



Promoting Intellectual  
Property Rights in the  
ASEAN Region

# Training on ASEAN Trademark Common Guidelines : Absolute Grounds

Thom Clark | 18<sup>th</sup> October 2022



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## SIGNS ADMISSIBLE AS TRADE MARKS :

### Visually Perceptible Signs

- Two-dimensional signs
- Colours
- Three-dimensional signs
- Motion marks and holograms
- Position marks

### Non-visually perceptible signs

- Signs perceptible by the sense of hearing
- Signs perceptible by the sense of smell
- Signs perceptible by the sense of taste
- Signs perceptible by the sense of touch

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## Sound marks : Common Practice

CP11 Common Practice

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The CP11 Common Practice aims to identify general principles on the examination of formal requirements and grounds for refusal of new types of trade mark and the new ways of representing them, to provide guidance in order to ensure that different MS IPOs come to a similar and predictable outcome when assessing those types of trade mark.

## Sound marks : Common Practice

Agreement on the type of mark when the sign clearly complies with one of the definitions and representation requirements established in the CCNTM.



## Sound marks : Common Practice

Clear and precise as long as it is represented in any appropriate form using generally available technologies, provided that the sign is also capable of being represented in a self-contained, easily accessible, intelligible, durable and objective manner, irrespective of whether it has a concept.



## Sound marks : Common Practice

Divided by type of mark - each includes the following subsections:



**Consumer perception**



**Inherently distinctive marks**



**Non- distinctive marks**



## Sound marks : Common Practice

**Sound marks:** They will be considered inherently **distinctive** if they are capable of being perceived by the relevant public as an indication of commercial origin.



***Class 41: Providing films  
for entertainment purposes***



***Class 3: Washing powder***

**Exception:** A particular arrangement of different elements of sounds, which is unusual could render the mark distinctive as a whole.

***Class 31: Fresh  
bananas***



## Sound marks : Common Practice

### ✓ Objective:

- ✓ Prevent granting an undertaking a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors.

### ✓ Public's perception role:

- ✓ It is not a decisive element to be considered however, it may be a useful criterion, especially when identifying, under Article 4(1)(e)(ii) and (iii), the essential characteristics of the sign in question.



*Class 9: Audio-sensitive  
controls for lighting  
apparatus*

## Sound marks

Examination of formalities

## Sound marks : Formalities

### EUIPO Guidelines:

A sound mark is defined as a trade mark consisting exclusively of a sound or combination of sounds.

A sound mark must be represented by submitting either an audio file reproducing the sound or an accurate representation of the sound in musical notation.

## Sound marks : Formalities

An audio file reproducing the sound



An accurate representation of a sound in musical notation



## Sound marks : Formalities

### Common Guidelines:

If the sign consists of a melody, jingle, tone, song or other musical sound that can be represented clearly and accurately by musical notation, such notation must be submitted with the application and will suffice to comply with the requirement of adequate representation

## Sound marks : Formalities

### Common Guidelines:

If the sign consists of a non-musical sound or noise that cannot clearly and accurately be represented by musical notation, and such signs are admissible for registration under the law, the examiner may require a graphic representation consisting of a sonogram, sonograph or oscillogram accompanied by a corresponding electronic sound file (sound record, MP3 file) submitted by electronic filing or in a standard electronic format

## Sound marks

Examination of absolute grounds



## Sound marks

### EUIPO Guidelines:

The acceptability of a sound mark must, like words or other types of trade marks, depend on whether the sound is distinctive per se, that is, whether the average consumer will perceive the sound as a memorable one that serves to indicate that the goods or services are exclusively associated with one undertaking.

## Sound marks

### EUIPO Guidelines:

The kinds of sound marks that are unlikely to be accepted without evidence of factual distinctiveness include:

- very simple pieces of music consisting of only one or two notes;
- sounds that are in the common domain (e.g. La Marseillaise, Für Elise);
- sounds that are too long to be considered as an indication of origin;
- sounds typically linked to specific goods and services.

## Sound marks

Examples

## Sound marks

EUTM 18605266

$\text{♩} = 94$

G

*mf*

3

G



## Sound marks

EUTM 18657960



EUTM 18657963



## Sound marks

EUTM 18470008



## Sound marks

EUTM 18698949



## Sound marks

EUTM 17880808

Objected to under Article 7.1.b

Appealed : R0620/2019-4

Application allowed





## Sound marks

EUTM 17700361

Barca



## Sound marks

EUTM 17889555

Refused under  
Article 7.1.b



## Sound marks

EUTM 017912475

Objected to under Article 7.1.b

Appealed : R0530/2019-3

Court: T-668/19

Application refused



## Sound marks

EUTM 17942771

Refused under  
Article 7.1.b



## Sound marks

EUTM 18168977

Objected to under Article 7.1.b

Appealed : R1996/2020-5

Application allowed



## Sound marks

EUTM 017916805



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## Smell / taste / touch marks

### Common Guidelines:

#### 1.2.2 Signs Perceptible by the Sense of Smell

Signs perceptible only by the sense of smell (olfactory marks or smell marks) cannot be represented graphically or otherwise in a manner that is sufficiently clear, precise, easily accessible, intelligible, durable and objective.



## Smell / taste / touch marks

EUIPO Guidelines:

### 9.3.11.2 Smell/olfactory and taste marks

Smell/olfactory or taste marks are currently not acceptable. This is because the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective ( Article 3(1) EUTMIR), and the current state of technology does not allow these types of marks to be represented in such way.

## Smell / taste / touch marks

### Common Guidelines:

#### 1.2.3 Signs Perceptible by the Sense of Taste

Signs perceptible only by the sense of taste (taste marks) cannot be represented graphically in a manner that is clear, precise, easily accessible, intelligible, durable and objective.

## Smell / taste / touch marks

### Common Guidelines:

#### 1.2.4 Signs Perceptible by the Sense of Touch

Signs perceptible by the sense of touch (tactile marks) could be used to distinguish products and services offered, in particular, to persons that are visually impaired, although they could also be addressed to consumers in general.

## Smell / taste / touch marks

### Common Guidelines:

#### 1.2.4 Signs Perceptible by the Sense of Taste

Tactile' marks may be represented graphically to the extent that they consist of physical features of the particular products or of their packaging, or of objects used in connection with the services for which the marks are to be used.

In this case the criteria and provisions regarding 'three-dimensional' marks would apply also to these tactile marks, *mutatis mutandis*. The usual conditions regarding distinctiveness and functionality would also need to be verified.

## Smell / taste / touch marks

EUIPO Guidelines:

### 9.3.11.3 Tactile marks

Tactile marks are marks where protection is sought for the tactile effect of a certain material or texture, for instance indications in braille alphabet or the specific surface of an object. However, taking into account the requirement under Article 4 EUTMR that the trade mark must be represented on the register in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor, it is not possible with currently available technology to deduce the ‘tactile feeling’ claimed with certainty from the existing formats of representation.

## Smell / taste / touch marks

Examples

## Smell / taste / touch marks

EUTM 428870

The smell of fresh  
cut grass

## Smell / taste / touch marks

EUTM 1452853

Refused under  
Article 7.1.a and b

The taste of artificial  
strawberry flavour



## Smell / taste / touch marks

EUTM 012112462

Refused under  
Article 7.1.a



Questions?



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