

# A Reflection About the Introduction of Non-Traditional Trademarks

Roberto Carapeto

## 1. Introduction

The present paper aims to analyze how some key jurisdictions have been adopting the protection of non-traditional trademarks. While doing that, it seeks to unfold the discussion about a comprehensive and universal definition of what mark/trademark is. Also, some consideration about how the adoption of non-traditional trademarks have been affecting the harmonization of Trademark law around the world, aiming to conclude if there was a positive influence or not.

For the current analysis the author choose to select jurisdictions with global influence, such as US and EU, historical influence, such as France and Germany, local influence, such as Argentina or India.

The scope of what is considered a non-traditional trademark has yet to be defined conclusively. In this sense, for the purpose of the present article, the introduction of the protection for sound trademarks will be used as a definite landmark for the protection of nontraditional trademarks.

## 2. About Non-Traditional Trademarks

The traditional range of trademarks have been limited to word, symbol or design, or a combination thereof. Even if there are some small differences from country to country, this scope is somewhat steady and the expansion of this scope has been being discussed for more than 100 years. Upon a difficulty in defining what is a non-traditional trademark, any trademark that does not fall within that traditional scope of “word, symbol or design, or a combination thereof” shall be considered as a non-traditional trademark.

In this sense, the definition of a non-traditional trademark is extremely wide, turning the use of this expression quite an ambiguous issue. The Standing Committee on the Law of Trademarks, Industrial Designs and

Geographical Indications (SCT) (a permanent committee responsible for studying trademarks, designs and geographical indications) that was established by the World Intellectual Property Organization (WIPO), upon its analysis of the non-traditional trademarks<sup>1</sup>, divided it into visual trademarks and non-visual trademarks. As examples of visual trademarks there are three-dimensional marks, color marks, holograms, slogans, titles of films and books, motion or multimedia signs, position marks, gesture marks and others. In what regards non-visual trademarks, the following marks are considered to fall within this concept: sound marks, olfactory marks, taste marks and texture or feel marks.

Although the expansion of the protection of non-traditional has been occurring more intensively in the past twenty years, the discussions regarding the scope of what can be considered trademark is at least centenary. You have consistent scholastic works from the 19th century in Europe<sup>2</sup> discussing if three-dimensional shapes and single colors should be protected as trademarks. There also court decisions from the same time in Europe, regarding the use of the color blue on envelopes<sup>3</sup> and three-dimensional shapes<sup>4</sup>. Also in the United States, there are court decisions from the early 20th century over the possibility of protecting signs such as the color red for ropes<sup>5</sup>, combination of red and blue for matches<sup>6</sup> and the format of syringes<sup>7</sup>.

The enactment of the Lanham Act helped the beginning of the trademark registrations for non-traditional trademarks in the United States. A milestone of this change occurred when the U.S. Patent and

---

<sup>1</sup> WIPO [Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)]

<http://www.wipo.int/sct/en/index.html> accessed November 29, 2014.

<sup>2</sup> See: VAN BUNNEN, Louis. *Aspects actuels du droit des marques dans le Marche commun*. Centre Interuniversitaire de Droit Compare, 1967. pp. 48, and POUILLET, Eugène. *Traité des marques de fabrique et de la concurrence déloyale*. Marchal-Billard, 1877. pp. 28-

<sup>3</sup> Paris, 25 janv. 1866, Mathieu C. Fouillet, Tuellet.15.508

<sup>4</sup> Tribunal Civil de la Seine (7 août 1908)

<sup>5</sup> A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U.S. 166 (1906)

<sup>6</sup> Diamond Match Co. v. Saginaw Match Co., 142 F. 727, 729 (6th Cir. 1906)

<sup>7</sup> Marvel Co. v. Tullar Co., 125 F. 829, 830 (S.D.N.Y.1903)

Trademark Office granted NBC their chimes as a service mark<sup>8</sup> in 1950. Also, the introduction of non-traditional trademarks has been studied in Europe since the 1960s<sup>9,10</sup>. It can be said, however, that the development of the protection of non-traditional trademarks has been increasing in the past 20 years due to several factors. From the late 80's until the early 2000's, a series of international treaties<sup>11</sup>, the Office for Harmonization in the Internal Market (OHIM) initiative<sup>12</sup>, a number of important decisions<sup>13</sup>, among others, have helped the evolution on the discussion on non-traditional trademarks.

### **3. The issue of the “definition of trademarks” on an International level and harmonization**

#### **3.1 The International Scenario**

During the discussions for the enactment of the Paris Convention, the member parties could never reach a conclusion about a definition of what a trademark is. Furthermore, the Convention does not even define if trademark rights are obtained through use, registration or both, leaving it to member's national laws<sup>14,15</sup>. In 1956, in views of the Congress of

---

<sup>8</sup> Registration granted on April 4, 1950 to NATIONAL BROADCASTING COMPANY, INC.; Registration number 0523616, Serial number 71541873.

<sup>9</sup> [On peut conclure en tout cas que se dessine actuellement un mouvement favorable a leur enregitrabilite et a leur inclusion dans le cercle des marques veritables.] in VAN BUNNEN, Louis. Aspects actuels du droit des marques dans le Marche commun. Centre Interuniversitaire de Droit Compare, 1967. pp. 47

<sup>10</sup> Also , BLUM, Rudolph. Les marques de service. P.I., 1953. pp. 117, and TETZNER, Heinirich. Neue Markenformen. GRUR, 1951. pp. 47

<sup>11</sup> Such as the Trademark Law Treaty (also called the trademark law harmonization treaty), in its 1997 revision

<sup>12</sup> With the Community Trademark system becoming effective on March 15, 1994, and the OHIM Office being established in Alicante, Spain.

<sup>13</sup> Namely, Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 165, 115 S.Ct. 1300, 1304, 131 L.Ed.2d 248 (1995); Kawasaki Motors Corp USA v Harley-Davidson Michigan Inc (TTAB 1997); Dr. Ralf Sieckmann vs Deutsches Patent-und Markenamt (case C-273/00); Shield Mark BV vs. Joost Kist (case C-283/01), among others

<sup>14</sup> BODENHAUSEN, GHC. Guide to the Application of the Paris Convention for the Protection of Industrial Property, as Revised at Stockholm in 1967. (WIPO, 1969) pp. 15

<sup>15</sup> “The conditions for the filing and registration of trademarks shall be

Washington to discuss the revision of the Paris Convention, the AIPPI reached a conclusion that it was inopportune under the circumstances of the time to introduce a general definition of trademark in the Union Convention<sup>16</sup>. This was not the first time the topic was discussed, as the topic was on the agenda at the Vienna Meeting (1952) and Brussels (1954)<sup>17</sup>.

The scope of a mark is not conclusively specified in the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks nor in the Agreement Concerning the International Registration of Marks either. However, under those international treaties, it is possible to construe that non-traditional trademarks such as “sound” may be included<sup>18</sup>. Currently, it is possible to file an application for registration of any marks under the Madrid Agreement.

The conclusion of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)<sup>19</sup> in 1994 presaged the advent of a global evolution in trademark rights. The definition provided by Article 15 (1) of the TRIPS Agreement is broad with regard to the nature of signs that can constitute a trademark at first, because the definition provided is functional, based on the distinctiveness function of trademarks<sup>20</sup>. Article 15 (1) also provides a non-exhaustive list of what can be considered trademarks, namely “signs, in particular words including personal names,

---

determined in each country of the Union by its domestic legislation” (Article 6 of the Paris Convention)

<sup>16</sup> (<https://www.aippi.org/download/committees/6/RS6English.pdf>) accessed January 15, 2015

<sup>17</sup> ANNUAIRE 1956 ([https://www.aippi.org/download/yearbooks/Annuaire%201956\\_NS%20No2%20Supplement.pdf](https://www.aippi.org/download/yearbooks/Annuaire%201956_NS%20No2%20Supplement.pdf)) accessed January 15, 2015

<sup>18</sup> PIRES DE CARVALHO, Nuno. *The TRIPS Regime of Trademarks and Designs*. Kluwer Law International, 2011., p.301

<sup>19</sup> Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, Marrakesh Agreement Establishing the World Trade Organization, signed at Marrakesh (Morocco), April 15, 1994 [hereinafter WTO Agreement]; Annex IC, Agreement on Trade-Related Aspects of Intellectual Property Rights [hereinafter TRIPS Agreement or TRIPS], reprinted in *The Results of the Uruguay Round of Multilateral Trade Negotiations — The Legal Texts*, 1–19, 365–403 (GATT Secretariat, Geneva 1994).

<sup>20</sup> “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark”

letters, numerals, figurative elements and combinations of colors as well as any combination of such signs”<sup>21</sup>. This broad and non-exhaustive definition was adopted because the participants to the negotiations on TRIPs Agreement in 1990 were unable to reach an agreement on the scope of the list of mark examples to be recognized as trademarks, although the EU, Japan and the US had proposed the definition of trademark listing “words, names, signs, figures or any combination thereof”<sup>22</sup>.

In this sense, you cannot conclude that the TRIPs Agreement completely excludes non-visual trademarks from its definition per se. The point is that the fourth sentence of said Article 15.1 reads “Members may require, as a condition of registration, that signs be visually perceptible,” and leaves the decision of whether to limit the scope of trademarks only to visually perceptible types to the discretion of each member state. Therefore, each member state is not obliged under the TRIPs Agreement to protect non-visual trademarks, even though they are within the context of definition of trademarks proposed.

Considering the functional definition brought by TRIPS, non-visual trademarks should be protected as long as they are used as a trademark and have any distinctive character, as provided for in the first sentence of said Article 15.1<sup>23</sup> defining what should be protected<sup>24</sup>. Such a protection may also be possible under the anti-competition laws, and the subject for the protection would not necessarily be required to be a registered trademark under the trademark law.

In one of the meetings towards the discussion on TRIPs Agreement, Bolivia proposed the following solution regarding visually non-visual trademarks<sup>25</sup>. It was proposed that: Sounds, smells, three-dimensional shapes and so forth are capable of being represented graphically and, therefore, should be eligible for registration as long as they have distinctive character. However, as trademarks are traditionally attached to goods, those new types of marks must be capable of being distinguished

---

<sup>21</sup> See *Supra* 6

<sup>22</sup> GERVAIS, Daniel. *The TRIPs Agreement; Drafting History and Analysis*. Sweet & Maxwell, 2003. p.167

<sup>23</sup> See *Supra* 20

<sup>24</sup> PIRES DE CARVALHO (2011), *supra* footnote 18, p.304

<sup>25</sup> *Id.*, p.314

from the designated goods to which they are attached. For example, with regard to perfumes and other fragrance products, the smell of perfume itself should not be protected as trademark<sup>26</sup>.

In other words, the proposal of Bolivia indicates that, when you seek registration of a sound mark, the sound is independent as a mark as long as you can describe it in a manner satisfying the Sieckmann test when filing an application. On the other hand, if you try to satisfy the requirements for application solely by using the sound source, it would be difficult to decide whether the designated goods or services are independent of the trademark.

The Trademark Law Treaty (TLT)<sup>27</sup> and the Singapore Treaty on the Law of Trademarks<sup>28</sup> center on the procedural law rather than the substantive law. The Singapore Treaty takes on a form of an amendment to the TLT in a meaning, and it is the first international treaty on trademarks that clearly provides for the sound marks. Under Article 2 of the Singapore Treaty, it is possible to protect hologram marks, sounds, smell and others, which had not been covered by the TLT, as trademark in accordance with the domestic laws and regulations of each member state. The member states are not obliged to protect those new types of marks under said Article 2, but in the Regulations under the Singapore Treaty on the Law of Trademarks you can find provisions concerning the application procedures where the new types of marks are protected<sup>29</sup>. Those provisions specify the

---

<sup>26</sup> IP/Q2/BOL/1, February 13, 2002, p.17

<sup>27</sup> The Trademark Law Treaty (TLT) is a treaty intended to simplify and harmonize the trademark registration procedure of national trademark offices. It was adopted in Geneva on October 27, 1994 and came into effect on August 1, 1996. In Japan, the Treaty came into effect on April 1, 1997.

<sup>28</sup> The Singapore Treaty on the Law of Trademarks basically introduces the content of the TLT, and intended to (1) respond to the recent rise in electronic filing and other technological advancements; (2) promote simplification and harmonization of procedures; and (3) develop the series of management systems and the final provisions to enable a revision of rules (including formats) at the general meeting without convening a diplomacy meeting (The Singapore Treaty is independent of the TLT, and both treaties coexist). It was adopted in Singapore on March 27, 2006, and entered into force on March 16, 2009, following the ratification or accession of ten countries, namely Singapore, Switzerland, Bulgaria, Romania, Denmark, Latvia, Kyrgyzstan, United States, Moldova, and Australia.

required descriptions in the application form for a trademark registration and the required documents to be attached thereto. It also specifies the manners for preparing an application form seeking the protection of hologram marks, sounds, smells and others.

The registration of new types of marks, including sound marks, is expanding globally also due to Free Trade Agreements (FTA). For example, the US demands expansion of trademark protection when executing the FTA with other country. Therefore, the draft of the FTA prepared by the US, especially where the other party is a developing country, normally contains provisions for the protection of sound marks, among others. For examples, the obligation to protect sound marks is clearly provided in Article 18.2 of the FTA between Korea and the US<sup>30</sup>, Article 16.2 of the FTA between Singapore and the US<sup>31</sup>, Article 17.2 of the FTA between Australia and the US<sup>32</sup>, Article 14.2 of the FTA between Bahrain and the US<sup>33</sup>, Article 17.2 of the FTA between Chile and the US<sup>34</sup>, Article 16.2 of the TPA between Peru and the US<sup>35</sup>. As an example, because of the FTA, Korea revised their Trademark Law to protect sounds and smells as trademarks<sup>36</sup>. The International Trademark Association (“INTA”) provides a model Free Trade Agreement Proposals, which

---

<sup>29</sup> Trademark System Subcommittee of Intellectual Property Policy Committee under the Industrial Structure Council (2009) Trademark System Subcommittee: Report on the 20th Non-traditional Marks Committee meeting from October 5, 2009. <[http://www.jpo.go.jp/shiryoku/toushin/shingikai/t\\_mark\\_paper20.htm](http://www.jpo.go.jp/shiryoku/toushin/shingikai/t_mark_paper20.htm)> accessed November 29, 2014. p.6

<sup>30</sup> <[http://www.ustr.gov/sites/default/files/uploads/agreements/fta/korus/asset\\_upload\\_file273\\_12717.pdf](http://www.ustr.gov/sites/default/files/uploads/agreements/fta/korus/asset_upload_file273_12717.pdf)> Accessed on December 31, 2014

<sup>31</sup> <<http://www.ustr.gov/trade-agreements/free-trade-agreements/singapore-fta>> Accessed on December 31, 2014

<sup>32</sup> <[http://www.ustr.gov/sites/default/files/uploads/agreements/fta/australia/asset\\_upload\\_file469\\_5141.pdf](http://www.ustr.gov/sites/default/files/uploads/agreements/fta/australia/asset_upload_file469_5141.pdf)> Accessed on December 31, 2014

<sup>33</sup> <[http://www.ustr.gov/sites/default/files/uploads/agreements/fta/bahrain/asset\\_upload\\_file211\\_6293.pdf](http://www.ustr.gov/sites/default/files/uploads/agreements/fta/bahrain/asset_upload_file211_6293.pdf)> Accessed on December 31, 2014

<sup>34</sup> <[http://www.ustr.gov/sites/default/files/uploads/agreements/fta/chile/asset\\_upload\\_file912\\_4011.pdf](http://www.ustr.gov/sites/default/files/uploads/agreements/fta/chile/asset_upload_file912_4011.pdf)> Accessed on December 31, 2014

<sup>35</sup> <[http://www.ustr.gov/webfm\\_send/1031](http://www.ustr.gov/webfm_send/1031)> Accessed on December 31, 2014

<sup>36</sup> The original text is as follows: “Neither Party may require, as a condition of registration, that marks be visually perceptible, nor may a Party deny registration of a mark solely on the ground that the sign of which it is composed is a sound or a scent.”

requires protection of colors without delineated contours and three-dimensional shapes, in addition to sounds<sup>37,38</sup>.

### 3.2 The issue of harmonization

Some commentators notice that the adoption of the non-traditional trademarks such as sounds marks may have a negative effect at genuine trademark harmonization<sup>39</sup>. On the other hand there is a movement among WIPO countries to harmonize while considering the standard of protecting nontraditional trademarks<sup>40,41</sup>. Many of the difficulties in harmonization of trademark law are related to different market practices around the world, also, due to different levels of concern to market regulation. Besides the issue of definition of trademarks, the necessity of having clear grounds for refusal of trademarks seems to be a concern shared by different trademark systems throughout the history and the globe. No matter how much fame a trademark has acquired or how long it has been in use, there is a public interest in leaving some signs available. Although the applications of grounds for refusal of trademarks differs from culture to culture, there seems to be some basic grounds shared by most jurisdictions<sup>42</sup>. In this sense, this should not be considered as an impeditive to the introduction of non-traditional trademarks.

---

<sup>37</sup> Model Free Trade Agreement Proposals Intellectual Property Rights: Trademark Law, <http://www.inta.org/downloads/tapmodelfreetrade.pdf> Accessed on November 29, 2014

<sup>38</sup> The original text is as follows: “expressing intent to protect sound, single color, and three-dimensional shape marks”

<sup>39</sup> PORT, Kenneth L., On Nontraditional Trademarks. William Mitchell College of Law Faculty Scholarship. Paper 235. (2011) pp. 1

<sup>40</sup> World Intellectual Property Organization, Member States Agree to Move Ahead With Efforts To Harmonize Trademark Law. Available: [http://www.wipo.int/pressroom/en/prdocs/2001/wipo\\_upd\\_2001\\_154.html](http://www.wipo.int/pressroom/en/prdocs/2001/wipo_upd_2001_154.html) Accessed on November 30, 2014

<sup>41</sup> World Intellectual Property Organization, Member States Address Non-Traditional Marks, Advance Work on Industrial Designs. Available: [http://www.wipo.int/pressroom/en/articles/2010/article\\_0024.html](http://www.wipo.int/pressroom/en/articles/2010/article_0024.html) Retrieved: April, 2, 2014

<sup>42</sup> WIPO SCT/21/2, of May 15, 2009, Grounds for Refusal of All Types of Marks -. Document Prepared by the Secretariat [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_21/ sct\\_21\\_2.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_21/ sct_21_2.pdf) “ Access December 15, 2014

Harmonization of trademark right substantive matter has been being desired for long. As seen below, the introduction of non-traditional trademark can be seen as step towards that, although complete harmonization is still to be established.

## **4. The introduction of the protection of non-traditional trademarks**

### **4.1 North America**

#### 4.1.1. United States

Trademark registration in the US is currently established under the Lanham Act of 1946<sup>43</sup>. After its enactment, the Lanham Act has been amended around 30 times. According to a famous scholar, “ingenious merchants have occasionally sought protection for exotic types of trademark formats<sup>44</sup>” and as a result, the scope of trademarks has been expanded to the maximum possible extent in the US. You can say there is no substantial limitation as long as the mark is in use and has a distinctive character<sup>45</sup>. These arguments have been presented in relation to the Qualitex case<sup>46</sup>.

The Qulitex Co.vs. Jacobson Products Co. was a lawsuit filed in March, 9th 1990 before the United States District Court for the Central District of California in which Plaintiff accused Defendant of unfair competition based on Jacobson’s sale of similar to Qualitex’s green gold pads for dry cleaning presses. In 1991, Qualitex filed an application for the green gold color of its pads before the USPTO. It is important to highlight that the US trademark protection structure is slightly different from the regular European Continental Law on trademarks due to the trademark right being mainly based on use instead of a single application granted by the PTO. The lawsuit was found in favor of Qualitex in California, but the US Court of Appeals set aside this judgment on the grounds that a color alone could not be registered as a trademark. Justice Breyer of the Supreme

---

<sup>43</sup> ub.L. 79–489, 60 Stat. 427, enacted July 5, 1946, codified at 15 U.S.C. § 105

<sup>44</sup> SCHECHTER, Roger E.; THOMAS, John R. Intellectual Property: The Law of Copyrights, Patents and Trademarks. West, 2003. P 632

<sup>45</sup> Id.

<sup>46</sup> Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 165, 115 S.Ct. 1300, 1304, 131 L.Ed.2d 248 (1995), p.41

Court. however, writing in a unanimous decision, overturned the Court Appeal decision holding that the Lanham Act defines trademark as “any word, name, symbol, or device, or any combination thereof”. Justice Breyer argued that colors could acquire a secondary meaning over time, in the course of its use in the marketplace<sup>47</sup>. In this case, it was defined that single colors, with no contour, could serve as trademarks although it was stated that, in principle, such marks would not have inherent distinctiveness.

As a result of such expansion, the definition of a trademark under the Lanham Act is currently “*any word, name, symbol, or design, or any combination thereof*”. In this definition, the word “symbol” and the “any combination thereof” are keys for a broad interpretation, developed by case law, allowing the protection of movement, hologram, color without delineated contours, position, sound, smell and others. In the US, the important requirements for obtaining protection as a trademark are that the trademark is in use and it has a distinctive character.

With regard to sound marks, said scholar states: “Take sound. The three-chime melody associated with the NBC television network has been in use for decades. It is widely, if not universally recognized as a designator for NBC and its programming. It serves no particular utilitarian or aesthetic function, and competitors have a host of other sounds to choose from. Thus, it is well-suited for trademark protection”<sup>48</sup>.

When the Seventeenth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, WIPO (“SCT”) on new types of marks was held at the USPTO, the representative of the USPTO stated that “The threshold issue of how to represent these ‘signs’ graphically in an application and subsequently, how to search them when examining for conflicting applications and registrations, should not be the sole reason for not accepting these marks for registration”<sup>49</sup>, alleging that it is unreasonable to reject protection of sound marks and

---

<sup>47</sup> Id.

<sup>48</sup> SCHECHTER (2003), supra 44, p.632

<sup>49</sup> NON-TRADITIONAL MARKS AT THE U.S. PATENT AND TRADEMARK OFFICE ([http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us\\_2.pdf](http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf)) accessed on November 29, 2014

other new types of marks on the ground of the issue of description requirement.

However, there are limits to the extent on non-traditional marks can be protected. In the United States, scents are capable of functioning as source identifiers. In 1990, the Trademark Trial and Appeal Board held that a scent reminiscent of Plumeria blossoms could be registered for “sewing thread and embroidery yarn<sup>50</sup>.” This scent mark had acquired distinctiveness through use, and this case led to the U.S. Patent and Trademark Office’s accepting that scents can function as trademarks. In other cases, applications for scents in the Supplemental Register have also been accepted<sup>51</sup>.

Considering the practice in the U.S., when a non-traditional trademark is not functional but has yet to acquire the requisite distinctiveness, the mark will be registered only on the Supplemental Register.

#### 4.1.2. Canada

The definition of the term trademark under the Trade-mark Act of Canada is ambiguous and broad<sup>52</sup>, and you cannot conclude perfectly about the protection of non-traditional trademarks. However, in fact, Canada had been rejecting the registration of non-visual trademarks, such as sound marks, until 2012<sup>53</sup>. As for the protection of color marks, goodwill and a protectable reputation must be shown. In Canada, color can satisfy the requirement for distinctiveness in combination with features such as shape, size or patterning. In this sense, registration of single color trademarks were also very difficult

---

<sup>50</sup> In re Clarke, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990)

<sup>51</sup> Such as the scent of lavender (Reg. No. 3140693) or vanilla (Reg. No. 3143735)

<sup>52</sup> Under Article 2 of the Trade-marks Act of Canada, “trade-mark” means  
(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,  
(b) a certification mark,  
(c) a distinguishing guise, or  
(d) a proposed trade-mark

<sup>53</sup> Trade-mark applications for sound marks in Canada — the left hand “giveth”: will the right hand “taketh away”? (<http://www.lexology.com/library/detail.aspx?g=19b5ff32-37af-4d43-afdb-b548e66654da>) accessed November 29, 2013

While Canadian Intellectual Property Office (“CIPO”) had long rejected the registration of sound as a trademark on the ground that it failed to meet the description requirement prescribed by Article 30(h) of the Trade-mark Act<sup>54</sup>. Such interpretation was based on the Playboy case decision rendered by the Federal Court of Canada<sup>55</sup>. In this decision, the court held that a trademark must be visually perceptible with regard to the goods or services.

However, the ruling of the Playboy case was overcome by the 2012 Federal Court decision on the MGM case. In this decision, the courts made a ruling supporting a trademark consisting of lion’s roar, for which MGM filed an application for registration<sup>56</sup> that was later rejected. After this decision, CIPO had to make modifications to its filing procedures.<sup>57</sup>

## 4.2 Europe

### 4.2.1. OHIM

EU has established the Community Trade Mark (“CTM”) system, which enables the applicant to obtain one registration that provides protection in all member states of the EU with one registration at the Office for Harmonization in the Internal Market (“OHIM”). Registration of CTM has no impact on the domestic trademark rights, and a person seeking a trademark protection may file a domestic application for trademark registration or a CTM application, or both.

Article 4 of the Council Regulation on the Community Trade Mark reads “A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or

---

<sup>54</sup> HAMOVITCH, Rebecca and SHANE, Hardy. A Sound Decision: CIPO Announces That It Will Accept Applications For The Registration Of Sound Marks. Available at <http://www.mondaq.com/canada/x/171812/Trademark/A+Sound+Decision+CIPO+Announces+That+It+Will+Accept+Applications+For+The+Registration+Of+Sound+Marks> accessed November 29, 2014.

<sup>55</sup> Playboy Enterprises Inc. v. Germain (1987), 16 C.P.R. (3d) 517 (F.C.T.D.)

<sup>56</sup> Metro-Goldwyn-Mayer Lion Corp. v. Canada (Attorney General), Case T-1650-10 (Order Mar. 1, 2012)

<sup>57</sup> Trade-mark consisting of a sound <http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03439.html> accessed November 29, 2014

services of one undertaking from those of other undertakings.”

Based on that definition, the constituent features of a trademark should be “capable of being represented graphically.” The reason for establishing such constituent features would be based on an idea that, considering the purpose of registration, a mark must be capable of being recorded and published. Therefore, an application for a non-traditional trademark may be registered as long as it is capable of being represented graphically, which becomes an issue for non-visual marks such as sound or scent marks.

There are 4 key cases regarding non-traditional trademarks in Europe that defined how the CTM trademark system should be set for such kind of marks. Those are the Sieckmann case<sup>58</sup>, the Shield Mark case<sup>59</sup>, the Libertel case<sup>60</sup> and the Heidelberger Bauchemie Case<sup>61</sup>. Sieckman Case is considered the landmark case regarding non-conventional trademarks in European Courts. Ralf Sieckmann tried to file “methyl cinnamate” before the German Patent and Trademark Office (DPMA). This chemical formula, contained in fruits like strawberries, has a strong, aromatic odor. The author described this scent as “balsamically fruity with a slight hint of cinnamon.” After being rejected by the DPMA, Mr. Sieckmann filed a lawsuit before the European Court of Justice. The ECJ, however maintained DPMA’s decision on the grounds that (i) a chemical formula depicting this scent did not represent the odour of a substance, was not sufficiently intelligible, nor sufficiently clear and precise; (ii) a written description was not sufficiently clear, precise and objective; and (iii) a physical deposit of a sample of the scent did not constitute a graphic representation, and was not sufficiently stable or durable .

With regard to the description requirement, the decision in the Sieckmann case established the standards for trademark applications stating that the “graphical representation (of a trademark) must be clear, precise, self-contained, easily accessible, intelligible, durable and objective so that the market participants may become aware of the rights of

---

<sup>58</sup> Dr. Ralf Sieckmann vs Deutsches Patent- und Markenamt (case C-273/00)

<sup>59</sup> Shield Mark BV vs. Joost Kist (case C-283/01)

<sup>60</sup> Libertel Groep v Benelux Merkenbureau (case C-104/01)

<sup>61</sup> Heidelberger Bauchemie GmbH (Case C-49/02)

competitors.”<sup>62</sup>

In the Shield Mark case, the registrability of a sound mark consisting of the sound of a rooster’s crow and the first nine tone of “For Elise,” for which an application for registration had been filed in the Benelux Office for Intellectual Property (BOIP). The main issues were whether a sound can be deemed as a trademark under Article 2 of the Community Trade Mark Directive, and whether what should be required to satisfy the requirement of graphical representation. Firstly, the court held that a sound mark is registrable. Further, it held that it is unreasonable to reject the registration of a sound mark as long as it is capable of being represented graphically and it has any distinctive character.

In the decision of Shield Mark case, the court construed what was proposed in the Sieckmann case as to sound marks<sup>63</sup>. With regard to the issue of what description could satisfy such requirements, the European Unified Patent Court held that “In case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consist of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.”<sup>64</sup>

---

<sup>62</sup> Institute of Intellectual Property.

2007 Fiscal Year’s Industrial Property Rights System Research Project: Report on the research topic of Non-traditional Trademarks. (2008) Available at [http://www.jpo.go.jp/shiryou/toushin/chousa/pdf/zaisanken/1907atarashiitype\\_all.pdf](http://www.jpo.go.jp/shiryou/toushin/chousa/pdf/zaisanken/1907atarashiitype_all.pdf) accessed November 20, 2014. p.324

<sup>63</sup> In the Sieckmann case, the court held that the graphical representation under Article 2 of the Directive 2008/95/EC should be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.

<sup>64</sup> The Japanese Group of the International Association for the Protection of Intellectual Property: “Comparative Survey on Industrial Property System in Each Country for FY2012 (Report on Survey and Study on the System and Operation on New Types of Trademarks Not Capable of Being Perceived Visually in Other Countries)” (June 2012) (<http://www.jpo.go.jp/shiryou/>

In what regards single color trademarks, the *Libertel* case deals with a trademark which consisted of the colour orange for goods and services related to telecommunications, described as just the colour and the word “orange”. The application was rejected by the PTO on the grounds that the applicant should have proved that the colour alone had acquired distinctive character through use, which didn’t happen. *Libertel* appealed to the Supreme Court of Netherlands which referred questions to the ECJ, asking whether a colour is registrable. The ECJ ruled that a trademark must be represented graphically in a clear, precise, intelligible and objective way, for example, using the Pantone Classification System. Also, the applicant must prove the distinctiveness of the colour for its products and goods through use, especially in the specification of its classes<sup>65</sup>.

In 1995, Heidelberg Bauchemie GmbH filed before the German PTO a trademark application for a trademark which consisted only of a rectangle comprising the colours blue, on top, and yellow below, specified for building material in general. The description stated that the trade mark which the applicant sought to register consisted of its corporate colours as used in “every conceivable form, in particular on packaging and labels”. DPMA rejected the application on the grounds that the sign could not be graphically represented nor had distinctive character. Heidelberg appealed to the Federal Court of Justice, who subsequently asked for guidance from the ECJ. The European Court, citing *Libertel*, confirmed that while colours can be protected, a combination of colours in “every conceivable form” this will not satisfy the requirement of graphic representation. Upon interpretation, it is decided that applications for combinations of colours must provide the exact ratio of the combination.

#### 4.2.2. Switzerland

In Switzerland, the constituent features of a trademark are defined in Article 1.1 of the Trademark Law, stating that a trademark may consist of “words, letters, figures, pictures, three-dimensional shapes or

---

toushin/chousa/pdf/zaisanken\_kouhyou/h24\_report\_01.pdf) Accessed on November 29, p. 41

<sup>65</sup> ECJ Rules that Colours are Registrable as Trademarks. Available at (<<http://www.internationallawoffice.com/newsletters/detail.aspx?g=543ec471-6cc4-4b94-8a61-96e6d5e373d4>> accessed November 29, 2014.

combinations of such elements”. Further, a trademark is also required to be “capable of distinguishing the goods or services of one undertaking from those of other undertakings.” The foregoing definition contains the term “in particular,” and it is construed that the provision of Article 1.1 is not of exhaustive nature, and any mark that has a distinctive character is capable of being registered as a trademark. Since Switzerland is not a member state of European Union, no judgement of ECJ has impact on the matters in Switzerland as a rule. However, the country introduced the requirement for graphical representation in its Examination Standards<sup>66,67</sup>.

Since the establishment of the current Trademark Law in 1992, Switzerland had registered many non-traditional trademarks without discrimination in principle.

In what regards sound trademarks, however, in 2005, the Swiss Federal Institute of Intellectual Property (“SFIIP”) made a drastic revision of its Examination Standards, and it was expressly provided that a mere musical sound is not deemed inherently distinctive (without features consisting of words). Due to this revision, some trademark applications were rejected on the ground of lack of distinctiveness.

Continuing on the issue of the sound trademarks, there is a very curious decision that might serve as reference for other jurisdictions. August Storck KG, a German sweets producer filed an application for a sound mark that SFIIP firstly rejected based on the then-current Examination Standards<sup>68</sup>. August Storck appealed the rejection, but the district court upheld the PTO’s decision, which lead August Storck to file an appeal with the Federal Administrative Court. Although the Federal Administrative Court denied the construction of the trademark based on the then-current Examination Standards, and held that a mere musical could be inherently distinctive, it decided that the application of August Storck was not inherently distinctive<sup>69</sup>. After that, the Federal Supreme

---

<sup>66</sup> Richtlinien in Markensachen (Examination Standards) 10.1

<sup>67</sup> AIPPI Schweizerischen Landesgruppe. Bericht Q 181 - Eintragungsvoraussetzungen und Schutzzumfang von nicht-konventionellen Marken (<https://www.aippi.org/download/committees/181/GR181switzerland.pdf>) Accessed on November 29, 2014

<sup>68</sup> Richtlinien in Markensachen (Examination Standards) 4.14

<sup>69</sup> August Stock v. Eidgenössisches Institut für Geistiges Eigentum (IGE),

Court of Switzerland confirmed that a sound mark consisting of mere musical note could be inherently distinctive<sup>70</sup>. In response to the decision of the Supreme Court, SFIIP revised the Examination Standards in 2010. It is expressly provided that a sound mark could have a distinctive character both in the 2010 version and 2012 version of the Examination Standards<sup>71</sup>.

#### 4.2.3. Germany

The Trademark Law of Germany was revised in 1996 for ratifying the EU Trademark Directive, and non-traditional trademarks have been the subject of protection thereafter. Before that revision, sound (especially consisting of musical elements) had not been protected as a trademark<sup>72</sup> as a rule, although there were some opinions that such sound mark could be protected under the anti-unfair competition laws with regard to the use as a trademark<sup>73</sup>.

Under the current Trademark Law, Section 3 “Signs eligible for protection as trademarks” provides that “(1) All signs, particularly words including personal names, designs, letters, numerals, sound marks, three-dimensional designs, the shape of goods or of their packaging, as well as other wrapping, including colors and color combinations, may be protected as trademarks if they are capable of distinguishing the goods or services of one enterprise from those of other enterprises,” and Section 8 “Absolute obstacles to protection” provides that “(1) Signs eligible for protection as a trade mark within the meaning of section 3 which cannot be depicted graphically shall be excluded from registration.”

In other words, in Germany, the traditional trademarks and new types of marks are not defined separately, and any mark that is (1) capable of distinguishing the goods or services of one enterprise from those of other enterprises and (2) capable of depicted graphically is registrable as a

---

(RKGE B-574/2008) (2008)

<sup>70</sup> August Stock v. Eidgenössisches Institut für Geistiges Eigentum (IGE), (BGE 135 III 359f.) (2009)

<sup>71</sup> Richtlinien in Markensachen (Examination Standards) 4.8

<sup>72</sup> Bundesgerichtshof, BGH 05.11.1987 I ZB 11/86 “Hörzeichen” (GRUR 1988, 306)

<sup>73</sup> MES, Peter für die Deutsche Landesgruppe, AIPPI. BERICHT Q96 - WORAUS KANN EINE EINTRAGBARE MARKE BESTEHEN?

trademark<sup>74</sup>. Therefore, a sound mark can be registered if it satisfies the foregoing requirements.

As Germany participates in the European Union, graphical representation is required in a trademark application. In other words, the applicant is required to file a “trademark sample”, in the case of sound marks, this is represented in musical notation and sound recordings<sup>75</sup>. Furthermore, the applicant is required to specify the type of the mark. You can find check boxes in the application form for selecting the type of trademark from six types: word marks, figurative marks, three-dimensional marks, sound marks, and “other forms of trade marks.”

The revised Trademark Law of 1996 reflects the requirement of graphical representation (as required by the EU Trademark Directive), and also contains new types of marks for protection.

The current Directive of Commissioner of the German Patent and Trademark Office is regarded as influenced by the Sieckmann case, under which the European Court of Justice held that the “graphical representation” which is required for identifying the mark should be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”<sup>76</sup>.

“Explanation on sound mark” is not essential. Therefore, the applicant is not required to specify the musical instrument or timbre (piano, violin, etc.). As to the tempo, there was a case under which the sound mark was registered just by attaching the metronome mark<sup>77</sup>. There are some unclear points as to the relationship between such unspecified description and the scope of protection.

#### 4.2.4. France

France has a long history of discussing and protecting (even if by unfair competition) non-traditional trademarks. Article 1 of the Trademark

---

<sup>74</sup> Journal of the Japanese Group of the International Association for the Protection of Intellectual Property (June 2012) *Supra* Footnote 64, p.9

<sup>75</sup> Article 11 of the Trademark Regulation

<sup>76</sup> Clear, precise, self-contained, easily accessible, intelligible, durable and objective

<sup>77</sup> PORT, Kenneth L., On Nontraditional Trademarks. William Mitchell College of Law Faculty Scholarship. Paper 235. (2011) pp. 3

Law of 1964 defines a trademark as “all signs which serves to distinguish the products, goods or services of one enterprise from those of other enterprise”<sup>78</sup>. At the time of legislation, the list of signs which are deemed as trademarks was proposed, and “sound” was clearly included in that list. However, at the time of the actual legislation, simpler form of the provisions was adopted<sup>79</sup>. Although the list was not adopted, some scholars argued that sound marks are within the scope of trademarks at that time. With the development of radio and television, they believed that protection of sound marks was of important<sup>80</sup>.

Article 711-1 of the current Trademark Law contains a comprehensive list which is almost the same as the list proposed at the time of legislation back in 1964.

“The following, in particular, may constitute such a sign:

- (a) denominations in all forms, such as :words, combination of words, surnames and geographical representations, pseudonyms, letters, numerals, abbreviations;
- (b) audible sings such as: sounds, musical phrases;
- (c) Figurative signs such as: devices, labels, seals, selvedges, reliefs, holograms, logos, synthesized images; shapes, particularly those of a product or its packaging, or those that identify a service; arrangements, combinations or shades of colour.”

France is a member state of the European Union, and it requires graphical representation of marks. However, the standards for the requirement are deemed less strict than other member states. For example, as for sound marks, submission of musical notation is recommended for sound marks consisting of musical elements, but descriptions by text or sonogram is permitted for trademarks that have won musical elements<sup>81</sup>.

---

<sup>78</sup> The original text is as follows: “Tous signes matériels servant à distinguer les produits, objets, ou services d’une entreprise quelconque”

<sup>79</sup> Groupe français AIPPI. RAPPORT Q96 - SIGNES SUSCEPTIBLES DE CONSTITUER UNE MARQUE ENREGISTRABLE

<sup>80</sup> BLUM, Rudolph. Les marques de service. P.I., 1953. p.117

<sup>81</sup> ROUX, Evelyne et al au nom du Groupe français. Rapport Q181 - Les conditions d’enregistrement et l’étendue de la protection des marques non-conventionnelles(<https://www.aippi.org/download/committees/181/GR181france.pdf>) Accessed on November 29, 2014

### 4.3 South America

#### 4.3.1. Argentina

Article 1 of the current Trademark Law of 1981 defines a trademark as a “mark for distinguishing goods and services”<sup>82</sup>, without further explanation to what kind of types may be registered as such. Albeit previous to the TRIPs agreement, this functional definition is broad and open to several types of non-traditional trademarks. In this sense, if a mark is distinctive and do not fall within the provisions in Articles 2 and 3 which foresees the grounds for registration, it is possible to register non-traditional trademarks, even sound mark, in Argentina. You can find several examples, such as sound marks, registered since 1997<sup>83</sup>

Actually, Argentina has a rare case regarding olfactory trademarks. In a 2004 first instance court decision, Argentinean courts ruled that there is no legal ground to prevent the registration of olfactory marks. In case 7249/01, the French cosmetics company L’Oreal filed various applications to register fruit smells, such a grape or strawberry, for shampoo containers. Nonetheless, the applications were opposed by a local company on grounds of lack of distinctiveness. The decision, however, concluded that there is no issue of distinctiveness in such smell for bottles and that there are no absolute grounds to refuse the application. The decision cited and received a large influence from the 1999 decision from the Board of Appeal of the Community Trade Mark Office regarding “the smell of fresh cut grass” for tennis balls, which is an interesting influence of foreign law at a domestic level.

As the requirements for registration, the description requirements similar to those required in Europe are provided. Therefore, graphical

---

<sup>82</sup> Article 1 of the Law on Trademarks of Argentine:

“The following may be registered as marks in order to distinguish goods and services: one or more words with or without conceptual content; drawings; emblems; monograms; engravings; patterns; seals; images; bands; combinations of colours applied in a particular place on goods or packaging; wrapping; packaging; combinations of letters and numbers; letters and numbers drawn in a particular way; advertising slogans; distinctive embossments and any other sign with such capacity”.

<sup>83</sup> Casos Relevantes - Caso 1ra. Marca Sonora ([http://www.sbm.com.ar/casos\\_marca\\_sonora.php](http://www.sbm.com.ar/casos_marca_sonora.php)) Accessed on November 29, 2014

representation is required when filing a new application for sound mark.

#### 4.3.2. Andean Community of Nations

Andean Community of Nations<sup>84</sup> is a union of four South American nations centered on Andean region - Bolivia, Colombia, Ecuador and Peru - aiming at integrated economic development, balance and autonomy. It has its own legislation related on intellectual property rights, Decision 486 "Common Intellectual Property Regime". The definition of a trademark under the Decision 486 of the Andean Community is made in Article 134:

"any sign capable of distinguishing goods or services on the market shall constitute a mark. Signs that are susceptible of graphic representation may be registered as marks. The nature of the product or service to which a mark is to be affixed shall in no case be an obstacle to the registration thereof. The following signs, among others, may constitute marks:

- (a) words or word combinations;
- (b) images, figures, symbols, graphics, logotypes, monograms, portraits, labels, emblems and shields;
- (c) sounds and aromas;
- (d) letters and numerals;
- (e) a color within an outline, or a color combination;
- (f) the shape of the goods, their containers or their packaging;
- (g) any combination of the signs or elements specified in the foregoing subparagraphs."

In other words, a trademark protected under the laws of those 4 countries is: (1) capable of functioning as a sign for distinguishing goods or services in the market, (2) capable of being represented graphically, and (3) listed in items (a) through (g) of Article 134 of Decision 486 of the Andean Community<sup>85</sup>. There is no doubt that a sound mark is protected in the Andean Community because it is clearly provided in item (c).

The protection of single color trademarks, however, is not clear and for a long time was not accepted. However, some courts of some member

---

<sup>84</sup> Established pursuant to the Cartagena Agreement dated May 26, 1969.

<sup>85</sup> Journal of the Japanese Group of the International Association for the Protection of Intellectual Property (June 2012) *Supra* Footnote 66, p.11

countries, such as Peru and Colombia has been accepting single color trademarks on cases where distinctiveness was obtained through use. It was in 2015 that Colombia started becoming more flexible towards single color trademark registrations<sup>86</sup>.

As the descriptions of the mark, as for sound trademarks, both (i) graphical representation and (ii) sound recording are required. An interesting point is that the main melody represented in the sound recording should be the key point for deciding the scope of protection<sup>87</sup>. Graphical representation is made by way of musical notation in many cases because many of the sound marks consist of musical elements<sup>88</sup>.

An interesting practice within the Andean Community is that, when filing an application for sound mark, the applicant should obtain consent of the author necessarily because no sound mark may be registered without the consent of the author as long as the mark infringes any copyright of others<sup>89</sup>.

#### 4.3.3. Uruguay

Article 1 of the Trademark Act of 1998 of Uruguay defines a trademark as “a sign used by a natural or judicial person to distinguish goods or services provided by it from those provided by others<sup>90</sup>”. This definition is quite broad, but Uruguay has an interesting controlling tool provided in Article 2. Article 2 specifies that “the registration of a sign which is not visually perceptible shall be subject to the availability of adequate

---

<sup>86</sup> COOPER, Camila. Now it's possible to have a Brand Color!|Colombia(2015) Available at (<<http://brlatina.com/now-its-possible-to-have-a-brand-colorlatin-america/>>) access in March, 5, 2015

<sup>87</sup> MARQUES, Ricardo Luiz Pereira. *Marcas Sonoras no Direito Brasileiro*. Juruá, 2010. p.107

<sup>88</sup> A very interesting point should be mentioned regarding the Peruvian practice, where the PTO outsources a part of the formality examination, and “the confirmation of match between the graphical representation (musical notation or spectrum) and the sound recording is made by the National Conservatory of Music and the Music Factory of Peruvian Catholic University. The cost for such analysis should be borne by the applicants” (Id. at p.289).

<sup>89</sup> Id. at p.286

<sup>90</sup> The original text is as follows: “Se entiende por marca todo signo con aptitud para distinguir los productos o servicios de una persona física o jurídica de los de otra.”

technological means. For the implementation of such registration, the government authority shall determine the form and instrumentation”<sup>91</sup>.

On May 3, 2001, the Decision 146 was issued to provide for the registration of a sign not visually perceived, including sound mark. According to this Decision, the registration should be allowed if the mark has any distinctive character and is properly and rightfully used<sup>92</sup>.

According to this Decision, “the description by way of sign or symbol capable of being acknowledged and compared as trademark” is required as the description requirement. Submission of explanation is not required but acceptable<sup>93</sup>. The graphical representation is published on the official gazette issued in print medium, and the files which are filed electronically may be accessed through database.

#### 4.3.4. Chile

Until quite recently, under Article 19 of the Trademark Law of 1991 in Chile, a trademark was defined as “a visually perceptible sign which serves to distinguish goods, services or industrial or commercial facilities.” This definition of a trademark was later amended due to a revision to the Trademark Law that was done in response to the execution of the Free Trade Agreement with the US and with Europe during the period of 2005 to 2007.

The revision introduced more clearly a broad scope of non-traditional trademarks, and the definition of trademark was modified. The portion of “a visually perceptible sign” in the former definition was changed to “a sign capable of being represented graphically”, and the list of signs falling under the definition of mark (although not exhaustive) was presented. For example, “Sound” is clearly provided in the list. No revision was made with regard to the procedural laws, and the application procedures for the traditional trademarks are applied to the new types of marks. Article 19 of the current Trademark Law is as follows:

---

<sup>91</sup> The original text is as follows: “El registro de los signos no visibles quedará condicionado a la disponibilidad de medios técnicos adecuados. A tales efectos, el Poder Ejecutivo determinará la oportunidad y reglamentará la forma de su instrumentación.”

<sup>92</sup> Decreto N° 146/001 sobre el Registro de Signos no Visibles, ART. 1

<sup>93</sup> MARQUES (2010), *Supra* Footnote 87, p.105

“Trademark” means a sign capable of being represented graphically which serves to distinguish goods, services or industrial or commercial facilities. The signs shall consist of a name of individual, words, characters including numerals, figures, images, signs, figurative elements such as a combination of colors, sound or a combination of any of the foregoing. If the sign is not inherently distinctive, the registration may be allowed as it has acquired the distinctive character through use in the domestic market. Similarly, slogans or advertisements may be registered by associating the use thereof to the applicable goods, services, or industrial or commercial facilities. The nature of the goods or services should not be an obstacle to the trademark registration<sup>94</sup>.

At the 17th Session of WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, where the main discussion was about non-traditional trademarks, Chile representative proposed a comment<sup>95</sup> indicating that the requirement of graphical representation for sound marks is generally met by a musical notation. However, procedure wise, there is no special item to be entered in the request form for inspection of registration items of a non-traditional trademark. Nonetheless, in practice, the National Institute of Industrial Property (INAPI), the Chilean trademark office, includes, for example, the term “MELODIA<sup>96</sup>” to the name of the sound mark so that the mark may

---

<sup>94</sup> Original text is as follows: Bajo la denominación de marca comercial, se comprende todo signo que sea susceptible de representación gráfica capaz de distinguir en el mercado productos, servicios o establecimientos industriales o comerciales. Tales signos podrán consistir en palabras, incluidos los nombres de personas, letras, números, elementos figurativos tales como imágenes, gráficos, símbolos, combinaciones de colores, así como también, cualquier combinación de estos signos. Cuando los signos no sean intrínsecamente distintivos, podrá concederse el registro si han adquirido distintividad por medio del uso en el mercado nacional. Podrán también inscribirse las frases de propaganda o publicitarias, siempre que vayan unidas o adscritas a una marca registrada del producto, servicio o establecimiento comercial o industrial para el cual se vayan a utilizar. La naturaleza del producto o servicio al que la marca ha de aplicarse no será en ningún caso obstáculo para el registro de la marca.”

<sup>95</sup> INFORMACION PROPORCIONADA POR EL DEPARTAMENTO DE PROPIEDAD INDUSTRIAL MINISTERIO DE ECONOMIA, FOMENTO Y RECONSTRUCCION ([http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/cl\\_1.pdf](http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/cl_1.pdf)) Accessed on November 29, 2014

<sup>96</sup> “MELODIA” means “melody” in English

be perceived as a sound mark when a third party is conducting a trademark search.

#### **4.4 Asia-Oceania**

##### **4.4.1. Australia**

Most probably, Australia would be the country which has amended its trademark system in the most properly in the world to comply with the continuous change of trademark use. The arguments presented in relation to the constituent features and the functions of trademarks, since the establishment of the Trade Marks Act of 1912, and at the time of revision in 1948, and up to the present Trade Marks Act, can be said to be really *avant-garde*. In what regards non-traditional trademarks, that is no exception.

The Trade Marks Act of 1995 was enacted to ratify the TRIPs Agreement and at that time, the definition of a trademark was amended to add new types of marks. When introducing the new types of marks and designing the new system, Australian authorities said they referred to the TRIPs Agreement and EU Directive, but actually, the scope of trademarks defined is far beyond that of the European Union.

Article 17 of the Trade Marks Act of Australia defines that a trademark 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 term “sign” is defined to include “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.”

Not only non-visual signs such as sound or scent are clearly provided within the definition but it is also possible to register a trademark combining new types of marks or combining any traditional mark with any new type of mark, as long as the applicant provides the description of those combinations. Whatever are the types of the trademarks, combined marks consisting of a combination of multiple elements are deemed more distinctive, and the registration of such marks are deemed as easier<sup>97</sup>. There are registrations<sup>98</sup>, for example, for combination<sup>99</sup> of sound and

---

<sup>97</sup> See *Supra* 62. at p.122

movement<sup>100</sup>.

Article 40 of the Trade Marks Act of Australia provides that “an application for the registration of a trade mark must be rejected if the trade mark cannot be represented graphically.” In case of new types of trademarks, the trade mark is identified by graphical representation and clear description.

In what regards the representation of sound marks, the requirement can be met by musical notation in case of a trademark consisting of musical elements. In case of a trademark consisting of non-musical elements, it must meet the requirement by way of written explanation<sup>101</sup>. Further, the applicant is required to file the description of the trademark and the sound recording<sup>102</sup>. About scent trademarks, the Trade Marks Office will accept a precise verbal description of a scent as a “graphical representation” of the mark.

There are examples of registrations of sounds for the word “sproing,<sup>103</sup>” intended to imitate the sound of a spring reverberating on metal, for the sound of Tarzan’s yell<sup>104</sup>, among others. Also, as for scents, there are registrations for a Eucalyptus Radiata scent<sup>105</sup> in respect of golf tee goods, and allowances for an application for “the strong smell of beer<sup>106,107</sup>.” There are also registrations for single color trademarks<sup>108</sup>.

---

<sup>98</sup> Australian registration No. 907230

<sup>99</sup> IP Australia <<http://www.ipaustralia.com.au/applicant/mccain-foods-aust-pty-ltd/trademarks/907230/>> Accessed on December 29, 2014

<sup>100</sup> Described as “The present trademark consists of a combination of sound and moving image. The sound is a high pitched ping sound (such as that of a glass being struck by a hard obstacle) lasting approximately two seconds, and the accompanying image of a star grows larger gradually, then shrinks smaller. The change of image of the star device is as described in the descriptions attached to the application. The sound and the accompanying image are recorded in the video tape attached to the application.”

<sup>101</sup> Australian Trade Marks Office Manual, Part 21, para 6.1

<sup>102</sup> CHALK Peter et al in the name of the Australian Group AIPPI. Report Q181 - Conditions for registration and scope of protection of non-conventional trademarks <<https://www.aippi.org/download/committees/181/GR181australia.pdf>> Accessed on December 29, 2014

<sup>103</sup> Australian registration No. 738848

<sup>104</sup> Australian registration No. 1480175

<sup>105</sup> Australian registration No. 1241420

When filing an application for some non-traditional trademarks, the applicant is required to file a written detailed description of the trademark, in addition to the graphical representation. For the trademark registrations in Australia, this “clear and brief explanation” is called “Endorsement” and is used after the registration, for the sake of contributing to an easier search for the marks<sup>109</sup>. Further, the applicant is required to describe the type of the mark. In the course of the examination, further explanation or amendment may be required, which also contribute to the identification of the trademark.

In Australia, there is an established route for entrusting the examination of marks to university professors and other experts in case it requires special knowledge on music or art<sup>110</sup>.

#### 4.4.2. Korea

The Trademark Act of Korea was recently amended to extend the protection to sound, scent and other non-conventional marks in order to reflect provisions of the Free Trade Agreement (FTA) between Korea and the United States which was ratified recently. The amendment came into force on March 15, 2012. Article 2 of the amended act provides that:

“the term “trademark” means any of the following items (hereinafter referred to as “mark”) that is used by a person who produces, processes or sell goods as a business, in order to distinguish the goods related to his/her business from those of another person:

- (a) Any sign, letter, figure, three-dimensional shape or the combination thereof or the combination of them and colors;
- (b) Any color that is not combined with others, the combination of colors, any hologram, movement or other item that can be visually

---

<sup>106</sup> Australian Application No. 700019

<sup>107</sup> Ultimately the mark did not proceed to registration because the registration fees were not paid.

<sup>108</sup> Mars was granted a registration for the color “Whiskas Purple.” (Mars Australia Pty Ltd (formerly Effem Foods Pty Ltd) v. Société des Produits Nestlé SA, [2010] FCA 639 (June 22, 2010).)

<sup>109</sup> Journal of the Japanese Group of the International Association for the Protection of Intellectual Property (June 2012) Supra Footnote 62, p.122

<sup>110</sup> Id. at p.129

recognized;

- (c) Any sound, odor or others that expressed realistically with a sign, letter, figure, or by any other visual means, among sounds, odors and others that cannot be recognized visually”

It is clear from those provisions that non-visual trademarks, such as sounds and scents may be registered as a trademark. However, under the current examination practice in Korea, non-visual trademarks are considered not to be able to have inherent distinctiveness. Therefore, in order for the marks to be registered, the applicants must show that the sound has acquired distinctiveness through extensive use in South Korea<sup>111</sup>.

The applicant for the registration of a trademark is required to present the description of the mark by way of graphical representation. For sounds, an explanation of the sound mark and the sound recording are required for a mark consisting of musical elements, and the applicant may file the musical notation as necessary. In case of a mark consisting of non-musical elements, the requirement can be met by filing the explanation and the sound recording<sup>112</sup>. The explanation of the mark must be described with 500 characters or less.<sup>113</sup>

#### 4.4.3. China

The current Trademark Law of the People’s Republic of China came into force in 1983. This is the first specific law concerning intellectual property rights since China implemented the Reform and Opening-up Policy. The law was amended in 1993 and in 2001, and for the third time it was amended on August 30, 2013 according to the “Decision on the Amendments to the Trademark Law of the People’s Republic of China” adopted at the 4th session of the 12th Term Standing Committee of

<sup>111</sup> KIM&CHANG [Korean Intellectual Property Law | November 18, 2013] <<http://www.kimchang.com/editor/upload/20131115170535.pdf>> Accessed on December 29, 2014

<sup>112</sup> Article 36.3 of the Ordinance for Enforcement of the Trademark Law

<sup>113</sup> Institute of Intellectual Property. 2012 Fiscal Year’s Industrial Property Rights System Comparative Study (Research Report on the system and practice of countries who protect non-visual trademarks) (June 2012) <[http://www.jpo.go.jp/shiryou/toushin/chousa/pdf/zaisanken\\_kouhyou/h24\\_report\\_01.pdf](http://www.jpo.go.jp/shiryou/toushin/chousa/pdf/zaisanken_kouhyou/h24_report_01.pdf)> Accessed on December 29, 2014, p.242

National People's Congress, and the third amendment to the Trademark Law of China is to come into force on May 1, 2014.<sup>114</sup>

Up to that point, some non-traditional trademarks, such as color trademarks were already protected. However, the third amendment to the Trademark Law of China meant the inclusion of "sound" within the definition of a trademark as provided in Article 8 of the Trademark Law. Article 8 of the law before the third amendment read as follows:

"An application may be made to register as a trademark any mark, including any word, device, any letter of the alphabet, any number, three-dimensional symbol, color combination and sound, or any combination thereof, that identifies and distinguishes the goods of a natural person, legal person, or other organization from those of others."

We have to wait for the establishment of the ordinance for enforcement of the Trademark Law yet to be promulgated, for the form of filing an application for sound mark, including the method for identifying the sound.

As of 2013, China is receiving the largest number of trademark applications in the world, and Chinese practice cannot be ignored completely as an influence.

What was characteristic to the third amendment<sup>115</sup> was that a provision for sound mark was clearly introduced in the provisions for the reasons for rejecting registration. In Article 10, "national anthem", "army emblem" and "military song" were added as the words or devices which shall not be used as trademarks.<sup>116</sup>

#### 4.4.4. Hong Kong

Article 3 of the Trademark Ordinance of Hong Kong<sup>117</sup> defines a "trade

---

<sup>114</sup> Comments on the third amendment to the Trademark Law of China <<http://www.raytec.co.jp/support/Ipnews/IP63.pdf>> Accessed on December 29, 2014

<sup>115</sup> Chixue WEI: "Key Points of the 3rd revision of Trademark Law of China" <[http://www.ryuka.com/home/uploads/patentinfo/seminar\\_105.pdf](http://www.ryuka.com/home/uploads/patentinfo/seminar_105.pdf)> Accessed on December 29, 2014

<sup>116</sup> Takashi NOMURA: "Key Points of the 3rd Amendment to Trademark Law of China" <[http://www.jurists.co.jp/ja/topics/docs/newsletter\\_201310\\_cn.pdf](http://www.jurists.co.jp/ja/topics/docs/newsletter_201310_cn.pdf)> Accessed on December 29, 2014

<sup>117</sup> Trade Marks Ordinance Cap. 559

mark” as “any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically,” and it is provided in Article 3 (2) that “a trade mark may consist of words (including personal names), indications, designs, letters, characters, numerals, figurative elements, colors, sounds, smells, the shape of goods or their packaging and any combination of such signs.” It is possible to state that the protection of non-traditional marks is clearly provided in Hong Kong.

The Trade Marks Registry of the Intellectual Property Department has established certain detailed Examination Standards for sound marks. Since the definition of a trademark requires “a sign capable of being represented graphically”, the applicants are required to describe the marks with graphical representation. It is clear from the Examination Standards that the standards of the Shield Mark<sup>118</sup> case are applicable. As Hong Kong is not a member state of the European Union, it is not required to apply the Shield Mark case *mutatis mutandis* to the domestic cases. However the Trade Marks Registry provides that the requirement of graphical representation is met where it is represented by a stave divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals (e.g. sharp (#), flat (b) and natural (♮))<sup>119</sup>.

It also provides that “a description in words alone unaccompanied by a graphic representation of the mark is insufficient”, which makes it quite difficult to register a sound mark consisting of non-musical elements. The applicants may submit a sound recording of the mark, but it will be used for reference purpose only by the Registry, and does not affect the decision of the scope of protection<sup>120</sup>.

The Examination Standards also refer to the decision of distinctiveness of a sound mark, and it is provided that the decision should be made in the same manner as the decision for other types of marks, including conventional trademarks. At the same time, however, it provides that “in most cases, evidence of acquired distinctiveness will be required.”<sup>121</sup> In

<sup>118</sup> Shield Mark case, *Supra* Footnote 59

<sup>119</sup> Sound marks ([http://www.ipd.gov.hk/eng/intellectual\\_property/trademarks/registry/sound\\_marks241008.pdf](http://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry/sound_marks241008.pdf)) Accessed on October 25, 2013

<sup>120</sup> *Id.*

practice, the Registry does not recognize inherent distinctiveness of any non-visual trademarks in principle.

#### 4.4.5. India

In India, Section 2(1)(m) of the Trade Marks Act of 1999 defines a “mark” as “includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof.” This definition seems to be influenced by the United Kingdom<sup>122</sup>. Therefore, the list is not construed to be exhaustive, and the Draft Manual provided by the Controller General of Patents Designs and Trade Marks (CGPDTM) indicates that marks which are not visually perceived will be given special consideration on a case-by-case basis<sup>123,124</sup>.

The Draft Manual applies, although indirectly, the Sieckmann standards with regard to the requirement of graphical representation, even though India is not a member state of the European Union<sup>125</sup>. Probably because India is a former colony of the United Kingdom, we see the effect here<sup>126</sup>. Although the Manual indicates that the description requirement is met by musical notation in case of a mark consisting of musical elements, there is no indication as to the sound marks consisting of non-musical elements.

In 2008, CGPDTM registered a sound mark of Yahoo, which is similar to a yodel sound. Considering that the description of the application for this mark was similar to that of the corresponding US registration, it seems that the decision on the description requirement is not so severe compared with that of the European Union<sup>127</sup>. CGPDTM, however, does

---

<sup>121</sup> The original text is as follows: In most cases, evidence of acquired distinctiveness will be required”

<sup>122</sup> GANGJEE, Dev. Non-Conventional Trade Marks in India. National Law School of India Review, Vol. 22, No. 1, pp. 67–96, (2010) p.2

<sup>123</sup> “The word “mark” is thus intended to be interpreted broadly and no type of sign is automatically excluded from registration. Marks which will require special consideration are colours, shape of goods, sounds and smells.”

<sup>124</sup> Draft Manual Ch II, at 3.1.

<sup>125</sup> Draft Manual Ch II, at 5.2.2 Sound marks

<sup>126</sup> GANGJEE (2010), Supra Footnote 122, p.11

<sup>127</sup> P. Manoj, Yahoo Awarded India’s First Sound Mark; Nokia in Queue LIVE

not recognize the inherent distinctiveness of a sound mark in principle<sup>128</sup>. This is a very interesting application of foreign case law at a domestic level.

#### 4.4.5. Japan

Japan has traditionally been a very strict country on the sense that a trademark must necessarily appeal visually. Accordingly, sounds, smells, tastes and other non-visual marks would not fall under the scope of trademarks under the Trademark Act, even if they provide similar functions to those of the trademarks<sup>129</sup>. However, as more and more countries came to protect sound marks as trademarks, the Intellectual Property Committee of Industrial Structure Council started deliberation on the introduction of a system where the “sound” marks, as well as other new types of trademarks, are protected in addition to the conventional trademarks having been protected thus far<sup>130,131</sup>.

---

MINT, Aug. 22, 2008; Yahoo! Yodels into India's Trade Mark Registry MANAGING INTELLECTUAL PROPERTY WEEKLY NEWS, Sep. 1, 2008.

<sup>128</sup> 「Prima facie, no sound marks will qualify for acceptance without evidence of factual distinctiveness. In particular, the following will fall in this category」Draft Manual Ch II, at 5.2.2.2

<sup>129</sup> Commentary on the Code of Intellectual Property Rights Law[19th version] <[http://www.jpo.go.jp/shiryuu/hourei/kakokai/pdf/cikujoyoukaisetu19/syuhyou\\_all.pdf](http://www.jpo.go.jp/shiryuu/hourei/kakokai/pdf/cikujoyoukaisetu19/syuhyou_all.pdf)> Accessed on December 29, 2013, p.1261

<sup>130</sup> Junko NAITO “Trend of New Type of Trademarks (Atarashi taipu no shohyo wo mguru doko)” <[http://www.japio.or.jp/00yearbook/files/2012book/12\\_1\\_08.pdf](http://www.japio.or.jp/00yearbook/files/2012book/12_1_08.pdf)> Accessed on December 29, 2014,

<sup>131</sup> The following is the outline of each examination by the Subcommittee:

(1) 19th Trademark System Subcommittee (June 2008): Discussed on the “Issues to be examined in relation to therevision of trademark system”, and it was concluded that the examiantion on protection of new types of trademarks under the Trademark Act is necessary. It was decidd to establish the Working Group on New Type of Trademarks (New Trademark WG) under the Subcommittee to examine the issue.

(2) 20th Trademark System Subcommittee (October 2009): The “Report by the Working Group on New Type of Trademarks” was reported summarizing the result of five-time meetings of the New Trademark WG.

(3) 22nd Trademark System Subcommittee (July 2010): Based on the report by the New Trademark WG, the registration requirements for new types of trademarks were examined, more specifically on the issues of (i) the principle of one mark per application, (ii) distinctiveness, (iii) similarity of trademarks and

After many years of deliberation, the Japanese Diet enacted the amendment act to change the Trademark Act<sup>132</sup>, etc. on April 25, 2014,

---

(iv) other reasons for rejection (sound for public interest, adjustment with copyrights and other rights, functionality, etc.).

(4) 24th Trademark System Subcommittee (February 2011): Further examination was made with regard to the ideas on the identification of new types of trademarks and on the recognition of application date as presented in the Report by New Trademark WG, in consideration of the consistency with the actual situation of other countries, new rules in the Singapore Treaty, and the operation under the Madrid Protocol.

(5) 25th Trademark System Subcommittee (February 2012): As the overall direction, it was proposed to conduct examination toward the introduction of the protection of new types of trademarks. It was approved to continue examining each issue.

(6) 26th Trademark System Subcommittee (April 2012): In preparation for conducting specific examinations for the introduction of protection of new types of trademarks, the result of the survey on the actual situation of other main countries (US, EU, AU and KR) was reported on the practice of protection and the situation of use of the new types of trademarks, including “smell”.

(7) 27th Trademark System Subcommittee (May 2012): The policies to introduce a comprehensive definition of a trademark to protect new type of trademarks, and to add the requirement for distinctiveness for distinguishing the goods and services from those of others were approved because it is unreasonable to uniformly exclude, from the definition of a trademark, such marks as are capable of distinguishing the goods and services from those of others.

(8) 28th Trademark System Subcommittee (June 2012): It was approved to include new types of trademarks which have become the subject of protection internationally, such as movement, colors without delineated contours, sounds and smells, for protection under the Trademark Act of Japan, subject to examination on the method of application and method of publication by referring to the examples of other countries and examining, in particular for “smell” and other marks which cannot be perceived visually, operation of examination considering use over reasonable period of time and examination on measures to clearly specify the scope of protection.

(9) 29th Trademark System Subcommittee (September 2012): The limitation on the effect of new types of trademarks and other issues were examined, and the system for revoking the trademark protection was examined with regard to the marks which have lost their distinctiveness after the registration. Further, the relationship between the revocation and Article 6(3) of the Paris Convention was discussed.

<sup>132</sup> The Act for Partial Amendment to Patent Act, Etc. (Act No. 36 of May 14, 2014). The Amending Act includes revisions to the other industrial property

which was then promulgated on May 14, 2014. With such revision, Japan has finally decided on adopting, officially, the protection of non-traditional trademarks. With this amendment, five types of non-traditional trademarks are to be newly covered by the Japanese trademark system: “motion trademark,” “hologram trademark,” “color trademark,” “sound trademark” and “position trademark.” The new revision started to be enforced since April 1, 2015.

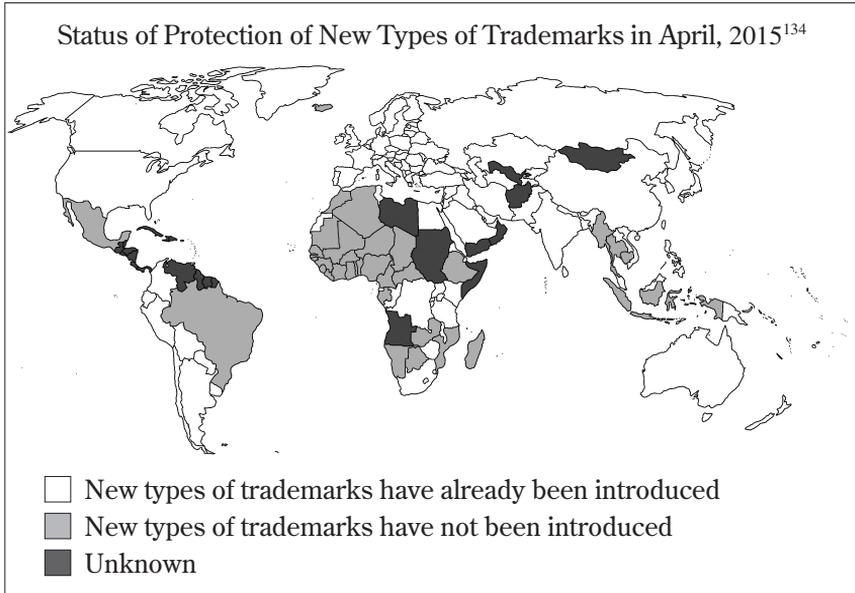
Because of the new amendment, the current definition of trademarks in Japan is “any character(s), figure(s), sign(s), three-dimensional shape(s) or color, or any combination thereof, sound(s), or other(s) specified by a Cabinet Order, as is recognizable with human perception”, as per the new text of Article 2, Paragraph 1. The interesting point is how Japan purposely did not include “scent” as trademark, but left a soft switch to be able to do so by including the possibility of protecting “other(s) (signs) specified by a Cabinet Order”.

To follow up the amendment of the Trademark Act, detailed guidelines were issued regarding the analysis of distinctiveness. To that extent, due to the natural functional nature of non-traditional trademarks, the exclusion of marks related to the characteristics of goods and services (e.g. colors such as “the color black” for goods of “automobile tires” and sounds generated such as “sizzling” sounds related to the services of “providing roasted meat” will be appropriately rejected as trademarks with no distinctiveness.) in Art. 3 and Art. 4 are topics well discussed in the guidelines.

As for the presentation of the trademark, the Japanese guidelines describe that if motion, hologram, color and position trademarks are to be registered, the trademarks themselves and their detailed description must be submitted. In the case of sound trademarks, five-line staff to be registered and related articles (sound files) must be submitted with the applications.

---

laws, such as the Patent Act and the Design Act, and also includes revisions to the Trademark Act in other respects. Among these revisited points, this Commentary focuses on the introduction of new nontraditional trademarks in Japan.



## 5. Some Final Remarks

The figure below demonstrates the countries through the entire world which by December 2014 accepts applications and grants registrations for at least one type of non-visual trademark. The graphic makes clear that at least in terms of geographical area protection of non-traditional trademarks is currently more a rule than an exception. However, this data becomes even more relevant when you realize that all countries within the top 10 recipients of trademark applications are currently protecting non-traditional trademarks<sup>133</sup>.

Although the current analysis cannot be said to be completely comprehensive about all the legal systems throughout the world, as per the analysis of the definition of trademarks in several jurisdictions, it is possible to divide the style of introduction of non-traditional trademarks in

<sup>133</sup> WIPO IP Facts and Figures (2014) Available at ([http://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_943\\_2014.pdf](http://www.wipo.int/edocs/pubdocs/en/wipo_pub_943_2014.pdf)) Accessed on June 17, 2015

<sup>134</sup> Data from “Registrations of and Main Judicial Precedent on New Types of Trademarks” edited by JPO, updated and modified by the author.

two ways. The first being the introduction by an amendment of a statute, by including words such as “sounds”, “scents” etc. The second being the introduction of protection for non-traditional trademarks through case law. This second way can also be divided into two sub sections, the first being the case law interpreting a word within the definition of trademark, such as “symbol”, and the second being an interpretation of the scope and possibilities of graphical representation.

Considering the above, although we have been seeing continuous adoption of non-traditional trademarks in the past 20 years, such style of introduction has not been uniform, unfortunately. In this sense, the swift to protection of nonvisual trademarks did indeed not have necessarily a positive effect towards harmonization of the definition of the trademark. The amendments made by obligation of FTA's might be one single exception to this pattern.

Notwithstanding the issue of the harmonization on the definition above, probably the only issue that has been harmonized to some extent would be the description requirement of graphical representation, which was generally presented in the Sieckmann case and the Shield Mark case. For example, for sound trademarks, many countries consider valid the submission of a musical notation in case of a mark consisting of musical elements. In some cases, those cases are directly quoted even in countries outside the EU.

In the end, considering that the details of the protection of each type of non-traditional trademarks still differ from country to country, it can be said that we have not yet reached a clear standard to generate a conclusive definition of what can constitute a trademark. Even though most of the world currently protects at least “sound” as non-visual trademarks and single color trademark, the scope of which color or sound and to what extent they are protected is still quite different.

However, considering the most recent introduction of non-traditional trademarks to domestic legislation, there seems to be somewhat of a pattern of drafting. Also, especially considering the raise on FTOs, more active discussion for harmonization is expected from now on.