Appendix

Corresponding Case References and Illustrations: Registrability of Non-traditional Trademarks in Europe & Central Asia

May 2009

Non-Traditional Marks, Europe & Central Asia Subcommittee, 2008-2009

All information provided by the Non-traditional Marks, Europe & Central Asia Subcommittee of the International Trademark Association in this document is provided to the public as a source of general information on trademark and related intellectual property issues. In legal matters, no publication, whether in written or electronic form, can take the place of professional advice given with full knowledge of the specific circumstances of each case and proficiency in the laws of the relevant countries. While efforts have been made to ensure the accuracy of the information in this document, it should not be treated as the basis for formulating business decisions without professional advice. We emphasize that trademark and related intellectual property laws vary from country to country, and between jurisdictions within some countries. The information included in this document will not be relevant or accurate for all countries or states.
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ANDORRA

ANDORRA: SHAPE

Just 76 out of the approximately 20,000 trademarks existing in Andorra are three-dimensional, all of which were allowed to proceed to registration, except for only 5, two of which are above.

The first one is the subject of application No. 17,277, filed on October 5, 2001 and subsequently refused on the grounds of lack of distinctiveness, as the trademark was considered to be exclusively constituted by a shape resulting from the nature of the good itself.

The second one is the subject of application No. 18,173, filed on February 5, 2003 and subsequently refused on the grounds of descriptiveness. The trademark represents a typical farmer of the country.

AUSTRIA

AUSTRIA: TRADE DRESS


AUSTRIA: SHAPE

OGH 20.1.2004, 4 Ob 222/03f – Juvina-Flasche - ecolex 2004, 463: successful enforcement of national trademark against similar bottle
BULGARIA

BULGARIA: SINGLE COLOUR
Expressly stated in the Internal Instructions on Application of the Bulgarian Act on Marks and Geographical Indications of the Head of the Bulgarian Patent Office of 1 July 2005.

BULGARIA: COMBINATION COLOUR
Example Reg No. 59150 of April 23, 2007

of OMV AG

BULGARIA: HOLOGRAMS
Expressly stated in the Internal Instructions on Application of the Bulgarian Act on Marks and Geographical Indications of the Head of the Bulgarian Patent Office of 1 July 2005

COMMUNITY TRADE MARK

CTM: TRADE DRESS
The Board of Appeal, decision of October 4, 2007 in case R 843/2007-2 : on October 24, 2006 the applicant filed two applications in class 05 with the following representations (colours claimed: green, mustard and grey) and . The first one was registered at the beginning of 2008 because of the colours, whereas the second one was refused for lack of distinctiveness also because the "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".

CTM: SHAPE
The First board of Appeal, decision of October 30, 2007 in case R 444/2007-1 : a tree-dimensional mark which is descriptive of the goods , have more possibility to be accepted when it is filed together with a word/figurative element. As a matter of fact, the relevant public’s perception is not the same as in the case of word/figurative mark, since average consumers are not in the habit of making assumption about the origin of the goods on the basis of their shape and in the absence of any graphic element.
Judgement of the Court of First Instance, decision of October 10, 2007, case T-460/05:

the decision of rejection of the mark for loudspeakers was annulled by the Court of First Instance since, considering that high-tech products are of an economic value, the public’s level of attention is high and the loudspeakers shown as a whole create a striking design which is remember easily (thanks to the presence of the pencil-shaped column with a long rectangular panel attached to one side). As a matter of fact, even a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in article 7(1) (b).

CTM: COMBINATION COLOUR

The Board of Appeal, decision of December 5, 2007 in case R 1379/2007-2: The mark was refused because of its complexity. As a matter of fact, the examiner stated that the pattern of colours would be viewed by the public as a decoration or an aesthetic feature; given the limited number of different colours that a human can describe, a consumer would not be able to easily and instantly commit to memory the particular combination of the mark; as a consequence it would not be able to repeat the purchase directly and with certainty. This decision is clearly in conflict with the fact that the same owner has two prior registrations (CTM n. 3759909 and CTM n. 2708220).

CTM: MOTION

Examples of motion trademarks and their description: (n. 5952999 description & colours: The trade mark consists of a moving image of a hand with a coin between forefinger and thumb being dipped into a liquid and removed / Shades of red, shades of pink, white, black, bronze, brown and flesh). (n. 5881628 description & colour: The object of the trademark is the movement cycle represented by the sequence of images. The images show excerpts of a continuous movement cycle. / Blue, grey.)

CTM: POSITION

The Board of Appeal, decision of November 12, 2007 in case R 437/2007-4: (description: the mark consists of the arrangement of nail heads in groups of three on the underside of a shoe heel around a part of the perimeter thereof) the mark was rejected because the position of nails on the underside of a shoes heel is common; the mark lacks of distinctive character.
On the other hand, some position marks have been recently allowed to publication:

(n. 6041099: description Position mark consisting of a representation of two diagonal bars which merge at the tip of the bottom end. The broken lines are not part of the trademark but determine the position on the product.) or (n. 5800313 : description: Positional mark: pink edge band 2mm wide running along the edge of the access opening of the tongue of the shoe.)

DENMARK: TRADE DRESS
A trademark may consist of the shape, get-up or packaging of the goods subject to the mark complying with the requirements regarding distinctiveness and graphical representation. If not inherently distinctive, the mark may qualify for registration if it has become established on the Danish market, i.e. through acquired distinctiveness. The question of possible trademark protection for square-shaped chocolate packaging was considered by the Danish Supreme Court in its decision U 1996.848 H. Protection was denied due to the square-shaped appearance of the packaging which resulted from the flow-pack method.

DENMARK: SOUND
Sound marks may be inherently distinctive subject to complying with the requirements formulated in the ECJ decision C-283/01 SHIELD MARK. One single tone is not sufficient, nor is it possible to register a long melody. The graphic representation requirement is satisfied by submitting notes and it is no longer necessary to indicate the musical instruments used. Sonograms or oscillograms are also accepted subject to providing a description of the sound. A bell sound with a frequency of approx. 1 kHz has been registered sub Danish Registration No. VR 2003 02355 for goods and services belonging to classes 29, 30 and 35.
DENMARK: SHAPE
International Registration No. MP828535 designating Denmark is for an ice cream cake shape covering edible ices in class 30.

International Registration No. MP698955 designating Denmark is for a cone shaped container covering goods in class 29.

Danish Application No. VA 1999 03986 for a square, slightly bent and slotted snack shape was rejected due to lack of distinctiveness since the applied-for features are commonly used for snacks and potato crisps.

DENMARK: SINGLE COLOUR
The DKPTO is reluctant to grant protection for a single colour and accepting inherent distinctiveness constitutes the exception. Single colours may, however, be distinctive if protection is sought for restricted goods or services within a specific market. Administrative practice is rather sparse and reference is made to the ECJ decision C-104/01 LIBERTEL. The DKPTO requires a reproduction of the colour itself, in addition to an internationally recognized colour code, e.g. the Pantone code system.

DENMARK: SMELL
There is no administrative practice but theory refers to the ECJ decision C-273/00 SIECKMANN pursuant to which the requirement regarding graphical reproduction is not satisfied by submitting a chemical formula or a description of the smell or by depositing a sample. In conclusion, smells are unregistrable until a method has been found which may serve to reproduce the smell graphically. Danish Application Nos. VA 1997 05710 (foam bath) and VA 1997 05111 (perfumery goods) have both been rejected by the DKPTO.
**GERMANY**

**GERMANY: SHAPE:** Only a mark 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. Denied for registered for a range of tobacco products in a Federal Patent Court, Decision of October 5, 2007 – 26 W (pat) 22/05, cancellation of the registered mark; denied for applied for “meat and meat products” in a Federal Patent Court, Decision of December 19, 2007 – 28 W (pat) 91/06 accepted for applied for “alcoholic beverages, namely wine” in a Federal Patent Court, Decision of September 26, 2007 – 26 W (pat) 204/99 (all Decisions published on www.bpatg.de).

**GERMANY: SINGLE COLOUR:** Federal Patent Court, Decision of February 28, 2007 – 28 W (pat) 223/04 (RAL 3020): Red is used as a signal colour to warn against danger and therefore describes the characteristics of the claimed goods “hydropneumatic storage and filter cases being integral parts of hydro devices”. It also lacks the distinctive character. The requirements for AD were not fulfilled. Published on www.bpatg.de.

**GERMANY: COMBINATION COLOUR:** Federal Patent Court, Decision of November 14, 2007 – 26 W (pat) 205/01 (RAL 1021, RAL 5010): Applied for services of a gas station, the application was denied. It cannot be argued that the high number of possibilities to combine colours makes a colour combination distinctive per se. As distinctiveness without any prior use is inconceivable save in exceptional circumstances, it must be shown that the mark is determined to be used for a very restricted and very specific market where consumers considers a colour combination as an indication for the source of the origin.

**GERMANY: POSITION:** Federal Patent Court, Decision of March 28, 2007 – 29 W (pat) 184/04: Application for a graphical representation of a barcode on the spin of books. Its position is fixed but the size and the sequence of the code depends on the EAN-ISBN. Applied for as a combination of figurative mark, 3-D mark, colour mark and position mark with an emphasis on the positioning part. The Court considers the mark as a new non-traditional mark, a variable trademark, which does not fulfil the requirements of the graphical representation and which it considers to be non-distinctive and descriptive. An appeal on a point of law to the Federal High Court of Justice was admitted. Published in MarkenR 2007, p. 398.
GREECE

GREECE: SHAPE

Figurative trademarks are normally accepted. The Trademark Office tends to refuse however trademarks exclusively consisting of a device, if the application covers “pharmaceuticals” in class 5. The above device for pharmaceutical products in class 5 (Greek trademark application No. 151.641) was refused accordingly.

GREECE: COMBINATION COLOUR

Combination of colors allowed to proceed to registration as a consequence of the distinctiveness the same acquired by the use made of the same.

POLAND

POLAND: TRADE DRESS

No 102678

No 112769

The judgment of the District Administrative Court in Warsaw of March 2, 2006, act signature VI SA/Wa 1705/05. The owner of the trademark No 102678 sought to cancel the trademark No 112769 (trapezoid box/packaging for a bar of chocolate with characteristic rectangle “window” at the front which allows the consumer to see the texture of the chocolate) The Court held that trademark should be examined entirely (as whole) and it is not allowed for the Polish Patent Office (the PPO) to assess only one element (for instance graphics) without linking to word elements. In the opinion of the court the marks are dissimilar.
POLAND: SOUND
Examples of valid sound mark registrations:

No 82258
No 121368

and

application No 328907

POLAND: SHAPE
Examples of valid shape mark registrations:

No 131006
No 107821
No 107640

No 83499

No 116211
The judgment of the District Administrative Court in Warsaw of 18 October 2004, act
signature 6 II SA 3199/03. The Court has ruled that the registration of 3D mark No
116211 (Jaffa cake’s shape) is contrary to the provisions of the Polish law on trade
marks and it may be deemed as the attempt to monopolize the market of specific
products. The court also held that such shape of a cake does not perform a basic
function of a trade mark because it does not help to distinguish goods of one producer
from the another. In Court’s opinion the registration of such shape should be treated as
information about a specific product. The mark was cancelled.
POLAND: SINGLE COLOUR
The District Administrative Court of June 2005 (Sygn. VI SA/Wa 1482/04) stated that a single color can be registered as a trademark but under certain when the mark acquired distinctiveness through use. The decision concerned single color red filed for confectionery, chocolate confectionery, sweets (Appl. No 206238). The mark was refused registration as no acquired distinctiveness has been proved.

No 206238

POLAND: COMBINATION COLOUR
Examples of valid color combination mark registrations

Supreme Administrative Court refused protection for a trademark consisting of a color combination (white and orange stripes Int. Reg. No 667827) filed in the name of FERRERO S.p.A. (Sygn. akt GSK 864/04). In the opinion of the Court it is not evident from the representation of the trademark (presented below) what the proportions of the white and orange stripes are. Therefore the representation is unclear and imprecise and the mark cannot be granted protection in Poland.

IR-667827
POLAND: MOTION

The decision of the Polish Patent Office of 17 August 2006, act signature DT-9/06. The Polish Patent Office has rejected a request to register a motion trade mark (the application was filled as the international registration IR-776498). The examiner found that such sign (described as: movement mark: the colours in the waves are changing continuously from red to green upwards from bottom left to top right in an 8-second time span) can not be shown in graphic form with the use of images, lines, symbols in the manner that such presentation is at the same time clear, precise, compact, easily accessible, comprehensible, durable objective and uniform, which in consequence is devoid of distinctive character.

POLAND: POSITION

Examples of valid position mark registrations:

No 139887. , No 54665 , No 115843

No 63281
ROMANIA

ROMANIA: MOTION

Example: Reg No 080630 of SC GAMA & GAMA SRL

ROMANIA: SOUND

Example: Reg No 062091 of SC JIDVEI SRL FILIALA ALBA

ROMANIA: POSITION

Example Reg No. 086138 of SC FAN COURIER EXPRESS SRL
RUSSIA

RUSSIA: SOUND


RUSSIA: SHAPE

AD if the shape serves functional purposes only; examples of shape (3-D) trademarks:

, certificate of registration № 264741 issued by Rospatent; , certificate of registration № 307625 issued by the Rospatent; decision of Federal arbitration court of North-West district of December 28, 2004 in case № А56-20533/04.

RUSSIA: SINGLE COLOUR

Example of single colour trademark: , certificate of registration № 310048 issued by Rospatent on July 6, 2006.

RUSSIA: COMBINATION COLOUR

Example of combination colour trademark , certificate of registration № 238780 issued Rospatent on February 19, 2003.
SERBIA

SERBIA: SOUND

Reg. 51837 (INTEL)

SERBIA: SHAPE

Reg. 44525 (Unilever)

Reg. 48724
(Carolina Herrera)

SERBIA: COMBINATION COLOUR

Reg. 50572 (BP)
SPAIN

SPAIN: TRADE DRESS

Spanish trademark application No. 2,663,400. Filed on July 22, 2005. The Trademark Office allowed the same to proceed to registration. The mark was found distinctive.

SPAIN: SOUND

Spanish trademark application No. 2,539,332. Filed on May 6, 2003. The Trademark Office allowed the same to proceed to registration. The graphic representation was therefore considered sufficient.

SPAIN: SHAPE

Spanish trademark application No. 2,683,902. Filed on December 7, 2005. The Trademark Office allowed the same to proceed to registration. The device in question was found distinctive as well.

Spanish trademark application No. 1,579,238. Filed on July 11, 1990. The Courts reversed a refusal the Trademark Office issued against the same, thereby allowing the trademark to mature into registration for goods in class 28.
**SPAIN: SINGLE COLOUR**

![Single Colour Image]

Spanish trademark **application No. 2,571,432**. Filed on December 10, 2003. The Trademark Office refused the application on the grounds of lack of distinctive character, in spite of extensive evidence supplied, thereby acknowledging no distinctiveness acquired through use or “secondary meaning”.

**SPAIN: COMBINATION COLOUR**

![Combination Colour Image]

Spanish designation of **International registration No. 925,565**. Filed on April 6, 2007. The Trademark Office accepted this International Registration in Spain, as it was considered to be sufficiently distinctive, as a result of the specific shapes the different colours are contained in.

**UKRAINE**

**UKRAINE: TRADE DRESS**

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### UKRAINE: SHAPE

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