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Benelux Office for
**Intellectual
Property**

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New types of trademarks

Webinar, 7 December 2021

Ellen Gevers

Pieter Veeze

Agenda

	<p>Introduction BOIP's practice (Pieter)</p> <ul style="list-style-type: none">- Technical aspects- Convergence- Experiences so far...	
	<p>Introduction user's perspective (Ellen)</p> <ul style="list-style-type: none">- Trademark Qualification- New criterion: Lasting Impression- Excluded marks – Substantial Value- Similarity assessment	
	<p>Examples and discussion</p>	



But first ... a warming-up question



Is this a valid sound mark for:

- A. Bicycles
- B. Delivery services
- C. Insurance services
- D. Funeral services
- E. None of the above

You can tick more than one box.

At the end of the webinar, we will repeat these questions, to see if Ellen and I have influenced your opinion.



What is really new?

Definition of a TM (Art 2.1 BCIP – 3 TMD – 4 EUTMR)

any signs [...] that are capable of:

a. **distinguishing** the goods or services of one undertaking from those of other undertakings; and

b. being **represented on the register** in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection [...]

Before TM package: **all signs** that can be **represented graphically** and that serve to **distinguish** the goods or services of an undertaking



Case law before TM package

Focus on representation (ECJ C-273/00, SIECKMANN)

a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective

(quoted in preamble/considerans, the article itself uses IP-Translator terminology: clear and precise)



After TM package

More room to focus on what can be a trademark (**or not**)



a. signs which cannot constitute a trademark

b. trademarks which are **devoid of any distinctive character**

c. trademarks which [are descriptive]

e. signs which consist exclusively of:

i. the shape, or another characteristic, which results from the nature of the goods themselves;

ii. the shape, or another characteristic, of goods which is necessary to obtain a technical result;

iii. the shape, or another characteristic, which gives substantial value to the goods;



Distinctive (or not)?

First instinct: what goes for shapes and colours, goes for all non-traditional TMs: criteria the same, but perception of public differs.. not in the habit of perceiving other signs than wordmarks / logos as TMs.

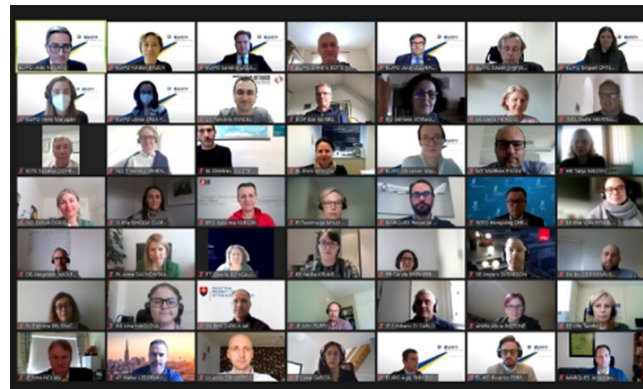
NO, UNLESS... (significant departure from the norm...).

Second thought: are all non-traditional TMs comparable to shapes & colours (often elements of goods)? Did the public perception evolve in time (f.i. due to new media)?

YES, UNLESS...???



We don't know! What to do?



Convergence.....



Common Communication (2018)

Formal and technical issues:
Types, definitions, file types...



Sound mark

A sound mark consists exclusively of a sound or a combination of sounds. It can be submitted as an audio file reproducing the sound or by an accurate representation of the sound in musical notation.



Word mark

A word mark consists only of words, letters, numbers or any other characters that can be typed.



Figurative mark

A figurative mark consists only of an image. A figurative mark does not contain text (letters, numbers or other characters).



Figurative mark with word elements

A figurative mark containing word elements consists of an image with text. Select this type of mark also if the text has a certain layout (font, colour, foreign characters).



Shape mark

A shape mark consists of an image of a shape in 3D, such as the actual product or its packaging.



Shape mark with word elements

A shape mark with word elements consists of an image which combines the use of a 3D shape with text.



Colour mark

A colour mark consists of an image which contains of one or more colours without contours. Do not confuse this with a figurative mark in colour.



Sound mark

A sound mark consists exclusively of a sound or a combination of sounds. It can be submitted as an audio file reproducing the sound or by an accurate representation of the sound in musical notation.



Position mark

A position mark consists of the specific way in which the mark is placed or affixed on the goods.



Multimedia mark

A multimedia mark consists, or extends to, the combinations of images and sound.



Hologram mark

A hologram mark consists of elements with holographic characteristics.



Motion mark

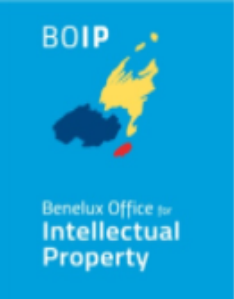
A motion mark consists of, or extends to, a movement or a change in the position of the elements of a mark.



Pattern mark

A pattern mark consists exclusively of a set of elements which are repeated regularly.

Other



CP11 (April 2021)



Formalities (filing, priority...)

Absolute grounds

Relative grounds



Common Communication
(85 pages, lots of examples):

boip.int / tmdn.org



CP11. New Types of Marks:
examination of Formal
Requirements and Grounds for
Refusal

Download

More info

CP11: what about distinctiveness?

Non-traditional marks \neq colours or shapes

But also not words or logos

Public perceptions varies for different TM types:

- ~~Does it depart significantly from the norm?~~
- Does it create a lasting impression? (memorable)
- Is it capable of being recognised as an indication of commercial origin?

YES/NO, UNLESS...



CP11: what about distinctiveness?

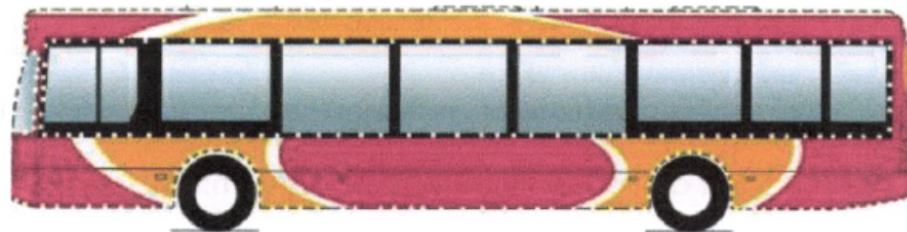
Example:



"With regard to multimedia marks, there is an increase in the number of signs combining image and sound used as part of branding strategies, therefore consumers are more likely to perceive them as indications of commercial origin."



Recent case law



ECJ 8 Oct 2020, C-456/19 (position mark)

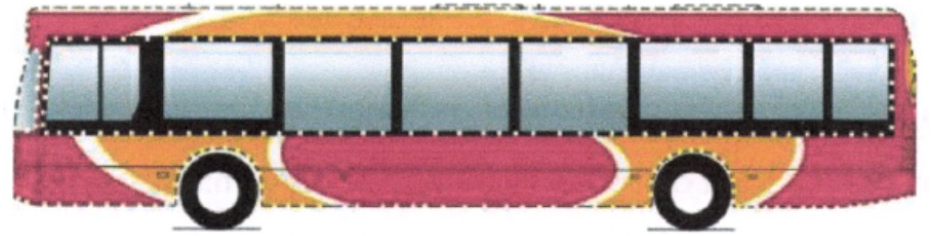


“As is clear from the settled case-law of the Court, the criterion for assessment of whether there is a significant departure from the norm or customs of the economic sector concerned applies where the sign consists of the shape of the product for which registration as a trademark is sought, average consumers not being in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element.”





Recent case law

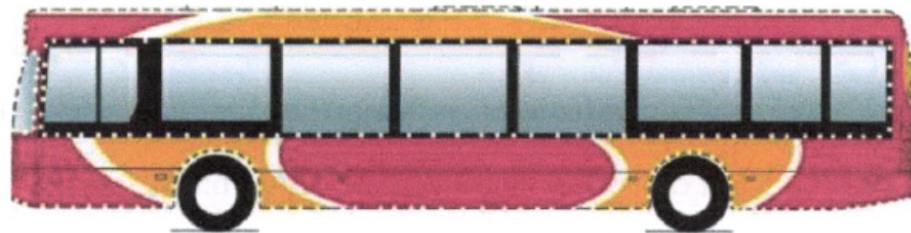


“That criterion for assessment also applies where the sign consists of the representation of the layout of the physical space in which the services in respect of which registration as a trademark is sought are provided (see Apple, C-421/13).”





Recent case law



“Such a situation does not arise [when] the signs at issue consist of graphic elements intended to be affixed to goods which are used to provide the services designated by the application for registration.”

“the distinctive character [...] must be assessed by taking into account the perception of the relevant public of the affixing of that sign to those goods, without it being necessary to examine whether that sign departs significantly from the norm or customs of the economic sector concerned.”



Recent case law



GC 7 July 2021, T-668/19 (sound mark)



“A three-dimensional mark consisting of the appearance of the goods themselves or of their packaging is not necessarily perceived by the average consumer in the same way as a word, figurative or sound mark which consists of a sign which is independent of the appearance or the shape of the goods”

“Therefore, [...] the Board of Appeal erred in applying the criterion of determining whether the mark applied for 'departs significantly' from the norm or customs of the relevant sector.”
(translation PV)



Recent case law



Appeal rejected because:



“The Board of Appeal also stated [...] that, in order to be registered as a trademark, a sound must have a certain resonance or recognisability so that the consumers concerned may perceive it as an indication of origin and not merely as a functional element or as an indication without a message”



Comp ECJ C-398/08 (Vorsprung durch Technik):

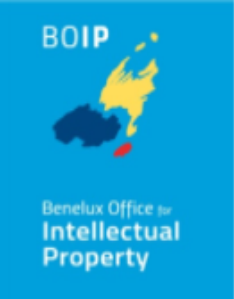
“...that slogan exhibits a certain originality and resonance which makes it easy to remember.”



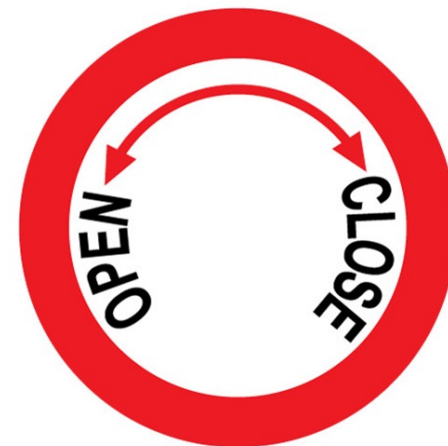
How to assess distinctiveness?

I	What is claimed?	<ol style="list-style-type: none"> 1. Representation 2. Type 3. Description 	
II	<p>Public's perception of the sign</p> <p>In the habit of perceiving it as badge of origin for G/S concerned?</p>		
	<p>YES</p> <p>Word/device...</p>	<p>YES/NO</p> <p>Sound, multimedia, pattern, position...</p>	<p>NO</p> <p>Colours per se, 3D...</p>
III	<p>Lasting impression</p> <p>Certain resonance, memorable..</p>	<p>Significant departure</p> <p>Highly unusual..</p>	





(preliminary) conclusion



CP11 seems in line with case law
Popularity is still limited



Example multimedia marks (since 2019/03):

BOIP 8 (+/- 0.013%)

EU IPO 43 (+/- 0.011%)



TMview

Offices: BX Territories: BE, LU, NL Trade mark type: Multimedia

Offices	Graphic representation	Trade mark name	Application date
<input type="checkbox"/> Benelux-BOIP (8)	<input type="checkbox"/>		06/11/2020
<input type="checkbox"/> Goods and Services	<input type="checkbox"/>	A ALDI	24/09/2019

TMview

Offices: EM Territories: AT, BE, BG, HR, CY, CZ, DK, EE, FI, FR, DE, GR, HU, IE, IT, LV, LT, LU, MT, NL, PL, PT, RO, SK, SI, ES, SE Application date: 2019-03-01 - 2021-1

Offices	Graphic representation	Trade mark name	Application date
<input type="checkbox"/> EU IPO-EUIPO (43)	<input type="checkbox"/>		12/11/2019
<input type="checkbox"/> Goods and Services	<input type="checkbox"/>		21/07/2020



Question 2



Do you see an added value for the multimedia mark compared to the above figurative mark?

A. Yes

B. No

(multimedia mark: EUTM 018135813)



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User's perspective...





All Types of 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



Trademark type selection

Identification of correct TM type is a legal requirement

- art. 2.1 BCIP & Rule 1.1 (e) Implementing Regulations (IP)



If representation and description of TM type do not match:

- Representation prevails, but
- Subject matter and scope of the protection must be clear
 - Hartwall CJEU 27 March 2019, C-578/17



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Trade mark information

Name	(Trade mark without text)	Filing date	30/05/2019
Filing number	018074168	Registration date	
Basis	EUTM	Expiry date	
Date of receipt	30/05/2019	Designation date	
Type	Colour	Filing language	German
Nature	Individual	Second language	English
Nice classes	7 (Nice Classification)	Application reference	19897TM_EU_Re
Vienna Classification	15.01.01, 98.04 (Vienna Classification)	Trade mark status	Application under examination
		Acquired distinctiveness	No



Colour mark or Position mark

Graphic representation





Trade mark information

Name	(Trade mark without text)	Filing date	20/11/2019
Filing number	018103614	Registration date	10/09/2020
Basis	EUTM	Expiry date	20/11/2029
Date of receipt	05/08/2019	Designation date	
Type	Colour	Filing language	German
Nature	Individual	Second language	English
Nice classes	9, 35 (Nice Classification)	Application reference	WER6004EU
Vienna Classification	29.01.02, 29.01.08, 29.01.12, 98.10 (Vienna Classification)	Trade mark status	Registered 
		Acquired distinctiveness	No

Colour mark or Pattern mark

Graphic representation

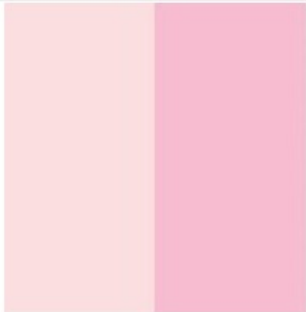


WIPO not up to speed with 'new TM types'

Non-traditional TM owners often have international aspirations

- Filing strategy for Europe:
 - BX base for IR designating EUTM, UK, Norway, Switzerland
- Problem:
 - Position mark & Pattern mark not available @ WIPO
- Solution for EUTM:
 - Add description to indicate TM type/subject matter
 - EUIPO selects matching type
 - Applicant may object/appeal




540	Mark
	
531	International Classification of the Figurative Elements of Marks (Vienna Classification) - VCL(8) 25.05 ; 29.01
591	Information concerning colors claimed The color(s) dark pink and light pink is/are claimed as a feature of the mark. The mark consists of a repetitive stripe design containing alternating bands of the color pink, a darker shade of pink and a lighter shade of pink.
571	Description of the mark The mark consists of a repetitive stripe design containing alternating bands of the color pink, a darker shade of pink and a lighter shade of pink.

- Description: The mark consist of a repetitive stripe design containing alternating bands of pink,...





Trade mark information

Name	(Trade mark without text)	Filing date	
Filing number	1536742A	Registration date	20/04/2020
Basis	IR (Search on WIPO database)	Expiry date	20/04/2030
Date of receipt	01/03/2021	Designation date	20/04/2020
Type	Pattern	Filing language	English
Nature	Individual	Second language	French
Nice classes	35 (Nice Classification)	Application reference	39604.229
Vienna Classification	25.05, 29.01 (Vienna Classification)	Trade mark status	IR accepted 
		Acquired distinctiveness	No

EUIPO

Graphic representation





International Sound marks

1 $\text{♩} = 144$

Flute

Clarinet in B \flat

Horn in F 1

Horn in F 2

Trumpet in C

Piano

Violin I

Violin II

Viola

Violoncello

Contrabass

WIPO facilitates 'Sound mark' qualification

- Representation: MP3's not accepted
- BX as base for IR: mandatory use of Musical notation

Options for EUTM:

- Designation EUTM in IR (musical notation); or
- 'Stand alone' application at EUIPO with MP3
 - With Priority claim from prior BX application (despite other representation)



Consequences abroad

Does Musical notation provide right to a Sound mark?

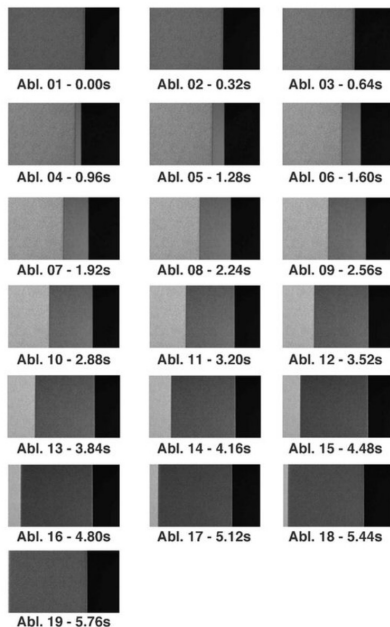
Yes	Colombia, Indonesia, Israel, Macedonia, Montenegro, Serbia, Switzerland, Ukraine, United Kingdom
Yes if MP3 is filed after office action	Australia, China, India, Japan, Malaysia, Mexico, New Zealand, Norway, Russia, Singapore, South Korea, Thailand, Turkey
No, it's a logo	Canada





WIPO not up to speed with 'new TM types'

Graphic representation



Motion mark, Multimedia mark & Hologram mark:

- Type & MP4 not available at WIPO
- Motion mark (& Hologram mark):
 - Frame Sequence representation
- Multimedia mark:
 - Cannot be registered via WIPO
 - Animated logos are the future:
Call to action for WIPO





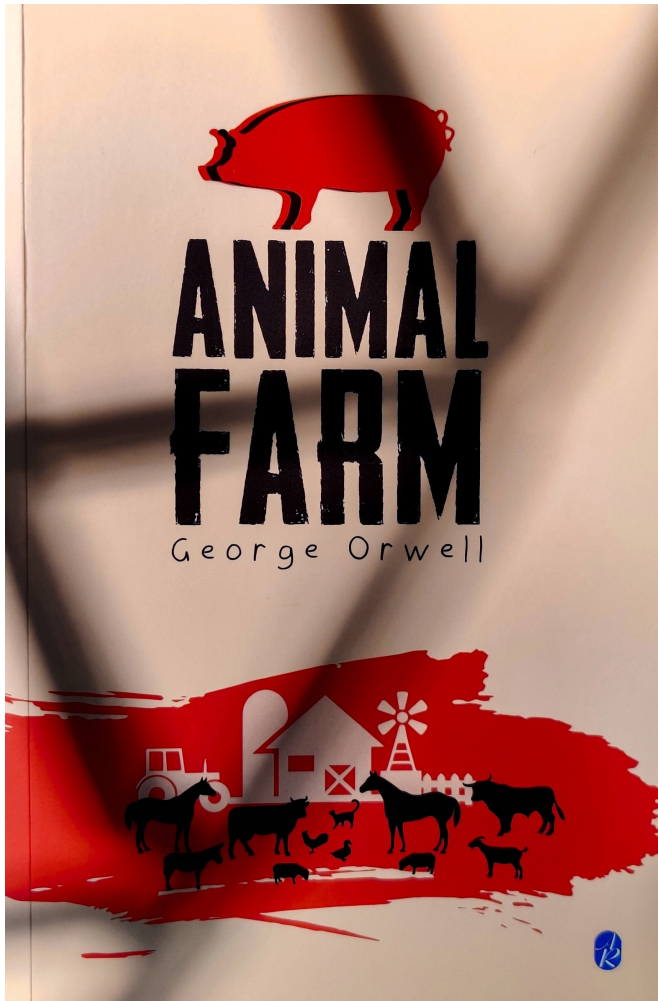
Absolute Grounds - Distinctiveness



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All trademark types are assessed equal, but some are perceived more equal than others.



Old: 'Significant Departure'

The same criteria apply to all TM types,
but some types are not perceived by the public as indications of origin



EU Courts created a 'tool' to 'establish' perception of the public:

- For 3D shape mark: must depart significantly from the norm in the sector.
- Replaces actual assessment of the perception of the public:
 - Swedish Court in Östgötatrafiken case:
 - evidence insufficient to show significant departure from the norm > therefore not perceived by the relevant public as an indication of origin.

Result: 'Tool' becomes 'independent criterion'



New: 'Lasting Impression'

CP 11 shows a shift in twofold:

1. Perspective of public shifted: The public is more used to non-traditional trademarks as indication of origin
2. '*Significant Departure*' replaced by '*Lasting Impression*'
Lasting impression may be the result from smaller departure?

Exit *Significant Departure* criterion confirmed by European Courts

- For Sound marks: Hiss sound (GC 7 July 2021, T-668/19)
- For (some) Position marks: Östgötatrafiken (CJEU 8 October 2020, C456/19)



Question 3: Should the Significant Departure criterion be applied to the new types of TM's

- Do you believe that the *Significant Departure* criterion, as developed in case law for 3D marks, should apply to position, sound, motion, multimedia and hologram marks?
 - a. Yes
 - b. Yes, depending on the subject matter of the application
 - c. No, replaced by 'lasting impression' criterion



What is a Position Mark

Trademark Types

Device mark
Pattern mark
3D product mark
Colour per se mark

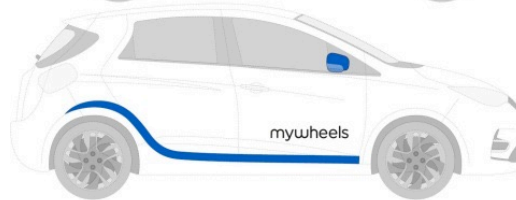
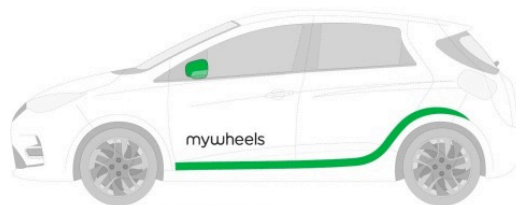
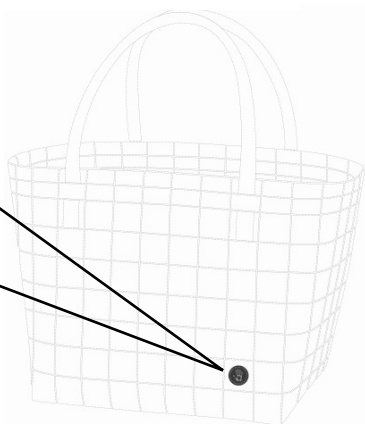
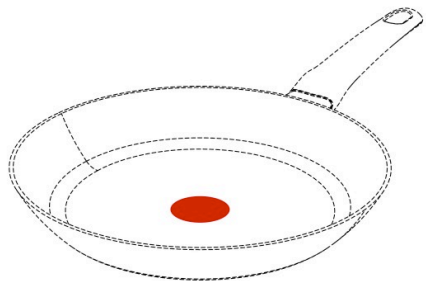
Position marks

Device mark on product
Pattern applied to product
Element on product, excl. shape
Colour on product





Benelux Position marks



Assessment of Position Mark

Trademark Types

Device mark



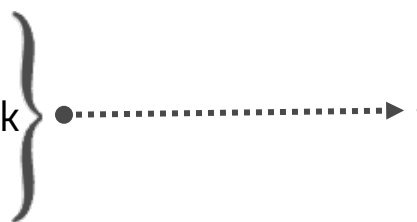
Position marks

Device mark on product

Pattern mark

3D product mark

Colour per se



Pattern applied to (part of) product

Element(s) on product, excl. shape

Colour on (part of) product

Significant departure



Lasting impression



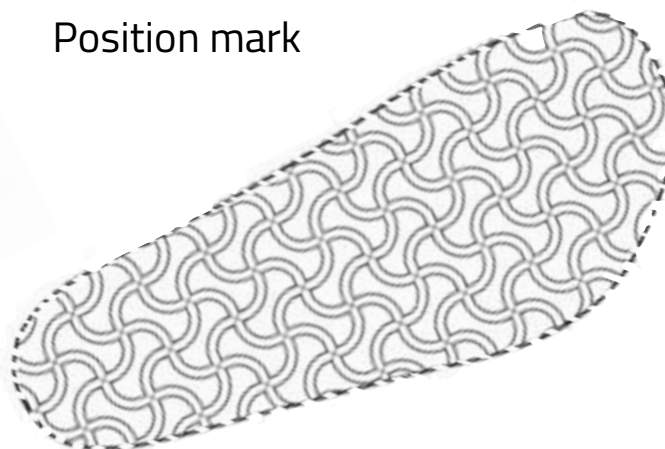


Assessment of Position Mark

3D mark



Position mark



Significant departure



Lasting impression



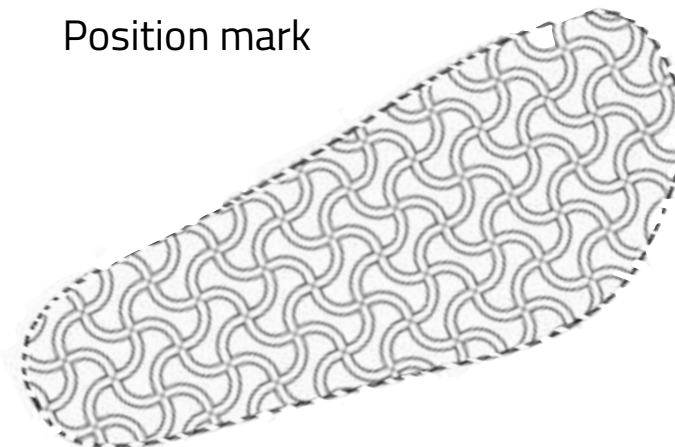
Birkenstock, what if...

CJEU 13 September 2018 C-26/17P

Pattern mark



Position mark



Significant departure



Lasting impression



Question 4: Birkenstock, what if...

- Do you believe that the Birkenstock pattern has a better chance of being accepted for registration if filed as a Position Mark?
 - a. Yes
 - b. Yes, but only a very slightly better chance
 - c. No





Colour per se



- Registering Colour per se:
CJEU 6 May 2003, C-104/01, Libertel
 - Freihaltebedürfnis
 - Distinctiveness without prior use inconceivable,
 - Save in exceptional circumstances
-
- BX 1450348 of 17 September 2021
 - Colour : MAGENTA (RAL 4010 Telemagenta)



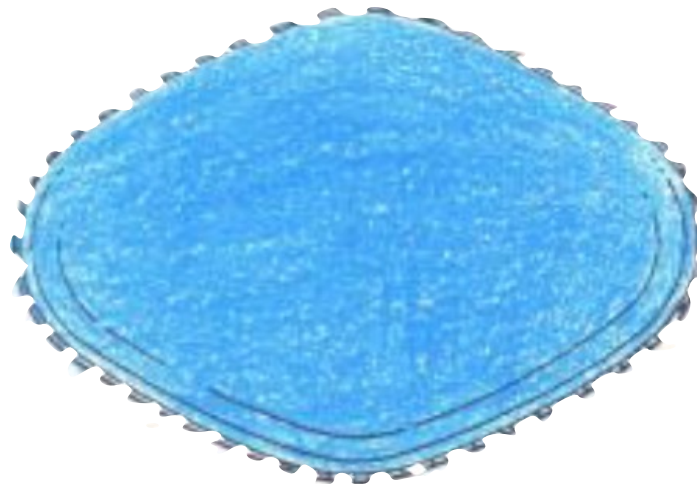


Colour Position mark: colour mark 'light'





Colour Position mark: colour mark 'light'





Absolute Grounds – Excluded marks



Exclusion grounds

Exclusion of marks: Nature of goods, technical result and Substantial Value

New TM types prone to assessment under exclusion grounds:

- Sound of tires for electrical car to warn pedestrians: Nature of the goods exception
- Camouflage pattern applied to clothing: Technical result
- Musical sound for doorbell: Substantial Value



Gömböc decision

CJEU 23 April 2020; C-237/19

Substantial Value Exclusion ground first extended:

- Design is very important in consumer's choice
(Bang & Olufsen decision GvEA 6 oktober 2011, T-508/08)
- Substantial value: both aesthetic value & functional values
(Hauck/Stokke (CJEU 18 September 2014, C-205/13))

Gömböc: Substantial Value Exclusion limited for aesthetic value:

- Intrinsic aesthetics only, exclude brand value
- Only applies if registration (monopoly) of aesthetics distorts competition
- Based on objective and reliable evidence
 - Burden of proof: BOIP?





Relative Grounds



Similarity assessment

Only CP11 > No Case law



Some main findings:

- Comparison perspectives: Visual; Aural, Conceptual

Main perspective depends on type of mark:

- Sound mark: Aural comparison key; visual comparison impossible
- Motion mark: Visual comparison key; Aural only if contains verbal element
- Conceptual comparison for all marks that convey a concept



Comparing different types

Similarity across different types

- Overlapping distinctive (verbal / figurative) element > similarity
- Overlapping striking and distinctive movement / melody > similarity,
 - despite differing elements, such as verbal elements.



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Conclusions



Conclusions

BOIP seems lenient in assessment of New TM Types

- Sound marks: 7 applied > 0 refused
- Motion marks: 6 applied > 0 refused
- Multimedia marks: 9 applied > 1 refused (*for being too long*)



Unused potential: Motion/Multimedia marks

- Registration of Animated logos
- Every brand has an app
- Many apps show an animated logo on start-up screen
- Few distinctiveness issues expected



One type left: *Other*

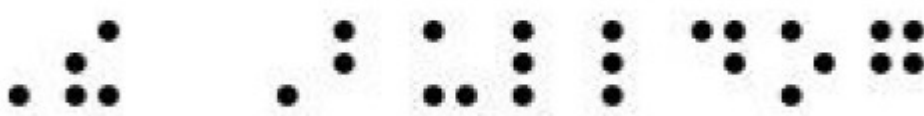


Future use

- Olfactory / Smell marks
- Taste marks
- Tactile / Touch marks



One type left: *Other*



- BX 1428720 of 5 November 2020
- Description: The trademark consists of the name The Bulldog in English Braille



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Q&A

Discussion, questions, answers...



Did you change your mind...?



Is this a valid sound mark for:

- A. Bicycles
- B. Delivery services
- C. Insurance services
- D. Funeral services
- E. None of the above

You can tick more than one box.



Thank you for joining!

- Next week:
Annual overview of opposition and cancellation cases
(Eline Schiebroek / Pieter Veeze)
- PE Points
 - Confirmation e-mail
 - Code word (BMM)
- Survey, please fill it out
- BOIP is hiring, check our website!



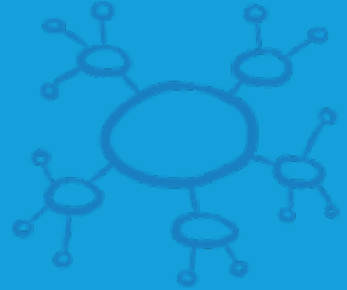
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Trademarks
Intellectual Patents
Property Designs
Copyright Ideas



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