Protection and Examination of Non-Traditional Trade Marks (NTTMs) in the EU

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EUIPO
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The New Legal Framework

1 OCT 2017

- **EUTMR**
  - Article 3 – Representation of the trademark: General principles, types of acceptable marks and specific representation requirements

- **EUTMIR**
  - Article 4 – New definition for the EU Trade Mark abolishing the graphical representation requirement

- **EUTMDR**
Signs of which an EU trade mark may consist

An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings;

(b) being represented on the Register of European Union trade marks (‘the Register’), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.
Art. 3(1) of Regulation (EU) 2018/626 (EUTMIR)

Representation of the trade mark

1. The trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor.

WYSIWYG – What You See Is What You Get
‘Types’ of trade marks

- Word mark
- Figurative mark
- Figurative mark containing word elements
- Shape mark
- Shape mark containing word elements
- Colour per se
- Sound mark
- Multimedia mark
- Position mark
- Motion mark
- Pattern mark
- Hologram mark
- Other

‘NEW’
Volumes 01.10.2017 – 04.09.2019

297,907

1,391

136,493

160,023

974

68

66

64

42

31

19

3

Word Mark Figurative 3D Position Color Sound Motion Pattern Multimedia Other Hologram
Definition expanded, includes appearance

No description

New formats: 3D modelling CAD

Article 3(3)(c) EUTMIR – Shape mark
Article 3(3)(c) EUTMIR – Shape mark: REGISTERED vs. REFUSED

EUTM 17 670 142
Classes: 33
Status: Registered

EUTM 17 788 886
Classes: 12, 28
Status: Refused (lack of distinctiveness)
Appeal pending
Article 3(3)(c) EUTMIR – Shape mark: REGISTERED

EUTM 17 754 284
Classes: 4, 35, 36, 37, 39, 43
Status: Registered
Article 3(3)(d) EUTMIR - Position mark

Position

*Visual* disclaimer to exclude certain characteristics (broken, dotted lines)

Description optional (how affixed to goods)
Article 3(3)(d) EUTMIR - Position mark: REGISTERED vs. REFUSED

EUTM 17 366 634
Classes: 12
Status: Registered

EUTM 17 935 217
Classes: 25
Status: Refused
Article 3(3)(e) EUTMIR - Pattern mark

Pattern

Reproduction showing the pattern of repetition

Description optional (details how elements are repeated)
Article 3(3)(e) EUTMIR - Pattern mark: OBJECTED. WITHDRAWN

EUTM 17 427 386
Classes: 18, 24, 25
Status: Objected. Withdrawn
Article 3(3)(f) EUTMIR - Colour mark

Indication of recognised colour codes compulsory

The reproduction must show the systematic arrangement

A description may detail the systematic arrangement further
Systematic Arrangement of Colour Combinations

Example 1

Example 2

Example 3

Example 4

Example 5

Objected for candy
Article 3(3)(g) EUTMIR – Sound mark

EUTM 7 214 083
Classes: 12, 35, 38
Status: Registered
Article 3(3)(g) EUTMIR – Sound mark

**EUTM 17 700 361**

Classes: 3, 9, 16, 25, 28, 35, 41, 43 (advertisement products, e.g. clothing, games, cosmetic products, advertisement and education materials).

**EUTM 17 277 864**

Classes: 9, 38 (electronic communications apparatus and services)
Ground for refusal: Article 7(1)(b) : ‘too long (39 seconds) and complex’

**EUTM 17 889 555**

Class 12 (Electrically operated scooters)
7(1)(b)EUTMR : ‘perceived as a mere burst engine noise’
EUTM 17 912 475

Classes: 6, 29, 30, 32, 33 (all related to ‘beverages, drinks’)
Grounds for refusal: Article 7(1)(b) EUTMR

• ‘sound that one hears when opening cans of effervescent drinks (which will be associated also in case of non-carbonated drinks)’

BoA Decision of 24.07.2019: REFUSAL CONFIRMED

• ‘non-distinctive: it does not deviate significantly from the sound normally available in this context (sound too close to the normal sound that is heard when a can containing a sparkling drink is opened)’
Article 3(3)(h) EUTMIR – Motion mark

**Motion**

**Video file**
(MP4 format, max 8 000 Kbps, 20 MB)
or
**still sequential images**
(single JPEG or single A4)

**For still images:**
a description explaining the sequence
Article 3(3)(h) EUTMIR – Motion mark: REGISTERED

EUTM 17 902 876
Classes: 35, 36, 44, 45 (fund raising, medical care, advertising campaigns with the aim of promoting awareness).

EUTM 17 894 400
Classes: 9, 16, 35, 41 (software, advertising, marketing and promotional services).
Classes: 9 (loudspeakers, television apparatus, projectors)
Grounds for refusal: Article 7(1)(b) EUTMR

- ‘Perceived as instruction for operation/activation of the goods (sensor technology, which uses gestures for activating functions for the goods); Sign language (‘open/unlock’; ‘light – increase light intensity’; ‘switch off’; ‘close’)’
- Highlighting of positive and advanced aspects of the products in question;
Article 3(3)(h) EUTMIR – Motion mark

EUTM 17 364 481
Classes 41
Status: Objected.
Withdrawn.

EUTM 17 350 901
Classes 9, 41
Status: Refused
Article 3(3)(i) EUTMIR - Multimedia mark

Multimedia

Audio-visual file
(MP4 format, max 8 000 Kbps, 20 MB)

No description

EUTM 17 868 267
Classes: 35, 38, 42, 45
Status: Registered
Article 3(3)(i) EUTMIR - Multimedia mark: REGISTERED

EUTM No 17941596
Class 25

EUTM 17 279 704
Class 45
EUTM 17889338

Classes: 9, 36, 38, 41 and 42 (software, computerised financial services, access to platforms on the Internet, programming and software design)

Grounds for refusal: Article 7(1)(b)EUTMR

- ‘mere sequence of amounts in Euro that the consumers will not perceive as an indication of origin’
Classes: 9, 28 and 41 (software, game machines, online gaming services)
Grounds for refusal: Article 7(1)(b)EUTMR

- ‘Just a promotional slogan, conveying positive characteristics of the G/S, namely that these will allow for a significant price reduction;
- The further elements (device, sound) are not able to provide the sign with a sufficient distinctive characteristics’
Article 3(3)(i) EUTMIR - Multimedia mark

EUTM 17 282 203
Classes 9, 28, 41
Status: under examination
Article 3(3)(j) EUTMIR: Hologram mark

Hologram

Video file, graphic or photographic reproduction, containing the views necessary for sufficiently identifying the holographic effect in its entirety

No description
Article 3(3)(j) EUTMIR: Hologram mark: REGISTERED

**EUTM 17 579 491**

Classes: 16, 21 and 35 (stickers, art prints, kitchenware)

**EUTM 17 993 401**

Class 9: Access control and alarm monitoring systems, accessories for virtual reality, accessories for watches, alarm sensors, audio speakers, batteries, phone covers, etc.
Art. 3(4) EUTMIR: OTHER MARKS (Unspecified)

(4) Where the trade mark is not covered by any of the types listed in paragraph 3, its representation shall comply with the standards set out in paragraph 1 and may be accompanied by a description.
Art. 3(4) EUTMIR – Other marks: Tracer marks: REFUSED

Classes: 6 (Metal elevator ropes, partially sheathed with a plastic sleeve)

**Description:** The sign identifies elevator ropes made of metal strands, in which one strand is continuously encased in red plastic material.

**Status:** Application refused - Article 7(1)(b) EUTMR:

- ‘public accustomed to red-silver ropes: not an indication of origin’;
- ‘public interested in the question of whether such ropes are durable and do not rust and how much weight you can hang on them; such goods are not bought because of their decoration value’.
Art. 3(4) EUTMIR – Other marks: Tracer marks: UNDER EXAMINATION

EUTM 17 938 135

Classes: 22 (Tension belts for tarpaulin spanners)

**Description:** The key thread mark identifies straps for truck tarpaulin spanners with an ongoing, lengthy-facing line, which is a blue line, which is uniformly dashed, in the middle of the belt.

Status: Application under examination
Art. 3(4) EUTMIR – Other marks: Tracer marks: UNDER EXAMINATION

EUTM 17 983 831

Classes: 22 (Non-metallic ropes and non-metallic cordage)

Description: The Trade Mark consists of a black yarn incorporated in a strand of the rope throughout the length thereof so that the black yarn is exposed at intervals on the surface of the rope. The black yarn is used as an identifying marker of the Applicant’s goods.

Status: Application under examination
SIX OPPOSITIONS PENDING

- All directed against MOTION marks
- All based on traditional marks (i.e. word, figurative)
- All grounded on Article 8(1)(a) and (b)EUTMR
OPPOSITIONS AGAINST ‘NEW’ TYPES’: some examples

B 3059889 and B 3058800

<table>
<thead>
<tr>
<th>Earlier Rights</th>
<th>Contested EUTM 17906814</th>
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<td>AUDI</td>
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<td>AUDITEL</td>
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## OPPOSITIONS AGAINST ‘NEW’ TYPES’

**B 3071595**

<table>
<thead>
<tr>
<th>Earlier UK Trademark</th>
<th>EUTMA 17961198</th>
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<tr>
<td>![ trademarks image ]</td>
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<tr>
<td>9, 16, 28, 35, 38, 41</td>
<td>9, 28, 41 (software, game machines, online gaming)</td>
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Thank you
Means of Representation

OPTION 1: ABSTRACT ARRANGEMENT WITHOUT DESCRIPTION

OPTION 2: THE COLOURS ARE SHOWN AS THEY APPEAR ON THE GOODS

OPTION 3: ADD DESCRIPTION
Case C-124/18 P Red Bull v EUIPO, Appeal before the Court of Justice: dismissed

The GC correctly applied the principles stemming from case C-49/02, Blau/Gelb.

The mere indication of the ratio of colours is insufficient as it allows for the arrangement of those colours in numerous different combinations and does not constitute a systematic arrangement associating the colours in a predetermined and uniform way. Also juxtaposition can take different forms, giving rise to different images or layouts, while still being in equal proportion (paras 42, 44).

Actual use of the mark. Since the marks at issue were registered on the basis of acquired distinctiveness through use, the EUIPO and the GC were entitled to take into account the actual use of those marks within their assessment of Article 4 EUTMR (para.58).

*The lack of precision of the graphic representations was confirmed by the evidence of actual use of the colours, which reproduced the mark in very different ways in comparison with the vertical juxtaposition of the two colours shown in the graphic representation (para. 45).