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INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

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NON-TRADITIONAL MARKS – KEY LEARNINGS

*Document prepared by the Secretariat*

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## I. INTRODUCTION

1. At the seventeenth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from May 7 to 11, 2007, the SCT requested the Secretariat to prepare a working document for its next session, taking into account the deliberations of that session and presenting key learnings for Member States in relation to the representation of those types of marks that the SCT had considered during the seventeenth session and any further submissions from SCT Members specifically addressing the issue of key learnings (see document SCT/17/7, paragraphs 7 and 8).

2. Accordingly, the Secretariat has prepared the present document, which is based on the discussions of the parts of document SCT/17/2 corresponding to three dimensional marks, color and sound marks that took place at the seventeenth session of the SCT (see document SCT/17/8 Prov., paragraphs 14 to 97). It is also based on information submitted by the following members of the SCT, prior to the seventeenth session of the Standing Committee: Australia, Bulgaria, China, Croatia, Denmark, Ecuador, Finland, France, Japan, Moldova, Morocco, Norway, Republic of Korea, Russian Federation, Slovakia, Slovenia, Sweden, Switzerland, The former Yugoslav Republic of Macedonia, Turkey, 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. In addition, it takes into account the information submitted by two SCT Members, following the seventeenth session of the SCT, namely Brazil and Turkey.

## II. GENERAL

3. Following the advice given by the SCT at its seventeenth session (see document SCT/17/8 Prov., paragraph 15), the formulation used throughout this document will be “non-traditional marks” instead of “new types of marks”.

4. It is to be noted at the outset, that the representation of non-traditional marks is only part of the more general issue of the representation of signs, which are applied for registration as marks with national Offices. Such representation often takes the form of a picture or drawing, but notably in the case of non-traditional marks, it may take other forms, as long as they demonstrate the nature of the mark, permit proper examination and allow any interested party consulting the register to seize the scope of protection granted to a particular sign.

5. In some instances, the representation of non-traditional marks may imply a combination of elements, such as: an indication of the type of mark in the application, so as to clearly distinguish it from more conventional signs; a detailed description of the mark, sometimes even if a picture or drawing are provided, and other technical means, such as sound recordings or references to color matching systems.

6. Current discussions seem to concentrate on finding “adequate” means of representation of non-traditional marks avoiding procedural requirements that would be too complex or onerous for applicants and Offices. It has been noted that the representation of these types of signs should satisfy not only the Office, but also the general public, including potential competitors, who need to understand what is claimed as a mark.

### III. THREE-DIMENSIONAL MARKS

7. Regarding the representation of three-dimensional marks, two issues seem to be relevant, namely the size of the reproduction and the number of different views of the mark, if any, forming the representation. An indication of the type of mark may also be a standard requirement. Most offices require a two-dimensional graphic or photographic representation of the mark showing the three-dimensional character of the sign.

8. However, there seem to be appreciable differences regarding the number of views of the three-dimensional object or sign to be represented and whether these should be provided only upon invitation by the Office or on the applicant's own initiative. In addition, practices also seem to differ as to whether those additional views should be arranged in a particular way on the application form or could be sent separately as attachments.

9. Concerning the number of views, one position would be that only one view of the mark is acceptable. If the Office is not able to ascertain the actual nature of the mark and considers that this would also be the case for the public, it would ask for a description of the mark in words. An applicant would actually have to request that the Office waive this practice in order to submit additional views.

10. This contrasts with the practice of Offices which leave it up to the applicant to determine the number of views to be submitted. In those systems, it is considered in the applicant's interest to supply the number of representations necessary to show the particulars of the mark. In the practice of other Offices, the question of the number of views necessary to provide an appropriate representation of the mark is considered in case-by-case analysis.

11. In relation to the size of representations there seems to be a large choice<sup>1</sup>, which may also include a diversity of formats. This may create problems for applicants seeking protection for the same sign in more than one jurisdiction. The typical case concerns a country of first filing, which provides for the representation of the mark in A4 or a similar format, or the submission of several reproductions in free format, while the country of the subsequent filing requires a much smaller format, for example 8 x 8 cm.

12. Offices may also have problems when examining marks the representation of which is not sufficiently clear and distinguishable. It may be difficult to distinguish characters or writing, particularly in very small formats and this might be a relevant factor for examination purposes. In such cases, the Office might require additional views or a description of the essential characteristics of the mark.

13. Where an Office has implemented a system of electronic filing, it may define how it will handle images submitted with the trademark application. In one case, for example<sup>2</sup>, the guidelines concerning electronic filing indicate that an attachment must be used for the representation of non-word marks and that only attachments using the *jpeg*<sup>3</sup> format will be accepted.

#### IV. COLOR MARKS

14. The first question regarding the representation of color marks is whether the same requirements should apply to the representation of color claimed as a distinctive feature of the mark and to color *per se* marks. In some jurisdictions, there seems to be a need to define this preliminary question, by determining that certain (more stringent) requirements should apply to color *per se* marks. Since the latter have been included in the category of non-traditional marks, the paragraphs that follow will refer to that type of sign and to combinations of color without delineated contours.

15. Since color marks are visible signs, the representation of such marks can be achieved by supplying a sample of the color or colors on paper. It is of course also possible to describe the colors making up for the mark in words (i.e., by using their common names). The nature of the mark is generally indicated in the application form or otherwise annotated in the remarks. A description of how the color is applied to the goods or is used in relation to the services may also be required.

16. A description of the color may include a reference to a color code, such as PANTONE®, RAL™, Focoltone®, RGB, etc. Office practice in this regard appears to be diverse. Some Offices make the reference to color codes a formal requirement of the application, others recommend the use of such references, yet others simply accept such indications should the applicant decide to include them<sup>4</sup>.

17. According to an authoritative view, a verbal description, in so far as it is composed of words which themselves are made up of letters, does constitute a graphic representation of the color, but it may not be sufficient in every instance. This view was preceded by an analysis of the modalities for representation of color signs, namely a sample of the color on paper, which considered that this form was not stable as it could deteriorate with time and would, therefore, not constitute, by itself, a graphic representation of the sign<sup>5</sup>.

18. Nevertheless, the designation of a color using internationally recognized color codes may be considered to constitute graphic representation, as those codes are deemed to be precise and stable<sup>6</sup>. However, a different view is whether reference to color codes should be supplied in addition to or instead of other representation requirements<sup>7</sup>. More generally speaking, it seems that a large number of Offices are recommending the use of color code references for the sake of precision, leaving it to the applicant to choose the preferred industry standard.

19. Certain Offices have encountered problems relating to the distortion of the original colors as a result of electronic transmission or scanning of color images. In this context, it should be mentioned that the Trademark Standards Task Force of the Standards and Documentation Working Group (SDWG) of the WIPO Standing Committee on Information Technologies (SCIT) is working on Guidelines for electronic image format and size, as part of a Draft Recommendation for the Electronic Management of Figurative Elements of Marks.

## V. SOUND MARKS

20. The preliminary question regarding sound marks is whether they relate to musical sounds, either pre-existing or specially commissioned for the purposes of trademark registration, or whether they consist of other sounds, either existing in nature (i.e., animal sounds, or sounds produced by meteorological or geographical features) or produced by machines and other man-made devices.

21. The representation of musical sounds under a strict requirement that such a representation be “graphic” is normally achieved by an indication of the type of mark in the application and by supplying the musical notes on a pentagram. These basic requirements may be supplemented by a description of the sound in words, indicating the instruments used, the notes that are played, the length and any other characteristics of the sound.

22. Many countries also require a recording of the sound in a commonly used audio media, namely cassette or audio CD. The introduction of electronic filing has made it possible to file the reproduction of the sound by using an electronic file, such as MP3 or .WAV<sup>8</sup>, which could be made available to the public via the Internet Website of the Office or simply by allowing access to the recording at the Office premises to any interested party.

23. According to one view, the graphic representation of sound marks can be achieved by a staff divided into bars and showing, in particular, a clef, musical notes and rests, whose form indicates the relative value and, where appropriate, accidentals, thereby determining the pitch and duration of the notes. If not immediately intelligible, through this form of representation the authorities and the public, in particular traders, can find out the sound easily<sup>9</sup>.

24. It is clear, however, that more flexible interpretations exist as to what should constitute “graphic” representation for the purposes of registration of sound marks, and this has been understood to correspond to musical notation and also a description in words. Where “graphic” representation is not an absolute requirement, recordings of the sound would be considered to be suitable representation of the mark. In fact, it has been noted that where the mark consists solely of a sound, a scent, or other completely non-visual matter, the applicant is not required to submit a drawing<sup>10</sup>.

25. The representation of non-musical sounds could be achieved through other methods, including onomatopoeia of the sound, a description in words, a sound recording annexed to the application form, a digital recording made available via the Internet, or a combination of those methods. This type of representation would seem relatively easy to achieve and quite accessible to the general public. In addition, to preserve accessibility, technical modes of representation that would only be understood by specialists would not seem acceptable. Nevertheless, according to one view, a simple onomatopoeia cannot without more constitute a graphical representation of the sound or noise of which it purports to be the phonetic description<sup>11</sup>.

26. The duration of a sound, in particular of musical sounds, may be relevant to determining whether the sign may constitute a mark. In most instances, the lengths applied for are rather short, and it has been mentioned that the Office could determine a maximum length of such signs. Definitely, the length of the musical sound would have an impact on the type of graphic representation that is acceptable for the Office. In particular, length would be important when the representation of the mark consists of musical notes, but it would seem less important in the case of digital or other forms of recording.

## VI. DESCRIPTION OF THE MARK

27. In the case of certain signs, a description in words appears to be the necessary complement to other methods of representation. In some cases, it might even seem like the only suitable (or possible) method. Some national laws already provide guidelines or minimum requirements concerning descriptions<sup>12</sup>. However, it might be helpful to look at this issue in further detail.

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<sup>1</sup> A random sample of the size of representations in different members and systems indicated the following dimensions: 8 x 8 cm (Madrid System-Form MM2), 8 x 8 cm (United Kingdom), 6 x 6 cm (Brazil), with a 0.5 cm on all sides, effectively meaning a 5 x 5 cm area; 8 x 12 cm (Spain), 10 x 10 cm (Australia), not larger than 10 x 10 cm and not less than 4 x 4 cm (Mexico), 17.5 x 10 cm (OAPI), and an A4 sheet (Singapore).

<sup>2</sup> Office for Harmonization in the Internal Market (Trade Marks and Designs), OHIM.

<sup>3</sup> JPEG: Joint Photographic Experts Group, the name of the group that created the standard that describes a coding scheme for the compression of images, as well as the file format for storing the compressed image.

<sup>4</sup> See document SCT/17/2, paragraph 15.

<sup>5</sup> *Libertel Groep BV v Benelux-Merkenbureau*, Case C-104/01 [2003] ETMR 63, paragraphs 31 to 35.

<sup>6</sup> *Libertel Groep BV v Benelux-Merkenbureau*, Case C-104/01 [2003] ETMR 63, paragraph 37.

<sup>7</sup> In its submission to the SCT, the United Kingdom Delegation indicates “we require the color to be identified by reference to an internationally accepted color code such as Pantone®, RAL™ or RGB. Applicant does not have to supply a representation, but may do if they wish”. See <http://www.wipo.int/sct/en/comments>.

<sup>8</sup> See document SCT/17/2, paragraph 32.

<sup>9</sup> *Shield Mark BV v Joost Kist*, Case C-283/01 [2004] ETMR 33, paragraph 64.

<sup>10</sup> Submission by the Delegation of the United States of America, page 2, see <http://www.wipo.int/sct/en/comments>.

<sup>11</sup> *Shield Mark BV v Joost Kist*, Case C-283/01 [2004] ETMR 33, paragraph 60.

<sup>12</sup> For example, Rule 1(1), paragraph (2) of the Regulations applied by the Benelux Office for Intellectual Property (BOIP) provides that the applicant should describe in 50 words the distinctive elements of its mark. Submission of the BOIP, page 2, see <http://www.wipo.int/sct/en/comments>.