

'Can non-traditional signs, such as colours, scents and sounds be protected under Trade Mark law? If not, what are the alternatives to do so? A comparative analysis between Europe and United States of America.'

By

Advocate Marilena Shambarta

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1.INTRODUCTION

The primary purpose of a Trade Mark (TM) is to allow the consumers to identify the origin of goods or services and therefore to be able to distinguish the goods or services of one undertaking from those of other undertakings.¹ For this reason, TM protection in Europe as well as in the United States of America(US) was traditionally '*reserved for marks, that are easily perceived as source identifiers such as words, names, logos, and graphic symbols*'.² However, gradually all over the world, acknowledging the potential contained therein, different kind of signs have been sought to be trademarked such as colours, scents sounds etc.³ Although there were views that such non-traditional signs could serve perfectly as TMs and they were a great innovative step for the modern business world, there were many who doubted the potential of these signs to be perceived as source identifiers.

Two of the greatest hurdles that non-traditional signs had to overcome in order to obtain TM protection is the distinctiveness and graphical representation (GR) requirements. The former requirement is necessary, so as to establish that the sign will be capable to indicate the origin of goods or services and to distinguish them from those of other undertakings⁴ and the latter is necessary so as to allow third parties to see the extent of the monopoly and the precise nature of a registered TM.⁵

This paper will provide a comparative study between Europe and the US regarding the registrability of colour, scent and sound marks as TMs, and by examining the way the TM

¹Cornish,W and Llewelyn, D and Aplin,T *Intellectual Property, Patents, Copyrights, Trademarks and Allied Rights* (7thedn,Sweet& Maxwell, 2010) 655.

²Symes,L, 'Sounds Smells, Shapes and Colors 'Protection and Enforcement of Non-Traditional Trademarks' <http://vipo-online.org/wp-content/uploads/2011/10/Sounds_Smells_Shapes_and_Colors-tm-protection-US.pdf> Accessed 5 September 2012.

³Sahay, V 'Conventionalising non-conventional Trademarks of sounds and scents: A cross jurisdictional study' Nalsar Student Law Review 128,129 <<http://www.clatgyan.com/nslr/2011/9.pdf>> Accessed 5 October 2012.

⁴Bainbridge,D 'Smell, sound, colour and shape trade marks: an unhappy flirtation?' (2004) JBL 219, 222.

⁵Ibid 223.

law of each country treats these non-conventional signs we will be able to conclude whether such signs have a place in the area of TM law.

Moreover, this paper will also examine the possibility of any alternative ways other than TM law to protect such non-traditional signs, in case where they are denied registration and protection under TM law. Both in Europe and in US there is also the concept of Unfair Competition (UC) and Passing off for the UK, whose rules are generally more relaxed than the rules of TM law and they are capable of providing protection to unregistered signs, which however are generally well known.

2. NON-TRADITIONAL SIGNS IN EUROPEAN UNION

2(a) Generally about Community Trade Mark (CTM) Law

According to the EU Trademark Directive (TMD)⁶ and the Community Trade Mark Regulation (CTMR) a TM is *'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 a sign is capable of distinguishing the goods or services of one business from those of another'*.⁷ In the definition they are also stated examples of what a TM may consist, such as words, designs, letters, numerals, or the shape of goods.⁸ The requirements of GR and distinctiveness are the basic hurdles for the applicants who seek to register their signs as valid TMs and these two requirements have caused the courts, in many cases, to be reluctant in allowing various signs to be registered as TM.⁹

Distinctiveness

⁶EU Trademark Directive (89/104/EEC)

⁷ Ibid Article 2.

⁸ Ibid

⁹Dubois, P 'Colour Trademarks- the US and European approaches converge'
[http://www.kirkland.com/siteFiles/kirkexp/publications/2337/Document1/Colour%20Trademarks%20\(Dubois\)%20Brands%20in%20the%20Boardroom.pdf](http://www.kirkland.com/siteFiles/kirkexp/publications/2337/Document1/Colour%20Trademarks%20(Dubois)%20Brands%20in%20the%20Boardroom.pdf) Accessed 6 July 2012.

The basic function and purpose of a TM is to indicate the origin of goods or services and to distinguish them from those of other undertakings.¹⁰ Therefore, a TM, in order to be able to achieve the purpose to indicate the origin of a specific good should be first of all distinctive.¹¹ The requirement of distinctiveness is confirmed by Article 7(1)(b) CTMR which provides that TM that are devoid of any distinctive character will be refused registration. Article 7(1)(b) rejects the registration of those signs which the average consumer 'does not identify as reliably indicating the commercial origin of the product'.¹² Therefore, any signs that are not able to communicate any message as to the source of the product and they would be rather treated as part of the goods, part of their appearance, or they are just descriptive will be excluded from being registered as TM.¹³ However, Article 3(3) of the TMD provides that a 'trade mark shall not be refused registration..[on the ground that it is non-distinctive, descriptive or generic] if, before the date of application for registration and following the use which has been made of it, has acquired a distinctive character'.¹⁴

Acquired Distinctiveness

The phrase acquired distinctiveness refers to the situation where a sign is not inherently distinctive but it is capable of becoming distinctive gradually through use.¹⁵ According to *Windsurfing* case the ECJ explained that a non-distinctive sign 'may be registered as a TM if, following the use which has been made of it, it has come to identify the [relevant] product as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings'¹⁶. In order to prove acquired distinctiveness, firstly it

¹⁰ Bainbridge, 'Smell, sound colour and shape marks: an unhappy flirtation' (n 4) 222.

¹¹ Ibid.

¹² *Nichols v. Registrar*, Case C-404/02 (2004) ECR I-8499 at para43

¹³ *LibertelGroep BV v Benelux-Merkenbureau*, Case C-104/01, [2004] Ch. 83.

¹⁴ EU Trademark Directive (n 6) Article 3(3)

¹⁵ Burton, H, 'The UK TradeMarks Act 1994: an invitation to an olfactory occasion?' (1995) 17(8) EIPR 378,381.

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[2000] Ch. 523,554.

must be shown that the TM is used in the Community as a whole¹⁷ and secondly, in such a way that a sufficiently large part of the relevant public recognises the sign as a distinctive TM when the application was filled.¹⁸

Graphical Representation

Signs must be capable of being represented graphically in order to be registered. This will enable third parties to avoid infringement and also to find out whether another sign can still be registered.¹⁹ In many cases the requirement of GR is a great obstacle in registering certain kind of signs as TMs.²⁰ Particularly, in recent years the issue of GR has gained a lot of attention in relation to olfactory, sound and colour marks.²¹

The issue of GR first came before the ECJ in 2002 in ***Sieckmann***²² case which concerned the protectability of smells as TMs.²³ The ECJ in *Sieckmann* emphasised the importance of the GR requirement as it stated that signs not capable of being perceived visually may be registered as TM as long as they can be represented graphically.²⁴ The ECJ in this case found that the GR has to be '*clear, precise, self-contained, easily accessible, intelligible, durable and objective*'.²⁵

¹⁷Ibid at para 46.

¹⁸Libertel (n 13).

¹⁹Torremans P, *Hollyak&Torremans Intellectual Property Law*, (6thedn, OUP, New York 2010) 394.

²⁰Ibid 393.

²¹ Ibid.

²²*Sieckmann v v Deutsches Patent* [2003] Ch 487

²³Clifford Chance LLP, 'Non-traditional trademarks in the Community trademark system' <<http://www.worldtrademarkreview.com/issues/article.ashx?g=f4e1f692-7c81-4198-b42e-639ea370b40f>> Accessed 6 July 2012

²⁴*Sieckman* (n 22) 509.

²⁵Ibid

2(b) Colours

It is obvious that, the definition of a TM, given by the TM Directive and the CTMR, does not impose any restriction on the registration of colours as TM.²⁶ The fact that colours are not listed specifically in the definition does not preclude them from being registered as valid TM since the list of examples stated in the definition is not exhaustive. Even though the TM Directive harmonized the definition of a TM, it remained silent on the use of colour marks which indicates that each member state will be somehow free to determine whether a colour complies with this definition.²⁷ Nonetheless, as already mentioned above, the broad definition given to TMs is not enough to allow colours and other signs to be registered as TMs as the requirements of distinctiveness and GR should be satisfied.

Colours and Graphical Representation

Beginning with the requirement of GR, it is clear that it will not suffice to describe a colour vaguely by a verbal description such 'blue' or 'pale green' or even 'vertical alternating yellow and purple stripes, the yellow stripe being 4 mm wide , and the purple stripe being 2 mm wide'.²⁸ Such a description lacks precision and objectivity and makes it difficult for others to know whether their use of a specific colour is likely to infringe a colour mark.²⁹

It has been suggested that proper GR for colours is to be achieved by including the colour or colours either as a sample or by presenting an image of the goods to which colour is attached.³⁰ Another way is to use a well-known referencing system for colours such as the Pantone system which is said to be the most well known standard for colour classification.³¹

²⁶Bainbridge,'Smell, sound colour and shape marks: an unhappy flirtation' (n 4).

²⁷ Ladas & Parry LLP, 'Trademarks: Sounds, Colors and Scents'
<<http://www.ladas.com/Trademarks/MakingSenseTM.html>> Accessed 3 July 2010

²⁸ Bainbridge, D *Intellectual Property*(8th edition, Pearson Education, 2010) 673.

²⁹ Ibid

³⁰ Ibid

³¹ Ibid 674.

In **Libertel**³² an application was made to register the colour orange as a mark for goods and services in relation to items of telecommunication equipment and GR was submitted in the type of a rectangle of the colour with no other indication of the colour.³³ The ECJ ruled that a single colour may be represented graphically and therefore being able to be registered as a TM, if an internationally recognised colour code is used.³⁴ **Libertel** confirmed what was stated in *Sieckmann* about 'clear, precise, self-contained, easily accessible, intelligible, durable and objective' GR and stated that mere reproduction of the colour on paper does not meet the requirement of being capable of GR whereas using an internationally recognised colour code does.³⁵

In **Heidelberg**³⁶, the ECJ introduced a further requirement for marks consisting of a combination of colours in the abstract without contours.³⁷ In this case the applicant sought to register the colours blue and yellow as a TM and the sign applied for was on a rectangle piece of paper, the upper part of which was blue and the bottom half being yellow.³⁸ The applicant referenced the colours with recognised colour codes but the problem was that it added a description to its application that these colours 'will be used in all conceivable forms'.³⁹ This phrase was said to be ambiguous and could be interpreted in various different uncertain ways.⁴⁰ The ECJ stated that in a case where there are two or more colours designated in the abstract and without contours, the GR must also include 'a systematic arrangement associating the colours in a predetermined and uniform way'.⁴¹

Colours and Distinctiveness

³² Libertel (n 13) 96.

³³ Ibid 83.

³⁴ Ibid

³⁵ Ibid 93.

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Heidelberg Bauchemie GmbH, Case C-49/02, [2004] E.T.M.R. 99

³⁷ 'Colour trade marks - Colour(s) alone - in the abstract or applied to the goods or their packaging' <<http://www.ipo.gov.uk/precolouralone.pdf>> Accessed 10 August 2012

³⁸ Heidelberg (n 36) 1289.

³⁹ Ibid

⁴⁰ Ibid

⁴¹ Ibid 1290.

The requirement of distinctiveness might be an even greater hurdle than that of GR for those aiming to register a colour mark due to the general view that colour signs have little inherent distinctive character.⁴²

In ***Light Green***⁴³ while the Board of Appeal confirmed that a colour per se may in some cases be capable of CTM protection, it established that single colours are usually devoid of distinctive character and therefore the application for registration of light green for chewing gum in this case was rejected.⁴⁴ Moreover it was stated that the indication of chewing gum flavour by colour was quite common and that the colour green was a basic colour which was extensively used in advertising and in trade.⁴⁵ However, the Board accepted that a different conclusion could have been reached if there were evidence of acquired distinctiveness of the colour light green in relation to the goods within the meaning of Article 7(3) CTMR or article 3(3) of TMD.⁴⁶

Similarly, in *Libertel* the ECJ observed that colours possess little inherent capacity to communicate specific information and that '[a] a colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking'.⁴⁷

Colour Depletion

In light of the *Libertel* case and principles, it can be deduced that together with the requirement of distinctiveness and GR of the relevant colour, it is also important to assess 'whether its registration would run counter to the general interest in not unduly limiting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought'.⁴⁸ Therefore even if the requirement of distinctiveness and GR are satisfied a colour mark might be denied regis-

⁴² *Libertel* (n 13) 90.

⁴³ *Light Green*, R 122/1998-3

⁴⁴ *Ibid* para/ point 3-4, 11.

⁴⁵ *Ibid* at para /point 3.

⁴⁶ *Ibid* at para/point 32.

⁴⁷ *Libertel* (n 13) 93.

⁴⁸ *Ibid* 96.

tration on the ground that it would be against the public interest to unduly restrict the availability of colours for competing business.⁴⁹ This is maintained by the depletion theory, which has been the most popular theory used to reject colour mark registrability.⁵⁰ According to this theory, the view is that the colour spectrum is limited and that granting a colour TM to a business would lead to a TM monopoly over that colour.⁵¹ This consequently would disadvantage the competitors of the colour TM owner as it would deplete the colour's availability and will foreclose the market.⁵²

2(c) Scents

A scent mark, like any other signs, in order to be eligible of CTM protection it has to be shown that scents fall within the definition of a TM according to Article 2 of the TM Directive. At first sight, all the examples of permissible signs listed in the definition of a CTM refer to visually perceptible signs but as Karapapa⁵³ argues the use of the word *particularly* in the definition implies that the list of the signs stated is not a fixed list but it rather, has a merely explanatory character.⁵⁴ This suggests that scent signs are not excluded by the CTMR definition. Besides Sandri and Rizzo⁵⁵ point out, that a *sign* is any element that represents not only itself but something other than itself.⁵⁶ Inherent characteristic of this concept is the ability of a sign to convey a message.⁵⁷ Since a message is not communicated only through visual symbols, then it can be assumed that both visual and sensory devices have the ability to convey information.⁵⁸ It is also interesting to

⁴⁹Bainbridge, *Intellectual Property*, (n 28) 674.

⁵⁰Doll, A 'Registrability of Stand Alone Colours as Trademarks', (2000) 12 J.Contemp.LegalIssues 66, 68.

⁵¹Karapapa, S 'Registering Scents as Community Trade Marks' (2010) 100 TMR 1335, 1346.

⁵² Ibid

⁵³ Ibid

⁵⁴ Ibid 1339.

⁵⁵Sandri, S and Rizzo, S 'Non-Conventional Trade Marks and Community Law' 5 (Maequwa: the Association of European Trademark Owners, 2003)

⁵⁶ Ibid

⁵⁷ Karapapa (n 51) 1340.

⁵⁸ Ibid

mention the view, that olfaction has a unique ability to evoke memories and thus a scent can help consumers to identify a specific product by stimulating their olfactory memory.⁵⁹ However even if scents qualify as signs, so as to be entitled of TM protection, their extensive use in the market unavoidably raises the question of whether they are capable of functioning as TMs.⁶⁰ Particularly, Hawes⁶¹ argues that although scents can function as identifiers they might be lacking of distinctive character in a TM context.⁶²

Scents and Distinctiveness

In order for a sign to achieve the primary function of TM i.e. the indication of origin, a TM must be distinctive.⁶³ *The distinctive features of products enable consumers to locate them, even where they do not remember their name.*⁶⁴ Scents, as mentioned above, can help consumers identify a product by stimulating their olfactory memory⁶⁵, but in order to pass the distinctiveness test and thus being qualified for TM protection, scent marks should be able to invoke this mental link.⁶⁶ Such features may be a single sign attached to the product, the packaging, or even the product's smell.⁶⁷

Regarding olfactory marks Karapapa argues that, the degree of distinctiveness depends on the particular combination of the mark with the relevant product, i.e. a smell may be distinctive in relation to one product but not in relation to another.⁶⁸ In light of the OHIM

⁵⁹Ibid 1335, 1342.

⁶⁰Ibid 1340.

⁶¹Hawes, J 'Fragrances as Trademarks', (1989) 79 TMR 134, 137.

⁶²Ibid 142.

⁶³Karapapa (n 51) 1341.

⁶⁴Ibid 1342.

⁶⁵Hawes (n 61) 143.

⁶⁶Karapapa (n 51) 1342.

⁶⁷Hawes, (n 61) 143.

⁶⁸Karapapa (n 51) 1342.

and ECJ it could be argued that the inherent distinctiveness requirement in relation to scents could be fulfilled only when scent is attached to a normally unscented product or when the scent is specifically unique so as to attract consumer recognition.⁶⁹ For example, 'the smell of fresh cut grass' for tennis balls was said to be distinctive and was thus recognised as a CTM.⁷⁰ Since the applicant would be the only producer of scented tennis balls, consumer could straight away recognise its products.⁷¹ As mentioned above if marks are not inherently distinctive they may be granted protection when they have acquired distinctiveness through use.⁷²

Scents and Graphic Representation

As already mentioned, 'graphical representation is purely a technical requirement for registration purposes'⁷³ and in order to comply with this requirement TM applicant should present the sign in question, in a precise and comprehensive graphic form such as through drawing, writing or a graph.⁷⁴ The question regarding the requirements of GR was whether a third party was given clear information to understand and have an unequivocal idea of what was being claimed.⁷⁵

Before granting TM registration to the 'smell of fresh cut grass' in **Vennootschap**⁷⁶ a controversial debate concerning the GR of smell marks has taken place. One of the main arguments that was used to support that GR will be inadequate was that of subjectivity,

⁶⁹Ibid 1343.

⁷⁰Ibid.

⁷¹Ibid.

⁷²Burton (n 15) 381.

⁷³Burton (n 15) 380.

⁷⁴Karapapa (n 51) 1348

⁷⁵OHIM-Decision of the Second Board of Appeal, February 11th, 1999, 30 (3) I.I.C. 1999, 309, para. 13

⁷⁶Ibid 308.

i.e. that a specific smell is possibly to be perceived differently by different persons.⁷⁷ Even if there are smells that are very characteristic and distinctive, it is still inevitable that there are shades of variances and subjective impressions made on individuals exposed to them.⁷⁸ Moreover, there is the problem of the language in the sense that it is difficult to find a suitable descriptive phrase to describe a smell precisely.⁷⁹ When people describe a smell, they usually refer to an object.⁸⁰ That is to say that a distinct scent smells like a particular object and thus they do not describe the smell itself but the object where the smell originates from.⁸¹

According to *Sieckman*, as stated above, the GR has to be clear, precise, self-contained, easily accessible, intelligible, durable and objective.⁸² In this case the applicant sought to register a scent as a TM which had been described by means of three different methods namely by a sample of the scent, by the chemical formula of the scent and by verbal description.⁸³ The issue was whether each of these methods or a combination of the three was capable to satisfy the requirement of GR.⁸⁴ The ECJ concluded that these methods were not sufficient to render the scent capable of GR.⁸⁵ Regarding the chemical formula it was stated that such a formula lacks sufficient intelligibility and only qualified people would be able to infer or to recognise a specific scent from a mere chemical formula.⁸⁶ Besides, it was stated that the submission of a scent sample will not be able to constitute a GR due to the temporary nature of scents i.e. that they are neither stable nor du-

⁷⁷Bainbridge, 'Smell, sound colour and shape marks: an unhappy flirtation' (n 4) 224.

⁷⁸Ibid

⁷⁹Ibid

⁸⁰Ibid

⁸¹Schaal, C 'The Registration of Smell Trademarks in Europe: another EU Harmonisation Challenge' <from <http://www.inter-lawyer.com/lex-e-scripta/articles/trademarks-registration-smell-EU.htm>> Accessed 10 July 2012

⁸²*Sieckman* (n 22) 509.

83 Ibid 487

84 Ibid

⁸⁵ Ibid

⁸⁶ Ibid 511.

nable, as the chemical components could led to the gradual fading of the smell.⁸⁷ In respect of the verbal description of an odour it was stated that even though it is graphic it is not adequately clear, precise and objective.⁸⁸

Karapapa argues that it is doubtful how these criteria can be met regarding smells which by nature are devoid of visual character.⁸⁹ Besides it has been also said that GR is the greatest obstacle in seeking TM registration regarding scent marks⁹⁰ However, there is a view that this problem can be solved by various scientific and sophisticated techniques such as chromatography and spectrometry. According to these methods the chemical components can be realised as this method appraises and analyses the chemical structure of a smell and provides information of the quality and quantity of the olfactory mixture.⁹¹ While a *'detailed structural formula of pure substances is considered sufficient for the requirement of graphical representation under Article 2 of the TM Directive'*,⁹² the judgement of the ECJ in Sieckmann ruled that a chemical formula is not adequately clear and precise and therefore is contradictory to such methods.⁹³ Karki⁹⁴ provides that the question whether a normal person would comprehend the formula and have a precise idea of the smell has nothing to do with the possibility of a representation of the smell by means of graph.⁹⁵

2(d) Sounds

Sound marks which are now used to uniquely identify the commercial origin of goods or services could be deemed to fall in the category of innovative ways to communicate in-

⁸⁷ Ibid

⁸⁸ Ibid 499.

⁸⁹ Karapapa (n 51) 1348.

⁹⁰ Zedel, D and Pahl, D 'Making Sense of Trademarks', (1996) 89 TW 21, 25.

⁹¹ Karapapa(n 51) 1353.

⁹² Karki, M 'Non-traditional areas of IP protection: Colours, sounds, taste, smell, shape, slogan and trade dress' 2005,10 JIPR 499, 504.

⁹³ Ibid.

⁹⁴ Ibid

⁹⁵ Ibid.

formation to the public.⁹⁶ Especially, the entertainment world provides the public with trademarked sounds as their experience as consumers is not only visual but aural as well.⁹⁷ Nevertheless, recognising sounds as TM was not always feasible and has only occurred in recent years.⁹⁸

The leading case that dealt with the question whether sound marks may be registered as TMs was **Shield Mark**⁹⁹ which came before the Supreme Court of Netherlands. The Court asked the ECJ whether the TMD allows sound signs to be registered at all.¹⁰⁰ In this case a whole range of sound marks were in issue as Shield Mark had registered various signature tunes or jungles as sound TMs with the Benelux Trade Marks Office.¹⁰¹ Particularly, these TMs included a musical stave with the first nine notes of 'Für Elise' by Beethoven, description of music using specific notes one with reference of being played on a piano, another was a simple onomatopoeia and finally a sound mark consisting of a cockcrow.¹⁰² The ECJ stated that the description given in Article 2 of the Directive was not an exhaustive description, and therefore sound signs could be registered as TMs; provided of course that they are able to distinguish the goods or services of one undertaking from those of other undertakings and be capable of GR.¹⁰³

The ECJ having established that sound marks are not by nature unable to distinguish the goods of one undertaking from those of other, it focused on the issue of GR and applied the Sieckmann definition to sound marks.¹⁰⁴ The Court found that the written description of a sound by simply saying that the sign consists of the notes making up a well-known

⁹⁶ Basile, K 'Non-traditional trademarks: Tips to the 21st century' <<http://www.iam-magazine.com/issues/article.ashx?q=2e8994c5-9962-44b0-adff-ae674f204c36>> Accessed 25 July 2012

⁹⁷ Browing, H 'Sound Like...A Trademark' <<http://www.ipfrontline.com/depts/article.aspx?id=23399&deptid=4>> Accessed 4 August 2012

⁹⁸ McCormick, K 'Ding you are now free to register that sound' (2006) 96 TMR 1101, 1104.

⁹⁹ Case C-283/01, Shield Mark [2004] Ch 97

¹⁰⁰ *ibid*

¹⁰¹ *Ibid* 97.

¹⁰² *Ibid*.

¹⁰³ *Ibid*.

¹⁰⁴ Torremans (n 19) 395

work, the onomatopoeia, and the written sequence of musical notes all failed to pass the Sieckmann test, as they were neither clear, nor precise, nor objective enough.¹⁰⁵

The court however, come up with a solution for sound marks and stated that the requirement of GR may be satisfied by the use of conventional musical notation with *'..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'*.¹⁰⁶

Observations and Objections regarding the protection of sound marks under TM law.

Bainbridge, argues that the ruling in *Shield Mark* has caused serious doubts over some sound marks that have been previously registered as TMs such as the sound of a dog barking.¹⁰⁷ Such a sound is vague as it is unclear whether the barking is friendly or aggressive, how loud is it and how long is the duration.¹⁰⁸ This would unavoidably lead to the reader's subjective interpretation and therefore the mark would be rendered invalid if challenged.¹⁰⁹ Vaver¹¹⁰ agrees with the above statement as he states that the *Shield Mark* decision is not envisioning non-musical sounds and thus it has perhaps unintentionally limited the number of potential sound TMs.¹¹¹

It is noteworthy however, to point out that before the *Shield Mark* case, Metro Goldwyn-Mayer successfully registered 'its lion roar' as a sound mark and the GR of the roar was in the form of sonogram.¹¹² The Board of Appeal found that sonograms in principle represent a suitable GR.¹¹³ The *Shield Mark* case is at divergence with the decision in MGM as

¹⁰⁵ *Shield* (n 96) 119

¹⁰⁶ *Ibid.*

¹⁰⁷ UK registration No 2007456.

¹⁰⁸ Bainbridge (n 28) 675.

¹⁰⁹ *Ibid*

¹¹⁰ Vaver, D ' Unconventional and Well-Known Trademarks', (2005) SING. J. LEGAL STUD. 1,8.

¹¹¹ *Ibid.*

¹¹² Metro-Goldwyn Mayer Lion Corporation's Appeal relating to Community Trade Mark Application No. 143 891, Case R 781 / 1999-4, Decision of OHIM Fourth Board of Appeal.

¹¹³ Decision of OHIM Fourth Board of Appeal of 25 August 2003,

it did not consider sonograms and stressed only on musical notes.¹¹⁴ However the use of sonograms is inapplicable to the national systems because the holding of the MGM has not been adopted by the ECJ.¹¹⁵

Furthermore, it has been suggested that in the future we may be able to file a sound mark in digital form which would make things easier regarding the GR of sounds.¹¹⁶ The problem however with digital representation of sound marks is firstly, that the requirement of GR would be relaxed and replaced for digital sounds and music files and secondly, a sound mark may not be precisely the same when played through dissimilar computer and audio systems.¹¹⁷

Until the time when sound marks can be submitted in digital form it seems that conventional musical notation is the only option for GR of sounds¹¹⁸ This however is still considered to be a problematic method of representation since not everyone can read musical notation and as Bainbridge states it is likely that only few of those interested in TMs can have a real and precise perception of the nature and character of the mark, after looking at a piece of music represented in musical notation.¹¹⁹ Vaver suggests that such representation does not satisfy the Sieckmann criteria, as he states that musical notes comprising a stave and cleft is not an intelligible method of representing sound since it caters only to a music-literate audience.¹²⁰ Additionally, it is generally argued that, it is almost impossible to establish sound mark infringement since it is difficult to tell whether the alleged infringing sound was similar to the sound TM.¹²¹

¹¹⁴ Sahay (n 3) 139.

¹¹⁵ McCormick (n 98) 1112.

¹¹⁶ Bainbridge, *Intellectual Property* (n 28) 675.

¹¹⁷ Ibid

¹¹⁸ Ibid

¹¹⁹ Bainbridge, 'Smell, sound, colour and shape trade marks: an unhappy flirtation?' (n 4) 228.

¹²⁰ Vaver (n 110) 8.

¹²¹ Bainbridge, 'Smell, sound colour and shape marks: an unhappy flirtation' (n 4) 230.

3. NON-TRADITIONAL SIGNS IN UNITED KINGDOM

In UK TM law, the basic definition of a TM is given by section 1(1) of the Trade Mark Act 1994(TMA) which states that a TM is '*any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another*'.

3(a)Colours

In the UK only a few colour marks are now registered, and there is very limited material or higher instance rulings available on the registration of colours.¹²² Some of the registered colour marks in the UK are the colour silver in relation with anthracite briquettes,¹²³ the colour red attached to the pin of a shackle,¹²⁴ three red bands on the handle of badminton, squash and tennis rackets¹²⁵ and the colour green attached to the surface of a building.¹²⁶

In **Ty Nant**¹²⁷ a case that came before the Appointed Person, the issue was about the registrability of GR of the colour cobalt blue.¹²⁸ In this case the colour cobalt blue was claimed as a TM for water bottles and the description given was in terms of its optical characteristics.¹²⁹ Initially it was found by the Hearing Officer that the representation of the colour was insufficient for the purpose of identification of the sign.¹³⁰ In the appeal however it was found that even if the given GR was said to be insufficient for the purpose of identification of the mark, it was nonetheless considered to be in theory capable of be-

¹²²Schulze, C 'Registering colour trade marks in the European Union', (2003), 25(2) EIPR 55, 64.

¹²³United Kingdom Reg. No.B1372291 of February 6, 1989 by Sophia-Jacoba GmbH.

¹²⁴United Kingdom Reg. No. 1526441 of February 10, 1993 by The Crosby Group, Inc.

¹²⁵United Kingdom Reg. No. B1087349 of November 29, 1977 by Dunlop Sports Company Ltd

¹²⁶International Trademark Association Bulletin, Oct. 2, 1995, at 13.

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Ty Nant Spring Water Limited's Application [1999] E.T.M.R. 974,

¹²⁸ Ibid

¹²⁹ Ibid

¹³⁰Schulze (n 122) 64.

ing represented graphically.¹³¹ The Practice Amendment Circular dealt with the issue and found that marks consisting solely of colour may be represented by either including a specimen of the colour or by defining the colours by reference to a well known colour standard.¹³² Besides, if the distinctive character of the colour mark depends partly on other factors such as the way the colours are arranged or applied to the goods, this has to be shown as well.¹³³ Therefore case law and practise circular have contributed to make clear the issue of GR and have established that colours can in principle be registered as TM though only after submission of *'very strong evidence of acquired distinctiveness'*.¹³⁴

3(b) Scents

The first application for olfactory marks, that was brought after the enforcement of the TMA 1994 and which was unsuccessful, was about the registration of the fragrance 'Chanel No5' as an olfactory mark.¹³⁵ The application, failed on the basis of Article 7(1)(e) of the CTMR which states that to be registered as TM, shapes should not give substantial value to the goods themselves. *'In relation to perfumes, where the scent per se determines the purchase, the smell attributes such substantial value to the goods'*.¹³⁶ Since the primary purpose and function of a perfume is to emit fragrance, the smell of the perfume is the good itself, therefore it cannot function as TM¹³⁷

More recently in ***L'Oreal v Bellure***,¹³⁸ the defendants(Bellure) had been selling 'smell alike' imitations of expensive L'Oreal fragrances and L'Oreal brought a claim for TM in-

¹³¹ Ibid

¹³² Ibid

¹³³ Ibid

¹³⁴ Holah, M 'The boundaries of trademark protection in the United Kingdom, (2000) TW 35, 37.

¹³⁵ Schaal (n 81)

¹³⁶ Karapapa (n 51)1347.

¹³⁷ Schall (n 81)

¹³⁸ [2009] E.T.M.R. 55,

fringement.¹³⁹ Even though a smell can be trademarked in principle, there was no such TM registered. Non-registration of such a scent, may be justified on the requirement of non-functionality as a smell originating from a fragrance has a functional character and therefore cannot be trademarked. However, L'Oreal did establish TM infringement on the basis that the defendants took unfair advantage of L'Oreal's fragrances' reputation since the bottle and the packaging of some of Bellure's cheap imitation perfumes were identical with the bottles and packaging of L'Oreal's perfumes.¹⁴⁰ The shape of the bottles and packaging were validly registered as TM by L'Oreal. It can be suggested that since brands owners face difficulties in protecting the smell of their perfumes, they should rely on the registration and get up of the package of their fragrances so as to protect them from look-alike products.¹⁴¹

The first UK olfactory trade mark was '*a floral fragrance/smell reminiscent o froses applied to tyres*'.¹⁴² Another smell mark that was successfully registered was '*the strong smell of bitter beer applied to flight for darts*'.¹⁴³

It is submitted therefore that even if a scent is proved to be distinctive and capable of being represented graphically it may not be successfully registered as a TM because of the function it serves in relation to a product.¹⁴⁴ This is the concept that the functionality doctrine provides. '*By being the product themselves, perfumes are functional in the utilitarian sense*'¹⁴⁵ and therefore their smell will be refused registration as olfactory trade

¹³⁹Ibid 987.

¹⁴⁰Ibid 1032.

¹⁴¹<http://www.mwe.com/info/news/euroip1106-trademark.htm> <Accessed 5 September 2012>

¹⁴²UK reg. No 2001416/filing date Oct. 31, 1994.

¹⁴³Schaal (n 81)

¹⁴⁴Ibid

¹⁴⁵Karapapa (n 51) 1347.

mark.¹⁴⁶ It follows therefore that scents affixed to goods that are not normally fragranced would stand a bigger chance of being considered distinctive.¹⁴⁷

3(c) Sounds

The UK implementing legislation did not explicitly list sound as permissible for TM registration although it certainly provided the chance to register sounds.¹⁴⁸ It is interesting to mention that sound marks have provoked far less controversy than colour marks and smell marks.¹⁴⁹ It has become accepted practice, both at the UK Trade Marks Registry and OHIM, to permit registration of such marks provided that the GR is by means of musical notation and the other requirements for TM registrability are established.¹⁵⁰ The UK Patent Office *Trade Marks Works Manual* adds that '*Musical notation will be accepted as a graphical representation of a sound mark. If the instrument(s) upon which the sound is played forms part of the mark, this should be stated. The names of pieces of music will not be accepted as a graphical representation of the sound [since] pieces of music can be played in different ways [and besides] the title of the piece is too imprecise and cannot stand in place of the actual sound, even if well known.*'¹⁵¹ One of the most known cases of a registered sound mark in UK is the Direct Line Insurance telephone jingle, which is represented graphically by musical notation comprising 10 notes without any limitation regarding the instrument by which the sound is played.¹⁵²

3(d) The law of Passing off- An alternative way to protect non-traditional signs that were denied registration in UK.

As can be understood from the above, TM law imposes a lot of barriers to those aiming to register a sign as a TM and especially to those who own a non-traditional sign. However,

¹⁴⁶Karapapa (n 51) 1347

¹⁴⁷Karapapa (n 51) 1341

¹⁴⁸ McCormick (n 98) 1112

¹⁴⁹ Bainbridge, 'Smell, sound colour and shape marks: an unhappy flirtation' (n 4) 227.

¹⁵⁰Ibid

¹⁵¹August 1998, Ch.6, p.22, para 2.3.6.

¹⁵²Registration No. 2000 778, registered in class 36 Applied for on October of, 1994.

all those marks that for various reasons could not be registered as valid TMs are still capable of being protected under the law of passing off which was developed in UK. Passing off is responsible to protect the goodwill and the reputation of famous signs from dishonest competition.¹⁵³ The law of passing off is based on the idea that it should be an offence for one trader to misrepresent his goods or services as those of another and so deceive consumers into buying his goods when they were with the impression that they were buying those of another.¹⁵⁴ That is to say that a passing off claim will be based on a defendant's unauthorized use of a distinctive mark that the plaintiff uses to identify its good or services.¹⁵⁵ A plaintiff who raises a passing off claim need not have a valid TM and therefore just because a mark is not registered does not mean that the person using a similar mark will not infringe.¹⁵⁶

Requirements for a Passing off claim.

According to the **Jif Lemon Case**¹⁵⁷ in order to establish a claim for passing off three elements must be present. Firstly it is necessary to establish that a TM has a goodwill or reputation, secondly that a misrepresentation or confusion as to the origin of the goods has taken place and thirdly it must be shown that there is likelihood of damage as a consequence of the deception.¹⁵⁸

The law of passing off provides among others protection over trade dress, get-up and the packaging of goods, since a person may acquire goodwill through use of particular get

¹⁵³ 'Passing off'

¹⁵⁴ <http://www.behanlegal.com/KnowledgeCentre/TrademarksIntellectualProperty/Passingoff/tabid/285/Default.aspx> Accessed 20 August 2012

¹⁵⁴ 'How To Protect Your Brand and reputation: Unregistered Trade Marks and Passing Off' Accessed 25 August 2012 <<http://ip-active.com/trademarks/unregistered-trademarks.php>

¹⁵⁵ Nature and Purpose of Trademark Protection

<<http://www.lexisnexis.com/lawschool/study/understanding/pdf/TrademarkCh01.PDF>> Accessed 28 August 2012

¹⁵⁶ Ibid

¹⁵⁷ [1990] 1 All ER 873

¹⁵⁸ Ibid 880.

up such as a particular colour on the product itself or on the packaging of the product.¹⁵⁹ Therefore consumers will identify products by their external characteristics rather than by words.¹⁶⁰ In order to show that a claimant has goodwill associated with the get up of its product and therefore to succeed in a claim in passing off he has to show that the consumers recognise that the get up is distinctive of the claimant's goods or services.¹⁶¹ Like in TM law descriptive and generic signs can only be protected under passing off when the claimant shows that they have acquired secondary meaning through use.¹⁶²

It is noteworthy to refer again to, *L'Oreal v Bellure* case, where the claimants in addition to their TM infringement claims, they also brought claims for passing off in respect to the defendants' fragrances.¹⁶³ It was stated that to establish passing off, L'Oréal had to prove that it had goodwill or reputation attached to its perfumes, that the get-up or packaging of the defendants' perfumes constitute a misrepresentation that was likely to make the consumers think that the perfumes were L'Oréal perfumes, and that it had suffer damage as a result.¹⁶⁴ The Court however, although found that the defendants exploited the reputation of L'Oreal by selling 'look alike perfumes' it rejected L'Oréal's claims, stating that the similarity of the smell-alike' get-up was not enough to create a likelihood of confusion among L'Oréal's perfumes and those of the defendants.¹⁶⁵

Furthermore, the need to show that the consumers consider a particular characteristic of a product as indicating source will be specifically difficult where the relevant product feature performs some function.¹⁶⁶ Though there is no a particular policy exception to passing off action for functional features and no need that features of get up be eccentric it will be very difficult for a trader to show that the consumers view, functional or uncom-

¹⁵⁹ Bentley, L and Sherman, B *Intellectual Property Law*, (3rdedn, Oxford University Press, New York 2008) 732.

¹⁶⁰ Ibid

¹⁶¹ Ibid

¹⁶² Li Yan 'A comparative study of Passing off among the UK, Japan, China'(2011) 20 IPP Bulletin 1, 2.

¹⁶³ *L'Oreal v Bellure*[2007] ETMR 1, 4.

¹⁶⁴ Ibid 45-46

¹⁶⁵ Ibid 37

¹⁶⁶ Bentley and Sherman (n 159) 733

mon features of a product, as indicating source.¹⁶⁷ In **Hodkinson v Wards Mobility**¹⁶⁸ however Jacob J stated that a defendant may commit passing off even if he has copied only functional features of the plaintiff's product provided that the copying of functional features is capable of deceiving the consumers as to the origin of the product.¹⁶⁹

Advantages of the law of Passing Off

Whilst in principle, get up of a product is now allowed to be register as a TM, the ECJ has shown that a restrictive approach will be adopted for the registration '*of such features, because of the interest in keeping the market open*'.¹⁷⁰ This was acknowledged in *Libertel* where, the court recognised the danger in permitting certain traders to monopolise all available colours.¹⁷¹ Therefore in the case where a trader will not be protected under TM law because this would give them monopoly rights over a colour for example,¹⁷² the law of passing off can intervene to protect the trader's mark in case where someone else uses his mark and this causes confusion to the public.¹⁷³

It is submitted therefore that various signs which have acquired goodwill through use and which were denied protection under TM law on the basis of the depletion theory, are capable of being protected under the law of passing off as it grants protection to them without unduly hindering the activities of other traders.¹⁷⁴

Moreover, regarding olfactory marks, which are often denied registration on the ground that they cannot be represented graphically, it seems that the law of passing off can offer them protection since the common-law protection of passing off is not based on registra-

¹⁶⁷ Ibid

¹⁶⁸ [1995] FSR 169 (HC)

¹⁶⁹ [1995] FSR 169 (HC) at 176-177, per Jacob J

¹⁷⁰ Shuilleabhain, 'M' Common law protection of trade marks: the continuing relevance of the law of passing off (2003) 34 IIC 722, 736-737.

¹⁷¹ Libertel (n 13) para 47-49,54

¹⁷² Shuilleabhain (n 170) 750.

¹⁷³ Ibid.

¹⁷⁴ Bainbridge, 'Smell, sound colour and shape marks: an unhappy flirtation' (n 4) 245.

tion and therefore the GR obstacle does not arise.¹⁷⁵ However it is a requirement, that the relevant scent does not come from a perfume as this would mean that the scent is part of the features of the product itself rather than an indication of its origin.¹⁷⁶ Besides in *L'Oreal v Bellure* it was stated that a smell of a perfume could not constitute part of the goodwill of a specific brand of perfumes.¹⁷⁷

One of the greatest advantages of passing off is the ability to react on a case by case basis since the absolute nature of statutory rights such as TM law might be denied to some features on the ground of policy¹⁷⁸ Besides, passing off apart from protecting signs that are absolutely unregistrable, it may also offer important bridging protection for those signs that may become registrable after extensive use.¹⁷⁹

It can be concluded, that the rules under the law of passing off seem more relaxed than the rules of TM law therefore the owners of signs that face difficulties in registering their signs they still have the chance to obtain protection under passing off.

4. NON-TRADITIONAL SIGNS IN GERMANY.

4(a) Colours

Traditionally, colours under German TM Law could only be protected as part of the product's get up. That is to say that colour or colour combination were '*only capable of registration as a trade mark within the frame work of the packaging*'¹⁸⁰ and there was no '*abstract protection for contour free colours*'.¹⁸¹ Since colours are generally used in connec-

¹⁷⁵Shuilleabhain (n 170) 730-731.

¹⁷⁶*L'Oreal Bellure* [2007] ETMR 1, 46.

¹⁷⁷*Ibid* 46.

¹⁷⁸Shuilleabhain (n 170) 750.

¹⁷⁹ *Ibid*.

¹⁸⁰FP C decision, *Black/Zinc-yellow* [1999] I.I.C. 700.

¹⁸¹ *Ibid*

tion with images, words, or a certain shape of a product were indirectly protected as part of the whole get up.¹⁸²

The enforcement of the new German TMA 1995, which was amended in the light of the Harmonization TMD, and the decision of the Federal Supreme Court (FSC) in Yellow/Black,¹⁸³ single colours and colour combinations as abstract colour marks are in principle capable of protection as registered TMs, provided that they satisfy the requirement of s.3(1) of the German TMA 1995.¹⁸⁴ *'The wording of section 3(1) was meant to give a non-exhaustive list of examples of protectable signs rather than to limit them to specific types'*.¹⁸⁵ Therefore colour is now protected under German TM law without being part of a linear or shaped object.¹⁸⁶

Colours and Graphical Representation

In Germany to protect a single colour, no drawing is required.¹⁸⁷ The requirement of GR for abstract colour TM, differs from those dependent on a concrete form of use.¹⁸⁸ The only factor that should be determined is the colour shade.¹⁸⁹ The applicant must give the colour classification system and number of the particular colour shade under that system.¹⁹⁰ The object on which the colour is attached and the contours of the colour are both undetermined.¹⁹¹

However for colour combinations the issue of GR is more complex. In Aral/Blue for example the German Patent Office rejected an application which included rectangular, equal sized colour samples in blue and white on the grounds that the mark could not be repre-

¹⁸² Caldarola, M ' Questions relating to abstract colour trade marks: recent developments in Germany' (2003) 25 EIPR 248, 248

¹⁸³ FSC decision [1999] I.O.C 808, Yellow/ Black

¹⁸⁴ Ibid.

¹⁸⁵ Schulze (n 122) 59.

¹⁸⁶ Caldarola (n 182)249

¹⁸⁷ Ibid 250

¹⁸⁸ Ibid

¹⁸⁹ Ibid

¹⁹⁰ Ibid

¹⁹¹ Ibid

sented graphically as it lacked satisfactory degree of certainty.¹⁹² On appeal *'the applicant specified the colour shades by reference to a colour-coding system and stated that the colours would be used 50:50 per cent ratio which the FPC found to satisfy the requirements of graphical representation'*.¹⁹³ Nevertheless, Stroebele suggests that since it has now been accepted that abstract, contour free colours are capable to be registered as TMs, *'the conventional requirements concerning certainty cannot be maintained with respect to colour marks, at least to the extent that they ultimately contain a specification of some kind of contour.'*¹⁹⁴

In Yellow/Green the FSC found that colour combinations mark 'without contours' was sufficiently graphically represented by giving in two coloured rectangles, reference to colour coding system.¹⁹⁵ Additional specification about ratio and distribution of colours were said to be inappropriate to the concept of colour mark without contour.¹⁹⁶

Colours and Distinctiveness

According to section 8(2)(1) of the TMA 1995 a TM which lacks distinctive character in relation to the goods or service shall not be registered. Generally there is the view that consumers perceive the use of colours in most enterprises as decorative elements in advertising.¹⁹⁷ Moreover, it is argued that since a large number of colour shades exist, the ability of the average consumer to distinguish between such shades is restricted.¹⁹⁸

For these reasons initially the Federal Patent Court (FPC) has found in all cases relating to abstract colour marks that colours are devoid of distinctive character with respect to the goods or services claimed.¹⁹⁹

¹⁹² [1999] IIC 812

¹⁹³ Schulze (n 122) 59.

¹⁹⁴ Schulze (n 122) citing Stroebele, P 'Die Eintragungsfähigkeit neuer Markenformen [1999] GRUR 10 41

¹⁹⁵ [2002] WRP 450

¹⁹⁶ Schulze (n 122) 59

¹⁹⁷ Ibid.

¹⁹⁸ Ibid.

¹⁹⁹ Ibid 59-60.

Nevertheless, some of these decisions were later reversed by the FSC such as Grey/Magenta,²⁰⁰ Black/Zinc-Yellow²⁰¹ and Violet²⁰² and it was established that the '*distinctiveness of colours per se had incorrectly been denied as a general rule*'.²⁰³

In *Black/Zinc-Yellow* FSC stated that a colour combination is not inherently capable to function as an indication of origin but this would not imply that a colour shade or a colour combination lack inherent distinctiveness for any product when assessed on a TM base.²⁰⁴

Similarly with EU and UK law German TMA, provisions state that a mark which is not inherently distinctive can be registered when it has acquired secondary meaning, unless it is not capable of distinctiveness in Germany.²⁰⁵ Grey/Magenta was returned to the FPC and it was found that the colour or colour combination was not distinctive per se but had acquired distinctiveness through use. In ***Violet*** case²⁰⁶ it was stated that the minimum amount of distinctiveness is satisfactory for the registrability of any kind of TM, even if there was a great interest in the trade to keep the particular colour free from use by other businesses.²⁰⁷ That is to say that, nothing will justify stricter requirements in relation to distinctiveness.²⁰⁸

It is submitted therefore that German TM Law both through case law and through the introduction of the new German Act, seems more relaxed and keener in allowing abstract colour marks to be registered as TM.

²⁰⁰ BGH [1997] WRP 748

²⁰¹ BGH IZB 5/98 of March 25, 1999

²⁰² BGH, Urt.v. 1.3.2001-IZB 57/98

²⁰³ Schulze (n 122) 60.

²⁰⁴ BGH I Z.B 5/98 of March 25, 1999—Schwarz Zink- gelb

²⁰⁵ Section 8(3) TMA 1995

²⁰⁶ BGH, Urt. V. 1.3.2001—I Z.B. 57/98—Farbmarkeviolettfarben

²⁰⁷ Ibid

²⁰⁸ Caldarola (n 182)251.

4(b) Scents

In principle, scents may be registered as TM in Germany if they are proved to be distinctive.²⁰⁹ However, after ECJ's Sieckmann decision, the German PTO has not yet found any means to represent scent marks graphically in the required '*clear, precise, self-contained, easily accessible, intelligible, durable and objective manner*'.²¹⁰ At the moment, there is no reliable and consistent coding system for scents.²¹¹

4(c) Sounds

Germany upholds one of the first places regarding the number of national sound mark registrations. This is justified by the fact that section 3(1) of the German TMA 1995 explicitly refers to 'sound marks' as being capable of protection under TM law.²¹² Germany had originally accepted sonograms as a permitted method of GR for sound mark applications, but after the Sieckmann decision, sonograms are no longer regarded and recognized as appropriate.²¹³ In contrast to the practise of the OHIM the German Patent and Trade Mark Office (PTO) does not accept spectrograms as they are inadequately intelligible.²¹⁴

4(d) Unfair Competition Law-An alternative way to protect non-traditional signs that were denied registration under TM law in Germany.

Germany has also two different types of protection for various signs: TM law for registered signs and unfair completion law against counterfeiting of registered and unregistered signs.²¹⁵ In order to benefit from the principles of UC the claimant must establish that the get up of its product is competitive distinctive, the product is distributed in Germany and enjoys a good reputation and that the imitated goods either create confusion

²⁰⁹ Weber, N and Viefhues, M 'The tradition of non-traditional TM in Germany', <http://www.jonas-lawyers.com/pdf/wtr0708_weber_viefhues.pdf> Accessed 3 September 2012

²¹⁰ Ibid

²¹¹ Ibid.

²¹² McCormick (n 98) 1112.

²¹³ Ibid.

²¹⁴ Weber and Viefhues (n 209)

²¹⁵ 'United States: Trademark And Unfair Competition In The UK, Germany And Italy' <<http://www.mondaq.com/unitedstates/article.asp?articleid=25993>> Accessed August 31 2012

in the consumers' minds as to the product's origin or damage the reputation of the product.²¹⁶

In **Lego v OHIM**²¹⁷ a case brought to the ECJ, the shape of Lego brick was denied registration as a TM, because its shape was necessary to obtain a technical result and therefore could not benefit from TM protection.²¹⁸ The ECJ however indicated that Lego could be able to be protected against slavish copying of the brick under the rules UC law.²¹⁹

Recently, the Higher Regional Court of Hamburg (HRCH) followed the approach that ECJ indicated and provided protection under the law of UC to Lego in respect of its plastic brick products.²²⁰ A competitor was found to have deceived consumers regarding the origin of its product under section 4(9)(a) of the Act against Unfair Competition since had sold bricks which were similar to Lego bricks and the packaging he used displayed both bricks and their characteristic studs.²²¹ The HRCH granted protection to Lego on the basis that the competitors of such bricks could continue trading in the same business sector without deceiving the consumers as to origin of their products.²²²

Although this case refers exclusively to the protection of a three-dimensional signs such as shapes, it indicates that any signs that are denied registration, for example on the ground that they serve a functional purpose, are still entitled of protection against imitation under the rules of UC provided of course that they satisfy the relevant requirements. As stated above, an UC claim may be also brought and succeed even in the absence of confusion, provided that the imitation of a product or a mark takes unfair advantage or damages the reputation of the genuine product according to section 4(9)(b) of the Act against UC.²²³

²¹⁶ Design and Trade Dress in Germany
<<http://www.worldtrademarkreview.com/issues/article.ashx?g=9e146542-3cf2-4126-9638-3d7d5c4da86e>>
Accessed 4 September 2012.

²¹⁷ Lego Juris v OHIM, Case C-48/09 P, [2010] E.T.M.R. 63,

²¹⁸ Ibid

²¹⁹ Ibid 1155.

²²⁰ 3 U 83/10 Lego, Higher Regional Court of Hamburg

²²¹ Ibid

²²² Ibid

²²³ 4(9)(b) of the Act against Unfair Competition

5. NON-TRADITIONAL SIGNS IN THE UNITED STATES

5)(a) Colours

Historically, United States courts were unwilling to allow single colours or colour combinations to be registered as TMs.²²⁴ Particularly in a case, it was stated that *'sometimes a colour, taken in connection with other characteristics, may serve to distinguish one's goods, and thus be protected by the courts..; but as a rule, a colour cannot be monopolized to distinguish a product'*.²²⁵ The courts viewed that a single colour could not function as a TM and they feared that with the protection of a single colour, the colours available to competitors would be exhausted based on the 'colour depletion' rule.²²⁶

With time TM registrability standards have been relaxed mainly due to the introduction of the Lanham Act 1946 (LA) whose drafters aimed to liberalize and expand TM protection so as to keep up with modern business practices.²²⁷ Accordingly, the Act defines a TM broadly, as *'any word, symbol, or device of any combination thereof [which a trader or a manufacturer] uses to identify and distinguish his goods..from those manufactured or sold by another..'*²²⁸ Although colours are not explicitly listed as potential TM in the LA definition there is nothing in the Act to prevent a single colour, or any other unconventional from being the subject-matter of a TM.

The first case since the enactment of the LA, which recognized the registrability and protectability of a single colour as a TM was **Owens-Corning**,²²⁹ where the Federal Circuit rejected an absolute prohibition on the registrability of the colour pink for fiberglass insulation.²³⁰ However, after Owens decision great uncertainty followed since US courts

²²⁴ Ladas & Parry (n 27)

²²⁵ Diamond Match Co. v. Saginaw Match Co., 142 F. 727, 729 (6th Cir. 1906)

²²⁶ Ladas & Parry (n 27)

²²⁷ Churovich, D 'Scents, Sense or Cents?; Something Stinks in the Lanham Act (2001) 20 St.LouisU.Pub.L.Rev. 293, 296.

²²⁸ Lanham Act 1946 § 45 (15 U.S.C. § 1127)

²²⁹ In re Owens-Corning Fiberglass Corp., 774 F.2d 1116 (Fed. Cir. 1985).

²³⁰ Ibid 1120.

were divided over the issue of single colour marks²³¹ In **NutraSweet**²³² for example the courts did not follow the ruling in Owens-Corning i.e. that a single colour could be protectable and ruled that colour blue could not function as a TM for sweetener packets.²³³

The issue on whether a single colour should be registered as TM was finally resolved in 1995 in **Qualitex**²³⁴ where it was held that a dry cleaning business (Qualitex) validly registered a particular shade of colour green gold for its cleaning pads as a TM. Following that, the Supreme Court also held that a competing business which used similar shade of that colour on its cleaning pads infringed Qualitex Trade mark. The Court stated that *'sometimes, a color will meet ordinary legal trademark requirements. And when it does so, no special legal rule prevents color alone from serving as a trademark.'*²³⁵

The Supreme Court by looking to the language of the LA and the principles of TM law decided that a colour per se could be included within the category of signs that can serve as a TMs.²³⁶ The Court acknowledged that a product's colour is not like arbitrary, fanciful or unusual words or designs which automatically tell to the public that they refer to a specific brand but it also pointed out that over time a particular colour on a product may acquire that attribute and be capable to signify a brand.²³⁷ That is to say that as long as a colour could serve the function of indicating the source or the brand of a product in an equal way that words can indicate then there is no reason why to deny a color per se to be registered as a TM. As the Court put it *'it is the source- distinguishing ability of a mark-not its ontological status as a color shape, fragrance, word or sign- that permits it to serve [as a TM].'*²³⁸

The doctrine of Functionality

²³¹ Morico, P Protecting colour per se in the Wake of Qualitex

²³² Nutrasweet Co. v. Stadt Corp., 917 F. 2d (7th Circ. 1990) 1024.

²³³ Ibid 1026, 1028.

²³⁴ Qualitex Co v Jacobson Products Co 514 U.S 159 (1995)

²³⁵ Ibid 161.

²³⁶ Qualitex (1995) 115 S. Ct 1300, 1302.

²³⁷ Ibid 1303.

²³⁸ Ibid 1304 .

As stated above, it is generally accepted that colour marks that are considered to be 'essential to the use or purpose of the article or...[they] affect the cost or quality of the article' will be considered functional and therefore will not be registered.²³⁹ A color that performs some utilitarian function in connection with a product cannot be appropriated as a trade mark²⁴⁰ as this will grant monopoly rights to a trader over the colour and will hinder competitors from using it. The Supreme Court stated that while sometimes colours are important in indicating some important information about the product itself (unrelated to origin identification) or in making the product more desirable (aesthetic functionality), there are also times that the colour is not necessary for the product's use or purpose and does not influence cost or quality.²⁴¹ This shows that the doctrine of functionality does not create an absolute prohibition to the use of a single colour as a TM.²⁴²

Colour Depletion Theory

The Court in *Qualitex* rejected colour depletion theory by stating that it is unpersuasive, as it is based on an irregular problem to excuse a blanket prohibition.²⁴³ The court also argued that functionality doctrine was sufficient to safeguard against any anticompetitive concerns that might occur in case where all available colours would be exhausted.²⁴⁴

5(a)(i) Louboutin 's red sole mark

The aforementioned theories were invoked and discussed in detail in a recent case called ***Louboutin v YSL***,²⁴⁵ as the court relied on the aesthetic functionality, depletion theory, and shade confusion theory when it initially denied the validity of the red sole mark on the Louboutin shoes. Very recently however (on 5 September 2012) that decision was overturned on appeal by the 2nd US Circuit Court of Appeals in New York where it was

²³⁹Inwood Labs v Ives Laboratories 456 US 844 at 85

²⁴⁰Moir, D 'Trademark Protection of Color Alone : How and When... inherently distinctive' (2011) 27(2) article 9 407,427 citing McCarthy,T, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION(4th ed. 2010)

²⁴¹Qualitex (n 236) 1304.

²⁴²Ibid

²⁴³Qualitex(n 234) 168.

²⁴⁴Doll (n 50)578.

²⁴⁵Louboutin v YSL 778 F.Supp.2d 445, (2011)

ruled that Christian Louboutin is now entitled to protect his shoes from imitation by trademarking the red sole.²⁴⁶ The Court of Appeals ruled that the red soles were a '*distinctive symbol that qualifies for trademark protection*'.²⁴⁷

The red outsole has appeared virtually on all Louboutin shoes since 1992 and in 2008 the 'red sole mark' was granted TM registration in the US, giving protection to 'a lacquered red sole on footwear'.²⁴⁸ Gradually, the red sole has become a great visual sign, broadly recognised by consumers as a TM of the Louboutin brand.²⁴⁹ However, despite the great association in consumer's minds between the red sole and the Louboutin brand, the red sole mark was threatened to lose its TM protection²⁵⁰ as Louboutin's U.S TM registration has recently been challenged by the luxury fashion house, Yves Saint Laurent, (YSL) which also features red-soled shoes.²⁵¹ Although Louboutin's red sole is now entitled of trademark protection, after the recent decision of the Court of Appeals in New York, it is worth mentioning the various arguments that were made in the US District Court(DC) where the Louboutin's red sole was denied TM protection.

Aesthetic Functionality Doctrine

YSL claimed that the use of colours in the fashion industry is intended to serve ornamental and aesthetic purposes rather than to indicate a specific commercial source.²⁵² The DC agreed with YSL and found that the colour red as used by Louboutin is purely aesthetically functional and therefore not entitled to TM protection.²⁵³

²⁴⁶O'Neil, L 'Christian Louboutin wins red-sole trademark case'

<http://www.cbc.ca/news/yourcommunity/2012/09/christian-louboutin-wins-red-sole-trademark-case.html> , Accessed 7 September 2012

²⁴⁷Christian Louboutin v. YSL 09/05/2012 11-3303 - US 2nd Circuit

²⁴⁸Registration No. 3361597

²⁴⁹Gorman, D 'Protecting Single Color Trademarks in Fashion after Louboutin (2012) 30 Caedozo arts &Ent.L.J 101, 102.

²⁵⁰Ibid.

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Clancy, P 'Should Colour be Accorded Trade-mark Protection in the Fashion Industry? Louboutin's "Lacquered Red Sole" Trade-mark in Jeopardy in U.S.' <<http://www.clancybrionraffoul.com/2012/news/should-colour-be-accorded-trade-mark-protection-in-the-fashion-industry-louboutins-lacquered-red-sole-trade-mark-in-jeopardy-in-u-s/> Accessed August 3 2012

²⁵²Louboutin (n 245) 449.

²⁵³Ibid

The aesthetic functionality doctrine is based on the idea that the visual value of a sign may be '*an important ingredient in the commercial success of the product*',²⁵⁴ which suggests that such a sign should not merit TM protection since it must be free for all to reproduce it for reasons of fair competition.²⁵⁵

In *Louboutin*, the DC interpreted the notion of aesthetic functionality too broadly²⁵⁶ and found that generally in the fashion industry, colour is used in designs mainly to promote expressive, ornamental and aesthetic purposes.²⁵⁷ Regarding the aesthetic functionality of the red sole and consequently its non-TM functions the court elaborated by stating that the red sole's function is to '*attract, to reference, to stand out, to blend in, to beautify, to endow with sex appeal*..²⁵⁸

It can be argued therefore, that the DC's rationale in *Louboutin* was capable of threatening many currently enforceable multi-colour TMs in fashion such as the red and green Gucci stripe, or TMs that use color in '*patterns or combinations*'²⁵⁹, such as the Burberry check'.²⁶⁰ That is to say that, the generalized interpretation of aesthetic functionality by the DC, would exclude nearly every mark in fashion from TM protection, and would generate the belief that a visually attractive mark is essential for free competition since fashion is based on aesthetic beauty.²⁶¹ Besides Colman²⁶² argues that those functional roles of colour quoted by the DC could have been invoked to render virtually all colour marks- not only those used in the fashion market- unprotectable.²⁶³

²⁵⁴ Pagliero v Wallace China Co 198 F.2d 339, 343 (9th Cir. 1952)

²⁵⁵ Gorman (n 249)117.

²⁵⁶ Ibid 118

²⁵⁷ Louboutin (n 245) 451.

²⁵⁸ Louboutin (n 245) 454.

²⁵⁹ Louboutin (n 245) 451.

²⁶⁰ Gorman (n 249) 104.

²⁶¹ Ibid 119.

²⁶² Charles E. Colman, 'A red-Leather Year for Aesthetic Functionality, Landslide: A Publication of the ABA Section of Intellectual Property Law(Nov./Dec. 2011),

²⁶³ Ibid 29.

Many commentators argue against such a broad understanding of aesthetic functionality.²⁶⁴ McCarthy, argues that the premise of 'aesthetic functionality' is an unjustifiable and illogical extension of the functionality policy, bring it beyond the utilitarian rationale that created the policy.²⁶⁵ He believes that, the question whether consumers perceive a sign as an ornamental feature or also as a symbol that recognize and distinguishes a single source could be performed better by the 'merely ornamental' rule rather than the broad idea of the aesthetic functionality doctrine.²⁶⁶ Krieger, states that it is conflicting to deny TM protection to signs on the ground of their consumer appeal and demand because '*creation of this demand is a recognized trademark function*'.²⁶⁷ Furthermore, the potential scope of the extensive aesthetic functionality standard is incompatible with the legislative aim and development of the LA, which aims to protect strong TM.²⁶⁸

Color depletion theory

Apart from the aesthetic functionality doctrine the DC in *Louboutin* proffered also the colour depletion theory to justify denial of TM to single colour marks. The color depletion theory is associated with the issue of hindering of competition. In *Louboutin*, the DC stated that '*Louboutin claim would cast a red cloud over the whole industry, cramping what other designers could do, while allowing Louboutin to paint with a full palette*'.²⁶⁹ Therefore, such a monopoly on the colour red would unjustifiably inhibit competition between other designers.²⁷⁰ The Court also stated that '*the law should not countenance restraints that would interfere with creativity and stifle competition*'.²⁷¹

²⁶⁴Gorman (n 249)119

²⁶⁵Gorman (n 249) citing McCarthy, T 'McCarthy on Trademarks and Unfair Competition' para 7:81 (4th ed. 2004)

²⁶⁶ Ibid

²⁶⁷Krieger, D 'The Broad Sweep of Aesthetic Functionality: A threat to trademark Protection of Aesthetic Product Features', (1982) 51 Forham L. Rev. 345, 348.

²⁶⁸Gorman (n 249)119.

²⁶⁹Louboutin (n 245) 454.

²⁷⁰Ibid.

²⁷¹Ibid 453.

Gorman states that there are a variety of flaws and problems with DC's understanding of the colour depletion theory.²⁷² The DC as stated above found that, by registering red as a TM, Louboutin would be able to sell a total outfit in the specific red, while other designers would not.²⁷³ Gorman argues that this is not the case as the Louboutin's TM registration limits the red mark to shoes and particularly on the outsole of the shoe.²⁷⁴ That is to say that the court failed to realise that Louboutin's red mark is an exceptionally uncommon practice regarding both the mark's placement as well as its unnatural shade.²⁷⁵ This would therefore render Louboutin's mark less anti-competitive than if the issue of the red colour mark referred to coloured trousers or bags, where use of a single colour is ordinary and the risk of depletion obvious.²⁷⁶

What can be assumed is that the DC in Louboutin` *neglected the specific facts of the case in favour of applying the colour depletion theory at the outset.*²⁷⁷ As it was stated in *Owens Corning case* and *Master Distributors*²⁷⁸ each case should be decided on its own facts²⁷⁹ and where a sign has met all the essential TM requirements, the colour depletion theory should not obstruct the single colour sign from protection²⁸⁰

Generally, colour depletion theory fails to take into account the fact that colours had many different shades and therefore it underestimates the existence of thousands of different colours visible to the human eye.²⁸¹ Therefore the colour depletion is less of a real threat where reproduction of precise shades on a specific product is permitted through modern technology.²⁸²

²⁷² Gorman (n 249)110.

²⁷³ Louboutin (n 245)454.

²⁷⁴ Registration No. 3361597(claiming red as a feature o the mark, which `consists of a lacquered red sole on footwear)

²⁷⁵ Samuels, J and Samuels, L `Color Trademarks: Shades of Confusion,(1993) 83 TRADEMARKS REP. 554, 569.

²⁷⁶ Gorman (n 249)111.

²⁷⁷ Gorman (n 249) 111.

²⁷⁸ Master Distribs. V Pako Corp. 986 F.2d 219 (8th Cir. 1993)

²⁷⁹ Ibid 222

²⁸⁰ Ibid 223

²⁸¹ Newman, S `Kill the `Mere Colour` Rule: Equal Protection for Color under the Lanham Act, (1994) 61 U. CHI. L. REV. 1595,1610.

²⁸² Ibid 1613

Shade Confusion Theory

Nevertheless, it has been also argued that variations in individual shades of colour would be too hard to distinguish by consumers²⁸³ which would lead in shade confusion problems and consequently will give rise for a claim against infringement based on likelihood of confusion. In *Master Distributors*, however, it was stated that even though protecting specific shades of colour may lead in shade confusion problems, the likelihood of confusion among colour shades is no more common than the likelihood of confusion between similar word marks.²⁸⁴

After all, however, Louboutin is now entitled to protect his red sole mark under TM law after the Court of Appeals decision where it was stated that *'the district court's conclusion that a single color can never serve as a trademark in the fashion industry was based on an incorrect understanding of the doctrine of aesthetic functionality'*.²⁸⁵

5(b)Scents

There is nothing in the provisions of the LA to prevent a fragrance from being the subject matter for a TM.²⁸⁶ However as Burton²⁸⁷ states, scents are usually an ornamental or functional characteristic of a product and thus cannot be considered as distinctive.²⁸⁸ Since at prima facie scents are not capable of identifying and distinguishing, they must acquire secondary meaning.²⁸⁹ According to the LA, in order to show secondary meaning the mark must point the consumer's mind in the direction of some independent source.²⁹⁰ Of course there will be no guarantee that scents are a trustworthy mechanism

²⁸³ Landau, M ' Trademark Protection for Color per se After Qualitex Co. V Jacobson Products Co.: Another Grey Area in the Law', (1995) 2 UCLA ENT. L. REV. 1, 11.

²⁸⁴ Master distrib(n 278) 223.

²⁸⁵ Christian Louboutin v. YSL 09/05/2012 11-3303 - US 2nd Circuit

²⁸⁶ Burton (n 15), 378

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Ibid

²⁸⁸ Ibid 379

²⁸⁹ Ibid.

²⁹⁰ Churovich (n 227) 311

to convey such an important message without any possibility of confusion.²⁹¹ For this reason, the question whether scents are capable of acquiring secondary meaning in the TM sense is a difficult question.²⁹²

In **Re Clarke**²⁹³ case, Clarke manufactured a yarn scented with '*a high-impact, fresh floral fragrance reminiscent of plumeria blossoms*' and which was packaged in such a way so that the smell of the fragrance is not precluded at the point of sale.²⁹⁴ The application of Clarke to register the scent as a TM was initially rejected on the grounds that it did not function as a TM and was functional.²⁹⁵ On appeal Clarke was successful as the issue of functionality was dropped and Clarke succeeded in proving validity and registering the above description of the fragrance.²⁹⁶

The recognition of the particular scent mark to be registered as a TM, can be explained by the fact that Clarke was the only manufacturer to add scent to yarn all over the US and this made her yarn undoubtedly distinguishable from any other yarn.²⁹⁷ Moreover Clarke emphasised that her yarn was scented in her advertising, which meant that the scent might have acquired secondary meaning.²⁹⁸

On the other hand, the scent was no different from any other notable feature of a product and the decision has been criticised for not focusing on whether the particular scent was capable of distinguishing the yarn in a market where competing scents on yarn might follow.²⁹⁹ Furthermore, very important is the question whether the consumers who purchase the scented yarn products they do so because fragrance guarantees them that they are buying a specific product from a specific source or because they like the idea of

²⁹¹ Ibid

²⁹² Ibid.

²⁹³ In Re Clarke 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990).

²⁹⁴ Ibid

²⁹⁵ Ibid.

²⁹⁶ Ibid

²⁹⁷ Burton (n 15) 380.

²⁹⁸ In re Clarke(n 293) 1239-40

²⁹⁹ Burton (n 15) 380

using scented yarn.³⁰⁰ If the reason for purchasing the yarn was the fact that the idea of using a scented yarn appealed to them, this of course goes full circle to functionality and therefore the scent mark should have been denied functionality.³⁰¹ Churovich³⁰² suggests that it is improbable that Clark's clients would purchase a scented yarn and put up with the smell for the long-lasting period of time required for craft activities merely to make sure that they bought the correct product, which shows that the scent purpose on the yarn is more of a functional-utilitarian.³⁰³

Burton however states that, Clarke may be wrongly decided or it may prove that the test of validity will be applied less strictly when there is a slight possibility of a future demand for competition using fragrances in a certain market.³⁰⁴ In fact the Board specifically isolated the facts and the circumstances of the case by stating that *'we are not here talking about the registrability of scents or fragrances of products which are noted for those features such as perfumes, colognes or scented household products'*³⁰⁵ and thus it seems that the decision is of very limited application as a precedent.³⁰⁶

5(c) Sounds

The US has been one of the most liberal countries in respect to recognising the registration of sounds.³⁰⁷ The flexibility allotted by the broad definition of a TM in LA allows sound marks to be registered as TMs provided that such marks are capable to perform as indicators of source and to comply with other statutory requirements.³⁰⁸ The U.S Trademark Manual of Examining Procedure (TMPE) para 1202.15 defines sound marks as marks that

³⁰⁰Churovich (n 227) 317.

³⁰¹Ibid

³⁰²Churovich (n 227)

³⁰³ Ibid 317

³⁰⁴Burton (n 15) 380.

³⁰⁵In Re Clarke (n 293) 1239.

³⁰⁶Burton (n 15) 380.

³⁰⁷McCormick (n 98) 1105.

³⁰⁸ Ibid 1106

*'identify and distinguish a product or service through audio rather than visual means'*³⁰⁹ thus there is no need to submit a drawing with the application.³¹⁰ What is required is a specimen, a description of the sign, and evidence of use which taken together represent a descriptive representation system.³¹¹ Since sound cannot be represented visually, the US system accepts as a satisfactory description of the sound the use of onomatopoeia, listed musical notes, and simple declaratory phrases.³¹²

Under U.S. TM law, the answer to the question whether a sound can be a TM is that it *'depends on [the] aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it struck'*.³¹³ This reasonably strict test was first applied in **General Electric Broadcasting Coin**³¹⁴ where the applicant tried to register the sound of a ship's bell clock.

That is to say that sound marks require strong proof of distinctiveness or proof of secondary meaning in order to be registered as valid TMs.³¹⁵ The spectrum of distinctiveness regarding sounds has been defined by the U.S. Trademark Trial and Appeal Board (TTAB) on the one hand as *'unique, different, or distinctive'* sounds which means that such sounds are inherently distinctive and on the other hand *'commonplace'* sounds which require secondary meaning³¹⁶

³⁰⁹ TMEP §§ 807.09, 808, 1202.15.

³¹⁰ McCormick (n 98) 1106

³¹¹ Ibid

³¹² Ibid 1106

³¹³ General Electric Broadcasting Co., 199 USPQ 560, 563.

³¹⁴ Ibid

³¹⁵ McCormick (n 98) 1107.

³¹⁶ Ibid

Registered Sound Marks in the US

In 1970 a sequence of three notes was registered as a sound mark for National Broadcasting Company the so-called NBC chimes³¹⁷ which was the first sound mark to be accepted and registered by the U.S Patent and Trademark Office.³¹⁸

Furthermore, one of the most famous sound signs registered in US was the roar of a lion that the Metro-Goldwyn-Mayer used to announce the beginning of a movie and which was registered as a TM in 1985, although begun using it decades ago before applying for TM registration.³¹⁹

Moreover, Intel acknowledged the value of a sound mark for use in connection with technology products in 1994, when the Intel bong sound mark was produced.³²⁰ The sound mark contributed to establish Intel's main brand qualities, including its reputation for cutting-edge technology.³²¹ Intel's sound mark is one of the most famous marks today, registered in many countries and heard every three seconds somewhere in the world.³²²

Cases where sound marks could not be registered as TMs

Later, in a couple of cases it was decided that a musical composition could not serve as a TM for itself.³²³ In *Oliveira v Frito-Lay*³²⁴ where the claimant attempted to register as a sound mark its Grammy Award winning song, the district court stated that '*there is no federal trademarks protection for musical works*'.³²⁵ The appeals court however disagreed, and stated that there was no reason why a musical composition could not function

³¹⁷ United States Reg. No. 916,522 (filed Jan. 23, 1970).

³¹⁸ Basile (n 96)

³¹⁹ Martens, L and Garcia, A 'Shape, Sounds and Smells, Non- traditional Trade Marks Explored' <<http://www.fr.com/files/News/4df146c1-5a9e-4180-a322-044249844e1c/Presentation/NewsAttachment/22dc19eb-0c31-47f1-a07c-0446a3d32a88/Martens%20Garcia%20TM%20World%20Shapes%20Sounds%20and%20Smells%20-%20Non-traditional%20trademarks%20explored%20November.pdf>> Accessed 4 August 2012

³²⁰ Basile(n 96)

³²¹ Ibid

³²² Ibid

³²³ EMI Catalogue Partnership v. Hill, Holliday 228 F.3d 56, 64 (2d Cir. 2000); G.M.L., Inc., v. Mayhew, 188 F. Supp. 2d 891, 897 (Mid. Dist. Tenn.2002).

³²⁴ *Oliveira v Frito-Lay* 251 F.3d 56,62 (2d Cir. 2001)

³²⁵ *Oliveira v. Frito-Lay*, No. 96 Civ. 9289 (LAP), 1999 WL 20849

as an indicator of source.³²⁶ The Circuit Court in Oliveira referred to the NBC's chimes and characterised them as a brief musical composition made up of three sounds, set to a specific tempo and played by a specific instrument.³²⁷ These characteristics made the circuit court to recognise that jingles were ordinary advertising tools that undoubtedly served as indicators of source and therefore merited protection.³²⁸ Nevertheless, the appeals court affirmed the decision of the district court because the claimant in this case failed to evidence that the song identified the source of a particular product and it rather serve as a TM for itself.³²⁹

In **Kawasaki Motors v Harley Davidson**³³⁰ Harley-Davidson (HD) attempted to register as a TM the very distinctive revving sound of a HD motorcycle engine.³³¹ According with the application for registration the mark '*consists of the exhaust sound of applicant's motorcycles, produced by V-twin, common crankpin motorcycle engines when the goods are in use*'.³³² The Board stated that it should be assessed whether the sound mark is '*a functional by product of or descriptive of, motorcycle engines that the instant[opponents],.. claim a right to use*'.³³³ Nine of HD competitors filled oppositions against the registration stating that a range of brands of cruiser-style motorcycles use the same engine and produce the same sound.³³⁴ After years of litigation, with no positive result, HD withdrew its application.³³⁵

Additionally in a recent case called **Ride the Ducks v Duck Boat Tours**³³⁶, the plaintiff and the defendant provided tours in duck shaped boats and they both provided its clients

³²⁶ Oliveira (n 324) 61.

³²⁷ Ibid

³²⁸ McCormick (n 98) 1108

³²⁹ Oliverira (n 324)62

³³⁰ Kawasaki v Harley Davidson 1997 TTAB LEXIS 11

³³¹ Kawasaki at 11.

³³² Harley-Davidson Trademark Registration, U.S. Patent & Trademark Office, February 1, 1994.

³³³ Kawasaki (330)

³³⁴ Gabrielides, J and Williams, T 'The sound of unconventional marks in the United States' <<http://www.worldtrademarkreview.com/issues/article.ashx?q=fb8ad3c5-087d-4b8c-8e08-d5077676a4ce>> Accessed 13 August 2012

³³⁵ Ibid

³³⁶ Ride the Ducks v Duck Boat Tours 2005 US Dist LEXIS 4422

with duck call devices that made quacking noises.³³⁷The plaintiff sought a preliminary injunction as he used the quacking noise first.³³⁸ The court held that the claimant failed to show that it held a valid TM in the quacking noise and also concluded that the quack was '*a familiar noise that would not..qualify as..inherently distinctive*'.³³⁹ As for secondary meaning the court held that the mark had not acquired distinctiveness because the claimant's advertisements directed the consumers to the quacking device itself rather than to the claimant's tour services and therefore the advertisements failed to identify the particular services in connection with the quacking noise.³⁴⁰ Besides, the sound had been used for only one full tourist season.³⁴¹

The few cases on sound marks clarify that courts will deny extension of protection to sound marks if they do not meet the traditional TM requirements i.e. source identification, distinctiveness and non-functionality even though the liberal provisions of the LA promote sounds as capable of being registered as TM.³⁴² If however those requirements are satisfied sound marks are as protectable as traditional marks³⁴³

5(d) Unfair Competition Law-An alternative way to protect non-traditional signs that were denied registration in US.

TM law of US is also marked by the principles of UC protecting consumers and traders against the risk of confusion.³⁴⁴ The UC law in US is designated to protect well known marks which however are not registered as TMs and therefore not capable of protection under TM law. Section 43(a) of the LA prohibits a person to use '*any word, term, name, symbol...which...is likely to cause confusion..as to the origin..or approval of his or her*

³³⁷ Ibid 8.

³³⁸ Ibid

³³⁹ Ibid 23-24.

³⁴⁰ Ride the Ducks (n 336)

³⁴¹ Ibid

³⁴² Ibid

³⁴³ Ibid

³⁴⁴ Gotting,P ' Protection of well known unregistered marks in Europe and the United States' (2000). 31(4) IIC, 389,404.

goods..³⁴⁵The LA also prohibits any damage to a mark owner's goodwill that might result from such confusion.³⁴⁶These provisions protect both registered and unregistered marks but of course its application is more significant for unregistered marks as registered marks are protected similarly by TM law.

In order to determine whether an unregistered TM is entitled to be protected under this provisions of the LA, the United States Supreme Court in **Two Pesos**³⁴⁷ held *'that the general principles qualifying a mark for registration under §2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under §43(a)'*.³⁴⁸ Section 2 of the LA provides that a TM that is capable of distinguishing goods or services from the goods of others shall not be refused registration. According to the Supreme Court in *Two Pesos*, this means that the unregistered TM must be either inherently distinctive or have secondary meaning so as to be protected under s.43(a) of the LA.³⁴⁹

In **Louis Vuitton v DB**³⁵⁰, although it was acknowledged that the unregistered Vuitton's multicolour monogram logo merited protection under section 43(a) since the combination of its famous logo was unique and inherently distinctive³⁵¹ the Court denied to grant injunction in favour of Vuitton and against DG who developed a line of bags embellished with a logo similar to that of Vuitton.³⁵² The trade dress protection, provided no refuge to Vuitton's logo on the ground that although it established secondary meaning it would not pass the 'not functional' requirement under 43(a)(3) of the LA.³⁵³ Hofmeister³⁵⁴ states

³⁴⁵ LA section 43 (a)

³⁴⁶ LA section 43(c)

³⁴⁷ *Two Pesos v Taco Cabana* (1992)505 US 763

³⁴⁸ *Ibid*768

³⁴⁹ *Ibid*768.

³⁵⁰ *Louis Vuitton v Dooney and Bourke* B 454 F.3d 108 (2006)

³⁵¹ *Ibid* 116

³⁵² *Ibid* 112

³⁵³ Hofmeister, *Louis Vuitton Malletier v. Dooney & Bourke, Inc.: Resisting Expansion of Trademark Protection in the Fashion Industry* (2008) 3(1) JBTL. 202.

that the use of a colour or a specific design to make a product more desirable is a functional use of that colour or design and therefore it would not be entitled of trade dress protection and that the multicolour monogram TM of Vuitton was probably al.³⁵⁵ Furthermore the Second Circuit considered that there wasn't enough evidence to establish likelihood of confusion and dilution and it also didn't wish to expand TM protection in the American fashion industry. As it was stated, if Vuitton wined the case it would have the opportunity to achieve an unjustifiable '*anticompetitive result and would grant Vuitton monopoly rights over a look- the multicolored monogram against a white or black background*'.³⁵⁶

Furthermore, s.43(c) of the Act provides for a specific cause of action for dilution of the reputation of famous marks. That is to say that TM owners will be protected against certain unauthorised uses of their marks that would damage the goodwill of their marks even without the presence of competition or likelihood of confusion.³⁵⁷ The only thing that a TM owner needs to prove in order to obtain protection is that his mark is 'famous' whether registered or not.³⁵⁸

In **Visa v JSL Corp**³⁵⁹ an injunction was granted against JSL's attempt to register the mark 'eVisa' since such a mark was said to dilute Visa International's famous mark in violation of section 43(c) of the LA.³⁶⁰ The Court found that 'eVisa' diluted Visa's famous mark³⁶¹, since it was proved that the plaintiff's mark was famous; the defendant was making commercial use of the mark after the plaintiff's mark became famous and such a use was capable to dilute the distinctive value of the mark.³⁶² The fact that the plaintiff

³⁵⁴ Ibid

³⁵⁵ Ibid

³⁵⁶ Louis Vuitton v Dooney and Boorke 340 F. Supp. 2d at 421.

³⁵⁷ Nature and Purpose of TM protection website (n 155)

³⁵⁸ Zuber, J 'Protection of Unregistered Well Known Marks: China v. US', <http://www.zuberlaw.com/attorneys/articles/200810_JJZ_Article_re_Protection_of_Unregistered_Well_Known_Marks_China_v_U_S_.PDF> Accessed 30 August 2012

³⁵⁹ Visa v JSL 533 F.Supp 2d 1089

³⁶⁰ Ibid 1099

³⁶¹ Ibid 1093

³⁶² Avery Dennison Corp. v. Sumpton, 189 F.3d 868

had not registered 'eVisa' as his TM was irrelevant since the 'VISA' mark was famous and his reputation was diluted.³⁶³

It is submitted therefore that TMs that are incapable of registration in US are still entitled to be protected under the aforementioned provisions of LA. For example Louboutin, could have brought a claim for infringement under the provisions of UC in case he lost red sole mark registrability if he could show that use of the red sole by other luxury fashion houses is likely to create confusion in the minds of consumers as to the real origin of the product. Regarding confusion as to origin, it is submitted that it is very likely that Louboutin would be able to establish such confusion due to the fact that the red sole is a very well known feature of Louboutin's shoes and consumers have been associating the red sole with Louboutin brand for a long time now. However, Louboutin and whoever wish to benefit from UC would still have to establish that the relevant mark is inherently distinctive or has acquired secondary meaning, as well as that the mark does not serve any aesthetic or functional purpose. Therefore, it is submitted that while UC principles under the provisions of LA are capable to provide protection to unregistered TMs it is clear that the TM owners will still face significant hurdles before obtaining protection, which are similar to the elements required for the registration of signs under TM law. Of course in fashion industry things will be even more difficult due to the fact that trade dress of a fashion product is considered to serve aesthetic and functional purposes so for reasons of functionality and monopoly, protection is not granted that easily.

6. CONCLUSION

The issue of registrability of new forms of TM has undoubtedly lead to a great amount of uncertainty and litigation.³⁶⁴ On the one hand non-traditional signs, such as colours, scents and sounds, are considered by many to be a welcome development in business as

³⁶³Zuber(n 358)Protection of Unregistered Well-known Marks : Chine v US website look somewhere else

³⁶⁴ Bainbridge, 'Smell, sound colour and shape marks: an unhappy flirtation' (n 4) 243.

new forms of TMs will meet the evolving needs of business.³⁶⁵ On the other hand however, there are many who are against the registration and protection of this kind of signs as it is believed that they lack the essential qualities that a real TM should possess.

It is concluded that the US has adopted a liberal approach towards the registration of these new forms of TMs while the EU has been more vigilant in adopting these signs as TMs.³⁶⁶ Of course each of these non-traditional signs has a different degree of acceptability. As can be understood, both in Europe and the US, scents hardly could obtain registration while colour and sound marks were more welcomed.

The nature of scents is such that they are confusing³⁶⁷, which means that they lack distinctiveness and therefore it would be null to rely on a smell so as to identify a specific product. The greatest obstacle regarding scents' registration is however that of GR since it has been shown that there are great difficulties in representing an olfactory mark. Bainbridge suggests that the requirement of GR '*condemns olfactory marks to what should now be almost automatic rejection*',³⁶⁸ although a small number of scent marks have been successful in registering as TMs.³⁶⁹

In case of colours for example, the GR issue is solved as they can be satisfactorily represented by reference to an internationally well known standard for colour classification. The main problem with registration of colours is that of colour depletion. That is to say, if a specific colour is granted registration as TM it automatically '*unduly restricts the availability of colours for use by other traders*'.³⁷⁰ In certain cases, colours are also denied registration because they are considered to serve a functional purpose rather than

³⁶⁵ Churovich (n 227) 318.

³⁶⁶ Sahay (n 3) 141.

³⁶⁷ Churovich (n 227) 318.

³⁶⁸ Bainbridge, 'Smell, sound colour and shape marks: an unhappy flirtation' (n 4) 244

³⁶⁹ Ibid.

³⁷⁰ Ibid.

being source identifiers. Colour due to its nature is often considered to fall in the ornamental and aesthetic part of a product that's why it is generally argued that is incapable to be perceived and function as a TM. Particularly this is observed mainly in fashion industry where colours are perceived as ornamental features of a product and therefore any rejections as to registration of colours in fashion industry might be rationale.

Sounds are generally considered as capable to function as TMs mainly in Germany and US as there is an express reference both in the German TMA and in the US TMEP about sound marks. In Europe, however, the issue of GR seems to bother sounds, as it is considered that the requirement of representation is only satisfied by conventional musical notation. However, changes in the way that TMs can be stored on the Register could surmount this problem if computer technology is used so *as to record 'sound marks faithfully and make them available in digital form'*.³⁷¹

As discussed above, despite all the possible difficulties that these new forms of marks may face in their attempt to be registered as TMs there is always the law of passing off or UC to provide them some sort of protection.³⁷² Although the provisions of passing off and UC are more relaxed than the rules of TM law, it is noteworthy to observe that the protection granted under these rules is not absolute. Particularly some of the requirements needed under UC law are similar to these of TM law such as distinctiveness and non functionality.

It is submitted that, the non-traditional TMs are here to stay, and provided that they satisfy the basic tests required in order to be capable of functioning as TMs there is no reason why these marks should not be registered.³⁷³ Besides in addition to satisfying the ordinary function of TMs, non-conventional signs bring in an extra benefit of catering to a

³⁷¹ Ibid.

³⁷² Ibid

³⁷³ Sahay(n 3) 128.

new segment of purchasers and thus encourage innovation between advertisers.³⁷⁴ Basically, there is no distinction between non-traditional and traditional TMs and so there is no justification for arguing that only the former represents an unwelcome restriction of free intellectual property resources.³⁷⁵

³⁷⁴ Ibid 141

³⁷⁵ Ibid

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