

Non-traditional trademarks: the removal of graphic representation

Ana Panão, Senior Associate, and Manuel Durães Rocha, Partner, of Abreu Advogados discuss what the new Portuguese Industrial Property Code means for trademarks.

On 1 July 2019 a new Industrial Property Code (IPC) entered into force in Portugal (Decree-Law No 110/2018), bringing significant changes, some of which were the result of the transposition of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks.

The most noteworthy change to the trademark system consists of the elimination of the requirement for graphic representation.

In fact, the new IPC now provides that a trade mark may consist of a "sign or set of signs capable of being represented graphically (...) or a sign or set of signs which can be represented in such a way which makes it possible to assess, in a clear and precise manner, the subject-matter of the protection granted to the holder, provided that they are capable of distinguishing the goods or services of one company from the ones of other companies."

This means that the applicant of a trademark registration is no longer required to submit a graphic representation of the trademark to be registered. Only the clear and precise representation of said distinctive sign is mandatory.

The removal of the requirement for graphic representation is a relevant change, given the fact that it paves the way for registration of non-traditional trademarks with recourse to technological means, exponentially increasing the possibilities of registration of this category of trademarks.

With respect to some types of non-traditional trademarks that were already accepted, the removal of the requirement for graphic representation also makes trademark application proceedings itself far simpler. For instance, although it was already possible to file a trademark application composed of sounds, by submitting the musical notation in order to



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comply with the mandatory requirement of graphic representation, from now on the applicant may simply submit an audio file. The same applies to dynamic/motion trademarks, whose application is currently much easier, given that the applicant is able to submit a video file instead of a series of still pictures that capture the movement. The trademark registration proceedings of hologram trademarks has also become easier, once the photographic reproduction in multiple images is replaced by a video file.

In light of this change, sound and motion/dynamic trademarks are likely to emerge in Portugal accompanying new trends in trademark registrations at the European level, such as the opening music of Twenty Century Fox and the handshake of Nokia, among others.

The first trademark application without recourse to graphic representation was filed before the Portuguese IP Office shortly after the entry into force of the new IPC in 16 August 2019. The trademark in question consists of a dynamic/motion mark to distinguish products and services in classes 9, 35, 42 and 45 of the International Nice Classification and it was filed by a Portuguese company with commercial activity in the field of artificial intelligence. This trademark application was published in the IP Bulletin in 20 September 2019 and in the field available for the purpose of reproduction of the sign there is the link to the mp4 file submitted by the applicant. This trademark application has since been granted and consists of the first of many expected trademark applications where the new legal formats were used.

Since the requirement of graphic representation was lifted, it is also expected that, through technological means many other non-traditional trademark applications will be filed, such as olfactory, taste, multimedia, hologram and touch marks.

For instance, who does not recall Cristiano

Ronaldo shouting out as he jumped in a pirouette in mid-air and threw his arms out to his side when he scored a goal? The shout of this legendary football player may be replayed using technological means in an easily accessible, intelligible, durable and objective way. These features – easy accessibility, intelligibility, durability and objectivity –, which are inherent to sound reproduction, would eventually allow said sound mark to be registered, namely by the submission of an audio file. The same logic applies to the movement, which may be reproduced by a video file. And why not a multimedia mark, composed of the sound of the shout and of the movement, which could be submitted as an audio-visual file?

Similarly, whether a distinctive scent inside a retail store or a fast food store may be registered as an olfactory mark is also debatable. The trademark composed of such scent would distinguish the services provided, attracting consumers and constantly reminding them of said services when in the presence of the scent.

However, with respect, for instance, to olfactory trademarks, the removal of graphic representation does not necessarily mean that this type of trademarks can be registered (or, at least, that said registration will not be challenging). Indeed, the current technology does not yet allow a durable representation of an olfactory mark, although that possibility may arise in a near future as consequence of the technological progress. Consumers must also be in a position to distinguish the scent that composes the trademark and people have completely different perceptions of the same scent. And how a trademark composed of a scent will be published? It is also noteworthy that the registered trademark must be readily understood by one searching the IPO databases.

So far, only the famous trademark with the verbal description "The smell of fresh cut grass" used for "tennis balls" (class 28 of the INC) was granted by EUIPO on 11 October 2000. The registration was not renewed in 2006 and has expired.

And what about the registration of the distinctive taste of a food product as a taste mark? The challenges raised about the registration of olfactory marks also apply to this type of trademarks. In fact, how the requirement of durability of the trademark can be met? In addition, a taste mark can only be perceived by the consumer after it has been tasted, which may be somewhat the opposite of a distinctive sign. Moreover, the mark may be perceived in different ways by the consumers, depending on how each person savors the product distinguished by the trademark. Also, the taste cannot be detached from the product. Who knows,

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The lack of distinctiveness character has also been raised in different trademark proceedings such as the famous case known as "The taste of artificial strawberry flavour", in which Eli Lilly and Company filed a trademark application before EUIPO to distinguish "pharmaceutical preparations" (class 5), which was refused on the grounds that "Any manufacturer of products such as pharmaceutical preparations is entitled to add the flavour of artificial strawberries to those products for the purpose of disguising any unpleasant taste that they might otherwise have or simply for the purpose of making them pleasant to taste. If the appellant were given an exclusive right to use such a 'sign' (...), that would interfere unduly with the freedom of the appellant's competitors."

With respect to olfactory marks, to which the same reasoning as that of taste marks applies, it is important to recall the "Sieckmann Case", a preliminary ruling brought before the European Court of Justice of a decision of refusal of an olfactory mark registration of the German Trademark and Patent Office. The applicant, Ralf Sieckmann, an IP attorney, deposited an olfactory mark before the German Office to distinguish services in classes 35, 41 and 42. In the application form, Mr. Sieckmann referred to a description attached as an annex to his

Résumés

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application, which was the following: "Trade mark protection is sought for the olfactory mark (...) of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester), whose structural formula is set out below. Samples of this olfactory mark can also be obtained via local laboratories listed in the Gelbe Seiten (Yellow Pages) of Deutsche Telekom AG or, for example, via the firm E. Merck in Darmstadt. C₆H₅-CH = CHCOOCH₃." Apart from the description attached to the application form, containing a chemical formula, an odour sample of the trademark in a container and the description of the scent in question as "balsamically fruity with a slight hint of cinnamon" were also deposited.

Although the ECJ stated that a trademark may consist of a sign which is not in itself capable of being perceived visually, it has ruled that the graphic representation of a trademark shall be "clear, precise, self-contained, easily accessible, intelligible, durable and objective" and concluded that "in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements."

The above "7 Sieckmann criteria" are now mentioned in recital 13 of the Directive (EU) 2015/2436, even though the requirement of graphic representation was removed. In the coming years we will see how national offices, EUIPO and courts, including the EUCJ, will approach Sieckmann criteria along with the elimination of the requirement of graphic representation.

Indeed, even considering that the restrictive view on the Sieckmann case was due to the requirement of graphic representation, non-traditional trademarks will still face many challenges.

In fact, the representation of non-traditional trademarks must ensure that the trademark is registered as clearly as possible in order to be perceived by the Office, the owners and third-parties. Said representation must be lasting in order to ensure the integrity of the trademark for the life time of the trademark registration, enabling the Office and all interested parties to perceive the scope of protection of the distinctive sign, namely to compare it to new trademark applications or to enforce the trademark rights. The technological means must be able to ensure that the trademark lasts in the same way as the durability of graphic representation has been guaranteed until now. This is especially important given the fact that the registration of

“clear” and “precise”.

a trademark right, in Portugal and in the European Union, is valid for a period of ten years from the application date and may be indefinitely renewed for further periods of ten years. The representation must also be objective in order to faithfully reflect the trademark in question.

Given the fact that the registration lays down the scope of protection of the trademark right its representation must be "clear" and "precise" in order to provide legal certainty.

In light of the above, some non-traditional trademarks, such as olfactory and taste marks, will face several challenges, being common understanding that the existing technological means do not yet allow a representation of a trademark that meets the aforementioned requirements.

Moreover, the lack of distinctive character of these trademarks has also been raised in many trademark registration proceedings. This shows that, although graphic representation is no longer required, non-traditional trademarks will still face several practical challenges in order to be registered and have to overcome the requirement of distinctiveness.

The fact is that the elimination of the requirement of graphic representation allows trademark owners to get inspired and widen the distance between their trademarks and the trademarks owned by their competitors. Furthermore, it allows them to find creative ways of advertising their products and services. The registration procedure also became swifter for some existing non-traditional trademarks, thanks to the elimination of such requirement, which is very likely to increase the number of trademark applications.

We believe that by eliminating the requirement of graphic representation the paradigm of the existence, the object, the content and the protection of trademarks will change significantly, in a way that is not yet noticeable. This change is surely innovative, challenging and imagination (and, of course, the legal certainty) is the limit.

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