelux Trade Mark Act jo. art. 1 (1) (d) of the application regulation provides that the representation of the mark may consist of either a photographic representation which is rich in contrast or a graphic representation. All characteristics of the mark have to be clear, readable and distinctive. The applicant may provide three different side views of the mark. Often line-drawings are used (and accepted).

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?**

For a mark to possess distinctive character within the meaning of that provision, it must serve to identify the product in respect of which registration is applied as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings. There is no higher standard to meet when compared to other kinds of trademarks.

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?**

In Linde, Winward, Rado/DPMA, the ECJ held that a trademark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court’s case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 Gut Springenheide and Tusky [1998] ECR I-4657, consideration 31, and Philips, consideration 63).

4.4 **Will the mark only be accepted for registration after de facto distinctiveness acquired through use has been shown?**

ECJ repeated in Linde, Winward, Rado/DPMA that the rules for three-dimensional trademarks are the same as for any other trademark if they do not fall under the specific exemption of art. 3 (1) (e). However, the court clearly indicates that it may be more difficult for a three-dimensional mark to meet the requirement of (art. 3 (1) (b)) having a distinctive character, because the public confronted with a product with a new shape will normally not see such shape as a sign of origin but just as a new product. This can be different when the shape has been used as a trademark before registering, and has acquired secondary meaning, necessary to be distinctive. Thus, often distinctiveness will have to be acquired through use.

4.5 **Are certain shapes denied registration on the basis that there is a need to keep them free for general use?**
No. According to the ECJ in Philips/Remington, there is no category of marks which is not
excluded from registration by article 3(1)(b), (c) and (d) and article 3(3) of the Directive, but
which is nonetheless excluded from registration by article 3(1)(a) thereof on the ground that
such marks are incapable of distinguishing the goods of the proprietor of the mark from
those of other undertakings.

In our opinion a need to keep a shape free - which is a legal notion based on the interests
of the public - should not be the argument to decide that such shape is not capable of dis-
tinguishing, which is a purely factual notion. In other words: it may well be that a shape is
capable of distinguishing, but that yet it may not be registered as there is a need to keep it
free; in such situation the refusal should not be based on article 3(1)(a). The decision of the
CFI in the Unilever-case (Case T-194/01) seems to be somewhat in contradiction with this
decision. In consideration 66, the CFI ruled that, on the assumption that it is in fact difficult
for technical reasons to produce tablets whose shapes differ significantly from one another,
registering shapes which are very close to the commonly-used basic shapes would in-
crease the risk of granting to one operator alone, by means of trade-mark law, exclusive
rights which could hinder competition on the market for the goods concerned. The absolute
grounds for refusal specifically address the concern of the Community legislature to prevent
the creation of such monopolies.

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?

The ECJ stated in Philips/Remington and in Linde, Winward, Rado/DPMA that purely func-
tional three-dimensional marks, without any "embellishment" or "capricious addition" can be
trademarks because the exception for "technical" three-dimensional marks of article 3(1)(e)
applies if the essential functional features of that shape are attributable only to the techni-
cal result.

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

According to the ECJ in Philips/Remington, a sign consisting exclusively of the shape of a
product is unregistrable by virtue thereof if it is established that the essential functional fea-
tures of that shape are attributable only to the technical results (see 4.6). Moreover, the
ground for refusal or invalidity of registration imposed by that provision could not be over-
come by establishing that there are other shapes, which allow the same technical result to
be obtained.

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

A smell as such is not excluded from registration. The ECJ ruled in Sieckmann, as referred
to in the introduction, that Article 2 of the Directive must be interpreted as meaning that a
trademark may consist of a sign which is not in itself capable of being perceived visually,
provided that it can be represented graphically, particularly by means of images, lines or
characters, and that the representation is clear, precise, self-contained, easily accessible,
intelligible, durable and objective. Hence, a smell will be accepted for registration in the
event that the application meets these conditions. However, practically it might be impossi-
bile to meet these standards when olfactory marks are concerned.

5.1 What form of representation or description of the smell is accepted as part of the application
for registration?

Since Sieckmann, it seems practically not possible that an olfactory sign meets the condi-
tions for registration. The requirements of graphic representability are not satisfied by a
chemical formula, by a description in written words, by the deposit of a smell sample or by
a combination of those elements.
Only few people would recognise the smell in question in a chemical formula. Such formula is not sufficiently intelligible. In addition, a chemical formula does not represent the smell of a substance, but the substance as such, and nor is it sufficiently clear and precise. It is therefore not a representation for the purpose of Article 2 of the Directive. A description of a smell is not sufficiently clear, precise and objective, although it is graphic. The deposit of an smell does not constitute a graphic representation for the purposes of Article 2 of the Directive. Moreover, a smell sample is not sufficiently stable or durable. A combination of those elements is not able to satisfy the requirements, in particular those relating to clarity and precision.

It is possible that someone finds another way to satisfy the requirements of graphic representability with respect to a smell.

5.2 How is the capacity of the smell to function as a trademark and/or its distinctiveness assessed?

In principle, a smell can be capable of distinguishing the goods or services of one undertaking from another. No category of signs is, theoretically, unsuitable to function as a trademark, as long as it is perceptible by human senses and fulfils the communication and distinguishing function of a trademark. No higher standard applies than when other trademarks are concerned. Because a smell can theoretically, but until now not practically be registered, the judgement of the distinctive power is not relevant.

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

An olfactory mark can until now not be made available to the public in a way acceptable under the rules of the Trademarks Directive. This might be different in the future.

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

As referred to in the introduction, a mark can be accepted for registration, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

6.1 What form of graphical representation of the mark applied for is required as part of the application for registration?

On November 27 2003, the ECJ will hand down its judgement in Shield Mark vs. J. Kist (C-283/01) regarding the sounds “a jingle comprising the first nine notes of Für Elise” and “the crowing of a cock”. Shield Mark is proprietor of fourteen different trademark registrations for these sounds in the Benelux. The ECJ will answer the preliminary questions with regard to the interpretation of Article 2 of the Directive.

Advocate General Ruiz-Jarabo Colomer concludes that the Directive does not preclude sounds from being accepted as trademarks (and even prohibits legal systems to deny sounds that capability a priori), and that the requirements of Sieckmann will apply. According to Colomer, national courts need to decide whether a particular graphic representation of a sound satisfies the requirements. The requirements will generally be satisfied by a musical notation. He also considers that descriptions in written language, including the form of onomatopoeia and the names of musical notes put in sequence, are insufficient as a rule.

The ECJ will apply the conditions of Sieckmann when determining whether the requirements are satisfied. Probably, the requirements of graphical representation are met by a musical notation, because the graphical representation consists of images, lines or characters, and the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. It is likely that a description in words will not meet the requirements.
At this moment, the OHIM accepts sound marks, represented by musical notation, or by other methods. Since the judgement of the Dutch Court of Appeal in Shield Mark, the Benelux Trademark Office does not accept sound marks at all.

6.2 Can audio recordings of a sound mark be filed as part of the application for registration?

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?

Currently, it is not possible to file audio recordings of a sound mark as part of the application for registration. In the event that (in the future) it is possible that such audio recordings can be filed, it is not sure whether the requirements of graphical representation are met.

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?

The Benelux Trademark Act seems to allow moving images and holograms to serve as trademarks (article 1 of the Benelux Trademarks Act). Like any trademark, the moving image or hologram should have the required distinctive character.

**Moving Image**

In the Benelux a moving image has been accepted as part of the application for registration by using only a still image together with the description stating that "the position and attitude of the specific item can vary". However, it can be discussed whether such an application / registration can still be considered to be valid under the European jurisprudence (Sieckmann, Libertel) as referred to in the introduction.

Moving images have also been accepted in the form of stills showing the different stages in the progression of the moving image together with a description of the progression of that sequence. The Benelux Trademark Office informally indicated that the latter registration should be preferred and that it is doubtful whether an application with only a still image together with a description would be accepted now regarding the recent European jurisprudence. In our opinion a moving image should be registered by means of different images showing the various stages together with a description of these stages to comply with the demands of being clear, precise, self-contained, equally accessible, intelligible, durable and objective. Whether or not there will be other possibilities to register a moving image successfully in the Benelux will only become clearer when new moving images will be applied for and assessed by the Benelux Trademark Office.

**Hologram**

In the Benelux holograms have been accepted as part of the application for registration by using a still image and a description stating that the trademark consists of a hologram. Again, it can be discussed whether this is still possible regarding current judgments from the European Court of Justice (Sieckmann, Libertel) as referred to in the Introduction. The Benelux Trademark Office informally indicated that it would be preferred if holograms would be registered by means of stills showing the different colours and/or shapes together with the remark that the registration consists of a hologram and if possible a description of the different shapes and colours of the hologram. It is also preferable to mention under “distinctiveness” that the trademark consists of one picture that can be viewed in different ways. In the opinion of the Benelux Trademark Office the public should be able to recognize the image as a hologram.
In our opinion a hologram should be registered in the Benelux by means of the different images that together form the hologram together with the remark that the trademark consists of a hologram to comply with the demands of the European jurisprudence. Whether or not there will be other possibilities to register a hologram successfully in the Benelux will become clearer when new holograms will be applied for and assessed by the Benelux Trademark Office.

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

The moving image or hologram will be made available to the public on publication of the trademark application and thereafter through the registered images and the description of the movement and/or hologram parts. By viewing the separate images together with the description the public should have a clear picture of the moving image or hologram that is protected by the trademark registration.

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In general the question can be raised whether the requirements that were laid down in the Sieckmann decision (to be acceptable for registration a trademark will have to be described in a sufficiently clear, precise, self-contained, easily accessible, intelligible, durable and objective way) are not too strict. According to the ECJ in the Sieckmann decision (consideration 37) ‘the registration system for trade marks constitutes an essential element of their protection, which contributes, in respect of both Community law and the different national laws, to legal certainty and sound administration’. It is clear that will be impossible to register certain signs as trademarks because they do not comply with the requirements of the Sieckmann decision, although generally spoken these signs are not excluded from registration. As a consequence of this the national rules of unfair competition will have to be applied to these ‘trademarks’. Of course this will not contribute to the ‘legal certainty’ since the rules of unfair competition vary from country to country.

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?

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?

For the purpose of ease and clarity the answers to questions 8 and 9 have been merged into one answer.

The Benelux Trademark Act does not make any distinction in assessment of scope of protection for marks that have been accorded trademark protection by means of registration, whether the mark is a 3D-mark, a colour mark, a smell mark, a sound mark or a moving image or hologram. The same has been confirmed in case law of the ECJ.

The scope of protection is determined by assessment of the distinctive character of the trademark in relation to the goods for which protection is claimed. The key to assessment of distinctive character is article 6 quinquiesB consideration 2 of the Paris Convention (“PC”). This article defines categories of marks which cannot enjoy protection. This provision does not make any exception of assessment of “non-traditional” marks.

Once a mark has been registered the scope of protection is assessed if and when the mark is invoked against the use or registration of signs that allegedly fall within the scope of protection of the registered mark. This is no different for “non-conventional” marks.
In consideration 23 of the Puma Sabel decision of the ECJ (11 November 1997, C251/95) it is said that “the more distinctive the earlier mark, the greater will be the likelihood of confusion”, i.e. the wider the scope of protection. This is the main rule, and applies to all conventional and non-conventional trademarks alike.

**Colour marks**

In Libertel the ECJ rules that in assessing the distinctive character of a specific colour as a trademark “regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought”, i.e. the number of options for others to use colours has an immediate bearing on the scope of protection. This is also dependent on the goods or services for which protection is claimed.

**3-D marks**

In Philips/Remington the ECJ appears to be anxious to preserve fair competition. In Para 78 the ECJ says that “The rationale of the grounds for refusal of is to prevent trademark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors”. Clearly the underlying interest is interest of the public to choose between competing products that fulfil the same function.

If and when a 3D mark attracts protection the scope of protection will be largely dependent on the number of alternatives available and the general interest for other traders to offer for sale goods or services of the same type as those in respect of which protection is sought.

**Other “non-conventional” marks**

There are no specific rulings on assessment of the scope of protection for Holograms or smell marks. However the assessment is likely to be dependent on the same general interest as described for colour marks and 3D marks.

**Influence of assessment scope of protection and scope of protection on assessment of registerability**

The scope of protection is the corollary of the assessment of distinctive character. The scope of protection is influenced by the general interest to enable other traders to offer for sale goods or services of the same type as those in respect of which protection is sought. There is therefore an immediate relationship between registerability and scope of protection.

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?

**Colour trademarks**

The Libertel case says that - in assessing the potential distinctiveness of a colour as a trademark - regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought.

**Three-dimensional trademarks (with a technical function)**

For three-dimensional marks (with a technical function) the same questions is answered in Philips/Remington and in the three Linde, Winward, Rado/DPMA cases (consideration 72).

The Court has held that Article 3 (1)(e) of the Directive pursues an aim which is in the public interest, namely that a shape whose essential characteristics perform a technical function, and where chosen to fulfil that function may be freely used by all. Furthermore, the
Court has held that regard must be had to the public interest underlying that provision, which is that all three-dimensional shape of product trademarks which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of that provision should be freely available to all cannot be registered. See paragraph 77 of Linde, Winward, Rado/DPMA.

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?

For colour trademarks and for three-dimensional trademarks (with a technical function) the question is answered in the Libertel case and in Philips/Remington. Basic principle of both conventional trademarks and non-conventional trademarks is that these marks are capable of identifying the product or service for which registration is sought and distinguishing that product or service from those of other undertakings. However, the perception of the relevant public is not necessarily the same in the case of a non-conventional sign as it is in the case of a conventional sign.

From the Libertel case it follows that a colour trademark for a colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking because a single colour is not used as a means of identification in the current commercial practice, and consumers are not in the habit of making assumptions about the origin of goods based on their colour. Nevertheless, all the circumstances of the particular case are relevant for the perception of the relevant public (the process familiarising the relevant public, registration for a large number of goods or services, or for a specific product or service).

From the Philips/Remington case, it follows that the distinctive character of a sign consisting of the shape of a product, must be assessed in the light of the presumed expectations of an average consumer and that this identification by the relevant public of the product as originating from a given undertaking must be as a result of the use of the mark as a trademark.

Where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods may be sufficient to give the sign a distinctive character in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with that trader and no other undertaking.

However, it is for the national court to verify that these circumstances are shown to exist on the basis of specific and reliable data, that the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect, are taken into account and that the identification, by the relevant class of persons, of the products as originating from a given undertaking is as a result of the use of the mark as a trademark.

**Colour trademarks**

In the Libertel case, the Court first of all stresses that a colour trademark for a colour per se must be capable of identifying the product or service for which registration is sought as originating from a particular undertaking and distinguishing that product or service from those of other undertakings. See consideration 69.

Subsequently, the Court comes to the conclusion that a colour trademark for a colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking, because a single colour is not used as a means of identification in the current commercial practice and consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging. See consideration 65.
Three-dimensional trademarks

As in the Libertel case, the ECJ first of all stresses that the shape of a product must simply be capable of distinguishing the product of the proprietor of the trademark from those of other undertakings, and thus fulfil its essential purpose of guaranteeing the origin of the product. See consideration 48 and 49.

Further, the Court stipulates that the distinctive character of a sign consisting in the shape of a product, must be assessed in the light of the presumed expectations of an average consumer of the category of goods or services in question and that this identification by the relevant public of the product as originating from a given undertaking must be as a result of the use of the mark as a trademark and thus as a result of the nature and effect of it. See consideration 63 and 64.

Finally, the Court comes to the conclusion that, "where a trader has been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods may be sufficient to give the sign a distinctive character for the purposes of Article 3(3) of the Directive in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associates that shape with that trader and no other undertaking, or believes that goods of that shape come from that trader. However, it is for the national court to verify that the circumstances in which the requirement under that provision is satisfied are shown to exist on the basis of specific and reliable data, that the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well-informed and reasonably observant and circumspect, are taken into account and that the identification, by the relevant class of persons, of the products as originating from a given undertaking is as a result of the use of the mark as a trademark." See consideration 65.

Résumé

Selon la directive européenne sur les marques, toutes les marques devraient être susceptibles de représentation graphique. Ceci n'implique PAS que les marques elles-mêmes devraient être susceptibles de perception visuelle. Ceci ouvre la possibilité que des sons et des sensations olfactives peuvent être des marques valides. Cependant, toutes les marques devraient être susceptibles de représentation graphique dans la base de données d’enregistrement des marques. Les marques doivent donc être décrites de manière suffisamment claire, précise, complète par elle-même, facilement accessible, intelligible, durable et objective. Le cas Sieckmann a montré que les standards auxquels il faut répondre sont élevés. Si élevés, en fait, qu’il est presque impossible d’enregistrer des marques olfactives (alors qu’elles ne sont PAS exclues par l’art. 2 de la directive sur les marques).

Selon A.G. Juiz-Jarabo Colomer, des possibilités favorables semblent toujours exister pour les marques de sons. Colomer a conclu que les mêmes spécifications que celles du cas Sieckmann devraient être observées, et qu’elles semblent l’être dans le cas d’une notation musicale, bien que le jugement final devrait être laissé aux tribunaux nationaux.

Le cas Libertel a montré que le besoin de la durabilité a des implications pratiques, du moins pour les marques de couleurs ; et qu’il faudrait donc utiliser un code d’identification internationalement reconnu. Il reste à savoir quelles seront les conséquences pour d’autres enregistrements de marques incluant des couleurs.

Par ailleurs, la décision sur le cas Libertel révèle que la couleur en soi (c’est-à-dire sans délimitation de l’espace) peut avoir un caractère suffisamment distinctif, et qu’elle est susceptible de représentation graphique d’une manière qui soit claire, précise, complète en elle-même, facilement accessible, intelligible, durable et objective. Concernant le caractère distinctif, la Cour souligne que dans l’intérêt général, les couleurs doivent rester librement utilisables par d’autres
opérateurs, et que ce fait devrait être pris en compte dans l’évaluation du caractère distinctif de la marque. À cet égard, le nombre de produits et de services pour lesquels l’enregistrement est demandé devrait également être pris en compte ; plus ces produits et ces services sont nombreux, plus l’argument de l’intérêt général, nécessitant de préserver la couleur pour qu’elle soit utilisée par d’autres opérateurs, est important.

Concernant les marques tridimensionnelles et le caractère distinctif, une orientation est possible d’après la décision de la CEJ dans les cas réunis Linde AG, Windsurf Industries Inc. et Rado Uhren AG. Le principe général de ce jugement est que tous les signes susceptibles de représentation graphique propres à distinguer les produits ou les services d’une entreprise de ceux d’autres entreprises, peuvent être une marque. Il n’y a pas de raison d’appliquer un critère plus strict lorsque des marques tridimensionnelles sont concernées. Les restrictions imposées par l’article 3, paragraphe 1, sous c) sont pertinentes lorsqu’elles sont jointes à des restrictions imposées par l’article 3, paragraphe 1 sous e), qui s’appliquent spécifiquement aux marques tridimensionnelles. En particulier, la CEJ souligne qu’il est nécessaire de tenir compte de l’intérêt général. Cet intérêt est que toutes les formes tridimensionnelles de marques de produits consistant exclusivement en signes ou en indications permettant de désigner les caractéristiques de produits ou de services dans le sens de cette disposition, devraient être librement accessibles à tous. Une approche analogue a été adoptée dans la décision Philips / Remington. La décision a cité l’intérêt général (voir la considération 78) comme arrière-plan de la restriction inscrite dans l’article 3(1)(e), deuxième tiret de la directive sur les marques. La Cour a conclu que cette disposition doit être interprétée en ce sens qu’un signe consistant exclusivement en la forme d’un produit ne peut pas être enregistré en vertu de ce fait, s’il est établi que les caractéristiques fonctionnelles essentielles de cette forme sont uniquement imputables au résultat technique. De plus, cette disposition impose pour le refus ou l’invalidité de l’enregistrement un motif qui ne peut pas être surmonté en établissant qu’il existe d’autres formes permettant d’obtenir le même résultat technique. Cependant, dans la même décision, la Cour a souligné que pour qu’une forme tridimensionnelle ait suffisamment de caractère distinctif, il n’est PAS nécessaire qu’elle comporte un quelconque ajout capricieux, tel qu’un embellissement n’ayant pas d’objectif fonctionnel. En outre, les marques de formes peuvent acquérir un caractère distinctif. Aucune autre spécification plus stricte ne s’applique par le fait que la marque concernée est tridimensionnelle.

Dans le domaine des images mobiles et des hologrammes, à notre avis, la loi Benelux sur les marques n’impose pas de restrictions. Les images mobiles et les hologrammes peuvent servir de marques à la condition que, comme toute marque, elles aient le caractère distinctif requis. Le besoin d’une représentation graphique (CJE Sieckmann) pourrait être satisfait en classant la marque sous la forme d’images immobiles qui montrent les différentes étapes dans la progression de l’image mobile ou de l’hologramme, assorties d’une description de la progression de cette séquence.

La loi Benelux sur les marques ne fait pas de distinction dans l’évaluation de l’étendue de la protection pour les marques auxquelles l’enregistrement a accordé la protection de la marque, que la marque soit une marque 3D, une marque de couleur, une marque olfactive, une marque de son ou bien une image mobile ou un hologramme.

L’étendue de la protection est déterminée par une évaluation du caractère distinctif de la marque par rapport aux produits pour lesquels une protection est demandée.

Dans la décision Libertel, la CEJ a déclaré qu’en évaluant le caractère distinctif d’une couleur spécifique en tant que marque, “il convient de reconnaître un intérêt général à ne pas restreindre indûment la disponibilité de couleurs pour les autres opérateurs offrant des produits ou des services du type de ceux pour lesquels l’enregistrement est demandé”, c’est-à-dire le nombre d’options pour que d’autres utilisent la couleur à une influence directe sur l’étendue de la protection. Ceci dépend également des produits ou des services pour lesquels la protection est demandée.
L’étendue de la protection d’une marque 3D dépendra largement du nombre de solution de rechange disponibles, et de l’intérêt général qu’il y a à permettre à d’autres opérateurs d’offrir des marchandises ou des services du même type que ceux pour lesquels la protection est demandée.

Il n’existe pas de décision spécifique régissant l’évaluation de l’étendue de la protection fournie pour des hologrammes ou des marques olfactives. Cependant, l’évaluation dépend vraisemblablement du même intérêt général que celui décrit pour les marques de couleurs et les marques 3D.

L’étendue de la protection est le corollaire de l’évaluation du caractère distinctif. L’étendue de la protection est influencée par l’intérêt général à permettre à d’autres opérateurs d’offrir des produits ou des services du même type que ceux pour lesquels la protection est demandée. Il existe donc un lien immédiat entre la capacité à être enregistrée et l’étendue de la protection.

Le cas Libertel discute explicitement la question de savoir si - dans l’évaluation du caractère distinctif d’une couleur spécifique en tant que marque - il convient de considérer s’il y un intérêt général dans la disponibilité de cette couleur.

La réponse finale à cette question est que dans l’évaluation du caractère distinct potentiel d’une couleur en tant que marque, il convient de tenir compte de l’intérêt général en ne restreignant pas indûment la disponibilité des couleurs pour d’autres opérateurs qui offrent des marchandises ou des services du même type que ceux pour lesquels l’enregistrement est demandé.

Pour les marques de formes (tridimensionnelle et ayant une fonction technique), la question de savoir s’il existe un intérêt général à préserver la disponibilité de la forme (tridimensionnelle et ayant une fonction technique) d’un produit a explicitement été discutée dans le jugement Philips /Remington et dans les trois cas Linde.

La Cour a considéré que la directive poursuit un objectif qui est dans l’intérêt général, à savoir qu’une forme dont les caractéristiques essentielles ont une fonction technique, et qui ont été choisies pour remplir cette fonction, peut librement être utilisée par tous.

**Zusammenfassung**

Gemäß der Europäischen Warenzeichen? Direktive müssen sämtliche Warenzeichen graphisch dargestellt werden können. Das beinhaltet NICHT, dass Warenzeichen an sich zur visuellen Wahrnehmung geeignet sein müssen. Das erschließt die Möglichkeit, dass Klänge und Düfte gültige Warenzeichen sein können. Jedoch sollten alle Warenzeichen graphisch in der Warenzeichen-Eintragungsdatenbank vertreten sein, was bedeutet, dass sie in einer ausreichend klaren, präzisen, in sich geschlossenen, leicht zugänglichen, verständlichen, dauerhaften und sachlichen Weise beschrieben sein müssen. Der Fall Sieckmann hat gezeigt, dass die zu erfüllenden Standards hoch sind. Im Grunde so hoch, dass es nahezu unmöglich sein muss, Duftwarenzeichen einzutragen (obwohl Artikel 2 der Warenzeichen? Direktive sie NICHT ausschliesst).


Der Fall Libertel hat erwiesen, dass die Forderung nach Dauerhaftigkeit praktische Implikationen zur Folge hat, zumindest für Farbwarenzeichen, und dass deshalb ein international anerkannter Identifikationscode anzuwenden ist. Es bleibt abzuwarten, welche Konsequenzen sich für weitere Warenzeicheneintragungen ergeben, die Farben beinhalten.

Die Libertel? Entscheidung zeigt auch, dass Farbe an sich (d.h. ohne irgendwelche räumlichen Abgrenzungen) einen hinlänglich unterscheidenden Charakter haben kann und in einer ausreichend klaren, präzisen, in sich geschlossenen, leicht zugänglichen, verständlichen, dauerhaften und sachlichen Weise dargestellt werden kann. Hinsichtlich der Unterscheidungskraft betont das
Gericht, dass Farben im allgemeinen öffentlichen Interesse für andere Gewerbetreibende frei verfügbar bleiben müssen, und das muss berücksichtigt werden, wenn die Unterscheidungskraft des Warenzeichens bewertet wird. In dieser Hinsicht müssen die Anzahlen der Waren und Dienstleistungen, für welche die Eintragung beantragt wird, ebenfalls berücksichtigt werden; je mehr es davon gibt, desto stärker wiegt das Argument des öffentlichen Interesses, die Farbe frei zur Verwendung für andere Gewerbetreibende zu halten. Die Antwort auf die fünfte Frage und Erwägung 66 in diesem Fall weist darauf hin, dass in Bezug auf Farbwarenzeichen die Unterscheidungskraft im allgemeinen durch die Verwendung erreicht wird.

Bezüglich dreidimensionaler Warenzeichen und unterscheidenden Charakters kann man eine Richtlinie ableiten aus der Entscheidung des Europäischen Gerichtshofes (ECJ) in den gemeinsamen Fällen von Linde AG, Winward Industries Inc. und Rado Uhren AG. Die allgemeine Prämisse dieser Entscheidung besteht darin, dass alle Zeichen, die zu einer graphischen Darstellung geeignet sind, welche die Waren oder Dienstleistungen eines Unternehmens von solchen anderer Unternehmen unterscheiden kann, ein Warenzeichen sein können. Es gibt keinen Grund, ein strengeres Kriterium anzuwenden, wenn es sich um dreidimensionale Warenzeichen handelt. Die Beschränkungen, welche Artikel 1, Absatz 1 c, auferlegt, sind relevant, wenn sie mit den Beschränkungen gesehen werden, die der Artikel 3, Absatz 1 e, auferlegt und die speziell für dreidimensionale Warenzeichen gelten. Im einzelnen unterstreicht der Europäische Gerichtshof, dass das öffentliche Interesse unbedingt berücksichtigt werden muss, das darin besteht, dass alle dreidimensionalen Formen von Produktwarenzeichen, die ausschließlich aus Zeichen oder Merkmalen bestehen, die dazu dienen können, die Eigenschaften der Waren oder Dienstleistungen innerhalb der Bedeutung dieser Bestimmung zu kennzeichnen, für alle frei verfügbar sein müssen. Eine ähnliche Betrachtungsweise wurde in der Entscheidung Philips/Remington übernommen. Sie zitierte das öffentliche Interesse (vergl. Erwägung 78) als Hintergrund für die Beschränkung, enthalten im Artikel 3(1)(e), zweite Einrückung, der Warenzeichen? Direktive. Das Gericht folgerte, dass diese Massnahme als Meinung zu interpretieren ist, dass ein Zeichen, welches ausschließlich aus der Form eines Produkts besteht, kraft dieses Umstandes nicht eingetragen werden kann, wenn feststeht, dass die wesentlichen funktionalen Merkmale dieser Form nur dem technischen Ergebnis zuzuordnen sind. Überdies kann der Grund zur Ablehnung oder Ungültigkeit der Eintragung, den diese Massnahme auferlegt, nicht durch die Begründung überwunden werden, dass es andere Formen gibt, durch die dasselbe technische Ergebnis erzielt werden kann. In derselben Entscheidung unterstrich das Gericht aber auch, dass es für eine dreidimensionale Form, soll diese einen hinlänglich unterscheidenden Charakter haben, NICHT notwendig ist, irgendeinen willkürlichen Zusatz zu haben, wie etwa eine Ausschmückung, die keinen funktionalen Zweck erfüllt. Ebenso können Formwarenzeichen Unterscheidungskraft erlangen. Es gibt keine weiteren zwingenden Spezifikationen für die Begründung, dass ein dreidimensionales Warenzeichen beteiligt ist.


Der Umfang des Schutzes wird bestimmt durch eine Festlegung des unterscheidenden Charakters des Warenzeichens im Verhältnis zu den Gütern, für welche der Schutz beantragt wird.
In der Libertel-Entscheidung bestimmte der Europäische Gerichtshof, dass beim Festlegen des unterscheidenden Charakters einer spezifischen Farbe als Warenzeichen “Rücksicht genommen werden muss auf das allgemeine Interesse hinsichtlich unangemessener Beschränkung der Verfügbarkeit von Farben für andere Gewerbetreibende, welche ebenfalls Güter oder Dienstleistungen gleicher Art anbieten, wie jene, zugunsten deren die Eintragung beantragt wurde“, d.h. die Zahl der Wahlmöglichkeiten für andere in der Verwendung von Farben hat einen unmittelbaren Einfluss auf die Reichweite des Schutzes. Das hängt auch von den Waren oder Dienstleistungen ab, für die der Schutz beantragt wird.

Der Umfang des Schutzes eines dreidimensionalen Warenzeichens hängt weitgehend von der Zahl der verfügbaren Alternativen und vom allgemeinen Interesse ab, das es den übrigen Gewerbetreibenden gestattet, Waren oder Dienstleistungen derselben Art anzubieten, wie jene, bezüglich deren der Schutz beantragt wird.


Der Fall Libertel behandelt ausdrücklich die Frage, ob - beim Festlegen des unterscheidenden Charakters einer spezifischen Farbe als Warenzeichen - berücksichtigt werden muss, ob es ein allgemeines Interesse an der Verfügbarkeit dieser Farbe gibt.

Die abschliessende Antwort auf diese Frage lautet, dass beim Festlegen der potenziellen Unterscheidbarkeit einer Farbe als Warenzeichen Rücksicht auf das allgemeine Interesse genommen werden muss, indem die Verfügbarkeit von Farben den übrigen Gewerbetreibenden, die Waren oder Dienstleistungen der gleichen Art, wie jene, bezüglich deren der Schutz beantragt wird, nicht in unzulässiger Weise eingeschränkt wird.

Bezüglich (dreidimensionaler) Formwarenzeichen (mit einer technischen Funktion) wurde die Frage, ob es ein allgemeines Interesse am Erhalt der Verfügbarkeit der (dreidimensionalen) Form eines Produkts (mit einer technischen Funktion) gibt, ausführlich im Urteil Philips/Remington und in den drei Linde? Fällen erörtert.

Das Gericht hat für Recht erkannt, dass die Direktive ein Ziel verfolgt, das im öffentlichen Interesse liegt, nämlich dass eine Form, deren wesentliche Merkmale eine technische Funktion ausüben und die gewählt wurden, um diese Funktion zu erfüllen, frei von jedermann verwendet werden darf.