



KU LEUVEN CAMPUS BRUSSELS
FACULTY OF LAW
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Characteristically Vague: Clarifying Which ‘Other Characteristics’ May be Excluded Under
Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD

Promotor: Prof. Dr. Marie-Christine
Janssens

Word Count: 16,417

Master’s thesis, submitted by

Richard Menzies

as part of the final examination for the degree of
MASTER OF INTELLECTUAL PROPERTY
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Plagiarism declaration

I confirm that this thesis is my own work, that all ideas contained in the thesis are expressed in my own words and that I have not literally or quasi-literally taken anything over from other texts, except for fragments cited between quotes for which I provided full and accurate bibliographical data.

Richard Menzies

Abstract

The recast Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD extended the absolute grounds for refusal to signs which consist exclusively of ‘other characteristics’ of goods which: i) result from the nature of the goods themselves; ii) are necessary to obtain a technical result; iii) or give substantial value to the goods. These ‘other characteristics’ are permanently excluded from trade mark protection, without the possibility to establish acquired distinctiveness. While the extension of the absolute grounds for refusal beyond shapes to ‘other characteristics’ has apparently created parity between shapes and other signs, it is as yet uncertain which ‘other characteristics’ will be excluded and on what basis they will be excluded. This thesis traces the origins of the addition of the words ‘another characteristic’ and initial reactions to the addition of this additional wording. It is argued that the *public interest* of ‘keeping free’ certain signs for use by all operators which has applied to date concerning shape marks will not necessarily underpin the exclusions concerning ‘another characteristic’. Rather, based on the first opinion of the Advocate General in *Christian Louboutin and Christian Louboutin SAS v Van Haren Schoenen BV* we suggest that the *general interest* of not ‘unduly restricting’ the availability of the characteristic (sign) for other operators may underpin the exclusions concerning ‘another characteristic’. Therefore, in evaluating the application of the exclusions concerning ‘other characteristics’ the determining factor should be whether the characteristic (sign) at issue would confer an ‘unfair advantage’ upon the proprietor by ‘unduly restricting’ the availability of the sign for other operators. This thesis applies this approach to key characteristics (signs) including colour marks, olfactory (smell) marks, sound marks, pattern marks and word marks to illustrate which characteristics are likely to be excluded under the new regime.

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1. Introduction

1.1. Background

Article 4 EUTMR¹ and the counterpart Article 3 EUTMD² state that an EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: distinguishing the goods or services of one undertaking from those of other undertakings; and being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. As the CJEU noted in *Hoffmann-La Roche & Co AG and Hoffmann-la Roche AG v. Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH*, the essential function of a trade mark ‘is to guarantee the identity of the origin of the trade-marked product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products which have another origin’.³ Therefore, trade marks ensure market transparency and aim at ensuring a system of undistorted competition.⁴

However, while trade mark rights may preserve a system of undistorted competition by granting exclusive rights over a given mark, trade mark law has also historically acknowledged that certain signs must not be granted to a single proprietor but must be denied registration and remain in the public domain. Trade mark law therefore embodies a certain tension between exclusivity and the need to allow certain signs to be freely used by all. For example, signs excluded include descriptive signs which are finite in quantity and where the granting of a trade mark would offer the proprietor a significant competitive advantage and a barrier to entry for incumbents. These include signs which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service.⁵ Some commentators have also suggested that culturally

¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [2017] OJ L154 (‘EUTMR’).

² Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L336 (‘EUTMD’).

³ C-102/77 *Hoffmann-La Roche & Co AG and Hoffmann-la Roche AG v. Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH* ECLI:EU:C:1978:108, para 7.

⁴ C-206/01 *Arsenal Football Club plc v Matthew Reed* ECLI:EU:C:2002:651, para 48.

⁵ EUTMR Article 7(1)(c); EUTMD Article 4(1)(c).

significant works should be excluded from trade mark protection and should remain in the public domain.⁶ A further category of marks excluded are shape marks consisting exclusively of shapes which result from the nature of the goods, are necessary to obtain a technical result, or which give substantial value to the goods.⁷

The recast Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD extended the absolute grounds for refusal of a sign beyond shapes to include:

(e) signs which consist exclusively of:

- (i) the shape, *or another characteristic*, which results from the nature of the goods themselves;
- (ii) the shape, *or another characteristic*, of goods which is necessary to obtain a technical result;
- (iii) the shape, *or another characteristic*, which gives substantial value to the goods.⁸

Much debate ensued in the wake of the adoption of the additional wording as to the meaning of the words ‘another characteristic’.⁹ Many of the contributions to the topic were simply ‘topical takes’ or raising concerns about the possible breadth of application of the additional words, which given the vagueness of the wording allows for considerable leeway in interpretation.

However, most interpretations seem based on the assumption that the CJEU’s approach to ‘other characteristics’ will mirror the approach taken to date concerning shape marks when this is still very uncertain.¹⁰ To date, the CJEU has generally taken an “all-or-nothing approach” to the exclusions concerning shape marks.¹¹ Thus, where a shape mark falls within any of the three shape

⁶ See Martin Senftleben, ‘Public Domain Preservation in EU Trademark Law – A Model for Other Regions?’ (2013) 103(4) *The Trademark Reporter* 775; Martin Senftleben, ‘Vigeland and the Status of Cultural Concerns in Trade Mark Law – The EFTA Court Develops More Effective Tools for the Preservation of the Public Domain’ (2017) 48 *International Review of Intellectual Property and Competition Law* 683; Martin Senftleben, ‘A Clash of Culture and Commerce – Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) ch 16.

⁷ EUTMR Article 7(1)(e)(i)-(iii); EUTMD Article 4(1)(e)(i)-(iii).

⁸ Emphasis added.

⁹ To avoid repetition and to enable reference to the plural form, the words ‘another characteristic’ are sometimes referred to in this thesis as ‘other characteristics’, ‘additional words’ or the ‘additional wording’.

¹⁰ Maeve Lynch, ‘Product Configuration Marks: the Shape of Things to Come’ (2017) 12(6) *Journal of Intellectual Property Law & Practice* 465, 471.

¹¹ Natalie Schober, ‘The Function of a Shape as an Absolute Ground for Refusal’ (2013) 44 *International Review of Intellectual Property and Competition Law* 35, 54.

mark exclusions then the ‘keep free’ *public interest* demands that such a mark must remain in the public domain and remain available for use by all competitors on the market.¹² However, the CJEU has in the past set out a ‘lesser form of need to keep free’¹³, namely the *general interest* of not ‘unduly restricting’ the availability of the sign as articulated in *Libertel Groep BV v. Benelux-Merkenbureau*¹⁴ (*‘Libertel’*). Based on the Advocate General’s first opinion in *Christian Louboutin and Christian Louboutin SAS v Van Haren Schoenen BV* (*‘Christian Louboutin AG 1st opinion’*)¹⁵ we propose that this general interest of not ‘unduly restricting’ the availability of the characteristic (sign) for other operators may underpin the exclusions concerning ‘another characteristic’. This is important given that the scope the general interest offers for refusing the registration of a sign is narrower and less draconian than public interest of ‘keeping free’ a sign for use by all. Therefore, this thesis suggests that when considering which ‘other characteristics’ will be excluded under the new regime, the determining factor should be whether the characteristic (sign) at issue would confer an ‘unfair advantage’ upon the proprietor by ‘unduly restricting’ the availability of the sign for other operators.

1.2. Research questions

The central question this thesis seeks to answer is:

- Which characteristics will be caught by the exclusions concerning ‘another characteristic’ under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD?

The following sub-questions arise from this central question:

- What were the initial reactions to the additional words and what does this background suggest about the purpose of the additional words and how to interpret them?
- Will the public interest of ‘keeping marks free for use’ underpin the exclusions concerning ‘other characteristics’ or will the general interest of ‘not unduly restricting’ the availability of the characteristic (sign) at issue underpin the exclusions?

¹² C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* ECLI:EU:C:2002:377, para 78.

¹³ Jeremy Phillips, ‘Trade Mark Law and the Need to Keep Free’ (2005) 36(4) *International Review of Intellectual Property and Competition Law* 389, 393.

¹⁴ C-104/01 *Libertel Groep BV v. Benelux-Merkenbureau* ECLI:EU:C:2003:244 (*‘Libertel’*), para 60.

¹⁵ C-163/16 *Christian Louboutin and Christian Louboutin SAS v Van Haren Schoenen BV* ECLI:EU:C:2017:495 (AG Szpunar, 1st opinion) (*‘Christian Louboutin AG 1st opinion’*).

- On the assumption that the general interest will apply, then how should we interpret the general manner in which the three exclusions (which arose to deal solely with shape marks) will apply to ‘other characteristics’?
- By reference to specific examples, which characteristics are likely to be excluded by virtue of the fact that they confer an ‘unfair advantage’ upon the proprietor in breach of the general interest of not ‘unduly restricting’ the availability of the characteristic (sign) for other operators?

1.3. Objectives

The general objective of this thesis is to ascertain whether the general interest of not ‘unduly restricting’ the availability of the characteristic (sign) at issue may underpin the three exclusions concerning ‘another characteristic’.

The specific objective of this thesis is to determine which characteristics are likely to be excluded under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD by virtue of the fact that if granted they would confer an ‘unfair advantage’ upon the proprietor by ‘unduly restricting’ the availability of the characteristic (sign) for other operators.

1.4. Methodology and structure

The general methodology applied to answer the questions described above includes an in-depth consideration of the following: i) the relevant portions of the Max Planck ‘Study on the overall functioning of the European Trade Mark System’ (the ‘Max Planck Study’);¹⁶ ii) the EUIPO Guidelines;¹⁷ iii) practitioner commentaries; iv) case law (and Advocate General opinions) relevant to shape marks and other non-traditional trademarks; and v) legal doctrine pertinent to shape marks and other non-traditional trade marks.

Specifically, the thesis will apply the following method of analysis:

¹⁶ Max Planck Institute for Intellectual Property and Competition Law, Munich, ‘Study on the overall functioning of the European Trade Mark System’ (2011) (the ‘Max Planck Study’).

¹⁷ European Union Intellectual Property Office, ‘Guidelines for examination of European Union Trademarks, European Union Intellectual Property Office (EUIPO), part B, Examination, section 4, absolute grounds for refusal, chapter 6, shapes or other characteristics resulting from the nature of the goods, with an essentially technical function or substantial value, article 7(1)(e) EUTMR’ (October 2017) (‘EUIPO Guidelines’).

- *Chapter 2* describes the background to the addition of the words ‘another characteristic’ with reference to the Max Planck Study and considers the reactions from legal scholars, the EUIPO, the International Trademark Association (‘INTA’) and legal practitioners.
- *Chapter 3* considers the ‘keep free’ public interest as it has been applied by the CJEU to shape marks in leading shape mark case law. It also considers the possible applicability of the public interest to ‘other characteristics’ and the problems and uncertainties of that approach. Against this background, this chapter analyzes the Advocate General’s comments in *Christian Louboutin AG 1st opinion*. In light of his comments, we propose that the ‘other characteristics’ likely to be excluded are those which confer an ‘unfair advantage’ upon the proprietor in breach of the general interest of ‘unduly restricting’ the availability of the characteristic (sign) for other operators. This stance provides the basis upon which to evaluate which characteristics (signs) are likely to be excluded.
- *Chapter 4* considers in general terms how the three exclusions (characteristics which result from the nature of the goods; characteristics which are necessary to achieve a technical result; and characteristics which give substantial value to the goods) will likely apply to various characteristics. This in order to provide a general framework for discussing when the general interest may apply to exclude certain characteristics (signs).
- *Chapter 5* will by reference to specific categories of characteristics (namely colour marks, olfactory (smell) marks, sound marks, pattern marks, and word marks) and by reference to real and hypothetical cases, evaluate which of those characteristics (signs) are likely to be excluded by virtue of the fact that if granted they would confer an ‘unfair advantage’ upon the proprietor by ‘unduly restricting’ the availability of the characteristic (sign) for other operators.
- *Chapter 6* sets out the conclusion. If characteristics (signs) will only be excluded if they confer an ‘unfair advantage’ by ‘unduly restricting’ the availability of the characteristic at issue, then the number of ‘other characteristics’ excluded may be less than expected.

2. The background to the words ‘another characteristic’ and initial reactions

2.1. Introduction

The purpose of this chapter is to describe the background to the addition of the words ‘another characteristic’ under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD by reference to the Max Planck Study and the legislative process and to consider initial reactions and interpretations by legal scholars, the EUIPO, the International Trademark Association (‘INTA’) and legal practitioners.

2.2. Background and interpretations

The general view amongst scholars seems to be that the additional words are intended to serve as a counterbalance to the elimination of the graphical representation requirement in the new EUTMR and EUTMD.¹⁸ However, this reasoning does not rest of a clear basis. First, if the additional words are a necessary corollary of the deletion of the graphic representation requirement then they should appear simultaneously in the legislative process. However, the additional words do not appear in the European Commission’s Proposals for the new EUTMR and EUTMD when the requirement for graphical representation was first removed and instead appear later in the legislative process.¹⁹ Second, the words ‘another characteristic’ covers colour marks *per se* but such marks may satisfy the graphical representation requirement by reference to an international code.²⁰ It is difficult to believe that the inclusion of the additional words can be satisfactorily explained solely as a counterbalance to the elimination of the graphical representation requirement.

Indeed, the Max Planck Study which was intended to provide the European Commission with an opinion of the overall functioning of the Community and national trade mark system in Europe

¹⁸ Maeve Lynch, ‘Product Configuration Marks: the Shape of Things to Come’ (2017) 12(6) *Journal of Intellectual Property Law & Practice* 465, 471; Anders Poulsen, ‘Adding Substantial Value to Shapes – Why This Absolute Ground Should be Abolished’ *World Trademark Review* (London 1 September 2017) <www.worldtrademarkreview.com/portfolio-management/adding-substantial-value-shapes-why-absolute-ground-should-be-abolished> accessed 28 October 2018.

¹⁹ Commission, ‘Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the member states relating to trade marks’ COM (2013) 162 final; Commission, ‘Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark’ COM (2013) 161 final.

²⁰ *Libertel*, para 68.

(the source of both the suggested removal of the graphical representation requirement and the inclusion of the additional words) does not link the two suggestions. Rather, the Max Planck Study states that extending the permanent exclusion beyond shapes to all kinds of signs is intended to ensure that shapes and other signs are treated in the same manner:

Nevertheless, the confinement of the permanent exclusion clauses to shapes might be too narrow. For instance, the corresponding exclusion clause for functional signs in US trade mark law does not contain any such restrictions, but can be applied to all kinds of signs, like colours, smells, or sounds. Whereas the practical relevance of the exclusion clause for such other forms of signs may be much smaller in practice than for shape marks, there is no pertinent reason for generally excluding other signs from its ambit.²¹

However, it is worth bearing in mind that the legislator declined the Max Planck Study's recommendation that the exclusion concerning shapes which give substantial value to the goods should be deleted.²² The exclusion was instead retained concerning shape marks and extended to 'another characteristic' which gives substantial value to the goods. Nevertheless, what is interesting about the Max Planck Study is that the avowed purpose of extending the permanent exclusions to 'all kinds of signs' is to achieve parity between shapes and any other 'kinds of signs' (in accordance with US trade mark law). Furthermore, the Max Planck Study's conflation of shapes with other signs suggests that they share the same rationale for exclusion.

The EUIPO Guidelines only briefly address the meaning of the additional words. According to the EUIPO Office 'most of the trade marks that fall foul of the new wording of this provision are currently objectionable under Article 7(1)(b) and/or (c) EUTMR, as they are descriptive or otherwise non-distinctive' while noting that marks caught by the permanent exclusion cannot rely on acquired distinctiveness to overcome the prohibition.²³ The EUIPO Office offers the following invented examples: 'a sound mark representing the sound of a motorbike for *motorbikes* could be captured by Article 7(1)(e)(i) EUTMR if the sound results from the nature of the goods (in the sense of its technical performance)'.²⁴ The sound of a motorbike is also used as an example of a mark excluded by virtue of giving substantial value to the goods as 'that may be appealing to a

²¹ Max Planck Study, para 2.31.

²² Max Planck Study, para 2.34.

²³ EUIPO Guidelines, para 1.

²⁴ EUIPO Guidelines, para 2 (emphasis in original).

significant part of the relevant public to the extent that it may indeed affect the consumer's choice of purchase'.²⁵ A further example of a sign that consists exclusively of 'other characteristics' resulting from the nature of the goods is 'an olfactory mark of a scent for a *perfume*.'²⁶ An example of another characteristic necessary to obtain a technical result may include 'a sound mark for insect repellents [which] may be objected to under Article 7(1)(e)(ii) EUTMR if the sound in fact repels insects'.²⁷ In the absence of guidance from the CJEU, the EUIPO Guidelines adopt a cautious approach to interpreting the meaning of the additional wording and the examples offered are largely drawn from the Max Planck Study and uncontroversial, with the notable absence of colour marks (which are specifically mentioned in the Max Planck Study) as an example of a possibly excluded sign.

In the wake of the European Council's publication of the Presidency Compromise proposals on the EUTMD and EUTMD, INTA offered strong opposition to the additional words arguing 'This would open up Article 7(1)(e) to all signs, not just certain shape/3D marks. All trade marks (including word marks) would also be vulnerable to challenge on the basis that they give substantial value to the goods'.²⁸ INTA's view of the scope of the additional wording is considerably broader than the EUIPO, extending even as far as word marks.

Scholarly articles interpreting the meaning of the words 'another characteristic' are largely lacking, but some practitioners have ventured to speculate as to the meaning of the wording. By way of example, one practitioner focusing on other characteristics adding substantial value suggests that word marks referring to ancient deities (and thereby to their associated virtues of strength, etc.) might conceivably be refused registration since those divine attributes add substantial value to the goods.²⁹ Furthermore, aesthetically pleasing device marks or colours rendering the product more attractive to customers might also be refused registration as they add substantial value to the goods. Another practitioner noted that Article 7(1)(e) EUTMR may 'become a serious threat to the registration of nontraditional marks, as well as other types of marks' and Article 7(1)(e)(iii) of the

²⁵ EUIPO Guidelines, para 4.

²⁶ EUIPO Guidelines, para 2 (emphasis in original).

²⁷ EUIPO Guidelines, para 3.

²⁸ INTA, 'EU Trade mark Reform – Community Trade Mark Regulation - INTA Comments' (November 2014), 26. Unpublished but available upon request from Christina Sleszynska, INTA Europe Representative, at csleszynska@inta.org.

²⁹ David Flynn, 'Uncharacteristic Characteristics Giving Substantial to Value to Goods' (14 March 2017) <<http://frkelly.com/uncharacteristic-characteristics-giving-substantial-value-goods>> accessed 4 April 2019.

EUTMR could ‘become a serious threat to the registration of a color per se or color combination trademarks’.³⁰

It is clear that there are a wide variety of different opinions concerning the meaning and purpose of the additional wording, but none offer a satisfactory explanation as to the rationale behind the exclusions nor in which circumstances the exclusions will apply. The Max Planck Study suggests that ‘all kinds of signs’ should be treated in the same manner as shape marks (seemingly suggesting that ‘all kinds of signs’ should be excluded for the same reasons as shape marks are excluded). However, given the multiple forms ‘other characteristics’ may take and the effect they may exert on other market operators if registered in comparison to shape marks, it is uncertain whether ‘other characteristics’ can (or will) simply be treated in exactly the same way as shape marks. Therefore, the following chapter will consider the CJEU’s approach to shape marks and considers whether the CJEU will necessarily adopt the same approach to ‘other characteristics’.

3. Determining whether the public interest or the general interest will apply to the exclusions concerning ‘another characteristic’

3.1. Introduction

At present, the relevance (or irrelevance) of shape mark case law for the exclusions regarding ‘another characteristic’ is uncertain.³¹ Accordingly, a detailed analysis of the manner in which the CJEU has approached the various shape mark exclusions may not prove particularly valuable in determining precisely which ‘other characteristics’ may be excluded under the new regime. What may prove fruitful is to consider is whether the *public interest* of ‘keeping free’ signs which fall within the three exclusions will continue to apply to the exclusions concerning ‘other characteristics’. Past practice of the CJEU indicates that if any of the three shape marks exclusions has been satisfied then the sign cannot be registered as a trade mark and must be ‘kept free’ for use by other operators.³² If this ‘keep free’ *public interest* applies to the exclusions concerning

³⁰ Taras Kulbaba, ‘EU Trademark Law Reform Series: Implications for Nontraditional Marks’ (5 April 2016) <<https://www.petosevic.com/resources/articles/2017/12/3442>> accessed 23 April 2019.

³¹ Maeve Lynch, ‘Product Configuration Marks: the Shape of Things to Come’ (2017) 12(6) *Journal of Intellectual Property Law & Practice* 465, 471.

³² Peter Turner-Kerr, ‘EU intellectual Property Law: Recent Case Developments’ (2004) 4 *Intellectual Property Quarterly* 448, 471.

‘another characteristic’ then it suggests that a wide swath of ‘other characteristics’ will be excluded.

However, the Advocate General in *Christian Louboutin AG 1st opinion* suggests that the *general interest* of not unduly restricting the signs available for the other operators who offer for sale goods or services of the same type (as articulated in *Libertel*) may apply in place of the *public interest*. This is an important distinction as *Libertel* does not refer to keeping signs available to be ‘freely used by all’ but instead to not ‘unduly restricting’ their availability.³³ Therefore, the *general interest* objective of not ‘unduly restricting’ the availability of certain characteristics (signs) is necessarily less restrictive than a *public interest* objective whose objective is to keep such characteristics (signs) freely available for use by all.³⁴ This distinction between the public interest and the general interest is of crucial importance for the exclusions concerning ‘another characteristic’ as it may indicate that the scope of the exclusions is limited to circumstances where the registration of the characteristic ‘unduly restricts’ the availability of the characteristic at issue for other operators.

Therefore, this chapter briefly traces the manner in which the CJEU has applied the ‘keep free’ public interest through three key cases, beginning with its first expression in *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (‘*Philips*’)³⁵ and onward through *Lego Juris v. OHIM* (‘*Lego*’),³⁶ and *Hauck GmbH & Co. KG v. Stokke A/S* (‘*Hauck*’).³⁷ This in order to discuss the CJEU’s approach and the problems and uncertainties concerning the application of the ‘keep free’ public interest for the exclusions concerning ‘another characteristic’. Next, we consider the Advocate General’s comments in *Christian Louboutin AG 1st opinion* concerning the possibility of the *Libertel*-style general interest of not ‘unduly restricting’ the availability of signs applying to the exclusions concerning ‘another characteristic’. Based on the Advocate General’s opinion it is proposed that we consider how the general interest of not ‘unduly restricting’ the availability of signs may determine which ‘other characteristics’ are likely to be excluded.

³³ Peter Turner-Kerr, ‘EU intellectual Property Law: Recent Case Developments’ (2004) 4 Intellectual Property Quarterly 448, 468.

³⁴ See AG Jacobs comments in C-329/02P *SAT.1 SatellitenFernsehen GmbH v European Union Intellectual Property Office* ECLI: EU:C:2004:532 (AG Jacobs opinion), para 28.

³⁵ C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* ECLI:EU:C:2002:377 (‘*Philips*’).

³⁶ C-48/09 *Lego Juris v. OHIM* ECLI:EU:C:2010:516 (‘*Lego*’).

³⁷ C-205/13 *Hauck GmbH & Co. KG v. Stokke A/S* ECLI:EU:C:2014:2233 (‘*Hauck*’).

3.2. The ‘keep free’ public interest and shape marks

The earliest CJEU case considering shape marks was *Philips*, a case concerning a three-headed rotary electric shaver for which Philips filed a trademark application consisting of a graphic representation of three circular heads with rotating blades in the shape of an equilateral triangle. The CJEU held that the grounds of refusal under Article 3(1)(e) First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks³⁸ (‘CTMD’) must be interpreted in light of the public interest underlying them, which is:

to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 3(1)(e) is thus intended to prevent the protection conferred by the trade mark right from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.³⁹

In particular, concerning the second indent of Article 3(1)(e) CTMD:

that provision is intended to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product.⁴⁰

Philips confirmed that the rationale underpinning all three exclusions under Article 3(1)(e) is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors.⁴¹ Uma Suthersanen notes that in taking this approach, ‘the Court is advocating a

³⁸ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [1989] OJ L40/01.

³⁹ *Philips*, para 78.

⁴⁰ *Philips*, para 79.

⁴¹ *Philips*, para 78.

wider approach which veers towards a broader market-based construction of Art.3(1)(e) which acknowledges the interface between this provision and effective competition within the market place’ and cites the importance of this approach in the ‘maintenance of market freedom’.⁴² Indeed, as Suthersanen notes, the CJEU clearly advocates a ‘free for others to use’ doctrine⁴³ in its strong emphasis on the fact that technically functional shapes which ‘were chosen to fulfil that function’ should ‘be freely used by all’ and that the registration of such signs should not ‘limit their [competitors’] freedom of choice’.⁴⁴ Furthermore, the CJEU also held that the existence of other shapes which could achieve the same technical result as the Philips shaver could not overcome the technical result exclusion.⁴⁵ It was clear in *Philips* that the CJEU wished to widen the scope of the functionality exclusion in order to realize the ‘the public interest in keeping functional signs free from being “monopolised” by one undertaking’.⁴⁶

The approach in *Philips* was subsequently confirmed in *Lego*, which concerned Lego’s attempt to register the famous Lego toy-brick shape as a trade mark. Rejecting Lego’s argument that the presence of alternative shapes to their Lego brick (e.g. round, oval or star-shaped) capable of achieving the same technical result ensured that their registered shape mark would not restrict the availability of the technical solution incorporated therein, the CJEU noted that a shape trade mark would afford Lego a monopoly over both identical and similar shapes. This meant that a significant number of shapes would be unavailable for use by competitors.⁴⁷ Turning to the Lego brick in question, the CJEU rejected Lego’s argument that the fact that competitors did not need to place on the market toy bricks whose shape and dimensions were identical to the Lego brick could overcome the application of the technical result exclusion.⁴⁸ The CJEU held that that conclusion applied ‘a fortiori in a case of this kind, where it has been found by the competent authority that the solution incorporated in the shape of goods examined is the technically preferable solution for the category of goods concerned’ as it would be difficult for the competitors of the proprietor to

⁴² Uma Suthersanen, ‘The European Court of Justice in *Philips v Remington* - Trade Marks and Market Freedom’ (2003) 7 Intellectual Property Quarterly 257, 269, 283.

⁴³ Uma Suthersanen, ‘The European Court of Justice in *Philips v Remington* - Trade Marks and Market Freedom’ (2003) 7 Intellectual Property Quarterly 257, 269.

⁴⁴ *Philips*, paras 79, 80.

⁴⁵ *Philips*, paras 81, 83.

⁴⁶ Ilanah Fhima, ‘The Public Interest in European Trade Mark Law’ (2017) Intellectual Property Quarterly 311, 314.

⁴⁷ *Lego*, paras 54-56.

⁴⁸ *Lego*, para 59.

place on the market shapes of goods constituting a real alternative.⁴⁹ Again, as in *Philips*, the approach by the CJEU is ‘explicitly identified as being justified by the underlying public interest in keeping certain marks free for other undertakings to use’.⁵⁰

In *Hauck*, the Court again applied the public interest of keeping free certain characteristics for use by other operators, this time concerning the application of Article 3(1)(e) CTMD first indent (which excludes shapes which result from the nature of the goods themselves). The Court held that this indent did not apply only to signs which consist exclusively of shapes which are indispensable to the function of the goods in question but also to shapes with essential characteristics which are inherent to the generic function or functions of such goods. This exclusion was necessary as ‘reserving such characteristics to a single economic operator would make it difficult for competing undertakings to give their goods a shape which would be suited to the use for which those goods are intended’. Therefore, the Court held that the first indent

must be interpreted as meaning that the ground for refusal of registration (...) may apply to a sign which consists exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors.⁵¹

The Court’s reasoning here clearly echoes the reasoning in *Philips* and *Lego* concerning the second indent and emphasizes the public interest of keeping certain characteristics free irrespective of the availability of alternative shapes where the shape arises from the nature of the goods.⁵²

In *Hauck*, the CJEU also took a particularly ‘expansive approach’⁵³ to the exclusion concerning shapes which give substantial value to the goods. The CJEU placed heavy emphasis upon ensuring that the perpetual monopoly granted by trade mark rights did not serve to extend time-limited rights.⁵⁴ Therefore, the Court stated that the realization of this aim (the non-perpetuation of time-

⁴⁹ *Lego*, para 60.

⁵⁰ Ilanah Fhima, ‘The Public Interest in European Trade Mark Law’ (2017) *Intellectual Property Quarterly* 311, 315.

⁵¹ *Hauck*, para 26.

⁵² Ilanah Fhima, ‘The Public Interest in European Trade Mark Law’ (2017) *Intellectual Property Quarterly* 311, 316.

⁵³ Ilanah Fhima, ‘The Public Interest in European Trade Mark Law’ (2017) *Intellectual Property Quarterly* 311, 317.

⁵⁴ Antoon Quaedvlieg, ‘Shapes With a Technical Function: an Ever-expanding Exclusion’ (2016) 17 *ERA Forum* 101, 108. The practical consequence of the decision in *Hauck* and the focus upon the non-perpetuation of time-limited rights has been to drive practitioners to avoid filing design applications for shape trade marks. See Gabrielle Engels and Claire Lehr, ‘Sweets, Cars and Bottles – Three-Dimensional Trade Marks’ (2017) 12(9) *Journal of Intellectual Property Law & Practice* 797, 800.

limited rights) may warrant the application of the substantial value exclusion ‘when, in addition to its aesthetic function, the product concerned also performs other essential functions’.⁵⁵ Further, when assessing the applicability of the substantial value exclusion, the Court provided a laundry list of factors which could serve to exclude a shape mark.⁵⁶

Clearly past practice of the CJEU indicates that any shape (sign) which falls within any of the three shape mark exclusions is categorically excluded as the public interest demands that such signs must be ‘kept free’ for use by other operators. More specifically, shapes falling under the substantial value exclusion and susceptible to time-limited rights are very likely to be excluded. The CJEU’s focus on the public interest of keeping certain shape marks free for use and avoiding the non-perpetuation of time-limited rights creates grave uncertainties as to how signs being ‘another characteristic’ will be treated. For example, will signs falling within the bare letter of the three exclusions be automatically barred from registration out of hand or will there be additional considerations to take into account? How will substantial value-giving characteristics (such as patterns) susceptible to copyright be treated given that there is no fundamental objection to the cumulative existence of copyright and trade mark rights⁵⁷ (for example they co-exist in device marks). How will substantial value-giving characteristics not protected by time-limited rights (such as sound, smell and colour) be treated under the new regime? A further complication noted by Maeve Lynch is that it is uncertain whether existing shape mark case law will even apply at all to the exclusions concerning ‘another characteristic’ given that the current version of the EUIPO Guidelines no longer states that case law concerning shape marks is applicable to the exclusions concerning ‘another characteristic’.⁵⁸

This creates a quandary as to how to approach the exclusions concerning ‘another characteristic’. A possible resolution may be found in the Advocate General’s comments in *Christian Louboutin AG 1st opinion* in which he introduces the possibility of the *Libertel*-style general interest of not

⁵⁵ *Hauck*, para 32.

⁵⁶ *Hauck*, para 35. In addition to the public’s perception of the value of the shape, the factors to be taken into account include the nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.

⁵⁷ Charles Gielen, ‘Substantial Value Rule: How it Came Into Being and Why it Should be Abolished’ (2014) 36(3) *European Intellectual Property Review* 164, 169.

⁵⁸ Maeve Lynch, ‘Product Configuration Marks: the Shape of Things to Come’ (2017) 12(6) *Journal of Intellectual Property Law & Practice* 465, 471.

‘unduly restricting’ the availability of signs determining which ‘other characteristics’ should be excluded. Therefore, the next section considers the Advocate General’s comments in detail and the implications of the applying the *Libertel*-style general interest of not ‘unduly restricting’ the availability of signs to the exclusions concerning ‘another characteristic’.

3.3. *Christian Louboutin AG 1st opinion* and the general interest

In *Christian Louboutin AG 1st opinion*, the Advocate General sets out the rationale underpinning the exclusions concerning signs which are indissociable from the appearance of the goods. He states that the ‘registration of such a sign as a trade mark may limit the ability of other undertakings to bring competing products onto the market’ and goes on to note that this rationale ‘underlies the specific legislation, contained in Article 3(1)(e) of Directive 2008/95, applicable to signs consisting of the shape of the goods’.⁵⁹ Continuing, he states:

I observe that these considerations apply equally, *mutatis mutandis*, in relation to other signs which represent an aspect of the goods in respect of which registration is sought.

Thus, the Court has pointed out that signs consisting of colours *per se* give rise, in principle, to the same objections with regard to the risk of practical characteristics of goods being monopolised. In this regard, the need for a specific approach was recognised in *Libertel*.⁶⁰

Subsequently, when discussing the applicability of Article 3(1)(e) of Directive 2008/95⁶¹ (the exclusion concerning shape marks) to marks consisting of a colour *per se*, he considers *Libertel*⁶² and notes that when assessing the registrability of colours ‘it is necessary to assess whether the

⁵⁹ *Christian Louboutin AG 1st opinion*, paras 21, 22.

⁶⁰ *Christian Louboutin AG 1st opinion*, paras 23, 24 (paragraph references omitted).

⁶¹ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299.

⁶² The complete relevant paragraphs (54-55) of *Libertel* read as follows:

‘As regards the registration as trade marks of colours *per se*, not spatially delimited, the fact that the number of colours actually available is limited means that a small number of trade mark registrations for certain services or goods could exhaust the entire range of the colours available. Such an extensive monopoly would be incompatible with a system of undistorted competition, in particular because *it could have the effect of creating an unjustified competitive advantage for a single trader*. Nor would it be conducive to economic development or the fostering of the spirit of enterprise for established traders to be able to register the entire range of colours that is in fact available for their own benefit, to the detriment of new traders.

Accordingly, (...) in assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to *the general interest in not unduly restricting the availability of colours for the other traders* who offer for sale goods or services of the same type as those in respect of which registration is sought. (emphasis added, paragraph references omitted).

registration of that sign would run counter to *the general interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type*'.⁶³ Interestingly, he states that 'the judgment in *Libertel* was essentially taking into account the same objective as underpins Article 3(1)(e) of Directive 2008/95'.⁶⁴ In other words, the Advocate General conflates the *general interest* of not unduly restricting the availability of colours (which underpins the exclusion of non-distinctive colour marks under 4(1)(b) EUTMD and 7(1)(b) EUTMR) with the *public interest* of keeping certain marks free for use by all operators the market.

This statement bears careful consideration. As discussed in relation to shape marks, once a shape mark falls within any of the three exclusions then that shape cannot be protected and must be kept free for use by all competitors on the market. However, this 'keep free' *public interest* is not the same as the *general interest* of avoiding undue restriction as articulated in *Libertel*. As Jeremy Phillips notes, the *Libertel* general interest of not unduly restricting availability is 'a lesser form of the need to keep free'.⁶⁵ Differentiating the 'keep free' public interest from the general interest, he writes it is 'clear that (i) *the general interest in avoiding undue restriction is not the same as the public interest in keeping signs free and that (ii) the scope it offers for refusing registration to a trade mark application is correspondingly narrower*'.⁶⁶ Thus, the general interest is intended to avoid unduly restricting the options available for the other operators who offer for sale goods or services of the same type rather than keeping certain signs free for use.⁶⁷

Therefore, it seems probable that the Advocate General is encouraging a narrower approach to applying the exclusions under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD by his statement that *Libertel* pursues the same objective 'as underpins Article 3(1)(e)'. Indeed, the Advocate General's subsequent statement concerning the rationale for the exclusion for shape marks giving substantial value suggests that he has the narrower general interest in mind. According to the Advocate General 'the provision in question is designed to (...) *prevent the*

⁶³ *Christian Louboutin AG 1st opinion*, para 45 (emphasis added).

⁶⁴ *Christian Louboutin AG 1st opinion*, para 47 (emphasis added).

⁶⁵ Jeremy Phillips, 'Trade Mark Law and the Need to Keep Free' (2005) 36(4) *International Review of Intellectual Property and Competition Law* 389, 393.

⁶⁶ Jeremy Phillips, 'Trade Mark Law and the Need to Keep Free' (2005) 36(4) *International Review of Intellectual Property and Competition Law* 389, 393 (emphasis added).

⁶⁷ Jeremy Phillips, 'Trade Mark Law and the Need to Keep Free' (2005) 36(4) *International Review of Intellectual Property and Competition Law* 389, 393.

*protection conferred by the mark being used to gain an unfair advantage*⁶⁸ which strongly echoes the judgment in *Libertel* where the CJEU held that a monopoly over a single colour might need to be avoided as it ‘could have the effect of creating *an unjustified competitive advantage* for a single trader.’⁶⁹

The Advocate General’s opinion suggests that the future scope of the exclusions under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD may be narrower and guided by the general interest of avoiding unduly restricting the options available for the other operators, at least concerning ‘another characteristic’. Of particular note is the Advocate General’s specific reference to the exclusion of colours (which are likely to be covered by the exclusion concerning ‘another characteristic’⁷⁰) under the *Libertel*-style general interest. This may indicate a rapprochement between the *Libertel*-style exclusion under 7(1)(b) EUTMR and 4(1)(b) EUTMD and the exclusions concerning colours and ‘other characteristics’ under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD.⁷¹

Therefore, we argue that the Advocate General’s opinion may have significance for determining when the exclusions concerning ‘another characteristic’ may apply. In light of the Advocate General’s opinion, one possible approach to determining which ‘other characteristics’ may be excluded is to consider whether the registration of the characteristic (sign) at issue would confer an ‘unfair advantage’ upon its proprietor by unduly restricting the availability of the characteristic (sign) at issue for the other operators who offer for sale goods or services of the same type.⁷² A relevant consideration in determining whether ‘unfair advantage’ is conferred by ‘unduly

⁶⁸ *Christian Louboutin AG 1st opinion*, para 71.

⁶⁹ *Libertel*, para 54 (emphasis added).

⁷⁰ Max Planck Study, para 2.31.

⁷¹ Commentators have long accepted that the rationale in *Libertel* may have significance beyond colour marks, see Peter Turner-Kerr, ‘EU intellectual Property Law: Recent Case Developments’ (2004) 4 Intellectual Property Quarterly 448, 474.

⁷² Such an approach based on ‘unfair advantage’ is of course not new and has parallels in US law. For example, Graeme Dinwoodie in his paper proposing a teleological approach to trade mark law argues that trade mark protection should not depend upon its categorical categorization but ‘upon whether protection of the particular symbol would accord the producer a practical monopoly and prevent effective competition by others (i.e., whether the matter is ‘functional’), see Graeme Dinwoodie, ‘The Death of Ontology: A Teleological Approach to Trademark Law’ (1999) 84 Iowa Law Review 611, 617. Followers of Dinwoodie’s approach such as Annette Kur, suggest that the registrability of a trade mark be determined by whether it would ‘liable to impede, or even exclude, efficient and meaningful competition’, see Annette Kur, ‘Too Pretty to Protect? Trade Mark Law and the Enigma of Aesthetic Functionality’ (2011) Max Planck Institute for Intellectual Property and Competition Law Research Paper No. 11-16 1, 22 <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1935289> accessed 15 March 2019.

restricting' the availability of options available for the other operators is whether the characteristic (sign) at issue is unique or whether there are good alternative options available to other operators.⁷³ Therefore, the following chapters of this thesis consider which 'other characteristics' are likely to be excluded (or not) by the application of the *Libertel*-style general interest of avoiding 'unduly restricting' the options available for the other operators who offer for sale goods or services of the same type.

4. Determining how the exclusions concerning 'another characteristic' will likely apply in general terms

4.1. Introduction

Before moving on to consider examples of when the registration of a characteristic may be deemed to confer an 'unfair advantage' and therefore be excluded, we must first consider in broad terms in which circumstances the three exclusions (characteristics which result from the nature of the goods, characteristics which are necessary to achieve a technical result and characteristics which give substantial value to the goods) will likely apply to various characteristics. This is not a straightforward task. The chief problem in interpreting the scope of the three exclusions lies in the fact that the legislator has simply grafted the words 'another characteristic' alongside the shape mark exclusions as if the additional exclusions are of the same species and dovetail neatly with the exclusions for shapes. Clearly, this is not the case. For example, whereas shape trade marks consist of the goods themselves (e.g. the Philips shaver head), the additional wording may also conceivably cover characteristics which have been imaginatively or arbitrarily added to the goods and only form one aspect of the goods, but not the entirety. This creates a great deal of uncertainty about the precise scope of the additional wording which is unlikely to be resolved absent guidance from the CJEU. However, some basic understanding of the probable scope and applicability of the three exclusions is necessary in order to meaningfully discuss specific examples of characteristics which may be excluded. Therefore, the purpose of this chapter is to briefly discuss the probable general applicability of the three exclusions concerning 'another characteristic'. This will serve as

⁷³ In support of this statement in the context of colours see T-173/00 *KWS Saat AG v OHIM* ECLI:EU:T:2002:243, para 45. The Court of First Instance (CFI) stated: 'Further, in so far as the colour claimed for the particular services is a specific shade, many colours remain available for identical or similar services. Accordingly, the Board of Appeal was wrong to find that registration of the sign would unduly restrict competitors' ability to choose to use that colour to present their services or identify their undertaking.'

a general framework within which we can discuss the various specific examples of when the registration of ‘another characteristic’ may confer an ‘unfair advantage’ upon the proprietor.

4.2. How closely related must a characteristic be to the goods to be considered ‘another characteristic’ of the goods?

An overarching issue is how closely related the characteristic concerned must be to the goods at issue to be caught by the exclusions. Lavinia Brancusi suggests that the Advocate General in his second opinion in *Christian Louboutin and Christian Louboutin Sas v van Haren Schoenen BV* believed that a ‘characteristic’ indicated ‘a part or an element of the goods in question’⁷⁴ but notes that this statement does not address how proximate the relationship needs to be between the characteristic and the goods.⁷⁵ Continuing, Brancusi rejects the notion that the exclusions concerning ‘another characteristic’ includes graphics or words and suggests ‘another characteristic’ is ‘a feature which does not have an independent nature/character with regard to the product itself’⁷⁶ relying on analogous reasoning in *X Technology Swiss GmbH v. OHIM* (a case concerning a position mark consisting of a sock with an orange toepiece).⁷⁷ While broadly agreeing with Brancusi that word and device marks are unlikely to be covered (simply because in most circumstances they will not afford the proprietor an ‘unfair advantage’), too narrow a categorization based on the indivisibility of the characteristic from the goods might misleadingly suggest the exclusion of sound or smell marks which have an independent character from the goods, for example smells and sounds which are added in an arbitrary fashion to goods. However, even characteristics which may be deemed to have an independent nature with regard to the goods to which they are applied may confer a ‘unfair advantage’ upon the proprietor if other undertakings are prevented from using them. Furthermore, realizing the rationale of avoiding ‘unfair advantage’ by ‘unduly restricting’ the availability of the characteristic (sign) for other operators should

⁷⁴ C-163/16 *Christian Louboutin and Christian Louboutin SAS v Van Haren Schoenen BV* ECLI:EU:C:2018:64 (AG Szpunar, 2nd opinion), para 23.

⁷⁵ Lavinia Brancusi, ‘Trade Marks’ Functionality in EU law: Expected New Trends After the Louboutin Case (2019) 41(2) European Intellectual Property Review 98, 101.

⁷⁶ Lavinia Brancusi, ‘Trade Marks’ Functionality in EU law: Expected New Trends After the Louboutin Case (2019) 41(2) European Intellectual Property Review 98, 101.

⁷⁷ T-547/08 *X Technology Swiss GmbH v. OHIM* ECLI:EU:C:2011:307, para 15. Brancusi does not cite the wording directly but the relevant portion reads (referring to the earlier tribunal decision): ‘la marque demandée vise à la protection d’un signe spécifique placé sur une partie déterminée de la surface du produit désigné. Ainsi, la marque demandée ne peut être dissociée de la forme d’une partie de ce produit, à savoir de la forme de la pointe d’un article de bonneterie chaussante’.

logically take precedence over purely semantic interpretations and issues of proximity of characteristics and goods. Indeed, this approach is also supported by the Max Planck Study which suggests that the exclusions ‘can be applied to *all kinds of signs*’⁷⁸ and therefore should not be limited solely to particular categories of characteristics. We therefore suggest that ‘another characteristic’ should be interpreted in a broad fashion as any characteristic which is associated with or related to the goods at issue.

4.3. What is ‘another characteristic which results from the nature of the goods themselves’?

Concerning shape marks, the CJEU held in *Hauck* that the prohibition concerning shapes which result from the nature of the goods applies where the sign consists of ‘one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors’.⁷⁹ Maeve Lynch argues that this answer is unclear and prefers the Advocate General’s opinion with which she states the CJEU seemed to agree.⁸⁰ The Advocate General suggests that the nature of the goods exclusion ‘concerns signs which are *typical of a particular semantic category*, in other words, signs which relate to *consumers’ ideas of the essential characteristics of the goods concerned*’.⁸¹ As noted in *Hauck*, this provision continues to apply where the producer has made a ‘personal essential contribution’.⁸² Therefore, it is clear that the exclusion concerning ‘another characteristic which results from the nature of the goods themselves’ may not simply cover characteristics which are naturally associated with the goods at issue but also those characteristics which are added by producers and which are normally associated in the mind of the consumer with the goods at issue. Similar reasoning was adopted by the OHIM Board of Appeal in refusing Wrigley’s application for the colour ‘Light Green’, ruling that the colour ‘is fashionably and commonly used to denote freshness and proximity to nature’ and ‘trade marks consisting exclusively of signs or indications which have become customary in the bona fide and established practices of the trade are not eligible for

⁷⁸ Max Planck Study, para 2.31 (emphasis added).

⁷⁹ *Hauck*, para 27.

⁸⁰ Maeve Lynch, ‘Product Configuration Marks: the Shape of Things to Come’ (2017) 12(6) *Journal of Intellectual Property Law & Practice* 465, 469.

⁸¹ C-205/13 *Hauck GmbH & Co. KG v. Stokke A/S* ECLI:EU:C:2014:322 (AG Szpunar opinion), para 48 (emphasis added).

⁸² *Hauck*, para 23.

registration.⁸³ Marks of this sort which are typically associated with a certain class of goods may be deemed to ‘result from the nature of the goods’ in the sense that they are invariably associated with them.

Analogous case law arguably suggests that this exclusion may apply even more broadly to characteristics which other producers might reasonably use in relation to the goods in the future as well as foreseeable variants on a theme. For example, in EUIPO (OHIM) Case R 711/1999-3 Myles Limited (5 December 2001) (The scent of raspberries), the Board of Appeal held that as regards the scent of raspberries applied to fuels such as candles and scented paraffin, this scent was an ‘essential property of the goods’. Furthermore, the Board of Appeal also stated that smell additives might be developed for diesel fuel and could therefore be considered to be an essential property of those goods as well.⁸⁴ Furthermore, in T-208/12 *Think Schuhwerk GmbH v OHIM* (a case concerning a position mark for red shoe aglets), the General Court held that the red shoe aglets were not unusual in the sector (they are simply a variant on the basic form).⁸⁵ It is therefore arguable that characteristics which could be used by producers in relation to the goods at issue or which are simply variants on an established theme may also be said to ‘result from the nature of the goods’ if it is reasonable to contemplate that the characteristic might be used in connection with the goods for which registration is sought.

4.4. What is ‘another characteristic of goods which is necessary to obtain a technical result’?

The general view is that this exclusion will mainly be applicable to three-dimensional shape marks.⁸⁶ Indeed, the reference to ‘technical result’ suggests some kind of mechanical result. However, the CJEU’s comments in *Philips* might suggest a broader reading. The CJEU stated that, as regards shapes, ‘a shape whose essential characteristics perform a technical function *and were chosen to fulfil that function*’ must be excluded.⁸⁷ Applied to ‘another characteristic’ this logic suggests that the exclusion applies to those characteristics which are primarily selected due to the

⁸³ EUIPO (OHIM) Case R 122/1998-3 WM. Wrigley Jr. Company (18 December 1998) (‘Light Green’), paras 24 and 28 <<https://euipo.europa.eu/eSearch/#details/trademarks/000051607>> accessed 22 April 2019.

⁸⁴ EUIPO (OHIM) Case R 711/1999-3 Myles Limited (5 December 2001) (The scent of raspberries), paras 41, 46 <<http://www.copat.de/markenformen/wrp2002/wrp10.pdf>> accessed 23 April 2019.

⁸⁵ T-208/12 *Think Schuhwerk GmbH v OHIM* ECLI:EU:T:2013:376, para 47.

⁸⁶ Antoon Quaadvlieg, ‘Shapes With a Technical Function: an Ever-expanding Exclusion’ (2016) 17 ERA Forum 101, 102.

⁸⁷ *Philips*, para 80 (emphasis added).

result they yield rather than their value as a source indicator. The example given in the EUIPO Guidelines of a sound mark for insect repellents as an example of ‘another characteristic’ necessary to obtain a technical result supports this view.⁸⁸ Therefore, it is submitted that ‘technical result’ should be read purposively so as to exclude all signs which are primarily chosen to create a desired effect.

4.5. How should ‘substantial value’ be interpreted when applied to ‘another characteristic’?

Scholars are uncertain as to how the CJEU will interpret the words ‘substantial value’ when considering ‘other characteristics’.⁸⁹ Furthermore, existing guidance given by the EUIPO concerning ‘substantial value’ raises a number of issues. According to the EUIPO Guidelines, when assessing substantial value:

it is important to determine whether **the aesthetic value of a shape (or, by analogy, other characteristic) can, in its own right, determine the commercial value of the product and the consumer’s choice to a large extent.** It is immaterial whether the overall value of the product is also affected by other factors, if the value contributed by the shape or other characteristic itself is substantial’.⁹⁰

It seems that the characteristic at issue must satisfy the cumulative conditions of largely determining both the commercial value and the consumer’s choice. In other words, the characteristic must virtually be a *sine qua non* the product is valueless. It is submitted that the requirement that the characteristic be largely determinative of the commercial value of the product is problematic when applied to ‘another characteristic’ and is not in keeping with intention of the legislation. When the substantial value exclusion applied only to shapes then this formulation may have been acceptable as the shape and the goods are one and the same. However, the recast legislation refers ‘another characteristic *which gives* substantial value to the goods’. This suggests that the exclusion addresses characteristics which *add* substantial value to the product at issue but that does not require that the characteristic must wholly ‘determine the commercial value of the product’.

⁸⁸ EUIPO Guidelines, para 3.

⁸⁹ Mitchel Adams and Amanda Scardamaglia, ‘Non-Traditional Trade Marks in Europe: an Historical Snapshot of Applications and Registrations’ (2018) 40(10) European Intellectual Property Review 623, 624.

⁹⁰ EUIPO Guidelines, para 4 (emphasis in original).

A further issue is that the wording ‘another characteristic’ has significantly broadened the possible features which may be excluded by virtue of giving substantial value to the goods at issue and may add value in different ways depending on the nature of the characteristic. The very idea of value is itself a nebulous concept. As Alison Firth notes, value may embrace both monetary value, desirability and utility and a wide range of qualities which individually or collectively render a product attractive or useful.⁹¹ Coupled with this issue is the problem of distinguishing between the value of the product to which the characteristic is applied and the value of the characteristic itself. Determining the precise meaning of ‘substantial value’ as applied to ‘another characteristic’ is a difficult task without further guidance from the CJEU. Therefore, we propose that as a working definition ‘another characteristic which gives substantial value to the goods’ should follow the General Court’s formulation in *Bang & Olufsen A/S v OHIM*: ‘the design [or *characteristic* in this case] is *an element which will be very important in the consumer’s choice* even if the consumer also takes other characteristics of the goods at issue into account’.⁹² This definition of substantial value is closely related to the notion of ‘unfair advantage’ as characteristics which are very important in the customer’s choice are those which may grant the proprietor an ‘unfair advantage’ if reserved to a single undertaking.⁹³

⁹¹ Alison Firth, ‘Shapes as Trade Marks: Public Policy, Functional Considerations and Consumer Perception’ (2001) 23(2) *European Intellectual Property Review* 86, 94. Firth lists beauty; style; practicality; suitability for purpose; efficiency in use; efficiency in manufacture; durability; ease of disposal (Evian bottle); good choice of materials; and value for money.

⁹² T-460/05 *Bang & Olufsen A/S v OHIM* ECLI:EU:T:2007:304, para 73 (emphasis added).

⁹³ A further observation is that the exclusion concerning ‘another characteristic’ also covers single colour marks and other signs which are not covered by copyright or any other time-limited right. This marks an important change from past practice where the shapes at issue were typically covered by a time-limited right and the exclusion of such shapes was justified as a means to prevent the perpetual right granted by a trade mark from serving to extend the life of other rights which the legislature has made time-limited. Although the distinction between signs susceptible to protection by a time-limited monopoly right and those not so susceptible may not be of great significance, it may impact on the assessment of whether ‘another characteristic’ adds substantial value to the goods. Whereas in *Hauck*, the CJEU ruled that customer perception is not solely determinative of whether a shape adds substantial value of the goods, that ruling may be partly understood in terms of the CJEU’s reluctance to rely on customer perception as the gatekeeper of the public domain in complex cases involving the interaction between time-limited rights and trade marks. However, where time-limited rights are not at issue, it is conceivable that public perception may have a more important role in determining whether ‘another characteristic’ gives substantial value to the goods.

5. Consideration of when ‘another characteristic’ may be excluded by virtue of the ‘unfair advantage’ conferred

5.1. Introduction

A potentially broad range of characteristics may be caught by the words ‘another characteristic’ including ‘non-traditional’ or ‘non-conventional’ trade marks such as colours, smells, sounds, position marks, holograms⁹⁴ as well as taste, texture, motion, and pattern marks. As noted earlier, INTA went as far as suggesting that ‘another characteristic’ may also cover word or device marks.⁹⁵ It is beyond the scope of this thesis to provide an exhaustive analysis of each of the above categories of characteristics (signs) (although the analysis which follows can of course be extrapolated). Furthermore, in some cases, such as motion or holograms or motion marks it is unclear how an ‘unfair advantage’ might be conferred and, in the case of taste marks, it is uncertain whether such signs can even function as trade marks.⁹⁶ Rather, it is proposed to focus on colour, olfactory (smell), sound and pattern trade marks, the former three being of especial interest given that commentators have long called for a circumspect approach to granting trade mark rights over these characteristics.⁹⁷ In addition, we also consider the issue of whether word trade marks may be considered excluded characteristics by reference to the ‘unfair advantage’ they confer. A series of examples are given for each category, both actual and hypothetical cases, to demonstrate which characteristics may be excluded as a result of the ‘unfair advantage’ they may confer upon the proprietor by ‘unduly restricting’ the availability of the characteristic (sign) at issue for the other operators who offer for sale goods or services of the same type.

5.2. Colour Trade Marks

Colour marks can take a variety of forms including single colours, colour combinations, or be used in connection with a logo or word mark. The focus of this section is upon single colour marks as they best exemplify how colour marks may enable a proprietor to gain an ‘unfair advantage’ (while

⁹⁴ Gordon Humphreys, ‘Non-Conventional Trade Marks: an Overview of Some of the Leading Case Law of the Boards of Appeal’ (2010) 32(9) *European Intellectual Property Review* 437.

⁹⁵ See Chapter 2.

⁹⁶ Due to the fact that the trade mark is only experienced after the product is purchased.

⁹⁷ David I. Bainbridge, ‘Smell, Sound, Colour and Shape Trade Marks: an Unhappy Flirtation?’ (2004) *Journal of Business Law* 219, 245.

acknowledging that other varieties of colour marks (especially common colour combinations) may also confer an ‘unfair advantage’ depending on the facts and circumstances of their use). Commentators have long noted the adverse impact the registration of colour marks may have upon competition, especially single colour marks.⁹⁸ The high potential for colour marks to present an anti-competitive threat results from two factors. The first factor is that undertakings commonly use a wide variety of colours in connection with their goods to render them more attractive to customers. Allowing a single undertaking to monopolize certain colours would unduly restrict competitors from freely using colours of interest. Furthermore, a colour trade mark enables the proprietor to prevent others from using identical/similar colours for identical/similar goods and, where the mark has a reputation, the proprietor may object to use of identical/similar colours in relation to goods identical/similar or dissimilar in circumstances where such use takes unfair advantage or is detrimental to the character or repute of the colour mark at issue.⁹⁹ Therefore, the broad ‘halo’ of protection afforded by a single colour mark coupled with the need for competitors to freely use colours as they see fit means that the granting of a single colour mark has the potential to create significant competitive distortions.¹⁰⁰

Single colour marks also pose competitive risks by virtue of the fact that there is a finite range of colours visible to the human eye and this must be taken into consideration when deciding whether to grant a mark.¹⁰¹ In *Libertel*, the CJEU noted that a small number of trade mark registrations could exhaust the entire range of colours available and that would create ‘an unjustified competitive advantage’ for the proprietor. Therefore, the court held that there was ‘a public interest in not unduly restricting the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought’.¹⁰² As noted in chapter 3.3 it is proposed that this *Libertel*-style general interest of avoiding unduly restricting the options available for the other operators who offer for sale goods or services of the same type

⁹⁸ Charlotte Schulze, ‘Registering Colour Trade Marks in the European Union’ (2003) 25(2) European Intellectual Property Review 55, 62.

⁹⁹ David I. Bainbridge, ‘Smell, Sound, Colour and Shape Trade Marks: an Unhappy Flirtation?’ (2004) Journal of Business Law 219, 231-32; EUTMR Article 9(2) (a)-(c); EUTMD Article 10(2)(a)-(c).

¹⁰⁰ David T. Keeling, ‘About Kinetic Watches, Easy Banking and Nappies That Keep a Baby Dry: a Review of Recent European Case Law on Absolute Grounds for Refusal to Register Trade Marks’ (2003) 2 Intellectual Property Quarterly 131, 148.

¹⁰¹ Gordon Humphreys, ‘Non-Conventional Trade Marks: an Overview of Some of the Leading Case Law of the Boards of Appeal’ (2010) 32(9) European Intellectual Property Review 437.

¹⁰² *Libertel*, paras 54-55.

determine whether the registration of the characteristic (sign) at issue would confer an ‘unfair advantage’ upon its proprietor. Given that this general interest has already been applied to colour marks the analysis somewhat overlaps with existing colour mark case law, although that case law must be construed within the context of the three exclusions.

We shall therefore consider in which circumstances the registration of a single colour mark may confer an ‘unfair advantage’ by ‘unduly restricting’ the availability of colours for other operators, beginning with Christian Louboutin’s much litigated¹⁰³ trade mark registration for red soled high-heeled shoes. Louboutin’s registration describes the mark as consisting ‘of the colour red (Pantone 18. 1663 TP) applied to the sole of a shoe as shown (the outline of the shoe is therefore not part of the trademark but serves to show the positioning of the trademark)’ for high-heeled shoes (except orthopaedic footwear) in class 25 (the ‘Red Sole Mark’).¹⁰⁴ Olena Butriy has analysed the specific red colour of the Red Sole Mark and concludes that human ocular perception and experience of the Red Sole Mark ‘in the wild’ means that Pantone code is simply intended to satisfy the *Libertel* requirement and that the Red Sole Mark covers ‘a colour red’.¹⁰⁵ Furthermore, in enforcement matters, the ‘halo’ of protection afforded by a trade mark enables a proprietor to object to identical or similar colour marks,¹⁰⁶ possibly extending the protection to any red colour. Therefore, we should approach the Red Sole Mark from the perspective that it affords Louboutin a monopoly over red soled high-heeled shoes.

The Red Sole Mark may fall within the exclusion concerning characteristics which result from the nature of the goods themselves. According to the Advocate General’s opinion in *Hauck* and the subsequent CJEU ruling this ground concerns signs concerning ‘consumers’ ideas of the essential characteristics of the goods concerned’¹⁰⁷ and ‘which consumers may be looking for in the products of competitors’ whilst allowing room for the producer to make a ‘personal essential

¹⁰³ For an overview of litigation concerning Louboutin’s mark see Carina Gommers and Eva De Pauw, ‘“Red Sole Diaries”: a Tale on the Enforcement of Louboutin’s Position Mark’ (2016) 11(4) *Journal of Intellectual Property Law & Practice* 258.

¹⁰⁴ EUIPO, ‘The trademark consists of the colour red (Pantone 18.1663TP) applied to the sole of a shoe as shown (the outline of the shoe is therefore not part of the trademark but serves to show the positioning of the trademark)’, Reg. No. 008845539, registered 5 May 2016 (cancellation pending).
< <https://euipo.europa.eu/eSearch/#details/trademarks/008845539>> accessed 25 May 2019.

¹⁰⁵ Olena Butriy, ‘Shaping a colour’ (2017) 12(12) *Journal of Intellectual Property Law & Practice* 997, 1001.

¹⁰⁶ Dev S. Gangjee, ‘Paying the Price for Admission: Non-Traditional Marks across Registration and Enforcement’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) ch 3, 62.

¹⁰⁷ C-205/13 *Hauck GmbH & Co. KG v. Stokke A/S ECLI:EU:C:2014:322* (AG Szpunar opinion), para 48.

contribution'.¹⁰⁸ Arguably consumers are habituated to expect high-heeled shoes to have coloured sole (albeit in the more typical colours of beige or grey). While Louboutin's decision to use the colour red (as opposed to the more normal beige or grey) was an inspired 'personal essential contribution',¹⁰⁹ it simply amounts to a variation on the existing theme of coloured high-heeled shoe soles. As argued previously (see chapter 4.3), characteristics which could conceivably be used by producers in relation to the goods at issue or which are simply variants on an established theme may also be said to 'result from the nature of the goods'. This reasoning is supported by the General Court's ruling in T-208/12 *Think Schuhwerk GmbH v OHIM* in which the court ruled that red shoe aglets were simply a variant on the basic form common in the sector and therefore unregistrable. Similarly, the Red Sole Mark simply amounts to completely colouring an element (the sole) of a high-heeled shoe red.¹¹⁰ It is therefore not unreasonable to suggest that the Red Sole Mark is a characteristic which results from the nature of the goods themselves.

The most obvious basis on which the Red Sole Mark could be excluded is the fact that the Red Sole Mark 'another characteristic which gives substantial value to the goods'. There can be little doubt that the Red Sole Mark is a characteristic 'which will be very important in the consumer's choice' even if the consumer also takes other characteristics of the shoes such as their quality and the reputation of Christian Louboutin into account. Justin Hughes, who writes from a US perspective discusses the question of aesthetic functionality (which roughly corresponds to the substantial value exclusion) writes that exclusion should be contingent upon whether 'the product feature at issue triggers a positive cognitive, psychological, or aesthetic response among a substantial composite of the relevant consumers *and* that response predates the trademark owner's activities'.¹¹¹ There can be little doubt that the colour red satisfies Hughes' criteria given its cultural significance. This is echoed by Olena Butriy who delineates the importance of the red colour and cites its role in emphasizing the female foot, its association with performance and celebration, its use in adding emphasis to a shoe sole, and finally the Red Sole Mark's similarity to a red ribbon

¹⁰⁸ *Hauck*, paras 23 and 27.

¹⁰⁹ *Hauck*, para 23.

¹¹⁰ Louboutin is supposed to have created the first version by covering the sole of a high-heeled shoe with red nail polish, see: Y-Jean Mun-Delsalle, 'Q&A With Christian Louboutin, The French King Of Sole' *Forbes* (Jersey City 25 February 2016) <www.forbes.com/sites/yjeanmundelsalle/2016/02/25/qa-with-christian-louboutin-the-french-king-of-sole/> accessed 15 March 2019.

¹¹¹ Justin Hughes, 'Cognitive and Aesthetic Functionality in Trademark Law' (2015) 36 *Cardozo Law Review* 1227, 1230 (emphasis in original).

(and the significance of that sign for the public), concluding that the Red Sole Mark adds substantial value to the high-heeled shoe.¹¹² Similarly, Louboutin himself has emphasized the aesthetic appeal of the red soles saying “Men are like bulls. They cannot resist the red sole.”¹¹³ Furthermore, the company’s website repeatedly features icons of a stylized version of the Red Sole Mark reminiscent of an exclamation mark, further underscoring the importance of the red colour.¹¹⁴ It is therefore clear that the Red Sole Mark lends substantial value to the shoes given the cultural significance of the colour and its attention-grabbing qualities.

However, the acid test is whether the Red Sole Mark sole mark confers an ‘unfair advantage’ upon the proprietor by ‘unduly restricting’ competitors’ ability to use the colour red for high-heeled shoes. Writers such as Deven Desai contend that it does, noting that the red colour and sole of the shoe ‘are general parts of design’ which should be freely available to all and notes that ‘a claim to the red sole of a shoe is quite a powerful claim against competitors in the shoe market’.¹¹⁵ It is difficult to disagree with this opinion. The Red Sole Mark almost certainly confers Louboutin an ‘unfair advantage’ over his competitors as, due to the colour red’s unique properties and cultural associations, it grants Louboutin a privileged position and places his competitors at a disadvantage by preventing them from adopting the preferred colour red in connection with high-heeled shoes. As a consequence of this registration, competitors are severely disadvantaged and this results in competitors having to ‘invest significant human and monetary resources to find other ways to compete with the colour mark owner, even though their products may have the same features as the trade marked product’.¹¹⁶ Therefore, based on this analysis it is likely that that Red Sole Mark would be deemed to confer an ‘unfair advantage’ upon its proprietor and therefore be excluded under the new regime.

Other colour marks may also be excluded on the basis that their registration would grant the proprietor an unfair advantage due to their popularity or their importance for the industry in which

¹¹² Olena Butriy, ‘Shaping a colour’ (2017) 12(12) *Journal of Intellectual Property Law & Practice* 997, 1003.

¹¹³ Lauren Collins, ‘Sole Mate: Christian Louboutin and the Psychology of Shoes’ *The New Yorker* (New York 21 March 2011) <www.newyorker.com/magazine/2011/03/28/sole-mate> accessed 2 April 2019.

¹¹⁴ <http://eu.christianlouboutin.com/be_fr/homepage-1/women.html> accessed 2 April 2019.

¹¹⁵ Deven Desai, ‘Should Trademark Law Protect Non-Traditional Trademarks? A Look at How Marketing Practices Try to Capture Essences’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) ch 6, 143.

¹¹⁶ Onur Sahin, ‘The Past, the Present and the Future of Colour and Smell Marks’ (2016) 38(8) *European Intellectual Property Review* 504, 507-508.

registration is sought. For example, in rejecting Wrigley’s application for the colour ‘Light Green’, the EUIPO Board of Appeal emphasized that ‘in advertising and on packaging of products in a broad range of consumer markets, it is fashionably and commonly used to denote freshness and proximity to nature’.¹¹⁷ Similarly, green is commonly used in connection with biological or ecological foodstuffs and other goods to indicate that the product is derived from natural sources or is environmentally friendly. US case law provides a further example of a colour which might also be rejected under EU law due to their importance in a particular industry.¹¹⁸ *In re Florists’ Transworld Delivery, Inc.* the court rejected the color black for floral arrangements as competitors who ‘want to offer flowers for bereavement purposes, Halloween or to imbue an element of elegance or luxury to their presentations through packaging therefor will be disadvantaged if they must avoid using the color black in such packaging’.¹¹⁹ In each of the examples, through long use, such marks may fall within the exclusion for a characteristic which may be deemed to ‘result from the nature of the goods’ in the sense that they are invariably associated with the goods at issue. Alternatively, they may be said to give substantial value to the goods in the sense that they are an element which will be very important in the consumer’s choice. For example, the colour green is indicative of the product’s freshness or environmentally friendly qualities and therefore enables the customer to quickly select a product with those desirable qualities. Similarly, black is very important in the customer’s choice of floral arrangement colouration as it alone can add convey the necessary gravitas due to its cultural significance as a colour of grief and formality.

US case law also provides an example of how the technical result exclusion might apply to certain colours. In *British Seagull Ltd and Outboard Marine Corporation v Brunswick Corp.* one of the reasons for rejecting the color black as applied to outboard motors was due to the optical effect of black diminishing the size of the object to which it is applied, ‘objects coloured black appear smaller than they do when they are painted other or lighter colors’.¹²⁰ The colour black is not chosen primarily to function as a trade mark, rather it is chosen to create a desired effect, namely

¹¹⁷ EUIPO (OHIM) Case R 122/1998-3 WM. Wrigley Jr. Company (18 December 1998) (‘Light Green’), para 24 <<https://euipo.europa.eu/eSearch/#details/trademarks/000051607>> accessed 22 April 2019.

¹¹⁸ The US cases which follow were brought to the author’s attention by Justin Hughes, ‘Non-Traditional Trademarks and the Dilemma of Aesthetic Functionality’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) ch 5, 107 which offers a full discussion of the US doctrine of aesthetic functionality.

¹¹⁹ *In re Florists’ Transworld Delivery, Inc.*, 106 U.S.P.Q.2d 1784, 1789.

¹²⁰ *British Seagull Ltd. and Outboard Marine Corp. v Brunswick Corp.*, 28 U.S.P.Q.2d 1199 WL 409141 (T.T.A.B. 1993).

that of making an object appear smaller. Viewed from this perspective, the colour black may be considered ‘a characteristic of goods which is necessary to obtain a technical result’ and therefore excluded where it may have that effect on the goods at issue (i.e. where registration is sought for larger goods).¹²¹

As with the Red Sole Mark, the granting of green or black marks would grant the proprietor an ‘unfair advantage’ over its competitors by unduly restricting their ability to use a commonplace colour. There are no feasible substitutes for green to indicate ‘freshness or closeness to nature’ or environmentally friendly qualities, nor is there a substitute for black to add formality, signify grieving or make objects seem smaller. Therefore, colours of this sort which have cultural significance, are necessary for a technical result, or which are habitually used within the industry and where granting a monopoly would grant the proprietor a significant ‘unfair advantage’ by preventing access to colours which all proprietors need access to are likely to be excluded characteristics under the new regime.

A further example of colours which may be excluded are those sometimes referred to as ‘laudatory colours’¹²² (such as gold, silver, bronze and platinum). Analogous case law from the EUIPO suggests that such colours may be excluded. Although the case concerned an application for the word mark ‘GOLD’ (in class 3 for perfumes and personal care items), the reasoning in EUIPO (OHIM) Case R1457/2007-1 Estee Lauder Cosmetics LTD (23 October 2008) (‘GOLD’) may potentially also apply to laudatory colour marks.¹²³ In this case the Board held that ‘GOLD’ ‘contains the laudatory message that something is valued as the finest of its kind’ and ‘the semantic content of the term ‘GOLD’ indicates to the consumer a characteristic of the products relating to value which, whilst not specific, comes from information designed to promote or advertise’.¹²⁴ Arguably, an application for a gold colour mark (or other laudatory colour mark) would similarly be rejected for giving substantial value to the goods since it is certainly a very important element

¹²¹ Other examples of colours necessary to obtain a technical result might include fluorescent colours where registration is sought for safety clothing or for goods where the fluorescent colour is used to mark sharp edges. The fluorescent colour is selected in those circumstances not as a trade mark, but rather for its technical effect (increased visibility).

¹²² Gordon Humphreys, ‘Non-Conventional Trade Marks: an Overview of Some of the Leading Case Law of the Boards of Appeal’ (2010) 32(9) European Intellectual Property Review 437, 438.

¹²³ Gordon Humphreys, ‘Non-Conventional Trade Marks: an Overview of Some of the Leading Case Law of the Boards of Appeal’ (2010) 32(9) European Intellectual Property Review 437, 438.

¹²⁴ EUIPO (OHIM) Case R1457/2007-1 Estee Lauder Cosmetics LTD (23 October 2008) (‘GOLD’), paras 18, 24 <<https://euipo.europa.eu/eSearch/#details/trademarks/003925799>> accessed 1 May 2019.

in the consumer's choice as it conveys a message of value and exclusivity concerning the product. Granting a single entity a monopoly over such a mark would confer upon the proprietor a significant 'unfair advantage' over its competitors as it would prevent them from realizing the desirable connotations of value and exclusivity associated with gold which increases the selling power of the product at issue and which should be kept free for all market players to use.

However, marks which do not confer an 'unfair advantage' are arguably unlikely to be excluded even if they give substantial value. An example might be the colour pink for military vehicles. Such a trade mark may add substantial value in the sense that it will be a characteristic which will be very important in the consumer's choice (i.e. the colour is valuable in the sense that it is shocking and subverts the normally menacing look of military vehicles). However, the colour pink can hardly be said to confer upon the proprietor an 'unfair advantage' over competitors by 'unduly restricting' competitors' right to use the colour as it neither prevents competitors from manufacturing tanks nor prevents them from adopting colours typical of the industry (e.g. drab green or camouflage) or which would foreseeably be used in the industry.

An overarching question concerning the application of the exclusion concerning substantial value-giving colours is whether this ground applies only to colours which give such value perennially (and which may create a perpetual risk of conferring upon the proprietor an 'unfair advantage') or whether it also applies to characteristics which gave value in the past but no longer do so presently. In his second opinion in *Christian Louboutin and Christian Louboutin SAS v Van Haren Schoenen BV*, the Advocate General suggests that the applicability of the substantial value may be dictated by the popularity of the characteristic at issue at the point of application:

A trade mark can be refused or declared invalid on the basis of Article 3(1)(e)(iii) of Directive 2008/95 where its characteristics give substantial value to the goods. That provision therefore allows a characteristic to remain available for all market participants over the period during which that characteristic has a particular effect on the value of the goods. From the point at which that is no longer the case — inter alia, as certain interested parties allege, because the public's preferences have changed and that characteristic is no longer sought and valued by the public —, the trade mark at issue would no longer

potentially be caught by the prohibition laid down in Article 3(1)(e)(iii) of Directive 2008/95.¹²⁵

Care must be taken not to construe this as meaning that any characteristic which has fallen out of favour will therefore be registrable. For example, the Advocate General's opinion might suggest that if green was a popular colour then it would be impossible to register a mark for a green shoe sole during that period of popularity, but thereafter it would be registrable. However, there are grave reservations with this reasoning, at least in the context of the fashion industry. A particular characteristic, such as a green sole mark, may be unpopular for long periods but may be immensely popular during periods in which green is 'in fashion' and grant the proprietor an unfair advantage over its competition during that time. It is difficult to see why such a registration is any less damaging than a registration over a characteristic which is perennially popular.

Furthermore, the CJEU's past approach is to consider not only the present value of the sign at issue, but also its prospective value. For example, in *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* the CJEU was at some pains to emphasize that the geographical origin exclusion did not simply apply to marks presently of interest but also applied prospectively 'to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods'.¹²⁶ The CJEU also extended this forward-looking logic to descriptive marks in *European Union Intellectual Property Office v Wm. Wrigley Jr. Company*, holding that marks which *could* be used descriptively by undertakings must be kept available for such use.¹²⁷ These rulings suggest that the CJEU will likely consider future popularity a factor in determining whether a potentially substantial value-giving colour should be excluded on the basis of the 'unfair advantage it may confer'.

A further complication is the interaction between reputation, substantial value and 'unfair advantage'. According to the EUIPO Guidelines the concept of value must not be interpreted as meaning 'reputation' as the ground for refusal is justified solely by the value conferred to the goods

¹²⁵ C-163/16 *Christian Louboutin and Christian Louboutin Sas v van Haren Schoenen BV* ECLI:EU:C:2018:64 (AG Szpunar, 2nd opinion), para 51.

¹²⁶ C-108/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* ECLI:EU:C:1999:230, para 37.

¹²⁷ C-191/01 P *European Union Intellectual Property Office v Wm. Wrigley Jr. Company* ECLI:EU:C:2003:579, para 32.

by characteristic and not by other factors such as the reputation of the word mark used to identify the goods at issue.¹²⁸ In other words, where the word mark consists of the designer, this should be deemed not to influence the value of the characteristic. Notwithstanding this statement, this may be difficult to apply in practice, especially concerning colour and colour combination marks adopted by designers. The moment a designer adopts a particular colour it is imbued with an aura of glamour and luxury which is not simply derived from the intrinsic value of the colour. Thereafter, the colour is likely to be rapidly copied by other designer and then ‘trickle down’ to less renowned producers.¹²⁹ Given that colours are not usually inherently distinctive, the designer will need to consistently use the colour or colour combination in order to prove acquired distinctiveness. This will inevitably result in the reputation of the designer further adhering to the colour at issue and thereby increasing its attractiveness to other market players. Lavinia Brancusi notes that these kind of branding strategies can influence consumer preferences such that consumers will be unwilling to consider alternatives:

branding efforts can render a trademark so unique that consumers are unlikely to consider alternative products. As they lead to trademark magnetism, these types of branding strategies may have a direct impact on consumers’ preferences and behaviour in the market. In turn, this raises anti-competitive concerns about how thin the line is between selling power and monopoly power of such strategies and resulting trademarks.¹³⁰

Accordingly, it seems inevitable that the reputation of the designer will determine both the value of the colour and the attendant ‘unfair advantage’ which may be conferred by granting the designer a trade mark monopoly over that colour. The result may be that famous designers face greater difficulties in achieving the registration of colours than their less well-known counterparts.¹³¹

¹²⁸ EUIPO Guidelines, para 4.

¹²⁹For a cinematic explanation, see the cerulean sweater scene in ‘The Devil Wears Prada’, <<https://www.youtube.com/watch?v=2-4J5VKmClc>> accessed 5 April 2019.

¹³⁰ Lavinia Brancusi, ‘Assessing the Impact of Registering Non-Traditional Marks: A European Union Competition Law Analysis’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) ch 12, 237.

¹³¹ For a contrary viewpoint see Carina Gommers and Eva De Pauw, ‘‘Red Sole Diaries’: a Tale on the Enforcement of Louboutin’s Position Mark’ (2016) 11(4) *Journal of Intellectual Property Law & Practice* 258, 269.

5.3. Olfactory (Smell) Trade Marks

Commentators such as David Bainbridge have expressed strong reservations as to whether smell marks should be registrable at all on the grounds that they grant a ‘powerful monopoly’ given that a proprietor may also object to the use of similar smells in relation to dissimilar goods¹³² and therefore may create competitive distortions. However, at least in principle, the removal of the graphical representation requirement would suggest an openness on the part of the legislator to the possibility of the registration of smell marks, although whether it will be practically any easier to register scent marks is debated.¹³³ Assuming that smell marks will be registrable, which smells are likely to be excluded under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD?

Smell marks, as a category, are mentioned in the Max Planck Study as potentially excluded¹³⁴ depending on the facts and circumstances. Much as natural shapes cannot be registered, it seems logical that natural smells inherent to the goods at issue are likely to be caught by the exclusion concerning characteristics which result from the nature of the goods themselves. The exclusion is also likely to apply to synthesized smells designed to mimic natural scents and which are used in relation to the goods with which they are associated. For example, supermarkets often use the artificial smell of baked goods to suggest that baked goods have just been baked (when they may in fact have been baked some hours before). Similarly, Thomas Pink Inc., a London-based shirt maker scents its shops with the smell of ‘line-dried linen’ which according to a company representative evokes ‘our product and its quality’¹³⁵ (i.e. their linen shirts).

Other possible examples might include natural odours which serve as a deterrent for animals or insects such as peppermint as a deterrent for rodents or citronella for mosquitos. Such natural deterrents may be said to result from the nature of the goods themselves (i.e. the smell is the goods), or are necessary to obtain a technical result (i.e. the characteristic is selected primarily for its

¹³² David I. Bainbridge, ‘Smell, Sound, Colour and Shape Trade Marks: an Unhappy Flirtation?’ (2004) *Journal of Business Law* 219, 224.

¹³³ See Danny Friedmann, ‘EU Opens Door for Sound Marks: Will Scent Marks Follow?’ (2015) 10(12) *Journal of Intellectual Property Law & Practice* 931; Désirée Fields and Alasdair Muller, ‘Going Against Tradition: the Effect of Eliminating the Requirement of Representing a Trade Mark Graphically on Applications for Non-Traditional trademarks’ (2017) 39(4) *European Intellectual Property Review* 238.

¹³⁴ Max Planck Study, para 2.31.

¹³⁵ Kate Murphy, ‘SPENDING IT; A Sales Pitch Right Under Your Nose’ *The New York Times* (New York 13 September 1998) <<https://www.nytimes.com/1998/09/13/business/spending-it-a-sales-pitch-right-under-your-nose.html>> accessed 4 May 2019.

function as a deterrent), and may be said to add substantial value to the goods (i.e. the smell entirely determines to value of the goods and the consumers' choice). A further example might include synthetic air fresheners, such as the smell of balsam fir, which would also fall within all three exclusions for the same reasons.

It is clear that in each of the above cases that the granting of a trade mark would confer an 'unfair advantage' by preventing other operators from using a natural emanation of the goods and thereby effectively prevent them from selling the goods to which they are related. Similarly, natural smells which have a deterrent effect such as peppermint or citronella are simply naturally occurring effects which result from the products, the granting of a trade mark over which confer an 'unfair advantage' by reserving an effect of nature to a single operator, leaving them without a substitute. Finally, even synthetic smells which are arbitrary but commonplace such as balsam fir, lavender and other smells commonly used to mask bad odours are likely to be excluded as their use is widespread and would confer an 'unfair advantage' if confined to a single operator.

A further illustrative example is the OHIM (EUIPO) Examination Division's rejection of an application for 'The Smell of Vanilla' for patches for application to the skin and adhesive patches for application to the skin, which the applicant argued was unusual in respect of such goods.¹³⁶ The Office held that the mark was non-distinctive as vanilla was commonly used for patches and noted that a brief internet search revealed 5430 references to such products. Furthermore, the Office noted that the applicant held a patent for vanilla smelling patches and noted that the smell was a functional 'characteristic applied to a product (...) such as a patent applied to a product to obtain a technical result' and therefore could not serve as a trade mark (designation of origin). Continuing, the Office cited the Advocate General's opinion in *Ralf Sieckmann v Deutsches Patent- und Markenamt*: 'in reality, the mark is not the smell as much as the perfumed product independently from its perfume'.¹³⁷ It seems clear that smell marks of this sort will fall within the exclusion concerning characteristics which results from the nature of the goods themselves as vanilla is simply a normal quality of patches. Furthermore, the vanilla smell is likely to be considered a characteristic of goods which is necessary to obtain a technical result as it is the

¹³⁶ EUIPO (OHIM) Decision of the Examination Division Office regarding Application No.001807353, 'The smell of vanilla' (18 December 2002), <<https://euipo.europa.eu/eSearch/#details/trademarks/001807353>> accessed 4 May 2019.

¹³⁷ C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt* ECLI:EU:C:2001:594 (AG Ruiz-Jarabo Colmer opinion), para 30.

subject of a patent and is a characteristic which is selected not as a trade mark but for the desired effect of the vanilla scent. Such a mark overreaches its potential function as a trade mark and would ‘form an obstacle preventing competitors from freely offering for sale products incorporating such (...) functional characteristics in competition with the proprietor of the trade mark’.¹³⁸ As Onur Sahin notes, ‘This kind of utilitarian function serves other purposes which are irrelevant or harmful to the origin function’.¹³⁹ Given the importance of the vanilla scent to the patch, this mark may also give substantial value to the goods (patch). The registration of such a scent mark would certainly give the proprietor an ‘unfair advantage’ by unduly restricting the ability of competitors to use a commonplace and functional smell and would therefore be excluded under the new regime.

The EUIPO Guidelines suggest that this exclusion may also apply to an olfactory mark for perfume as the smell results from the nature of the goods.¹⁴⁰ Indeed, in the past Chanel’s attempt to register its famous N ° 5 fragrance as a smell mark in the United Kingdom was unsuccessful as the scent of the perfume was ‘the very essence of the product’.¹⁴¹ In addition, the smell of the perfume is a characteristic which gives substantial value to the goods as it is a very important element in the consumer’s decision to purchase. Most perfumes are likely to confer an ‘unfair advantage’ upon their proprietors if registered as most perfumes incorporate commonplace scents. For example, Chanel N ° 5 is described as ‘a floral bouquet of May rose and jasmine from Grasse’.¹⁴² Allowing an olfactory registration for such a mark would pose serious problems for competitors as it would effectively prevent the marketing of identical or confusingly similar smells, including possibly all scents incorporating rose or jasmine or other scent notes similar to Chanel N ° 5. Such a mark would confer an ‘unfair advantage’ by preventing competitors from using the commonplace natural smells of rose and jasmine which every perfume producer should be free to use.

The above examples all relate to smells which are intrinsically part of the goods themselves or are at least naturally associated with the goods to which they relate. However, producers may also add smells in an imaginative, fanciful or arbitrary manner to goods. The most well-known example is

¹³⁸ *Philips*, para 78.

¹³⁹ Onur Sahin, ‘The Past, the Present and the Future of Colour and Smell Marks’ (2016) 38(8) *European Intellectual Property Review* 504, 511.

¹⁴⁰ EUIPO Guidelines, para 2.

¹⁴¹ WIPO, ‘Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks’ *WIPO Magazine* (Geneva February 2009) 1, 1 <https://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html> accessed 23 April 2019.

¹⁴² <https://www.chanel.com/nl_BE/parfums-beauty/parfums/c/n5/parfum.html> accessed 17 February 2019.

the famous olfactory trade mark consisting of ‘the smell of fresh cut grass’ for tennis balls.¹⁴³ Such a mark may fall within the exclusion concerning characteristics which give substantial value to the goods. The scent of fresh cut grass would undoubtedly be an important element in the consumer’s decision to purchase the tennis balls as the novelty value of the scented balls is intended to encourage consumers to prefer the scented balls over normal unscented balls. However, it seems unlikely that the registration of such a sign would confer an ‘unfair advantage’ on its proprietor. Some might argue the smell of cut grass is evocative of famous grass courts such as Wimbledon and is therefore a unique scent, but such reasoning is unlikely to prevail. The smell of cut grass is completely divorced from the function of the tennis balls and simply forms a cosmetic addition and places no competitive constraints on the underlying product. Furthermore, granting a trademark monopoly over the smell of cut grass does not leave competitors devoid of substitutes and competitors are free to use a myriad of other scents limited only by their imagination.

A more recent example is an application for ‘the smell of tea tree oil applied to industrial safety gloves’ filed on 28 March 2014. Although the mark was rejected for not fulfilling the *Sieckmann* criteria of being sufficiently clear, precise and objective, the decision explicitly states that there was no objection for non-distinctiveness or for any other reason.¹⁴⁴ Arguably, smell marks such as this will not be excluded. While such a smell trade mark undoubtedly adds substantial value to the gloves, it arguably does not confer upon the proprietor an ‘unfair advantage’ as the scent is arbitrary and not commonplace. It neither constrains competitors from producing safety gloves nor does it prevent them from adopting one of vast range of other scents they may wish to apply to their gloves, including smells typical in the industry such as lavender or camomile.

5.4. Sound Trade Marks

Sound marks such as the roar of a motorbike are cited as an example of ‘another characteristic’ which may be caught by the prohibition against registering signs resulting exclusively from the nature or technical performance of the goods in the Max Planck Study.¹⁴⁵ The EUIPO Guidelines

¹⁴³ EUIPO, ‘The Smell of Fresh Cut Grass’, Reg. No. 000428870, registered 31 December 2001, expired 11 December 2006, <<https://euipo.europa.eu/eSearch/#details/trademarks/000428870>> accessed 24 April 2019.

¹⁴⁴ EUIPO, ‘The Smell of Tea Tree Oil Applied to Industrial Safety Gloves’, filing No. 012741401, rejected 21 August 2014, <<https://euipo.europa.eu/eSearch/#details/trademarks/012741401>> accessed 24 April 2019.

¹⁴⁵ Max Planck Study, para 2.31.

suggest this as an example of a sound resulting from the nature of the goods ‘in the sense of its technical performance’.¹⁴⁶ The EUIPO Guidelines gives the example of a sound mark which serves to repel insects as a further example of a sound mark excluded by the technical result exclusion.¹⁴⁷ Other examples of sounds which do not naturally emanate from the goods but which might nevertheless be caught as characteristics which result from the nature of the goods might include sounds which are typically associated with the goods at issue such as animal sounds associated with stuffed animals or the sound of a siren for a toy fire engine. Alternatively, these might be caught by the exclusion concerning a characteristic which gives substantial value to the goods at issue as the consumer is likely to purchase the goods primarily or largely due to the sound they emit. Further examples of marks which might be caught by the substantial value exclusion might include sound marks such as ‘Greensleeves’ or other popular Christmas songs for acoustic Christmas lights or ornaments, and Brahms’ ‘Lullaby’ for baby cradles or other baby cradle toys. Finally, marks such Unilever New Zealand Limited’s registration No. 247094¹⁴⁸ ‘a squeak produced by the friction of thumb or forefinger on dishware’¹⁴⁹ for hand dishwashing products in class 3 (the sound indicating that the dishes are ‘squeaky’ clean) may be deemed to add substantial value to the goods by the laudatory nature of the mark, which encourages the consumer to purchase the goods (dishwashing liquid) to achieve the result denoted by the mark.

Each of the above marks would certainly grant the proprietor an ‘unfair advantage’ over its competitors by placing an undue restraint upon the ability of competitors right to use that sound. Granting a monopoly over sounds such as the roar of a motorcycle, a lion’s roar, a fire engine, a popular Christmas song, Brahms’ Lullaby, which are sounds either emanating from the goods or which are typically associated with the goods at issue would prevent competitors from using a commonplace emanation of the goods at issue and leave competitors with no substitute. Similar considerations might also warrant excluding a sound mark designed to repel insects as granting a monopoly over a deterrent would place the proprietor in a privileged position by preventing use of

¹⁴⁶ EUIPO Guidelines, para 2.

¹⁴⁷ EUIPO Guidelines, para 3.

¹⁴⁸ New Zealand IPO, ‘A squeak produced by the friction of thumb or forefinger on dishware’, Reg. No. 247094, registered 16 October 1998.

<<https://app.iponz.govt.nz/app/Extra/IP/Mutual/Browse.aspx?sid=636912398040353411>> accessed 18 April 2019.

¹⁴⁹ Candida J. Hinton, ‘In Your Ear! Trademarking a Sound Mark Requires More Than a Good Ear for Music’ (2002) 57(2) INTA Bulletin.

<<https://www.inta.org/INTABulletin/Pages/InYourEarTrademarkingasoundmarkrequiresmorethanagoodearformusic.aspx>> accessed 18 April 2019.

a sound essential to the purpose of the goods and would leave competitors without a good substitute. Finally, Unilever's squeak sound mark arguably gives its proprietor an 'unfair advantage' over its competitors as it effectively amounts to granting a monopoly over a normal effect of using any hand dishwashing liquid and is not unique to Unilever's product. The registration of such a trade mark would effectively prevent competitors from demonstrating a normal effect of using their product and leave them at a significant disadvantage in comparison with Unilever which would be the only entity which could demonstrate a 'squeaky clean' effect.

An interesting question is whether portions of famous popular classical music pieces might be excluded where application is sought for the musical instruments on which the music is played. For example, where a registration is sought for a portion of Beethoven's 'Ode to Joy' for pianos. It is doubtful whether the sound would be excluded as a characteristic which gives substantial value to the goods in the sense that it is a very important element in the consumer's choice. However, such sound marks would likely be excluded as a characteristic which results from the nature of the goods themselves in the sense that it is normally associated with the goods at issue and consumers might reasonably expect such music to be played on the instrument. The granting of a trade mark monopoly over such a sound mark would certainly grant the proprietor an 'unfair advantage' over its competitors as competitors would expect to be able to freely use such music to demonstrate their instruments either in-store or in advertisements. Therefore, popular pieces such as 'Ode to Joy' and other popular works unlikely to be registrable for musical instruments as that would confer the proprietor an 'unfair advantage' over its over its competitors.

The above examples involve sounds which naturally emanate from the goods (or are at least normally associated with) the goods for which registration is sought and the competition issues are manifestly apparent. However, sounds may also be applied to goods in an imaginative manner which may lend substantial value and form a characteristic which is a very important element in the consumer's decision to purchase the goods. An invented example might include a retractable pen aimed at golf enthusiasts which, when the piston button is pressed, emits the sound of a golf club striking a golf ball by means of a micro-speaker. Would a trade mark registration for this sound for pens be excluded? It seems likely that the sound would satisfy the requirement of determining the consumer's choice to a large extent. Accordingly, prima facie such a sound mark would be excluded. However, is there a 'unfair advantage' granted to the proprietor as a result of

the registration of the sound at issue? This question can likely be safely answered in the negative as the granting of such a trade mark is not an undue restriction on the ability of competitors to use that sound mark as pen manufacturers have an almost infinite variety of substitute sounds which they may choose from. This analysis suggests that the sounds excluded under the new regime will be limited to those sounds which naturally emanate from the goods in question or which are normally associated with them and therefore would grant the proprietor an ‘unfair advantage’ by denying other operators access to commonplace sounds rather than excluding those sounds which are added in an arbitrary manner, even if the latter do add substantial value to the goods at issue.

5.5. Pattern Trade Marks

Amongst the examples of pattern marks, the EUIPO lists the Burberry Tartan and the Louis Vuitton Monogram Canvas.¹⁵⁰ Other examples of patterns might include patterns on textiles. These patterns tend to be original, highly intricate and aesthetically pleasing. There is little doubt that these patterns give substantial value to the goods with which they are associated as they are an element which will be very important in the consumer’s choice. Consumers arguably purchase the products at least partly due to the aesthetic appeal of the pattern and therefore the pattern mark adds substantial value to the goods in addition to the value afforded by the reputation of the designer (i.e., the pattern is intrinsically valuable in its own right).

Whether such patterns confer an ‘unfair advantage’ over competitors is debated, with some arguing that these patterns do in fact confer an ‘unfair advantage’. For instance, Irene Calboli argues that the increase in the number of registrations of this sort ‘is symptomatic of the larger disease of “intellectual property protection grabbing”’¹⁵¹ and argues that granting exclusive rights over such marks may have an adverse impact on market competition as it ‘results in preventing access to competitors and third parties to relevant and aesthetically appealing designs and product features’.¹⁵² However, closer consideration suggests that no ‘unfair advantage’ is conferred by granting a trade mark here. Despite Calboli’s assertion that competitive considerations warrant

¹⁵⁰ <https://euipo.europa.eu/ohimportal/en/trade-marks-examples#Pattern_mark> accessed 10 April 2019

¹⁵¹ Irene Calboli, ‘Chocolate, Fashion, Toys and Cabs: The Misunderstood Distinctiveness of Non-Traditional Trademarks’ (2018) 49(1) *International Review of Intellectual Property and Competition Law* 1, 4.

¹⁵² Irene Calboli, ‘Hands Off “My” Colors, Patterns and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation’ in Irene Calboli and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford University Press 2018) ch 15, 305.

granting access to appealing design features such as patterns, this assertion is highly problematic. At least part of the appeal of patterns used by fashion houses results from the reputation of the fashion house responsible for the pattern, not from the intrinsic value of the pattern itself. The reality is that competitors primarily wish to use famous patterns to ride on the coat-tails of the designer responsible for the pattern, rather than any compelling need to use the particular pattern adopted by the fashion house. Refusing trade mark protection and allowing competitors to use the pattern at issue would not simply enable competitors to use the pattern, but to profit from the reputation of the fashion house reflected in the pattern. Care must be taken not to conflate the necessity to use a particular pattern as such in order to compete with the desire to compete by partaking of the designer's reputation reflected in the design. Viewed from this perspective, patterns such as the Burberry Tartan and Louis Vuitton Monogram Canvas do not afford their proprietors an 'unfair advantage' over their competitors as there is no need for competitors to use the exact patterns and the variety of possible alternative patterns is almost infinite.¹⁵³ Therefore, ornate patterns of this sort are unlikely to confer an 'unfair advantage' upon their proprietors and are therefore not likely to be considered as 'another characteristic' which will be excluded.

However, other commonplace patterns may be excluded. For example, patterns such as a polka dot pattern, animal prints or other common patterns for which registration is sought in relation to clothing may be considered to 'result from the nature of the goods' in the sense that they are invariably associated with clothing and consumers would expect them to be offered by all market

¹⁵³As an example of this reasoning it is worthwhile considering the US T.T.A.B case concerning Bottega Veneta's application for its 'intrecciato' or 'weave' design (*In re Bottega Veneta*, Serial No. 77219184 (T.T.A.B. Sept. 30, 2013) (ttabvue-77219184-EXA-25)). Considering the issue of aesthetic functionality, the Board noted: 'Suffice it to say that a mark will be deemed aesthetically functional, and therefore prohibited from registration by Section 2(e)(5) of the Trademark Act, *if the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage. Therefore, we must consider whether registering the instant mark would have a significant effect on competition, i.e., whether there is a competitive need for others to use the particular weave design that is the subject of this application*' (see page 6 of the ruling, emphasis added). Considering the application at issue, the Board ruled 'Thus, items which have a 'horizontal' weave, or are not made of leather or materials that simulate leather, or have strips that are much wider than 8 to 12 millimeters, or have a weave pattern on only a portion of the product, or have a weave that is not a plain weave, *are not persuasive evidence that third parties have a competitive need to use the particular weave design that applicant seeks to register*. Applicant is not seeking exclusive rights to all weave designs for the identified leather goods. As applicant has stated, 'other designs could appear in different sizes, at different angles, and indifferent orientations'' (see pages 9-10 of the ruling, emphasis added). The Board also considered the issue of reputation in determining competitive need, stating: 'Certainly evidence of a great number of third parties that use a certain feature can show that the feature is necessary for companies to be able to compete. effectively, i.e., the exclusive appropriation of that feature would put competitors at a significant non-reputation related disadvantage. At the same time, we must also be aware that *competitive usage may not always be evidence of competitive need, but of a desire to copy or take advantage of a feature that has become associated with a single company*' (see page 17 of the ruling, emphasis added).

players. Furthermore, they are also likely to fall under the substantial value exclusion as the pattern is a very important factor in the consumer's decision to purchase the clothing. These types of patterns would certainly confer upon the proprietor an 'unfair advantage' over its competitors as it would rob them of the ability to use a pattern common in the industry and thereby confer an 'unfair advantage' upon the proprietor.

5.6. Word Trade Marks

As suggested by INTA, word marks could conceivably be considered 'another characteristic' which gives substantial value to the goods. It is axiomatic that companies choose certain trade marks which may serve to add value to the goods by their positive associations. For example, use of the word Nike (which adds value by reference to the Greek goddess of victory), use of the word Canada Goose (which adds value by reference to the warmth offered by goose down), and finally Brioni (which adds value and an aura of luxury by reference to a group of Croatian islands historically associated with luxury and glamour) all may be said to add value to the goods for which they are registered. However, several concerns arise regarding this interpretation.

First, it is unlikely that the intrinsic value of the word mark could be considered an element which will be very important in the consumer's choice. Rather, the consumer's choice is typically based on the reputation of the trade mark proprietor of the mark in question. Therefore, consumers buy Nike shoes not because of the inherent value of the mark arising from its association with the Greek goddess of victory, but due to the reputation of the Nike company which has been built over several decades.

Nevertheless, certain marks may be considered an important element in the consumer's choice. For example, French Connection's controversial 'FCUK' trade mark¹⁵⁴ (an abbreviation of French Connection UK) was hugely popular due to its close similarity to a swearword. Consumers purchased T-shirts entirely based on the ability of the trade mark to shock and offend and French Connection's revival was largely due to the adoption of this trade mark and different variations thereof. Therefore, the 'FCUK' mark unequivocally adds substantial value to the goods at issue. However, even where word marks do add substantial value it is doubtful that such marks would

¹⁵⁴ EUIPO, 'FCUK', Reg. No. 000743112, registered 18 October 1999, <<https://euipo.europa.eu/eSearch/#details/trademarks/000743112>> accessed 24 April 2019.

be excluded based on the ‘unfair advantage’ they confer by denying competitors the right to use such mark. As Graeme Dinwoodie notes, word marks do not typically create competitive distortions as ‘their appropriation does not affect the capacity of others to produce competing goods’.¹⁵⁵ Furthermore, the number of possible word marks is limited only by human ingenuity and there is arguably no ‘unfair advantage’ conferred by granting the mark since producers do not need to use the particular word mark in order to compete effectively and there are any number of substitutes which a clever branding manager could conceivably create in substitution.

6. Conclusion

The main research question this thesis sought to answer was ‘Which characteristics will be caught by the exclusions concerning ‘another characteristic’ under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD?’. This thesis takes as its starting point that it is uncertain how case law regarding the exclusions concerning ‘other characteristics’ will develop. In particular, it is uncertain whether the ‘keep free’ *public interest* which has been applied in the past concerning shape marks will also apply to ‘other characteristics’. We argue that in *Christian Louboutin AG 1st opinion* the Advocate General may have left the door open for an alternative approach to interpreting the applicability of the exclusions concerning ‘another characteristic’ rooted not solely in the wording but by reference to whether the granting of a trade mark would confer an ‘unfair advantage’ in breach of the *Libertel*-style *general interest* of not ‘unduly restricting’ the availability of the characteristic (sign) at issue for other operators.

Therefore, we suggested that in determining which characteristics are likely to be excluded, the categorical nature of the characteristic (sign) at issue (i.e. as a smell, colour, etc.) is not decisive. Rather, ‘all kinds of signs’¹⁵⁶ may potentially be excluded with the determining factor being whether the characteristic confers an ‘unfair advantage’ upon the proprietor by violating the *Libertel*-style *general interest* of ‘unduly restricting’ the availability of the characteristic (sign) at issue for other operators. This approach was applied to various characteristics, namely colour marks, olfactory (smell) marks, sound marks, pattern marks, and word marks.

¹⁵⁵ Graeme Dinwoodie, ‘The Death of Ontology: A Teleological Approach to Trademark Law’ (1999) *Iowa Law Review* 611, 614.

¹⁵⁶ Max Planck Study, para 2.31.

Concerning colour marks, we concluded that colour marks which are commonly used in the industry (such as green for environmentally friendly products or black for flower arrangements) may fall within the exclusion concerning characteristics which result from the nature of the goods themselves or within the exclusion concerning characteristics which give substantial value to the goods. Furthermore, colours such as black may fall within the exclusion concerning characteristics which are necessary to obtain a technical result where registration is sought for larger goods where the colour may function to reduce the apparent size of the object at issue. Finally, colours with significant cultural connotations such as red as used in the Red Sole Mark or gold for perfumes are likely to fall within the exclusion concerning characteristics which give substantial value to the goods. In each of the above cases, the exclusion of the mark would fall foul of the general interest as its registration would confer an ‘unfair advantage’ upon the proprietor by ‘unduly restricting’ the availability of a colour which should be freely available to all users.

Olfactory (smell) marks such as natural smells (or their synthetic counterparts) where registration is sought for goods from which the smell naturally emanates or for goods where the smell at issue is commonly added to the goods by operators are likely to fall within the exclusion concerning characteristics which result from the nature of the goods themselves. Other examples of excluded smells might include natural deterrents such as peppermint or citronella, common smells used for synthetic air fresheners (such as balsam fir), and other common smells (such as vanilla for skin patches). Those examples may fall into all three exclusions as they may be said to result from the nature of the goods themselves (i.e. the smell is the goods), or are necessary to obtain a technical result (i.e. the characteristic is selected primarily for its function), and may be said to add substantial value to the goods (i.e. the smell entirely determines the value of the goods and the consumers’ choice). Furthermore, perfumes embodying common natural odours are likely to fall within the exclusion concerning characteristics which result from the nature of the goods as well as the exclusion concerning characteristics which add substantial value to the goods. Each of the above smell marks would confer an ‘unfair advantage’ upon the proprietor by ‘unduly restricting’ the availability of a smell which should freely be available to all operators.

Turning to sound marks, marks such as the roar of a motorcycle, animal sounds associated with stuffed animals, or the sound of a siren for a toy fire engine are likely to fall within the exclusion concerning characteristics which result from the nature of the goods themselves. Sound marks such

as a sound intended to deter insects is an example of a sound mark being a characteristic of goods which is necessary to obtain a technical result. Examples of sound marks which may fall within the exclusion concerning characteristics which give substantial value to the goods may include popular Christmas songs for Christmas goods, classical lullabies for cradle toys, popular classic music for musical instruments, and marks such as Unilever New Zealand Limited's registration No. 247094 'a squeak produced by the friction of thumb or forefinger on dishware' for hand dishwashing products in class 3. We conclude that the granting of each of these sound marks would confer an 'unfair advantage' on the proprietor in violation of the general interest by 'unduly restricting' the availability of the sound at issue since other operators would reasonably expect such sounds to be available for all to use and not restricted to a single operator.

We argue that whilst ornate and unique patterns such as those adopted by fashion houses may give 'substantial value' to the goods at issue they are unlikely to be excluded as they confer no 'unfair advantage' to the proprietor. Conversely, patterns such as animal prints together with common patterns which may fall foul of the exclusion concerning characteristics which result from the nature of the goods themselves (or alternatively the exclusion concerning characteristics which give substantial value to the goods) would be excluded since the granting of a trade mark over such a common pattern would confer an 'unfair advantage' on the proprietor by preventing other operators from adopting a pattern which is standard in the industry.

Finally, turning to word marks which may give substantial value to the goods at issue, it is submitted that such marks are unlikely to be excluded as they confer no 'unfair advantage' upon the proprietor by 'unduly restricting' the availability of the sign at issue since the range of alternative word marks is limited solely by the human imagination.

In passing, and echoing the EUIPO Office's observation, many of the marks which we argue would be excluded are also objectionable under Article 7(1)(b) and/or (c) EUTMR (and Article 4(1)(b) and/or (c) EUTMD) as they are descriptive or otherwise non-distinctive (indeed, many of the real examples discussed were excluded on this basis). The difference is of course that marks which fall within Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD cannot rely on acquired distinctiveness to overcome the prohibition and are permanently excluded from trade mark protection.¹⁵⁷ Marks

¹⁵⁷ EUIPO Guidelines, para 1.

which are susceptible to exclusion under Article 7(1)(e) EUTMR and Article 4(1)(e) EUTMD are of course first examined under this ground before the examining office moves on to consider further possible grounds of exclusion.¹⁵⁸ Therefore, the practical consequence of the addition of ‘other characteristics’ may be to enable examining offices to permanently bar marks which confer an ‘unfair advantage’ on the proprietor in breach of the general interest whereas this was not possible previously since the proprietor could in theory still prove acquired distinctiveness.

If characteristics (signs) will only be excluded if they confer an ‘unfair advantage’ by ‘unduly restricting’ the availability of the characteristic at issue, then the number of ‘other characteristics’ excluded may be less than expected. Rather than being a ‘sea-change’ in thinking, the application of the general interest to the exclusions concerning ‘another characteristic’ indicates a natural progression of trade mark law enabling ‘other characteristics’ which confer an ‘unfair advantage’ to be permanently excluded. Such a stance maximizes the registrability of characteristics (signs) whilst protecting competition by ensuring that no single proprietor unduly restricts the availability of characteristics which should be available for other operators. However, how the CJEU will eventually interpret the exclusions concerning ‘another characteristic’ remains to be seen.

¹⁵⁸ EUIPO Guidelines, para 1.

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