

Case Law Laboratory

Alicante, 12 June 2017



Case Law Laboratory

Monday, 12th June

08:30 **Registration and breakfast**

09:00 – 09:20 **Introduction and presentation of the Case Law Laboratory by João Negroo, Director International Cooperation and Legal Affairs Department, Théophile Margellos, President of the Boards of Appeal and Ursula Schildt, Director of the Academy**

09:20 – 11:00 **Parallel working groups: Topics 1 and 2**

Topic 1 – Non-traditional trade marks

As of 1 October 2017, the requirement of graphic representation will be removed. At first sight this is a bonanza for non-traditional marks. Nevertheless, just what this will mean in practice is still somewhat of an unknown quantity. The non-graphic representation needs to comply with the Sieckmann criteria by being clear, precise, self-contained, easily accessible, intelligible, durable and objective. That will undoubtedly continue to be a challenge for some unconventional signs such as smell marks in the current state of technology. In addition, the newly revamped version of Article 7(1)(e) EUTMR presents a further hurdle for non-traditional marks where they relate to 'other characteristics' of the goods. Yet, some forms of non-traditional marks are likely to prosper under the new regime. The EUIPO already accepts MP3 files for sound marks and service marks are totally unaffected by Article 7(1)(e). While EUIPO's Boards of Appeal previously refused MGM's roar of a lion and Tarzan's yell, these signs have long existed the other side of the Atlantic. The Madrid Protocol means that these signs, when used for services, could be the subject of a valid extension to the EU. This workshop will look at the opportunities that the abolition of graphic representation offers, including overlap with copyright and with discussion on potentially thorny issues such as retail services, priorities and proof of use.

EUIPO panellists:

Mr. Gordon Humphreys, Chairperson of the 5th Board of Appeal

Mr. Arnaud Folliard-Monguiral, Team leader, Litigation, International Cooperation and Legal Affairs Department

Mr Dennis Scheirs, Team Leader, European Cooperation Service, , International Cooperation and Legal Affairs Department

External panellists:

Mr. Eli Salis, Partner at Disain IP

Dr. Ralf Sieckmann, Partner at Cohausz Hannig Borkowski Wißgott GbR

Ms. Maria Eugenia Martins de Nazaré Ribeiro, Former Judge of the General Court of the European Union

Topic 2 – Functional trade marks and designs

Both the European Union Trade Mark Regulation and the Community Design Regulation include a prohibition against registering trade marks or designs which are comprised of functional characteristics.

This workshop seeks to explore the intricacies of the prohibition itself when viewed in the context of the differing legal frameworks in which it is expressed, for example by a comparative analysis of its purpose and application. Is that prohibition, for all intents and purposes, the same concept merely implemented in two different pieces of legislation or is there a difference? Are the same purposes pursued in differing permutations in the context of the trade mark and design regulations respectively? And what are the differences (if any) in the underlying interests which define the specific application of that prohibition in the context of trade marks and designs? And finally can jurisprudence regarding trade marks be used analogously to interpret the prohibition within the context of designs and vice versa?

EUIPO panellists:

Ms. Elisabeth Fink, Member of the 3rd and 4th Board of Appeal

Mr. Stephan Hanne, Legal Affairs, International Cooperation and Legal Affairs Department

External panellists:

Mr. Mikael Francke Ravn, Chief Legal Adviser at Danish Patent and Trademark Office

Prof. Dr. Dr. h.c. Annette Kur, Senior Research Fellow and Head of Unit in Max-Planck-Institut für Innovation und Wettbewerb

Mr. Andrea de Gaspari, Member of the ECTA Design Committee, Partner in De Gaspari Osgnach S.R.L.

11:00 – 11:30 **Coffee Break**

11:30 – 13:00 **Parallel working groups: Topics 3 and 4**

Topic 3 – Disclosure of designs

The issue of disclosure is crucial in design conflicts. Nowadays, establishing disclosure of prior designs is increasingly becoming more related to the Internet and new technologies, which means that litigants rely more and more on Internet printouts, digital pictures, and other similar documentation. The constantly changing and dynamic nature of online content creates challenges in the dating of evidence. Parties are therefore increasingly turning to printouts from the 'Wayback machine' and other Internet archives or repositories. Nevertheless, the law has some difficulty in reconciling, on the one hand, the possibility of using Internet and new technologies for proving disclosure with, on the other hand, the general principle of legal certainty, particularly as regards the date of disclosure and its territorial scope. The divergences in national practice have been considered sufficiently important for the EUIPO and National Offices to have recently included this topic as a dedicated Convergence Programme project. However, in the absence of a common practice, the workshop will bring together multi-jurisdictional experts from within the EUIPO, national IP offices and private practice to examine the challenges faced and consider what solutions could be brought forward.

EUIPO panellists:

Mr. Harri Salmi, Member of the 2nd and 3rd Board of Appeal

Mr. Declan Finlay, Seconded National Expert, International Cooperation and Legal Affairs Department

External panellists:

Mr. Shane Smyth, Partner in FRKelly

Avv. Niccolò Ferretti, Member of the ECTA Design Committee, Partner in Nunziante Magrone Law Firm

Topic 4 – National law rights in the context of Article 8(4) EUTMR

Although less frequently invoked as basis of an opposition or invalidity request, non-registered rights protected by national law in conjunction with Arts 8(4) and 53(2) EUTMR can constitute the only available remedy available to economic operators wishing to protect their acquired earlier rights against conflicting subsequent EU trade marks. Notwithstanding its significance, key questions of this specific field of trade mark law still remain to be clarified. These include the requirements of (i) substantiation before the EUIPO, (ii) use (in particular the relationship between the standards set by EU law and by the applicable national law), (iii) ownership, (iv) the right to prohibit use (and/or registration?) of a subsequent trade mark, as well as (v) the scope of protection afforded by different non-registered rights.

EUIPO panellists:

Mr. Philipp von Kapff, Member of the 1st Board of Appeal

Mr. Dominik Hanf, Legal Affairs Area, International Cooperation and Legal Affairs Department

External panellists:

Dr. iur. Verena von Bomhard, Founding Partner at Bomhard IP

Mr. Imre Gonda, Head of IP Department at Gedeon Richter Plc.

13:00 – 14:30

Lunch

Plenary Sessions

14:30 – 14:50 **Presentation of results and conclusions of Topic 1**

14:50 – 15:10 **Discussion**

15:10 – 15:30 **Presentation of results and conclusions of Topic 2**

15:30 – 15:50 **Discussion**

15:50 – 16:10 **Coffee Break**

16:10 – 16:30 **Presentation of results and conclusions of Topic 3**

16:30 – 16:50 **Discussion**

16:50 – 17:10 **Presentation of results and conclusions of Topic 4**

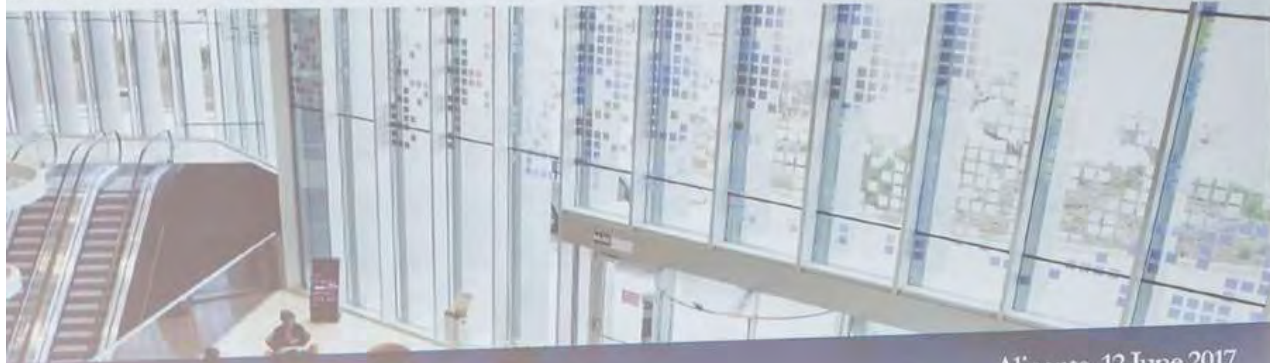
17:10 – 17:30 **Discussion**

17:30 – 17:40 **Closing**

17:40 **Cocktail**

IPCLL

IP Case Law Laboratory



Alicante, 12 June 2017

Topic 1-
Non-traditional
trade marks

IPCLL

IP Case Law Laboratory



Alicante, 12 June 2017





Workshop on Aspects of
Non Traditional Trade Marks
during Case Law Laboratory
@EUIPO, Alicante, 12th June 2017

PA Dr. Ralf SIECKMANN

Cohausz Hannig Borkowski Wißgott GbR
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 chdgermany@aol.com

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Industry and Practical Concerns

3.1 Why does Industry and Commerce need NTTMs?



3.2 Should judicial decision taking in Trade Marks cases keep pace with technology, and if so, how?



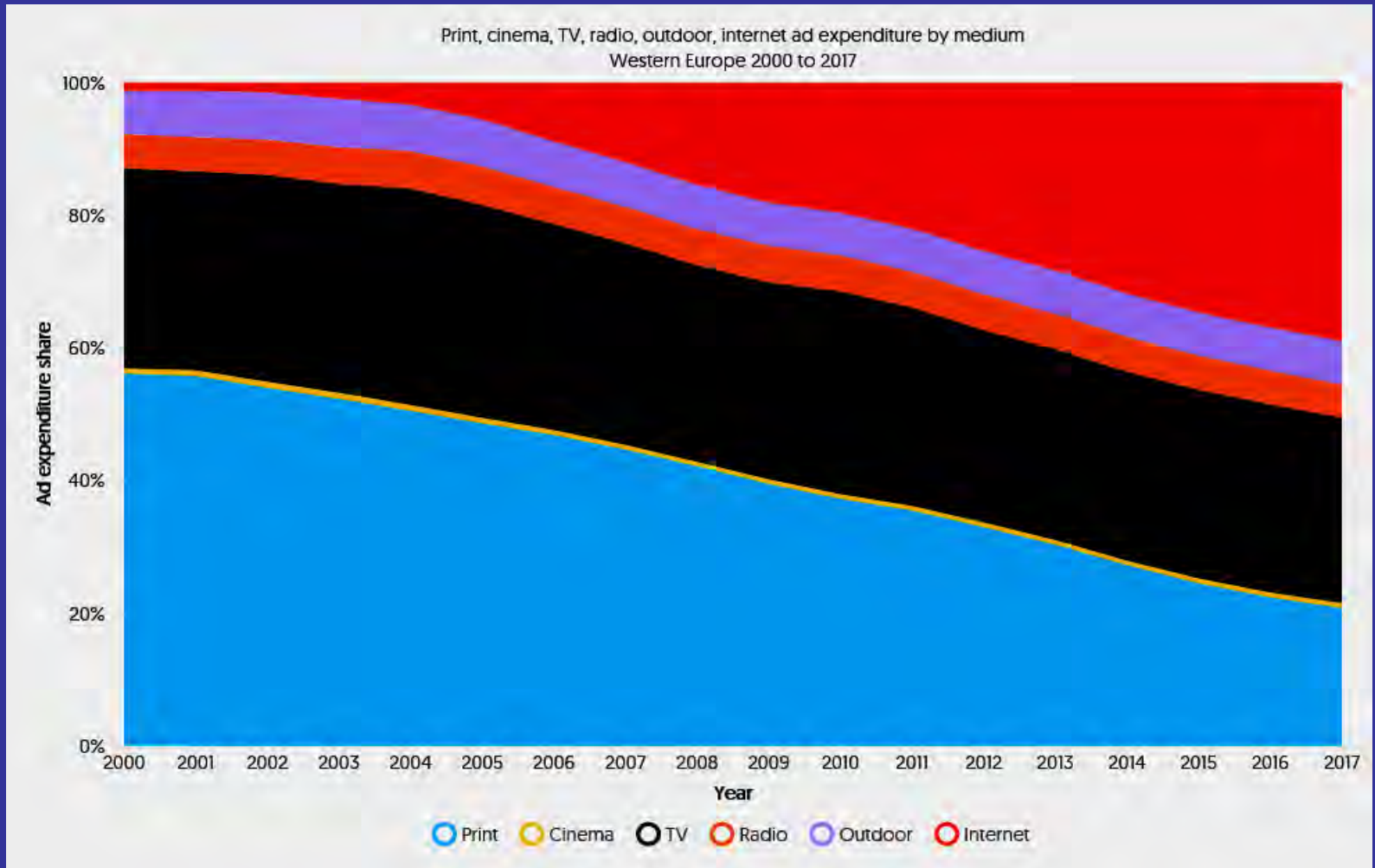
3.3 Is the current state of law of NTTMs to academic, and if so, what can be done?



3.1 Why does Industry and Commerce need NTTMs?

Advertising trends this Millennium in Western Europe (AT, BX, Ch, DE, DK, ES, FI, FR, IR, IT, NO, PT, SE, UK) from

<http://adforecast.zenithmedia.com/Charts/ChartsWP.aspx?chartType=Chart2StackedAreaSpnByMedium>.





3.1 Why does Industry and Commerce need NTTMs?

History: Introducing Color TV ads in European Union since 1967, following radio advertising, Advertising and product placement becomes multimedial & interactive requiring NTTMs



For supermarket

For shopping mall

china-did.en.alibaba.com



For restaurant



For hotel





3.1 Why does Industry and Commerce need NTTMs?

Conclusion:

Industry and commerce need and use NTTMs as source identifiers and have registered NTTMs, at least as far as it could be displayed visually, now electronically, the old fashion way and much easier by the end of this year.

As far as smells are concerned some firms use it e.g. the additional coffee smell at Starbucks and some car producers using true leather scent to advertize their cars and SUVs but at present and even under Council Regulation (EC) No 207/2009 legislation no smells, taste and haptics trade marks will overcome the burden for registration “**reproduced on the register**” at the EUIPO.



3.2 Should judicial decision taking in Trade Marks cases keep pace with technology, and if so, how?

Current File requirement for NTTM annexes at EUIPO

Sounds: mp³-file (Size: <= 2 MB)

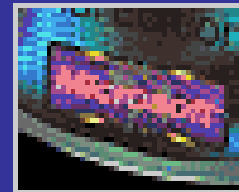
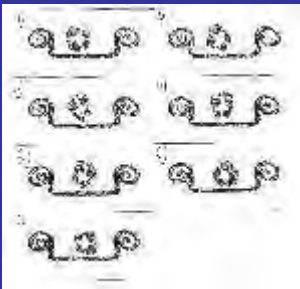
Picture, 3D, motion picture ...:jpg-file, (Size: <= 2 MB, resolution: = > 96 dpi to 300 dpi, max.: 2835 x 2008 pixels)

Fresh Art. 3 No. 3h to 3j EUTMR requires the filing of motion picture trade marks either with a video file annex only, or animation and hologram trade marks with a series of sequential still images / views or a video file.

By today neither type of video file nor upper size limit of annex have been defined in the guideline for examination and of only 2 MB will show very small sized videos e.g. in mp4 format which may not meet the SIECKMANN Criteria set in Art. 3 Nr. 1 EUTMR..

Concise Oxford English Dictionary [11th Ed) [on CD ROM] would favor that **animated gif** files be included as video files stating **video**

n noun (plural **videos**) the system of recording, reproducing, or broadcasting moving visual images on or from videotape. -a film or other recording on videotape. -a video cassette. -British a video recorder. **Samples of animated gif**



(c) PA Dr. Sieckmann Copat



3.2 Should judicial decision taking in Trade Marks cases keep pace with technology, and if so, how?

Conclusion:

Access granted for registration more easily now for motion picture, animation and hologram trade marks but access denied for registration, still for technical reasons, for smells, tastes and haptics trade marks, under Council Regulation (EC) No 207/2009, current version.



3.3 Is the current state of law of NTTMs to academic, and if so, what can be done?

In the field of non electronic displayable NTTM such as smells, tastes these trade marks are not perceived on distance but only at close distance (smells) or when swallowed (taste). So they can for technical reasons *as such* never be reproduced in the register as required under Art. 3 No 1 EUTMR.

However, any smell {or taste] coming from pure chemical compounds is available for the competent authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor. The only thing they have to do is to obtain it through a global network of reseller of fine chemicals. You only need to know the **chemical name** of the smell or taste trade mark, since product numbers are subject to change.

Example: You have created a smell trade mark as well as a taste trade mark in the field of nutraceutical both having a pleasant smell and taste of **menthol additive**.

From the field of chewing mint chewing gum and using tissue handkerchiefs having a fresh smell of mint also referred to as menthol smell and taste impressions of menthol are common general knowledge for the competent authorities and the public in the European Union. But you need to reproduce this smell / taste, but how to do it in practise?



3.3 Is the current state of law of NTTMs to academic, and if so, what can be done?

You go on a portal of a fine chemical reseller www.sigmaaldrich.com chose your home country in the European Union e.g. the United Kingdom, enter **Menthol** into the search mask to order Menthol and you have the sample within a week..

The screenshot shows the Sigma-Aldrich website search results for 'Menthol'. The search term is 'Menthol' and 29 matches were found. The results are sorted by relevance. The first product is 'M2772 99% (Sigma-Aldrich)'. The second product is '63670 racemic, ≥98.0% (GC) (Aldrich)'. The table below shows the details for the first product.

SKU-Pack Size	Availability	Price (GBP)	Quantity
M2772-5G-A	Available to ship on 07.06.17 - FROM	17.40	0
M2772-100G-A	Available to ship on 07.06.17 - FROM	35.50	0
M2772-500G-A	Only 1 left in stock (more on the way) - FROM	134.50	0

The second product, '63670 racemic, ≥98.0% (GC) (Aldrich)', has the following table:

SKU-Pack Size	Availability	Price (GBP)	Quantity
63670-100G-F	Available to ship on 07.06.17 - FROM	27.40	0
63670-500G-F	Estimated to ship on 05.09.17	109.50	0

For these types of trade marks chemical name in combination with a seller contact may be reproduced on the Trade Mark Register of EUIPO on a piece of paper to the e-files instead of the visual or electronic representation on the register, that's all.



3.3 Is the current state of law of NTTMs too academic, and if so, what can be done?

Conclusion:

Current state of the law on NTTMs is too academic as far as smell and taste trademarks are concerned.

Access for registration smells and tastes trade marks may be re-opened if the requirement of visual / electronic reproduction on the register under Art 3 EUTMR is replaced by reproduction the chemical name of the smell / taste trade mark and where the said chemical compound having the smell / taste as applied for and registered can be obtained from / bought.



Further reading

- <https://www.brainguide.de/Ralf-Sieckmann/publikationen?time=thisYear>
- http://www.country-index.com/articles/article_229.pdf
- <http://www.copat.de/markenformen/si-markenr2001.pdf>
- https://www.brainguide.de/upload/publication/e9/nfh1/04842bb0532744f41854ed3cb44751f1_1311535280.pdf
- <http://ipkitten.blogspot.de/2006/07/taste-that-doesnt-register-its-those.html>
- Rakhal Zaman, Should EU trademark law abolish the requirement for graphic representation?, Doctoral Thesis Kings College London 2016

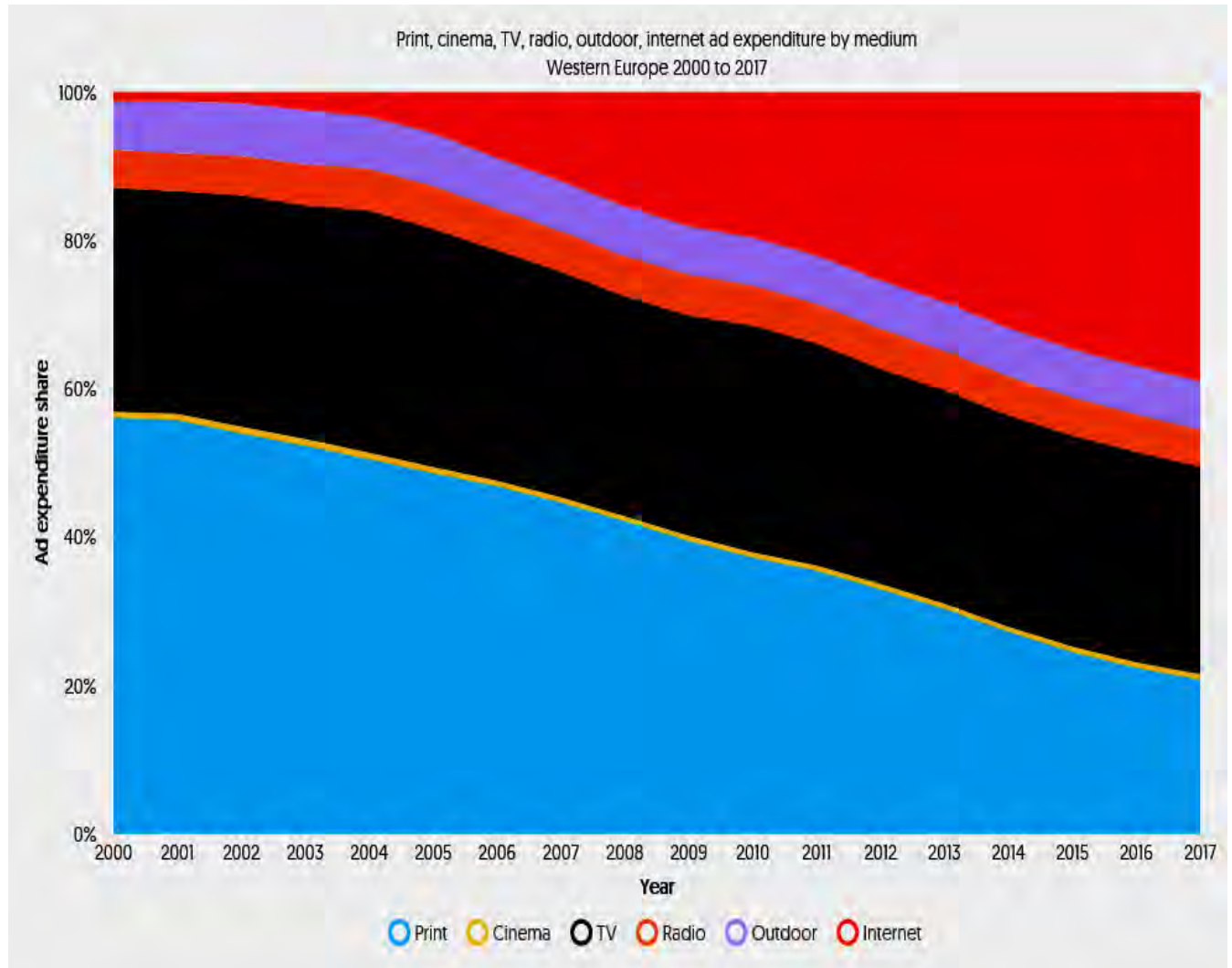
Thanks for your Attention

Notes on Presentation of Ralf Sieckmann, Panellist, at EUCLL EUIPO on 12/6/ 2017

1.1 Why does industry and commerce need NTTMs?

Advertising trends this Century in Western Europe (AT, BX, Ch, DE, DK, ES, FI, FR, IR, IT, NO, PT, SE, UK) from

<http://adforecast.zenithmedia.com/Charts/ChartsWP.aspx?chartType=Chart2StackedAreaSpemByMedium>



Since beginning of this Century electronic ads media (TV (35%), Cinema (0.7), Internet (37%)) have replaced traditional print media (15 %) for promoting clients goods and services in these media

Share of global adspend ^[38]

medium	2015	2017 ^[disputed - discuss]
Television advertisement	37.7%	34.8%
Desktop online advertising	19.9%	18.2%
Mobile advertising	9.2%	18.4%
Newspaper#Advertising	12.8%	10.1%
Magazines	6.5%	5.3%
Outdoor advertising	6.8%	6.6%
Radio advertisement	6.5%	5.9%
Cinema	0.6%	0.7%

History: Introducing Color TV ads in European Union since 1967, following radio advertising

Outdoor Animated Advertising in the EU @ Piccadilly Circus by night since 1980th



Indoor 42 inch (1.07 m) Interactive advertising displays (2010)



Smart phone store offers interactive demonstrations using a wall of touch screens (2013)



Conclusion:

Industry and commerce need and use NTTM and have registered NTTMs, at least as far as it could be displayed visually, now electronically, the old fashion way and much easier by the end of this year.

As far as smells are concerned some firms uses it *e.g.* the additional coffee smell at Starbucks and some car producers using true leather scent to advertize their cars and SUVs but at present and even under no smells, taste and haptic trade mark will overcome the burden for registration “**reproduced on the register**” at the EUIPO.

1.2 Should judicial decision taking in Trade Marks & Design cases keep pace with technology and, if so how?

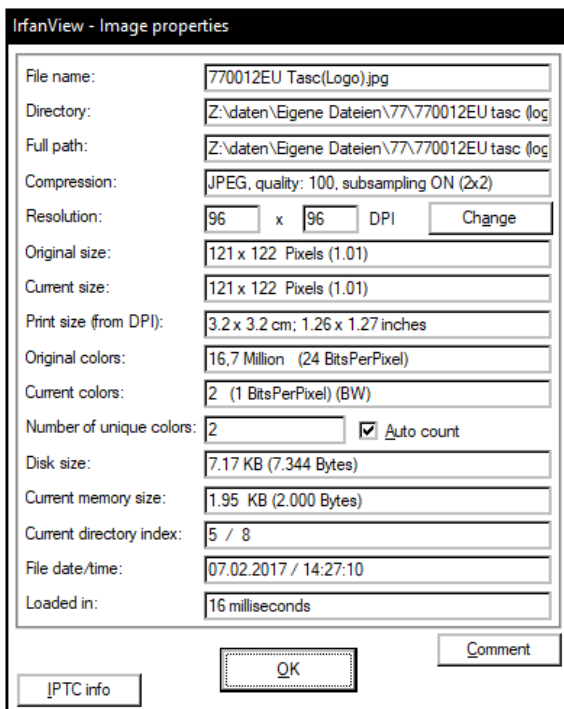
Yes, Of Course.

Practical Example

Current File requirement for NTTM Annexes at EUIPO

Sounds: mp³-file (Size: <= 2 MB)

Picture, 3D, motion picture ...: jpg-file, (size: <= 2 MB, resolution: = > 96 dpi to 300 dpi, max.: 2835 x 2008 pixels)



Minimum sized sample

Prior to e-filing always check file information of annex file under **image properties** beforehand, you may adapt the JPG file lowering the quality in compression if the resolution is high enough, otherwise e-filing system of EUIPO will reject your e-filing request.

Fresh Art. 3 No 3 h to 3 j of EUTMR require filing of motion picture trade marks with a video file annex only, and animation and hologram trade marks with a series of sequential still images / views or a video file.

By today neither type of video file nor upper size limit of annex have been defined in the guideline for examination EUIPO and a size not going beyond 2 MB will show only very small sized videos e.g. in mp4 format which may not satisfy all of the SIECKMANN Criteria set in Art. 3 Nr. 1. EUTMR.

Since type of video file has not been specified further it would be interesting to find out if animation formats having no sound e.g. animated gif format would fall under the definition of video file.

At least definition from Concise Oxford English Dictionary [11th Ed) [on CD ROM] would favour such an interpretation

video

- **noun** (plural **videos**) the system of recording, reproducing, or broadcasting **moving visual images** on or from videotape. >a film or other recording on videotape. >a video cassette. >**British** a video recorder.
- **verb** (**videoes**, **videoing**, **videoed**) make a video recording or film of.

Remember: Original silent film movies became today's radio pictures in the 30th of the last century

So also small sized video format animated gif fall under this definition viewed by common graphical programs such as irfanview, Photoshop

First picture shows stills of motion Trade Mark EUTM 2 857 704 registered for IC 6, 10 and 20 by Danish (medical) device maker Vendlet now purchased by HC Equipment which are of very poor quality in 2004.

Second picture is a animated gif of this motion trade mark obtained from owners portal having a size of only 43 KB perfectly showing for what protection is thought.

Third picture shows EURO banc notes displaying its hologram on the front side on the right hand corner in animated gif format.

Forth picture is a partial view of Microsoft® Office 2007 DVD having a hologram displaying alternatively "Microsoft" and "Genuine" depending on the angle in which you view the data carrier in animated gif format..

Fifth picture is a hologram displaying a 3D version of a weapon. You can buy these types of 3D holograms showing objects in great department stores or on the www.

Conclusion:

Access granted for registration more easily now for motion picture, animation and hologram trade marks but access denied, still for technical reasons, for smells, tastes and haptics trade marks, under Council Regulation (EC) No 207/2009, current version.

1.3 Reserve question: How can the practical needs of industry be reconciled with the legal concerns of law-makers and decision-takers? In other words, is the current state of the law on NTTMs too academic and, if so, what can be done?

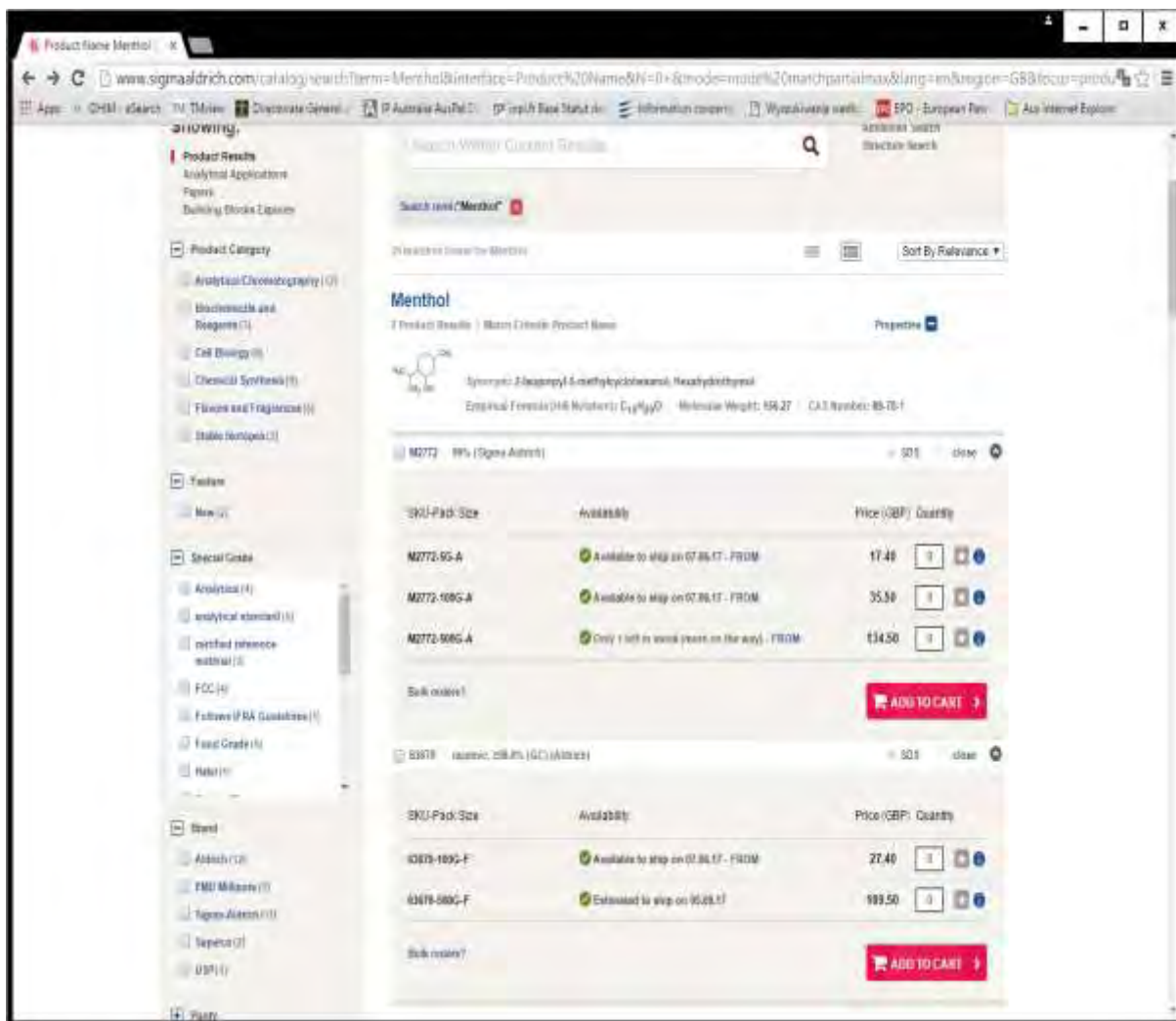
In the field of non electronic displayable NTTM such as smells and tastes these trade marks are not perceived on distance but only at close distance(smells) or when swallowed (taste). So they *can for technical reasons as such* never be reproduced in the register as required under Art. 3 Nr. 1. EUTMR

However, any smell {or taste} is available for the competent authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor. The only thing they have to do is to order it through a global network of reseller of fine chemicals. The only thing you need to know is the **chemical name** of the smell or taste trade mark, since product numbers are subject to change.

Example: You have created a smell trade mark as well as a taste trade mark in the field of nutraceutical both having a pleasant smell and taste of **menthol**.

From the field of chewing mint chewing gum and using tissue handkerchiefs having a fresh smell of mint = menthol the smell and taste impressions of menthol are common general knowledge for the competent authorities and the public in the European Union. But you need to reproduce this smell / taste, but how to do it in practice?

You go on the portal of fine chemical reseller www.sigmaaldrich.com select your home country in the European Community, e.g. the United Kingdom, enter **Menthol** into search mask <http://www.sigmaaldrich.com/catalog/search?term=Menthol&interface=Product%20Name&N=0+&mode=mode%20matchpartialmax&lang=en®ion=GB&focus=productN=0%20220003048%2019853286%2019853121> the following option is displayed for order Menthol and you have a sample within a week.



So for these types of trade marks the chemical name in combination with a seller contact may be reproduced on the trade Mark register of EUIPO on a piece of paper to the e-filed TM instead of the visual or electronic representation on the register, that's all.

You need not to fear that menthol runs out of stock since as such it is on the market for more than 100 years now.

Conclusion:

Current state of the law on NTTMs is too academic as far as smell and taste trademarks are concerned.

Access for registration smells and tastes trade marks may be re-opened if the requirement of visual / electronic reproduction on the register is replaced by reproduction of the chemical name of the smell / taste trade mark and where the chemical having the smell / taste as applied for and registered can be obtained / bought.

Article 3 Representation of the trade mark from C(2017) 3224 final of 18May2017

1. The trade mark shall be represented in any appropriate form using generally available technology, as long as it can be **reproduced on the register** in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor.

3.

(h) in the case of a trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark (motion mark), the mark shall 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;

(i) in the case of a trade mark consisting of, or extending to, the combination of image and sound (multimedia mark), the mark shall be represented by submitting an audio-visual file containing the combination of the image and the sound;

(j) in the case of a trade mark consisting of elements with holographic characteristics (hologram mark), the mark shall 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.

4. Where the trade mark is not covered by any of the types listed in paragraph 3, its representation shall comply with the standards set out in paragraph 1 and may be accompanied by a description.



Dr. Ralf SIECKMANN

Ralf Sieckmann is German and European Patent and Trade Mark Attorney. He has attended “Law for Patent Attorneys” (Kandidatenkurs Flschbachau) and European Patent law at C.E.I.P.I., Strassbourg. He studied Chemistry at Bochum University and Economics and Law at the Hagen University, School of Economics.

Ralf has been educated at German Patent and Trade Mark Office, at Federal Patents Court, Munich, at the Düsseldorf District Court, Patents Division and the IP Law Firm of von Kreissler Selting Werner in Cologne.

Ralf obtained his diploma (M.Sc.) and his doctoral thesis (Ph.D) at the School of Chemistry at Ruhr-University Bochum in organic photochemistry, passed German Patent Attorneys Examination, the European Qualifying Examination and entered into EUIPO list after its opening.

Ralf was admitted as patent attorney in 1990, for the first 4 years of his professional career worked in Essen, in 1994 joined Cohausz Hannig Borkowski Wißgott, [Patent & Trade Mark Law Firm](#), Duesseldorf and is Head of Chemistry & Trade Marks Division.

He's working for more than 25 years in industrial property rights protection, specialized in patent and trade mark law; management consultancy in IP (patent and trade mark strategies). Specialities: trade marks including new media, chemistry, pharmacy, chemical engineering and related non mechanical fields.

Ralf was lecturer on industrial property at Duesseldorf University for Applied Sciences, School of Arts from 1997 to 2001, and at [School of Electrical Engineering](#) from 2009 to 2012 teaching IP (patents, trade mark, design) to under-graduate students and regularly speaks on trade mark and patents topics. He is Referee @ North Rhine-Westphalia regional competition instance of Youth Researchers (Jugend forscht) since 2004.

He is Co-author of BUSINESS ANGELS (2002), Lesson on Trade Mark Law in INTELLECTUAL PROPERTY (2006 - 2012), Sound Trade and Service Marks – Legal aspects in AUDIO BRANDING (2009), technical coordinator of INTERNATIONALES MARKENRECHT (2007, 2008) and Co-author of Lessons on Madrid Agreement and Protocol, Community Trade Marks after Publication.

Ralf provides [information on non-traditional trademarks](#) worldwide [since 2003](#) after [Landmark Judgment of 12 December 2002 in Case C-273/00](#), (Ralf Sieckmann vs DPMA) on graphic representability of national trade marks and EUTM. This archive has the function to inform and help IP professionals and students in the field of law and economics writing their thesis on this subject matter. It includes comments, books and case law on the said decision and an annual compilation of the said Non-Traditional Trademarks published at the [beginning of every year](#).

He is member of the International Trade Mark Association (INTA), GDCh (German Chemists Society, IP Division) and of other IP-related associations.

For your feedback pls use

 sieckmann@aol.com

 <http://www.brainguide.de/Ralf-Sieckmann>

