

in the minds of the audience respectively.<sup>673</sup> Failing distinctiveness does not necessarily mean a zero point score, as this score is reserved for deal breakers and a mature brand may well be able to survive without underlying trade mark protection.

In this context it shall be briefly mentioned that the degree of distinctiveness is not an end in itself. The more a mark tends to be descriptive, the easier it is for the audience to associate it with the respective goods or services due to the content-related link, i.e. the less marketing effort is necessary. Hence, the proprietor's interests of achieving a high degree of distinctiveness and thereby a strong legal scope of protection of the trade mark and of not spending too much on the marketing budget need to be balanced. The decision-making process depends on many factors such as the respective market segment and is a strategic one ideally co-performed by legal and marketing professionals.

#### 5.2.4 Non-Descriptiveness

From a trade mark proprietor's point of view, a mark which describes his goods or services is often deemed to be the most attractive one, e.g. 'Supacote' for paint.<sup>674</sup> However, from a legal perspective, such a sign may be rendered descriptive and therefore lack legal protection. It is seen as inept to perform the main function of a trade mark, i.e. to identify the commercial source of the respective good or service.<sup>675</sup> The signs which entail the strongest legal protection are those which are invented or fanciful, like 'KODAK' or 'XEROX'.

##### 5.2.4.1 The Law in General

On the European level, descriptiveness is dealt with by Art. 7(1)(c) CTMR. This provision excludes from trade mark protection all those signs which can, in ordinary linguistic use and according to the relevant consumers' view, describe the respective goods or services, either directly or by allusion to one of their intrinsic characteristics.<sup>676</sup> If this is the case, the interest of others

673 Trade marks frequently utilised and known in the market have a high degree of distinctiveness, cf. ECJ, above fn. 125 – *Canon*, at no. 18.

674 *Murphy*, Brand Strategy, p. 130.

675 Above at 2.1.2.1.3. CFI, judgment of 27 February 2002, Case T-219/00, [2002] ECR II-753, *Ellos AB v. Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) – *ELLOS*, para. 28.

in keeping the respective sign free to use in connection with the goods or services at issue must prevail.<sup>677</sup>

Like with respect to distinctiveness, the assessment of non-descriptiveness needs to be carried out from the perspective of the average consumer, reasonably well informed and reasonably observant and circumspect.<sup>678</sup> The application of Art. 7(1)(c) CTMR does not require the respective sign(s) to already be used in a descriptive manner for the goods or services in question at the time of registration. As results from the wording of the provision (“*may serve*”), it is sufficient that the respective signs could be used in a descriptive way for the respective goods or services.<sup>679</sup>

It is not always easy to discern whether a sign is actually descriptive. Even the ECJ case law seemed to be in a state of flux, particularly with respect to word combinations. The court took a rather generous view on non-descriptiveness in *Baby-dry*,<sup>680</sup> stating that “any perceptible difference” between the word combination sought to be registered and descriptive usage of the terms in common parlance is sufficient to satisfy the criterion of distinctiveness, even if it is merely a “syntactically unusual juxtaposition”.<sup>681</sup> This basic rule was confirmed, further clarified and slightly narrowed in *DOUBLEMINT*,<sup>682</sup> *BIOMILD*<sup>683</sup> and *Postkantoor*.<sup>684</sup> It is now settled case law that the mere combination of descriptive terms is descriptive on its part, unless the overall impression of the mark at issue is sufficiently far removed from the descriptive parts.<sup>685</sup> An ambiguous sign is already descriptive in case one of the possible

676 CFI, judgment of 16 March 2006, Case T-322/03, [2006] ECR II-835, *Telefon & Buch Verlagsgesellschaft mbH v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) – WEISSE SEITEN*, para. 90.

677 Cf. e.g. ECJ, *supra* fn. 636 – *WINDSURFING CHIEMSEE*, para. 26, as to a geographical indication.

678 To that effect, cf. ECJ, above fn. 644 – *Lloyd Schuhfabrik Meyer*, para. 26; CFI, judgment of 7 June 2001, Case T-359/99, [2001] ECR II-1645, *Deutsche Krankenversicherung AG (DKV) v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) – Euro Health*, para. 27.

679 ECJ, above fn. 642 – *Postkantoor*, para. 97; judgment of 23 October 2003, Case C-191/01 P, [2003] ECR I-12447, *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v. Wm. Wrigley Jr. Company – Doublemint*, para. 32.

680 Judgment of 20 September 2001, Case C-383/99 P, [2001] ECR I-6251, *Procter & Gamble Company v. Office for Harmonisation in the Internal Market (Trade Marks and Designs)*.

681 At paras 40 and 43.

682 *Supra*, fn.679.

683 Judgment of 12 February 2004, Case C-265/00, [2004] ECR I-1699, *Campina Melkunie BV v. Benelux-Merkenbureau*.

684 Above fn. 642.

meanings is so understood.<sup>686</sup>

#### 5.2.4.2 Value Implications

Like missing concrete distinctiveness, descriptiveness results in negation of trade mark protection, unless the mark has acquired distinctiveness through use. (Non-)descriptiveness is also linked to the value of the respective brand in a qualitative way, the dimension of which must be assessed on a case-by-case basis.

Even though all absolute grounds for refusal are per se separate and therefore need to be examined separately,<sup>687</sup> distinctiveness and non-descriptiveness are linked as both relate to the strength of a mark. Furthermore, both serve the protection of the general public from unjustified exclusivity of rights. Despite they may overlap in practice,<sup>688</sup> they need to be kept apart from a legal point of view. Hence, despite ECJ and CFI state that concrete distinctiveness of descriptive marks lacks inevitably,<sup>689</sup> both need to be fully examined in the course of the SIM.

#### 5.2.5 Graphical Representability

##### 5.2.5.1 The Law in General

Art. 4 CTMR stipulates that “any signs capable of being represented graphically” may constitute a Community trade mark. This requirement, necessary

685 Cf. e.g. ECJ, above fn. 630 – *SAT.2*.

686 This was first laid down in *DOUBLEMINT* which narrows the generous *Baby-dry* ruling to some extent. It seemed that, after *Baby-dry*, the mark would not be descriptive in case it had at least one possible non-descriptive meaning. However, it was clarified in *DOUBLEMINT* (and affirmed in *Postkantoor*) that the opposite is the case – at least one descriptive meaning renders the sign descriptive.

687 At least the European courts state this in their settled case law, cf. e.g. above fn. 678 – *EuroHealth*, para. 48; above fn. 648 – *EUROCOOL*, para. 25.

688 Experience shows that a sign is more likely to lack concrete distinctiveness the more descriptive (and thereby more in need to be kept free) it is, cf. *Ströbele/Hacker*, Markengesetz, § 8 no. 68. This is one of the factors the expert would have to keep in mind assessing distinctiveness and non-descriptiveness in the course of the SIM.

689 ECJ, above fn. 642 – *Postkantoor*, at no. 86; above fn. 683 – *BIOMILD*, at no. 19; CFI, judgment of 6 November 2007, Case T-28/06, [2007] ECR II-4413, *RheinfelsQuellen H. Hövelmann GmbH & Co. KG v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) – VOM URSPRUNG HER VOLLKOMMEN*, at no. 44.

in light of the fact that Community trade marks can only be protected by means of registration, can easily be met by traditional signs such as words, pictures, drawings, photographs or a combination thereof.

However, in case of non-traditional signs, especially those which are not directly visually perceivable, the question arises whether and, if yes, how this requirement can be met. At this, considerations that the intended purpose of the requirement of graphical representation is (amongst others) to enable exact determination of the scope of protection of the respective mark so that economic participants are able to acquaint themselves with what their current or potential competitors have trade marked play an important role.<sup>690</sup>

In *Sieckmann*, a case concerning an olfactory sign, the ECJ handed down its first ruling in this respect, stating that the graphical representation shall particularly consist of “images, lines or characters” and must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective.”<sup>691</sup> These requirements have since become settled case law.

Olfactory, audio and abstract colour marks are practically important groups which shall be illuminated in more detail in the following.<sup>692</sup>

#### 5.2.5.2 Olfactory Marks

Smells are of increasing importance in branding since many companies outside the classically smell-focussed perfume industry have discovered the possibility of offering customers a holistic sensual experience.<sup>693</sup> For instance, international hotel chains attend to creating uniqueness of experience for their customers by using proprietary smells.<sup>694</sup>

690 *Marx*, Deutsches, europäisches und internationales Markenrecht, at no. 146.

691 ECJ, judgment of 12 December 2002, Case C-273/00, [2002] ECR I-11737, Ralf Sieckmann v. Deutsches Patent- und Markenamt – *Sieckmann*, para. 55.

692 Further non-traditional signs such as haptic marks, holograms or moving marks will not be mentioned due to the fact that they rarely appear in practice and/or do not constitute interesting legal aspects worth mentioning over and above the marks discussed in the following. Note that the Singapore Treaty, which is a further development of the Trademark Law Treaty (TLT), is the first international instrument of trade mark law explicitly dealing with non-traditional marks (*WIPO*, *WIPO Magazine* No. 3, 7 et seq.). The Singapore Treaty was adopted in 2006 and was not yet in force as of January 8, 2007.

693 Branding experts allege that 75% of human emotions generated daily are triggered by smells yet 83% of all commercial communication is designed to appeal to the sense of sight only, cf. *Manning-Schaffel*, Branding that Makes Scents.

694 For example, the US-American *Starwood* hotel group and *Omni* hotels are using pro-

As with any other brand device, its use in branding and marketing, as frequent as it may be, must be distinguished from its ability to be protected as a trade mark. Art. 4 and 7 CTMR contain no provision suggesting that the number of signs eligible for trade mark protection is *prima facie* limited. In theory, therefore, smells can be protected as trade marks. However, since European courts interpret the requirement of graphical representability quite narrowly compared to some other jurisdictions, the protection of a smell as a trade mark is more or less impossible. As the ECJ stated in *Sieckmann*, the requirements of graphical representability of an olfactory sign are not satisfied by “a chemical formula, a description in words or the deposit of an odour sample” or by a combination of those elements.<sup>695</sup>

As laid down in *Sieckmann*,<sup>696</sup> the current state of the art of technology does not enable a smell to be graphically represented in a way satisfying the relevant criteria. Hence, there are no olfactory trade marks validly registered at OHIM at present.<sup>697</sup>

### 5.2.5.3 Audio Marks

Like other non-traditional signs, sounds have become increasingly popular in branding in recent years, as companies seek new ways of product positioning and differentiation in light of increasing local and global competition. *Deutsche Telekom*’s five-tone jingle<sup>698</sup> and *Audi*’s heartbeat sound played at the end of each commercial<sup>699</sup> are good examples. However, the application of sounds in branding is not confined to advertisements but can also be found as mobile ringtones, background soundscapes in stores, telephone waiting loops and – as forms of internal communication – anywhere within the corporate building, e.g. in elevators.<sup>700</sup>

The ECJ has held that, in case of an audio sign, above criteria for graphical representation are neither met by a description in writing nor by an ono-

prietary scents, cf. *Orth*, *Wie riecht ein Zimmermädchen im Hilton?*.

695 *Supra*, fn. 691 – *Sieckmann*, para. 72.

696 Fn. 691.

697 As of January 14, 2008, there were seven applications for an olfactory trade mark which had either been refused, withdrawn or the registration of which had lapsed.

698 Registered with OHIM on February 1, 2001 under the file number 001416858.

699 Applied with OHIM under the file number 006111009. Not yet registered as of January 12, 2008.

700 *Hirt*, *Audio-Branding: Klingel-Fluch oder Markensegen?*, p. 3.