The Removal of the Requirement for Graphical Representation of EU Trade Marks
The Impact of the Amending Trade Mark Regulation

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Abstract

This thesis has the aim of illuminating how the removal of the requirement for graphical representation will affect the EU trademark registration system, especially in regard to legal certainty and flexibility. By examining and analyzing the contents of the ATMR, along with the landmark Sieckmann case, the results indicate that the regulation may simultaneously improve both legal certainty and flexibility. The legal elements are improved as the ATMR provides possibilities for the creation of many new forms of representations that are both more precise and better suited to the technology of modern times than previously permitted representations.

Keywords: Graphical representation, representation, trademark, EU, Amending Trade Mark Regulation, ATMR, Regulation (EU) 2015/2424, legal certainty, flexibility, Sieckmann, non-conventional trademarks, sound mark, 3D-mark, hologram, color mark, scent mark, smell mark, touch mark, positional mark.
Sammanfattning

Denna uppsats har syftet att bringa klarhet kring hur avskaffandet av kravet på grafisk återgivning kommer påverka EUs varumärkesregistreringsystem, i synnerhet med rättssäkerhet och flexibilitet i åtanke. Genom att granska innehållet i Ändringsförordningen för varumärken, tillsammans med det mycket betydelsefulla Sieckmann-fallet, har svaret till frågan ovan framkommit genom analysen som indikerar på att införandet av Ändringsförordningen kan förbättra graden av både rättssäkerhet och flexibilitet. Sagda förbättringar uppkommer till följd av att förordningen möjliggör skapandet av många nya sorters återgivningar som både är mer precisa till sin form samt bättre anpassade till dagens teknologiska nivå än tidigare tillåtna återgivningar.

Nyckelord: Grafisk återgivning, återgivning, varumärke, EU, Ändringsförordningen för varumärken, Förordning 2015/2424, rättsäkerhet, flexibilitet, Sieckmann, okonventionella varumärken, ljudmärke, 3D-märke, hologram, färgmärke, luktmärke, känslmärke, positionsmärke.
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Abbreviations

AG – Advocate General
ATMR – Amending Trade Mark Regulation
CTM – Community Trade Mark
CTMD – Community Trade Mark Directive
CTMIR – Community Trade Mark Implementing Regulation
CTMR – Community Trade Mark Regulation
EEC - European Economic Community
ECJ – European Court of Justice
ECLI – European Case Law Identifier
ECR – European Court Reports
EU - European Union
EUIPO – European Union Intellectual Property Office
EUTM – European Union Trade Mark
EUTMD – European Union Trade Mark Directive
EUTMIR – European Union Trademark Implementing Regulation
EUTMR – European Union Trade Mark Regulation
GPTO – German Patent- and Trademark Office
OHIM – Office for Harmonization in the Internal Market (Trade Marks and Design)
OJ – Official Journal (of the European Union)
PBR – Patentbesvärsrätten
TEU – Treaty on European Union
TFEU – Treaty on the Function of the European Union
1 Introduction

1.1 Background

A necessity for all law has, since the inception of law itself, been a measure of predictability. Without predictability there cannot be legal certainty.\(^1\) Likewise however, law is in need of a certain degree of flexibility to function well and reflect changing societal needs and demands. It is in this balancing act between predictability and flexibility where we find cornerstone to the problem at hand.\(^2\)

The need for a graphical representation of a trademark in the registration process has for long existed as a requirement in EU trademark law, found in its most recent form in article 4 of the Council Regulation (EC) No 207/2009 on the Community trade mark (CTMR). Said requirement has provided mainly two elements to the registration process.

Firstly, it has created a standardization of the format for which an EU trademark is represented through. All trademarks must be able to be visibly seen in some form when represented in the EU trademark register, thereby providing a basis under which all trademark registrations can be indexed through.\(^3\)

The above-mentioned standardization of the format in this case represents a degree of predictability. This is because trademarks, due to the standardization, must be depicted in the trademark register in a consistent manner for external observers. Consequently, trademark holders and future applicants can more easily predict whether a trademark right is occupied already, or if they might become target of legal action if they register a certain trademark, which provides legal certainty for the involved parties.

Secondly however, the requirement has acted as a hindrance against registering non-conventional trademarks such as for example sounds or scents, which traditionally are not depicted through ocular means. Non-conventional trademarks first need to be adapted into visible form, as for example into musical notes for sound marks, to be able to be represented graphically and thus entered in the trademark register. One could argue that this makes EU trademark law inflexible, as non-conventional trademarks becomes harder to register than conventional trademarks.

Earlier case-law has also, similarly to the legislated need for graphical representation, emphasized the aspect of legal certainty when registrating trademarks. The Sieckmann\(^4\) case

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\(^1\) Van Meerbeeck, p. 10; Wolff, p. 553.
\(^2\) For a detailed explanation of the opposing relationship between legal certainty and flexibility, see ch. 2.2.
\(^3\) The EU trademark register consists of a database called eSearch plus and is maintained by EUIPO. By average, 50 000 trademark applications have been filed in the register every year between 1996-2014, see http://ec.europa.eu/eurostat/statistics-explained/index.php/Intellectual_property_rights_statistics. As of September 21, 2016, a search for all trademarks in the register gave 1 535 735 individual results. For further information about the trademark register, see https://euipo.europa.eu/ohimportal/eutm-register.
proved to be a landmark ruling in which a “golden” standard was created through the introduction of a set of criteria for evaluating the level of representability for trademarks.

According to the Sieckmann criteria, trademark representations in the register need to be clear, precise, self-contained, easily accessible, intelligible, durable and objective, in addition to being represented in graphical form. All aforesaid requirements have one common objective, namely providing legal certainty and a unitary system for representing trademarks.\(^5\)

What will then happen when the need for graphical representation disappears? As of the introduction of the new amending EU trademark regulation\(^6\) (ATMR) this is the change that will inevitably happen. Will the same degree of predictability remain while allowing non-conventional trademarks to register more easily, providing an earlier unseen flexibility to the registration system? Or will perhaps the standards set by the Sieckmann ruling regarding representability be impossible to follow with the new legislation, with legal certainty suffering as a consequence?

### 1.2 Research topics

It is stated in the 9\(^{th}\) recital of the ATMR that both the degree of legal certainty and flexibility of the trademark registration system will increase as a consequence of the removal of the need for graphical representation. However, the relationship between legal certainty and flexibility is most often in opposition. Generally if there is more legal certainty, there is less flexibility.\(^7\) The content of the 9\(^{th}\) recital could therefore be questioned regarding its validity and it must be examined if the arguments of the legislators are true or not.

This thesis thus has the purpose to examine the possible consequences for the trademark registration system in regards to legal certainty and flexibility when registering EUTMs\(^8\) following the removal of the need for graphical representation and the subsequent introduction of new types of non-graphical representations.

Furthermore; a fundamental ruling in defining the criteria concerning what is regarded as a graphical representation is found in the Sieckmann case. Both the interpretation of what is graphical and what is seen as a suitable representation was cemented by the ECJ in the aforementioned case. It is thus of relevance to assess whether or not said criteria regarding what constitutes an acceptable representation still is compatible with the new legal situation, following the removal of the need for the graphical part of a trademark representation.

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5 See ch. 4.3.


7 See ch. 2 “The concepts of legal certainty and flexibility”.

8 EU Trademarks (“EUTMs”) were called Community Trademarks (“CTMs”) until March 23, 2016, when the amended article 1 of the ATMR replaced the term.
The essential questions to be answered in this thesis are thus the following:

- What are the consequences for the trademark registration system, in regard to both legal certainty and flexibility, following the removal of the need for graphical representation of trademarks and the subsequent possibilities for new forms of non-graphical representations?

- Are aforesaid consequences for the trademark registration system compatible with the pre-existing legal situation regarding representability, especially the Sieckmann-criteria?

1.3 Method and material

1.3.1 Method

The method used in this thesis is the traditional judicial method utilized in the European Union where binding legal sources follow a hierarchy of norms, which consists of five main tiers. The tiers are structured as follows: The constituent Treaties and the Charter of Rights; general legal principles; legislative acts; delegated acts; and lastly, implementing acts.

In the above-mentioned hierarchy, the constituent Treaties act as the basis for which all other legislative norms must be pursuant in some form to. General principles, as the second tiered norm, can be used to interpret the norms of the constituent Treaties. Aforesaid principles can also invalidate norms underneath them in the hierarchy, such as for example a legislative act, if the act contradicts the principle. The principles are often created by the Courts of the EU. Some examples of these general principles are proportionality, equality and legal certainty.

Legislative acts are acts which are adopted through legislative measures. They can consist of the EU legal instruments specified in art. 288 TFEU, which are regulations, directives and decisions. Regulations are entirely binding and applicable directly in all EU Member States. Directives are binding in the manner that they are to be achieved by the addressed Member States, however the ends to do so can vary in method between Member States. Lastly, decisions are binding to those whom it is addressed to.

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9 Note that there are often two different methodological classifications of what exactly constitutes the EU hierarchy of norms. One of the classifications is found explained above. The other classification instead divides the hierarchy of law into two main legal sources, primary law and secondary law, see Schütze, p. 82. The reason for not using this methodological classification is because the author of this thesis finds it to be too narrow.

10 The constituent treaties are comprised of the Treaty on the European Union (TEU) and the Treaty on the Functioning of the European Union (TFEU) including their protocols, annexes and declarations, see Craig & De Burca, p. 103.

11 Craig & De Burca, p. 103.


13 Ibid., p. 105-107.
Delegated acts are lower on the hierarchical scale of norms than legislative acts and function in the way that they are of general application, and supplements or amends legislative acts in non-essential ways. The last binding legal norm, implementing acts, have the function to execute EU legislative acts in national law of the Member States.\textsuperscript{14}

EU case law can be both legally binding and non-binding, depending if the case expresses a general principle of the EU. If the case expresses a general principle, the ruling is directly binding within the EU. If it is not, the ruling in the case is to be seen as an interpretation of a higher legal norm. Nevertheless, EU case law becomes an important legal source due to the guidance that can be found through the interpretations.\textsuperscript{15}

Outside of the binding hierarchy of norms there exist other types of non-binding legal sources that can supplement the formal norms. They are recommendations, opinions and to an extent, legal writings. These soft-law accessories provide guidance when the legal situation is unprecise and there are no formal norms which regulate the situation.\textsuperscript{16}

\textbf{1.3.2 Material}

The regulations and directives that are used in thesis are the new trademark regulation\textsuperscript{17}, the new trademark directive\textsuperscript{18} and their older counterparts\textsuperscript{19} respectively, including the implementing regulation.\textsuperscript{20} The reason for choosing to include all of the regulations is because it gives the thesis a possibility to compare the fourth article, which is the provision previously containing the requirement for graphical representation. It also becomes possible to examine the different relevant recitals of the regulations and directives.

As this thesis focuses on the new trademark regulation there are some legal norms that are more commonly used for answering the posed research question than others. For example, as the amended wording of art. 4 ATMR will be applicable from October 1, 2017, no new case-law relevant to the question has yet to emerge.\textsuperscript{21} It is consequently the \textit{Sieckmann}\textsuperscript{22} ruling that this thesis mainly uses in terms of case-law, as it has acted as a landmark case on the area of graphical representation in regards to non-conventional trademarks since 2002.\textsuperscript{23} Additional EU case-law is also used when necessary for the descriptive parts of the thesis.

\begin{itemize}
\item[\textsuperscript{14}]Craig & De Burca, p.113-117.
\item[\textsuperscript{15}]Schütze, p. 198.
\item[\textsuperscript{16}]Craig & De Burca, p. 107-108.
\item[\textsuperscript{17}]See n. 6.
\item[\textsuperscript{21}]See the tab “Graphical representation” found at https://euipo.europa.eu/ohimportal/en/eu-trade-mark-regulation-technical for information regarding when the amended provision comes into force.
\item[\textsuperscript{22}]Case C-273/00, \textit{Sieckmann} [2002] ECR I-11737.
\item[\textsuperscript{23}]See ch. 4.1.
\end{itemize}
Note that decisions from the OHIM Board of Appeal are also utilized, as said Board of Appeal is the first legal instance when appealing an EU trademark registration decision.

Because of the legal vacuum that exists due to the so far non-existent new case-law, the material utilized for answering the research question of this thesis must also be gathered from elsewhere. It is thus mainly in the non-binding “soft” source of law that is legal writings where the appropriate completing material is found. Additionally, guidelines published by EUIPO such as their working guidelines provide additional insightful information as they often deal with practical solutions and examples to different problems within trademark law. It is however important to note that said guidelines may change depending on how EUIPO changes their own routines, with the result that some minor discrepancies can arise between what has been considered correct procedure earlier and what is currently correct.

1.4 Limitations

Firstly, it can be stated that the thesis will only encompass trademark law. Consequently, examinations regarding other intellectual properties such as patents, copyrights or design rights are not included or discussed in this thesis. The reason for limiting the thesis in the above-mentioned manner is because of the unique nature of trademarks, as they can protect many widely differentiating elements, ranging from sounds to words. This is in contrast to for example designs, which always protect the appearance of an object.

Furthermore, the thesis only includes an examination of the consequences for registering EUTMs following the removal of the need for graphical representation. Thus the span of the research question does not include any national trademarks systems as such24 or international trademarks registered through the Madrid System.25

Regarding the general principles of EU law that are taken into account when analyzing the research question at hand, the thesis limits itself to the principle of legal certainty. Thus, other general principles such as proportionality and equality are left out of the extent of this thesis. Including said principles can lead to an analytical focus which tends to become more politicized than legally inclined, which is not the purpose of this thesis.26

Other areas of law that can be of importance to the trademark registration process as such, for example procedural or administrative law, are also not included. The limitation against said types of law relates to their irrelevance in answering the research question; while they are

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24 Registration processes of national authorities and national trademark law in the separate member states of the EU are thus not taken into account in this thesis; however, as the EU member states need to implement the new trademark directive, there exists overlapping between the areas of EU and national trademark law. Additionally, any national trademark law of other, non-EU states is likewise not examined.

25 The Madrid System is a system for registering “bundles” of national trademarks through WIPO (World Intellectual Property Organization) in countries which are parties to the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement.

26 That is not to say that such an examination is irrelevant for the legal position regarding trademarks; on the contrary, it may illuminate the problems which applicants of non-conventional trademarks face.
undoubtedly important from a practical viewpoint when registrating trademarks, they do not fall into the theoretical scope of this thesis.

1.5 Prior research

As the ATMR was valid as of December 16, 2015, the amount of legal research on the specific subject of the removal of the need for graphical representation has been quite sparse. Nonetheless, it has been touched upon in a small number of legal articles treating changes brought by the introduction of the new trademark regulation.27

In regard to the concept of graphical representation itself however, research and legal discussions has been conducted for quite some time. Following the Sieckmann case in 2002, there arose numerous legal articles treating the ruling of the Court and the new criteria for graphical representation.28

As the problems created by a need for graphical representation are closely connected to the nature of non-conventional trademarks, it is also important to include said field of legal research in this chapter. Erika Lunell, Doctor of Laws (LL.D.) has conducted extensive research into the area of non-conventional trademarks, especially in relation to how the concepts of graphical representation and distinctiveness have applied to such marks.

1.6 Ethical considerations

As the subject of this thesis does not involve any reflections or discussions that generally would be described as of ethical or moral nature, it is not necessary to include such considerations for this body of research. Furthermore, as the thesis chooses to exclude viewpoints focusing on a more politicized discussion regarding trademark registration policy, the need for ethical considerations becomes minimized.29

1.7 Disposition

The first chapter of the thesis is comprised of the introduction to the matter at hand. It describes a short, informative background to the legal situation. After, the research question is elaborated and precised. Thereafter follows sections regarding methodological choices, chosen material for answering the research question and finally the disposition itself.

In the short second chapter the definitions of legal certainty and flexibility are given. This is to provide a framework for which this thesis will base its descriptions of what legal certainty and flexibility is. Furthermore, said framework provides clarity to the analytical section of the thesis as the precision of the terms eliminates the risks of misconceptions and unclear results.

27 See e.g. Ward, p. 16.
28 See e.g. Gioia, p. 983; Leistner, p. 78; Gow, p. 87. For further examples, see list of references, under literature.
29 See ch. 1.4.
By the third chapter an amount of descriptive information is provided regarding necessary basics of trademark law relevant to the understanding of the research question. The current trademark legislature and competent authorities are detailed. Additionally, the concept of EU trademarks is explained, as are the concepts of what constitutes conventional and non-conventional trademarks.

In the fourth chapter an in-depth explanation is given regarding the concept of graphical representation as expressed in art. 4 of the old EU trademark regulation and how the Sieckmann ruling influenced aforesaid concept. The applicable criteria stemming from the Sieckmann case and their effects on the legal situation regarding registration of trademarks are detailed extensively.

The fifth chapter analyzes and predicts the consequences for legal certainty and flexibility in regard to registration of trademarks following the removal of the need for graphical representation. It examines how and details why the amended article 4 of ATMR and its reliance on representation alone influences both the level of legal certainty and flexibility. This is accomplished by applying and analyzing the Sieckmann criteria in relation to the new amendment and new types of trademark representations.

The sixth chapter summarizes the found research results of the analysis and presents the conclusions. The chapter ends by giving a short concluding opinion based on the answer of the research question regarding the future of trademark registrations following the removal of the need for graphical representation.
2 The concepts of legal certainty and flexibility

2.1 – The importance of defining terms and concepts

In order to provide a singular basis of understanding for those partaking in the reading of this thesis, it is of importance to define the terms which the thesis uses. For long, the definition of terms has been a most significant element in scientific pursuits, or as allegedly said by the Greek philosopher Socrates: “The beginning of wisdom is the definition of terms”. With precise terminology the risks of misconceptions regarding the subject at hand is minimalized.

This chapter will therefore define the meanings of legal certainty and flexibility. The reason for this clarification is because the terms are of great weight to the formulation of the research question, and in extension the analysis, which discusses how the need for graphical representation will influence both the concept of legal certainty and flexibility. The definitions are determined from an operational viewpoint, which means that they are not necessarily defined as they appear in a dictionary, but instead how they are used in relation to the contents of this thesis.

2.2 – Legal certainty

Legal certainty is a concept of law that is highly important and which has existed in some form since the inception of most western legal systems. In the EU judicial system, legal certainty is situated higher in the hierarchy of norms than for example legislative acts. This is because of the nature of legal certainty, as it is considered a general principle of EU-law. The status as a general principle of EU-law has been confirmed through a very large number of rulings stemming from the ECJ.

Because of the higher position of general principles in the EU hierarchy of law than legislative acts and those acts below it, the principle of e.g. legal certainty can invalidate regulations, directives and decisions, or parts of them, if they contravene the principle. In context to the subject of this thesis the following can thus be said; if the new provision regarding the removal of graphical representation is found to be incompatible with the principle of legal certainty, the provision may have to become declared invalid. The aforesaid possible declaration of invalidation is however not discussed here but instead in the analysis.

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30 See Firey, p. 2.
32 Ibid.
33 Van Meerbeeck, p. 1.
34 Craig & De Burca, p. 109.
35 The existence of legal certainty as a general principle of EU-law was for the first time mentioned in 1961 by the ECJ in Joined cases 42 and 49/59, S.N.U.P.A.T [1961] ECR I-00095. As of the year 2013, there existed around 2500 EU cases which mentioned the term “legal certainty”, see Van Meerbeeck, p. 9.
36 See ch. 1.3.1 for an explanation of the hierarchy of law in the EU.
37 See ch. 6.2.
When concisely summarized, the definition of legal certainty which has been created through EU case law can be stated as meaning that rules of law have to be precise, clear and predictable to their effects. Furthermore, the application of a rule of law must thus be “foreseeable” by those subjected to the rule. Also of very high importance for the definition of legal certainty and thus this thesis is the following statement from the ECJ, given in case *Heinrich*, para. 44, which states that: “*Individuals must be able to ascertain unequivocally what their rights and obligations are and take steps accordingly*”.

There is also another legal principle of importance called the principle of legitimate expectations which can be described as a correlating, underlying principle to the one of legal certainty. Legitimate expectations essentially means that when the EU institutions gives specific assurances that a certain consequence will happen as the result of a certain action, an individual performing said action will have justified hopes that said result always will happen.

In summarizing the meaning of the concept of legal certainty, in relation to how it is used in this thesis, the following can thus be stated. All individuals which are involved in a trademark registration process, be it trademark holders, applicants or examiners, must be able to know what their rights are, what other conflicting rights exists and what obligations may be put upon them, when they register a trademark. Under these circumstances, legal certainty as defined in this thesis can exist.

In practice, the above-mentioned means that when registering a trademark, the involved parties must have the ability to obtain knowledge regarding their legal situation through the entries of trademark representations found in the trademark register. An applicant needs to be able to predict, through information gained by observing the trademark register, if their trademark can be registered or not, as it may already exist very similar or identical trademarks. Likewise, a potentially opposing party needs to be able to receive information regarding newly applied trademarks which show similarity to their own as to be able to oppose against them. Lastly, an examiner needs to be able to know the exact extent of the protection that they will grant a trademark if it is registered.

### 2.3 – Flexibility

Flexibility as opposed to legal certainty is not a principle which is regarded as a general principle in EU-law. Nor is flexibility generally defined as having one meaning when discussed in different legal writings. Thus it is of importance to establish what the term flexibility means in relation to the use of it in this thesis.

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40 Case C-345/06, *Heinrich* [2009] ECR I-01659, para. 44.
41 Van Meerbeeck, p. 10.
42 Wolff, p. 550.
The legal scholar Wolff identifies a number of general definitions used for the concept of flexibility in relation to legal matters. One commonly used definition states that the rules themselves, intrinsically, have an amount of flexibility stemming from how they are construed. Another definition relates to how rules are applied in practice, and thus it is the application itself that determines the flexibility. Lastly, a third definition of flexibility means that legal rules which allow e.g. evaluations of proportionality or “reasonableness” are flexible.\textsuperscript{43}

The first definition which consists of the thought of a possibly inherent flexible nature of legal rules, depending on how they are constructed, also usually contains another important element. This element is the one of legal certainty, which is defined as being in opposition to flexibility. If a provision is flexible, it also becomes uncertain to a degree as a consequence. Flexibility and legal certainty are thus always in opposition of each other. Still the question of what exactly flexibility means remains unanswered however. Flexibility, in the above-mentioned context, means that the legal system can provide just decisions in individual cases, as it is adaptable to a number of interchangeable circumstances.\textsuperscript{44}

What does then flexibility mean in the context of this thesis? Flexibility, as the term is used within this thesis, represents the degree of how much the trademark registration system of the EU allows different types of trademarks, submitted with different types of representing information, to be registered. In practice, this means that if the trademark registration system allows for different trademarks to be represented in the trademark register by a wide assortment of types of representations, ranging from images to even possibly scent samples, it is adaptable and flexible to each individual case.

\textsuperscript{43} Wolff, p. 550.
\textsuperscript{44} Wolff, p. 552.
3 The EU trademark and the categorization of marks

3.1 Legal framework, competent authorities and the nature of the EU trademark

3.1.1 The framework and competent authorities

The first attempt to approximate the trademark law of the members of the European Union (then the EEG) was taken in 1989 with the first trademark directive. The directive was not implemented in all of the member states until 1996 however. In 1994 the first trademark regulation was adopted and became implemented through the implementing regulation, either called CTMIR or more recently EUTMIR, in 1995. EUTMIR is still applicable and has been amended by the EU trademark regulations and directives which have followed since. Aforesaid regulations and directives came into force 2009 and 2016 respectively.

OHIM, the Office for Harmonization in the Internal Market, was established at the same time as the introduction of the first trademark regulation. It shortly thereafter became the authority which established the administrative system for registering EU trademarks and became operational in 1996. As stated earlier OHIM has received over 50,000 trademark applications every year between 1996-2014, with as much as 120,000 applications in 2015. In 2016, following the introduction of the latest EU trademark regulation, OHIM changed its name to EUIPO (European Union Intellectual Property Office). Aside from the change of name, the authority keeps the same competency to handle EU trademark and design right registrations.

EUIPO also handles the examinations, registrations and possible cancellations of EU trademarks. All procedures, including applications, are entered in the trademark register. The importance of a precise, easy-accessible and comprehensive register quickly becomes apparent when seeing the scope of the number of trademarks administered by the EUIPO.

3.1.2 The nature of EU trademark

The creation of a single, internal European market has for long been one of the main goals of the EU. To accomplish the proper functioning of said internal market, many steps will have to be taken in order to ensure economic harmonization. One such step was the creation of a new type of trademark right in 1994, following the introduction of the first trademark regulation. It

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46 Council Regulation (EC) No 40/94 on the Community trade mark.
48 Kur & Dreier, p. 159.
49 OHIM/EUIPO also administers the system for registering EU design rights, see Kur & Dreier, p. 163.
50 See n 3.
51 See art. 2 ATMR.
was a trademark that transcended the territorial borders of EU member states. It came to be called the Community Trade Mark (CTM).52

As stated above, the creation of the CTM would increase the development of a single market according to the legislators. In order for undertakings to be able to distribute goods and provide services across the whole internal market, suitable legal conditions had to be created for said undertakings. One such appropriate legal condition was given by the nature of the CTM as it enabled the goods and services of different European undertakings to be distinguished to all European consumers on equal terms.53 As a side note, it can be mentioned that the fundamental function of all trademarks is their ability to distinguish the commercial origin of a product or service.54 Consequently, EUTMs are important tools for undertakings that operate in the EU and offer goods or services to consumers within the internal market.55

Made apparent through what is written above is the most important characteristic of the CTM/EUTM, namely its ability to provide a unitary right through the area of the European Union. This is called the unitary right principle. It means that a holder of a EUTM generally has protection for their trademark in all of the EU member states when registered. Because of the unitary right principle, it is thus not possible to apply for registration in for example only half of the Member States or a certain part of the European Union. Correspondingly, if the EUTM is cancelled, transferred or declared invalid, the procedure has validity for the trademark through the whole European Union simultaneously.56

Even though EUTMs offer unitary protection through all of the EU member states, it does not replace the national trademark systems of said states. The legislators recognized that some undertakings, such as small businesses, did not necessarily want protection for their trademark in the whole territory of the EU as they only conducted business within the borders of a specific member state. Thus the national registration systems were left intact and the EUTM instead coexists with national trademark rights.57

Aforesaid principle of coexistence means that national rights and EUTMs are equal in regard to their mutual exclusiveness. If an earlier identical EUTM is already registered, a national trademark registration filed by a third party must be declined as the EUTM has protection in the member state. In correlation, if a national trademark right already exists, the EUTM cannot be registered. Furthermore, EUTM and national trademarks can coexist concurrently if they are held by the same proprietor.58 Seniority can also be claimed from a surrendered national mark to a EUTM.59

52 Kur & Dreier, p. 161. Note that the CTM, as of the introduction of the new trademark regulation, is now instead called a European Union Trade Mark (EUTM).
53 CTMR, recital 2.
54 Ibid., recital 8.
55 Kur & Dreier, p. 159.
56 CTMR, art. 1 (2).
57 Ibid., recital 6.
58 Kur & Dreier, p. 162.
59 As the concept of seniority is not relevant for this thesis, it will not be explained further here. Instead, for additional reading, see Kur & Dreier, p. 162.
To summarize the nature of the EU trademark the following can be stated. The trademark is of unitary character and therefore the legal rights conferred by a EUTM registration are generally valid through the whole of the European Union. The same unitary element applies to the effect of cancellations, transfers and invalidations. Meanwhile however, the EUTM is also able to coexist with national trademarks. With the above-mentioned basics made clear, it is possible to delve further into the specific types of signs that can be registered as EUTMs.

3.2 The categorization of conventional and non-conventional trademarks

When discussing categorization of trademarks a divide is often made into two main groups of trademark types; conventional trademarks and non-conventional trademarks. What constitutes a conventional trademark and a non-conventional trademark is not found in any legislated source however. Instead the classification is dependent on definition and time.

A non-conventional trademark is often considered to be a new type of object or element that may have the possibility to acquire protection as a trademark. What is acknowledged as new, as stated above, is influenced by how much time has passed since the object or element became more commonly occurring. However, to end the definition of what constitutes a non-conventional trademark there might exclude another important factor. For a trademark to be considered as non-conventional, the sign representing the trademark also needs to be rarely thought of as sign that is generally viewed as being able to represent a trademark.

What does then define a conventional trademark? Basically, the definition is the opposite of what constitutes a non-conventional trademark. Conventional trademarks are therefore not seen as new objects of trademark protection and are not either generally considered as being traditional types of possible signs for representing trademarks.

3.3 Conventional trademarks

Conventional trademarks are usually divided into two categories, word marks and figurative marks. Sometimes three-dimensional marks are also included into the category of conventional trademarks. However, as 3D-marks are still not very frequently registered and not generally what strikes the public as a traditional representation of a sign, they are instead regarded as a non-conventional trademark in this thesis.

As of September 21, 2016, a search for all trademarks found in the EU trademark register gave 1 535 753 results. Of those results, 900 801 were word marks and 623 954 were

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60 The reason for using the word "generally" is due to the existence of certain exceptions, such as when linguistic differences hinder enforcement of rights in specific member states but not in others. For a detailed explanation, see Kur & Dreier, p. 160.
61 Kur & Dreier, p. 160.
62 Lunell, p. 53.
63 Ibid.
64 Ibid.
figurative marks. 99% of all applied trademarks were thus conventional trademarks while 10,998, or 1%, were non-conventional trademarks. The number of non-conventional trademarks applied for in relation to conventional trademarks is increasing however and will probably continue to do so due to the removal of the need for graphical representation. 65

3.3.1 Word marks

Word marks are as stated above the most common type of sign used for trademarks in the EU, making up approximately 60% of the entries in the trademark register. They consist of words, numbers, letters or other writable signs, such as +, - or 1.66 Word marks can incorporate one or a combination of the aforesaid elements.67 Some examples of word marks are VOLVO, PHILIPS and ADIDAS, as written in plain text here.68

All words marks, as they are comprised of purely visual elements, must be represented graphically to have the ability to be entered into the trademark register. They also have, as all types of signs, a requirement of distinctiveness. Thus some words, for example purely descriptive ones, are excluded from protection as trademarks.69 As the discussion regarding distinctiveness is not included in this thesis however, it will not be detailed further here.

3.3.2 Figurative marks

Figurative marks are signs consisting of images, graphical signs or figures. They are often typically called “logos” by consumers. One example of such a figurative mark is the Nike “Swoosh”.70 Such a mark does not have any inherent associative meaning. However, figurative marks can also contain graphical elements and words in combination. These types of marks are called figurative marks containing words or letters and may have a linguistic meaning.71 Nonetheless all figurative marks need to be graphically represented in the register by an image, as they solely contain visual elements.72

3.4 Non-conventional trademarks

The following subchapter details the different types of signs that can be considered of non-conventional nature.73 EUIPO lists 5 such types of trademarks in their trademark register: Three-dimensional marks, holograms, colors, sounds and lastly olfactory (scent) marks. As of

65 For support of this presumption, see ch.6.2 and 6.3.
66 See art. 4 ATMR.
69 Art. 7 (c) EUTMR. See also Kur & Dreier, p.175-176.
70 For other figurative marks, see https://euipo.europa.eu/ohimportal/sv/trade-marks-examples#Figurative-mark.
71 For examples of figurative marks containing words and letters, see https://euipo.europa.eu/ohimportal/sv/trade-marks-examples#Figurative-mark-with-letters.
72 Some authorities such as EU IPO make a separate classification between figurative marks and figurative marks containing words. This classification is not necessary in this thesis however, as they are very alike and both require graphical representation of the same sort in the trademark register.
73 For the definition of a non-conventional trademark, see ch. 3.2.
September 22, 2016 a search in the register yielded applications for 8775 3D-marks, 976 colors marks, 253 sound marks, 9 holograms and 7 olfactory marks.

As has been stated in chapter 3.2 regarding what is defined as a non-conventional trademark, the concept of what is non-conventional changes over time. The definition of non-conventional is thus derived after the situation as it was during the time of writing of this thesis. New categories of marks will surely emerge over time. To exemplify; the concept of a hologram as a trademark is rather recent because of the perceived technological obstacles of holography, and thus EUIPO saw its first application for a hologram in 2000.74

3.4.1 Three-dimensional marks

Three-dimensional marks (3D-marks) are as stated above the most frequently occurring of applications for non-conventional signs. 3D marks are unique in relation to other types of marks as they are actually comprised of physical forms. Often the form consists of the appearance of a product or the packaging of one, such as for example the form of a packaged bar of Toblerone.75 It can also be of more atypical nature, such as the interior design of a store.76 Traditionally however, forms have only retained intellectual property protection as registered designs or by copyright from applied art.77

The reason for providing a third option for protection of forms is because it has become increasingly common in society to use forms in themselves for signaling a message of commercial origin. As said signaling distinguishes a commercial origin of the goods of a certain proprietor, it fulfills the basic function that all trademarks must have. Consequentially, 3D marks have been recognized by the legislators and EUIPO as an acceptable sign for use as a trademark. Worth noting is that the trademark protection does not cover the appearance per se, but the element that provides the indication of the commercial origin of the product.78

All 3D-marks must be graphically represented in the register as they are comprised of visual elements. Unlike conventional trademarks which also require graphical representation however, applications of 3D trademarks must according to art 3 (4) of the EUTMIR contain a representation which establishes that the sign is in 3D format. This can be accomplished by providing multiple photographic reproductions of the same object that the mark will protect, taken from up to a maximum of six different perspectives.79

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74 See EU trademark registration no. 001787456. It can be found in the online register at https://euipo.europa.eu/eSearch/#details/trademarks/001787456.
75 For further examples, see https://euipo.europa.eu/ohimportal/sv/trade-marks-examples#3D-mark.
76 See Case C-421/13 Apple Inc. [2014] ECLI:EU:C:2014:2070, where the Court found that the design of an interior of a store could retain trademark protection if certain circumstances were fulfilled.
77 Lunell, p. 57.
78 Ibid.
79 See EUTMIR, art. 3 (4). See also Guidelines for Examination in the Office, Part B, Examination, Section 2, Formalities, p. 20.
The most common obstacle for registering a 3D trademark is not fulfilling the necessity for graphical representation as it can be performed quite easily according to the criteria above. Instead the obstacle is usually the need to show distinctiveness of the mark. As this thesis does not include examinations of the concept of distinctiveness however, said discussion is left out here.\textsuperscript{80}

### 3.4.2 Holograms

Holograms are a very new concept in the sphere of trademark registrations. The first EU application of a hologram as a trademark was made in 2000\textsuperscript{81} and they have for long not been generally considered as marks capable of distinguishing a commercial origin. Nevertheless holograms have, first in theory and later in practice, proved that they may indicate the commercial origin and be distinctive enough to be registered.\textsuperscript{82}

A frequent problem with registration of holograms as trademarks is the requirement of graphical representation, or more precisely, suitable graphical representation. As a hologram is essentially a 3D mark which moves and changes, six photographic reproductions as required for a 3D mark might not be enough to graphically represent all possible movements and angles. Instead, if the description is clear enough and all of the possible angles are graphically represented in the filed application, the hologram might be registered by the EUIPO.\textsuperscript{83} As evidenced by the lack of EUIPO trademark registrations for holograms however, this may be more easily accomplished in theory than practice.

### 3.4.3 Colors and colors per se as marks

A color might not directly strike consumers as a sign capable of representing a specific commercial origin of a goods or service. Nonetheless, it has been deemed that colors may retain trademark protection through a number of different alternatives, as companies often actively and consistently use specific colors in their advertising. It has been repeatedly shown that consumers can identify a commercial origin through observing a certain specific color.\textsuperscript{84}

One mean of protecting a color is by including the color as a subsidiary element in another type of mark. Thus colors can be indirectly protected if they are included as visual elements of e.g. figurative marks. Nevertheless, in such a case the color only retains protection when used specifically in combination with the registered figurative mark.\textsuperscript{85}

\textsuperscript{80} See Lunell, p. 85, for a more detailed discussion regarding the problem of showing distinctiveness of 3D-marks.
\textsuperscript{81} See n. 74.
\textsuperscript{82} Sieckmann (IP Review) p. 26.
\textsuperscript{83} Sieckmann (IP Review) p. 28. See also Guidelines for Examination in the Office, Part B, Examination, Section 2, Formalities, p. 27.
\textsuperscript{84} See e.g. case C-104/01 Libertel [2003] ECR I-03793. An additional example; the color "Löfbergs Lila" has been registered in Sweden as it had acquired distinctiveness and consumers thus recognized a commercial origin in connection to observing the color, see PBR, case 03-088 (Löfbergs Lila).
\textsuperscript{85} When applying for a figurative mark which includes a specific color the color must be clearly indicated in the application, see EUTMIR, art. 3 (1).
Trademark protection for a color may also as mentioned above be directly sought for. In those cases, colors may retain protection that is either "concrete" or "abstract". The concrete protection is given to colors when they are used in connection to a specific form, such as for example when a specific color is applied to the form of a bottle. Trademark protection is then provided to the color only when used in the context it is applied for in the application.\textsuperscript{86}

Abstract protection of a color is much more extensive than the concrete protection. The abstract protection is given to the color per se, i.e. the color itself. Thus the color can retain trademark protection in theoretically\textsuperscript{87} all types of situations and applied to any type of object. Abstract protection can also be given to a combination of multiple specific colors capable of signifying a certain commercial origin.\textsuperscript{88}

In order for color per se marks to be able to be graphically represented in the register certain criteria need to be fulfilled. Color per se marks consisting of one color can be graphically represented by submitting a color sample, with a precise description of the sample in words. A recognized color code may also be added that indicates the exact nuance of the color.\textsuperscript{89}

It is not sufficient to only fulfill one of the above-mentioned criteria for graphical representation according to the pre-existing legal situation. Consequentially, even though a description in words is a visually observable representation of a trademark, it is not a representation which can be exact enough for representing a color per se. However, as shown in the \emph{Libertel}-case, the combination of different methods for providing graphical representations can fulfill the necessity of exactness for the color per se mark.\textsuperscript{90}

For color per se marks that consist of multiple specific colors, an additional criterion needs to be fulfilled for the graphical representation to be considered exact. Said criteria relates to how the colors themselves comprise the appearance of the mark. For example, one cannot both protect a shade of blue and a shade of yellow color in a color per se mark. Instead, one can protect a color mark consisting of e.g. 50\% blue, 50\% yellow color, with the blue color always positioned on top of the other or vice versa. When applying for a color per se mark, the graphical representation must therefore always systematically state the ratio of the colors and the positioning of them for the exactness criteria to be fulfilled.\textsuperscript{91}

\textsuperscript{86} Lunell, p. 123.

\textsuperscript{87} The reason for including the word "theoretically" is the following: As an applicant must state which goods and services a trademark shall encompass in the so called list of goods and services, the protected color can be used in relation to the goods and services applied for. In theory one could include all of the classes of goods and services when applying for a trademark, but in practice this is quite unlikely as most companies do not deal in hundreds of business areas simultaneously.\textsuperscript{88}

\textsuperscript{88} Lunell, p. 126.

\textsuperscript{89} See EUTMIR art. 3 (5). See also See also Guidelines for Examination in the Office, Part B, Examination, Section 2, Formalities, p. 25. Some examples of recognized color codes are RGB, CMYK and PMS.

\textsuperscript{90} Case C-104/01 Libertel [2003] ECR I-03793, para. 36.

\textsuperscript{91} Case C-49/02 Blau/Gelb [2004] EU:C:2004:384, para. 33. See also Guidelines for Examination in the Office, Part B, Examination, Section 2, Formalities, p. 25.
3.4.4 Sound marks

Sound marks are the last category of mark that, as of the writing of this thesis, EUIPO lists as a registrable sign capable of indicating commercial origin. On October 3, 2016, a total of 255 EU sound mark applications had been made since 1995. Sound marks consist of either musical sound elements, which for example can be a so-called marketing “jingle”, or natural sound elements, such as the roar of a lion. 92

Sounds themselves are comprised of soundwaves, which retain different frequencies. The frequency determines the pitch of the sound. Musical sound elements consist of different pitches which can be reproduced and arranged as musical notes. Meanwhile, natural sound elements consist of pitches that are not possible to be arranged into musical notes, as the frequencies involved are too differentiated. 93

One of the main issues that sound marks face is the problem relating to the graphical representation of such a mark. When a consumer comes in contact with a sound mark, they will typically only hear it, and not observe it. A sound mark thus lacks any inherent visible form. It has however been clarified through multiple legal sources that sound marks can retain a graphical representation, and thus be valid for registration. 94

Musical sound marks have been found by both the AG and the ECJ to be capable of graphical representation in accordance with the Sieckmann-criteria. The AG stated that the requirements for graphical representation of musical sound marks could generally be fulfilled by providing the sounds in the form of musical notation. 95 Likewise, the Court found that musical notes could be capable of graphically representing a musical sound mark, if they were represented in a notation system that showed height of pitch and length of notes. 96

The Court furthermore stated under which circumstances the criteria for graphical representation was not fulfilled. If a musical sound mark only is described by words, such as e.g. “the mark consists of the first notes of The Ride of The Valkyries”, it is not graphically represented in an exact enough manner. An onomatopoeia, i.e. sounds as mimicked in speech, for example the humming of a melody, is also not capable of representing a musical sound mark. 97

In regard to natural sound marks, words describing the natural sound have not constituted a graphical representation. An example of this can be found in the Tarzan Yell-decision, where the applicant had applied for trademark protection of the somewhat iconic “Tarzan yell”. In the application, the yell had been described by words and was rejected by the Board of Appeal

92 See EU trademark registration no. 005170113, ”Metro-Goldwyn-Mayer”.
93 Lunell, p. 190.
94 Ibid., p. 190-192. For the legal sources that are referenced to, see n. 90 and n. 91.
96 Case C-283/01 Shield Mark [2003] ECR I-14313, para. 61-63.
97 Case C-283/01 Shield Mark [2003] ECR I-14313, para. 59-60.
of OHIM under the grounds that said description did not constitute a graphical representation of the sound mark.98

For natural sound marks, it is instead necessary to provide a spectrogram in combination with a sound file sample (in mp3-format) in order to graphically represent such a mark. A spectrogram is a type of diagram, showing frequencies in combination with time and intensity. The sound file sample provides the replication of the sound itself, as the spectrogram only contains visual elements. It is not sufficient to provide a spectrogram without a sound file, or vice versa, in order to fulfill the exactness criteria for graphical representation.99

3.4.5 Olfactory marks and taste marks

Olfactory marks, also called “scent marks” or “smell marks”, in addition to taste marks, have only been registered once in the EU.100 However, applications of olfactory marks have been made several times between the years of 1996 and 2003.101 Nonetheless, after the decision given by OHIM in Decision R 120/2001-2, “The taste of artificial strawberry flavour”, all scent and taste marks applications were to be seen as non-submitted, meaning that OHIM would not even examine any new such applications thereafter.102

Scent marks can be divided into three categories: primary, secondary and arbitrary (or accessory) scents. Primary scents are such scents which consumers buy because of the smell itself, e.g. perfumes. Secondary scents are scents which have an inherent secondary function to the first function, such as for example scents belonging to shampoos. Shampoos have the primary function of cleaning hair but the secondary function of smelling good. Lastly, arbitrary or accessory scents are scents that are used in connection with things that do not usually have a distinct scent. One such example can be e.g. a smell of roses applied to vehicle tires. This last category, containing accessory scents, has generally been seen as capable of indicating the commercial origin of a product or service.103

The reason for choosing not to include scent and taste marks as protectable marks in the EU stems from the rulings given in the Sieckmann case104 and Decision R 120/2001-2, “The taste of artificial strawberry flavour”.105 It is worth noting that, as shown by the opinion of the AG in the Sieckmann case, scent and taste marks can nonetheless fulfill the function of indicating

100 See EU trademark registration no. 000428870 “The smell of fresh cut grass”.
101 As a side note, it can be of interest to mention that while only one smell mark has been registered in the EU, protection was in some instances given to smell marks in the UK prior to the Sieckmann ruling, such as UK registration no. 2000234 “the strong smell of bitter beer applied to the flight of darts”, see Holah, p. 1.
103 Lunell, p. 157.
105 OHIM Board of Appeal, R 120/2001-2 [2003] “Taste of artificial strawberry flavour”.
a commercial origin. However, the Court did not find that scent and taste marks could retain an adequate graphical representation in accordance with the criteria the Court stated was necessary (the criteria themselves are explained in chapter 4 of this thesis).

Following the Sieckmann ruling, it was decided that the visualization of a chemical formula is not sufficient for graphical representation. The ruling also excluded the possibilities for graphical representation through the description of the scent in words, or by providing a physical sample of the smell. Thus, scent and taste marks were excluded from trademark protection as they could not be graphically represented in a suitable manner. Chromatography, with either gas or fluid, is also another possible medium of visualizing a scent, but the AG stated in his opinion in the Sieckmann case that such technology was too unprecise to fulfill the Sieckmann criteria.

As an interesting side note, it can be of relevance to mention that the technology for perceiving smells through electronic media has been largely improved since the Sieckmann ruling in 2002. In approximately the last five years technology has been developed that enables users of TVs and smartphones to smell up to 10 000 scents through their screens. Consequently, it could be questioned if smells should still be excluded from trademark protection, which is discussed further in the analysis.

3.4.6 Other types of non-conventional marks

There are some additional types of non-conventional marks that are worthy of mentioning, but as they are quite uncommon, they will be jointly discussed in this subchapter. Some examples of such marks are motion marks, positional marks and touch marks.

Motion marks, or animated marks, are marks similar to holograms in the respect that they are trademarks which can change appearance in relation to a time-scale. Motion marks do however not need to be three-dimensional as holograms need. The common problem with motion marks is graphical representation as the motion marks, in likeness to holograms, need to be graphically represented by an image and a verbal description for every animation that the mark consists of.
Positional marks are marks which are always placed upon a product, with constant size and proportions. For example, a positional mark can be a specific seam or stitching on clothing, but also other things, such as a certain ring on a lightbulb.116 The placement of such a mark must therefore always be clearly described in the trademark application, as well as represented by an image of the mark itself. Positional marks share characteristics with design rights, as they are both always used in relation to the protection of the appearance of a product or a part of it.117

The idea of touch marks is quite new and no such marks have been registered in the EU yet. A touch mark consists of a texture that gives consumers an indication of a commercial origin of a product or service through the sense of physical feel. This can be for example the feeling of a certain wine-bottle texture against skin. Touch marks are different from for example design rights as the design right can protect the appearance of a texture, but not the feel of it.118

Distinctiveness is the main issue when registrating touch marks, as many touch marks lack inherent distinctiveness or may be found to only retain a functional nature. It may also be problematic to graphically represent a touch mark, as observers may not understand the precise feel of a touch itself by examining a representation of it. As an example, it may be very hard for individuals to perceive a feel of touch by for example observing an image of the surface-texture of a wine bottle.119

In likeness to scent marks however120, the technology relating to sensory perception also continues to develop. With the aid of software, it has become possible for adaptable screens to transmit textures and “bumps” to screens, which individuals may then feel when they touch the surface of their screen.121 The problems related to representation of touch marks may thus be smaller than earlier thought. Said discussion is detailed further in the analysis of this thesis.122

116 See EUTM 003799574, “Green ring on lightbulb”.
118 Monteiro, p. 9.
119 Ibid.
120 See n. 111.
122 See ch. 5.4.6.
4 Graphical representation and the Sieckmann case

4.1 The importance of the Sieckmann case

The Sieckmann case\(^{123}\) has, since the decision was taken in 2002, come to be regarded as one of the landmark cases for trademark law in the EU.\(^{124}\) It has, in hindsight, become the cornerstone ruling for defining the concept of graphical representation in relation to the nature of non-conventional trademarks. The ruling of the ECJ did so through the introduction of a certain set of criteria, commonly called the Sieckmann criteria. Consequentially, the case and its criteria has influenced the examination of all applications for non-conventional trademarks since the decision was given in 2002.\(^{125}\)

As the Sieckmann case and its criteria are of such high importance to the definition of the concept of graphical representation, both the case and criteria will be detailed extensively in the following chapter. The reason for giving an elaborate description of the case lies in its importance for the analysis of this thesis; to be able to clearly analyze how the removal of the “graphical” part of graphical representation will affect the legal situation, the concept of what exactly has constituted graphical representation must be precise. Likewise, in order to gain the ability to compare the earlier legal situation and the coming legal situation in the analysis, it is necessary to describe the consequences of the Sieckmann ruling for the earlier legal situation in relation to how it influenced legal certainty and flexibility.

4.2 Background

Dr. Sieckmann, a German patent attorney, applied for the registration of a smell mark to the German Patent- and Trademark Office (Deutsches Patent- und Markenamt). The sought registration concerned the smell of the chemical \(C_6H_5-CH = CHCOOCH_3\), or as expressed in words, methyl cinnamate. To fulfill the necessity of graphical representation, as then expressed in art. 2 of the first trademark directive\(^{126}\), the application included the depiction of the chemical formula above \((C_6H_5-CH = CHCOOCH_3)\) as well as a description of the smell. The smell was described as “balsamically fruity with a slight hint of cinnamon”. Lastly, references were given to addresses of certain facilities capable of providing scent samples of the applied trademark.\(^{127}\)

The GPTO proceeded to refuse the application of the smell, finding it unsure if smells could be registered as trademarks and if smells could be represented graphically. Dr. Sieckmann appealed the decision to the appellate court, the Bundespatentgericht. The appellate court, also

\(^{123}\) Case C-273/00, Sieckmann [2002] ECR I-11737.
\(^{124}\) See e.g. Mezulanik, p.1; Karapapa, p. 1335; Carapeto, p. 37.
\(^{125}\) Lunell, p. 160.
\(^{127}\) Case C-273/00, Sieckmann [2002] ECR I-11737, para. 11.
finding it uncertain if smells could be registered as trademarks as well as being represented graphically, suspended the case and referred it for preliminary ruling to the ECJ.\textsuperscript{128}

The appellate Court wanted the ECJ to provide clarity to two questions of interpretation. For the first question, they asked the ECJ to give an answer concerning if the wording of “signs capable of being represented graphically”, found in art. 2 of the first trademark directive, was to be interpreted as meaning signs which can be reproduced directly in their visible form, or if it also included signs, such as sounds and smells, that could be perceived visually be indirect means (for example through certain aids).\textsuperscript{129}

The second question, which was only to be answered under the condition of a positive answer of the first question, in regards to if signs can be perceived through indirect means, concerned the protection of smell marks specifically. The appellate court asked if the requirements for graphical representation were fulfilled if a smell is reproduced by either a chemical formula, by a description of the smell, by the means of a sample, or by a combination of all the aforementioned reproductions.\textsuperscript{130}

4.3 Ruling of the Court and the creation of the \textit{Sieckmann} criteria

In the ruling of the Court, the ECJ commenced their reply to the first question of the appellate court by examining the recitals of the first trademark directive. In the 10\textsuperscript{th} recital of the first trademark directive, it is stated that the base function of a trademark is for the trademark to act as an indication of origin. Furthermore, the Court stated that it was clear from earlier case-law\textsuperscript{131} that the essential function of a trademark is to guarantee that the identity of a product or service, belonging to a specific undertaking, is distinguishable to consumers without any risk of confusion.\textsuperscript{132}

The Court thereafter proceeded to examine the wording of art. 2 of the first trademark directive and how it should be interpreted. The wording of the article is the following:

“A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

The Court stated that a purpose of the provision was to define which types of signs that trademarks could consist of. They found that the provision only referred to such marks which are capable of being visually perceived, such as two- or three-dimensional marks. However, when examining the language in the provision, along with the 7\textsuperscript{th} recital of the directive,

\textsuperscript{128} See Kur & Dreier, p. 171.
\textsuperscript{130} Ibid., para. 19 (2).
containing wordings such as “necessary to list examples of signs” and “A trade mark may consist of [...]”\textsuperscript{133}, the Court found that the list of marks referred to in art. 2 was to be seen as non-exhaustive. As a consequence, signs which are only capable of being perceived visually through indirect means were not to be seen as expressly excluded from protection.\textsuperscript{134}

By coming to the above-mentioned conclusion, the Court found that article 2 of the first trademark directive was to be interpreted as meaning that trademarks may consist of signs that are capable of being perceived visually through indirect means, under the circumstance that the signs also could be represented graphically.\textsuperscript{135}

The Court thereafter continued by detailing what constitutes a graphical representation. They found that a graphical representation must give a sign the ability to be represented visually, “particularly by means of images, lines or characters”, in order for the representation to be able to be identified in a precise manner.\textsuperscript{136} Such an interpretation of the concept of graphical representation was deemed necessary by the Court for the well-functioning of the trademark registration system.\textsuperscript{137}

Expanding on the requirement of graphical representation, the Court proceeded to explain the different functions provided through said requirement. Firstly, it has the function to define the mark itself, as it then becomes possible to determine the precise nature and extent of the protection that the registered mark provides to its proprietor.\textsuperscript{138} Secondly, the requirement has the function of making the mark accessible through the trademark register for the competent authorities and the public, especially economic operators.\textsuperscript{139}

In connection to the first and second functions provided by the requirement of graphical representation, the Court developed their reasoning further by stating why the competent authorities and the public need said functions. In regard to the competent authorities, the Court declared that the authorities with clarity and precision need to be able to know the nature of signs of which marks consists, as they consequently can examine new trademark applications in a proper and certain manner\textsuperscript{140} as well as maintaining a precise and appropriate register of trademarks.\textsuperscript{141}

\textsuperscript{133} Emphasis has been added to the words ”examples” and ”may” for clarification, and does not appear in such a way in the directive itself.
\textsuperscript{134} Case C-273/00, Sieckmann [2002] ECR I-11737, para. 43-44.
\textsuperscript{135} Ibid., para. 45.
\textsuperscript{136} Ibid., para. 46.
\textsuperscript{137} Ibid., para. 47.
\textsuperscript{138} Ibid., para. 48.
\textsuperscript{139} Ibid., para. 49.
\textsuperscript{140} Note that the Court did not explicitly state how applications were examined in a more certain manner. However, the Court implicitly referred to, for example, the evaluation of confusing similarity between marks, which is performed during the registration process if an opposing party submits an opposition to a trademark application. For further information regarding said evaluation, see Kur & Dreier, p. 190.
\textsuperscript{141} Case C-273/00, Sieckmann [2002] ECR I-11737, para. 50.
Regarding the reasons why the economic operators of the public required the functions provided by graphical representation, the Court stated the following. For economic operators to be able to determine, with clarity and precision, which registrations and applications that have been made by their competitors or other undertakings on the market, the requirement of graphical representation was deemed necessary. Through said requirement of graphical representation, the economic operators could therefore receive relevant information about the rights of third parties and act accordingly.¹⁴²

The Court thereafter stated what has become the reasoning behind the so called “Sieckmann criteria”. Firstly, on order for users of the trademark register to be able to ascertain the precise nature of a mark through its registration entry, the Court found that the graphical representation of the mark must be self-contained, easily accessible and intelligible.¹⁴³ Furthermore, as trademarks do not in theory have a final date when the protection of the mark ends, the graphical representation must be durable to stand the passing of time.¹⁴⁴ Lastly, the Court stated that graphical representations must be objective, in order for the marks to be perceived in an unequivocal manner, eliminating any subjective elements of the perceived representation.¹⁴⁵

In summarizing what they had found when interpreting art. 2 of the first trademark directive, in order to answer the first question of the appellate court, the Court created what came to be called the Sieckmann criteria. The conclusion of the Court led as follows:

“In the light of the foregoing observations, the answer to the first question must be that Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”¹⁴⁶

As seen above, the Court established seven criteria for graphical representation that needed to be fulfilled for trademarks which could not be perceived visually by direct means. Applying these newly created criteria, the Court proceeded to answer the second question posed by the appellate court, namely if smells could be graphically represented and thus afford protection as trademarks.

In the second question of the appellate Court, they specifically asked if the requirement for graphical representation of a smell could be fulfilled by providing a chemical formula, a description of the smell, a sample, or by a combination of said things. The Court first examined whether a chemical formula could fulfill the requirement of graphical representation.

¹⁴³ Ibid., para. 52.
¹⁴⁴ Ibid., para. 53.
¹⁴⁵ Ibid., para. 54.
¹⁴⁶ Ibid., para. 55. Emphasis is added to highlight the criteria themselves.
Concerning chemical formulas and the requirement for graphical representation, the Court referred to the observations submitted in the case by the United Kingdom government and the Austrian government. Both governments had in their submissions called attention to that different factors, such as quantity, temperature and concentration of the smell may actually influence how the smell is perceived, thus causing uncertainty regarding the exact extent of the protection of the mark. Furthermore, the United Kingdom government noted that very few people can connect a chemical formula to the object or element it represents, and even if so, it would be hard for most to understand the exact smell by observing the formula.

The Court, based on the submissions above and their own subsequent conclusion, stated that a chemical formula does not fulfill the requirements of graphical representation. Firstly, the Court found that a chemical formula is not intelligible enough for most people, as most could not understand what the representation in question actually means. Secondly, a chemical formula does not always represent the smell of a substance, but the substance itself, and the representation is therefore not sufficiently precise and clear.

Thereafter, the Court answered if a written description of a smell could be a sufficient graphical representation. Admittedly, a written description did fulfill the “graphical” part of graphical representation. However, as different people most likely will interpret and describe a smell in different ways, which the Commission also pointed out in their submission, the criteria of objectivity could not be seen as fulfilled.

Lastly, the Court found that a sample of a smell is not sufficiently durable or stable to conform to the requirements of graphical representation, as the quality and contents of a sample can degrade over time. A combination of a written chemical formula, a description in words and a sample did not fulfill the Sieckmann criteria either, as none of the single elements had proved that they could fulfill the requirements for graphical representation and were still unclear and unprecise when combined together.

To summarize the ruling, the Court had through their interpretation of art. 2 of the first trademark directive found that it is indeed possible for signs which are in themselves not capable of being perceived visually to retain protection as trademarks. However, for such marks to be able to gain trademark protection, they must fulfill certain criteria regarding their graphical representation, which later came to be called the Sieckmann criteria. The criteria require that the graphical representation of such above-mentioned marks need to be clear, precise, self-contained, easily accessible, intelligible, durable and objective. When applying said criteria to smells, the Court found that it was not possible for smell marks to achieve the requirements that the criteria brought for graphical representation.

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147 Case C-273/00, Sieckmann [2002] ECR I-11737, see para 63-64.
148 Ibid., para. 64.
149 Ibid., para 69.
150 Ibid., para 65 & 70.
151 Ibid., para. 71.
152 Ibid., para 72-73.
4.4 Consequences following the ruling

4.4.1 The administration of smell and taste mark applications

Naturally, one consequence of the Sieckmann ruling was that smells were deemed to be unfit for protection through trademark registrations. Shortly after the Sieckmann case, a decision was given by the OHIM Board of Appeal where they declared that, following the Sieckmann ruling, taste marks could not either fulfill the criteria for graphical representation. In retrospect, the decision has been utilized by OHIM/EUIPO as a stopping mechanism, as all smell and taste mark applications made subsequently to the decision has been seen as “non-submitted” and thus not examined any further by the Office. Furthermore, it was stated in a decision by the fourth OHIM Board of Appeal that there is no further room for interpretation regarding graphical representation for smell marks following the Sieckmann ruling.

Another related consequence following the Sieckmann case was the problem that arose due to that there actually existed an already valid registration for a smell mark within the EU, registration no. 000428870, “The smell of fresh cut grass”, which was registered in October 2000. As the Sieckmann ruling had shown, it was a practical impossibility to register a smell mark which fulfilled the requirements of graphical representation. The above-mentioned registration was not declared as invalid however, but expired in 2006 as it was not renewed. It is very likely that the holder of the trademark did not renew the trademark as they knew of the legal developments regarding smell marks.

4.4.2 Consequences for legal certainty and flexibility in the trademark registration system

The ECJ stated in para. 37 of the Sieckmann ruling that:

“The registration system for trade marks constitutes an essential element of their protection, which contributes, in respect of both Community law and the different national laws, to legal certainty and sound administration.”

The above-mentioned statement illuminates the underlying aims of the ruling in the Sieckmann case well. Through the ruling in the case important changes were imposed onto the trademark registration system, mainly with the purpose of improving legal certainty. Firstly, even though the Sieckmann case dealt specifically with a smell mark, the criteria concerning the requirements of graphical representation became universally applicable to all marks which were not in themselves capable of being observed directly. Furthermore, representations of such non-conventional marks that were capable of being perceived directly, such as holograms, still needed to fulfill the Sieckmann criteria, as they needed to be precise and

155 See OHIM Board of Appeal, R 0445/2003-4 [2005] ”El olor a limón”.
156 Holah, p. 1.
clear. Consequently, said changes also influenced how applicants submitted their trademark applications after the ruling.\textsuperscript{158}

By applying the \textit{Sieckmann} criteria when examining if marks fulfills the requirements for graphical representation, the trademark system gained a uniform standard for representing trademarks to the public and to the authorities. This was achieved as trademarks only could be represented in a few select ways according to the criteria, which made trademarks in the trademark registration system appear under the same or at least very similar circumstances. It thus became easier to search, access and understand, for both authorities and public, what a certain trademark was and what its protection entailed as the information became structured in a consistent manner.\textsuperscript{159}

It has already been mentioned above that a consequence of the \textit{Sieckmann} criteria was an improved level of legal certainty. To give a more detailed explanation, the following can be stated. Earlier in this thesis, the precise and defined concept of legal certainty was described; legal certainty means that individuals need to be able to ascertain what their rights and obligations are in an unequivocal manner.\textsuperscript{160}

As has been shown above, the standardization of the requirements for graphical representation led to that the relevant authorities, and the public, consisting of applicants, opposers and observers, could more easily access and understand the contents and structure of the EU trademark register. Involved parties also gained an ability to better predict the legal measures which could follow when applying for a trademark. Consequently, this improved legal certainty to an extent.\textsuperscript{161}

The \textit{Sieckmann} ruling and its criteria for graphical representation also had quite an opposite effect on flexibility however. Following the ruling, those applying for non-conventional trademarks have sometimes had to adhere to a strict set of rules which can even seem contradictory in practice.

An example of the above-mentioned can be found with sound marks. An applicant of a sound mark naturally wants to protect the sound itself, and may thus wish to submit a digital sound file which is an exact copy of the sound in question. Nevertheless, with the application of the criteria for graphical representation, it means that a sound file is not sufficient as it is of a non-graphical nature. Consequently, the sound mark cannot be registered on the basis of how the sound actually sounds.

In contrast, a musical notation is deemed to be acceptable because it is a graphical representation of the sound mark, even though the notation could be played by a

\textsuperscript{158} Corcoran, p. 1-2.
\textsuperscript{159} Ibid., p. 1.
\textsuperscript{160} See ch. 2.2.
\textsuperscript{161} Corcoran, p. 1-2.
variety of instruments, with different volumes and so forth. The trademark registration system can thus become inflexible for those wishing to apply for a non-conventional trademark such as a sound mark, as what may logically be seen as the most suitable form of representation does not fulfill the legal requirements for graphical representation.

The same reasoning can also be applied to, for example, animated marks; the most flexible manner of representing them would logically be through showing the animation itself through the means of, for example, a video file (e.g., an mp4-file or any other suitable format). However, existing regulations and case-law that corresponds with the criteria for graphical representation require that an animated mark must instead be represented by an image and a verbal description.

See Guidelines for Examination in the Office, Part B, Examination, Section 2, Formalities, p. 24-25. See also EUTM No. 7227218 “HULU, animated mark”, which was rejected because the images and the accompanying description were not deemed sufficiently precise and accurate.

163 See Guidelines for Examination in the Office, Part B, Examination, Section 2, Formalities, p. 24-25. See also EUTM No. 7227218 “HULU, animated mark”, which was rejected because the images and the accompanying description were not deemed sufficiently precise and accurate.
5 Analysis

5.1 The aim and structure of the analysis

This introductory chapter of the analysis has the purpose of clarifying how the analysis will answer the posed research questions of the thesis and how it is structured. The chapter also includes a short recapitulation of the research questions themselves so the reader can follow the analytical conduct with easier understanding.

5.1.1 The posed research question

The 9th recital of the AMTR states that:

“In order to allow for more flexibility while also ensuring greater legal certainty with regard to the means of representation of trade marks, the requirement of graphic representability should be deleted from the definition of an EU trade mark. A sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”164

As has been shown in chapter 2 of this thesis however, legal certainty and flexibility are often in opposition to one another. The above-mentioned recital must thus be tried regarding its validity, which the research question has the aim of answering.

The research question of the thesis is divided into two interconnected parts.165 The first part of the question seeks to predict how the removal of the requirement for graphical representation will affect the trademark registration system in regards to both legal certainty and flexibility. The second question is dependent on the answer of the first question; Are the consequences, which follow from the findings of the first question, compatible with the Sieckmann criteria?

5.1.2 Structure of the analysis

The analysis is structured in a manner comparable to the structure of chapter 4; the consequences for legal certainty and flexibility following the removal of graphical representation will be analyzed in connection to each different type of trademark, such as e.g. sounds marks, 3D-marks and so forth. Furthermore, the relevant Sieckmann criteria will be examined on each new mean of representation that may become valid following the removal of graphical representation. In the concluding chapter of the thesis, chapter 6, the analytical results for the different trademark types are summarized in a joint manner before the thesis gives a final answer concerning how the removal of graphical representation will affect the trademark registration system.

164 ATMR, recital 9.
165 See ch. 1.2.
5.2 The removal of the need for graphical representation in art. 4 of the ATMR

Before examining and analyzing the consequences for the trademark registration system in regards to legal certainty and flexibility, the changes in the legislature itself will be shown. Prior to the introduction of the ATMR, article 4 of the EUTMR provided that:

“The EU trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

Following the changes stemming from the introduction of the ATMR, article 4 now reads:

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

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

b) being represented on the Register of European Union trade marks, (“the Register”), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”

There are numerous changes to the provision. Most visually noticeable is the division of the provision into three separate parts. In the first part, a recounting follows which states a number of different types of trademarks possible for registration. Even though no case-law yet exists that explicitly states that the new list of recounted trademarks is to be seen as non-exhaustive, the author of this thesis finds that it is very likely that the list is to be interpreted in such a manner. The reasoning behind said conclusion is stated below.

By applying the same argumentation that the Court had used in the Sieckmann case, where the Court found that the wording in art. 4 of the CTMR indicated a non-exhaustive nature due to its language, by for example including the word “may” and not the word “must”, it is in the belief of the writer of this thesis that art. 4 of the ATMR is to be interpreted in the same manner, as the new provision states that “An EU trade mark may consist of any signs […]”. As a consequence, non-conventional trademarks which are not included in the list may still be able to retain trademark protection.166

Another change has been added in the list of recounted trademarks. The change itself might not be very notable visually, but may actually serve as an indication of how the legal situation is changing following the removal of the need for graphical representation. Aforesaid change in the list is the addition of the first type of

166 For the above-mentioned conclusion of the Court, see Case C-273/00, Sieckmann [2002] ECR I-11737, para. 43-44.
trademark that is not visually perceivable; sound marks. As no explicit reference to non-graphical marks has ever been included in the EU trademark legislation before, the inclusion of such a mark can according to the writer of this thesis be seen as an expression of a legal situation that more than ever before accepts non-graphical signs as permissible for trademark protection.

The second and third parts of the amended art. 4 ATMR are to be examined in connection to the first part, which states that marks must be capable of two things. According to the second part, found under subheading a), a mark must be capable of distinguishing its commercial origin. The wording itself has not changed in regard to its contents from the EUTMR to the ATMR.

The third part of the article, which regards representation, has changed substantially from the ATMR to its preceding contents in the EUTMR. Firstly, the new provision states that a sign must be capable of representing a trademark. The change found here is of outmost importance of this thesis and the legal situation for trademarks as a whole; the word “graphical” is removed in connection to the word “represented”. By removing the graphical requirement for a trademark representation, trademarks are consequently allowed to be represented through non-visual means as of the introduction of the amendment.

Furthermore, the Sieckmann ruling and some of its criteria have been incorporated into the third part of the amended article. The requirement of clarity and precision for users and observers of the trademark register have been explicitly included in the provision. The reason behind aforesaid inclusion was made in order to make it possible for the users and observers to determine the precise nature of protection that a trademark retains. As shown in chapter 4.4.2 of this thesis, this was also one of the main aims of the Sieckmann ruling, as it set out to improve the legal certainty of the trademark registration system.

5.3 Consequences for conventional trademarks

The consequences for conventional trademarks following the removal of the requirement for graphical representation will most likely not be affected in any notable manner. As stated earlier, word marks and figurative marks are the types of marks that most frequently referred to as conventional marks.167

The current procedure of depositing representations for the above-mentioned conventional trademarks is through providing either a written sequence of text, in standardized font, for word marks, or an image or electronic image file for figurative marks. The aforesaid types of trademark representations do also, by their nature, fulfill the Sieckmann criteria (e.g.

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167 See ch. 3.3.
precision, durability and objectivity) which is not generally ever contested in trademark law.\textsuperscript{168}

In likeness to the above-mentioned, the author of this thesis also finds that the current method of representing word marks and figurative marks is the most suitable; to introduce new ways of representation for conventional marks would not improve legal certainty as they already fulfill the \textit{Sieckmann} criteria with ease.\textsuperscript{169}

New types of representations of conventional marks could likely on the other hand bring more uncertainty for applicants, opposers, examiners and other observers of the trademark register, as the objects of trademark protection would become more difficult to distinguish. Consequently, it is the opinion of the author of this thesis that the trademark registration system does not need to adapt in regards to the representation of conventional marks following the removal of the need for graphical representation.

\textbf{5.4 Consequences for non-conventional trademarks}

In the 9\textsuperscript{th} recital of the ATMR it is stated that signs should be allowed to be represented “in any appropriate form” using “generally available technology”, which in turn would lead to both improved legal certainty and flexibility.\textsuperscript{170} The question thus arises regarding what is considered both an appropriate form and what constitutes generally available technology. Earlier, the predominant technological format that has been accepted by the EUIPO is images and electronic image files. To some extent, sound files have also been regarded as acceptable when accompanied by an image file. Sound files are sometimes available for both playback and download in the form of mp3-files, which are provided through the online EUIPO trade mark register at the entry pages for the sound marks in question.\textsuperscript{171}

Generally available technology and appropriate form are quite vague terms. Official sources do not yet state what constitutes an appropriate form or generally available technology. The EUIPO website only declares that EUIPO will provide users of the register with “information on the alternative media and formats that are considered to comply with the new provision” some time before the amended art. 4 ATMR comes into force.\textsuperscript{172} However, by examining the contents of the 9\textsuperscript{th} recital of the ATMR it can be understood that an “appropriate form” needs to at least fulfill the

\textsuperscript{168} For example, note how in the \textit{Sieckmann} ruling, the Court only mentioned non-conventional marks, whereas the Court did not find it necessary to clarify that word marks and figurative marks are capable of precise and clear representation, as such marks are inherently clear and precise, as they can only be represented exactly as to how they appear when observed.\textsuperscript{169} See n. 153.\textsuperscript{170} ATMR, recital 9.\textsuperscript{171} See for example EU trademark registration no. 005170113, ”Metro-Goldwyn-Mayer”, available online at https://euipo.europa.eu/eSearch/#details/trademarks/005170113.\textsuperscript{172} See the information found under the tab “Graphical representation” available at https://euipo.europa.eu/ohimportal/en/eu-trade-mark-regulation-technical.
Sieckmann criteria, in that the form is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The meaning of the term “generally available technology” as found in the 9th recital of the ATMR can nevertheless not be found in any legal sources. It is assumed by the author of this thesis that such technology includes the most commonly available media and media formats. Thus, in practice the term would include at least a media player that is capable of showing electronic image files or playing sound files and video files.

Observe that the term in question also can be somewhat misleading, as it is the EUIPO itself that will define what constitutes generally available technology and not the other parties who use or observe the trademark registration system, such as applicants or trademark proprietors. Another factor that makes the term vague is that it is dependent on time; technology is developed fast in our modern society and what is widely available may thus also change quickly. Therefore, what is considered as generally available technology may change over the course of a few years.\(^{173}\)

### 5.4.1 Three-dimensional marks

Three-dimensional marks have earlier been possible to represent through providing at least six images from different angles of the object which seeks to retain trademark protection.\(^{174}\) Using the amendment of the 4th article of the ATMR, in addition to considering the contents of the 9th recital of the ATMR, there is at least one new type of representation that might seem possible for three-dimensional marks to use.

The above-mentioned means of representation might seem as an overly obvious alternative, as it consists of actually displaying the three-dimensional mark in three dimensions. For such a representation, the 3D-representation would be provided and shown through an interactive, electronic 3D-model viewer. The observers of the 3D-model viewer would be able to manipulate the view of the trademark object by clicking and dragging said object on the 3D-view interface. Consequently, it is possible through this type of representation to see all available angles of the trademark instead of seeing one separate angle in one image.

As stated in the 9th recital, a trademark representation should be represented in appropriate form through generally available technology. Since 2015, it has been possible for applicants of RCDs (Registered Community Designs) to deposit samples of 3D-models of a design object into an interactive and dynamic 3D-model viewer.\(^{175}\) The technology capable of

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\(^{173}\) Compare for example the introduction of smartphones into the consumer market, as they were introduced in 2007 and became the new standard for cellular phones within 5 years. For further reading, see https://www.statista.com/topics/840/smartphones/ (accessed on 2016-11-15).

\(^{174}\) See ch. 3.4.1.

\(^{175}\) See https://euipo.europa.eu/ohimportal/en/the-four-step-form#design(s)-information, under the tab “Design(s) information”. The electronic formats for 3D-models currently accepted are .OBJ, .STL and .X3D. See also the
showing and manipulating 3D-models does thus exist, and is also already incorporated into the application and registration process of design rights within the EUIPO. As designs and 3D-trademarks are closely related in nature\textsuperscript{176}, it would not be improbable to assume that the same technology could be utilized for three dimensional trademarks according to the author of this thesis.

The 3D-view of the trademark must still also be regarded as an appropriate form for representation however, in order to qualify for trademark protection. To achieve this, the representation must fulfill the \textit{Sieckmann} criteria. It is clear that the representation inherently fulfills the criteria of being intelligible, durable and objective. This circumstance stems from that the representation is easily understood by observers, undegradable (as it is in electronic format) and impossible to interpret in different manners, as the representation only contain elements that are fully non-verbal.

Furthermore, the criteria of precision and clarity are fulfilled as the 3D-model of the representation provides an exact replica of the trademark object in question, viewable from all possible angles the object can be seen from. It is in the opinion of the author that this type of representation fulfills the \textit{Sieckmann} criteria of precision and clarity better than the pre-existing type of representation for three-dimensional marks. As the pre-existing type of representation only shows six angles of the trademark object, it thus leaves said representation with less precision than if all angles of the object would be shown. Consequently, the 3D-model view of the representation is more precise and clear according to the author.

Nevertheless, it could be questioned if the criteria regarding self-containment and easy accessibility are fulfilled with the 3D-model type of representation. Said type of representation is only available for the public through online access of the EUIPO website, which makes it inaccessible to those not using the Internet. Furthermore, the representation is only capable of being shown through a specific utility for viewing 3D modes, which arguably results in that the representation is not self-contained. The possibilities for viewing the representation are thus completely dependent on electronic means, which is in contrast to the pre-existing types of representation that can be shown in the physical world as printed images.

By providing the EU trademark registration system with the possibility of utilizing the new 3D-model representation, following the introduction of the amended art. 4 of the ATMR and the 9\textsuperscript{th} recital of the same regulation, it is in the belief of the author of this thesis that both legal certainty and flexibility might become improved as a consequence.

As has been stated earlier in this thesis, legal certainty and flexibility are often in opposition to one another. In this case however, both elements may increase simultaneously. The new type of representation is, on one hand, more precise than earlier representations of three

\textsuperscript{176}See ch. 3.4.1.
dimensional marks, which increases legal certainty as individuals better can determine the exact extent of the protection that a trademark provides its proprietor.

On the other hand, the new representation also increases flexibility, as individuals can either choose the new type of representation when filing online or the old but nonetheless still valid type of representation when filing a physical application. A combination of the two types of representations could also be filed in conjunction when applying in the online format. Consequently, this results in that applicants can choose between a total of three different alternatives when applying for protection of a 3D trademark, which is in contrast to the earlier situation where only one option could be chosen. Individuals are thus given more choices by the trademark registration system, and can choose representation according to which alternative that best suits their means.

Nonetheless, the problem still remains concerning the possible non-fulfillment of certain Sieckmann criteria relating to accessibility and self-containment. As this problem is also prevalent with some other new types of representations for non-conventional trademarks, the discussion regarding said problem is made jointly in the summarizing chapter of the analysis.

5.4.2 Holograms

By applying the amended article 4 of the ATMR, with the contents of the 9th recital of the same regulation also in mind, there are according to the author of this thesis at least two new manners of representations that could become possible for representing a hologram trademark.

As of the EUTMR, holograms are capable of suitable representation through providing images of the hologram from all different angles, with accompanying verbal descriptions of the movements of the hologram. The new types of representations that might become possible to represent a hologram trademark with are, in the belief of the author, either a video file depicting the hologram and its movements, or utilizing a 3D-model, as proposed for three-dimensional marks above.

A combination of the two above-mentioned types of representations may however prove to be the most suitable option for representing a hologram trademark. A video file of a hologram might best show the movements of the hologram, but it may still not be possible for observers to gain a clear and precise overview of how the hologram looks from different angles. A 3D-model can in contrast best provide a clear and precise overview of all the angles of the hologram but it cannot, at least not with generally available technology, show any movement that occurs. Consequently, the combination of both representations in question might be the most compatible with the Sieckmann criteria, as the criteria regarding precision and accuracy best are fulfilled when utilizing both representations.

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177 See ch. 3.4.2.
178 See ch. 5.4.1.
By utilizing the new representations, legal certainty would most likely improve. In contrast to the prior manner of representing holograms through images and descriptions, the new manners are in the opinion of the author more suited to fulfill the requirements posed by the Sieckmann criteria. For one, images do not convey as much information as a recording, and a rather high number of images may be needed to reflect the content of a recording. A video file showing a hologram is thus more likely to be more precise as a representation than images showing a hologram. Likewise, verbal descriptions of a hologram and its movements may become subjective to a degree, as a verbal description with some probability will change in wording from person to person. By using a recording of the movements instead of a verbal description, the element of subjectivity instead becomes eliminated as the recording depicts the exact nature of the movements in question.

As a result of the above-mentioned improvements to clarity and precision following the introduction of the new types of representations for holograms, legal certainty would thus likely improve as a consequence. The flexibility of the trademark registration system could nevertheless also increase with the new types of representations for holograms. As individuals obtain more possible ways of representing their trademark, they can choose from the option that is most suitable for them, which in turn makes the trade mark system more flexible. If for example an applicant does not have the capability of creating or providing a video file or a 3D-model, images are still considered as acceptable representations of holograms.

With holograms however, as with three-dimensional marks, it is questionable if the 3D-model representation is deemed to be self-contained as it needs a specific utility to be shown. As stated in the previous chapter regarding three-dimensional marks, the question regarding the criteria of self-containment will be discussed in the summarizing chapter of the analysis.

5.4.3 Colors per se marks

Color per se trademarks (i.e. marks consisting only of a color) have earlier been capable of representation through a visual sample of the color in question, supplemented with a mandatory verbal description. A complementary recognized color code may also be added.179

It does not seem necessary, in the belief of the author of this thesis, for color per se marks to be represented in a new alternative manner. The current ways of representing a color per se marks fulfill the Sieckmann criteria, and there does not seem to be any clear new alternative of representing color per se marks stemming from the possibility to use “generally available technology” as stated in the 9th recital of the ATMR. Consequently, the removal of the requirement of graphical representation does not affect color per se marks in a notable manner.

It can be noted however, that a more precise way of representing color marks could possibly be achieved by increasing the importance of providing a recognized color code when applying

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179 See ch. 3.4.3.
for color per se marks. The recognized color code gives applicants and trademark proprietors an increased ability to ascertain their rights, or if their rights are intruded upon, with better precision and exactness. Likewise, authorities may better perform their examinations. Without usage of recognized color codes the representation becomes more unprecise, as for example the verbal description of a color more likely will not be able to describe the exact nuances of a color. The author of this thesis therefore believes that representation of color per se marks should include usage of recognized color codes, for better precision and thus also legal certainty. Flexibility would in the belief of the author not improve in any notable manner for color marks, as no new alternatives for representation for color marks have come to emerge following the introduction of the AMTR.

5.4.4 Sound marks

Sounds marks have previously been capable of suitable representation through either musical notation if it is a musical sound mark or spectrograms in combination with sound files if it is a natural sound mark. Following the removal of the requirement of graphical representation however, it will at least in theory no longer become necessary to provide musical notation or a spectrogram when registering a sound mark. In practice it may nevertheless still be required, at minimum, to provide a spectrogram in order to fulfill the Sieckmann criteria of clarity and precision, which is something that will be discussed more extensively later in the chapter.

Article 4 of the ATMR and the 9th recital of the same regulation has introduced the possibility of utilizing sound files when applying for protection of sound marks. Sound files (in mp3-format) are already able to be played on the EUIPO website for some sound trademark entries in the register. Sound files are thus most likely to qualify as being capable of representation through generally available technology, in accordance with the contents of the 9th recital of the ATMR.

In the belief of the author of this thesis, sound files are inherently more suitable for representation of a sound mark than musical notation. Musical notation is generally not intelligible for the broad public, which makes it arguable if musical notation fulfills the Sieckmann criteria. Furthermore, stemming from the lack of intelligibility, many individuals can thus not ascertain the extent of the protection of a sound trademark when represented by musical notation. By instead using a sound file to represent sound marks however, the exact character of the sound which retains trademark protection will be replicated for the listeners. Consequently, the trademark system pertaining to sound marks becomes more legally certain when using sound files, as individuals more easily can determine the protection given by a trademark right and act accordingly.

180 See ch. 3.4.4.
182 See ch. 4.4.2.
Musical notation alone, in the opinion of the author of this thesis, is thus not suitable for representation of sound marks in a modern society. Musical notation should thus be complemented by a sound file in the future, in order to fulfill the Sieckmann criteria. It could however also be questioned if sound files by themselves fulfill the above-mentioned criteria.

An example can be given to clarify the above-mentioned: When two sound marks represented by sound files are compared to each other, the individual examining the sounds might miss certain distinctions between the sounds. The human sense of hearing, while generally reliable, may sometimes perceive sounds incorrectly by either adding or omitting certain nuances or frequencies of the sounds in question. Consequently, sound files can also retain a small measure of imprecision, at least when being compared to other sound files.

Following the introduction of the ATMR, a plausible and suitable alternative for representing a sound mark can be accomplished by providing an electronic file capable of containing both auditory and visual elements. Said file should contain a reproduction of the actual sound in question, which in turn is visualized through a waveform image, such as spectrogram, showing the change in frequencies and intensities over a scale of time corresponding to the length of the sound. Such technology is generally available and widely used when recording audio samples. Audio samples are often of the .wav-format, which visually show the waveforms that comprise the sounds. The combined sound and waveform-representation provides a more complete overview of the exact character of a sound, showing changes in frequencies or tone which the human ear might miss.

By using the abovementioned type of representation for sound marks, a higher level of precision and clarity can be achieved for individuals using the EU trademark registration system. When comparing the sound/waveform-files of two sound marks, an individual examining the representations will most likely be able to ascertain the likenesses and differences of the sound marks better with aid of the above-mentioned files, than if only sound files without visualization were used for representing the sound marks. Consequently, even though the requirement of graphical representation is removed from EU trademark law, sound marks may actually still need a visual element to fulfill the Sieckmann criteria of precision and exactness. This may in turn lead to a higher level of legal certainty. In the opinion of the author of this thesis, it will be of major interest to observe whether or not sound marks will be capable of precise representation through only sound files in the future, and the reasoning of the legislators, courts and authorities behind such a decision.

Flexibility might also increase for the individuals utilizing the trademark register to seek protection of sound marks, as those without the capability of providing a spectrogram or musical notation can instead provide an electronic recording of the sound itself as a representation following the introduction of the ATMR. As electronic recordings of sounds contained in sound files might possibly be the most common means of reproducing a sound in our modern society, it would be inflexible to disallow individuals from representing sound marks by sound files. The ATMR has thus provided a measure of flexibility to the trademark registration system in regards to registration of sound marks.
5.4.5 Olfactory marks and taste marks

Following the *Sieckmann* ruling and Decision R 120/2001-2, “The taste of artificial strawberry flavour”, both scent and taste have been excluded from protection as trademarks. However, the time might have come for a reevaluation of the validity of the above-mentioned rulings in relation to the question regarding representation and protection of scent and taste marks. The introduction of the ATMR and the amendment of the 4th article has removed the biggest obstacle for scent and taste marks, namely the requirement of graphical representation. As scents and tastes are inherently of a non-graphical nature, the removal of above said requirement may open up for new possibilities for protection of scent and taste marks, as the marks can now be represented by new, non-graphical means.

As stated before however, the representation of a scent or taste must still be in appropriate form and capable of being represented by generally available technology. To provide a sample of the smell at specific places such as laboratories, which was suggested by the applicant in the *Sieckmann* case, is nevertheless still not suitable. Such physical samples, while non-graphical, are not self-contained, durable or easily accessible for the general public. However, with the development of new technology, such as smell transmitters in screens of televisions and smartphones, the scents samples would instead become both durable and easily accessible for the public. While such smell transmitting technology may not be “generally available” at the moment, it still exists and may become available in a much broader scale within a foreseeable future.

It is uncertain whether or not the transmitted smell samples are of appropriate form however. The fulfillment of the criteria of precision and clarity still remain problematic for scent and taste marks since the *Sieckmann* ruling. While individuals can obtain easy access to durable scent samples with the new scent screen transmitting technology, they might still not be able to correctly identify the exact character of the smell when they come in contact with the sample. Thus, the possibilities of using completing types of representations together with the smell transmitting technology should be examined.

A verbal description of the smell, shown in connection to the release of the above-mentioned sample, may possibly not be sufficient to fulfill the *Sieckmann* criteria as the verbal description might be seen as it contains subjective elements. To show a chromatogram in relation to the scent sample will most probably not fulfill the criteria of intelligibility, as many individuals cannot understand the meaning of a chromatogram. The lack of a recognized system for smells, as already exists for e.g. colors, further causes a problem to the clear

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183 See ch. 3.4.5.
184 Compare the reasoning of the Court in the *Sieckmann* ruling, where the Court found that smell samples degrade and are thus not suitable as representation of scent marks, see para 71 of said ruling. See also ch. 4.3.
185 See ch. 3.4.5.
186 Compare the reasoning of the Court in the *Sieckmann* ruling, para. 70.
187 Compare the reasoning in the Opinion of the AG in the *Sieckmann* case, para 44.
representation of scents as it is consequently not possible to categorize smells according to a logical systematic.

The absence of representations that are of “appropriate form” thus still poses a problem to the protection of scent and taste marks. It could be argued that scents and tastes which are nearly universally known might be able to be represented solely by the screen transmitting technology, as most individuals would be capable of identifying and distinguishing the smell or taste without complementary representations. To allow this may however diminish the level of legal certainty in the trademark registration system according to the author of this thesis. The precise extent of the protection which is given upon the scent or taste trademark would be hard for individuals to ascertain whenever a smell deviates from the most commonly known and identifiable scents, or when multiple smells are combined together. Therefore, the possibilities for protection of scent and taste marks remain small even after the removal of the requirement for graphical representation.

One should not rule out all possibilities for protection of scent and taste marks indefinitely however, as both technology relating to precise representation of scents and trademark law develops continuously. The single largest hindrance for registration of scent and taste has nonetheless been removed with the introduction of the ATMR and the amendment of the 4th article, making it theoretically probable that scent and taste marks may one day be able to retain protection in the EU trademark registration system.

5.4.6 Other types of non-conventional marks

The three types of non-conventional marks that were described in the correlating descriptive part of this thesis were animated marks, positional marks and touch marks. As every type of different mark varies greatly in their respective nature, they will be analyzed separately.

Animated marks have earlier been represented through images with accompanying descriptions of every movement that occurs during the animation which comprises the mark. Animated marks are thus quite alike holograms in respect of their requirement regarding representation, as holograms also have had the necessity of using complementing verbal descriptions to describe their movements in order to fulfill the Sieckmann criteria of precision and clarity. However, animated marks do not retain protection for different angles of the animation (three-dimensional views) and the 3D-model type of representation mentioned in the subchapters of the analysis regarding 3D-marks and holograms is thus not relevant for animated marks.

Instead the most suitable way of representing animated marks, following the introduction of the ATMR and its 9th recital, may be quite self-evident. There is a clear and precise way of showing movement according to the author of this thesis, namely by utilizing video files displaying the movement. The video file shows the exact movements of the animation, as they

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188 See ch. 3.4.6.
appear in real life when observers and consumers see the animated mark in question. Furthermore, the usage of video files, instead of images, eliminates any measure of subjectivity or imprecision that may stem from using verbal descriptions of the movements as a representation of the animated mark. As a consequence of the abovementioned factors, the legal certainty of the trademark registration would most probably improve if video files are used to represent animated marks.

Positional marks could in likeness to three-dimensional marks and holograms benefit from the capabilities of the electronic 3D-model viewer that has been described earlier in this thesis. While protection is not sought of the three-dimensional objects themselves, the positional marks are often placed upon such objects. Furthermore, the dimensions and proportions of positional marks need to remain constant when displayed to observers. Thus, the 3D-model viewer may be beneficial for showing positional marks in a manner which fulfills the Sieckmann criteria, as the positional marks are represented in regard to how they appear on the product in reality. Consequently, it becomes easier for individuals to ascertain existing rights related to positional marks when using a 3D-model viewer to represent the mark. A verbal description of the positional mark may nonetheless still be necessary as a complement to the 3D-model representation, in order to define what constitutes the mark itself and what constitutes the non-protected object it is placed upon. Said complementing representation may be provided in order to fulfill the Sieckmann criteria of precision and clarity, as individuals must be able to ascertain the exact extent of the protection of the mark.

Touch marks have earlier had problems in being represented graphically and no registrations of touch marks yet exist in the EU. As with the representation of scent and taste marks however, new means of representing touch marks have also arisen due to the development of new technology related to sensory perception. Thus, the possibilities for suitable representation should be examined on the grounds of the new developments. The technology, which consists of screens that are capable of creating different textures on their surface, may not be generally available at the moment. As stated before in thesis however, technology is continuously developed and can spread very quickly in the modern society. The exclude all future possibilities for protection of touch marks on the basis of technological shortcomings would according to the opinion of the author of this thesis be a hasted decision.

Even considering the circumstance that touch marks in the quite near future may eventually be capable of representation through generally available technology however, the representation of the touch mark must still be of appropriate form to fulfill the requirements of the ATMR and the 9th recital. It is questionable if the “texture screens” mentioned above are compatible with the Sieckmann criteria, as the criteria of precision and exactness may possibly not be fulfilled. The problem is quite alike to the one with “smell screens”, detailed in chapter 5.4.5. In likeness to smells, textures can vary greatly from one another and can sometimes be hard to precisely identify. Individuals thus risk being unable to ascertain the

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189 See ch. 5.4.1 and 5.4.2.
190 See ch. 3.4.6.
exact extent of the protection given to a touch mark by solely using a “texture screen”. At the moment, it therefore seems hard for touch mark to retain protection within the EU.

6. Summary and conclusions of the analysis

6.1 Summary of the findings of the analysis

The removal of the necessity for graphical representation of EU trademarks has introduced new possibilities regarding representation for many types of non-conventional trademarks. Likewise, the contents of the 9th recital of the ATMR has also brought further options for representation, even through graphical means, as representations now must be capable of representation through generally available technology. Consequently, this change in the legislation has made it so that video files, sound files and a 3D-model viewer (already available at EUIPO for design rights) will most probably become suitable when representing EU trademarks. The Sieckmann criterion of self-containment may however pose some problems to the above-mentioned representations, which will be discussed further in the concluding chapter of the analysis.191

As stated above, marks such as three-dimensional marks, holograms, sound marks, positional marks and animated marks will very likely gain additional suitable options for representation following the introduction of said regulation in October, 2017. Above said manners of representation are often capable of both fulfilling the Sieckmann criteria and the requirements found in the 4th article and the 9th recital of the ATMR, albeit sometimes with the use of complementary representations such as verbal descriptions.

Furthermore, it can also be stated that there exists no need for color per se marks to be represented in a manner different for the current one according to the author of this thesis, as doing so would not lead to any improvements in regards to legal certainty or flexibility. In the opinion of the author of this thesis, it would not seem logical for colors to be capable of being represented non-graphically as colors are of an inherently graphical nature.

Lastly, scent marks, taste marks and touch marks may in the near future become at least potentially viable for protection as EU trademarks following the development of new sensory perception technology and the removal of the requirement of graphical representation. It is however questionable whether or not the new types of representations consisting of electronically stored samples of smells and textures can fulfill the Sieckmann criteria relating to precision and exactness.

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191 See ch. 6.2.
6.2 Conclusions

6.2.1 The importance of the 9th recital of the ATMR

Stated in the 9th recital of the ATMR, the legislators declare that both legal certainty and flexibility will improve following the removal of the requirement for graphical representation. According to the author of this thesis, the results of the analysis indicate that the claim of the legislators in the 9th recital might indeed have legitimacy, even though the relationship between legal certainty and flexibility usually is an opposite one.192

After examining the findings of the analysis, it is in the belief of the author of this thesis that the 9th recital of the ATMR opens up for the new possibilities to increase the level of both legal certainty and flexibility. The recital does this through the inclusion of the possibility to use “generally available technology” when representing trademarks, as long as the representation is of “appropriate form”.

The wording “generally available technology” allows an increase in the flexibility of the trademark registration system as more forms of representation are permitted for individuals to use when choosing how they wish to represent their trademark. Furthermore, the above-mentioned wording is not time-dependent. This consequently results in that the term generally available technology should be interpreted from what technology is available at the time of the reading of the recital. For example, if the recital is interpreted in 2020, what constitutes generally available technology should derive from the technology available in that year. Therefore, new forms of representation may become possible to use as time progresses, which increases the flexibility of the EU trademark system as it will no longer be necessary to amend the legislation in correlation to the development of new technology that may be used for representation.

Meanwhile, the term “appropriate form” in the 9th recital of the ATMR safeguards the legal certainty of the trademark registration system. The wording assures that representations must still be suitable even if they are represented using generally available technology. The representations are of appropriate form if they fulfill the Sieckmann criteria in regards to that the representations need to be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

6.2.2 Legal certainty and the new forms of representation

The new probable forms of suitable representation such as sound files, video files and the 3D-model viewer could provide an earlier unseen precision for those observing marks in the EU trademark register. The abovementioned representations are reproductions that reflect what is actually perceived by the individuals when observing the trademarks in reality; a sound trademark is heard in real life, therefore the representation should also be perceived through

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192 See ch. 2.2. & 2.3.
audial means. Likewise, 3D-marks should be able to be represented in 3D, while the representation of animated marks should be capable of showing movement.

By allowing the new, above-mentioned forms of representations in the EU trademark registration system, legal certainty would most likely increase as the representations are more precise than the previous forms of representations in the belief of the author. As an example, it does no longer seem purposeful nor especially legally certain to represent sound trademarks solely through musical notation anymore, as notation is both more unprecise and less intelligible for most individuals than a reproduction of the sound itself. Similarly, based on the findings in this thesis, it does not appear purposeful in regards to legal certainty to represent 3D trademarks with six images or animated marks with images and verbal descriptions for every animation, as said representations does not correlate with what individuals perceive in reality when they observe the marks. The introduction of the ATMR and the removal of graphical representation could likely thus have made it easier for individuals using the EU trademark registration system to ascertain the rights contained within it.

However, some representations that might have become at least theoretically possible to utilize following the introduction of the ATMR may lack in qualities that makes them conform to the standards of the Sieckmann criteria. Scents, tastes and touches may be capable of representation using technology that may quite soon be generally available for the public, but their forms of representation still lack in the aspects of clarity and precision as individuals would not be able to ascertain the exact extent of protection of the trademark with the aid of the representation. Consequently, the legal certainty would be affected in a negative manner by allowing these forms of representation at the moment. Once again it is important to point out that technology related to representation continues to develop nevertheless, so it may one day be possible for the protection of scents, tastes and touches in the EU.

6.2.3 Flexibility and the new forms of representation

As many new types of representations are made possible to utilize through the institution of the ATMR, individuals gain additional alternatives of representing their trademarks. Said phenomenon is in accordance with the definition of flexibility chosen for this thesis, as flexibility was defined as to what extent the trademark registration system allows individuals to use different types of representations for their marks. 193

Certainly, individuals are not permitted to utilize any representation of their own choosing as the representation in question might not be fulfilling the Sieckmann criteria and thus not be of appropriate form. Nonetheless the general level of flexibility shows indications of increasing as many new representations which also are of appropriate form have the capacity of becoming available for use in the EU trademark registration system as art. 4 ATMR comes into effect on October 1, 2017.

193 See ch. 2.3.
It can be noted from the findings of the analysis that some forms of representation may appear to no longer be suitable for use in the EU trademark registration system, such as musical notation. The removal of said representations might however decrease flexibility as the trademark registration system offers individuals using the system fewer alternatives for representation. The author of the thesis does therefore not propose to fully remove said representations from the EU trademark registration system. The author suggests that the representations that may seem either outdated, such as musical notation, or redundant, such as utilizing images for representing 3D-trademarks when a 3D-model viewer already exists, can instead be used as complementary representations. By allowing complementary representations, flexibility would not become decreased to the same extent as if the representations would be removed altogether.

6.2.4 The necessity of a revision of the Sieckmann criteria

One conclusion drawn from the findings of the analysis by the author was that the Sieckmann criteria might need some adaptation in order to conform to the contents of the 9th recital of the ATMR. At least, the Sieckmann criterion of self-containment is problematic in relation to the terms “using generally available technology” found in the 9th recital of the ATMR. Self-containment means that a representation should be perceivable without the aid of other means. The criterion thus in practice excludes the possibility of using for example the 3D-viewing utility to represent a mark, as the 3D-viewer only is used as a aid for showing the 3D model itself. Meanwhile, the terms “using generally available technology” indicates that such a utility may now indeed be used to represent a trademark, creating a discrepancy between the standard created in the Sieckmann ruling and the currently existing legislation in the form of the ATMR.

As stated before the 3D-model viewer is already in use at the EUIPO, albeit for representing designs. As also have been found in the analysis, the 3D-model viewer would likely improve legal certainty. In the belief of the author, it therefore seems both counter-productive and diminishing of legal certainty to disallow using the 3D-model viewer for trademark representation on the grounds of not fulfilling the Sieckmann criteria of self-containment.

The Sieckmann criterion relating to self-containment may thus need either a revision or a removal altogether in the future as it is not compatible in its current form with the 9th recital of the ATMR. The benefits of allowing for example the 3D-viewer outweigh the negative elements stemming from the lack of having a self-contained representation in the belief of the author. Legal certainty would likely improve more by allowing the 3D-viewer and other future possible utilities used for representing trademarks than the upholding of the criteria of self-containment. The requirement that representations need to be self-contained is also somewhat outdated. It is nonetheless understandable why the criterion was created, as the technological possibilities for representation were fewer when the Sieckmann ruling was given in 2002. As of the now however, it may be time to either remove or revise the criterion as the technological means for representation have improved significantly since 2002.
6.3 Concluding reflections

The aim of this thesis was to illuminate how the introduction of the ATMR and the removal of the requirement for graphical representation would affect the EU trademark registration system in regards to both legal certainty and flexibility. The findings of the analysis indicate that the new possible forms of representation for trademarks might actually improve both legal certainty and flexibility simultaneously, which is unusual as legal certainty and flexibility most often are two elements that are in opposition.

Furthermore, the new forms of representation open up new opportunities for the registration of non-conventional marks. The author of this thesis believes that the introduction of the ATMR might lead to a substantial increase in applications for non-conventional marks, as it will become easier to correctly represent different non-conventional marks in manners which fulfill the requirements posed by the EU trademark legislation. For example, sound trademarks will most likely be represented through sound files, a 3D-trademark through a 3D-model, an animated mark with a video file and so forth.

Additionally, previously excluded marks which have not been able to retain trademark protection such as scent marks, taste marks and touch marks might have taken the first step towards being capable of registration in the EU as they no longer need to be represented graphically, which was one of the biggest hindrances to such marks.

While the predictions of this thesis regarding the exact possible forms of the new representations may or may not be entirely correct, the certain answer will be given as the amended art. 4 of the ATMR comes into effect on October 1, 2017. It will certainly be of interest to observe which types of representations that the EUIPO will deem as suitable. Likewise, the coming case-law as well as the approach taken by the ECJ will be of large interest for those using the trademark registration system. Will the Court along with EUIPO safeguard the new possibilities for trademark representation following the introduction of the ATMR as they see the potential benefits to legal certainty and flexibility for the EU trademark registration system? Or will they perhaps deem that the new representations are too technology complicated and instead comfortably conform to the older ways of representation? Only time will tell.
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