

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 4 – New definition for the EU Trade Mark abolishing the graphical representation requirement

EUTMIR

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

EUTMDR

Art. 4 of Regulation (EU) 2017/1001 (EUTMR)

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.

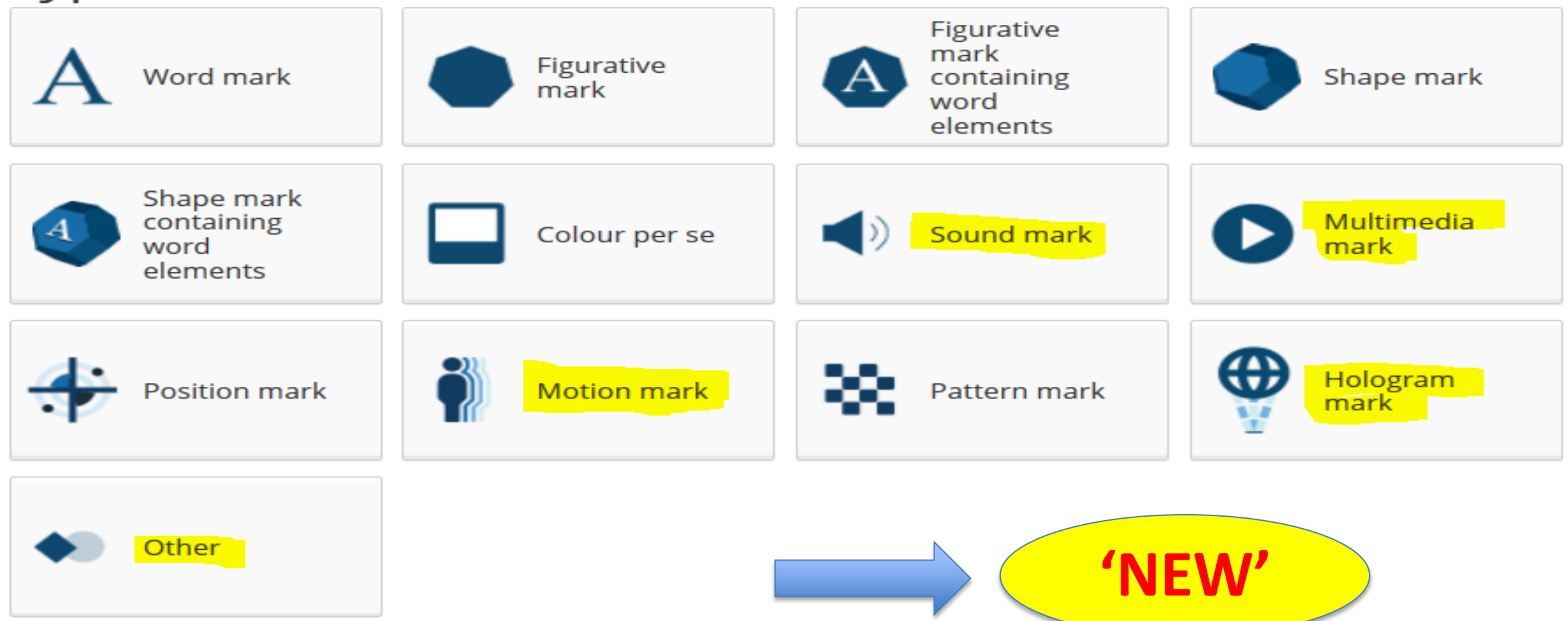
Art. 3(1) of Regulation (EU) 2018/626 (EUTMIR)

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.

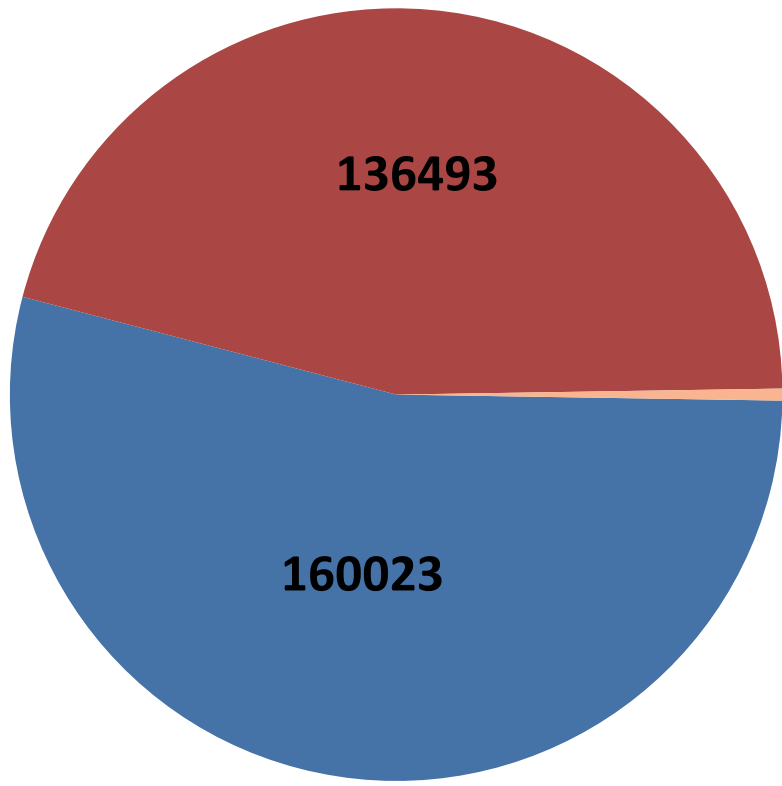
WYSIWYG – What You See Is What You Get

'Types' of trade marks

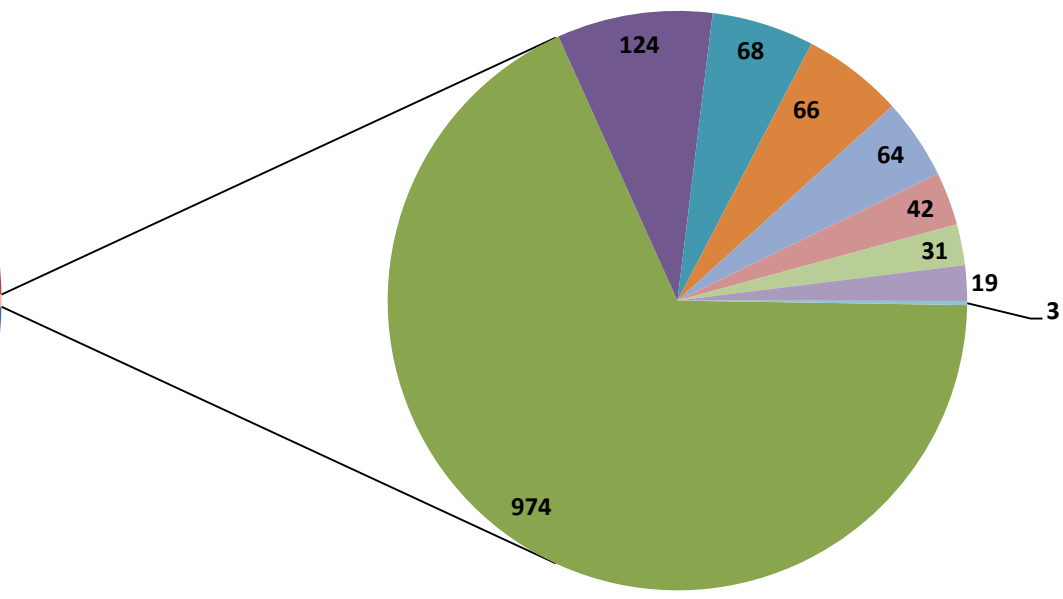


Volumes 01.10.2017 – 04.09.2019

297.907

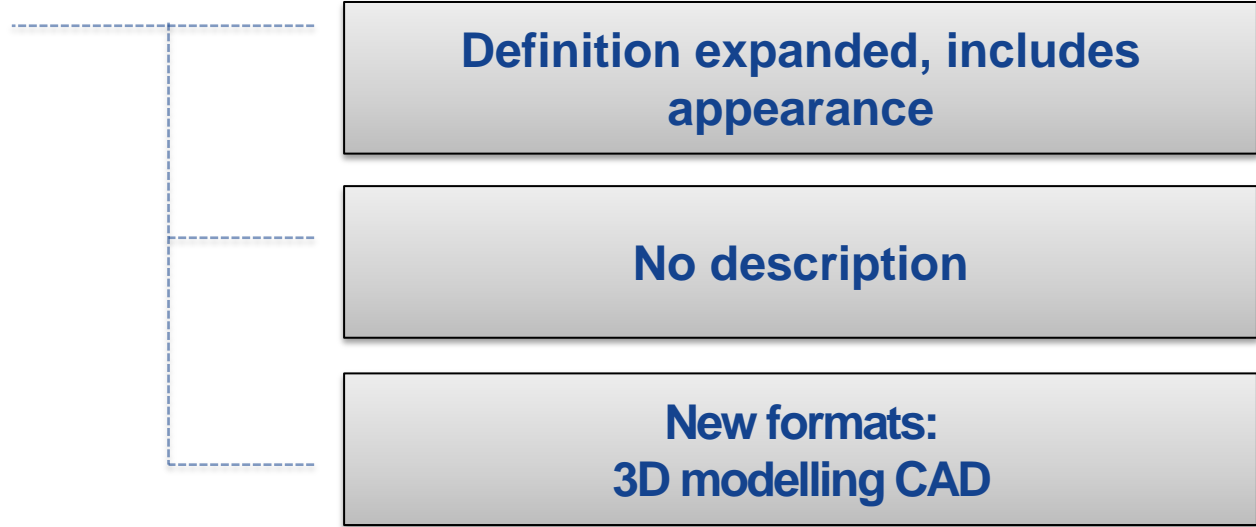
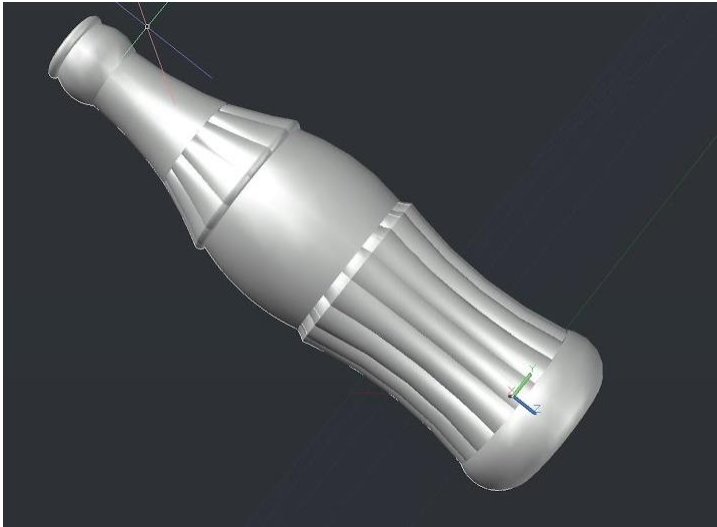


1.391



Article 3(3)(c) EUTMIR – Shape mark

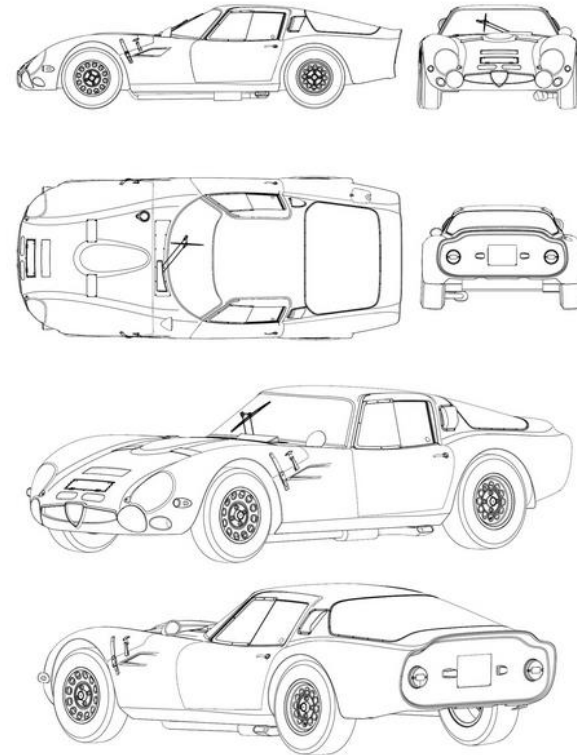
Shape



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



EUTM 17 670 142
Classes: 33
Status: **Registered**



REFUSED

EUTM 17 788 886
Classes: 12, 28
Status: **Refused** (lack of distinctiveness)
Appeal pending

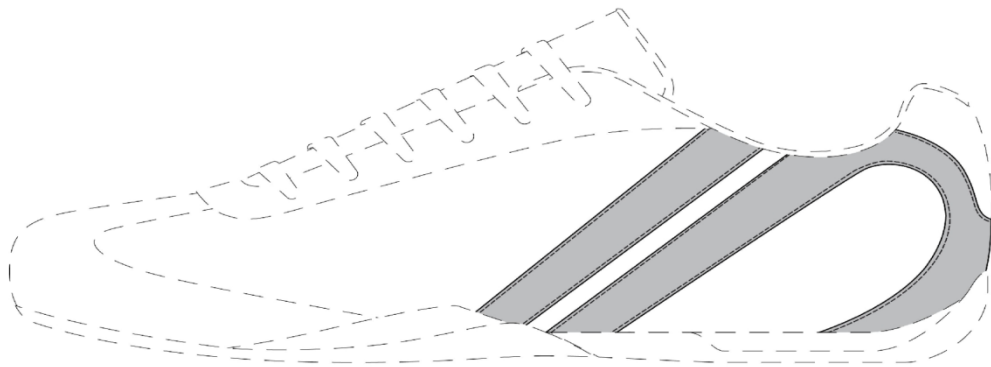
Article 3(3)(c) EUTMIR – Shape mark: REGISTERED



EUTM 17 754 284
Classes: 4, 35, 36, 37, 39, 43
Status: **Registered**

Article 3(3)(d) EUTMIR - Position mark

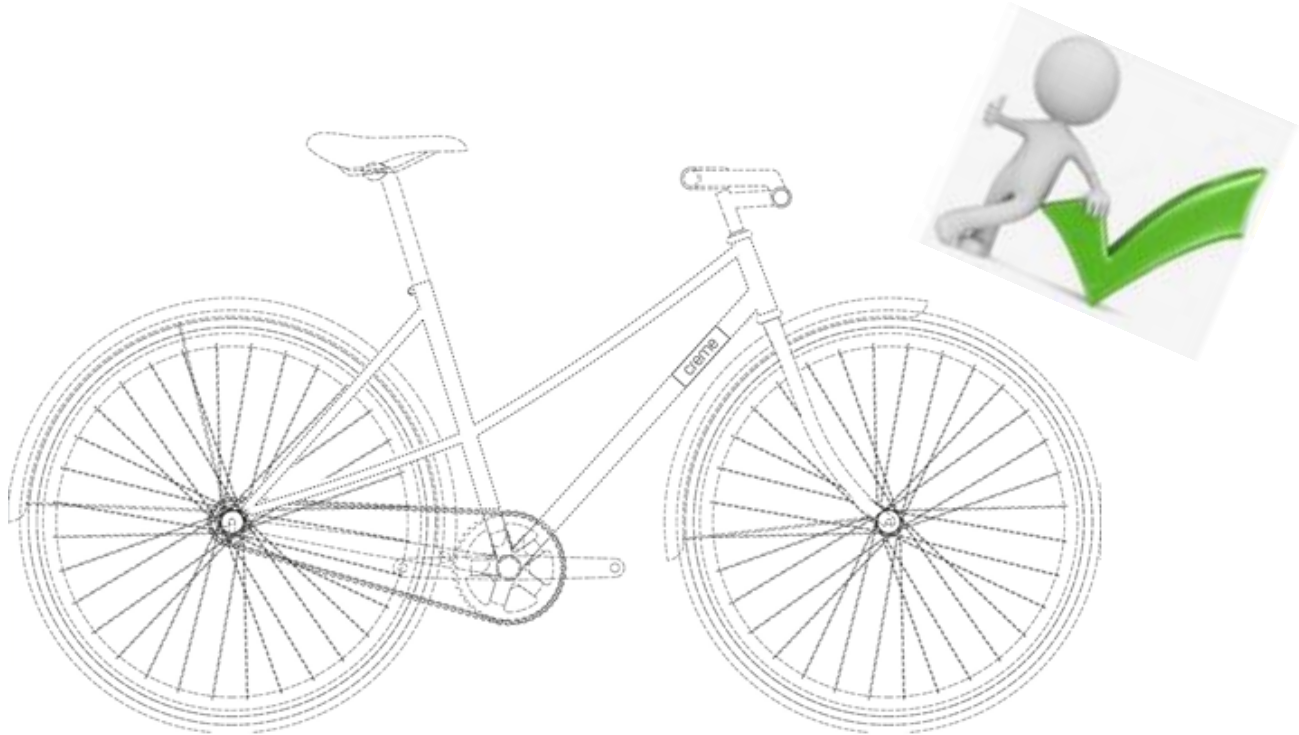
Position



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



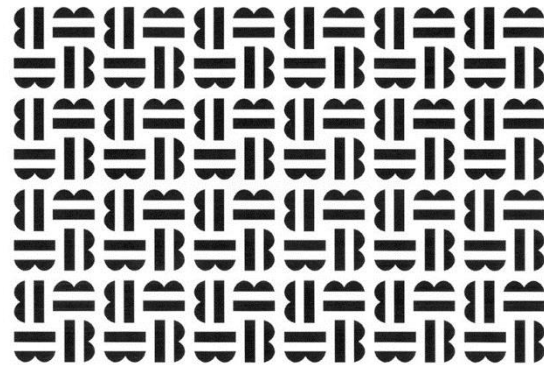
EUTM 17 366 634
Classes: 12
Status: **Registered**



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)

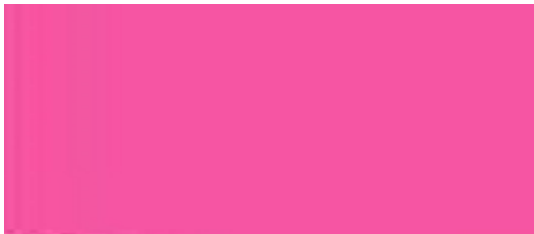
Article 3(3)(e) EUTMIR - Pattern mark: **OBJECTED. WITHDRAWN**



EUTM 17 427 386
Classes: 18, 24, 25
Status: **Objected.**
Withdrawn

Article 3(3)(f) EUTMIR - Colour mark

Colour



Indication of recognised colour codes compulsory

The reproduction must show the **systematic arrangement**

A description may detail the systematic arrangement further

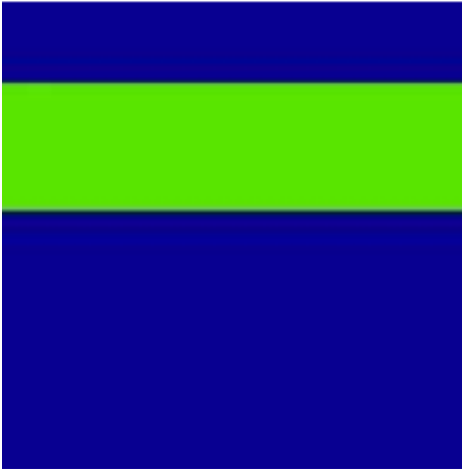
Systematic Arrangement of Colour Combinations



Example 1



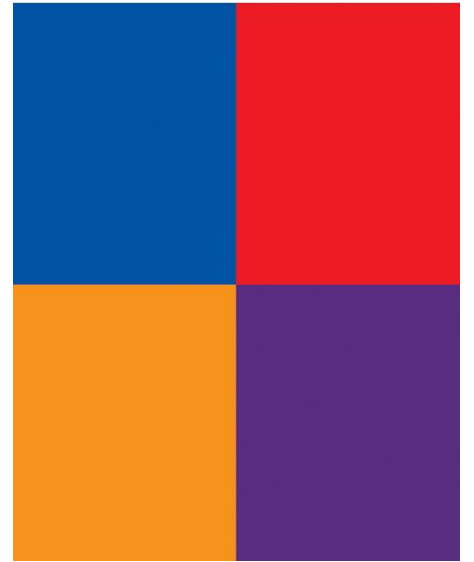
Example 2



Example 3



Example 4



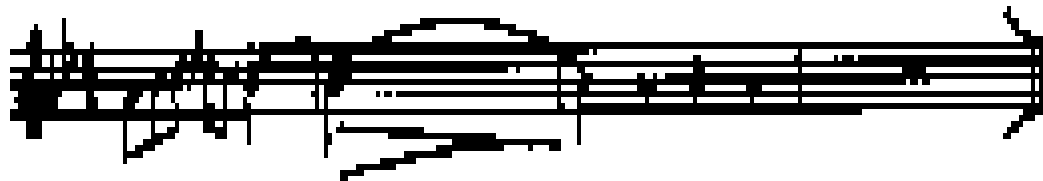
Example 5
Objected for
candy

Article 3(3)(g) EUTMIR – Sound mark

Sound



EUTM 7 214 083
Classes: 12, 35, 38
Status: Registered



Audio file
or

Musical notation

No description

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’**



Article 3(3)(g) EUTMIR – Sound mark: UNDER APPEAL

EUTM 17 912 475



APPEAL

R 0530/2019-1

Classes: 6, 29, 30, 32, 33 (all related to ‘beverages, drinks’)

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

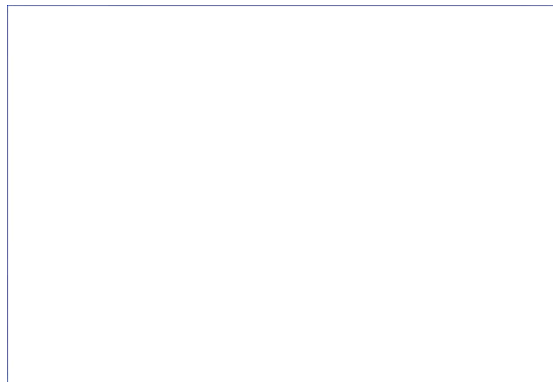
- ‘sound that one hears when opening cans of effervescent drinks (which will be associated also in case of non-carbonated drinks)’

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

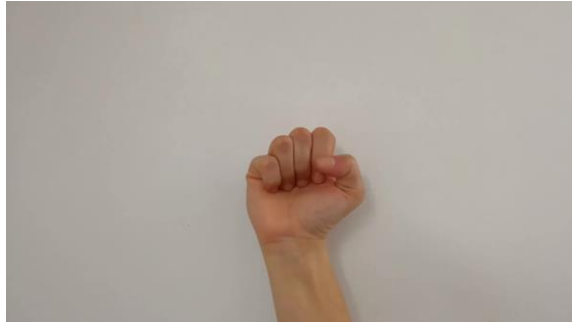
Motion



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).



**WIN
WIN**

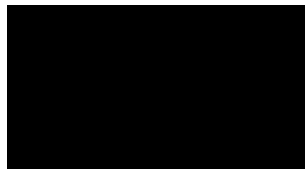
EUTM 17 894 400

Classes: 9, 16, 35, 41 (software, advertising, marketing and promotional services).

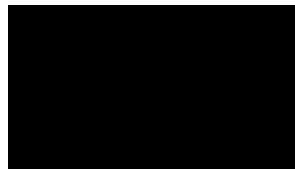


Article 3(3)(h) EUTMIR – Motion mark: REFUSED

EUTM 17 280 215



EUTM 17 280 249



EUTM 17 280 264



EUTM 17 280 281



REFUSED

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**

REFUSED

Article 3(3)(i) EUTMIR - Multimedia mark

Multimedia



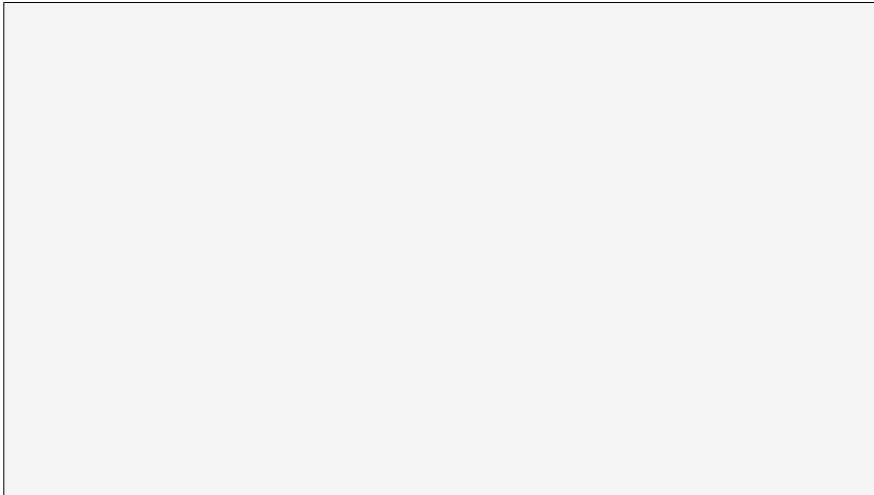
EUTM 17 868 267
Classes: 35, 38, 42, 45
Status: **Registered**



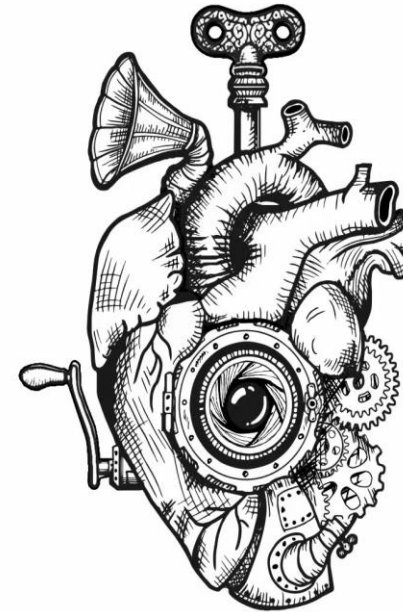
Audio-visual file
(MP4 format, max 8 000 Kbps, 20 MB)

No description

Article 3(3)(i) EUTMIR - Multimedia mark: REGISTERED



EUTM No 17941596
Class 25



EUTM 17 279 704
Class 45

Article 3(3)(i) EUTMIR - Multimedia mark: APPEAL PENDING

EUTM 17889338

R-2024/2018-5



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’**

REFUSED

APPEAL

Article 3(3)(i) EUTMIR - Multimedia mark: APPEAL PENDING

EUTM 17 931 246



R-0803/2019-4

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 character’**

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

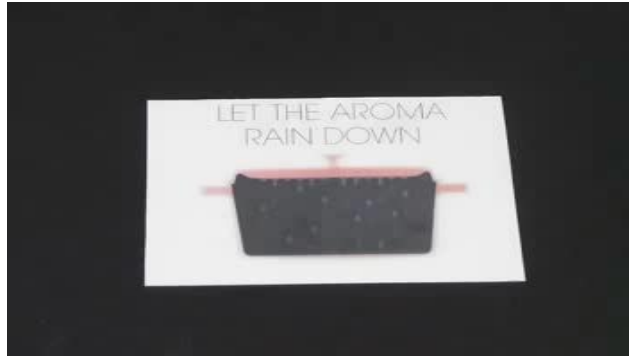
Hologram



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)

“OTHER” MARKS



Smell?

Taste?

Texture?

Samples not acceptable

(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



EUTM 17 932 932

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**


OPPOSITIONS AGAINST 'NEW' TYPES'

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**


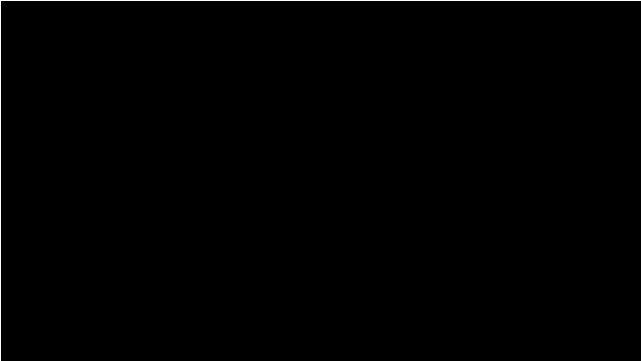
OPPOSITIONS AGAINST 'NEW' TYPES': some examples

B 3059889 and B 3058800

Earlier Rights	Contested EUTM 17906814
<p>AUDI</p>  <p>AUDITEL</p>	

OPPOSITIONS AGAINST 'NEW' TYPES'

B 3071595

Earlier UK Trademark	EUTMA 17961198
 <p data-bbox="560 1135 955 1178">9, 16, 28, 35, 38, 41</p>	 <p data-bbox="1337 1135 2331 1185">9, 28, 41 (<i>software, game machines, online gaming</i>)</p>



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Thank you

Means of Representation

**OPTION 1:
ABSTRACT ARRANGEMENT
WITHOUT DESCRIPTION**



**OPTION 3:
ADD
DESCRIPTION**



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



C-124/18 P, Blue and Silver



- **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).