

First published in October, 2003
by MARQUES, The Association of European Trade mark Owners
840 Melton Road, Thurmaston, Leicester LE4 8BN UK



Copyright © MARQUES, October 2003

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system or transmitted in any form or by any means electronic, mechanical, photocopying, recording or otherwise without the prior permission of the publishers.

ISBN 0-9545703-0-8

Disclaimer

Every effort has been made to ensure that the contents of this publication are accurate and free from error. However, it is possible that errors do exist, both typographical and in content. Therefore, the information provided herein should be used only as a guide and not as the only source of reference.

The authors, advisors and publishers can accept no liability to any person or entity for any loss, damage or injury caused or alleged to have been caused directly or indirectly by any information contained in or omitted from this publication.

This work represents the personal opinions of the Authors and does not necessarily represent the opinion of MARQUES and/or its members, the Authors' employers, nor anyone other than the Authors. Any mention of commercial products, company names, or universities are solely for information purposes and do not imply any endorsement by MARQUES, the Authors or any other entity.

Typeset in Great Britain by
D Graphic Services, Nottingham, UK

Printed in Great Britain by
Print Partnership Ltd, Nottingham UK

CONTENTS

<i>The Authors</i>	<i>i</i>
<i>Foreword</i>	<i>ii</i>
<i>Preface</i>	<i>iv</i>
<i>Abbreviations</i>	<i>viii</i>
<i>Acknowledgements</i>	<i>ix</i>

PART I: NATURE, FUNCTION AND PROTECTION OF NON-CONVENTIONAL TRADE MARKS

Chapter 1 - The sign

1-1 The long road to the sign	1
1-2 But what is a sign?	4
1-3 The consumer as mark perceiver	12
<i>References</i>	15

Chapter 2 - The function of trade marks

2-1 Distinctive function - but in which sense?	18
2-2 To be or not to be abstract? That's the question	22
2-3 Article 7(1)(a) CTMR	26
<i>References</i>	29

Chapter 3 - Graphic Representation

3-1 The reasons for which it is prescribed	31
3-2 What the law says	32
3-3 From the representation of the mark to its graphic representation	33
3-4 For an extensive interpretation of graphic representation	36
3-5 Who should have easy access?	38
3-6 Is a mere verbal description sufficient?	40
<i>References</i>	44

Chapter 4 - Shape marks

4-1	What a lot of shapes!	45
4-2	How shape marks are perceived by consumers	47
4-3	OHIM practice and the BOAs jurisprudence	51
4-4	CFI jurisprudence: or " <i>All marks are equal, but some are more equal than others</i> "	58
4-5	Shape marks at the ECJ	62
	References	67

Chapter 5 - Colour marks

5-1	The sense of sight and the perception of colour	70
5-2	What is the purpose of a colour mark?	73
5-3	The juridical picture	74
5-4	The experience gained so far in the United States	76
5-5	Community jurisprudence	79
5-5-1	Colour combination	79
5-5-2	Colours <i>per se</i>	83
5-5-3	Colour trade marks at the Court of Justice	86
5-5-4	Chromatic shades	90
5-6	A secondary meaning for marks of colour?	92
5-7	Graphical representation	96
5-8	Colour depletion and shade confusion	99
5-9	The theory of functionality	103
5-10	The problem of counterfeiting in the case of shades of colour	105
5-11	Final considerations	106
	References	107

Chapter 6 - Smell Marks

6-1	An undervalued sign	111
6-2	Smells as distinctive signs and promotional tools	114
6-3	Graphic representations	119
6-4	The Sieckmann case. A step back?	122
6-5	Proof in counterfeiting cases	125
6-6	Free competition	127
6-7	Remarks	128
	References	130

Chapter 7 - Sounds as trade marks

7-1	A sound - How does it work?	133
7-2	The sound mark between hearer and consumer	136
7-3	Normative reference	138
7-4	Graphic representation	142
7-5	The limitations of competition - The Harley-Davidson case	144
7-6	Comparison between sound marks	145
7-7	Reality and prospects of sound marks. The case of " <i>Für Elise</i> "	146
	References	149

Chapter 8 - Future Trade Marks

8-1	In the not-too-distant future	151
8-2	The position mark	151
8-3	The taste mark	154
8-4	The tactile mark	157
8-5	The gesture mark	159
8-6	Brief sequence of images	160
8-7	Light marks	162
8-8	Hologram marks	164
	References	166

PART II: RULES AND DECISIONS

Chapter 9 - International, national and EC laws relevant to non-conventional marks

9-1	Paris Convention for the Protection of Industrial Property	167
9-2	TRIPs Agreement	169
9-3	Trademark Law Treaty	172
9-4	Community Trade Mark Regulations	173
9-5	CTMR Implementing Regulations	176
9-6	First Directive	178
9-7	Council and Commission Joint Statements	183
9-8	Benelux Trade Mark Law	184
9-9	Italian Trade Mark Law	185
9-10	German Trade Mark Law	187
9-11	French Trade Mark Law	189
9-12	Spanish Trade Mark Law	191
9-13	United Kingdom Trade Marks Act	194

Chapter 10 - The Decisions

10-1	Ferragamo	196
10-2	Philips/Remington	206
10-3	Brown cigar and gold ingot shape	223
10-4	Colour green	234
10-5	Orange	243
10-6	Green-grey	256
10-7	The smell of freshly cut grass	261
10-8	The scent of raspberries	264
10-9	Ralf Siekmann	274
10-10	Sound of click	285
10-11	Shield Mark	289
10-12	Position Mark	302

APPENDICES

Appendix 1	315
Bibliography	
Appendix 2	330
Examples of non-conventional marks	

The authors

Professor Stefano Sandri has over 30 years of experience in the legal field of intellectual property and is internationally known for his practice in trademark law.

Between 1997 and July, 2003, he was Chairman of the Third Board of Appeal for the Office for Harmonisation in the Internal Market (OHIM). He is a frequent speaker on and author of numerous books about intellectual property topics. In July, 2003 he was appointed as an IP consultant to the Italian Ministry of Industry.

Sergio Rizzo is an attorney with the law firm Garrigues in Alicante, Spain. His practice focuses on intellectual property issues, and he specialises in all aspects of Spanish, Community and international trademark law.