

THE NOTION OF THE EUROPEAN UNION TRADEMARK

OCHRANNÁ ZNÁMKA EURÓPSKEJ ÚNIE

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I. Introduction

Trademarks belong to the oldest subject matters of the intellectual property. The prehistoric nations used the special signs on their property (e.g. on their domestic animals) to prevent the robbery. In ancient Egypt, people draw various signs on the stone buildings to sign an origin of the buildings materials. The trade development evoked a need to distinguish the origins of goods on the market. The used sign was a guarantee of quality or particular characteristics of goods. In ancient Greece, trademarks were called "signum" and were used mainly on the ceramic goods, guns and other goods for export⁽¹⁾. The legal protection of trademarks was given for the first time in ancient Rome. To misuse a trademark was considered as a crime and the offender was threatened a criminal sanction⁽²⁾. In the middle Ages, there were used signs in the aristocratic families. Later, when the crafts were being developed, the craftsmen tried

to use various signs to distinguish their goods from all other goods on the market. The associations of craftsmen, which associated the craftsmen to protect their rights, also used the signs. These associations controlled also the quality of goods of their members. If the quality of a good was not sufficient according to the requirements of the association, a craftsman was sanctioned according to the regulations of the association, e.g. by exclusion from the association of the craftsmen⁽³⁾. One of the oldest legal regulations of trademarks is a British law adopted by the British Parliament in 1266 (Bakers' Marking Law). It obliged all bakers to sign by their signs all their baker's goods⁽⁴⁾. However, the first modern laws on trademarks were adopted in 19th century with the industrial revolution. In 1857, France adopted the Law on the production and marking goods. The Great Britain adopted two laws related to the trademarks. In 1862 the Law on trademarks was adopted, which regulated a crime of imitating a trademark. In 1875 the Law on trademarks registration was adopted, which enabled the registration of trademarks by the British Patent Office⁽⁵⁾. Ger-

⁽¹⁾ Pipková (2007)

⁽²⁾ Lochmanová (1997)

Abstract (EN)

The EU trademark law has recorded the important changes in the last years. The Community trademark in the past and the EU trademark at the present have become very popular legal measures not only in the EU Member States but also in the third countries. Its preferences are increasing year to year. The EU trademark may consist of a sign that fulfils two main attributes. Firstly, there is a distinctive character. Secondly, there is a capability of being represented on the Register of the EU trademarks. The second attribute is new and replaced the previous attribute - capability of being represented graphically. The interpretation of the above mentioned attributes is not possible without the judgements of the Court of Justice of the European Union. It is necessary to take into account the kind of trademark, list of the goods and services, which should be signed by the trademark, and its perception by the public. The paper includes the main judgements of the Court of Justice of the European Union related to the interpretation of the sign that may be registered as the EU trademark. They are very helpful in the application practice of the European Union Intellectual Property Office and the national offices of the intellectual property as well.

Keywords (EN)

EU trademark, goods and services, right for priority, EUIPO, national trademark

Abstrakt (SK)

Právo ochranných známk EÚ zaznamenalo v posledných rokoch výrazné zmeny. Ochranná známka Spoločenstva a v súčasnosti ochranná známka EÚ sa stala obľúbeným právnym inštitútom nielen v členských krajinách EÚ, ale i v tretích krajinách a jej obľúbenosť z roka na rok vzrastá. Ochrannou známkou EÚ môže byť označenie, ktoré spĺňa dva základné atribúty, a to rozlišovaciu spôsobilosť a spôsobilosť byť vyjadrené v registri, ktorý nahradil doterajší atribút grafického vyjadrenia. Výklad uvedených atribútov sa nezaobíde bez judikatúry Súdneho dvora, pričom je potrebné vziať do úvahy druh ochrannej známky, zoznam tovarov a služieb, na ktoré sa vzťahuje a jej vnímanie verejnosťou. V článku sú uvedené najvýznamnejšie rozhodnutia Súdneho dvora EÚ týkajúce sa výkladu označenia, ktoré môže byť zaregistrované ako ochranná známka, a ktoré významne pomáhajú rozhodovacej praxi EUIPO a národných úradov duševného vlastníctva.

Kľúčové slová (SK)

ochranná známka EÚ, tovary a služby, právo prednosti, EUIPO, národné ochranné známky

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many adopted the law on trademarks for the first time in 1874, which introduced the registration system of trademarks. In 1894 there was adopted a new law on the protection of goods marking⁽⁶⁾. In Habsburg's monarchy, the Austrian imperial patent no. 230 was adopted in 1858 that enabled the registration of trademarks in the particular chamber of the crafts and commerce. In 1890, the imperial patent was replaced by the Law no. 19/1890 Coll. on the trademarks protection, which was valid for Austria. In Hungary, the Article II was adopted in 1890, which was abolished by the Law no. 471/19919 Coll. on the temporal measures of the trademarks protection after the formation of Czechoslovakia. The validation of the Law no. 19/1890 Coll. was expanded into Slovakia⁽⁷⁾. These legal rules were adopted under the motivation of the Paris Convention on the protection of industrial property 1883 (no. 64/1975 Coll.) that provided the legal protection to the patents, trademarks, industrial designs, utility models, service marks, trade names and geographical indications.

The central objective of the EU is to create the internal market with the free movement of goods, services, capital and persons that is to ensure within Community similar conditions to those existing in a national market⁽⁸⁾. The development of the internal market, keeping the EU at the top of the international innovations and the preserving of its global competitiveness could be ensured by the development of science, techniques and innovations. Moreover, the innovations, research and scientific progress contribute to the welfare of the EU citizens. The innovations and the results of the creative activities of the human beings are protected by the intellectual property law, which should provide fast and effective legal protection not only in the field of the repressive legal measures (it means after the breach of the intellectual property rights) but also in the field of the preventive legal measures, which eliminate the breaches of the intellectual property rights. Therefore, the effort of the EU (as well as Communities before 2009) is focused on the harmonisation of legal regulations of the Member States in the field of the intellectual property. One of the first subject matters in the field of the intellectual property was a trademark, which was harmonised in the 80's of the 20th century. In 1989, the first Council directive 89/104 to approximate the laws of the Member States relating to trademarks was adopted, because the trademark laws currently applicable in the Member States contain disparities, which may impede the free movement of goods and freedom to provide services and may distort competition within the common market (preamble of the Council directive 89/104). The directive was oriented on the harmonisation of the selected legal measures on trademarks such as notion of signs, which are able to create the trademark, absolute and relative grounds for refusal the registration of sign, grounds for revocation and invalidity of the trademark, rights to the trademark, limitation of the effects of the trademark, exhaustion of the rights conferred by the trademark, use of trademark, and acquiescence of use of a newer trademark. The directive was an inspiration also for the Slovak lawmaker when preparing the first Slovak law no.

55/1997 Coll. on trademarks in spite of the fact that the Slovak Republic was not a candidate country of the EU at that time. 19 years later, the new directive of the European parliament and Council 2008/95/EC to approximate the laws of the Member States relating to trademarks was adopted. It did not bring any important changes in the harmonisation process of trademarks. The important changes were brought by the new directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. The directive abolishes the obligation of the graphic expression of a sign, which should be registered as trademark. This obligation is replaced by the obligation of being represented in the register. It is enabled to register new types of trademarks, whose registration was absolutely impossible (e.g. cock-crowing due to the impossibility of the graphic expression) or very problematic (e.g. sound had to be expressed by the stave) up to the new directive adoption. Nowadays, the sound trademarks can be expressed by the MP3 or MP4.

In spite of the harmonisation process, the EU has not left the idea to create a trademark, which should be valid in all Member States after a single registration. The idea was realised by the adoption of the Council regulation 40/94 on Community trademark. The regulation has an objective to support the economic activities and a continuous and balanced expansion by completing an internal market, which functions properly and offers conditions, which are similar to those obtaining in the national market, to remove barriers to free movement of goods and services and to ensure that competition is not distorted, but, in addition, legal conditions must be created, which enable undertakings to adapt their activities to the scale of the Community, whether in manufacturing and distributing goods or in providing services (preamble of the Council regulation 40/94). For the purpose of attaining the Community's said objectives it is necessary to create uniform protection of trademark whereby undertakings can by means of one procedural system obtain Community trademarks, to which uniform protection is given and which produce their effects throughout the entire area of the Community (preamble of the Council regulation 40/94). The Community trademarks became the third registration system of trademarks in the Member States except for the national and international system introduced by the Madrid Agreement 1891 (no. 64/1975 Coll.), Madrid Protocol 1989 (no. 267/198 Coll.) and their common regulations 1989 (no. 345/1998 Coll.). The new system of trademark's legal protection has been interesting not only for businessmen from the EU Member States but also for the businessmen from the third countries, because the single registration enables to protect a trademark in the all EU countries without any national part of registration procedure when comparing to the Madrid system. Moreover, the access of the new Member States to the legal protection of a trademark was automatically expanded to all new Member States. The Community trademark system was accompanied by the institutional changes. The first of all, a new EU body needed to be created responsible for the registration process and acting the regulation on trademark. Therefore, the Office for the Harmonisation of Internal Market (OHIM) was established in Alicante in Spain. In 1996, the OHIM received more than 25 000 applications for Community trademarks

⁽⁶⁾ *Ibid.*

⁽⁷⁾ Maruniaková, I. et al. (2012)

⁽⁸⁾ C-15/81

from the EU Member States and nearly 20 000 applications for Community trademarks from the third countries. This count is still increasing and nowadays, there are more than 100 000 applications for the EU trademark per year; of it 60 – 70% of applications are coming from the EU Member States. The majority of applications is coming from Germany (16 000 applications in 2016), USA, the Great Britain, Italy, Spain, France and China (app. 6 000 applications in 2016). In comparison, only 3000 applications for the EU trademark have been filed from Slovakia, since accession into the EU. In the period 2014 – 2016 Slovakia filed more than 300 applications for the EU trademark per year what is 0, 5% of all applications for the EU trademark filed by the EU Member States per year.

In 2009 the EU decided on reform of the trademark law, since it was substantially amended several time. The regulation adopted in 1994 was replaced by the new Council regulation 207/2009 on the Community trademark. The definition of the trademark owners was simplified, the new absolute grounds for refusal were added, and division of the application and revocation of decisions were enabled. The adoption of the new regulation renumbered the particular rules. In 2015, the EU has adopted the most important amendment of the trademark law. We mentioned above that the harmonisation directive 2015/2436 was adopted. Related to this, within the reform of the trademark law, the regulation 207/2009 on the Community trademark was amended by the regulation of the European parliament and Council (EU) 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trademark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trademark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market. The amendment included some important changes. Firstly, there were changes related to the notions and institutional changes, which reflected the Lisbon Treaty when the Community trademark is replaced by the EU trademark. Moreover, the OHIM was renamed to the European Union Intellectual Property Office (EUIPO). In addition, the closer cooperation between the EUIPO and the national offices for intellectual property was introduced. Secondly, the fees related to the procedure at EUIPO were changed. Commission regulation on fees was abolished and the fees are regulated directly by the regulation on the EU trademark. The basic fee for the application for an individual EU trademark is related to only one class of goods and services by the Nice Convention (no. 77/1985 Coll.). Fee for the second class of goods and services and fees for each class of goods and services exceeding two for an individual EU trademark is stipulated separately. Before the amendment, the fees were stipulated separately only for each class of goods and services exceeding three for an individual EU trademark. Thirdly, the most important changes are related to the substantive and procedural issues. Within the procedural issues, the most important change is related to the observations by the third parties and opposition, revocation and invalidity of an EU trademark, the file of application directly to the EUIPO without possibility to use the national offices. The substantive matters are related to the absolute and relative grounds for refusal and notion of a sign, which is asked to be registered as a EU trademark. Due to many changes in-

troduced by the amendment 2015/2424, the EU law maker decided on adoption of a new regulation 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, which includes all above mentioned changes. The new regulation has been applied since 1st October 2017. The new amendment related to the harmonisation of the trademark law in the Member States has been applied since 14th January 2019. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks and Regulation 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark received that many legal measures are common, which enables to use the judgments of the Court of Justice of the EU (hereinafter as ECJ) on the national trademarks and the EU trademarks regardless how the ECJ interprets the directive or the regulation.

II. Objective and Methodology

The legal framework of the EU trademark law consists of the legislative Regulation 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, the non-legislative Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trademark, and repealing Delegated Regulation (EU) 2017/1430 and the non-legislative Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trademark, and repealing Implementing Regulation (EU) 2017/1431. In spite of this fact, the judgements of the ECJ is important for their interpretation, application and understanding the legal measures of the EU trademarks and national trademarks as well. The new legal regulation of the EU trademarks specifies the new attributes of a sign, which has to be registered as trademark. The aim of the paper is to interpret the new notion of the EU trademark in the context of the new legal regulation, the application practise of the EUIPO and the judgements of the ECJ. For the purpose of this paper, the jurisprudence and the judgments of the ECJ and the basic methods of jurisprudence such as legal analysis and comparison were used.

III. Notion of the EU trademark

The article 4 of the Regulation 2017/1001 on the EU trademark specifies the EU trademark as follows: An EU trademark 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 trademarks, 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. It follows that a sign being registered as a trademark has to fulfil two

main attributes: a distinctive character and a capability of being represented on the Register of EU trademarks.

IV. Distinctive character of the EU trademark

A distinctive character is the oldest attribute of trademarks. This attribute enables to distinguish the goods and the services of a natural person or a legal entity from any other goods and services on the market. By the words of the ECJ, the essential function of the trademark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or service from others, which have another origin⁽⁹⁾. For the trademark to be able to fulfil its essential role in the system of undistorted competition, which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking, which is responsible for their quality⁽¹⁰⁾. A trademark's distinctiveness within the meaning of the EU secondary law must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect⁽¹¹⁾.

IV.1 Distinctive character by reference to the goods and services

In the registration procedure of a trademark (regardless whether at the EUIPO, national offices or international office of WIPO) there is used a system of classification of goods and services, which was introduced in 1957 by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (no. 118/1979 Coll.). Nowadays, the international classification of goods and service for the purposes of the registration of trademarks includes 45 classes; of it 34 classes for goods and 11 classes for services. According to the article 33 (2) of the regulation 2017/1001 on the EU trademarks the goods and services, for which the protection of the trademark is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought. For the purposes of classification of goods and services, the article 33 (3) of the regulation 2017/1001 on the EU trademarks enables to use the general indications included in the class headings of the Nice Classification or other general terms, provided that they comply with the requisite standards of clarity and precision. The goods and services, for which the protection of the trademark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis

alone, to determine the extent of the protection sought⁽¹²⁾. On the one hand, the competent authorities must know with sufficient clarity and precision the goods and services covered by a mark in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and the publication and maintenance of an adequate and precise register of trademarks. On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties⁽¹³⁾. The EU law does not preclude the competent national authorities from requiring or agreeing that an applicant for a national trademark should identify the goods and services for which he is seeking the protection conferred by the trademark by using the Nice Classification. However, in order to guarantee the smooth functioning of the system for the registration of trademarks, such identification must meet the requirements of clarity and precision⁽¹⁴⁾. The requirement of clarity and precision is just not fulfilled when applying the Nice Agreement. The ECJ did not name directly, which classes are in harmony with the requirement of clarity and precision. In the EU Member States were used two approaches to the use of the general indications of the class headings of the Nice Classification, namely the approach corresponding to that derived from the Communication No 4/03, according to which the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within that particular class, and the literal approach, which seeks to give the terms used in those indications their natural and usual meaning⁽¹⁵⁾. Therefore, the EU Member States issued Common Communication on the Common Practice on the General Indications of the Nice Class Headings (20th November 2013), which included 11 non-acceptable general indications of the Nice class headings that were not found being clear and precise. In 2015, there was issued the new Common Communication on the Common Practice on the General Indications of the Nice Class Headings (28th October 2015), which includes 5 general indications that are not clear and precise. Therefore, the unclear and imprecise general indications cannot be accepted without further specification. The applicants of trademarks are obliged to precise which goods and services belonging into these classes bear in mind. The five general indications include class 7 (machines), class 37 (repair), class 37 (installation services), class 40 (treatment of materials), and class 45 (personal and social services rendered by others to meet the needs of individuals. The unclearness and imprecision is given because these goods and services cover a wide range of goods and services related to the various fields of market. By the article 33 (5) of the regulation 2017/1001 on the EU trademark, the use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms

⁽⁹⁾ C-517/99, par. 22, C-39/97, par 28

⁽¹⁰⁾ C-39/97, par. 28; C-10/89, par. 13 and 14 and the cited judgements

⁽¹¹⁾ C-363/99, par. 34 and the cited judgements

⁽¹²⁾ C-307/10, par. 49

⁽¹³⁾ C-420/13, par. 43

⁽¹⁴⁾ C-307/10, par. 52 and 53

⁽¹⁵⁾ C-307/10, par. 58

or indications shall not be interpreted as comprising a claim to goods or services, which cannot be so understood. This rule is a reaction to the change in the application practice of the EUIPO under the influence of the judgements of the ECJ⁽¹⁶⁾. Up to this change, the EUIPO used the general indications to all goods and services named in the alphabetical order of the particular class. The distinctive character of a mark, including that acquired by use, must be assessed in relation to the goods or services in respect of which registration is applied for. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may inter alia also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations⁽¹⁷⁾. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages⁽¹⁸⁾.

The relevance of the relation between trademark on the one hand and goods and services on the other hand is shown in the judgements related to the absolute ground for refusal by the article 7 (1) (c) of the regulation 2017/1001 on the EU trademark. The situations specifically covered by Article 7(1) (c) of Regulation No 40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those, which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought⁽¹⁹⁾. It follows that on the one hand, a sign could be perceived as a sign described a characteristic of some classes of goods or services (e.g. information on the weights such as KILO, TON etc.) and on the other hand this sign could be acceptable as a trademark for other classes of goods and services because a sign would be not perceived as a characteristic of goods and services (e.g. TON or KILO for the trademark of services where the information on weights are illogical). As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics⁽²⁰⁾. The ECJ refused the legal protection to the sign "1000" for the periodicals containing crossword puzzles and rebus puzzles because the relevant public will perceive the sign "1000" on a particular publication as an indication that it contains 1000 riddles or rebus puzzles

⁽²¹⁾ or the sign "ecodoor" that the term 'ecodoor' would be understood immediately by the relevant public to mean 'a door the construction and mode of operation of which are ecological' ⁽²²⁾. According to settled case-law, a sign will be descriptive if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of one of the characteristics of the goods and services in question⁽²³⁾.

IV.2 Distinctive character by reference to the relevant public

A sign which will be registered as EU trademark should be perceived as a sign of a particular goods or services. The signs suitable for marking the goods and services are words, including personal names, or designs, letters, numerals, and the shape of goods or of the packaging of goods, but also colours and sounds, which are included in the article 4 of the regulation 2017/1001 for the first time. However, in assessing the potential distinctiveness of a given colour as a trademark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought⁽²⁴⁾. The distinctive character is not given when a sign consists of simple illustration of a good or a sign with the descriptive character providing only information on the goods or services⁽²⁵⁾. The ECJ interpreted the distinctive character of various types of trademarks in many judgements. The important criterion to consider the distinctive character of a sign is the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect⁽²⁶⁾. Some of the signs applied for as a trademark show a lower other higher distinctive character. In that regard, the Court has already stated that difficulties in establishing distinctiveness which may be associated with certain categories of marks because of their very nature – difficulties that it is legitimate to take into account – do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law ⁽²⁷⁾. The example of such trademarks could be a trademark created by only letter, or only number or only colour. For the purpose of applying those criteria, the average consumer's perception is not necessarily the same in the case of a three-dimensional mark consisting of the appearance of the product itself as it is in the case of a word or figurative mark consisting of a sign, which is unrelated to the appearance of the products

⁽¹⁶⁾ C-307/10

⁽¹⁷⁾ C-299/99, par. 59-60

⁽¹⁸⁾ C-108/97 and C-109/97, par. 52

⁽¹⁹⁾ C-51/10 P, par. 49-50

⁽²⁰⁾ C-51/10 P, par. 50; C-108/97 and C-109/97, par. 31; C-363/99, par. 56

⁽²¹⁾ C-51/10 P, T-298/06

⁽²²⁾ T-625/11, par. 24; C-126/13 P

⁽²³⁾ T-234/06, par. 25 and cited judgements

⁽²⁴⁾ C-104/01, par. 60

⁽²⁵⁾ The Office of the industrial property of the SR, Methodology of Procedures in the matter of trademarks, 2018

⁽²⁶⁾ C-64/02 P, par. 43; C-468/01 P to C-472/01 P, par. 33; C-104/01, par. 46; C-53/01 to C-55/01, par. 41; C-363/99, par. 34; C-342/97, par. 26

⁽²⁷⁾ e.g. C-265/09 P, par. 34; C-64/02 P, par. 36; C-398/08 P, par. 38

it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could, therefore, prove more difficult to establish the distinctiveness of such a three-dimensional mark than that of a word or figurative mark⁽²⁸⁾. Similarly, consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not, in current commercial practice, used as a means of identification. A colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking⁽²⁹⁾.

The ECJ has not excluded distinctiveness for marks consisting of a single letter; however, it may prove more difficult to establish distinctiveness for such type of marks than for other word marks⁽³⁰⁾, because the relevant public has a habit to perceive the word and figural trademarks as identification of origin; it is not the case of a sign consisting only of a colour as it is in the case of a word or figurative mark which, as at the present case, consists of a sign that bears no relation to the appearance of the goods covered⁽³¹⁾. It follows from all of the foregoing that, by assuming from its lack of graphical modifications or ornamentations that, by definition, the sign (created by only letter of Greek alphabet “α”) lacked distinctive character in relation to the Times New Roman character font, without carrying out an examination as to whether, on the facts, that sign is capable of distinguishing, in the mind of the reference public, the goods at issue from those of the applicant’s competitors⁽³²⁾. In addition, the level of attention of the relevant public is likely to vary according to the category of goods or services proposed and consumers may constitute a very attentive public where, as at the present case, their commitments can be relatively significant and the services supplied relatively technical⁽³³⁾. The General Court confirmed the decision of the EUIPO and refused to accept the distinctive character of the sign PHOTOS.COM because the first component of the sign, namely the word ‘photos’, immediately informs the relevant public that the goods and services covered by the application are related to photography or have photography as their subject matter. It follows that that element is devoid of distinctive character in relation to the goods or services concerned. As regards the element ‘.com’, it is important to note that this will immediately be recognised by the relevant public as referring to an internet site; it is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site. Furthermore, the element ‘.com’ may also indicate that the goods and services covered by the trademark application can be obtained or viewed on-line, or are internet-related. Accordingly, the element in question must also be considered to be devoid of distinctive character

in respect of the goods or services concerned⁽³⁴⁾. The General Court refused to accept the distinctive character of the word sign INSULATE FOR LIFE, because immediately and without further analytical effort, as a reference to very long-lasting services related to the use of a particularly durable insulation material, and not as an indication of the commercial origin of those services⁽³⁵⁾.

The ECJ does not exclude the names of natural persons. In the same way as a term used in everyday language, a common surname may serve the trademark function of indicating origin and, therefore, distinguish the products or services concerned⁽³⁶⁾ regardless the fact that the EU secondary law enables third parties to use their name in the course of trade⁽³⁷⁾.

The trademarks can be created also by slogans if the relevant public perceive it as a promotional formula and as an indication of the commercial origin of goods or services⁽³⁸⁾. However, while it is true that a mark possesses distinctive character only as far as it serves to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, it must be held that the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character⁽³⁹⁾. In addition, the Court has held, in particular, that an advertising slogan cannot be required to display ‘imaginativeness’ or even ‘conceptual tension, which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness⁽⁴⁰⁾. Registration of a sign as a trademark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trademark. It suffices that the trademark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings⁽⁴¹⁾.

A figural trademark can be created also by the simple geometric shapes in a special case, e.g. a pentagon can fulfil an identification function only if it contains elements which are suitable for distinguishing it from other pentagonal representations and attracting the attention of the consumers⁽⁴²⁾. By other words, the case law, which was developed in relation to three-dimensional trademarks consisting of the appearance of the product itself, also applies where, as at the present case, the trademark applied for is a figurative mark consisting of the two-dimensional representation of that product⁽⁴³⁾. By the ECJ only a trademark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character

⁽²⁸⁾ C-26/17 P, par. 32

⁽²⁹⁾ C-104/01, par. 65

⁽³⁰⁾ C-265/09 P, par. 39; T-23/07, par. 41

⁽³¹⁾ T-23/07, par. 51

⁽³²⁾ T-23/07, par. 56; T-302/06; T-441/05

⁽³³⁾ T-441/05, par. 63; T-320/03, par. 70 and 73

⁽³⁴⁾ T-338/11, par. 21 and 22

⁽³⁵⁾ T-157/08, par. 52

⁽³⁶⁾ C-404/02, par. 30

⁽³⁷⁾ C-404/02, par. 32

⁽³⁸⁾ C-398/08, par. 45

⁽³⁹⁾ C-398/08 P, par. 44

⁽⁴⁰⁾ C-398/08 P, par. 39; C-64/02 P, par. 31 and 32

⁽⁴¹⁾ C-329/02 P, par. 41

⁽⁴²⁾ T-304/05, par. 23

⁽⁴³⁾ C-26/17 P, par. 34; C-25/05 P, par. 29

ter⁽⁴⁴⁾; however, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character⁽⁴⁵⁾. According to the above mentioned, the ECJ confirm the decision of the EUIPO which refused to register a sign of a sweet in a gold-coloured wrapper with twisted ends that the wrapping at issue was not substantially different from wrappers for sweets or caramels commonly used in trade⁽⁴⁶⁾. On the other hand, a minimum degree of distinctive character is sufficient to render the ground for refusal set out in that article inapplicable⁽⁴⁷⁾. The ECJ solved a question if there is a three-dimensional trademark created by the shape, where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product. The ECJ noted, while it is true that the shape of the product or of a part of the product plays a role in creating an outline for the colour, it cannot, however, be held that a sign consists of that shape in the case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product⁽⁴⁸⁾.

The trademark can be created also by a shape of a good or a shape of its wrapper (e.g. Toblerone). However, the diction of the article 7 (1) (e) of the regulation 2017/1001 has not to be fulfilled because the application would be refused. The article 7 (1) (e) is one of the absolute grounds for refusal, according to which there will be not register a sign which consists exclusively of firstly, the shape, or another characteristic, which results from the nature of the goods themselves; secondly, the shape, or another characteristic, of goods which is necessary to obtain a technical result; thirdly, the shape, or another characteristic, which gives substantial value to the goods. It follows that there are mentioned some facts. Firstly, the absolute ground for refusal is related only goods, not services as results from the above mentioned diction of the rule. Secondly, the rule does not have a cumulative character; it means that the absolute ground for refusal is fulfilled when at least one of the three alternatives is given. However, the ECJ judged that registration of a mark could not be refused where each of the three grounds for refusal set out was only partially established⁽⁴⁹⁾. Thirdly, the previous regulation (no. 207/2009) included only a shape of a good. The shape of a good is usually understood as a set of lines or contours that outline the product concerned⁽⁵⁰⁾. It regulated the three-dimensional trademarks but also the two dimensional ones, if a figure is a three-dimensional object⁽⁵¹⁾. The regulation 2017/1001 added to the diction “shape” also the notion “another characteristic” which could be find in all three alternatives. At the present, there is no judgement that interpret the notion “another characteristic” and so, it is not clear what does it mean. If we take into account the new type of

trademarks, which can be represented on the register, we suppose that “another characteristic” is linked to the new types of trademarks such as sound, motion, multimedia or holographic trademark. The objective of this rule is to prohibit a registration as a trademark of any sign consisting of the shape of goods which is necessary to obtain a technical result ensures that undertakings may not use trademark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions⁽⁵²⁾. When the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trademark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution⁽⁵³⁾. The system of intellectual property provides a monopoly right to an owner of patent, utility design, or design to use his/her intellectual property and interferes with the economic competition as one of the basic pillars of the internal market. On the other hand, the lack of a system of monopoly rights introduced by the intellectual property law would cause a decreasing of the investment in the research and development with the negative impact on the intellectual property. At last the internal market would be inhibited as well. The compromise is to provide only temporal protection to the monopoly rights of the owners of the intellectual property, mainly for a period for returning the investment in research and development and after the expiration of that period the intellectual property is free for all economic subjects on the market. This period is fixed, stipulated by law, e.g. patents are protected for 20 years without option of prolongation, utility designs are protected for maximum 10 years, and designs are protected for maximum 25 years. The trademarks are protected 10 years; however, the period can be prolonged for next 10 years repeatedly. Without the rule cited above there would be given a possibility to act in fraudem legis because the owners of an intellectual property would be free to choose the patent or trademark protection and they could prefer the trademark protection which is de facto time unlimited. The ECJ added that technical solutions are capable of protection only for a limited period, so that subsequently they may be freely used by all economic operators⁽⁵⁴⁾. Consequently, in the context of an application for registration of a sign consisting exclusively from the shape of goods, it must first be ascertained that there is no obstacle under Article 7(1) (e) of Directive 2017/1001 which may preclude registration, before going on to analyse, as appropriate, whether the sign at issue might have acquired a distinctive character⁽⁵⁵⁾.

In the practice we can meet the trademarks composed of a combination of elements. They were the object of the judgement BioID⁽⁵⁶⁾. As regards a compound mark, any distinctive character may be assessed, in part, in respect of each of the terms or elements, taken separately, but that assessment must, in any event, be based on the overall perception of that trademark by the relevant public and not on the presumption that

⁽⁴⁴⁾ C-456/01 and C-457/01 P, par. 39

⁽⁴⁵⁾ C-468/01 and C-472/01 P, par. 37

⁽⁴⁶⁾ C-25/05 P, par 31, C-24/05 P

⁽⁴⁷⁾ T-129/00, par. 49; T-34/00, par. 39, T-128/01, par. 33

⁽⁴⁸⁾ C-163/16, par. 24

⁽⁴⁹⁾ C-215/14, par. 48-51

⁽⁵⁰⁾ C-163/16, par. 21

⁽⁵¹⁾ T-331/10, par. 24 and 27

⁽⁵²⁾ C-48/09 P, par. 45; C-421/15 P, par. 33

⁽⁵³⁾ C-48/09 P, par. 46

⁽⁵⁴⁾ C-48/09 P, par. 46

⁽⁵⁵⁾ C-215/14, par. 40

⁽⁵⁶⁾ C-37/03

elements individually devoid of distinctive character cannot, on being combined, present such character. The mere fact that each of those elements, considered separately, is devoid of distinctive character does not mean that their combination cannot present such character⁽⁵⁷⁾.

The ECJ judged that a colour can dispose by a distinctive character in the special cases. In the case of a colour per se, distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific⁽⁵⁸⁾. The General Court added that a colour does not in itself have a distinctive character, unless it can be demonstrated that it has acquired such a character by use and, on the other, that colours must remain available to all undertakings. It is therefore only under certain circumstances that a colour will in itself be recognised as having a distinctive character per se, on condition that the colour in question is one that is entirely unusual in regard to the goods or services concerned⁽⁵⁹⁾. The combination of two or more colours is even more seldom for registration as a trademark. According to the opinion of the ECJ, a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', does not exhibit the qualities of precision and uniformity. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trademark⁽⁶⁰⁾. The most famous judgement of the ECJ related to a colour, as a trademark is *Libertel*⁽⁶¹⁾. The ECJ judged a colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character, provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code. In assessing the potential distinctiveness of a given colour as a trademark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought. Under the judgements of the ECJ, the EUIPO registered the colour Lila as a trademark for the MILKA chocolates of the company Kraft Foods. However, the EUIPO took opposite opinion on the application of the company Viking-Umwelt-

technik GmbH that requested the registration as a trademark the combination of two colours – green and grey for the goods of garden mechanisms. The ECJ confirmed the decision of the EUIPO on the refusal because those two colours, or similar shades, are commonly used together for gardening products, the effect of juxtaposing the colours green and grey is to create an impression of a shade of green – a colour that is widely used for and enhances the appeal of the goods in question – against a backdrop in a shade of light grey, which is a colour that is not designed to attract attention, as it resembles the colour of metal and is commonly used on many types of material. The consumer will therefore not see the juxtaposition of green and grey as a sign indicating that the goods come from the same undertaking but will rather see it merely as an aspect of the finish of the goods in question. In addition, the shade of green used in the juxtaposition sought to be registered is not perceptibly different enough from the shades of green in common use in the sector to which the goods belong⁽⁶²⁾.

In the case of sound trademarks the ECJ judged in its judgement *Shield Mark BV*⁽⁶³⁾ that a sounds can be considered as a trademark if they are able to distinguish the goods and services from the others and they can be expresses graphically (the judgement was adopted in 2001 before the amendment of notion of a trademark). If a sound is expressed by description, such as the first nine notes of "Für Elise" or a cockcrow or an onomatopoeia or musical notes, which are a common method of representing sounds, a sequence of notes without more, such as E, D#, E, D#, E, B, D, C, A, these sounds expressed graphically were not able to be registered as a trademark. On the other hand, a sound was able to be registered as a trademark if the sound is expressed by a stave divided into bars and showing, in particular, a clef (a treble clef, bass clef or alto or tenor clef), musical notes and rests whose form (for the notes: semibreve, minim, crotchet, quaver, semiquaver, etc.; for the rests: semibreve rest, minim rest, crotchet rest, quaver rest, etc.) indicates the relative value and, where appropriate, accidentals (sharp, flat, natural) – all of this notation determining the pitch and duration of the sounds. This mode of graphical representation of the sounds meets the requirements of the case-law of the Court that such representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective⁽⁶⁴⁾. According to the cited judgement only those sounds expressed by the stave were suitable to be registered as trademarks. On the other hand, the sounds, which could not be expressed by the stave such as sounds of animals or things were not able to be registered as trademarks because the second attribute on the graphical expression was not fulfilled. In spite of this fact, the EUIPO registered the sounds trademarks in more cases when the sounds were expressed by the sound tracks. The EUIPO practise contributed to the replacement of the attribute related to the graphical expression by the attribute being represented on the register. The amendment will enable more facile and precise expression of the registered sound trademarks. Moreover, it will open the possibilities to register the new type of trademarks.

⁽⁵⁷⁾ C-37/03, par. 29; C-363/99, par. 99 and 100; C-329/02 P, par. 28, C-265/00, par. 40 and 41

⁽⁵⁸⁾ C-104/01, par. 66

⁽⁵⁹⁾ T-173/00; C-447/02 P, par. 68

⁽⁶⁰⁾ C-49/02, par. 33-35

⁽⁶¹⁾ C-104/01

⁽⁶²⁾ T-316/00

⁽⁶³⁾ C-283/01

⁽⁶⁴⁾ C-283/01, par. 56-62

V. Capability of being represented in the register

The second attribute of the notion of a trademark is a capability of being represented in the register of the EU trademark (art. 4 of the regulation 2017/1001). The article 3(1) of the Commission Implementing Regulation 2018/626 the trademark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor. The regulation 2018/626 names the types of trademarks and the options of their representation only demonstratively, such as trademark composed of words, figure, shape, position, pattern, colour, sound, motion, multimedia and hologram. At the present, the trademarks can be represented by the electronic file formats such as JPEG or MP3 for sound trademarks, JPEG and MP4 for motion trademarks, MP4 for multimedia trademarks, JPEG and MP4 for holographic trademarks⁽⁶⁵⁾. Other trademarks have to fulfil the requirements of the article 3 (1) of the Commission Implementing Regulation 2018/626. Their representation could be fulfilled by the description. It opens the possibilities to registration of new untraditional types of trademarks. On the other hand, the restrictions given by the judgements of the ECJ and transferred to the EU secondary law are still remaining the barriers for the registration of untraditional trademarks such as taste and odour trademarks. However, it is also a big challenge for the EU lawmaker and scientists to prepare the system of durable and clear identification of such trademarks for their representation in the register. The ECJ gave its opinion to the olfactory trademark in the case Sieckman⁽⁶⁶⁾ where the issue was the registration of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester), whose structural formula was added. Moreover, its sample was deposited with the Deutsches Patent- und Markenamt. In respect of an olfactory sign, the requirements of graphic representability were not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements⁽⁶⁷⁾. The General Court judged in the case Eden Sarl⁽⁶⁸⁾ that the olfactory mark expressed by the combination of a figurative element and a description in words, 'smell of ripe strawberries' did not constitute a valid graphic representation for the purposes. The graphic representation of an olfactory mark must, in order to be accepted, represent the odour whose registration is sought and not the product emitting that odour⁽⁶⁹⁾. It was not possible to determine whether the sign, which is the subject of protection, is the image of the ripe strawberry itself, or its smell⁽⁷⁰⁾. The description 'smell of ripe strawberries'

was not objective, clear and precise⁽⁷¹⁾, because it could refer to several varieties and therefore to several distinct smells⁽⁷²⁾. Moreover, at the present time, there is no generally accepted international classification of smells which would make it possible, as with international colour codes or musical notation, to identify an olfactory sign objectively and precisely through the attribution of a name or a precise code specific to each smell⁽⁷³⁾. In spite of the common opinions declared in this case by the EUIPO and the General Court, the EUIPO had registered the first and only odour trademark "smell of fresh cut grass on the tennis balls" in 2000. The attribute of graphical expression was accepted on the base of description „The smell of fresh cut grass." This registration finished in 2006.

In the cases of taste trademarks, the EUIPO refused to register the taste of artificial strawberry flavour for pharmaceutical products of the Eli Lilly and Company. The Appeal Body of the EUIPO decided that the vague description of artificial strawberry flavour does not allow for comprehension of the actual taste being referred to. A strawberry taste may be simulated in many different ways with the variable results. Moreover, the taste of strawberry is one of many common tastes used as a flavouring to mask the otherwise unpleasant taste of the products⁽⁷⁴⁾. At the present, the EUIPO does not register any taste and odour trademarks. This question still remains opened because the present technologies do not allow expressing taste or odour to have a capability of being represented in the register. The ECJ judged that the requirements of graphic representability were not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements⁽⁷⁵⁾. We suppose that the similar judgement will be issued also in the case of new attribute "being represented in the register," because any of the presented above mentioned options do not fulfil the requirement to be clear, precise, self-contained, easily accessible, intelligible, durable and objective. However, the hope that new technologies could bring the solutions that will be able to fulfil all of these requirements.

VI. Conclusion

The development of the information and communication technologies creates also new possibilities to represent the trademarks. It allows leaving the attribute of the graphical expression of the trademarks. A trademark can be represented not only graphically in two-dimensional spaces but also by the electronic file formats MP3, MP4, JPEG. It enables to register also the multimedia, hologram, motion or sound trademarks at the present. Their registration according to the former legal regulation was impossible or very hard.

The new attribute of being represented in the register on the base of the present technologies does not allow ensuring the clear, precise, self-contained, easily accessible, intelligible, durable and objective representation of the taste and odour trade-

⁽⁶⁵⁾ Common Communication on the representation of new types of trademarks, 2018

⁽⁶⁶⁾ C-273/00

⁽⁶⁷⁾ C-273/00, par. 73

⁽⁶⁸⁾ T-305/04

⁽⁶⁹⁾ T-305/04, par. 39, C-273/00, par. 69

⁽⁷⁰⁾ T-305/04, par. 36

⁽⁷¹⁾ T-305/04, par. 35

⁽⁷²⁾ T-305/04, par. 33

⁽⁷³⁾ T-305/04, par. 34

⁽⁷⁴⁾ EUIPO, R 120/2001

⁽⁷⁵⁾ C-273/00, par. 73

marks. A priori, their registration is not excluded; however, the present technologies do not provide the fulfilment of all these requirements. The registration of the taste and odour trademarks is still remaining an important challenge for the science and development.

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