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RELATION OF ESTABLISHED TRADEMARK PRINCIPLES
TO NEW TYPES OF MARKS

Document prepared by the Secretariat

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I. INTRODUCTION

1. At the sixteenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) held in Geneva from November 13 to 17, 2006, the SCT requested the International Bureau to develop a paper for discussion at its next session, exploring the relation of established trademark principles to new types of marks. All principles, *inter alia*, functionality, speciality and distinctiveness would be considered, as well as issues of public interest including safeguarding the public domain (see document SCT/16/8, paragraph 9). Accordingly, the Secretariat has prepared the present document, which addresses those issues.

2. This document is based on the preliminary findings contained in document SCT/16/2 (“New Types of Marks”), which is largely based on information provided by 73 Member States and three intergovernmental organizations in their Replies to the Questionnaire on Trademark Law and Practice (document WIPO/Strad/INF/1). It is also based on information submitted by the following members of the SCT, as agreed at the sixteenth session of the Standing Committee: Australia, Bulgaria, Chile, China, Croatia, Ecuador, Finland, France, Germany, Japan, Moldova, Morocco, Norway, Republic of Korea, Russian Federation, Slovenia, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, United Kingdom, United States of America, the European Community and the Benelux Organization for Intellectual Property (BOIP) on behalf of Belgium, Luxembourg and The Netherlands.

II. ESTABLISHED TRADEMARK PRINCIPLES AND NEW TYPES OF MARKS

(a) Overview

3. It has been noted that there are no separate criteria for assessing the registrability of non-traditional marks. National and regional case law does not appear to require authorities a stricter assessment of the registrability of new types of marks, than it does for traditional marks. In essence, the former type of marks must be able to overcome absolute grounds for refusal, such as: lack of distinctive character (i.e. descriptiveness and genericness) conflict with public order or morality, or deceptiveness¹. The law or practice of some countries provides for particular conditions that may be applied to certain types of marks². Even though identical examination criteria may be applied for all types of marks, differences in appreciation cannot be excluded in as much as the perception of the public may change depending on the type of sign. Consumers are not necessarily accustomed to seeing new types of marks in the same way that they see other more traditional marks³.

(b) Subject Matter of Protection

4. Article 15(1) of the World Trade Organization (WTO) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) defines eligible subject matter for trademark protection as “any sign or combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings...” Members of the WTO may require that signs be visually perceptible as a condition for registration, according to the fourth sentence of Article 15(1). However, they are not obliged to do so.

5. The above definition is followed by a non-exhaustive list of signs which are eligible for registration, namely words, including personal names, letters, numerals, figurative elements and combinations of colors, as well as any combination of such signs. Most countries have incorporated these provisions in their trademark laws by either including an illustrative and

non-exhaustive enumeration of the types of signs that may be considered eligible for trademark protection or by mentioning the specific requirements that any chosen sign must fulfill, for example, the requirement of graphic representation⁴.

6. Because the enumeration, in Article 15(1) of the TRIPS Agreement, of signs eligible to constitute trademarks is not exhaustive, it does not seem to limit the types of signs that may be considered a trademark. Instead, the focus of that provision is on distinctiveness, which could be considered a universal criterion, although its application may differ from one system to another⁵. The TRIPS Agreement thus refers to one of the core functions of trademarks, namely to identify the commercial source of goods and services offered in the market. In this connection, it has been ruled that “it is the source-distinguishing ability of a mark – not its ontological status as a color, shape, fragrance, word or sign – that permits it to serve basic purposes” of a trademark⁶.

(c) Distinctiveness

7. The test of whether a trademark is distinctive generally depends on the understanding of the persons to whom the sign is addressed. Very often, a sign has not been used as a trademark before it is filed for registration, and so the question has to be whether it is capable of distinguishing the goods or services to which it is to be applied⁷.

(i) *General*

8. A sign is distinctive for the goods or services to which it is to be applied when it can be recognized by those to whom it is addressed as identifying goods or services from a particular trade source, or is capable of being so recognized. The distinctiveness of a sign is not, however, an absolute and unchangeable factor. It is a purely circumstantial matter. Circumstances such as possibly long and intensive use of the sign have to be taken into account when considering the distinctiveness of a sign at any point in time. There may be different degrees of distinctiveness, and the question is how distinctive a sign must be in order to be registrable, regardless of its possible use.

9. The question of the capacity to distinguish revolves around the degree to which other traders may need to use the sign in the ordinary course of their business without improper motive. If other traders are unlikely to need to use a sign (i.e. it is not common to the trade, functional or otherwise required by others), it is likely to be acceptable for registration⁸.

10. Not every sign that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so, and not everything that is recognized or associated with a party is necessarily a registrable trademark. Subject matter that does not identify and distinguish the applicant’s goods or services may not function as a mark. This could be the case of a merely decorative feature⁹.

11. For matter that does not inherently function as a mark because of its nature (e.g., non-distinctive product container shapes, overall color of a product, mere ornamentation), actual evidence that the mark is perceived as a mark for the relevant goods or services is required to establish distinctiveness. The determination of whether or not a mark is distinctive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in

connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. The great variation in facts from case to case prevents the formulation of specific rules for specific fact situations¹⁰.

(ii) *Special considerations*

12. The test of distinctiveness for new types of marks is not handled in a way stricter than for traditional marks. However, as average consumers are not necessarily in the habit of making assumptions about the origin of goods or services based on new types of marks, it might nevertheless prove more difficult to establish distinctive character than in the case of a word or figurative mark. Moreover, like traditional marks, new types of signs may not be descriptive or have become customary in trade. They may also acquire distinctive character through use in the marketplace. The criteria for acquiring distinctiveness are usually not defined in national legislation, but it has been suggested that the mark in question should be established in a considerable part of the affected trade circles (degree of familiarity of no less than 50%)¹¹. Acquired distinctiveness can be proven, where appropriate, by giving evidence of use or presenting opinion polls¹².

13. As mentioned in paragraph (3) *supra*, even where the same criteria are applied for the assessment of distinctive character in the case of new types of signs, special considerations are made in relation to certain types of marks.

Three-dimensional Marks

14. A product shape or its packaging may be considered to have distinctive character if it clearly departs, by its particularities, from the usual and expected shape of the category of products concerned, so that it remains in the memory of the persons to whom it is addressed. In other words, a shape does not form part of the public domain when it is different from the common shapes for the category of products concerned and in such a manner that it is perceived by the interested circles as a reference to a particular undertaking¹³.

15. However, protection may be granted to the shape of a product or its packaging on condition that it is combined with distinctive two-dimensional elements (verbal or figurative elements, colors) which influence in an essential manner the general impression produced by the three-dimensional plan. For example, a distinctive writing placed on one single side of a common cubic packaging would not seem to influence the general impression in an essential manner. However, a distinctive two-dimensional element may influence the general impression in an essential manner if it adopts the form of the product¹⁴.

16. It has been noted that shape marks should not be objected on the general basis that the public needs to be educated to see them as trademarks. Distinctive shapes may be capable of functioning as trademarks and it would not be appropriate to object *prima facie* to the registration of a three-dimensional mark on grounds that a shape is not a trademark. The question of whether a shape actually functions in the marketplace as a trademark could therefore not be raised in the initial examination of a trademark. The ability of a given shape to function as a trademark may only be tested if objections on the basis of lack of capacity to distinguish have been substantiated and the applicant is seeking to overcome these through evidence of use¹⁵.

Color Marks

17. Color, whether a single overall color or multiple colors applied in a specific and arbitrary fashion, is usually perceived as an ornamental feature of the goods or services. Consumers do not normally perceive in abstract colors an indication of commercial source, since their essential function is, as a general rule aesthetical and not distinctive. A color or a combination of colors may have distinctive character only if it is clearly distinguished from the colors that are common to the corresponding category of goods. Thus, if a great variety of colors is used for a product segment, a large number of colors will be considered as common for those products¹⁶.

18. It has been noted that colors have a limited inherent capacity for distinguishing goods or services. For this reason and following recent case law, applicants in most European countries will be required to provide evidence to demonstrate that the color sign applied for has acquired distinctiveness through use in relation to the goods or services indicated in the application, which will also result in a rather limited list of goods and services¹⁷.

19. A single color applied to the surface of goods that are normally colored will be regarded as lacking in distinctiveness since there is a high likelihood that other traders would need to use that color in the ordinary course of their business e.g. the color “yellow” applied to a lampshade. Such a color will only be acceptable on submission of convincing evidence of factual distinctiveness¹⁸. The principle of availability would also bar the registration of basic colors, as these should remain free for use by all market participants¹⁹.

20. Combinations of color are easier to register than single colors as there is generally less of a competitive need for traders to use specific color combinations – especially if those combinations are memorable. The more complex or invented the color scheme, the stronger the potential for registration. However the prospects for registrability will depend on the nature of the color combination and the particular goods in question²⁰.

Slogans

21. In relation to slogans, the question usually is whether general statements or common appreciative expressions fulfill the essential function of indicating to the consumer or end user the commercial source of the products or services. Some times, this happens not to be the case. In particular, if it is established, when assessing the distinctiveness of the trademark in question, that it served a promotional function consisting, for example, of commending the quality of the product in question and that the importance of that function was not manifestly secondary to its purported function as a trademark, namely that of guaranteeing the origin of the product. In such a case, authorities may take account of the fact that the average consumer is not in the habit of making assumptions about the origin of products on the basis of slogans²¹.

22. Slogans can be particularly hard to assess as they are naturally elliptical and often used with other, more dominant, marks²². The fact that a slogan is used with other indicia, or even as part of a longer slogan, would not necessarily present a bar to registration²³. However, Offices would generally object to marks which appear to be simply a decoration and unlikely to be used as such.

Position Marks

23. A position mark is characterized by the fact that an unchanging element appears always on the product at the same position and in constant proportions. The combination of the sign and the position may benefit from “distinctive character” as a result of the general impression produced, but the position alone would not be eligible for protection as a mark. If the sign itself does not have distinctive character, the influence of the constantly identical position must be appreciated. The fact of placing the sign at a habitual place may contribute to conferring it distinctive character. That would not be the case if the sign were placed at an unexpected or non-habitual place each time²⁴.

Movement Marks

24. The assessment of distinctive character may be problematic in the case of signs formed by the movement of an object which is identical to the product it designates. For example, the sign (i.e., the movement) and the product concerned would coincide in the case of the movement of a car door opening. The public would recognize in this movement a technical function in the first place, and not a reference to a given enterprise. Only signs which clearly depart from a common movement for the category of products in question may acquire distinctive character. Common movements could be understood as those that the target public perceives as being determined by technical or functional characteristics. As a general rule, a common movement is also submitted to the need to keep certain signs free and available for other traders²⁵.

Sound Marks

25. Single tones or trivial sounds would not be perceived as distinctive signs, and the same would apply to a lengthy musical piece or a long play, even if it includes words. Following the principle of availability, sounds that would be regarded as common to the trade and required by other traders could not be registered as trademarks, for example, the sound of glass breaking in relation to “windscreen repair services” or well known classical music pieces in relation to “dancing tuition” services. However, many sounds have no particular descriptive relationship with the proposed goods or services and would be considered *prima facie* acceptable, for example, the sound of a “wolf howling” in relation to “alcoholic beverages”²⁶.

Scent Marks

26. Scents which are the natural odor of a product or are otherwise common for the type of goods applied for are likely to be needed by other traders and are difficult to register, e.g., the scent of “vanilla” – a normal ingredient in many food products, would not be registrable for “confectionery”. Scents normally applied as masking agents in products are also lacking in distinctiveness e.g., the scent of “pine” in relation to disinfectants and the scent of “lemon” in relation to “dishwashing liquid”. However, the application of a scent to a product not normally scented would have considerably more potential to be registrable²⁷. Obtaining a registration for this type of mark would probably not be simple and a showing of acquired distinctiveness may be required. It has been noted that the amount of evidence needed to establish that a scent functions as a mark may be substantial²⁸.

(d) Functionality

(i) *General*

27. A sign which could otherwise serve as a mark may not be registrable if it is a functional feature of the goods, that is if it is “essential to the use or purpose of the product or if it affects the cost or quality of the product”²⁹. The functionality doctrine was first devised to prevent the registration of functional shapes, but it seems to also be relevant in the examination of other non-traditional signs, namely color, sound or scent. This doctrine is intended to encourage legitimate competition by maintaining a proper balance between different areas of intellectual property, such as patent, industrial design and trademark law. It is supposed to ensure that protection for utilitarian product features be sought, for example, through a limited-duration utility patent and not through the potentially unlimited protection of a trademark registration³⁰.

(ii) *Special considerations*

28. When making the assessment as to whether a product feature is functional, it should also be established if other traders would need to use that feature (shape, color, sound or scent) for their similar goods.

Three-dimensional Marks

29. If a shape has significant functional features, it will not qualify for registration as a three-dimensional or shape mark. According to several submissions, a sign shall not be registered as a trademark if it consists exclusively of: (a) the shape which results from the nature of the goods themselves, (b) the shape of goods which is necessary to obtain a technical result, or (c) the shape which gives substantial value to the goods³¹. In European Community case law, these provisions have been interpreted as preventing the use of trademark registrations to acquire or perpetuate exclusive rights relating to technical solutions³².

30. Apart from the shape of the product itself, product packaging and containers may also be applied for registration as a mark. In this case, the sign will be considered acceptable only if it departs substantially from the shapes used in the business practice of the sector concerned. With regard to product packaging and containers for products which have no shape of their own, such as liquids and powders, the shape of the packaging and containers will be assimilated to the shape of the goods themselves and will thus be subject to the same test as to functionality³³.

31. A shape would also be considered functional if it has an engineering advantage, resulting in superior performance or if it results from a comparatively simple, cheap method of manufacture. Sometimes a functional feature may be associated with an engineering advantage that has yet to become commonplace but nevertheless because of its utility should remain open for all to use³⁴.

31. The fact that a shape is attractive or aesthetically pleasing should not be a reason for *prima facie* objection. However, an attractive aesthetic appearance will not in itself be sufficient to enable the public to perceive the sign as an identification of origin, especially in cases where that aesthetic element is common to the trade. Thus generally, aesthetics should not be considered when assessing whether a shape is functional³⁵.

Color Marks

32. A color mark may be deemed to be functional, and therefore not registrable, if it serves some utilitarian purpose or is used to provide a particular technical result for the goods concerned. For example, the color “silver” is known for its heat and light reflecting properties and so is the color of choice for manufacturers of building insulation sheeting. No other trader should be able to obtain a monopoly in a color that other traders are commonly using. Some colors have developed generally accepted meanings in particular trades and therefore are unlikely to be able to distinguish the goods of any trader from those of another. For example, the color “red” is commonly used on fire extinguishers and would therefore be difficult to register in relation to “fire fighting equipment”³⁶.

33. In addition, a color mark may be deemed functional if it is more economical to manufacture or use. For example, a color may be a natural by-product of the manufacturing process for the goods. In such a case, appropriation of the color by a single party would place others at a competitive disadvantage by requiring them to alter the manufacturing process³⁷.

Sound Marks

34. Sounds which are common to the trade would be difficult to register. A functional sound could be one caused by the normal operation of a piece of equipment or machinery and would not be considered distinctive of that product. For example, the sound of a chainsaw motor would not be registrable in relation to “chainsaws” without evidence of factual distinctiveness³⁸.

Scent Marks

35. It would seem difficult to get a registration for the scent for a product that the consumer public would expect to be scented in the first place. This would in principle rule out products such as perfume, soaps, detergents, lotions, etc. Masking scents would also be problematic, as described *supra*, in Section II(c)(ii), as well as the natural scent of a product, which could also be needed by other traders and therefore not registrable³⁹.

(e) Specialty

36. The right of the owner of a mark to prevent third parties from using that mark in trade is subject to the principle of specialty, according to which this right can only be asserted with regard to those goods and services in respect of which the trademark is protected, usually as a result of registration. In principle, other traders may use an identical trademark for dissimilar goods or services, provided that no risk of confusion, association or dilution is caused.

37. The protection of well-known marks against dilution in respect of their use for dissimilar goods and services constitutes an exception to the rule of specialty. Protection against dilution aims at protecting the owner of a well-known or famous mark against the blurring or tarnishing of the mark’s particular reputation and to prevent unfair free-riding on the well-known mark’s reputation.

38. Since new types of marks are ruled by the same principles as traditional marks, it seems that this very important principle would also apply to them⁴⁰. It has been noted, for example, that the name of a character in a famous play, on which the copyright had expired could be registered as a trademark for goods or services which have no relation with culture or cultural activities⁴¹.

III. OTHER ISSUES

(a) Public Interest Considerations

39. Issues relating to the public interest have been identified by national and regional courts in connection with grounds for refusal of registration of both traditional and new types of marks. Several submissions noted that they applied such rulings in their assessment as to the suitability of a sign to become a trademark. However, some pointed out that there are no specific provisions of positive law protecting the public interest⁴².

40. It is argued that it lies in the public interest that certain signs should be kept free and available for other traders to use. There are probably two slightly different reasons for that exclusion from protection. Firstly, some marks are thought to be of a sort that is so important commercially that they would enable a trader who obtained an exclusive right in them to have an unfair advantage over his competitors. This applies even if there are other words or signs that could be used to convey the same message to consumers. Secondly, some marks are composed of elements that are thought to be in finite supply such as colors and they should not be reserved to one undertaking alone because they have been registered as trademarks⁴³.

41. The argument of the exhaustive nature of color signs has been further developed by several national courts, and a regional court⁴⁴ has held that the number of colors that the average consumer is capable of distinguishing is limited, because he/she is rarely in a position directly to compare products in various shades of color. Thus, the number of different colors that are in fact available as potential trade marks to distinguish goods or services is limited. The possibility of registering such a mark could therefore be limited for reasons relating to the public interest.

42. The fact that the number of colors actually available is limited means that a small number of trademark registrations for certain services or goods could exhaust the entire range of colors available. In the view of that particular Court, such a broad right would be incompatible with a system of undistorted competition. Thus, in assessing the potential distinctiveness of a color as a trade mark, it is necessary to take account of this interest⁴⁵.

43. Although not universally accepted⁴⁶, this exhaustion or “depletion” theory seems to inspire the assessment of registrability of other types of signs. More generally, the depletion theory operates on the principle that there are a limited number of devices (i.e., shape, color, scent or sound) that will be favorably perceived by consumers. Granting a trademark right over one of the few desirable marks available “depletes” the remaining pool of desirable marks and thus adversely affects competition. However, if there are a large or even infinite number of sensory devices that will be positively received by consumers, then removing one sign out of this deeper pool via trademark registration does not significantly affect competition⁴⁷.

44. It has been noted that, in relation to sounds, this pool could be very vast or even theoretically infinite, since sound signs may be musical and non-musical, existing or “invented” (i.e., especially commissioned). This may not be the case for scents, since it is likely that commercially useful scents would be limited to the range of pleasant scents, given that few traders would be likely to use unpleasant scents as trade marks⁴⁸.

(b) Safeguarding the Public Domain

45. The preceding considerations point out significant differences between the aims and requirements for trademark protection and those pertaining to other areas of intellectual property protection, such as patents, industrial design and copyright. It has been mentioned, for example, that the functionality principle ensures that protection for utilitarian product features be properly sought through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain, and the functional features disclosed in the patent may then be copied by others – thus encouraging advances in product design and manufacture⁴⁹.

46. Similarly, after the expiry of copyright, a work falls into the public domain and, in principle, may be used freely, although certain restrictions may follow from the exercise of moral rights potentially enjoying longer or perpetual protection under national law. The free use of works in the public domain includes the use of a work as a basis for new intellectual creations. Works in the public domain may be freely reproduced, communicated and disseminated. The expiry of copyright protection may thus have a positive effect on the creation of new works because it enhances the available material since the authorization of the copyright owner is no longer necessary⁵⁰.

47. National systems usually contain specific exclusions to the protection as trademarks of signs that are in the public domain⁵¹ and therefore covered by the principle of availability, which was developed in further detail, in subsection (a). Such exclusions normally constitute absolute grounds for refusal of signs applied for trademark protection.

IV. SUMMARY

48. The present document attempts to explore the relation of established trademark principles to new types of marks. It considers functionality, distinctiveness and speciality in general, as well as particular aspects relating to certain marks. Issues of public interest and the safeguard of the public domain, are also dealt with.

49. The overview in Section II is an introduction to the subject-matter of the document and as such, reflects the principle generally stated in the submissions by SCT Members, i.e., that they apply the same criteria to the examination of traditional marks as they do to the assessment of new types of marks.

50. The information contained in that Section demonstrates, however, that while established trademark principles and normal examination techniques seem suitable for the assessment of registrability of new types of signs, additional trademark law analysis and some policy discussion to set the boundaries between different intellectual property rights is needed. Therefore, established trademark principles need to be seen in the context of the specific new signs described in the SCT Members' submissions.

51. Section III deals with the notion of “Public Interest”, which has been mentioned as an important consideration determining the suitability of signs as trademarks and which seems to be important in decisions concerning the registration of new types of marks. Consideration is also given to the need to exclude from trademark protection signs that belong in the public domain.

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1 Submissions by the Delegations of Australia, France, Ecuador, the United Kingdom and the
European Community

2 Submissions by the Delegations of France, The former Yugoslav Republic of Macedonia, and
the European Community. Special conditions applying to shape marks were specifically
mentioned

3 Submissions by the Delegations of Switzerland and the United Kingdom

4 For example, submissions by the Delegations of Australia, France, and the United States of
America. Also Andean Community Decision 486 “Common Provisions on Industrial Property”,
Article 134 and Council Regulation (EC) No. 40/90 on the Community Trade Mark, Article 4

5 GERVAIS, Daniel “The TRIPS Agreement, Drafting History and Analysis”, Sweet and
Maxwell, 1998, p. 105

6 The United States of America Supreme Court in *Qualitex Co. v Jacobson Products Co., Inc.*,
514 US. 159, 164, 34 USPQ2d 1161, 1163 (1995), as stated in the submission by the Delegation
of the United States of America

7 Reference is made to Article 15(1) of the TRIPS Agreement

8 Submission by the Delegation of Australia

9 Submission by the Delegation of the United States of America

10 *Ibid*

11 Submission by the Delegation of Germany

12 *Ibid* and also Submission by the Delegation of Switzerland in the case of sound and color marks

13 Submissions by the Delegations of China, Japan, Switzerland, Slovenia and The former
Yugoslav Republic of Macedonia

14 Submissions by the Delegations of Japan and Switzerland

15 Submission by the Delegation of Australia

16 Submissions by the Delegations of Switzerland and the United States of America

17 Submissions by the Delegations of Croatia, Germany, Slovenia, Norway and the United
Kingdom. In this context, reference has been made to European Court of Justice (ECJ) Cases
C-104/01 *Libertel Groep v Benelux-Merkenbureau*, C-447/02 *KWS Saat v Office for
Harmonization in the Internal Market*, and C-49/02 *Heidelberger Bauchemie GmbH*

18 Submission by the Delegation of Australia

19 Submission by the Delegation of Norway

20 Submission by the Delegation of Australia

21 ECJ Case C-64/02 *OHIM v Erpo Möbelwerk GmbH (Das Prinzip der Bequemlichkeit)*,
paragraph 35, as stated in the Submission by the Delegation of Norway

22 Submission by the Delegation of Ecuador

23 Reference is made to ECJ Case C-353/03 *Société des Produits Nestlé v Mars UK Ltd.*, (“Have a
Break” case) paragraph 23, as stated in the Submission by the Delegation of the United
Kingdom

24 Submission by the Delegation of Switzerland

25 *Ibid*

[Endnote continued from previous page]

- 26 Submissions by the Delegations of Australia and Norway
27 Submission by the Delegation of Australia
28 Submissions by the Delegations of Norway and the United States of America
29 Reference is made to United States Supreme Court Case *TrafFix Devices, Inc. v Marketing Displays Inc.*, 532 U.S. 23 (2001), as stated in the Submission by the Delegation of the United States of America
30 Reference is made to United States Supreme Court Case *Qualitex Co. v Jacobson Products Co., Inc.*, 514 U.S. 159, 164, 34 USPQ2d 1161, 1163 (1995)
31 Reference is made to Article 7(1)(e)(i) to (iii) of Council Regulation (EC) No. 40/90 on the Community Trade Mark and to the submissions by the Delegations of China, Germany, Norway, Slovenia, The former Yugoslav Republic of Macedonia, United Kingdom and the European Community
32 Reference is made to ECJ Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products*, as stated in the submissions by the Delegations of Germany and the United Kingdom
33 Submissions by the Delegations of Germany and Norway
34 Submissions by the Delegations of Australia and the United States of America
35 Submissions by the Delegations of Australia and Norway
36 Submission by the Delegation of Australia
37 Submission by the Delegation of the United States of America
38 Submission by the Delegation of Australia
39 Submissions by the Delegations of Australia and Norway
40 Submission by the Delegation of China
41 Submission by the Delegation of Norway
42 Submissions by the Delegations of Germany, Norway, Slovenia, Sweden, United Kingdom, United States of America and The former Yugoslav Republic of Macedonia
43 SIMON, Ilanah, “ECJ decisions reveal tension over registrability”, *Managing Intellectual Property*, Vol. 2005, No. 149, pp. 55-56
44 The ECJ in C-104/01 *Libertel Groep v Benelux-Merkenbureau*. See comment by Peter Turner-Kerr in “EU Intellectual Property Law: Recent Case Developments”, *IP Quarterly*, 2004, No. 4, Sweet and Maxwell Ltd and Contributors 2004, p. 454
45 *Ibid*
46 In *Qualitex Co. v Jacobson Products Co., Inc.*, *op. cit.*, note 30, the US Supreme Court rejected the color exhaustion theory
47 See FLECK, Lorraine M., “What makes sense in one country may not in another: a survey of select jurisdictions re Scent Mark Registration and a Critique of Scents as Trademarks”, *Center of Innovation Law and Policy*, UK, 2003, pp. 25 to 26
48 See McCUTCHEON, Jani “The Registration of Sounds and Scents as Trade Marks under Australian Law”, *Intellectual Property Quarterly*, Issue 2, 2004, pp. 162 and 163.
49 Submission by the Delegation of the United States of America
50 Reference is made to document SCT/16/5, p. 15
51 Submission by the Delegation of Switzerland