

European Trade Mark Reform Round Up – Removal of the requirement for Graphical Representation

We have previously reported on the various changes to the European Union Trade Mark Regulation which came into force in March 2016 and October 2017. One of these changes was the removal of the requirement to file a graphical representation of the trade mark. A few months down the line, it is interesting to look at how this has affected trade mark filings in practice.



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EU Trade Marks can now be represented in any appropriate format using generally available technology.

Shortly after the new provisions came into force, we filed an EU Trade Mark Application for a sound mark without any graphical representation, submitting only an MP3 music file of the sound ([here](#)). This Application achieved registration at the end of January and is the first ever EU Trade Mark Registration for a non-graphically represented mark, of any kind (see <https://euipo.europa.eu/eSearch/#details/trademarks/017321464>).

It can be seen from the EU Trade Mark Register that there are now 2 sound marks registered, without graphical representation, 2 multimedia marks and a hologram mark represented by MP4 video files. A number of new motion trade marks, represented by MP4 files, are currently under examination. Of the 16 applications for motion marks filed since 1 October 2017, only 4 have been accepted for publication and one has achieved registration as at 13 March 2018.

It is interesting that the official registration certificates for these types of marks simply contain a link to the sound or video file in the 'representation' box, which takes you to the official online register. This means that registration certificates alone do

not provide a representation of the trade mark, and a connection to the internet is required to determine what the trade mark is – it might also cause problems if the EUIPO domain name is updated in the future!

Do the new rules mean that non-traditional trade marks are now easier to register?

Not necessarily.

In the past, one of the difficulties when filing an application for a non-traditional trade mark such as position, sound, motion, multimedia and hologram marks was finding a suitable graphical representation that was sufficiently clear and precise, and met all of the other Sieckmann criteria (self-contained, easily accessible, intelligible, durable and objective). The EUIPO guidelines set out the requirements for representation, but for some marks, in particular sound, motion and hologram marks, it was questionable whether these representations were adequate – could the general public really understand what was protected from, say, a series of stills or a musical notation?

The new Regulation also specifically refers to these types of marks and allows for the list of types of trade mark to be expanded in the future, as technology advances.

These types of marks can now be represented by a JPEG, MP3 or MP4 file alone, as appropriate, provided that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. It is now undoubtedly easier to file an application for, say, a sound or motion mark as you can simply upload an MP3 or MP4 file and these new methods of representation should, in fact, provide more clarity than the previous types of graphical representations.

However, such non-traditional trade marks must still satisfy the requirement for distinctiveness and so it is still likely to be difficult to protect many of these types of trade marks.

Our previous newsletter on the Nestle v Cadbury (shape of KitKat) decision ([here](#)) looked at this in more detail, as that case considered the threshold for proving acquired distinctiveness.

Furthermore, it still does not appear possible in practice to register smell, taste and tactile/texture marks, as they cannot adequately be represented using currently available technology (specimens are not acceptable).

What description or other information is required?

Descriptions are no longer permitted for most types of mark and are optional for colour combination, position and movement marks. It is also no longer possible to include colour claims, other than for single and combination colour marks, although marks filed in colour

will be deemed to be protected in that particular colour format. For colour marks, an indication of the colour code is now a formal requirement.

We are always pleased to advise on the best strategy for seeking to protect trade marks of any kind, including non-traditional marks. If you have any questions on the above changes, please get in touch with your usual Abel & Imray contact, or e-mail ai@abelimray.com

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