Non-Traditional Trade Marks: Past Practice and a Look to the Future

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INTRODUCTION

The protection of trade marks in Europe has become two tiered. In the first tier are traditional marks such as logos and names that can easily be registered in the EU Intellectual Property Office (EUIPO) thereby granting them protection across the EU. In the second tier are so called “non-traditional marks”. There are a number of reasons why it is so difficult to register non-traditional marks but perhaps the most notable are the Sieckmann seven which lays down a set of criteria that must be met in order to constitute adequate graphical representation. While reform has been introduced to remove the need for graphical representation, the Sieckmann seven have been expressly maintained. It is the view of this author, in common with Fields and Muller, that these reforms may, when considered holistically, actually make it harder to register certain non-traditional marks, especially scents.

The purpose of this paper is to critique the protection that is afforded to non-traditional marks and highlight how it is inadequate. The view taken is shared with Wiszniewska who has pointed out that, “[while] the registration of the olfactory trade mark has not been forbidden either by the Directive or by The Trade Mark

Act, it is nowadays practically impossible." The authorities have struggled with non-traditional marks because, in part, they are rooted to the idea of a “paper paradigm”. This notion must be abandoned, or other avenues pursued, before non-traditional marks can be adequately protected.

The structure of this paper is as follows: first, the particular requirements in trade mark law that have presented difficulties for non-traditional marks shall be highlighted. Second the proposed and implemented changes to this regime are discussed. Third this paper shows that a number of problems remain for the protection of non-traditional marks. Finally, the alternatives to trade mark protection are considered.

I. THE REQUIREMENTS

There are a number of requirements that must be met in order to register a trade mark in the EU. However this paper will focus on those requirements that place a heavier burden on non-traditional marks as opposed to traditional marks.

A. Graphical Representation

One of the most difficult requirements for non-traditional marks to fulfil has been the need to be graphically represented. The law currently in force says that a trade mark that can be registered may consist of:

any sign 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 services of one undertaking from those of other undertakings [emphasis added].

This requirement has become more difficult to satisfy for marks that are not normally perceived on paper because of the way that it has been interpreted by

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5 See Section IV.B.
the case law, in particular Sieckmann v Deutsches Patent- und Markenamt. In this case Mr Sieckmann attempted to register a scent that was “balsamically fruity with a slight hint of cinnamon”. He also deposited a sample of the smell and gave the chemical formula. The first question for the court was whether it was possible for a non-traditional mark to be registered. The problem derived from the fact that all the examples given in Article 2 of the Trade Marks Directive (“words, including personal names, designs, letters, numerals, the shape of goods or of their packaging”) are capable of being perceived visually. To take the example of a logo, the logo that is put on the registration form is perceived in exactly the same way when it is used as a trade mark. By contrast, when a sound is registered by way of a musical stave, the perception of it on the paper is very different to the perception of a consumer when the trade mark is used. Therefore, so it was argued in Sieckmann, registration should be refused for those marks that cannot be perceived visually.

This argument was summarily rejected by the court who held that:

The Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically.

The fact that all the marks referred to in the text were capable of being perceived visually was held to be a coincidence and the drafters had simply intended to use them as examples of marks that could be registered without suggesting any further conclusion. However, the court went on to hold that a graphical representation of a mark must be:

- Clear;
- Precise;
- Self-contained;
- Easily accessible;
- Intelligible;
- Durable; and
- Objective.

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8 Case C-273/00 Sieckmann v Deutsches Patent- und Markenamt [2003] Ch 487, [2003] 3 WLR 424. Hereinafter “Sieckmann”. It should be noted that while the requirement for graphical representation has been dropped, this jurisprudence has been expressly retained and so remains relevant. This is discussed further below at Section III.A.


10 ibid [44].

11 ibid [48]-[54].
These criteria are known as the *Sieckmann* seven.\(^{12}\) The decision in *Sieckmann* has created a problem for those wishing to register non-traditional marks because there now exists an inherent inequality in the law. As Sahin points out, “Non-traditional trade marks … continue to struggle to find a place in the current EU trade mark system… [because] … the current EU trade mark system is based on traditional trade marks, such as words, names, letters and logos.”\(^{13}\) A slogan, for example, automatically meets these criteria and many have been registered.\(^{14}\) By contrast, traders have struggled to find a way to represent scents in a way that meets these criteria. This leads to inequality because a scent is just as capable of functioning as a badge of origin.\(^{15}\) Non-traditional marks can create just as strong an emotional response in consumers as traditional marks can when acting as a badge of origin. As Perez puts it, “For some time, entrepreneurs and marketing experts have identified the potential offered by the sense of smell”.\(^{16}\) The *Sieckmann* seven operates as an extra hurdle for non-traditional marks such as scents and sounds for practical considerations rather than their ability to function as a badge of origin.\(^{17}\)

In particular, the way that the requirement for “easily accessible” has been interpreted is arbitrary and makes it unnecessarily difficult for non-traditional marks to be registered. The purveyor of the register is expected to be able to read music,\(^{18}\) and understand all of the international systems for the representation of colours\(^{19}\) but is not expected to be able to understand a chemical formula.\(^{20}\) Almost all GCSE students can understand a basic chemical formula but, as Bainbridge points out, many people cannot read music.\(^{21}\) Why then should the line for “easily accessible” be drawn here? The jurisprudence draws the line in an unhappy middle ground that achieves nothing. Either they should hold that the

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14 Case C-398/08 *Audi AG v Office for Harmonisation in the Internal Market* [2010] ECR I-00535.
18 Case T-408/15 *Globo Comunicação e Participações S/A (Globo) v EUIPO* EU:T:2016:468.
representation must be intelligible by anyone who reads the register, or they should accept that those registering trade marks invariably instruct experts and merely require that the representation be understandable by a qualified expert in the field.

In *Sieckmann* the Court of Justice of the EU (CJEU)22 seem to base their analysis of the “easily accessible” criteria on a person that has never smelt anything before.23 Such a person, so they held, would be unable to recognise the scent simply from looking at the chemical formula.24 This reasoning is applied haphazardly and in a way that favours traditional marks over non-traditional marks. A person that has never heard a musical note before will be similarly unable to recognise a musical stave. That does not appear to be an impediment for registering music in the case law.25 As Goulbourn argues, “It does seem anomalous that musical notes are accepted as a graphical representation of a sound mark on account of their ability to be understood by musicians, when chemical formulae are not permitted as an acceptable graphical representation of an olfactory mark.”26 This reasoning leads to arbitrary results and the CJEU should take the first opportunity to discard it.

Furthermore, it is wrong to attempt to impute perception like this.27 Someone who can smell will never know what it is like not to smell. It is strange to attempt to answer the unanswerable hypothetical question of what someone else can perceive. That is a question that has haunted philosophers for generations.28 Trade mark law is not the place to enter into a critique of the literature on the question. We should instead concentrate on people who can perceive smell and whether they would recognise the smell in question as a badge of origin. As Wiszniewska points out, “the ‘Sieckmann criteria’ are so rigorous that it seems almost impossible that any olfactory mark would ever meet such requirements, especially if the graphical representation by a chemical formula is precluded.”29 This is a considerable problem for traders in smell with Friedmann remarking that, “the significance of scent marks for marketeers (sic) can hardly be overestimated”.30

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22 For the sake of simplicity the European Court of Justice is referred to throughout as the CJEU.
24 ibid.
25 Case C-283/01 Shield Mark BV v Kist (t/a Memex) [2004] Ch 97, [2004] 2 WLR 1117.
is time, therefore, to liberalise these requirements in favour of the registration of non-traditional marks.

Sounds have also proved difficult. The leading case in the area is *Shield Mark*.\(^{31}\) In that case the Dutch Company Shield Mark BV tried to register, among other marks, the first nine notes of “Fur Elise” by Beethoven. The CJEU held that a sound can be registered provided that 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”.\(^{32}\) As Goulbourn points out, this ruling appears to go against the requirement that the graphical representation be self-contained.\(^{33}\) It would be impossible to read music properly without the help of someone properly trained in reading music.\(^{34}\) Again then we see that the Sieckmann seven have been applied inconsistently, making it almost impossible for trade mark owners to register non-traditional marks because of an inherent bias against such marks.

Furthermore, in *Edgar Rice Burroughs* the OHIM (Office for Harmonisation in the Internal Market) refused the registration of the Tarzan yell.\(^{35}\) In implementing the Sieckmann seven it was suggested that it is the perspective of the average person inspecting the register that matters and not someone with no skills at all.\(^{36}\) Again, this hypothetical person appears to have a particularly niche set of skills. The Board’s statement that, “many people can read musical notations” is unconvincing because it does not appear to be based on quantitative data, merely a hunch.\(^{37}\) Furthermore, their suggestion that, “Beethoven’s music has survived until today only in the form of scores” and that “nobody reads spectrograms for entertainment” smacks of conservatism that will not allow the law to develop to protect non-traditional marks.\(^{38}\) The problem is that some sound marks, like the Tarzan yell, cannot be transformed into a musical stave. The requirement of a stave discriminates against these marks.

In contrast to Goulbourn, this author suggests that there is no principled distinction between musical notation and a spectrogram.\(^{39}\) As McFarlane suggests, it is difficult to understand how the well known Tarzan yell can fail while the

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\(^{31}\) Case C-283/01 *Shield Mark BV v Kist (t/a Memex)* [2004] Ch 97, [2004] 2 WLR 1117.

\(^{32}\) ibid [64].


\(^{34}\) ibid [820].


\(^{36}\) Case R 708/2006 Edgar Rice Burroughs Inc (2007), [20]-[21].

\(^{37}\) ibid [34].

\(^{38}\) ibid [45].

ubiquitous Fur Elise is registrable. On first principles this seems to be the wrong way around. The Tarzan yell would, it is suggested, function as a much more accurate badge of origin among the general population. Furthermore, the enjoyment or otherwise of understanding the music, which the OHIM refer to, should be irrelevant. The question is not whether it can be enjoyed but whether it can be understood. There are sufficient problems of subjectivity in this area without introducing the concept of enjoyment.

The purpose of the Sieckmann seven and what they are trying to achieve has become unclear in the way that they have been applied. One of the main reasons for them should be to allow competitors to easily understand what it is that the registration will monopolise. As Goulbourn points out, however, it seems strange that a sound recording will not count as a sufficient graphical representation despite the fact that it is arguably more use to someone inspecting the register than is a spectrogram or musical stave. Perhaps it is felt that the problem with a spectrogram is that even a skilled specialist could not recreate the music from a spectrogram alone. It is therefore more difficult for a competitor to decide whether or not they wish to object to a registration that has been applied for. Despite this, the requirements have functioned to discriminate against non-traditional marks and so a liberalisation is needed of the Sieckmann seven.

B. Distinctiveness

Non-traditional marks also face a difficulty in showing that they are distinctive. There are two ways to show distinctiveness. Firstly, a mark might be inherently distinctive. Secondly it might have acquired distinctiveness. Sahin argues persuasively that non-traditional marks can never be inherently distinctive and so they will have to rely on the acquired distinctiveness provisions through extensive use. For example, as he points out, everyone has encountered all of the

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44 ibid [824].
45 Trade Marks Act 1994 s 1 and s 3(1)(b).
colours in their lifetime and so it is impossible for a brand to create a new one.\(^9\) This is in contrast to a brand name like “Exxon” which is inherently distinctive because it has no meaning in the English language and did not exist before it was invented to be a brand name. When a consumer sees the colour purple, who has never seen a Cadburys chocolate bar, it is difficult to see how they would instinctively know that it was from Cadburys.\(^{50}\) Non-traditional marks cannot be inherently distinctive because companies are simply taking something that already exists and using it in a different context. This makes it more difficult for non-traditional marks to be registered.

A good example of the problem with distinctiveness is demonstrated in \textit{Globo Comunicação e Participações S/A (Globo) v EUIPO}.\(^{51}\) In that case Globo attempted to register a sound that consisted only of two notes. While the result is correct, some of the reasoning is questionable. The court held that the music was too simplistic to be regarded as distinctive and that the average consumer would not recognise the nuances that were said to be apparent in the musical score. “Excessive simplicity” is not a problem that trade marks owners encounter when trying to register, for example, words. If a word has no other meaning it will be inherently distinctive regardless of how simple the word happens to be.\(^{52}\) It is suggested therefore that the case law in relation to sound marks is overly prescriptive. Some of the best and most original pieces of music are simple. If a composer commissioned by a company comes up with something that is genuinely distinctive there is no reason to stop its registration. This problem is further compounded by the fact that sound marks cannot be overly long.\(^{53}\) It is difficult to come up with music that is not too simply but yet is not more than a few bars long.

In the context of colours there is a particular issue for traders with regards to distinctiveness. In the leading case of \textit{Libertel Groep BV v Benelux-Merkenbureau} the CJEU held that colours could in principle be distinctive but only in exceptional circumstances.\(^{54}\) This was an application to register the colour orange for certain telecommunications goods and services. As Fields and Muller point out, in any international system for the registration of colour, there are only a limited number of colours in international codes.\(^{55}\) The CJEU was therefore rightly worried about


\(^{51}\) Case T-408/15 \textit{Globo Comunicação e Participações S/A (Globo) v EUIPO} EU:T:2016:468.

\(^{52}\) See for example: Case C-265/00 \textit{Campina Melkunie BV v Benelux-Merkenbureau} [2004] ECR I-1699.

\(^{53}\) Case C-283/01 \textit{Shield Mark BV v Kist (t/a Memex)} [2004] Ch 97, [2004] 2 WLR 1117.

\(^{54}\) Case C-104/01 \textit{Libertel Groep BV v Benelux-Merkenbureau} [2004] Ch 83, [2004] 2 WLR 1081.

granting a monopoly to one trader over a particular colour.\textsuperscript{56} To do so would have a particularly restrictive effect that is not as problematic in the context of other marks.\textsuperscript{57} This has, however, made it difficult for traders to make out acquired distinctiveness in the context of colours. While this may seem to be a problem from the point of view of the trader, the law must weigh up the rights of competing stakeholders and so this apprehension about granting a monopoly is appropriate.\textsuperscript{58} The CJEU in \textit{Libertel} was right to suggest that the more of a monopoly the trader is seeking the greater the scrutiny of the court should be before granting the registration.\textsuperscript{59} While it does place a larger burden on non-traditional marks, it is the correct balance to strike.\textsuperscript{60}

\textbf{C. Shapes}

In relation to shapes there is a particular issue that has proved difficult to overcome. Article 3 of the Trade Marks Directive provides, among other provisions, that signs cannot be registered if they consist exclusively of:

(i) signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering the service, or other characteristics of the goods; or

(ii) the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods.\textsuperscript{61}

The leading case in EU law is \textit{Philips v Remington}.\textsuperscript{62} In that case Philips tried to argue that the exclusion in part (ii) above did not apply where there is another

\textsuperscript{57} ibid [231]-[232].
\textsuperscript{58} Joel Smith, “EC: Trade Marks – Cock a Doodle Do! Sounds Represented Graphically Can Be Registered As Trade Marks” (2004) 26(6) EIPR N86.
\textsuperscript{59} Case C-104/01 \textit{Libertel Groep BV v Benelux-Merkenbureau} [2004] Ch 83, [2004] 2 WLR 1081 [54].
shape that is capable of producing the same result. Philips had tried to register a specific shaver head design. In rejecting this approach, the CJEU held that the provision was, “intended to preclude the registration of shapes whose essential characteristics perform a technical function”. The problem is that the protection for a design like this more naturally lies in patent or design. Given there are limited shapes available to use on the head of an electric razor, this decision of the CJEU is to be applauded. Accepting registration would lead to an unfair monopolisation by Philips of a particular shape. Again, the greater burden placed on non-traditional marks is an acceptable trade off to protect against monopolisation.

The same text under Article 7(1)(e) of the CTMR has been examined in Lego v MEGA. Lego attempted to register a red three-dimensional toy brick. The OHIM Grand Board of Appeal held that this rule infringed the same policy goal as that in Philips. Namely it was an attempt to register a shape whose essential characteristics perform a technical function. Lego’s appeal was dismissed because granting registration would give Lego a monopoly over a technical result, something the legislation forbids. These decisions strike the right balance between preventing monopolies and allowing adequate protection of non-traditional marks. Indeed, as Marsland points out, a number of shapes have in fact been registered including the Weetabix shape, Unilever’s Vienetta ice cream shape, and the Bounty chocolate bar shape. The fact that these registrations have all survived in tact shows that, in this area, the law does provide adequate protection and that Philips were simply pushing at the boundaries of the law. The balance here then is not tipped so far against non-traditional marks as it is when considering distinctiveness and the Sieckmann seven.

For the sake of completeness it should also be noted that Dyson has failed in an application to register a “transparent bin or collection chamber forming part of

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64 ibid [79].
the external surface of a vacuum cleaner”.  

They attempted to register every conceivable shapes of transparent vacuum cleaner as a trademark. This failed because it was insufficiently specific to be a sign. This is not an issue in regard to non-traditional marks but is rather an attempt by Dyson to register a concept rather than a badge of origin. The CJEU were therefore right to reject the appeal.

II. THE NEW LEGISLATION

As has been alluded to above, the EU has recently introduced a number of wholesale changes. Two are relevant to non-traditional marks: the removal of the requirement for a graphical representation, and a change to the absolute grounds of refusal contained in Article 7 EUTMR (EU Trade Mark Regulation). This author’s view is that these changes will make it easier to register a sound but more difficult to register a scent.

A. Removing Graphical Representation

On 16th December 2015 EU trade mark law was amended by Regulation 2015/2424. From 1st October 2017 there will no longer be a requirement for trade marks to be represented graphically. However, this amendment is counteracted by the fact that the Sieckmann criteria have been expressly retained. Perez argues that:

70 Case C-321/03 Dyson v Registrar of Trademarks [2007] ETMR 34.
71 ibid.
73 Max Planck Institute for Intellectual Property and Competition Law, Study on the Overall Functioning of the European Trade Mark System (Munich 2011).
76 ibid.
Even though the "graphical representation" requirement is removed, it is not certain that smell trade marks will be able to be registered because we do not know whether the CJEU, OHIM, or other examination offices will now consider a detailed description of the perfume, or a chemical formula or the deposit of the fragrance as "clear, self-contained, easily accessible, intelligible, durable and objective".

In fact, with respect, it is perfectly clear. The CJEU has held in Sieckmann that such a detailed description or chemical formula does not meet the seven criteria. Removing the requirement for “graphical representation” is therefore of limited usefulness given that the legislature has expressly incorporated the Sieckmann seven. The courts will continue to have considerable regard to previous decisions that ruled on these criteria and the issues highlighted above will remain. So while Sahin is right to point out that, “The graphical representation requirement may be the hardest obstacle for olfactory marks in the current legal situation” the EU has not properly solved the problem.

Indeed, many of the old cases would be decided the same way under the new legislation. For example, in Opel v Autec the court held that a smell sample was not sufficiently stable and durable. Even under the new rules this case would fail under the Sieckmann seven. A smell sample, even though it is not a graphical representation, is not sufficiently durable to be registrable under Sieckmann. The same can be said of Eden Sarl v OHIM. In that case the CFI (Court of First Instance) held that the description “smell of ripe strawberry” was not sufficiently objective, clear, or precise. There is no reason why this would change simply because there is no longer a need for a graphical representation. The problem is that it is not sufficiently precise to be registrable. The CFI’s assertion that the graphical representation must represent the odour and not the product emitting the odour is problematic but the removal of the requirement for graphical representation will not solve this because, as Gow points out, this decision is a classic example of a court arriving at a decision and then working backwards to try and find the reasoning to support it. The courts will still be able to engage in backwards reasoning even under the new legislation. A better amendment would have one that would bring the court’s decision making out into the open.

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80 Case C-48/05 Adam Opel AG v Autec AG [2007] ECR I-01017.
Fields and Muller point out that once the new legislation comes into effect, “trade mark offices may accept digital sound files as the sole means of representation of a sound sign.” However, what they do not further develop is that there will be no requirement for individual offices to accept these recordings as the sole means of registration. This creates the risk that discrepancies will be created across the EU, as some countries may not be able to afford the expensive equipment required to accept certain samples. This point aside, the acceptance of digital sound files would transform the protection of sound marks making their registration, so far as the Sieckmann seven are concerned, routine. A sound recording counteracts Bainbridge’s concern that a sound mark cannot be represented with sufficient precision.

For colour marks, the removal of the requirement for graphical representation has potential to be counter-productive. Colours are inherently subjective with different people perceiving colours differently. If the court holds that it is no longer a requirement that an international colour code be submitted then there is a risk of subjectivity enveloping the law. It is hoped that the CJEU will hold that an international code is still a requirement under the Sieckmann seven in order to ensure that the representation is sufficiently objective.

It is unlikely that, even after the requirement for graphical representation has been removed, many taste marks will become registered. This is because 80% of a taste is in the smell and so all the problems encountered by smells will be shared by tastes. There is a further objection that has been raised by a number of trade mark offices. That is that tastes should not really be registrable at all. It is only after the product has been purchased that the customer will be able to taste it. Granting a trade mark is therefore not protecting the brand because when the mark is perceived the product has been bought and consumed. It is almost

89 ibid.
impossible to enjoy a taste before you have made a purchase. Such marks should therefore not be registered.

There is also a systematic point. The graphical representation requirement made it easy for someone to search and find a registration that they might want to object to.\footnote{Max Planck Institute for Intellectual Property and Competition Law, \textit{Study on the Overall Functioning of the European Trade Mark System} (Munich 2011) [1.57].} Given that internet searches are currently based on words, and that there is no way to search by way of smell, removing the requirement for graphical representation risks making it very difficult to find a trade mark. It is hard to think of a way that someone could search for a smell that has been deposited as a sample. This search facility is vital, as Bainbridge points out, to allow other traders to predictably determine what they can and cannot do.\footnote{David I. Bainbridge, \textit{“Smell, Sound, Colour and Shape Trade Marks: An Unhappy Flirtation?”} [2004] JBL 219, 223.} The CJEU should bear this in mind when developing the case law but that would risk undermining the whole point of the reforms. This is a difficult “catch 22” that can only really be resolved by developing better technology, a point developed more fully below.

\section*{B. Article 7 EUTMR}

One change that has already taken effect is an amendment to the absolute grounds of refusal. The amended Article 7 provides for an absolute ground of refusal where the sign consists exclusively of:

\begin{enumerate}
\item the shape, \textit{or another characteristic}, which results from the nature of the goods themselves;
\item the shape, \textit{or another characteristic}, of goods which is necessary to obtain a technical result;
\item the shape, \textit{or another characteristic}, which gives substantial value to the goods \footnote{Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark [2009] OJ L78/1, art 7.}.
\end{enumerate}

The addition of the term “or another characteristic” to these absolute grounds of refusal is intended to counter-balance the removal of the graphical representation requirement.\footnote{Taras Kulbaba, \textit{“EU Trademark Law Reform Series: Implications for Nontraditional Marks”} (2016) 71(3) INTA Bulletin.} Kulbaba correctly points out that this could have the effect that, overall, the reforms actually make it less easy for non-traditional marks to be
registered. In particular, the third paragraph will be a major stumbling block for smells. The smell of perfume, for example, clearly gives substantial value to goods. Indeed, the only reason why people buy perfume is because of the smell. If, as seems likely, the CJEU rules that “characteristic” can include smell and other non-traditional marks, the overall effect of these reforms is likely to be negative. This is to be regretted given the already considerable difficulties encountered when trying to protect non-traditional marks.

III. REMAINING PROBLEMS

There still exist a number of problems in relation to European trade mark law, particularly for scents. These problems shall be discussed in turn.

A. Lack of Legal Certainty

Friedmann argues that the effect of Sieckmann was to “guarantee legal certainty”. That, it is respectfully suggested, is an optimistic way to view Sieckmann and the related decisions. While progress has been made, there is still considerable uncertainty in this area of law. From a trademark owner’s point of view, the lack of legal certainty is problematic because they do not know what protection they will get and, even if they are registered, whether a court will subsequently withdraw that protection. A number of points will be made about legal certainty.

Firstly, as a preliminary point, it should be noted that in trade mark law there will always be an element of subjective judgment which leads to uncertainty. The purpose of the law should be to reduce this uncertainty by creating a structure for judicial analysis. The Sieckmann seven as a concept are an excellent step in the right direction. They provide a framework in which judges can base their decisions. However, the way that the criteria have been applied is, as highlighted above, inconsistent. The risk with criteria like this is that judges use them as a veil to hide their true reasoning and there is at least an element of that in this area.

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94 Ibid.
95 Ibid.
Secondly, in relation to colour marks, Sahin has remarked that:

it is not clear when a single colour can be distinctive, whether it must be the only colour or the dominant colour, or how a combination of colours can be identified and described in order to make it precise.\(^{99}\)

A similar issue has arisen in the UK where the Court of Appeal has recently handed down its decision in *Société des Produits Nestlé S.A. v Cadbury UK Ltd*.\(^{100}\) In this case it was held that a registration for the colour purple where it was the “predominant” colour should fail because the mark lacked sufficient precision.\(^{101}\) To allow registration, so they held, would risk jeopardising legal certainty. Sahin argues that there is still scope for uncertainty because a single colour can be deployed in a number of ways.\(^{102}\) With respect, this misses the point. It was not open to the Court of Appeal to make sweeping statements about the law; they could only decide the case in front of them. If an appropriate case arises they may very well decide that other colour marks are insufficiently certain. A more problematic aspect of the case is that it is unclear how other EU Member States might decide a similar case. It is unfortunate that a reference was not made to the CJEU to decide the point authoritatively across the EU and remove uncertainty about the position in different Member States.\(^{103}\)

Thirdly, the situation in relation to scent marks has created uncertainty. There are two smell marks that are currently registered in the UK: Sumitomo Rubber Industries has a mark in respect of "floral fragrance/smell reminiscent of roses" as applied to tyres,\(^{104}\) while Unicorn Products Ltd has a mark for "the strong smell of bitter beer applied to flights for darts".\(^{105}\) The EUIPO has made clear that they do not agree with these two marks and so it is quite possible that they would be removed if challenged by a competitor.\(^{106}\) Furthermore, as Gow points out, these


\(^{100}\) *Société des Produits Nestlé S.A. v Cadbury UK Ltd* [2013] EWCA Civ 1174, [2014] 1 All ER 1079.

\(^{101}\) ibid [52].


\(^{103}\) This was because the Court of Appeal is not the final court of appeal in the UK and so it was open to the parties to agree not to ask for a reference. See: *Société des Produits Nestlé S.A. v Cadbury UK Ltd* [2013] EWCA Civ 1174, [2014] 1 All ER 1079 [13].

\(^{104}\) Registration No. UK 00002001416, filled on 31st October 1994, entered in the register on 9th April 1996.

\(^{105}\) Registration No. UK 00002000234, filled on 31st October 1994, entered in the register on 3rd May 1996.

registrations were granted before the seminal ruling in *Sieckmann* and they were granted solely on the basis of the written description.\(^\text{107}\)

Indeed, as Wiszniewska points out, the reasons for accepting these marks are unknown.\(^\text{108}\) This presents a significant problem for legal certainty. The only two marks that are registered have had their status doubted and no one even knows the reasons for the registration in order to defend them.\(^\text{109}\) From the trade mark owners’ perspective it is problematic because their rights could be challenged at any moment and they would lose the protection that they have assumed to have for over 20 years. However, the implications for the system as a whole are even more profound. Those wishing to register non-traditional marks are risking expensive litigation in an area where the result cannot be predicted with any certainty.

**B. A Paper Paradigm**

One of the recurring problems in this area has been trying to represent something on paper so that it can be perceived by the eyes when humans normally perceive that mark by another sense.\(^\text{110}\) Friedmann argues that we are about to enter into an exciting new era for non-traditional marks because of emerging technology that allows us to store scents digitally.\(^\text{111}\) Coupled with the removal of the requirement for graphical representation, he argues that the registration of scent and taste marks will allow for an exponential increase in registration in coming years.\(^\text{112}\)

For example, Scentcom is currently working on technology to sense, transmit, and receive smell via a digital media.\(^\text{113}\) Furthermore, a team from the Tokyo University of Agriculture and Technology have recently created a smelling screen that allows smells to be emitted.\(^\text{114}\) It is conceivable then that we may soon live in a world where it is possible to deposit a smell at an IP Office. As Friedmann points out, once this happens it will only be a matter of time before tastes follow given

\(^{107}\) Laura Gow, “Creating a Stink?” [2007] BLR 86, 87.

\(^{108}\) ibid.


\(^{112}\) ibid.


that 80% of taste is thought to originate from the smell. Problems of cost will remain, however, and this will create an issue for uniformity. Those Member States that can afford the new technology will be at a competitive advantage compared to poorer economies.

Friedmann’s optimist is misplaced because technology that allows a machine to recreate a smell does not solve our problem. All it allows for is more robust storage than currently takes place using a smelling stick. A judge would still have to smell the recreated sample and make a judgment. Such a judgment is inherently subjective and so inconsistent with the Sieckmann criteria of objectivity. If the law allows for traders to deposit a sample of a smell as the only mode of registration, it will be impossible for a judge to give a reasoned opinion as to why that registration was allowed. This criticism applies equally to the digital storing of music and sounds. Before a real improvement for scents can be made technology will need to be able to register scents on an objective scale. This is, of course, already possible for sounds in the form of a spectrogram. The problems experienced in relation to sound marks could largely be solved by accepting spectrograms.

C. Practice Does Not Align with Theory

A further problem with the law is that in theory non-traditional marks are registrable but in practice they are rarely accepted. For example, given the rejection of spectrograms, sounds that cannot be represented on a stave have no other avenue for representation open to them. In Sieckmann the CJEU took away with one hand what they gave with the other. While they did hold that non-traditional marks could be registered provided they met the Sieckmann seven, they also held that there is no possible graphical representation available for smells. To make registration possible in theory but unavailable in practice like this is unacceptable. If the law says that a mark is registrable then there should be a straightforward route to having the registration accepted. Sahin has also made this point arguing:

In my view, the CJEU should have either prohibited all olfactory marks or indicated a way to make a graphical representation. It is unacceptable not to indicate any possible means to make a graphical

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representation of smells, while clearly stating that olfactory marks are not excluded from registrability.\textsuperscript{118}

Perez disagrees, arguing that non-traditional marks can be registered.\textsuperscript{119} She rigorously goes through the requirements for registration of a smell mark and concludes that it is not impossible for a smell to be registered.\textsuperscript{120} However, her analysis is incomplete because it does not point to any significant number of examples where non-traditional marks have actually been registered. The criticism that in practice registration is impossible therefore stands. A legal framework that allows for registration in theory but applies the requirements so strictly that it cannot happen in practice is useless to the commercial world.

\textit{D. Inherently Descriptive}

In relation to smells, in particular, there is a problem that what is sought to be registered is often inherently descriptive. As Perez argues, “a smell will be able to be considered distinctive only in respect to a product for which this smell is not an essential quality or normal to it.”\textsuperscript{121} This does not mean that the owner should not be able to protect their property in them.\textsuperscript{122} For example, the whole point in perfume is to smell nice. But many of us could instantly recognise certain brands of perfume. Why should Chanel not be able to protect itself from people imitating it? There is an inherent tension here. The smell is performing two functions; it is both an attribute of a product but also something that alerts the consumer to who made it. In these cases, it is suggested that the trade mark owner is not given sufficient protection.

Furthermore, the way that we currently describe smells is by reference to what they smell like.\textsuperscript{123} It is, by definition, impossible to create something new. The lack of technology to accurately describe smells limits a trade mark owner’s ability to defend their mark. Even if they do come up with a distinctive way of using a certain smell, the way that it is described will always arouse suspicion in a court who naturally focus on the written word. It is, and will remain to be, difficult to

\begin{footnotes}
\begin{enumerate}
\item ibid [510].
\item ibid.
\item Cristina Hernandez-Marti Perez, “The Possibility of IP Protection For Smell” (2014) 36(10) EIPR 665, 668.
\item See for example: Case C-273/00 Sieckmann v Deutsches patent- und Markenamt [2003] Ch 487, [2003] 3 WLR 424.
\end{enumerate}
\end{footnotes}
convince a judge that something that smells like something else is nevertheless distinctive.

IV. THE ALTERNATIVES

Given the difficulties that are currently encountered in registering a non-traditional mark, and the anticipation that this will continue to be the case, there is an incentive for traders to look to other avenues of protection. This section shall examine those avenues and their implications for trade mark law.

A. Copyright

Copyright law has been used to protect scents. In *Lancôme Parfums et Beauté et Cie SNC v Kecofa BV* the Dutch Supreme Court held that it was possible to protect a perfume by way of copyright. In that case a French company Lancôme sued the low-end perfume company Kecofa. Kecofa had produced a scent that bore a remarkable resemblance to Lancôme’s leading brand. It was held that, while none of the chemical components in and of themselves were unique, the way that they were combined was unique. This was sufficient to grant copyright protection to the scent. Gow has described this decision as “revolutionary” and it has potential to fill a gap in European trade mark protection. If national courts can protect scents in this way the pressure on European trade mark law to adapt is relieved. This is something the courts have been reluctant to do through fear of venturing into other areas of law, as Fields and Muller point out.

Gow argues that, “If legal protection is to be extended to smells, it seems logical that this protection should lie in copyright and not trade mark.” However, it is important to note that the protection extended to copyright is deficient in at least two related respects. Firstly, Lancôme was forced to sue Kecofa after their product had already been copied. They were unable to preemptively register their trade mark through the EU system to gain protection before anyone attempted to copy them. This has the effect that when they sued in copyright they had to make out all of the individual elements of the action. By contrast, in trade mark law, the material facts will already have been proved upon registration and it is only necessary to show that the trade mark has been infringed, a relatively straightforward process.

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127 Laura Gow, “Creating a Stink?” [2007] BLR 86, 89.
Secondly, the protection is only on a national level. Lancôme was forced to sue in the national court to protect their intellectual property. By contrast, a registered trade mark can take effect across the entire Union. Indeed this lack of a Union wide remedy creates inconsistency. For example, the French Court of Cassation has reached the opposite conclusion and Perez has noted that, “the Dutch Supreme Court decision is unique in Europe”. Such inconsistency undermines the very purpose of a European legal order. The fact that the Dutch decision is seen as “unique” may suggest simply that it is wrong and liable for rectification by harmonization at the EU level. Copyright therefore, while attractive in the Netherlands, may not be a realistic source of protection for traders to consistently use.

B. Passing Off

Passing off might be used to protect non-traditional marks that have been refused registration. Space precludes a detailed analysis of passing off and so only two points will be made. Firstly, the law of passing off is geographically restricted. On one level this is obvious: it is only law in certain common law jurisdictions and so will not extend to most of the EU. Even within the UK, however, the law of passing off is limited to the area that the “goodwill” extends to. While this will not be a problem for large multi-nationals, it will be restrictive for smaller companies acting in one small area.

Secondly, a passing off action has recently failed in L’Oréal and Others v Bellure. The English High Court held that it was sufficient that the competitor had changed the name of the perfume so that they were not relying on L’Oréal’s goodwill. This is an important decision as it shows that passing off is primarily designed to protect brand names and traditional marks. It will therefore struggle

129 ibid [512].
133 Eleonora Rosati, Originality in EU Copyright: Full Harmonization through Case Law (Edward Elgar 2013).
137 L’Oréal and Others v Bellure [2007] EWC Civ 968.
to adapt to protect non-traditional marks. This is a serious limitation on the law and may signal that traders should look elsewhere for protection.

C. Trade Secrets

Many of the things that traders seek to protect can only be produced in one way using a secret recipe. One of the ways they might try to meet the Sieckmann seven to register a trade mark is by divulging that recipe. Many will choose to maintain the trade secret rather than get a trade mark. They may feel that the secret itself is sufficient to protect their interest. However, trade secrets can also be protected under the WTO law. As Perez highlights:

Article 39 TRIPS establishes when undisclosed information will be protected against unfair competition. In order to be protected, that undisclosed information must be (1) secret; (2) have a commercial value due to its secrecy; and (3) reasonable steps have been taken in order to keep it secret.

The advantage for traders in using trade secrets, rather than patents or trade marks, is that there is no requirement for registration. This relieves a trader of initial bureaucratic costs. On the other hand, however, should the secret become public the secret is blown and everyone can use it. Legal protection takes the form of an injunction before the secret is leaked, not a monopoly after the event.

V. CONCLUSION

Looking to the future, the CJEU is likely to be given the opportunity to re-evaluate its jurisprudence. While the thesis throughout this paper has been that the reforms do not change much, and so the old case law is still good law, the proposition is likely to be tested in the courts. The CJEU should seize the chance to undo some of the inherent inequality in the law. For example, they should clarify that the Sieckmann requirement for a representation to be easily accessible only requires it to be understood by a qualified expert. This would level the playing field as between traditional marks and non-traditional marks considerably.

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140 ibid.
141 ibid.
142 See Section II.A.
and be an important step towards providing adequate protection for non-traditional marks.

A number of alternatives to trade mark protection have been examined by this paper. While traders will always look to stretch the law by exploring such avenues, it is important that the courts do not pursue judicial legislation in order to fill a perceived gap in trade mark law. To do so would risk undermining the internal coherence of other areas of law such as copyright.\textsuperscript{143} If trade mark law is inadequate, and it has been argued at length that it is, then the solution must be found in trade mark law. The EU has a difficult task ahead of it but perhaps that task will be eased considerably by advances in technology that allow non-traditional marks to be transformed onto an objective scale. Such advances are, it is hoped, not too far away.\textsuperscript{144}

\textsuperscript{143} Pia Letto-Vanamo and Jan Smits, \textit{Coherence and Fragmentation in European Private Law} (Sellier 2012).