

DE BERTI ■ JACCHIA

De Berti Jacchia Franchini Forlani
studio legale

WIND IN THE SAILS FOR ATYPICAL TRADEMARKS WITHIN THE EU

Roberto A. Jacchia
Giulia Beneduci

INTRODUCTION

1. A trademark must first of all be a *sign*, an entity that conveys a message to those who perceive it. This is a “genetic” feature, because undertakings fundamentally utilize trademarks to communicate with the public. Typically, trademarks are made up of signs like words, letters, numerals, images, designs or their combinations. They can, though, be also perceived in other ways or by human senses other than sight. It is the case of the so-called *atypical* trademarks, comprised – among others – of color, sound, smell, shape, motion or taste. Indeed, in today’s highly competitive markets, businesses increasingly launch new marketing strategies, aimed at achieving a broad array of sensory reactions, often based on innovative technologies. Thus, the commercial appeal of non-traditional trademarks has correspondingly increased, and IP law has been compelled to address the manifold challenges involved by their protection.

2. Whilst, in the abstract, all kinds of signs can amount to trademarks, non-conventional trademarks may present criticalities in relation to the fulfilment of the requirements for registration. In general, they tended to be excluded from registration, or thereafter declared null, because the applicant or proprietor was unable to represent them graphically, and/or because they were found to lack distinctive character, and/or they were considered an indivisible part or feature of the product. In fact, a cornerstone of trademark law, at both European and Italian level, was the rule whereby a sign could be registered as a trademark only if it was capable of i) being represented graphically and ii) distinguishing goods or services of one undertaking from those of other undertakings. This was the case under old Article 4 of Regulation (EC) No. 207/2009 on the Community trademark (now EU trademark) and Article 7 of the Italian Industrial Property Code (IPC). Besides, according to the principle of separation of trademark from product, the mark should be alien to the product and its characteristics, that is, be conceptually separable from the product.

3. One of the major changes introduced by the recent EU Trademark Reform (Reform) – based on Regulation (EU) No. 2015/2424 (Amending Regulation), modifying Reg. (EC) No. 207/2009, and Directive 2015/2436/UE (New Directive), repealing Directive 2008/95/CE – addresses the very concept of signs capable of registering as trademarks, directly impacting on the protection of atypical trademarks.

REPEAL OF THE GRAPHICAL REPRESENTABILITY REQUIREMENT

4. More particularly, the Reform abolished the original requirement of graphical representability of the sign, whose ambit was long debated by the legal literature and case-law with respect to non-traditional trademarks. In order to be validly registered, the sign must still be capable of being *represented*, but any appropriate form of representation is admitted, as long as it “*enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor*” (Article 4, letter b), of the New Regulation and Article 3, letter b) of the New Directive).

5. The graphical representability requirement was conceived in order to define the mark and determine the precise scope of the protection afforded to its holder. The Court of Justice of the

European Union (CJEU) expressly connected the need for a clear and precise representation of the mark to that of legal certainty, not only towards the public and consumers, but likewise towards the competent authorities (in relation to their tasks of examination, publication and maintenance of the Register), as well as towards other economic operators (wishing to know about registrations and applications of competitors). The CJEU furthermore emphasized the requirements of objectiveness and durability of the (graphic) representation, whereby the latter should be i) unequivocal and untainted by elements of subjectivity, and ii) durable, given that a trademark registration lasts many years and may be subject to renewal, ultimately, for an indefinite period of time. These principles are laid down in the *Sieckmann* judgment (12.12.2002, Case C-273/00), which will be recalled below when dealing with smell trademarks. Actually reflecting the language utilized by the CJEU in *Sieckmann*, Recital (10) of the New Regulation and Recital (13) of the New Directive now provide that the trademark representation must be “*clear, precise, self-contained, easily accessible, intelligible, durable and objective*”. As concerns the suppression of the graphical representability requirement, its rationale is connected with the aim to ensure “*greater legal certainty*” and allow “*more flexibility*”, as based on “*generally available technology*”.

COLOURS AND SOUNDS AMONG OTHER ATYPICAL TRADEMARKS

6. A significant change introduced by the Reform is the express addition of *colours* and *sounds* to the exemplifying list of signs capable of being registered as trademarks (pursuant, again, to Article 4 of the New Regulation and Article 3 of the New Directive). In the Italian perspective, *colour combinations or tones*, as well as *sounds*, are already present in the analogous list contained in Article 7 IPC. On the other hand, smells and (shape trademarks aside) other non-traditional trademarks, such as motion or taste trademarks, are not expressly mentioned in either the amended European list or the Italian list.

7. As highlighted by certain commentators, an implied reference to *other* non-conventional trademarks can be found in another change introduced by the Reform, namely, the amended provision on shape trademarks (Article 7.1, letter e), of the New Regulation and Article 4.1, letter e), of the New Directive), extending the three specific limits put to the possibility of registering a shape also to other signs exclusively consisting of “*another characteristic*” inherent to the product (see below). However, since the list has an illustrative, rather than exhaustive, value, the express mention of (only) colours and sounds ought not to result in an obstacle to registration.

WHEN DO THE CHANGES START TO APPLY?

8. With respect to EU trademarks, whilst the Amending Regulation in general entered into force on March 23, 2016, the specific amendment relating to the sign of which a trademark may consist started to apply on October 1, 2017. This deferral derived from the need to wait for the implementing EU secondary legislation in their respect to be issued.

9. Namely, on May 18, 2017, the EU Commission issued Delegated Regulation (EU) 2017/1430 (Delegated Regulation) – repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 – and Implementing Regulation (EU) 2017/1431 (Implementing Regulation), both published in the Official Journal on August 8, 2017.

10. Starting from October 1, 2017, Regulation (EU) 2017/1001 of June 14, 2017 likewise applies. It is the new Regulation on the EU trademark (New Regulation), repealing Regulation (EC) No. 207/2009.

11. With respect to national trademarks within the European Union, the corresponding changes introduced by the New Directive will need to be transposed by Member States within January 14, 2019.

EU SECONDARY LEGISLATION, SUB-CATEGORIES OF ATYPICAL MARKS

12. Article 3 of the Implementing Regulation sets out a series of specific technical rules for the representation of certain types of trademarks, in accordance with their respective nature. As from October 1, 2017, it is necessary to comply with such rules when filing an application for an EU trademark before the European Union Intellectual Property Office (EUIPO).

13. To exemplify, a *multimedia mark* (consisting of, or extending to, the combination of image and sound), must be represented “*by submitting an audiovisual file containing the combination of the image and the sound*” (Article 3.3, letter i), Implementing Regulation). The rule on *position marks* (consisting of the specific way in which the mark is placed or affixed on the product) is that they must be represented “*by submitting a reproduction which appropriately identifies the position of the mark and its size or proportion with respect to the relevant goods. The elements which do not form part of the subject-matter of the registration shall be visually disclaimed preferably by broken or dotted lines*”; such representation “*may be accompanied by a description detailing how the sign is affixed on the goods*” (letter d)). A *hologram mark* must be represented “*by submitting a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety*” (letter j)), while a *pattern mark* (made up exclusively of a set of elements which are repeated regularly), must be submitted “*by submitting a reproduction showing the pattern of repetition*”, which “*may be accompanied by a description detailing how its elements are repeated regularly*” (letter e)). Multimedia, position, hologram and pattern marks are sub-categories of atypical trademarks the admissibility of which is expressly confirmed by the Implementing Regulation. But, as previously noted, there is no exhaustive list of “representable” signs, and more sub-categories could be conceived in the future.

14. In general, the EU Commission points out that the introduction of technical alternatives to graphical representation may be afforded by new technologies, and derives from the need of modernization of the registration process in a way closer to technical progress (Recital 6 of the Implementing Regulation), and that, following the repeal of the graphical representation requirement, certain types of trademarks will be capable of representing in electronic format (Recital 8).

MAIN BREEDS OF ATYPICAL TRADEMARKS, SHAPE TRADEMARKS ASIDE

15. The next paragraphs of this paper will dwell on four particularly significant categories of atypical trademarks: *colour*, *sound*, *smell* and *motion* marks. The focus will be on their respective critical features and any special rules laid down by EU secondary legislation for filing a valid

application therefor. Thereafter, an overview will be provided on two other non-traditional trademarks, *taste* and *tactile* marks, which at this time constitute a new frontier.

16. Conversely, *shape* (or *3D*) trademarks will not be considered, inasmuch as trademark law reserves to them (and reserved in the past) specific provisions when dealing with absolute grounds for refusal. In particular, Article 7.1, letter e), of the New Regulation, excludes from registration the shape, or another characteristic, i) which results from the nature of the goods; ii) of goods necessary to obtain a technical result; or iii) which gives substantial value to the goods. The rationale behind these limits would deserve a separate analysis, but it is worthwhile mentioning them here, because they are sometimes referred to by case-law and literature dealing with atypical trademarks.

17. While the assessment of the distinctive character of shape trademarks may be problematic, the requirement of their (graphic) representability has not raised any particular issue. The rule laid down in Article 3.3, letter c), of the Implementing Regulation provides that: *“in the case of a trade mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance (shape mark), the mark shall be represented by submitting either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction. The graphic or photographic reproduction may contain different views. Where the representation is not provided electronically, it may contain up to six different views”*.

COLOUR TRADEMARKS

18. Businesses are aware that the systematic adoption of one or more identifying colours or shades of colour can prove strategic in optimizing corporate image and identity. This is why the registration of trademarks consisting of a colour or combination of colours (colour marks) is quite frequent. A classic example is the lilac/violet colour applied to the packaging of the Milka chocolate, which is a registered EU trademark since 1999, owned by Kraft Foods.

19. As previously noted, the New Regulation and the New Directive now expressly mention colours among the signs which a trademark may consist of. But, already before the Reform, notwithstanding a strict EUIPO examination policy, the EU General Court and the CJEU had opened the door to the registration of colour trademarks, subject to the rigorous fulfilment of certain requirements. More particularly, in the landmark *Libertel* judgment (06.05.2003, Case C-104/01), concerning a particular shade of orange colour utilized as a trademark for certain telecoms goods and services, the CJEU pointed out that, while a colour per se cannot be presumed to constitute a sign (because normally colours are simple properties of things), it is nonetheless capable of being perceived as one in relation to a product or service, depending on the context in which the use occurs.

20. The CJEU furthermore held that the competent authority for registering trademarks must take into account the public interest in not unduly restricting or monopolizing the availability of colours for competitors (24.06.2004, Case C-49/02, *Heidelberger Bauchemie*). As noted by certain commentators, since the number of basic colours is limited, their registration as trademarks could create situations of monopoly unduly interfering with free competition. For that reason, the assessment of colour trademarks should be strict.

21. Colour trademarks may also give rise to issues with respect to their potential lack of distinctive character. According to the case-law, distinctiveness must, again, be assessed having regard to the general interest in not unduly restricting the availability of colours for competitors (*Libertel*). Moreover, an obstacle to the registration of colour trademarks was traditionally identified in their potential functional or decorative significance in relation to certain products. The Italian case-law and legal literature tended to solve this problem by applying to colour trademarks the strict limits posed to the registrability of shape trademarks, as laid down in Article 9 IPC, mirroring Article 7, para. 1, letter e) of the Regulation (EC) No. 207/2009 (now of the New Regulation).

22. As concerns graphical representability, the *Libertel* judgment lays down certain limits: a) a mere sample of a colour does not per se constitute a suitable graphical representation, because it may deteriorate with time and therefore does not possess the durability requirement; b) a verbal or textual description of a colour might constitute an adequate graphical representation of the colour, depending on the circumstances of each individual case; and c) the designation by way of an internationally recognized identification code could constitute an acceptable graphical representation, because such codes are presumed precise and stable. A widespread standard is the notorious *Pantone Matching System*, introduced in 1963 and in continuous development.

23. With regard to combinations of colours, the CJEU held that the graphical representability requirement cannot be satisfied by their mere juxtaposition without shape or contours, or by claiming the colours concerned in every conceivable form. Such representations would not fulfill the necessary requisites of precision and uniformity. Rather, the Court requires that a combination of two or more colours, designated in the abstract and without contours, should, in order to achieve representability, be “systematically arranged by associating the colours concerned in a predetermined and uniform way” (*Heidelberger Bauchemie*).

24. The specific rules on the representation of colour trademarks laid down in Article 3.3, letter f), of the Implementing Regulation reflect that case-law, by providing that: “(i) where the trademark consists exclusively of a single colour without contours, the mark shall be represented by submitting a reproduction of the colour and an indication of that colour by reference to a generally recognised colour code; (ii) where the trademark consists exclusively of a combination of colours without contours, the mark shall be represented by submitting a reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner and an indication of those colours by reference to a generally recognised colour code. A description detailing the systematic arrangement of the colours may also be added”.

SOUND TRADEMARKS

25. Another intriguing category of non-traditional trademarks is that of audible signs, which can be either music (songs, jingles, etc.) or sounds that cannot be reproduced in a stave/pentagram (like an animal cry, or sounds recorded from the world of nature). To exemplify, think of McDonald’s jingle, made up of a short melody accompanied by the text “I’m lovin’ it”: this is an EU trademark, registered since 2005. Another well-known EU sound trademark, registered since 2006, is the Tarzan yell, utilized to distinguish audiovisual products and entertainment formats revolving around the fictional character created by Edgar Rice Burroughs. And so on.

26. The admissibility of sound trademarks, and of trademarks that are not capable of being perceived visually, had already been recognized by the CJEU, with emphasis being placed, again, on the issue of their (graphic) representability. The landmark case in this connection is Shield Mark (27.11.2003, Case C-283/01), relating to several sound trademarks, some consisting of a signature tune employing the musical composition “Für Elise” by Beethoven, others of a cockcrow sound. According to this precedent, in presence of a sound trademark, the graphical representability requirement is satisfied where the sign can be expressed by a stave divided into measures *“and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals”*; conversely, a description utilizing written language, an onomatopoeia or a mere sequence of musical notes are not considered adequate means of graphical representation.

27. A famous sound trademark registered by the EUIPO is the Metro-Goldwyn-Mayer’s lion roar. Initially, the application had been rejected and the appeal against the examiner’s decision had been unsuccessful. The EUIPO Fourth Board of Appeal (by its Decision of 25.08.2003, corrected on 29.09.2003, Case R 781/1999-4, Roaring lion sound) specified that the trademark applied for, although not involving music in traditional sense, was registrable in principle, because a sonogram can constitute a satisfactory graphical representation; however, in that particular case, the sonogram provided by the applicant was incomplete (since it contained no representation of scale on time and frequency axis), so that the trademark could not be registered. Later on, in 2006 Metro-Goldwyn-Mayer successfully filed a new application for the same mark, representing it through a three-dimensional spectrogram combined with a MP3 file and a very detailed verbal description; hence, since 2008 the lion roar is a registered EU trademark.

28. As from October 2017, when applying to the EUIPO for a trademark exclusively consisting of a sound or combination of sounds, one will need to comply with Article 3.3, letter g), of the Implementing Regulation, whereby *“the mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation”*.

SMELL TRADEMARKS

29. *Scent marketing* is increasingly spreading among cutting-edge businesses, which aim at exploiting the strong evocative power of the sense of smell. However, the registration of odours as trademarks, although admissible in the abstract, remains difficult to achieve in practice. Whilst other legal systems, like that of the US, accepted olfactory trademarks without excessive difficulties, the European case-law, despite recognizing that in principle smells are signs of which trademarks may be comprised of, has taken a very conservative approach when assessing the fulfilment of the (graphical) representation requirement.

30. In Sieckmann (previously cited) it was held that, in respect of an olfactory sign, the requirement of graphical representability would not be satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements. As to the chemical formula, the Court found that it was not intelligible to the public and did not represent the odour of a substance, but rather the substance as such. As to the deposit of a sample, the CJEU considered that it was not sufficiently stable or durable, upholding the objection that an odour changes over time because of volatilisation and other physical phenomena.

31. The principles laid down in Sieckmann were then applied by the EU General Court in Eden (27.10.2005, Case T-305/04). The Third Chamber held that the description “smell of ripe strawberries” was incapable of identifying an olfactory sign in an unequivocal, precise and objective way. The Court considered that the smell of strawberries varies from one variety of strawberries to another, and consequently the description comprised several distinct smells. According to Eden, the image of a strawberry did not amount to a graphical representation of the olfactory sign claimed either, because (in the same way as for a verbal description) it lacked clarity and precision, and only represented the fruit which emits the smell.

32. Consistently, the EUIPO (then OHIM, Office for Harmonization in the Internal Market) rejected several applications for smell trademarks. For example, back in 2001, the OHIM Third Board of Appeal upheld the examiner’s refusal of registration for “the scent of raspberries” as an olfactory trademark applied to fuels. The Board found that consumers did not take in the scent of raspberries separately from the good concerned (fuel) and recognized it only as a sort of decorative element, rather than a distinctive feature: *“The addition of raspberry scent to fuels such as diesel or heating oil, which generally smell unpleasant, is similar to the perfuming of unpleasant-smelling rooms with scented sprays. The consumer will therefore see the added raspberry scent as one of the industry’s many attempts to make the smell of these goods more pleasant”* (05.12.2001, Case R 711/1999-3, The scent of raspberries).

33. At EU level, the registration as a trademark of “the smell of fresh cut grass” for tennis balls, filed in 1996 and currently expired, altogether remained an isolated case. In that (now outdated) decision, the OHIM Second Board of Appeal gave a positive answer to the question of whether or not the verbal description at issue complied with the graphical representation requirement: *“The smell of freshly cut grass is a distinct smell which everyone immediately recognises from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences”* (11.02.1999, Case R 156/1998-2, The smell of fresh cut grass).

34. In the light of the foregoing, one understands why the Amending Regulation and the New Directive omit smells from the list of signs expressly capable of registering as trademarks. Nevertheless, such list is non-exhaustive, thus, the registration of entities not mentioned therein is not precluded, and alternative new methods of representation could be developed in the future with the progress of science, and the evanescent, unstable nature of scent may then no longer prove an obstacle to registration.

MOTION TRADEMARKS

35. Also moving images can amount to a trademark, provided that certain essential conditions for registration are met. More particularly, a motion trademark consists of a movement or a change in the position of the elements of the mark itself (for instance a sequence of stills). Although the number of motion trademarks is still rather limited compared to that of other categories of atypical marks, their use is not uncommon in the world of media, advertising and the Internet.

36. A significant example is the well-known Nokia short video showing a child’s and an adult’s hand shaking, displayed on the screen of Nokia mobile phones when switching on: this is an EU trademark, registered in 2005 and then renewed, described as *“four images depicting hands*

coming together, shown in succession from left to right and from top to bottom". Another famous motion trademark, registered at EU level since 2010, is the dynamic logo that is displayed on the computer screen at the starting of the Windows system, described as follows: "The mark consists of an animated sequence that begins with four objects of colored light (one each in the color red, green, yellow and blue) that appear in a staggered sequence and swirl around one another in distinct arcs, expanding in size and illumination intensity until they converge and form a four paneled flag image with a circular white light in the center that oscillates with varying illumination intensity. The total length of the animated sequence is approximately seven seconds".

37. Pursuant to Article 3.3, letter h), of the Implementing Regulation, a motion trademark must be represented *"by submitting a video file or by a series of sequential still images showing the movement or change of position. Where still images are used, they may be numbered or accompanied by a description explaining the sequence"*. The EUIPO (then OHIM) accepted several applications for motion trademarks in the past, in which the movement that was the object of the sign was represented through a series of stills. For example, the OHIM Second Board of Appeal (23.09.2010, Case R 443/2010-2, Red liquid flowing in sequence of stills) found that representation by submitting a flipbook of twenty images/stills, in combination with a textual description, passed the (graphical) representation test. The motion was described as a trailing ribbon with a liquid-like appearance, flowing around and ultimately into a sphere design; the duration of the motion was indicated in approximately 6 seconds and the precise sequence of the images/stills was specified. In its decision, the Board ruled that *"when looking at the representation this way, which could have been done by the examiner and could also be done by any third party interested in the content of the mark, any possible gaps in the progression of the movement between the stills disappear and the progression of the flowing movement becomes clear. In the reality of the marketplace, this way of presenting the mark actually corresponds more to the way that the mark will be seen by the public and the same can actually be said of almost all marks consisting of, or containing, a movement"*; and, in addition, that *"the Board is of the opinion that even based on just looking at the stills as presented in the application form and read in conjunction with the textual description the movement that happens in the mark is, in fact, quite clear"*.

38. In the same decision, the OHIM Board of Appeal, though, upheld the principle whereby a motion trademark may be refused registration when a reasonably observant person with normal levels of perception and intelligence would, upon consulting the EUTM register, not be able to precisely understand what the mark consists of *"without expending a huge amount of intellectual energy and imagination"*. In a recent case, the EUIPO Second Board of Appeal dismissed the appeal against the examiner's decision to refuse the application for a motion trademark consisting of a moving transparent red-purple hexagon showing different shapes and changing colours (03.03.2017, Case R 1439/2016-2, Movement mark, al.). The representation of the trademark provided by the applicant in the form of fifteen images with a textual description, did not pass the test. The reasons are clarified by the Board in the following terms: *"in the present case, it is not possible to grasp the movement described in the description of the mark from the sequence of images shown. The changing of colours of the shapes represented and the 'illusion of movement' are not perceptible for a reasonably observant person with normal levels of perception and intelligence"*; besides, *"The description provided by the applicant may give some vague idea of what the applicant wishes to protect, but it is unrelated to the images as viewed by the reader of the EUTM Bulletin"*.

39. Finally, in addition to the issue of (graphical) representability, those of distinctive character and separation from the product transpired, with specific implications with respect to motion trademarks. In that perspective, the movement claimed as a trademark cannot be protected as an integral part of the product, but rather as a sign, which must be distinctive (for this purpose, as observed by some commentators, the motion should be short, incisive and able to catch the public's attention). In relation to these caveats, the Lamborghini decision is worth recalling, where the OHIM First Board of Appeal upheld the examiner's decision to refuse the application for a motion trademark consisting of a particular upwards-swiveling movement of a car door (23.09.2003, Case R 772/2001-1, Door movement of a vehicle). In confirming its lack of distinctive character, the Board concluded that *"upwards-swivelling car doors are perceived by the relevant trade circles as a characteristic feature of a category of (sports) cars and not as a trade mark of a particular manufacturer of these cars"*. Moreover, that decision is interesting because the Board, detecting the three-dimensional nature of that trademark, applied the criteria on shape trademarks provided under Article 7, para. 1, letter e) of Regulation (EC) No. 207/2009, considering the motion as a characteristic mechanical movement of a car door, equivalent to a technical function of the product, thus precluded from trademark protection.

TASTE TRADEMARKS

40. The commercial appeal of taste trademarks is not negligible either and is increasing, in particular, in the chemical and pharmaceutical industry, with undertakings being interested in protecting as their own distinctive signs the flavours of certain pleasant substances added to medicines. Nevertheless, gustatory marks are characterized by yet other peculiarities which result in substantial obstacles to registration. Taste is physiologically unstable, intrinsically subjective and unreliable, and its perception is influenced by other human senses (like sight and smell); hence, it hardly fulfils the Sieckmann test regarding the representability requirement. Besides, flavour would be inseparable from the product itself and it is perceptible only after placing the food or medicine in one's mouth; thus, it could not serve the function of orienting consumers' purchasing choices.

41. As it were, registration of gustatory trademarks before the EUIPO is an uphill climb. In a remarkable case, the OHIM Second Board of Appeal upheld the examiner's decision to refuse registration of a smell mark for pharmaceutical preparations, described by the applicant (the American multinational Eli Lilly) as *"the taste of artificial strawberry flavour"* (04.08.2003, Case R 120/2001-2, The taste of artificial strawberry flavour). In particular, also resting on previous case-law concerning other categories of atypical trademarks, the Board found that

- i) the graphical representability requirement could not be satisfied by a description in written words (pursuant to the Sieckmann criteria)
- ii) the taste at stake was devoid of any distinctive character, based on the following reasoning: *"Any manufacturer of products such as pharmaceutical preparations is entitled to add the flavour of artificial strawberries to those products for the purpose of disguising any unpleasant taste that they might otherwise have or simply for the purpose of making them pleasant to taste."*; *"A feature that any manufacturer of such goods is entitled to use cannot distinguish the goods of one manufacturer from those of competing undertakings"*

iii) given the public interest in not restricting the availability of flavours, if the applicant were given an exclusive right to use the (alleged) sign, that would unduly interfere with free competition (on this point, the Board also recalled the Liberte! judgment on colour trademarks)

iv) the taste was unlikely to be perceived as a trademark by consumers, who are far more likely to assume that it is intended to disguise the unpleasant taste of the product (in this regard, the Board referred to the OHIM Decision The scent of raspberries concerning smell trademarks).

42. Certain commentators observed that, in order to allow the registration of taste trademarks, it would be necessary to store samples, and have them regularly tested by experts, throughout the whole duration of the legal protection. However, Article 3.9, of the Implementing Regulation clearly provides that the filing of a sample cannot constitute a proper representation of a trademark. One cannot help concluding that the EU legal system is not ready for gustatory trademarks, as openly indicated by the EUIPO Guidelines for Examination, whereby: *“It is currently not possible to represent a taste”,* because *“the subject matter of protection cannot be determined with clarity and precision with generally available technology”* (Part B, Section 4, Chapter 2, Page 15, Version of 01.10.2017).

TACTILE TRADEMARKS

43. The impossibility to submit samples to the EUIPO also precludes proper representation, thus registration, of trademarks perceptible by touch. In this regard, the EUIPO Guidelines for Examination provide: *“It is currently not possible to represent the tactile effect of a certain material or texture”,* because, again, *“the subject matter of protection cannot be determined with clarity and precision with generally available technology”* (Part B, Section 4, Chapter 2, Pages 15-16, Version of 01.10.2017).

44. In a case concerning a tactile trademark, the OHIM Second Board of Appeal upheld the examiner's decision to refuse registration for a trademark described in the application as *“the tactile feeling constituted by the imprinted embossed pattern on the smooth bottle surface”,* sought by The Procter & Gamble Company for products like soaps and cosmetics (27.05.2015, Case R 2588/2014-2, Embossed pattern on a smooth bottle surface). While acknowledging that a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented (graphically), the Board noted that *“we ought to ask not whether a graphic representation is a possibility but in the present case a reality”*. In that case, the applicant had provided a verbal description of the mark and had attached an image for information purposes. According to the Board, that representation was not clear, intelligible and self-contained.

45. More particularly, the Board held: *“the embossed pattern featured on the image filed together with the application is a combination of different oval shapes that are not very prominent and might be difficult to perceive. Furthermore, these oval shapes do not provide a clear indication or clarity as to the tactile feeling that they produce. The applicant ought to have shown that and how people could discern the tactile feeling from the graphic representation”*. Besides, as specifically regards the non fulfilment of the criterion of being “self-contained”, the Board pointed out that: *“the notion of ‘self-contained’ means that third parties viewing the CTM Bulletin, should*

on their own and without additional technical means, be able to understand what this claimed 'particular sensation to the touch' or at least to have a general idea of what this 'tactile' mark is. As correctly held by the examiner, it is impossible to deduce from the image as filed to identify with certainty the claimed 'tactile feeling'".

FINAL REMARKS

46. To sum up, atypical trademarks are a multi-faceted and very lively reality. The changes introduced by the 2015 Reform with reference to the signs which a trademark may consist of encourages their registration and protection, by "releasing" the representability requirement from its graphical declination. However, as some Italian legal literature recently observed, the requirement itself must still be applied in compliance with the demanding Sieckmann criteria, which continue to be referred to in the Recitals of the New Regulation as well as the New Directive. Therefore, the impact that the Reform will have on non-conventional trademarks remains to be verified, based on how the Courts and IP Offices, especially the CJEU and EUIPO, will implement the changes from now on.