

Unconventional trademarks and their protection in the legal system

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We understand for "conventional" trademarks as those that are expressed by words, numbers, images or symbols, that is, they can only be perceived by the sense of sight. On the other hand, the so-called "Unconventional" trademarks can be distinguished by any of the five senses and are expressed through unusual methods, such as, for example, a type of experience used as part of a marketing strategy in order to leave a mark on consumers, thus in this way orienting their preferences towards a certain offer.

The Unconventional trademarks that are mostly registered would be:

Holographic, that is, a three-dimensional image microscopically recorded on a photosensitive film by means of a laser beam, in such a way that when viewed from different perspectives, the image is reflected in three dimensions, for example, holograms used for security purposes in credit cards ; **Sound-brands**, any sound that the consumer associates with a particular brand, such as the unique roar of the MGM lion; **Olfactory**: they would be a scent that reminds the consumer of a product, an example could be the Play-Doh plasticine; **Commercial images**, that contain a set of unique characteristics that protect the identity of a product, such as its color, shape, packaging, etc.

In general, these types of trademarks have acquired a certain degree of legal recognition over time; in the international area mainly through the Singapore Treaty on the Law of Trademarks, (March 27, 2006), which creates a framework of protection for these brands and allows each member country the freedom to register all kinds of trademark that it considers valid. The mentioned Treaty indicates in its regulations the way in which the interested parties must request the representation of some of the most frequent unconventional trademarks, see below:

“a) This Treaty shall apply to marks consisting of visible signs, it being understood that only the Contracting Parties that accept the registration of three-dimensional marks shall be obliged to apply this Treaty to said marks.

b) This Treaty shall not apply to holograms or to marks that do not consist of visible signs, in particular sound marks and olfactory marks.”

And, at the national regulation, through Andean Decision 486, this expressly considers some unconventional marks, such as colors, sounds, olfactory marks and the three-dimensional mark, however, it is relatively ambiguous with respect to other type of signs that can be recognized as trademarks (see subsection g)).

“Article 134.- For the purposes of this regime, any sign that is capable of distinguishing products or services in the market shall constitute a trademark. Signs capable of graphic representation may be registered as trademarks. The nature of the product or service to which a trademark is to be applied will in no case be an obstacle to its registration. The following signs may constitute trademarks, among others:

- a) the words or combination of words;*
- b) images, figures, symbols, graphics, logos, monograms, portraits, labels, emblems and shields;*
- c) sounds and smells;*
- d) letters and numbers;*
- e) a color delimited by a shape, or a combination of colors;*
- f) the shape of the products, their containers or wrappings;*
- g) any combination of the signs or means indicated in the previous sections. ”*

One case that obtained great jurisprudential relevance in the field of unconventional trademarks was that of Ralf Sieckman¹.

The person in question tried to register an olfactory trademark with the German Patent and Trademark Office, in classes 35, 41 and 42 of the Nice Classification, however, in order for his application to have a better chance of success, he made a description of the smell to be registered: "pure chemical substance methyl cinnamate cinnamic acid methyl ester", accompanied by the indication of places where samples of the odor could be found: "samples of this olfactory mark can be obtained by contacting local laboratories ..." and he also indicated what the chemical formula of the smell was: "C₆H₅-CH = CHCOOCH₃." Finally, he presented an odor sample in a container and added that it was "a fruity balsamic aroma with light touches of cinnamon".

The application for registration was rejected by the Court of the European Union, who came to the conclusion that "it cannot be excluded that signs such as olfactory signs may also constitute trademarks that, although they are not perceptible as such by sight, can be visible by means of a graphic representation", but only "can be constituted as a trademark, a sign that in itself cannot be visually perceived, on the condition that it can be object of graphic representation, in particular by means of figures, lines or characters, that is clear, precise, complete in itself, easily accessible, intelligible, durable and objective".

This requirement referred to the representation "clear, precise, complete in itself, easily accessible, intelligible, durable and objective" of the trademark, is the condition that the Court has used since then, and it is the one that various courts or judges put into practice today as criteria when deciding whether an unconventional trademark can be recognized as a trademark or not.

According to this, we can conclude that the main problem that come up when registering an unconventional trademark is to determine the way in which these brands can be represented graphically, so that the owner can enjoy the rights granted by that registration. In Peru, there has not been a considerable amount of trademark history for this type of signs, however, over the years, large companies will use these criteria to design types of trademarks that allow them to connect with consumers in a more efficient way, directly, based on their preferences and the impact of what they can see, hear or feel.

¹ Court of Justice of the European Union. Sentence C-273, December 12, 2002
[<http://eurlex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:62000CJ0273:ES:PDF>].

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