

A new trade mark sensation

Traditionally, trade marks have been restricted to signs that are capable of being experienced visually and reproduced orally. The most common example is word marks. The principles and rules relating to the lodgement and examination of word marks have long been crystallised and understood. Although word marks are very powerful, their efficacy can be somewhat diminished by language and cultural differences. For example, an English language trade mark might be less effective in a predominantly French speaking country. Furthermore, word marks may be less effective in markets that are characterised by a large number of people who are illiterate.

The potential limitations inherent in word marks have led, indirectly, towards attempts to adopt trade marks that are more universally accessible. The first of these so-called non-traditional trade marks to gain recognition was colour trade marks. Colours can be experienced by all members of society regardless of their cultural or educational background. The same can be said for sound marks and shape marks. All of these marks can be experienced without recourse to language and are therefore immune to the geographic and cultural barriers that can potentially afflict word marks.

More recently there have been attempts to expand the sphere of non-traditional trade marks even further. Such concepts as smell marks, taste marks, holograms, motion marks, gesture marks, position marks and texture marks have all emerged as potential subject matter for trade mark protection. It would appear that the sphere of trade mark protection that can be sought is now only limited by the human imagination. The reality, however, is that these seemingly unlimited options are still bound by the existing legal requirements for a trade mark.

The most important principle of trade mark registration is the requirement that the trade mark must be capable of graphic representation. This requirement is a cornerstone of the trade mark system and is therefore strictly adhered to. The importance of this principle lies in the fact that members of the public who inspect the register must be able to determine what the state of the register is. If a trade mark is not clearly represented, then members of the public will not be able to determine what the scope of the trade mark monopoly is. They will therefore not be in a position to determine whether their actions are in fact infringing on the trade mark. Equally, trade mark proprietors will find it difficult to enforce their trade mark monopolies if this is not clearly defined.

Non-traditional trade marks can be particularly difficult to represent graphically. Fortunately, the South African Registrar of Trade Marks has now issued guidelines for the lodging of non-traditional trade marks. The guidelines set out the criteria that must be met for the successful lodging of a non-traditional trade mark. In particular, the guidelines provide clarity regarding how non-traditional trade marks are to be graphically represented. The guidelines identify 10 categories of non-traditional trade marks and the requirements for each of these are discussed below:

1. Three-dimensional trade marks

The guidelines state that "a single view of a three-dimensional mark will be accepted, provided it is possible to determine the three-dimensional nature from the single view". It is submitted that a single view will seldom fully expose the three-dimensional nature of a mark and it is therefore advisable to file sufficient views to adequately illustrate the unique features.



2. Colour trade marks

The guidelines require that an application for a colour trade mark should be accompanied by a sample of the colour, on paper or electronically, together with an indication of the recognised international colour code and lastly, a written description of how the colour is applied to goods or used in relation to services. In practice, these requirements are met by filing a colour swatch together with the relevant Pantone colour codes and a written description of how the colour mark will be used. Colour marks are not a new concept in trade mark law and the registrar's guidelines are merely a confirmation of existing practice.

3. Hologram trade marks

The guidelines require that a hologram trade mark should be represented by "either a single or multiple views... provided it is possible to determine the holographic nature of the mark from the views submitted". The guidelines further require that a description of the holographic effect be submitted.

4. Motion/multimedia trade marks

The guidelines state that motion/multimedia marks must be represented by a series of still images, a detailed written description of the movement of the mark and an explanation of the chronological order of the still images. The guidelines also state that a digital or analogue version of the mark may be required for purposes of examination of the mark.

5. Position trade marks

The guidelines state that position marks will be treated as figurative marks. The only additional requirement is that a clear description of what constitutes the mark needs to be lodged. It is submitted that this requirement is slightly more onerous than that of figurative marks, which only require the lodging of a clear illustration of the mark to be registered.

6. Gesture trade marks

The guidelines state that gesture marks "will be treated as the subject of the other type of mark that it represents, for example a motion or figurative mark". It is submitted that, in practice, this approach will effectively mean that the registrar will treat a gesture mark as falling into one of the other nine categories of non-traditional trade marks, the requirements of which are outlined under each of the respective headings.

7. Sound trade marks

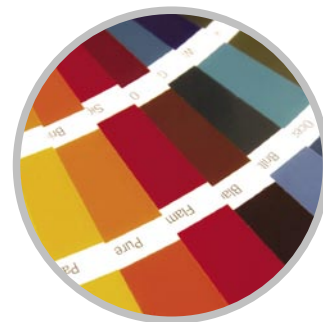
The guidelines state that a sound mark must be represented by musical notation on a staff, together with a written description and an analogue or digital representation of the mark. Sound marks are not a new concept in trade mark law and the registrar's guidelines are merely a confirmation of existing practice.

8. Taste trade marks

The guidelines state that a taste mark will be represented by an indication of the type of mark together with a written description of the characteristics of the taste. At this stage, in the absence of concrete examples, it is difficult to envisage what would constitute an acceptable written description of the characteristics of the taste to be protected.

9. Texture trade marks

The guidelines state that a texture mark will be represented by an indication or a statement concerning the type of mark sought, together with a detailed written description and a representation/sample of the surface.



10. Smell trade marks

The guidelines state that a smell mark will be represented by at least a written description of the mark. The guidelines go on to state that the Sieckmann criteria will be applicable to smell marks. The Sieckmann criteria were laid down in the European Court of Justice (ECJ) case of *Sieckmann v Deutsches Patent- und Markenamt*. This decision determined that the representation of a mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The court went on to state that, in the context of smell marks, these requirements would not be met by lodging a scientific formula, written description, sample or combination of any of these. Practically this means that, although the registrar will accept smell marks accompanied by a written description of the mark, the additional requirement that the Sieckmann criteria must also be met is problematic, in that there are currently no means of graphically representing a smell mark other than those specifically rejected by the ECJ. The lodging of smell marks will remain impossible until a new method of graphically representing a smell trade mark is devised.

The registrar's guidelines are to be lauded in as far as they represent a bold step towards clarifying the rules and requirements that need to be met when one is filing a non-traditional trade mark. Although there are still some question marks surrounding the practical application of these guidelines, it is to be hoped the introduction of more non-traditional trade marks will add a new and exciting dimension to the register.

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