

Part 21 Shapes, Sounds, Colours, Scents and Aspects of Packaging

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Relevant Legislation

The Act

Section 6 Sign

Section 17 What is a trade mark?

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Section 40 Trade mark that cannot be represented graphically

Section 41 Trade mark not distinguishing applicant's goods or services

The Regulations

Reg 4.3 Representation of trade marks

1. Shapes, sounds, colours, scents and aspects of packaging

One of the intentions of the introduction of the *Trade Marks Act 1995* was to broaden the definition of a trade mark. The 1995 Act at section 17 defines the nature of a trade mark in the following words:

A trade mark is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person

The word "sign" is defined at section 6 as follows:

Sign includes the following or any combination of the following, namely any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent".

This definition added to the legislation four signs which at the time of the introduction of the Trade Marks Act 1995 were new to consideration as trade marks. These are "shape", "sound", "scent" and "aspect of packaging". The definition also articulates "colour" as a sign, and although colour was dealt with on occasions under the repealed Act, it seems appropriate to deal with it in this section, along side the more unusual kinds of sign.

In this Part "aspect of packaging" is dealt with in the "shape" and "colour" sections as these are the areas that incorporate the vast majority of trade marks that could be said to be aspects of packaging.

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2. Representing shapes, sounds, colours, scents and aspects of packaging

- It is a requirement of the legislation that a trade mark be represented graphically (section 40).
- The representations must clearly demonstrate the nature of the mark, and show each feature clearly enough to permit proper examination (subregulation 4.3(8)).
- In particular, where the trade mark contains or consists of a sign that is a colour, scent, shape, sound or an aspect of packaging, or any combination of those features, the application for registration must include a concise and accurate description of the trade mark (subregulation 4.3(7))
- The description is entered as an endorsement on the registration.

It is clear from the regulations that these kinds of signs need both pictorial representations of the trade mark where possible, and a clear description before the scope of the application is properly defined and effective examination can take place.

The requirements for pictorial representations of each kind of mark, where relevant, will be dealt with later in the Part in the specific paragraphs discussing each individual kind of sign.

2.1 Description endorsement

All these kinds of signs require a description, whether or not a pictorial representation is relevant. Ideally, the description of the trade mark should appear on the application when filed. There should be no discrepancy between the description and the required graphical representations and the relationship between them should be clearly spelled out, for example by including a cross reference to the representation in the description.

Without a clear description of the trade mark claimed, it may be difficult to research it for section 41 purposes. It may also be difficult to search the database for any conflicting trade marks on the Register. There may also be questions raised about the scope of the applicant's claim. The description is thus very important in helping Part 21 Shapes, Sounds, Colours, Scents and Aspects of Packaging

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decide the exact nature of the trade mark claim. Examples of appropriate descriptions for the various kinds of signs are included in the specific sections of the Part referring to those signs.

2.2 Amendments to descriptions

It is important to note that the description is an integral part of the representation of the trade mark and any amendments made to it will affect the trade mark. If the applicant puts forward a proposal to amend the description that would change the identity of the trade mark then that amendment will not be allowed. When a description is supplied after filing care must be taken that the description is exactly in accord with the trade mark as filed. The combination of description and representation should not include any differences that would affect the identity of the trade mark, thus constituting an unallowable amendment.

2.3 Amending descriptions to accord with the representations on file

On occasions, an applicant may claim the trade mark as a shape or colour mark, but the representations filed include words and/or other material as well. In many of these cases, while the shape/colour itself might not be capable of distinguishing, the combination of the shape/colour and the additional material included in the representations adds up to a trade mark with sufficient adaptation for *prima facie* acceptance. In these cases, it is appropriate to amend the description to make mention of the facts of the case, if the applicant is agreeable to the change. A change of this nature does not extend the applicant's rights because the additional material formed part of the published record at the time of filing. However, adding words/devices/colours/shapes to a plain rendition of a shape/colour post filing is likely to be a substantial change to the mark as filed and may not be allowed.

3. Shape (three-dimensional) trade marks

Prior to the introduction of the 1995 Act, shape trade marks were not registrable because a trade mark was considered to be something separate and apart from the goods, a material sign to be affixed to the goods or their container (see *Coca-Cola Trade Marks* [1986] RPC 421, the *Coca-Cola bottle* case). Another view held was that three-dimensional objects were more properly registrable under the Designs legislation if they were novel and original. However, since the definition of "sign" in Trade Marks Examiners Manual

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section 6 of the 1995 Act specifically mentions shape as a sign, there is no doubt that a three-dimensional shape is now registrable as a trade mark if it meets the requirements of the Act.

3.1 Representations and descriptions of shape trade marks

The Regulations require that any trade mark application must include descriptions and/or representations that show each feature of the trade mark sufficiently clearly to permit proper examination of the trade mark.

This requires some different considerations for representing shape trade marks.

- The representation of the trade mark should, where practicable, be in the form of perspective or isometric drawings that show clearly all the features of the trade mark. The parts of the configuration claimed to constitute the trade mark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines.

- The drawings, views and/or photographs of the trade mark must also be accompanied by a written description of the trade mark.

- The description and the pictorial representation of the shape trade mark should together clearly define all the details which constitute the trade mark.

Examples of suitable descriptive endorsements to accompany the representations are as follows:

The trade mark consists of the shape of a biscuit, as shown in the representations attached to the application form.

The trade mark consists of the 3-dimensional shape of a rooster applied to the roof of a vehicle, as shown in the representations attached to the application form, where the vehicle itself is represented as dotted lines.

- In the case where the pictorial representations are particularly clear, and all features of the mark are obvious, a briefer description of the trade mark will be acceptable. For example:

The trade mark is a three dimensional trade mark, as shown in the representations attached to the application form.

Note: Examiners need to ensure the wording of any descriptive endorsement clearly delineates the scope of the trade mark. A term such as "as exemplified in the representation" is not sufficiently precise, and should not be accepted. This term does not clearly specify what the trade mark is. It merely says that an example of what the trade mark might be is attached to the application form.

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3.1 A graphical representation is required

3.2 Representation of the trade mark - Shape (3-dimensional) trade marks

3.2 Shapes may be capable of distinguishing

Applications for shapes as trade marks should be considered under the same broad criteria as any other kind of sign. The normal test applies - whether the shape claimed as a trade mark is capable of distinguishing the goods or services of one trader from the similar goods or services of another. The appropriate inquiry was set out by Kitto J in *F.H. Faulding & Son Ltd v Imperial Chemical Industries of Australia and New Zealand Ltd*, (the Barrier Cream case (1965) 112 CLR 537 at 555) and is paraphrased as follows:

The question to be asked in order to test whether a [shape] is adapted to distinguish one trader's goods from the goods of all others is whether the

[shape] is one which other traders are likely in the ordinary course of their business and without any improper motive, to desire to use upon or in connection with their goods.

The *Kenman Kandy* decision (*Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks*, [2002] FCAFC 273) confirms that a shape may be capable of functioning as a trade mark and it is not appropriate to object *prima facie* that a shape is not a trade mark because the public will need to be educated to see it as a badge of origin. The shape must be considered in the context of the market in which it is placed, and a decision on its adaptation to distinguish then made using the usual tests.

3.3 Shapes which are common to the trade

Any shape which is commonplace for the goods in question is likely to be legitimately needed by other traders. It is therefore unlikely to be registrable *prima facie*. The conclusion that something is common to the trade should only be reached after research reveals that that shape, or some minor variation of it, is commonly used within the relevant market. Examples of these types of shapes are normal wine bottles for wines; ordinary cylindrical shaped jars for sauces; a standard umbrella shape for sun umbrellas; a cylindrical mug shape with a standard handle for coffee mugs and egg shaped or rabbit shaped Easter chocolates.

Commonplace shapes of these kinds will attract grounds for rejection under the provisions of subsection 41(6). It will be necessary for the applicant to supply evidence of use demonstrating that the shape, at the date of filing, did distinguish the applicant's goods/services from those of other traders.

3.4 Shapes and functionality

There are a number of issues which must be looked at when considering whether other traders are likely to need to use a shape in respect of their own goods/services

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and thus whether it is adapted to distinguish. The first of these is the issue of functionality.

If a shape has *significant* functional features there is a strong likelihood that other traders will need to use that shape for their similar goods. Therefore, the shape will not be inherently adapted to distinguish, and grounds for rejection should be raised.

A shape can be regarded as functional if:

- it is a shape essential to the use or purpose of the article. For example, the shape of the handles and blade assembly for a pair of scissors, necessary for the functioning of the article.
- it is a shape needed to achieve a particular technical result. For example, the shape of vanes in a fan which will create a particular air flow pattern.
- it is a shape which has an engineering advantage, resulting in superior performance. For example, a new invention for opening a bottle that is easier to use than existing devices.
- the shape results from a comparatively simple, cheap method of manufacture.

For example, simple extruded or cut shapes for biscuits, such as discs or rectangles.

The presence of functional features need not be fatal to an application. In some cases, the other features of a mark may be sufficient to allow for acceptance where it is obvious that the applicant is not seeking or gaining rights in functional aspects. If something extra has been added to the inherent form of the goods, that will weigh in favour of acceptance. For example, a wheelie bin shaped like a lighthouse is

functional in that it is a receptacle designed for waste products. However, the presentation of the bin in the form of a lighthouse is not something that other traders are likely "without any improper motive, to desire to use upon or in connection with their goods". The shape of the bin as a whole would be capable of distinguishing, and registration would not give the owner rights to the functional features of the receptacle.

If the shape of the trade mark is intrinsically functional with an engineering advantage that has yet to become commonplace, but nevertheless, because of its utility, should remain open for all to use, it is appropriate to raise grounds for rejection. An example here could be a new invention for opening a bottle, easier to use than those currently on the market. Such a shape is unlikely to have sufficient adaptation to distinguish for *prima facie* acceptance, because the shape is highly functional and there is an identified need for others to use it.

3.5 Shapes and aesthetics

There is no reason to object to a shape merely because it is attractive or aesthetically pleasing, and therefore other traders might want to use it. Most traders would hope Part 21 Shapes, Sounds, Colours, Scents and Aspects of Packaging

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that their trade marks, whether or not they are shapes, are attractive to the consumer. The test for the shape mark must be the same test applied for any other mark - whether the shape is one which other are likely to want to use without any improper motive. The question of aesthetics is peripheral only to this test, and should play a relatively minor part in the consideration of whether a shape is adapted to distinguish.

This view is supported by the comments of Justice Stone in *Kenman Kandy*. The discussion involved references to both the *Tub Happy* decision (*Mark Foy's Limited v Davies Coop & Company Limited* (1956) 95 CLR 190) and the *Wella* decision (*Wella Aktiengesellschaft v Registrar of Trade Marks* (1995) 33 IPR 374). Stone J commented at paragraph 156:

In the above examples the trade marks were held to be inherently adapted not because of any positive content but because they had no associations or significations that prevented them from being inherently adapted to distinguish a trader's goods. In addition they show, especially in the comments made in Mark Foy's and Wella, that, at least in relation to word trade marks, it is not an obstacle to inherent adaptation that the trade mark is also designed to elicit a positive emotional response. The fact that the "sign" that comprised the trade mark in those cases had a dual function was not seen to be inconsistent with the sign acting as a trade mark in respect of certain goods. I see no reason why the attractiveness of a shape should be considered differently. Moreover, I also see no reason why an invented shape should be regarded as different from an invented word in terms of assessing its inherent capacity to distinguish a traders goods.

3.6 Shapes and invention

An invented shape should be treated in a similar manner to an invented word, and is equally entitled to *prima facie* acceptance. Refer to the comments by Stone J above. However, the question of what amounts to invention in respect of a shape is far from clear. *Kenman Kandy* gives some guidance on what may be regarded as invention in the confectionery trade, but does not offer clear guidance on what amounts to invention in other trades.

It may be difficult to "invent" shape in some trades. For example, toys in class 28 already incorporate as commonplace a great variety of shapes. In this class it is unlikely that a simple shape such as a bear or tractor will be registrable unless there is considerable additional get up of the sort not normally found in the marketplace. Merely clothing a toy bear or doll will not be sufficient to identify the shape as registrable. The get up of the clothing, and the whole combination would need to be most unusual.

In some other classes of goods, while a shape per se might not strictly speaking be a new or different shape, it may be unusual enough in respect of the particular goods of interest to be capable of distinguishing. An example of such a shape is the lighthouse shaped wheelie bin mentioned at paragraph 3.4.

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If a trade mark is registrable as an invented device in a two dimensional form, this suggests it would be similarly registrable in its three dimensional form.

3.7 Researching shape marks

Researching shape trade marks may on occasions present problems for examiners. It may be difficult to target the search to the shape itself, and the most appropriate methodology might be to search sites within the particular industry to determine what shapes are already in use. Trade magazines, catalogues, advertising brochures and industry specific publications, if available, would also be useful.

It is important that the examiner look, not just for the exact shape, but for similar shapes and shapes in the same class or category as the one applied for in the application under consideration. If the shape is a minor variation of something already common within the industry, the examiner will need to raise grounds for rejection based on the shape's lack of inherent adaptation to distinguish for the goods claimed.

Despite the difficulties inherent in searching for a shape rather than a word, an exhaustive examination of the Internet and/or printed material is neither expected nor required. Commonplace shapes will most likely be easily accessed via a basic Internet search within the relevant industry, and by reference to any easily available printed material. In many instances the examiner may make a judgement based on his/her own knowledge without the need to conduct an Internet search. For example, there would be no need to conduct an Internet search for common bottle and jar shapes if the goods were sauces and jams.

Unusual shapes are, by definition, more likely to be acceptable. If, after the examiner has carried out a reasonable level of research, the shape does not appear to be either functional or common to the trade, the shape should be considered as capable of distinguishing.

3.8 Shape of packaging or aspect of packaging

The same considerations as to functionality and capability to distinguish that apply to the shape or configuration of the goods themselves also apply to the shape or configuration of the packaging of goods. Packaging may include the container in which the goods are sold or the outer packaging which covers the goods and the container. Shape is just one aspect of packaging and the more unusual the shape of the container or box applied for as a trade mark, the more likely it is to be capable of distinguishing the applicant's goods.

3.9 Evidence of use for shape trade marks

If grounds for rejection are raised against a shape trade mark under the provisions of

either subsection 41(5) or subsection 41(6), the applicant may decide to provide evidence of use. Any such evidence needs to meet the same basic requirements as evidence for any other kind of trade mark.

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Part 23 - EVIDENCE

Applications for shapes may face difficulties in demonstrating an adaptation to distinguish. All goods have shapes, and containers for goods come in shapes. Customers expect a variety of shapes for goods within many trades. It may not be as easy for the applicant to show the capability of a shape trade mark to distinguish their goods as it would be if the trade mark consisted of words, devices or phrases. For a shape to have acquired recognition as a trade mark, it will need to have been promoted as something apart from the goods. Entries in catalogues or brochures showing pictures of the goods in the shape claimed are not definitive, even if the applicant is able to show many years of such material. What may be more useful are examples of advertising text referring specifically to the shape in respect of the goods. Statements such as "Look for the star shaped box" or "Attractive colours; unusual shape" are the type of promotional terms that may assist an applicant in demonstrating that the shape has a capacity to distinguish. Consumer surveys based on recognition of the shape, declarations from the trade and declarations from consumers relating to recognition of the shape as an indicator of trade source may also be valuable.

3.10 Registered design as a trade mark

There should be no grounds for rejecting an application for registration of a trade mark that is or contains a shape (that is, a three-dimensional object) merely on the grounds that the applicant has a design registration, or a pending application for registration of a design, for the same three-dimensional object (*United States Playing Card Co's Application* [1908] 1 Ch 197; *Charles Goodall & Son Ltd v John Waddington Ltd* (1924) 41 RPC 658; *Sobrefina S.A.'s Trade Mark Application* [1974] RPC 762 at 680). However, the fact that features of shape and configuration of a container for goods have been registered under the Designs Act, does not mean that they are necessarily adapted to distinguish as a trade mark. (See *S.C. Johnson & Son, Inc's Appn.* (1980) 50 AOJP 4200 (Reg)).

4. Colour and coloured trade marks

A colour, by itself or in combination with other colours and/or any of the other features which fall within the definition of a sign, may be used as a trade mark. For Trade Marks Examiners Manual

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example, a trade mark may consist of a coloured label or ticket which incorporates other signs, or it may consist of a colour or colours applied to the goods themselves. Colour may also be an aspect of packaging which is used as a trade mark. An example here is a particular coloured wrapper or box used to cover the goods. In all cases the trade mark will only be registrable if, taken as a whole, it is capable of distinguishing the applicant's goods and/or services from those of other traders.

4.1 Representations and descriptions of colour marks

- An application for a colour or colours as a trade mark must include a clear

and concise description of the trade mark as an endorsement to the application.

- A pictorial representation showing the colour claimed and the manner in which it is to be applied to the goods or packaging should also be supplied, especially in cases where the description is complex.
- An example of the actual colour or colour combination claimed should be supplied in all cases.
- If the applicant chooses to define the colour/s more precisely by the use of a recognised colour matching system, this reference may be included in the descriptive endorsement. The Office does not, however, support, or insist on, the use of any specific colour identification system.
- The description and the pictorial representation of the colour trade mark should together clearly define all the details which constitute the trade mark. Examples of suitable endorsements to accompany the representations are as follows:

The trade mark is a colour mark. It consists of the colour GREEN applied to the upper surface of the goods, as shown in the representations attached to the application form.

The trade mark consists of the colour GREEN, specifically identified as PMS 348C, applied to the cap of a container as shown in the representations attached to the application form.

The trade mark consists of three vertical stripes in the colours PURPLE, GREEN and YELLOW applied to the fascias of buildings and to doors as shown in the representations attached to the application form.

Note: A claim for colour as "an essential element" is unacceptable terminology as it neither restricts the trade mark to colour, nor gives any useful information as to the use of the colour within the trade mark.

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3.1 A graphical representation of the trade mark will be required.

3.5 Colour trade marks

4.2 Combinations of colours applied to the goods or their packaging

As with any other sign, a combination of colours being claimed as a trade mark must pass the usual tests for adaptation to distinguish. These tests are set out in the discussion on shape trade marks in paragraph 3. The colour/s may be applied directly to the goods, or may form part of the overall appearance of the packaging.

4.2.1 A combination of colours may be applied directly to the surface of the goods.

For example, copper and black colours applied to batteries; maroon and gold colours as applied to pharmaceutical capsules; green and white colours applied to pharmaceutical capsules. The Trade Marks Office accepted some of these trade marks on proof of "factual distinctiveness" under the repealed Act and under the provisions of subsection 41(5) of the Trade Marks Act 1995, thereby acknowledging that such trade marks may have some degree of inherent adaptation to distinguish.

4.2.2 Trade marks consisting of two or three colours applied directly to the goods are likely to possess a greater degree of inherent adaptation than single colours and in some cases may be *prima facie* acceptable. The question, as always, will surround the degree to which other traders are likely to want to use the colours and the answer should stem from a consideration of what is normal in the market place or

relevant trade. For instance, in the case of "roofing nails" which are typically coloured after the metal they are made from (steel, zinc etc), the colour "grey" would be to no extent inherently adapted to distinguish (s41(6) applying) whereas a combination of "pink" and "green" for these goods is arguably not commonplace and may be *prima facie* acceptable.

4.2.3 Similarly, combinations of colours applied to the packaging of goods should be considered in light of what is normal in the relevant trade or marketplace.

4.3 Single all over colouring applied to the goods or their services

A trade mark may also consist of a single all over colour applied to the surface of goods or to the container or packaging in which they are marketed.

In the past there was considerable discussion in relation to whether colour applied in this manner was capable of functioning as a trade mark. For many goods the general view was that colour would be seen as mere ornamentation, and it was considered unlikely to be registrable. However, there are examples of traders successfully using a single colour to denote the origin of their goods and with sufficient evidentiary support, a single colour applied to the goods may indeed be found to be capable of distinguishing.

Examples are the colour maroon for electronic storage batteries, the colour orange for the labels on sparkling wines and the colour terracotta for irrigation pipe

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connectors (the *Terracotta* decision, *Philmac Pty Limited v The Registrar of Trade Marks* [2002] FCA 1551).

4.3.1 Single colour applied to the goods.

A single colour applied to the surface of goods that are normally coloured will generally be regarded as being devoid of inherent adaptation to distinguish, and the provisions of subsection 41(6) will apply. This view was supported by Mansfield J in the *Terracotta* decision where he decided that the colour "terracotta" was devoid of adaptation to distinguish for the goods the applicant was claiming.

While his Honour decided that the particular case should proceed under the provisions of subsection 41(6), he went on to discuss the issue of a single colour applied directly to the goods, and to give some guidelines for assessing these types of marks (paragraph 65).

"...I do not mean to suggest that a single colour applied to goods may never be inherently adapted to distinguish an applicant's goods from those of other traders. Such a conclusion would be inconsistent with the provisions of the Act that contemplate that a colour may serve as a trade mark. The definition of a sign in the Act provides that a colour may be a sign in its own right, and not merely as an element of another species of sign such as a logo or aspect of packaging. It would therefore not be in accordance with the Act to reject a trade mark purely on the basis that rejection would secure a monopoly over part of what is in reality a limited resource. However, having regard to the above principles and the test in Clark

Equipment, I consider that the circumstances in which a colour applied to goods will be inherently adapted to distinguish are limited to the following:

** the colour does not serve a utilitarian function: that is, it does not physically or chemically produce an effect such as light reflection, heat absorption or the like;*

** the colour does not serve an ornamental function: that is, it does not convey a recognised meaning such as the denotation of heat or danger or*

environmentalism;

** the colour does not serve an economic function: that is, it is not the naturally occurring colour of a product and registration of that colour in respect of that product would not thereby submit competing traders to extra expense or extraordinary manufacturing processes in order to avoid infringement;*

** the colour mark is not sought to be registered in respect of goods in a market in which there is a proven competitive need for the use of colour, and in which, having regard to the colour chosen and the goods on which it is sought to be applied, other properly motivated traders might naturally think of the colour [and] use it in a similar manner in respect of their goods."*

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4.3.2 Single colour applied to packaging

Similarly, a colour used as the overall colour of packaging is unlikely to be adapted to distinguish for the same reasoning as the colour on the goods themselves. Again, the onus lies with the applicant to demonstrate that the colour is capable of distinguishing the applicant's goods from those of other traders.

4.4 Colours claimed as trade marks for services

An applicant may make a claim for a colour or colours as a trade mark for use in respect of services. Again, a colour or combination of colours used in respect of services meets the description of a sign for the purposes of the Act.

4.4.1 As with applications for goods, a clear description of the nature of the trade mark is required so that its scope is clearly defined. This description must identify how the colours are used in respect of the services claimed. For example, a red swatch attached to an application form together with a claim for "*the colour red, as depicted in the example attached to the application*" in respect of retailing services is not sufficient, as it does not explain how the colour is used in respect of the services. A more acceptable description for retailing services would be the following: "*The trade mark consists of the colour red applied in a single broad stripe to the fascias and doors of buildings. The colour and configuration of the trade mark are shown in the examples attached to the application form*". The accompanying examples would need to clearly show how the broad stripe is applied to the buildings and doors.

4.5 Registrability of colour as trade marks

The preceding paragraphs have discussed the use of single colours, and combinations of colours as trade marks. The Courts have determined that a single colour is unlikely to be inherently adapted to distinguish, whereas a combination of colours may have at least some degree of inherent adaptation. Each application must be examined in the light of the market in which the trade mark is to be used, and some issues similar to those which apply to shapes need to be considered.

4.5.1 Functionality and colour

There are a number of situations in which a colour or colour combination may be regarded as functional, and therefore not inherently adapted to distinguish an applicant's goods or services from those of others.

Colours providing a particular technical result

A colour may also be functional if it serves to provide a particular technical result for the goods concerned. The colour black for solar power collectors and associated piping is an example here. Similarly, the colours silver or white in situations where heat or light reflection is required would be regarded as functional. An example of this circumstance is a silver colour for building insulation sheeting to go under roofing

tiles.

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Colours conveying a generally accepted meaning.

A colour may be functional if it has developed a generally accepted meaning in the trade or the wider community. For example, yellow or orange colours are generally accepted for safety signs and red for a hazard warning sign. Red is likewise the generally accepted colour to denote a fire extinguisher and its whereabouts. These colours serve a functional purpose in respect of these items, or goods and services likely to use such items.

4.5.2 Colours which are common to the trade

Colours which are commonly used with the particular trade are not likely to be capable of distinguishing one trader's goods from those of another.

Colours which are the natural colour of goods

A colour may be common to the trade if it is the natural colour of the product itself or the natural colour of the product because of the manufacturing process. The granting of a monopoly in such a colour may interfere with the ability of other traders to produce the goods by normal manufacturing procedures, and may thereby force a change to a more costly production method to avoid producing goods in their natural colour. For example, a monopoly cannot be granted in the natural colour of hemp rope or seagrass matting because consumers would be unable to distinguish the goods of the trade mark owner from those of other producers whose manufacturing processes result in goods of the same colour. Other producers would be obliged to produce their goods in different colours via a possibly more expensive process. The natural colours have no inherent adaptation to distinguish for the goods in question.

Colours for which there is a competitive need

If there is a proven competitive need for the use of colour in a particular market, the colour is likely to be difficult to register. A colour is most likely to fall into this category if manufacturers within the particular industry do not typically colour their products, or the accepted standard is one particular colour. This issue was referred to in the Terracotta case, where Justice Mansfield considered that the terracotta colour was an obvious and apt choice for the goods in question, and was therefore the kind of colour that another honest trader might legitimately desire to apply to his similar goods.

4.6 Researching colour trade marks

As with shape marks, an exhaustive search of the Internet or published material is neither expected nor appropriate. However, the examiner needs to do sufficient research to determine if the colour is common to the trade or is used in a functional manner within the particular industry. Grounds for rejection are likely to be raised for applications consisting of a single colour or a combination of only two or three colours. The onus is then on the applicant to support the application with evidence of use.

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4.7 Evidence of use for colour trade marks

Evidence of use for colour trade marks needs to meet the same basic requirements as evidence for any other kind of trade mark.

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For a colour or combination of colours to be recognised as a trade mark, the applicant usually needs to be promoting the colour/s as something apart from the goods or their packaging. Entries in catalogues or brochures showing pictures of the goods in the colour claimed may not be sufficient, even if the applicant is able to show many years of such material. However, if research or information from the applicant demonstrates that the usual colour for the goods in question is something quite different, these examples will be more persuasive.

Examples of advertising text referring specifically to the colour/s in respect of the goods will be most useful. Statements such as "Look for the orange coloured box" or "Unusual colours; exceptional goods" are the type of promotional terms that will assist an applicant in demonstrating that the colour/s have the capacity to distinguish. Consumer surveys based on recognition of the colour/s and declarations from the trade and from consumers attesting to a recognition of the colour/s as an indicator of trade source may also be valuable.

5. "Sensory" trade marks - sounds and scents

The definition of "sign" in the Act allows for the registration of sounds or scents as trade marks. While these types of trade marks are not as common as trade marks consisting of words or devices, identification of goods or services via the auditory or olfactory senses is entirely possible. These "sensory" marks must meet the same requirements as any other trade mark. They must be capable of distinguishing the goods/services of the trade mark owner from the similar goods and services of other traders.

5.1 Representing sounds and scents

Section 40 of the Act specifies that "*an application for the registration of a trade mark must be rejected if the trade mark cannot be represented graphically*". This

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requirement has the most impact in regard to sensory trade marks such as sound and scent trade marks because other kinds of signs are, by their nature, graphical. As the words "represented graphically" have not been judicially defined, it is appropriate to take as their meaning the common, ordinary meaning they would be given by an ordinary person reading them - the so-called "golden rule" of statutory interpretation. The *Macquarie Dictionary* gives *graphical* as the equivalent of graphic, and defines "graphic" as follows:

2. *pertaining to the use of diagrams, graphs, mathematical curves, or the like; diagrammatic.* 3. *pertaining to writing: graphic symbols.*

"Represent" is defined as:

1. *to serve to express, designate, stand for, or denote, as a word, symbol, or the like; symbolise.* 2. *to express or designate by some term, character, symbol or the like: to represent musical sounds by notes.*

Taken together these definitions make it fairly clear that to be expressed or represented graphically a trade mark can be represented by symbols in the form of diagrams and/or writing. However, as with shape and colour trade marks these representations must make it clear to the general public exposed to the trade mark application/registration, what the scope of the trade mark is. Specific issues for representing sounds and scents will be dealt with during the discussion of the particular kind of sign.

5.2 Researching sounds and scents

Researching sound and scent trade marks may present a challenge to the examiner. Most of these kinds of applications will not require specific research. However, in cases where the issue is not clear, a basic Internet search conducted in the field/s in which the applicant intends using the trade mark should be sufficient to determine whether specific scents or sounds are common to the trades in question.

6. Sound (auditory) trade marks

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A sound trade mark can be anything auditory. It can be a complex orchestral fanfare, or a simple mechanical clicking noise. It can be sung or spoken words, or a combination of voice and other sounds. It can be the sound of a dog barking, a bell ringing or a baby crying. Whatever it is, it must serve the purpose of identifying the trade source of the goods/services in respect of which it is to be used.

6.1 Representations and descriptions of sound trade marks

- An application for a sound as a trade mark must include a graphical representation of the mark. This may be a simple verbal description of the sounds such as "CLIP CLOP MOO" (see second example of acceptable descriptions below).
- Musical notation is acceptable as a graphical representation of a sound mark consisting of a musical piece. However, a lengthy piece of musical notation such as the complete score of an orchestral or piano piece is of limited use.
- The name of a specific piece of music is not acceptable as a graphical representation unless additional information is supplied to identify the particular rendition claimed as a trade mark. Refer to the first example of acceptable endorsements below. In general, the musical notation of the specific piece would be more appropriate than just its name.
- As well as the graphical representation, the applicant must supply a clear and concise description of the trade mark which will be entered as an endorsement to the application.
- The applicant must supply recordings of the trade mark on a medium which allows for easy replaying. Audio tapes, Compact Discs or other media which are easily and commonly accessible are acceptable.
- The description and the recorded representation of the trade mark should together clearly define all the details which constitute the trade mark.

Examples of suitable endorsements to accompany the representations are as follows:

The trade mark is a sound mark. It comprises the sound of dogs barking to the traditional tune "Greensleeves" as rendered in the audio tape accompanying the application.

The trade mark consists of the sound of two steps taken by a cow on pavement, followed by the sound of a cow mooing (clip, clop, MOO) as rendered in the recording accompanying the application.

The trade mark consists of the sound of a soprano voice singing wordlessly to the tune represented in the musical score attached to the application. The trade mark is demonstrated in the recording accompanying the application form.

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The trade mark consists of a repeated rapid tapping sound made by a wooden stick tapping on a metal garbage can lid which gradually becomes louder over approximately 10 seconds duration. The sound is demonstrated in the recordings accompanying the application.

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3.3 Representation of the trade mark - sound trade marks

6.2 Registrability of sounds as trade marks

A sound mark is designed to identify the trade source of goods and/or services via auditory rather than visual means. Technology developed over the last century has increasingly exposed the buying public to advertising via sound, and thus to the possibility that goods or services could be identified by sounds, rather than by visual presentations. The 1995 Act allows for the registration of a sound as a trade mark. As with any other kind of trade mark, a sound must first meet the basic requirements for registrability set out in the Act.

The first consideration for a sound claimed as a trade mark is to assess whether it is inherently adapted to distinguish the applicant's goods/services. The words of Lord Parker (*W & G Du Cros Appn* (1913) 30 RPC 660 at 672) need to be taken into account here. The extent to which the trade mark is adapted to distinguish the applicant's goods and/or services will:

... largely depend upon whether other traders are likely, in the ordinary course of their businesses and without any improper motive, to desire to use the same mark, or some mark closely resembling it.

To determine whether a sound is one which other traders are likely to need or want to use, the examiner should consider whether it has functional aspects, or is commonplace in the trade and wider community.

6.2.1 "Functional" sounds.

A "functional" sound is one which, for example, is caused by the normal operation of a piece of equipment. The sound of a motorbike engine is an instance of a functional sound in respect of motorbikes or motorbike motors, and therefore one which other traders are likely to want to use for their own goods.

6.2.2 Sounds which are capable of distinguishing

Sounds which are not functional or common to the trade when considered in respect of the goods/services claimed are adapted to distinguish the applicant's goods.

Grounds for rejection under section 41 should not be raised. The following table gives some examples of sounds which fall into this category. This list is representative only, and examiners will need to consider each application on its own merits.

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Sound of wolf howling Beer, wine and spirits

Sound of a child giggling or laughing Children's clothing; books; ornaments

Sound of a chain saw Retailing of books, clothing, foodstuffs

Hand bell ringing Restaurant services, take away, food bars

Applicant's name sung in an advertising jingle

Most goods and/or services

Peal of church bells Clothing; cosmetics; hand tools and cutlery

Short unrecognisable tunes Class 29 and 30 goods

Human voice quacking like a duck Sightseeing tours; tour books, maps

Portions of well know classic tunes eg

Beethoven's 9th Symphony (Song of Joy)

Most goods and services

6.2.3 Sounds which have insufficient adaptation to distinguish - 41(5)

Sounds fall into this category if they contain or consist of commonplace sounds, that is, they are sounds which other traders are likely to want to use for their similar goods. The amount of evidence required will depend on the nature of the trade mark. The more common the sound, the more evidence to support it will be required.

A representative set of examples is included in the following table:

Strauss Waltzes or Tango music Dancing tuition - *some evidence required*

Combination of barnyard sounds Farming services; stock food and pet food

Sound of a child giggling or laughing Child care services; paediatric medical services

Sound of a ringing cash register with words "Best value, lowest prices"

Retailing services - *considerable evidence required*

Three blasts on a referee's whistle Sporting goods and bags

Sound of vehicle motor starting up and running, with descriptive words

Vehicle sales; automotive repair and maintenance; vehicles in class 12

6.2.4 Sounds which have no inherent adaptation to distinguish - 41(6)

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Sounds which are functional or very commonplace are likely to be wanted and needed by other traders in the same field. They therefore have no inherent adaptation to distinguish, and the provisions of subsection 41(6) apply. The applicant for one of these sound trade marks will need to show that, at the date of filing, the sound did distinguish their goods/services from the similar goods/services of other traders. Examples of these types of marks are shown in the table below.

Sound of a chain saw Chain saw repair services; tree lopping services; retail of chain saws

Sound of a duck quacking, fowls clucking, roosters crowing

Live poultry, prepared/frozen poultry

Sound of a cash register ringing Retailing services

Single bell tolling or a solemn hymn Funeral services; undertaking services

Sound of glass breaking Windscreen repair services; glass repair services

Sound of vehicle motor starting up and running

Vehicle sales; automotive repair and maintenance; vehicles in class 12
"ping" sound Microwaves; retailing of microwaves
Portions of well known classical musical pieces
Orchestral music performances
Synthesised musical sounds Electronic musical synthesises;
computer software for synthesising music on home computers

7. Scent trade marks

Of the more unusual kinds of signs, scent is probably the most unusual, and the most difficult to represent graphically. However, "scent" is mentioned in section 6 as being a sign, and applicants may apply for a scent as a trade mark. Under the right circumstances, it is possible for a scent to serve the purpose of a trade mark by identifying the goods or services of one particular proprietor.

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7.1 Presentations and descriptions of scent trade marks

- The application must include a graphical representation of the scent mark. This could be a precise verbal description of the scent such as "the scent of apple blossoms".
- The graphical representation must be in a form that conveys information to the ordinary person allowing them to identify the trade mark. Highly technical data will not be acceptable as a graphical representation. For example, the results of analytical techniques such as infrared spectroscopy; vacuum, fractional and molecular distillation; nuclear magnetic resonance; vacuum fractionation; "electronic nose" analysis and chromatographic techniques would not be acceptable.
- An actual sample of the scent is not required at filing but may be needed during the course of examination .
- The applicant must include a precise and accurate description of the scent that will be entered as an endorsement of the application. Examples of acceptable descriptions are as follows:

The trade mark is a scent mark. It consists of the smell of roses applied to plastic storage boxes for domestic purposes.

The application is a scent mark, consisting of the smell of apple blossoms applied to car tyres.

The mark comprises the strong smell of bitter beer applied to the flights of darts.

Part 10 DETAILS OF FORMALITY REQUIREMENTS

3.4 Representation of the trade mark - scent trade marks

7.2 Registrability of scents as trade marks

Relying on an olfactory sense, rather than on the visual or auditory, to identify a proprietor is perhaps a new concept, but the question of the capability of a scent to distinguish an applicant's goods and/or services should be decided on the same general criteria as with any other kind of trade mark. That is, on the basis of whether other traders would want or need to use it in the ordinary course of their business, without improper motive.

7.2.1 Scents not adapted to distinguish

Natural scent of a product

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The natural scent of a product will have no inherent adaptation to distinguish the goods. Into this category come goods such as perfumes and eau de colognes for personal use; essential oils for perfumery or cooking; the scent of cedar for timber products and herbal scents/essences for culinary use. These scents either form the goods themselves or are a natural attribute of the goods. The scent thus refers to the goods, and not to the trade source. Other examples of this type are the scents of chocolate or vanilla for bakery goods (commonly used ingredients), or the smell of rubber for car tyres.

Masking scents

In addition to the natural or inherent scents of goods, many producers use scents to mask unpleasant natural odours in the goods they sell. A masking scent has a functional purpose, and is not capable of distinguishing for that reason. Examples of this type of scent could be the use of lemon to scent domestic bleaches and laundry sprays, and lavender to scent carpet deodorants. As masking scents are commonly used within the trade, purchasers are unlikely to regard the scent as an indicator of trade source, but rather as something that mitigates the normally unpleasant odour of the goods.

Scents which are common to a trade.

A non-functional use, but nevertheless use which is common to the trade, and hence not adapted to distinguish, is use of a scent to make a product more pleasant or attractive. Potential purchasers of these goods are unlikely to consider these fragrances as an indication of the origin of the goods because the use of fragrance on such goods is common to the trade. For example, the scent of lemon has been added, over a considerable period of time, to dish washing detergents and laundry products. While it cannot be said that a lemon scent is "descriptive" of such goods as there is no specific relationship between lemon and the cleaning qualities of such goods, a lemon scent would be treated as not being capable of distinguishing because it is common to the trade. The use of pine or cedar scents for disinfectants falls into the same category, as do herbal scents for shampoos and soaps.

Scents which may be capable of distinguishing

To be capable of distinguishing the applicant's goods, the scent needs to be something apart from the goods themselves. It should be neither a natural characteristic nor an expected characteristic of the product, but something added to identify the applicant's goods from those of others in the same market. Examples which have been accepted in other jurisdictions include the smell of beer for dart flights, and a smell reminiscent of frangipani flowers for embroidery yarn, as well as various fruit perfumes for motor oils. In these cases, the perfume did not consist of the natural scent of the product, nor was there an expectation that the product be perfumed. The scent was something unusual added to the goods to assist in identifying them via olfactory means from the similar products of other traders.

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8. Composite trade marks - combinations of shapes, colours, words etc

A trade mark may consist of a combination of any of the signs discussed earlier in this Part, as well as any of those signs combined with words or devices. The same principles apply to these composite marks as apply to any other trade mark- whether the trade mark as a whole is adapted to distinguish the applicant's goods from those of other traders.

These kinds of trade marks are likely to be prima facie adapted to distinguish because the composite trade mark, taken as a whole, consists of more than the sum of the individual parts. The following example of a description for a trade mark to be used on wines in class 33 demonstrates a trade mark of this type:

The trade mark consists of a combination of the word RED, the colour blue, and the shape of a wine bottle, as shown in the representations attached to the application form.

An example of a composite trade mark which is not prima facie adapted to distinguish goods in class 33 is the following:

The trade mark consists of a combination of the shape of a wine bottle and the colour green, as shown in the representation attached to the application form.

As a great proportion of wine bottles are green, this claim is unlikely, on the face of it, to be adapted to distinguish. However, if the bottle itself has an unusual shape, or includes decoration on the glass, even decorations common to the trade such as vine leaves or grape bunches, then the trade mark moves closer to being capable of distinguishing.

Another type of combination mark may be a claim for an aspect of packaging where the mark claimed involves a combination of features including shapes, words and colours. The same considerations apply to this kind of trade mark as to any combination mark. The combination as a whole is likely to be adapted to distinguish, where the individual components are not. The following is an example of a description of this kind of trade mark:

The trade mark is an aspect of packaging. It consists of the shape of a box, with semi circular holes cut in three sides, each hole filled in with red coloured
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transparent film printed with the words CHOCOLAT DE PARIS, as shown in the representations attached to the application form.