

CHAPTER 6

DISTINCTIVENESS OF NON-TRADITIONAL TRADEMARKS

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6.1. Introduction

Following the introduction of the 2019 Act, the definition of a trademark had been broadened. The meaning of “trademark” is defined in section 3:

“Trademark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

The word “sign” is defined in section 2 as follows:

*“sign” includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, **shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion** or any combination thereof.*

This definition added to the legislation several signs which are new to consideration as trademarks. These are “shape of goods or their packaging”, “colour”, “sound”, “scent”, “hologram”, “positioning” and “sequence of motion”. As a group, these trademarks are referred to as “non-traditional signs”.

Non-traditional signs are subject to the same absolute grounds for objection as traditional marks are. Shape marks are subject to additional requirements, and these are discussed in the “Shape (three dimensional) trademarks” section.

6.2. Representing non-traditional signs

Under section 23(1)(a) of the Act, it is a requirement that trademarks be represented graphically. Under Regulation 9 of the Trade Mark Regulations 2019, the representations must clearly demonstrate the nature of the mark and show each feature clearly enough to permit proper examination.

A clear representation is especially important when examining non-traditional marks. These signs require both pictorial representations of the trademark where possible, and a clear description before the scope of the application can be properly defined and examination can take place. Specific requirements for non-traditional marks are outlined in their respective subchapters as well as Chapter 1.

6.3. Written descriptions

Non-traditional signs require a description which helps make clear what is being claimed as a trademark. Ideally, the description of the trademark should appear on the application when filed. There should be no discrepancy between this description and the graphical representations. The relationship between them should be spelled out.

Examples of appropriate descriptions for various kinds of non-traditional signs are included in Chapter 2.

6.4. Shape (three dimensional) trademarks

Prior to the introduction of the 2019 Act, shape trademarks were not registrable because a trademark was considered to be something separate and apart from the goods, a material sign to be affixed to the goods or their container (see *Coca-Cola Trade Marks [1986] RPC 421*). Since the definition of "sign" in section 3 of the 2019 Act specifically mentions 'shape' as a sign, there is no doubt that a three-dimensional shape is now registrable as a trademark if it meets the requirements of the Act.

6.4.1. Representations and descriptions of shape trademarks

The Regulations require that applicant provide a clear and durable graphical representation of the trademark. To permit the proper examination of a shape trademark, a representation must meet the following criteria:

- The representation of the trademark should, where practicable, be in the form of perspective or isometric drawings that clearly show all the features of the trademark. The parts of the drawing which constitute the trademark should be shown in solid lines, while the unclaimed parts, if any, should be shown in broken lines.
- The drawing, views and/or photographs of the trademark must also be accompanied by a written description of the trademark.
- The description and pictorial representation of a shape trademark should, when viewed together, clearly define all the details which

constitute the trademark. Examiners need to ensure that the trademark is clearly defined. A term in the written description such as "as exemplified in the representation" is too vague and should not be accepted. This term does not clearly specify what the trademark is. It merely says that an example of what the trademark might be is attached to the application form.

6.4.2. Shapes which may be capable of distinguishing

Applications for shapes as trademarks should be considered under the same broad criteria as any other kind of sign. The normal tests apply and include - whether the shape claimed as a trademark is capable of distinguishing the goods or services of one trader from the similar goods or services of another. The appropriate inquiry was set out by Kitto J in *F.H. Faulding & Son Ltd v Imperial Chemical Industries of Australia and New Zealand Ltd* (1965) 112 CLR 537 at 555, and is paraphrased as follows:

*The question to be asked in order to test whether a [shape] is adapted to distinguish one trader's goods from the goods of all others is **whether the [shape] is one which other traders are likely in the ordinary course of their business and without any improper motive, to desire to use upon or in connection with their goods.***

The decision in the case of *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* [2002] FCAFC 273 in Australia has confirmed that a shape may be capable of functioning as a trademark. The decision was

acknowledged that the shape of the goods could operate as an indicator of trade source in the same way that words or symbols applied to goods had done so for many years. As with all trademarks, a shape must be considered in the context of the market in which it is placed, and a decision on its capability of distinguishing then made using the usual tests.

6.4.3. Shapes which are common to the trade

Any shape which is commonplace for the goods in question is likely to be legitimately needed by other traders. It is therefore unlikely to be registrable *prima facie*. The conclusion that something is common to the trade should only be reached after research reveals that the shape, or some minor variation of it, is commonly used within the relevant market.

Examples of these types of shapes are standard wine bottles for *wines*; ordinary cylindrical shaped jars for *sauces*; a standard umbrella shape for *sun umbrellas*; a cylindrical mug shape with a standard handle for *coffee mugs*.

Shapes of these kinds which are commonly used by many competing traders are likely to attract grounds for objection under section 23(1).

Trademark	Goods/ Services	Objection under s23(1)?	Rationale
 <p><i>The trademark consists of the three-dimensional shape of the goods as shown in the representations attached to the application form.</i></p> <p><i>Case: Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks [2002] FCAFC 273</i></p>	<p>Class 30: <i>Confectionery</i></p>	<p>No</p>	<p>The Full Court held that although the bug shape was suggestive of insect, it was an imaginary shape and was not the shape of any specific insect or bug.</p> <p>It was also determined that other traders would have no desire to use the shape or similar without improper motive.</p>
 <p><i>A coordinated packaging design, consisting of a crinkled gold foil spherical wrapping, in a brown pleated designed cup-holder with two</i></p>	<p>Class 30: <i>Pastry and confectionery, pralines, stuffed wafer, chocolate and chocolate-based products, ices.</i></p>	<p>Yes</p>	<p>The evidence of use namely the sales and promotional materials provided by the applicant had the FERRERO ROCHER's mark featured prominently.</p>

Trademark	Goods/ Services	Objection under s23(1)?	Rationale
<p><i>gold lines. The combination is topped off with a white oval sticker, also designed with a gold rim with a black [sic: blank] white space</i></p> <p><i>In the matter of a trade mark application by Ferrero S.p.A. [2019] SGIPOS 19</i></p>			

6.4.4. Shapes and functionality

If a shape has significant functional features, there is a strong likelihood that other traders will need to use that shape for their similar goods. No single owner should have exclusive ownership of words, devices, symbols or three-dimensional shapes which are common to the trade. One way of testing this from a shape mark perspective is to consider whether the shape is made up of the sort of functional elements that are commonly used in the relevant industry.

A shape can be regarded as functional if:

- it is a shape essential to the use or purpose of the article. For example, the shape of the handles and blade assembly for a pair of scissors, which are necessary for them to function;
- it is a shape needed to achieve a particular technical result. For example, the shape of vanes in a fan which will create a particular air flow pattern;
- it is a shape which has an engineering advantage, resulting in superior performance. For example, a new invention for opening a bottle that is easier to use than existing devices; or
- it is a shape that results from a comparatively simple, cheap method of manufacture. For example, simple shapes for biscuits, such as discs or rectangles.

The presence of functional features is not necessarily fatal to an application. In some cases, the other features of a mark may be sufficient to allow for acceptance where it is obvious that the applicant is not seeking or gaining rights in functional aspects. If something extra has been added to the inherent form of the goods, that will weigh in favour of acceptance.

For example, a garbage bin shaped like a lighthouse is functional in that it is a receptacle designed for waste products. However, the presentation of the bin in the form of a lighthouse is not something that other traders are likely "without any improper motive, to desire to use upon or in connection with their goods" as ruled in the case of *F.H. Faulding & Son Ltd v Imperial Chemical Industries of Australia and New Zealand Ltd* (1965) 112 CLR 537 at 555. The shape of the bin as a whole would be capable of distinguishing, and registration would not give the owner rights to the functional feature.

There have been several court decisions issued in respect of shape trademarks. Particularly relevant to the functionality issue is the decision in respect of the "fence dropper" case – *Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd* [2008] FCA 27. Justice Greenwood said the following:

*"There is no element of the S shape that is invented or concocted to make the article more appealing. The shape helps to render comparatively dysfunctional wire droppers functional in an improved novel way. ... Here the inverted U shapes forming an S bend are the functional solution to problems in the prior art. So much so that a statutory monopoly in the form of a patent was granted to the applicant's predecessor for inventing the novel solution. **There can***

be no doubt that the S shape takes its features from the function to be performed by the loop and thus the nature of the work the article does. Other shaped loops might also catch a wire just as other shaped containers might hold fluid, but the S shape of this loop owes its shape quite precisely to the functional solution its shape serves.”

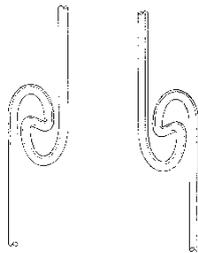


Figure 1 - Shape trademark applied for in Mayne Industries Pty Ltd v Advanced Engineering Group Pty Ltd

Trademark	Goods/ Services	Objection under s23(3)?	Rationale
 <p data-bbox="206 954 792 1168"><i>The trademark consists of the three-dimensional shape of a transportable building as shown in the representations attached to the application form.</i></p> <p data-bbox="206 1200 685 1276"><i>Case: Rodney Gibson [2010] ATMO 73</i></p>	<p data-bbox="810 357 1048 485">Class 6: <i>Transportable buildings</i></p>	<p data-bbox="1214 357 1285 392">Yes</p>	<p data-bbox="1397 357 2038 485">In this decision, the applicant relied on the shape of the roof and steel side panels as distinctive features.</p> <p data-bbox="1397 596 2038 890">The Hearing Officer determined that these elements were purely functional, and that other manufacturers of steel buildings would have a legitimate need to use the trademark or something similar without improper motive.</p>

6.4.5. Shapes and aesthetics

There is no reason to object to a shape simply because it is attractive or visually pleasing. Most traders would hope that their trademarks are attractive to the consumer. The test for a shape mark must be the same test applied for any other mark - whether the shape is one which other traders are likely to want to use, in the ordinary course of their business, without any improper motive.

The question of aesthetics will only be of relevance if the goods are purpose built with aesthetics in mind, i.e., glass ornaments where ornamentation is the purpose of the goods and is unlikely to be seen by potential purchasers as a badge of origin.

This view is supported by the comments of Justice Stone in *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* [2002] FCAFC 273. The discussion involved references to both the *Mark Foy's Limited v Davies Coop & Company Limited* (1956) 95 CLR 190 decision and the *Wella Aktiengesellschaft v Registrar of Trade Marks* (1995) 33 IPR 374 decision. Stone J commented at paragraph 156:

In the above examples the trade marks were held to be inherently adapted not because of any positive content but because they had no associations or significations that prevented them from being inherently adapted to distinguish a trader's goods. In addition they show, especially in the comments made in Mark Foy's and Wella, that, at least in relation to word trade marks, it is not an obstacle to inherent adaptation that the trade mark is also designed to elicit a positive emotional response. The fact that the "sign" that comprised

the trade mark in those cases had a dual function was not seen to be inconsistent with the sign acting as a trade mark in respect of certain goods. I see no reason why the attractiveness of a shape should be considered differently. Moreover, I also see no reason why an invented shape should be regarded as different from an invented word in terms of assessing its inherent capacity to distinguish a trader's goods.

6.4.6. Shapes and invention

An invented shape should be treated in a similar manner to an invented word and is equally entitled to acceptance. Refer to the comments by Stone J above. *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks [2002] FCAFC 273* gives some guidance on what may be regarded as invention in the confectionery trade but does not offer clear guidance on what amounts to invention in other trades.

A starting point for “shape” trademarks is the question “what is common to the trade”? This can be assessed through research into the shape applied for in the relevant trade. If research shows several parties using a shape in a non-trademark sense, this will tend to support a view that the marketplace does not regard it as a trademark and objections are in order.

It may be difficult to "invent" a shape in some trades. For example, *toys* in class 28 already come in a great variety of shapes. In class 28, it is unlikely that a simple shape such as a bear or tractor will be registrable unless there is considerable, unique stylisation. Adding clothing to a toy bear or doll will not be sufficient to identify the shape as registrable. The

“get up” of the clothing, and the whole combination, would need to be most unusual.

Similarly, the shapes of decorative items such as ornaments or jewellery will be unlikely to be acceptable *prima facie* because it is normal within these trades to provide unusual and imaginative creations. The applicant will need to be able to demonstrate that it is using the shape in a trademark sense, rather than just producing an item in that shape.

In some other classes of goods, a shape may be unusual enough in respect of the particular goods of interest to be capable of distinguishing. This matter was touched upon by Justice Sundberg in the *Chocolaterie Guylian NV v Registrar of Trade Marks* [2009] FCA 891 decision at paragraph 75:

*“The ultimate question **on the issue of inherent adaptation is whether a sign – in this case, a shape – possesses any ordinary significations and, if it does, whether or not other traders might think of the shape and want to use it** for those ordinary significations in a manner which would infringe a registered mark in respect of the sign. In cases where a shape depicts a known object or concept (cf. wholly concocted or ambiguous shapes), and is therefore likely to signify the same to most if not all consumers, then a subsidiary question is whether the shape is nevertheless sufficiently distinctive or unique so that other traders wishing to represent the same or a similar concept will remain free to do so without infringing the mark, that is, without requiring use of the same shape or one substantially identical or deceptively similar. An*

important consideration in all of this is the nature of the goods for which the shape mark is used.”

Note: If a trademark is registrable as an invented device in a two-dimensional form, this suggests it would be similarly registrable in its three-dimensional form.

6.4.7. Shape of packaging or aspect of packaging

The same distinctiveness considerations that apply to shape trademarks apply to the shape or configuration of the packaging of goods. Packaging may include the container in which the goods are sold or the outer packaging which covers the goods and the container. Shape is just one aspect of packaging and the more unusual the shape of the container or box applied for as a trademark, the more likely it is to be capable of distinguishing the applicant's goods. However, there are currently many different ways of styling and presenting containers and packaging and so most variations on simple shapes will not meet registrability requirements.

6.4.8. Additional provisions applying to shape trademarks

In addition to the absolute grounds for objection set out in sections 23(1)(a), (b), (c) and (d), the Act sets out additional absolute grounds for objection which apply specifically to shape trademarks. Section 23(3) is read as follows:

The Registrar shall refuse to register as a sign as a trademark if the sign consists exclusively of –

*(a) the shape which results from the nature of the goods themselves;
e.g. An image of a plain, unadorned football to be used for sporting articles in Class 28*

(b) the shape of goods which is necessary to obtain a technical result; or

*e.g. An image of a children's building block for toys in Class 28.
The specific shape of the block would be necessary to enable the blocks to be connected to others for building*

(c) the shape which gives substantial value to the goods.

*e.g. A loudspeaker in Class 9 which put an emphasize on its shape.
This becomes the main factor that influences customer's decision to purchase and therefore increases its commercial value.*

The marks described in this section of the Act are shapes which fall into the category of not inherently capable to distinguish. There is no provision

in the Act allowing these grounds for objection to be overcome with the provision of evidence.

6.4.9. Indistinctive shapes or packaging which contain distinctive elements

A non-distinctive shape or packaging which incorporates distinctive words or images may not be capable of distinguishing. The following example of a shape mark demonstrates this:

6.5. Colour and coloured trademarks

A colour, by itself or in combination with other colours, may be used as a trademark. For example, a trademark may consist of a coloured label or ticket which incorporates other signs, or it may consist of a colour or colours applied to the goods themselves. Colour may also be an aspect of packaging which is used as a trademark. In all cases the trademark will only be registrable if, taken as a whole, it can distinguish the applicant's goods and/or services from those of other traders.

6.5.1. Representations and descriptions of colour marks

An application for a colour or colours as a trademark must include a clear and concise description of the trademark as a part of the application. A pictorial representation showing the colour claimed and the how it is to be applied to the goods should also be supplied, especially in cases where the description is complex.

An example of the actual colour or colour combination claimed must be supplied in all cases. Applicants must define the colour/s more precisely by using colour matching system, such as Pantone®, as this ensures long lasting clarity as to which colours have been claimed. This reference can be included in the written description.

The description and the pictorial representation of the colour trademark should together clearly define all the details which constitute the trademark. The description of the colours shall also be accompanied by the Pantone Code numbers. Examples of suitable descriptions to accompany the representations listed in Chapter 2.

6.5.2. Trademarks which are restricted or limited to certain colours (coloured trademarks)

Coloured trademarks are ones where protection is limited to certain colours. Both traditional and non-traditional signs can be restricted by colour.

Examples of descriptions for coloured trademarks that will be taken as an indication of a restriction or limitation to colour are below:

- *The trademark is **limited** to the colours green and blue as shown in the representation on the form-of application*
- *The colours green and blue are **claimed** as a **distinctive** feature of the trademark as shown in the representation—on the form of application*

The following list contains examples of descriptions for coloured trademarks which are allowable but **will not be a restriction or limitation to colour:**

- *The trademark is **depicted** in the colours green and blue as shown in the representation attached to the application form.*
- *The trademark is **presented** in the colours green and blue as shown in the representation attached to the application form.*
- *The trademark is **represented** in the colours green and blue.*

6.5.3. Combinations of colours applied to the goods or their packaging

As with any other sign, a combination of colours being claimed as a trademark must pass the accepted tests for adaptation to distinguish. These tests are set out in the discussion on shape trademarks. The colour/s may be applied directly to the goods or appear on the packaging.

A combination of colours may be applied directly to the surface of the goods. For example, copper and black colours applied to batteries; maroon and gold colours as applied to pharmaceutical capsules; green and white colours applied to pharmaceutical capsules.

Trademarks consisting of two or three colours applied directly to the goods are likely to possess a greater degree of being inherently capable of distinguishing rather than single colour, though in many cases a distinctiveness objection will still be appropriate.

The question, as always, will be the degree to which other traders are likely to want to use the colours. The answer will depend on what is normal in the marketplace. For example, *roofing nails* are coloured according to the metal they are made from (steel, zinc etc). The colour "grey" would not be inherently capable to distinguish these goods, whereas a combination of "pink" and "green" for these goods is arguably not as commonplace. On the other hand, it is unlikely that two-coloured stripes would be prima facie acceptable for *clothing* in class 25, *linen* in class 24 or for *wrapping papers* in class 16. The same considerations will apply to the packaging of goods.

6.5.4. Single colours applied to goods or packaging

A trademark may consist of a single colour applied to the surface of goods or their packaging.

In the past there was considerable discussion about whether single colours could act as trademarks. However, there are examples of traders successfully using a single colour to denote the origin of their goods after showing considerable evidence of use. Examples are the colour 'maroon' for electronic storage batteries, the colour 'orange' for the labels on sparkling wines and the colour 'terracotta' for irrigation pipe connectors as reported in the case of *Philmac Pty Limited v The Registrar of Trade Marks [2002] FCA 1551*. In these cases, distinctiveness objections were initially taken and there was a heavy onus on the applicants to show that the colour applied to goods but had become trademarks.

Single colour trademarks are generally not inherently capable to distinguish.

6.5.5. Colours claimed as trademarks for services

An applicant may make a claim for a colour or colours as a trademark for use in respect of services. Again, a colour or combination of colours used in respect of services meets the description of a sign for the purposes of the Act.

As with applications for goods, a clear description of the nature of the trademark is required so that its scope is clearly defined. This description must identify how the colours are used in respect of the services claimed.

For example, a red swatch attached to an application form together with a claim for "*the colour red, as depicted in the example attached to the application*" in respect of *retailing services* is not sufficient, as it does not explain how the colour is used in respect of the services.

A more acceptable description for retailing services would be: "*The trademark consists of the colour red applied in a single broad stripe to the fascias and doors of buildings. The colour and configuration of the trademark are shown in the examples attached to the application form*". The accompanying examples would need to clearly show how the broad stripe is applied to the buildings and doors.

6.5.6. Registrability of colour as trademarks

The following guidelines set out the issues involving functionality and that examiners must consider when assessing a colour trademark.

6.5.6.1. Functionality and colour

There are many situations where a colour or colour combination may be functional, and therefore not inherently capable to distinguish an applicant's goods or services from those of others.

6.5.6.1.1. Colours providing a particular technical result

A colour is functional if it provides a particular technical result for the goods concerned. The colour black for solar power collectors and associated piping is an example, as black coloured equipment is better at absorbing heat. Similarly, the colours silver or white on goods where heat or light

reflection is required would be regarded as functional. An example of this is a silver colour for building insulation sheeting to go under roofing tiles.

6.5.6.1.2. Colours conveying a generally accepted meaning

A colour may be functional if it has developed a generally accepted meaning in the trade or the wider community. For example, yellow or orange colours are generally accepted for safety signs and red for a hazard warning sign. Red is also the generally accepted colour for fire extinguishers. These colours serve a functional purpose in respect of the goods/services.

6.5.6.2. Colours which are common to the trade

Colours which are commonly used with the particular trade are not likely to be capable of distinguishing one trader's goods from those of another.

6.5.6.2.1. Colours which are the natural colour of goods

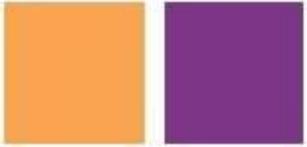
A colour may be common to the trade if it is the natural colour of the product itself or the natural colour of the product because of the most usual manufacturing process. For example, a monopoly cannot be granted in the natural colour of hemp rope or seagrass matting because consumers would be unable to distinguish the goods of the trademark owner from those of other producers whose manufacturing processes result in goods of the same colour. The natural colours are not inherently capable to distinguish for the goods in question.

6.5.7. Colours needed for competition

If there is a proven competitive need for the use of colour in a particular market, the colour is likely to be difficult to register. A colour may fall into this category if the accepted standard is one particular colour, or if colours are used to indicate product type. For example, in the irrigation pipe industry, colours are used as a form of coding for measurements, performance characteristics or to differentiate between imperial and metric fittings.

More guidance on the how colour marks should be considered can be found in the Australian decision *Philmac Pty Limited v The Registrar of Trade Marks* [2002] FCA 1551 at paragraphs 50 – 60.

Trademark	Goods/Services	Objection under s23(1)?	Rationale
<div data-bbox="392 272 593 459" data-label="Image"> </div> <p data-bbox="206 475 788 1254"> <i>The trademark consists of the colour light-green itself in the specific hue as is shown on the enclosed specimen of the colour. Trademark protection is claimed for this specific hue of the colour and not for the particular rectangular form of the colour specimen. Also enclosed is "Color Standard Chart" from the Applicant in support of this application. The vertical block in the middle of this chart shows the colour green in the specific hue claimed, the other squares show the various colour tolerances of this specific hue.</i> </p> <p data-bbox="206 1299 788 1385"> <i>Case: WM. Wrigley JR. Company's Application [1999] E.T.M.R. 214</i> </p>	<p data-bbox="808 277 1126 411"> <i>Chewing gums in classes 3, 5 and 30.</i> </p>	<p data-bbox="1263 277 1330 312">Yes</p>	<p data-bbox="1467 277 2038 564"> The OHIM Third Board of Appeal noted that in advertising and on packaging of products in a broad range of consumer markets, this shade of green is used to denote freshness and proximity to nature. </p> <p data-bbox="1467 609 2038 944"> Given the diversity of persuasive elements in commercial advertising, the colour light green has no particular striking impact that keeps the eye focused. The mark was found to have no inherent adaptation to distinguish. </p>

Trademark	Goods/Services	Objection under s23(1)?	Rationale
 <p><i>The trademark consists of the colours PURPLE (Pantone 2612) and ORANGE (Pantone 1505) as shown in the representation attached to the application, used in combination where either colour forms a significant proportion of the overall combination on banners, signs, walls, and counters in retail stores, on staff uniforms, and on promotional and advertising material, including as shown in the illustrative examples, all used in connection with the services covered by the application.</i></p> <p><i>Case: Discount Drug Stores Pty Ltd [2014] ATMO 66</i></p>	<p><i>Pharmacy services in Class 35 and 44</i></p>	<p>Yes</p>	<p>In this Australian decision, the mark was found to have some inherent adaptation to distinguish owing to the uncommon combination of colours and the fact that they did not convey any particular meaning.</p> <p>However, the Hearing Officer determined that although the colour combination wasn't being used by competing pharmacies, there were still other businesses using a similar colour scheme and other traders may still have an honest desire to use the colours in future.</p>

6.6. Sound trademarks

A sound trademark can be anything a person can hear – a song, spoken words, a dog barking, a doorbell ringing, etc. Whatever sound is applied for, it must be able to identify the trade source of the goods/services it is used with.

6.6.1. Representing sound trademarks

Section 23(1)(a) of the Act states that an absolute ground for objection will apply to any trademark which is not capable of being represented graphically. Unlike most other signs, sound marks are not visual.

To meet this requirement of the Act, sound trademarks can be represented graphically by symbols, musical notation, diagrams and/or writing. However, as with shape and colour trademarks, these representations must make it clear to the general public exposed to the trademark application/registration, what the scope of the trademark is.

- It is mandatory for the applicant to supply recordings of the trademark on a medium which allows for easy replaying. The sound recording shall be in the format of MP3 regardless of the medium.
- An application for a sound as a trademark must include a graphical representation of the mark. The description can be written such as “*The trademark consists of the sound of two steps taken by a cow on*

pavement, followed by the sound of a cow mooing (clip, clop, MOO) as rendered in the recording accompanying the application.”

- Musical notation may be provided in addition of the MP3 and the written description of the sound, but it is not compulsory. However, a lengthy piece of musical notation such as the complete score of an orchestral piece is unlikely to meet registrability requirements.
- The name of a specific piece of music is not acceptable as a graphical representation **unless** additional information is supplied to identify the particular rendition claimed as a trademark. For example, “*The trademark is a sound mark. It comprises the sound of dogs barking to the traditional tune "Greensleeves" as rendered in the audio tape accompanying the application.*”
- As well as the graphical representation, the applicant must supply a clear and concise description of the trademark which will be entered as an endorsement to the application.
- The written description and the recording of the trademark should together clearly define all the details of the trademark. Examples of suitable written descriptions to accompany the representations are available in Chapter 2.

6.6.2. Sounds which may be capable of distinguishing

Sounds which are not functional or common to the trade when considered in respect of the goods/services claimed are adapted to distinguish the

applicant's goods. The following table gives some examples of sounds which fall into this category. This list is provided as a guide, and examiners will need to consider each application on its own merits.

Sound	Goods/Services
Sound of wolf howling	<i>Beer, wine and spirits</i>
Sound of a child laughing	<i>Taxation consultancy services</i>
Sound of a chain saw	<i>Retailing of books, clothing, foodstuffs</i>
Applicant's name sung in an advertising jingle	<i>Most goods and/or services</i>
Church bells	<i>Clothing; cosmetics; hand tools and cutlery</i>
Short, invented tunes	<i>Most goods and services</i>
Human voice quacking like a duck	<i>Sightseeing tours; tour books, maps</i>
Portions of well know classic tunes e.g., Beethoven's 9th Symphony	<i>Most goods and services</i>

6.6.3. Sounds which may not be capable of distinguishing

Sounds fall into this category if they are commonplace, as they are sounds which other traders are likely to want to use in the regular course of trade. Some examples of sounds which fall into this category are provided in the table below.

Trademark	Goods/Services
Sound of a chain saw	<i>Chain saw repair services; tree lopping services; retail of chain saws</i>
Sound of a duck quacking, chicken clucking, roosters crowing	<i>Live poultry, prepared/frozen poultry</i>
Sound of a cash register ringing	<i>Retailing services</i>
Single bell tolling or a solemn hymn	<i>Funeral services; undertaking services</i>
Sound of glass breaking	<i>Windscreen repair services; glass repair services</i>
Sound of vehicle motor starting up and running	<i>Vehicle sales; automotive repair and maintenance; vehicles in class 12</i>
"ping" sound	<i>Microwaves; retailing of microwaves</i>
Portions of well-known classical musical pieces	<i>Orchestral music performances</i>
Synthesised musical sounds	<i>Electronic musical synthesises; computer software for synthesising music on home computers</i>

The more common the sound, the more evidence to support it will be required. Functional sounds are not inherently capable of distinguishing. Examples of functional sounds include sirens used by ambulances for *medical transportation services*.

6.7. Scent trademarks

Under the right circumstances, it is possible for a scent to serve the purpose of a trademark by identifying the goods or services of one particular trader.

6.7.1. Presentations and descriptions of scent trademarks

Unlike shapes, colours, sounds or words, it is hard to represent a scent in a way which clearly defines its nature, as it can't be seen or heard. Applicants must be very careful to provide clear, unambiguous descriptions of their scent trademarks. The following guidelines apply:

- The application must include a graphical representation of the scent mark. This could be a description of the scent such as "the scent of pine".
- The graphical representation must be in a form that conveys information to the ordinary person. It should allow them to identify the trademark. Highly technical data will not be acceptable as a graphical representation. For example, the results of analytical techniques such as infrared spectroscopy; vacuum, fractional and molecular distillation; nuclear magnetic resonance; vacuum fractionation; "electronic nose" analysis and chromatographic techniques would not be acceptable.
- An actual sample of the scent is not required at filing but may be needed during examination.

- The applicant must include a precise and accurate written description of the scent that will accompany the graphical representation. The description must include what the scent is, and how will be used in respect of the goods or services.

Examples of acceptable descriptions are available in Chapter 2. In addition to the written description of the scent, which is mandatory to be provided during filing, the applicant may also provide the chemical composition or formula of the scent.

6.7.2. Scents which may be capable of distinguishing

To be capable of distinguishing the applicant's goods, the scent needs to be something apart from the goods themselves. It should be neither a natural characteristic nor an expected characteristic of the product, but something added to identify the applicant's goods from those of others in the same market.

Examples which have been accepted in various jurisdictions include the smell of beer for *dart flights*, and a smell reminiscent of frangipani (plumeria) flowers for *embroidery yarn*, as well as various fruit perfumes for *synthetic motor oils*. In these cases, the perfume did not consist of the natural scent of the product, nor was there an expectation that the product be perfumed. The scent was something unusual added to the goods to assist in identifying them via smell from the similar products of other traders.

6.7.3. Scents which are not inherently capable of distinguishing

The capacity of a scent to distinguish an applicant's goods and/or services should be decided on the same general criteria as is any other kind of trademark. This is based on whether other traders would want or need to use it in the ordinary course of their business, without improper motive. The following categories of scents will generally not be capable of distinguishing.

6.7.4. Natural scent of a product

The natural scent of a product will not be inherently capable to distinguish the goods. This category includes goods such as perfumes and colognes for personal use; essential oils for perfumery or cooking; the scent of cedar for timber products and herbal scents for culinary use. These scents either form the goods themselves or are a natural attribute of the goods. The scent therefore refers to the goods, and not to the trade source. Other examples of this type are the scents of chocolate or vanilla for baked goods or the smell of rubber for car tyres.

6.7.5. Masking scents

Many producers use scents to mask unpleasant natural odours in the goods they sell. A masking scent has a functional purpose and is not capable of distinguishing for that reason. Examples of this type of scent include lemon for domestic bleaches and laundry sprays, and lavender to scent carpet deodorants. As masking scents are commonly used within the trade,

purchasers are unlikely to regard the scent as an indicator of trade source, but rather as something that covers the normally unpleasant odour of the goods.

6.7.6. Scents which are common to the trade

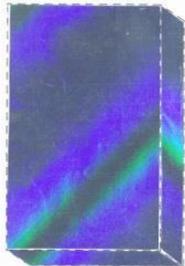
Certain industries often use scents which are non-functional but make their products more appealing to customers. These types of marks are not inherently capable to distinguish. Potential purchasers of these goods are unlikely to consider these fragrances as an indication of the origin of the goods because the use of fragrance on such goods is common to the trade. For example, the scent of lemon has been added to dish washing detergents and laundry products. While it cannot be said that a lemon scent is "descriptive" of such goods, a lemon scent would be treated as not being capable of distinguishing because it is common to the trade. The use of pine or cedar scents for disinfectants falls into the same category, as do herbal scents for shampoos and soaps.

6.7.7. Motion mark and holograms

Trademarks which consist of motion and holograms (which change their character when viewed from different angles) are uncommon but are registrable.

While these signs may appear to be more complex than the others already discussed, the same principles and requirements apply. The applicant must provide clear representations which show all the features of the trademark. The application must be accompanied by a description of the trademark which clearly describes all its features.

For motion mark, it is mandatory to provide a graphic representation of the sequence of motion in the form of a series of still images of the mark to show the movement in all different views. The views provided by the applicant shall be numbered or accompanied by a description explaining the sequence and detailed description explaining the movement of the motion mark. An applicant may also submit A copy of the actual trademark in video format of MP4 with the size limit of not exceeding 50MB, although the video is not mandatory.

Trademark	Goods/Services	Objection under s23(1)?	Rationale
 <p>The trade mark is a circular hologram, placed on the top of the packaging. (EUTM 001787456)</p>	Class 3: <i>Cosmetic preparations</i>	Yes	The mark consists of a reproduction of the hologram however the description is not precise. The applicant fails to explain the differences when the hologram is moved, hence the mark cannot be accepted.
 <p>The mark as shown in the attachment consists of holographic paper that reflects the spectrum of colour in a pattern of oblique, parallel lines applied to the surface of a package; the dotted lines shown in the drawing form. (EUTM 002559144)</p>	Class 34: <i>Cigarettes</i>	No	<p>The mark consists of a reproduction of a hologram as applied on the packaging of a cigarette.</p> <p>A holographic image on the packaging goods applied is not common and can be identified as the source of origin for the applicant.</p>

For hologram mark, an applicant shall provide, during filing, a graphic or photographic reproduction of the hologram, containing a maximum of six (6) views which are necessary to sufficiently identify the holographic effect in its entirety. The applicant may also submit a video file in MP4. The size of the video file shall not exceed 50MB.

The description for either a motion trademark or a hologram must be precise. It should describe exactly what the trademark consists of in positive terms. The wording of the description must refer precisely to the trademark which is being claimed – there should be no ambiguity. An example of a suitable description is:

The trademark is a motion mark. It consists of a yellow balloon with a face drawn on it which floats from the bottom left corner of the screen to the top right corner, while the facial expression changes over the course of the traverse from frowning to smiling. The trademark appears in the video clip attached to the application.

The description for a hologram must clearly describe each view formed by the hologram when it is moved. Representations of each view should also be provided with the maximum of 6 views.

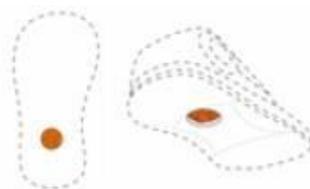
In all the above cases, expressions such as “as exemplified in” or “an example of which” within the description do not precisely define the trademark and will not be acceptable.

6.7.8. Position Mark

Position marks are uncommon but are registrable provided that it fulfils the requirements of distinctiveness. While position mark may appear to be more complex than the others already discussed, the same principles and requirements apply.

The requirements for position mark are as follows:

- The applicant shall provide the Registrar a graphic representation which show solid line on the part where the applicant wants to claim registration and dotted line to denote the part where the applicant does not want to claim.
- It is mandatory to give description of the position mark. The description shall clearly describe the trademark itself and the manner of how and the position where the trademark is used on the goods or services.
- Acceptable graphic representation and description for the position mark are as follows:



Description of the mark: The trade mark is a position mark. It consists of an orange circle, inside which is the drawing of an undefined geometric shape consisting of curved lines and a small circle. The position mark is placed on the exterior of a sole of a shoe. The shoe shape (represented by dotted lines) as well as the quadrilateral with concave and convex shapes and the semicircle in the shape of a half moon inside it (both on the exterior of the sole of the shoe) do not form part of the position mark, they are only outlined to indicate the exact context in which the claimed position mark appears.

EUTM 017363201

6.8. Composite trademarks – combinations of shapes, colours, words, etc.

A trademark may consist of a combination of any of the signs discussed earlier in this chapter, as well as any of those signs combined with words or devices. The same principles apply to these composite marks as any other trademark - whether the trademark as a whole is adapted to distinguish the applicant's goods from those of other traders.

Trademark	Goods/Services	Objection under s23(1)?	Rationale
<div data-bbox="519 343 584 587" data-label="Image"> </div> <p data-bbox="206 608 898 820"><i>The trademark consists of a combination of the shape of a wine bottle and the colour green, as shown in the representation attached to the application form. (EUIPO Guidelines for Examination)</i></p>	Class 33: <i>Wine</i>	Yes	This particular combination of shape and colour are not inherently capable to distinguish, as both are commonly used in the course of trade.