

Guidance on answering the discussion questions in the book

Para 14.22

How much of a difference do you think that the changes introduced by the 2015 reform package will really make in practice? How many marks not considered capable of graphic representation will now be capable of adequate representation on the register?

Even though the requirement for *graphic* representation has been removed from the definition of a registrable trade mark, there does remain a requirement for a sufficiently clear and precise representation of the mark in some acceptable form. The *Sieckmann* criteria have also been retained in the recitals of the TMD 2015 and EUTMR 2017.

Given this, it seems unlikely (on the state of current technology, at least) that the more controversial types of non-conventional mark such as smells and tastes will become registrable. However, it should become considerably more straightforward to register sound, motion and multimedia marks using standard digital file formats.

A good way to get a feel for the impact of the recent reforms is to explore filings on the trade mark register. For example, you can explore the variety of different types of EU trade mark which are being applied for and granted at the EUIPO using the ‘eSearch plus’ database at <https://euipo.europa.eu/eSearch/>. Select ‘Advanced search’ and play around with the ‘Trade mark type’ search criteria, selecting from among the available drop-down options.

Para 14.35

What is your view on the Court of Justice’s assumptions about the consumer perception of different categories of mark? Do you think that it is right to say that consumers do not understand aspects of product presentation, such as shape or colours, as indicators of trade origin? Do you think that consumer perception may have evolved at all since the Court of Justice’s first decisions on this issue?

Although framed as an empirical assumption on the state of consumer understanding, there are arguments that the Court of Justice’s approach on this issue in effect conceals a more normative choice – aiming to make it harder to register certain types of mark to keep them in the public domain for policy reasons rather than because, as a matter of fact, consumers do actually perceive them differently.

However, even if consumers have in the past reacted to aspects of branding such as shape or colour by not thinking of them as trade marks, there are good arguments that the position has changed, and will continue to change over time. Registered trade mark law itself plays a part in this. Making it necessary to prove acquired distinctiveness in order to register many types of non-conventional mark encourages big brand owners to invest in ‘teaching’ consumers to recognise their non-conventional marks as indicators of origin. Over time, as consumers become more and more familiar with more and more non-conventional marks, consumer understanding of what constitute typical forms of trade mark indicia will evolve.

If consumer perceptions do demonstrably change, this will pose a challenge to the Court of Justice’s assumptions and, relatedly, to the effectiveness of the Court’s approach as a ‘filter’ for weeding out registration of marks which give rise to public domain and policy-related concerns. For more discussion, see L Anamaet, ‘The public domain is under pressure – why

we should not rely on empirical data when assessing trade mark distinctiveness’ IIC 2016, 47(3), 303-335.

Para 14.86

To what sort of ‘other characteristics’ do you think the objections at section 3(2) TMA 1994 (as amended) are likely to be applied? How do you think this expansion of the scope of the exclusion may shape the direction of future case law under each of the three limbs of section 3(2) TMA (as amended)?

The reference to ‘other characteristics’ is broadly worded. It seems likely that this could include characteristics such as the colour, texture or surface design of a product, the sound it makes when used, or conceivably even its taste or smell. The expansion of the scope of these objections gives registries and courts new ways to try to deal with concerns about the monopolisation and propertisation of generic or general product features – a public interest-driven approach, building on the anti-monopoly and anti-perpetuation rationales articulated by the Court of Justice in *Philips v Remington*, seems likely to continue.

Para 14.90

Do you think that the case law discussed here adequately covers all of the public policy considerations that might arise in relation to trade mark registration? Do you think that there is any role for this ground of objection in relation to the appropriation of public domain cultural creations? Read the article M Senftleben, ‘Vigeland and the Status of

Cultural Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for Preservation of the Public Domain’ IIC (2017) 48: 683-720, which discusses a decision of the EFTA Court in relation to an attempt to register works by Gustav Vigeland, an eminent Norwegian sculptor, as trade marks. Do you think that EU courts should take a similar approach to cultural works the EFTA Court took in the *Vigeland* case?

There are increasing concerns that trade mark law contains insufficient filters for preventing the appropriation of public domain cultural works by trade mark owners who wish to adopt and monopolise them as an aspect of their branding. Were a trade mark owner to try to register the ‘Mona Lisa’ for cars, or chocolates, or telecoms services for example, it seems unlikely that the distinctiveness objection would be engaged. As the scope of registered trade mark protection broadens, this becomes an increasingly pressing concern. See further M Senftleben, ‘A Clash of Culture and Commerce – Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation in I Calboli and M Senftleben (eds) *The Protection of Non-Traditional Trademarks – Critical Perspectives* (OUP, 2018) - available free via open access here: <https://global.oup.com/academic/product/the-protection-of-non-traditional-trademarks-9780198826576?cc=gb&lang=en&#>.