

NEW TYPES OF TRADEMARKS – PROTECTION OF MULTIMEDIA TRADEMARKS

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Abstract

The 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 trademarks and the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark changed one of the classical registration conditions for trademarks. More specifically, the graphical representation of the trademarks was replaced by the possibility to represent trademarks 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. This change enabled a more appropriate representation for sound marks, motion marks and holograms and, more important, made it possible to register a new type of trademarks – the multimedia trademarks. The complexity of multimedia trademarks could raise interesting practical challenges regarding their scope of protection, assessing their distinctiveness and their opposability. Moreover, given that such marks represent a combination of sound of images, the overlap with other intellectual property rights, such as copyrights, is more probable. Considering this element of novelty, this paper aims to analyze the early stages of the practice and anticipate potential challenges that multimedia trademarks would create, also based on the practice so far with respect to other types of non-traditional marks.

Keywords: multimedia trademarks, EU IPO, EU case-law, non-traditional trademarks, copyright

1. Trademark definition. Registration conditions for trademarks according to the current Romanian legislation¹.

From the point of view of international regulations, the possibility of registering non-traditional trademarks was strongly encouraged by the Singapore Treaty of 2006 which, in its Implementing Regulation, at Rule 3 it details the content of the trademark application for registration of three-dimensional marks, holograms, motion, color or positioning marks, as well as *non-visual* signs. With particular relevance to the subject matter of this paper, we reiterate the provisions on the representation of the motion trademarks, to which the Regulation establishes that: *Where the application contains a statement to the effect that the mark is a motion mark, the representation of the mark shall, at the option of the Office, consist of one image or a series of still or moving images depicting movement. Where the Office considers that the image or images submitted do not depict movement, it may require the furnishing of additional images. The Office may also require that the applicant furnish a description explaining the movement.*².

The doctrine also considers the Singapore Treaty to be the first international instrument to remove the condition that a trademark consists of visible signs. However, as rightly pointed out in the cited article, and as we will further detail, the difficulty of registering such signs as trademarks remains because of the absence of a direct link between the trademark and the goods and / or services applied to, the difficulty or the impossibility of graphic representation, and last but not least, the lack of distinctiveness³.

The national law lists, without limitation, a series of signs that can be registered as trademarks. As the doctrine has identified, the phrase *such as* clearly indicates that it is a non-exhaustive enumeration of signs that may constitute marks⁴.

Prior its republication in 2010, the Trademarks Law contained a less detailed list of possible types of trademarks. The doctrine thus concluded that the amendment of this article in Romanian law is the direct result of the Treaty of Singapore⁵. We do not exclude the fact that the reformulation of this article, following the republication, is to be done in the spirit of the new international commitments ratified by Romania, considering that even the Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States

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¹ This introduction was addressed within the article *Protecția mărcilor netradiționale*, published in *Revista Română de Dreptul Proprietății Intellectuale*, no. 1 / 2017, p. 183 – 198;

² Rule 3 para. (4)-(6) of the Regulations under the Singapore Treaty on the Law of Trademarks (as in force on November 1, 2011), ratified by Romania through Law no. 360 / 04.12.2007;

³ Ioan Macovei, Nicoleta Rodica Dominte, *Reflecții asupra înregistrării semnelor netradiționale ca marcă*, *Revista Română de Dreptul Proprietății Intellectuale*, no. 2 / 2013, p. 19;

⁴ Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *Dreptul Proprietății Intellectuale. Dreptul Proprietății Industriale. Mărcile și indicațiile geografice*, All Beck Publishing, Bucharest, 2003, p. 39;

⁵ Ioan Macovei, Nicoleta Rodica Dominte, *Op.cit.*, p. 20;

relating to trademarks, which stood at the base of the republishing of the Romanian law in 2010, also provided for a relatively limited list of possible trademarks⁶. We only wish to point out that, apart from affirming the possibility of registering certain types of trademarks, such a change is not aimed to permit the registration of those marks *per se*. Before republication, as it is the case today, we share the opinion that the listing of Article 2 of the Trademarks Law was and is not exhaustive. Consequently, not legislative confinement is the main obstacle to the registration of non-traditional trademarks, but the way in which they may or may not meet the conditions imposed by the definition of the mark.

In turn, 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 trademarks maintains this narrow list of signs that can be registered as trademarks⁷, despite the fact that it opened the door to new types of trademarks due to amending the trademark registrability conditions.

According to the current form of Law no. 84/1998 on trademarks and geographical indications, republished, the trademark is defined as *any sign capable of being represented graphically, such as: words, including personal names, designs, letters, numerals, figurative elements, three-dimensional shapes and, particularly, the shape of goods or of packaging thereof, colors, combinations of colors, holograms, acoustic signals, as well as any combination thereof, provided that such signs are capable of distinguishing the goods or services of one enterprise from those of other enterprises*⁸.

This legal definition includes essential elements, which we consider to be relevant in this presentation related to the protection of multimedia trademarks.

First, it highlights a first condition for a sign to be a trademark, namely that it is susceptible of graphic representation. Thus, this condition is one of the main obstacles to the possibility of registering certain categories of non-traditional trademarks, including, for example, sound trademarks. From this perspective, non-traditional trademarks are defined by doctrine as those marks that are not directly perceptible or for which it is difficult to achieve a graphic representation⁹, if not impossible, we might add.

Second, through the condition that the trademark distinguishes the goods or services of an undertaking from those of other undertakings, the Romanian law defines the distinctive character of the mark.

As regards the distinctiveness of a sign, the doctrine emphasizes that it should not be confused with the novelty, originality or creativity of the sign¹⁰. The first two concepts are rather linked to the condition of availability of the sign as a mark. As regards the third element, namely creativity, it may be a factor in assessing the distinctiveness of a trademark, in the sense that a more creative sign sets the premises of a stronger, but not necessarily, distinctive feature. It is not enough for a sign to be creative to be considered distinctive. We will see how this aspect is particularly important in interpreting the distinctiveness of new types of trademarks, especially multimedia trademarks that, although they enjoy originality, as a form of manifestation of the creativity of those who have created them, they are not necessarily and distinctive.

The distinctiveness, that is, that capacity to distinguish the goods and / or services of an entity from those of another entity, is therefore appreciable in relation to the goods or services designated by that trademark. It is equally important that this appreciation is made through the public filter, the consumers of those goods and / or services. As a consequence, the doctrine has very rigorously defined distinctiveness as a *triangular relation between trademark - product - public*. Moreover, distinctiveness, although it is a condition of registration of the sign, it is not a characteristic of the sign *per se* (although in practice we say that a trademark is distinctive), it is rather a characteristic of the relationship trademark - goods. Moreover, as the doctrine rightly emphasizes, the distinctiveness of a sign cannot be determined in isolation from the designated goods¹¹. Although we agree with all the considerations underlying this view, another possible approach is to take into account the fact that although the distinctiveness undoubtedly leads to an analysis of that relationship, it is rather a characteristic of the trademark, of course characteristic relating to the designated goods and / or services.

Also related to distinctiveness, it should be noted that this characteristic is variable in time. The distinctiveness of a trademark must be maintained, either by its use as a trademark, in the case of trademarks with acquired distinctiveness, or, in case of the intrinsic distinctiveness, itself may be lost if its proprietor does not take care that the trademark does not become a common or generic name for its goods or services¹².

⁶ Art. 2 of the preamble of 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, published in the Official Journal of the European Union of November 08, 2008;

⁷ Art. 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015 to approximate the laws of the Member States relating to trademarks, published in the Official Journal of the European Union of December 23, 2015;

⁸ Art. 2 of Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014;

⁹ Ioan Macovei, Nicoleta Rodica Dominte, *Op. cit.*, p. 19;

¹⁰ Viorel Roş, Octavia Spineanu-Matei, Dragoş Bogdan, *Op.cit.*, p. 89;

¹¹ *Idem*, p. 91-92;

¹² Ştefan Cocos, *Mărci naţionale şi mărci comunitare*, Tribuna Economică Publishing, Bucharest, 2007, p. 34 şi urm;

2. Trademark definition following the EU legal developments

As regards the trademark definition, article 3 of the Directive renounces to the phrase signs capable of being represented graphically, stating that trademarks should be 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 proprietor¹³.

The European trademark regulation, like the directive, defines the European Union mark as being any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- b) being represented on the Register of European Union trade marks ('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 proprietor¹⁴. This change is essential to open the path of recording multiple types of unconventional trademarks, especially those that are perceived by other senses than the sight. Thus, the new regulation allows the register to be adapted in a manner that trademarks could be shown through any technological form, as long as it is able to accurately determine the scope of its protection. For example, in terms of sound trademarks, they are traditionally rendered by a portative. However, we consider this only to be a compromise solution, given that not every consumer, who consults a register, may have the representation of a musical piece only by reading its portative (only a rather limited number of consumers have this capacity). For example, how many consumers can "read" the national sound trademark no. 062091, from the simple view of a fairly long portative?:



Much more effective is, for example, uploading an audio file, a practice that was not categorized as a graphic representation of the sign. From this point of view, we will detail below Metro-Goldwyn-Mayer's attempt to record the famous lion roar as a trademark at European Union level in 1996 (application no. 000143891) for goods and services in classes 09, 38 ,

41 and 42, a sound that is impossible to reproduce accurately through a portative. It was represented by a spectrogram, with the description *the sound made by the roar of a lion and represented in the attached spectrogram*. The mark was refused, one of the invoked reasons being that the graphic representation of the mark is not such as to enable the public to perceive the sound, even with the above-mentioned explanation¹⁵. However, the new definition allows offices to use the appropriate technical means to reproduce a sound trademark in such a way that it is perceived precisely by the public, as the EU IPO has already implemented even before the adoption of the new regulation, as we will see in the following.

Nevertheless, the use of new technical means could allow for a better and clearer representation of motion trademarks or holograms and, more recently, of multimedia trademarks, a new type of trademark established by the European legislation and practice. However, if the EU IPO is now ready to represent trademarks by means of video files, as we shall see, part of the Member States' offices (some of which have not even implemented the new directive yet) are not yet prepared. Under such circumstances, how could a European multimedia trademark be converted into a national trademark? Thus, a first aspect that we can now point out is the gap between the EU IPO's technical means and the national ones, which could hinder the cooperation between national systems and the European trademark system.

3. What is a multimedia trademark, what does it protect and how is it filed for registration

The European Trademark Regulation does not provide a definition of multimedia trademarks. Nevertheless, the article cited above has opened the way for the representation of motion marks and holograms by means of video files, given that traditionally, if we can talk about the representation of non-traditional trademarks using such wording, they were represented by a stream of images that would indicate possible movements.

As regards the European Union Trade Mark Implementing Regulation, its only reference to the multimedia trademarks is that of the formal requirements for the constitution of the regulatory deposit: *Where the application concerns any of the trade mark types listed in points (a) to (j), it shall contain an indication to that effect. Without prejudice to paragraphs 1 or 2, the type of the trade mark and its representation shall accord with each other as follows:*

1. in the case of a trade mark consisting of, or extending to, the combination of image and sound

¹³ Art. 3 of Directive (UE) 2015/2436;

¹⁴ Art. 4 of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, published in OJ from June 16, 2017;

¹⁵ EU IPO's refusal decision concerning EUTMA 000143891 issued on 29.09.199, pg. 1;

(multimedia mark), the mark shall be represented by submitting an audiovisual file containing the combination of the image and the sound;¹⁶

Thus, a first possible definition of these marks, namely that they are a combination of images and sounds, is delineated.

As for motion trademarks, uploading a video file is not the only way for it to be represented. Although preferable, such video can be replaced with a sequence of images, as it was the practice before the implementation of the technical means for uploading video files. Such a file is, however, the only one able to represent, in an acceptable manner, a possible combination of sounds and images, which are today the multimedia trademarks. However, it is interesting that in the case of multimedia trademarks it is not permissible to submit a description thereof, given that, as recently claimed in an on-line webinar hosted by the EU IPO, for such marks *such descriptions could rather tangle than help*¹⁷.

Therefore, it is important to note that the representation of this type of trademark is the only one that indicates the extent of its protection, without any additional information (description of colors, visual elements, image sequence etc.)

The EU-IPO's joint communication on the representation of new types of trademarks sets out the technical limits for the submission of multimedia trademarks. Thus, they can be represented by uploading an audio-visual material in MP4 format, this document also showing that at this time only Hungary and Latvia have expressed their opinion on possible acceptable formats for representing the multimedia trademarks¹⁸, which again shows the very long distance up to the harmonization of European-wide practice on with respect to this type of marks. It is also established that the uploaded video materials cannot exceed 20 MB¹⁹. It is noteworthy that the materials have no limitations in terms of their duration. It is true that file size delimitations are, in fact, a time limitation, but this is not an accurate one, a lengthier video material of poorer quality having the same dimensions as a shorter one but having a better-quality image. We insist on this issue, because, from our point of view, the lengthier a multimedia trademark is, the more its distinctive character may be affected, given that it would be more and more difficult for a consumer to memorise it, or retain its message. Moreover, even new types of trademarks, including the multimedia trademarks, in order to be registered must comply with the conditions laid down

in the *Sieckmann* judgment, namely to be clear, precise, self-contained, easily accessible, intelligible, durable and objective²⁰. We are of the opinion that a video, the longer it is from the point of view of its duration, the harder it is to meet these conditions.

As regards the Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430, it does not provide any provisions on multimedia trademarks.

On the basis of the above, it follows that multimedia marks are therefore combinations of sounds and images. Thus they could consist of a fairly wide range of trademarks themselves: first of all traditional trademarks, whether word marks, figurative or combined, sound trademarks, three-dimensional trademarks, motion trademarks, color marks and so on. Or, being signs that combine such a wide range of elements, we consider that they are likely to raise a number of practical questions.

To this end, we are looking forward to EU IPO's rendering of the first opposition decision involving a multimedia trademark. The registration of EUTM 017961198 THUNDER BALL consists of a 7 seconds clip, where initially the name THUNDER BALL is depicted, along with the appearance of an animated thunder, and at the end of an animated blue sphere with a thunder inside. The mark also consists of the sound of a voice saying "THUNDER BALL":



¹⁶ Article 3 para. (3) letter (i) of the COMMISSION IMPLEMENTING REGULATION (EU) 2018/626

of 5 March 2018, laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431, published in the EU Official Gazette of June 16, 2017;

¹⁷

<https://euipo.europa.eu/knowledge/mod/scorm/player.php?a=2501¤torg=&scoid=7396&sesskey=JaHqNCHw5X&display=popup&mcode=normal>;

¹⁸ https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/768538/en-common-communication-2018.pdf;

¹⁹ <https://euipo.europa.eu/ohimportal/en/trade-marks-examples>;

²⁰ Judgement of the European Court of Justice of December 12, 2002 in the matter C-273/00;



This mark was opposed based on the following UK national trademark registration:



Regardless of the outcome of the opposition, the EU IPO's decision and reasoning will certainly be an interesting read.

In its chapter regarding the assessment of distinctive character, the EU IPO Practice Guidelines describes the multimedia trademarks as follows: *a multimedia mark is a trade mark consisting of, or extending to, the combination of image and sound. The term 'extending to' means that these marks cover not only the combination of sound and image per se but also combinations that include word or figurative elements*²¹.

Therefore, what we consider as specific to this type of trademark is that it represents a possible combination of elements that in turn can be non-traditional trademarks, as will be explained below.

Multimedia trademarks are the natural consequence of diversifying the technical possibilities of creating a trademark deposit. As regards the EU IPO, this development began with the difficulties of registering sound trademarks, where the fulfillment of the graphic representation requirement raised difficulties for certain trademarks that could not be reproduced on the portable. We will summarize, briefly, the evolution of the representation of the sound trademarks before the EU IPO.

Concerning the graphic representation of these signs, in line with the current practice of OSIM and the EU IPO, it was emphasized that a trademark, as long as it can be represented on the portable, fulfills the condition of susceptibility to graphic representation²².

There are, however, sounds which, although they can be considered distinctive, in the sense that a consumer makes a direct connection with the

commercial origin of the goods or services they designate, cannot be represented in the form of a portable. We have mentioned above that Metro-Goldwyn-Mayer wanted to register the famous lion roar as a trademark at European Union level and how that mark was refused, one of the reasons being that the graphic representation of the mark does not allow the public to perceive that sound²³.

Although filing an audio file would be more conclusive, such a practice could not at this time be categorized as a graphical representation of the sign. One of the most relevant decisions from this point of view was Case C-283/01 *Shield Mark*, where it was established that a sound trademark can be constituted only by a sound susceptible to graphic representation, and that its representation must be clear, precise, self-contained, accessible, intelligible, durable and objective. As a consequence, onomatopoeias, animal noises or other sounds that cannot be represented graphically were excluded from protection²⁴.

In 2005, a first step was taken by the decision of the President of OHIM (at that date) on the electronic filing of sound trademarks, which established that it is possible to upload an MP3 document, having a maximum size of one Megabyte. According to this decision, loops and / or streams are not allowed²⁵. The first European mark registered by this procedure is European trademark no 004901658 on behalf of INLEX IP EXPERTISE, where the audio file can be downloaded directly from the trademark file of the EU IPO database²⁶.

Another interesting case is the attempt to register Tarzan's cry of Edgar Rice Burroughs, Inc. We quote from the EU IPO press release of 5 November 2007 (at that time OHIM) on the efforts to register this trademark, summarizing the above developments: *We all know that Tarzan of the monkeys, the character created by American novelist Edgar Rice Burroughs, has a distinct cry (...). Over the years, (...) OHIM (...) received three requests to register this appeal (...). The first application, in February 2004, included a graphical representation of the call. It was refused by the OHIM examiners on the grounds that it did not comply with the requirement that the graphic representation of the mark should be clear, precise, self-contained, easily accessible, intelligible, durable and objective and concise. The independent Boards of Appeal confirmed the examiner's objection on 27 September 2007. (...) However, a second application for the musical notation, also made in February 2004, was accepted for registration because it complied with the above formalities and "the cry" which he described was considered to be distinctive. In addition, a third*

²¹ EU IPO Practice Guidelines, <https://euipo01app.sdlproducts.com/819173/720967/trade-mark-guidelines/16-motion--multimedia-and-hologram-marks>;

²² Viorel Roş, Octavia Spineanu-Matei, Dragoş Bogdan, *Op.cit.*, p.81;

²³ EU IPO's refusal decision regarding EUTMA 000143891 issued on 29.09.199, pg. 1;

²⁴ WIPO - Smell, Sound and Taste - Getting a Sense of Non-Traditional Marks, http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html;

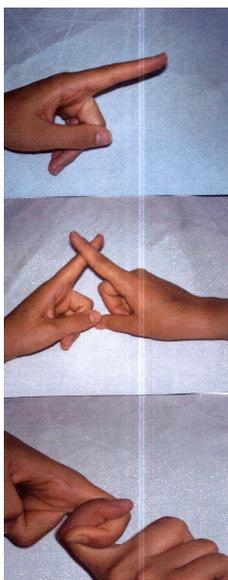
²⁵ Art. 4 para. 2 of Decision no. EX-05-03 of the President of the Office of October 10, 2005 regarding the online filing of sound marks;

²⁶ <https://euipo.europa.eu/eSearch/#details/trademarks/004901658>;

request, made in May 2006, which combines a sonogram with an MP3 sound file, is currently being examined. This was possible through a change in legislation in 2005, which means that the Office is capable of accepting sonograms provided they are accompanied by an MP3 audio file at the time of filing. It is also reiterated the increased interest in such trademarks in the market, the availability of the EU IPO to sound trademark registration as well as the need to adapt the protection conditions to the development of technological possibilities²⁷.

On the same line of development, we may consider that the emergence of multimedia trademarks was also the result of the difficulties of graphic representation of trademarks such as, for example, motion trademarks.

Motion trademarks consist of a series of two-dimensional images that, if succeeded by a certain frequency, give the feeling of movement²⁸. An example of this is the national trademark no. 080630, registered as a motion trademark, consisting of successive images of the disposal of fingers of a hand:



However, by means of multimedia trademarks allowing to represent motion and hologram trademarks by means of the available technology, such a movement can now be rendered *per se* and not only suggested by a series of images in which the position of its elements is altered, since it is possible to represent the motion, holograms and multimedia trademarks before the European Office via video files.

4. The distinctiveness of multimedia trademarks

The practice of the Alicante office has been generous to these trademarks. At the time of writing this paper, 21 trademark applications have already been filed, of which 13 have already been registered

In fact, the EU IPO Practice Guidelines mentions, in the case of multimedia trademarks, that: in the absence of relevant case-law, the general criteria for the assessment of distinctiveness will apply to these marks. The mark will be distinctive within the meaning of Article 7(1)(b) EUTMR if the sign can serve to identify the product and/or services for which registration is applied for as originating from a particular undertaking, and thus to distinguish that product/service from those of other undertakings. This distinctiveness will be assessed by reference, first, to the goods or services for which registration is sought and, second, to the relevant public's perception of that sign. These marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark (our underlining)²⁹. Or, we consider this last sentence to be essential in terms of the distinctiveness of the multimedia trademarks.

The first multimedia trademark applied for registration before the EU IPO was EUTM 017279704, a trademark designating intellectual property services and legal services in Class 45. This mark consists of the stylized representation of a moving heart, from which various other visual elements emerge, from a sound representing heart beats and the text IFORI INTELLECTUAL PROPERTY & ICT LAW:



The mark has been registered without any objection to its distinctiveness.

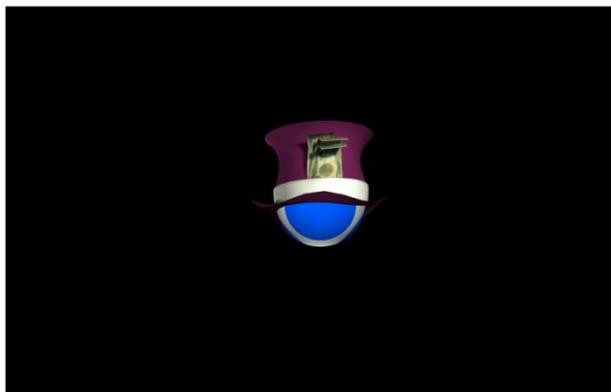
Another trademark that we find interesting is EUTM 017411315, registered, among others, for games similar to gambling. It consists of a topper that falls from a ball in the shape of a dice, a topper that has attached some paper bills, all this movement being accompanied by a drum sound, like the one who creates suspense before a draw. This mark successfully passed the examination on absolute grounds, probably on considerations that, although it contained a number of

²⁷ OHIM's press release CP/07/01 of November 5, 2007, General Affairs and External Relations Department;

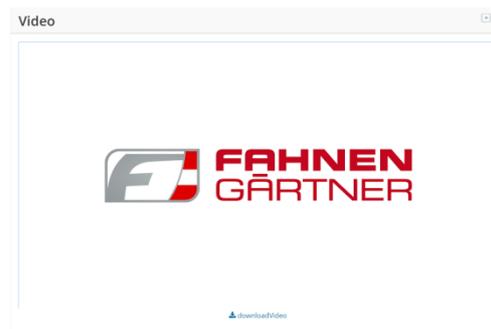
²⁸ Ștefan Cocoș, *Op. cit.*, p. 82 și urm;

²⁹ EU IPO Practice Guidelines, <https://euipo01app.sdlproducts.com/819173/720967/trade-mark-guidelines/16-motion--multimedia-and-hologram-marks>;

evocative elements of gambling, their combination was considered to be only allusive and “creative” enough to confer distinctiveness:



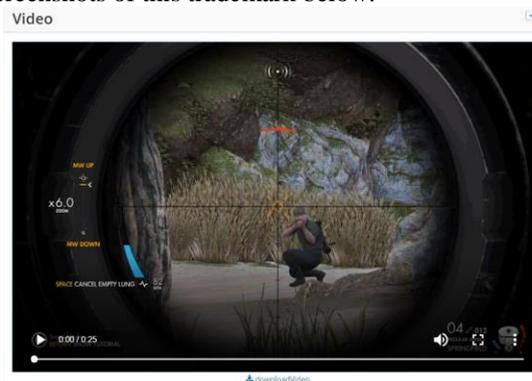
However, by analyzing other multimedia marks accepted by the Alicante Office, we cannot fail to notice that, through them, the advertising function of a trademark becomes increasingly important. Thus, if trademarks are generally directly applied to marketed products, non-traditional trademarks in general and multimedia trademarks in particular are often encountered by consumers separately from the products or services they designate. To this end, the doctrine noted that the advertising role of a trademark is rather linked to the *originality* of the mark itself, by the ideas and impression it raises to the public, its attraction, thus becoming an autonomous element of the commercial success thereof³⁰. Or, if we take a look at trademarks such as trademark no. 017451816, it does not move away from a possible advertising spot: it begins with a character waving its hand, taking a bow while ovations and applause are heard in the background, the final sequences showing the animated logo of the trademark owner:



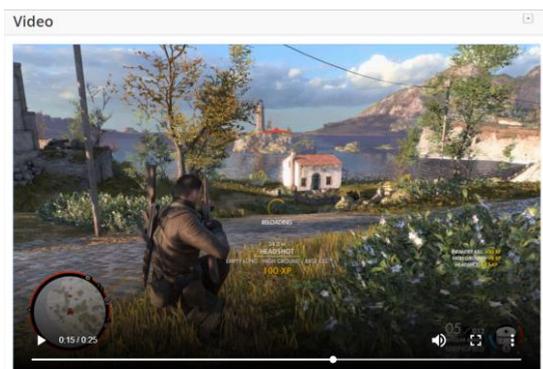
We ask ourselves, looking at this material, what is the scope of protection for the trademark represented through this video material? The red character? The combined trademark depicted at the end of the video? Both? In the latter case, this trademark has a scope of protection that, traditionally, could have made the subject of several trademark applications. The answer to this question is important because it will subsequently determine issues such as its opposability to other subsequent trademarks or, for example, what constitutes effective use thereof if it is challenged in order to remain valid.

In fact, the more complex the uploaded video material is, the more complicated we find it to assess the extent of its scope of protection as a trademark.

We take another example to this end, in respect of which the examination procedure has not yet been completed. It's EUTM no. 01728220, consisting of sequences from a video game, where the track of projectiles gone from what appears to be a sniper's weapon is followed, and the way they reach their human targets. Going beyond the possible objections based on public policy considerations, these images being able to overcome the tolerance of violence, even for the target audience, namely consumers of video games, we believe that this mark could also raise questions regarding its distinctiveness. To give a picture of this 25-second video, we've provided some screenshots of this trademark below:



³⁰ Yolanda Eminescu, *Regimul juridic al mărcilor*, Lumina Lex Publishing, Bucharest, 1996, p. 27;



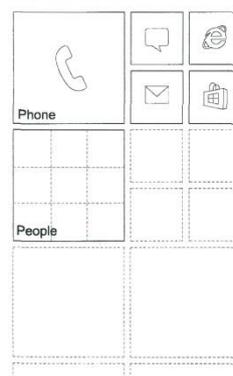
Again, it is quite difficult to imagine what could be the extent of protection for such a mark in the event it is registered. We quote an article that, although does not originate from a specialized source of intellectual property, being a website dedicated to video games, is edited by a specialist in the field and provides an interesting insight into the breadth of the protection of a multimedia trademark. This article highlights the fact that multimedia trademarks can revolutionize the means of protection for so-called *game mechanisms*, which are difficult to protect because they squeeze between different types of intellectual property rights: patents are often not applicable because the condition of novelty is difficult to fulfill, and methods are exempted from patent protection, copyright protects the source code, images, movies, but not ideas or game mechanisms, and industrial designs protection is limited to the external shape of a product. That's why, video game *cloning* is a common phenomenon³¹.

However, we are of the opinion that the protection of ideas should not be subject to trademark protection, and that the multimedia trademarks should not be used to obtain a monopoly in that direction. It is to be taken into account that these images are obtained once the game is played, so not at the time when a consumer makes his choice and therefore are not meant to indicate a commercial origin.

Also, starting from this trademark application, the problem has arisen in the same recent EU IPO-hosted webinar³², if the interface of a computer program could

be registered as a multimedia trademark. There is no clear answer yet, and the practice is in far too early stages to give a solution. Although, of course, such situations are to be examined on a case-by-case basis, it is not necessary to overlook the purpose of a trademark, namely to indicate the commercial origin of a product or service, and not to monopolize certain ideas or creations.

An interesting example in this regard is the attempt by a well-known software company that tried to gain protection for its operating system interface. Thus, it applied for registration the EUTM no. 011752863, for specific products related to the computer program interface:



This trademark has been refused, and the applicant did not successfully appeal the decision. In maintaining the rejection decision, the Board of Appeal noted that the arrangement of the multi-square interface is common for mobile phones or tablets, so that it is not meant to indicate the commercial origin of the designated products. Thus, such an interface can be registered as a trademark only to the extent that it is capable of attracting public's attention and of indicating the commercial origin of the product.³³

However, there are cases where protection for multimedia marks has been refused. For example, the European multimedia trademark no. 017889338 whose claimed figurative element is the '€' symbol, has been refused registration and is now pending appeal proceedings. We continue the hard work of talking about multimedia marks in a written work, but we will try to overcome this obstacle through its verbal description, accompanied by screenshots. Basically, this trademark consists up of a colored circle, placed on a black background, the size of which changes in a pulsation motion. Also, its color changes at intervals. In the middle of the circle are displayed different values, followed by the symbol "€". At the end of the video, the sound of 3 bells is heard:

³¹ <https://www.gamesindustry.biz/articles/2018-02-19-multimedia-trademarks-kill-cloners>;

³² <https://euipo.europa.eu/knowledge/mod/scorm/player.php?a=2501¤torg=&scoid=7396&sesskey=JaHqNCHw5X&display=popup&mode=normal>;

³³ Decision of the EU IPO's Fifth Board of Appeal of November 7, 2014;



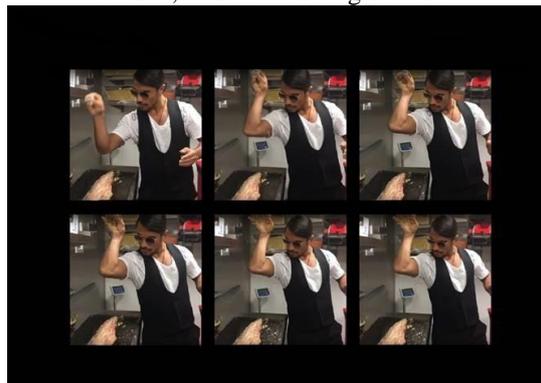
The initial test of the refusal is not available in the EU IPO electronic database. However, it is clear from the decision that this refusal was issued for the infringement of Article 7 (2) of the European Trade Mark Regulation, namely for lack of distinctive character. A thing that we recognize as interesting for a trademark consisting of visual elements, dynamic elements, colors, words and even sounds.

Despite this, the Office starts to argue that the trademark does not contain any verbal elements which could serve to identify the commercial origin of the designated goods / services. As for the number sequence, negative when the fund is red and positive when it is green, the office asserts that it is usual in commerce to reflect amounts, so they are not an element of identification. The amounts shown in the video can be used in connection with any product or service. The presentation of these elements is common and the form of presentation of the number sequence consisting of colors and sound elements is not sufficient to offer the mark distinctive character³⁴.

We chose this example to highlight the fact that, in our opinion, with regard to these types of trademarks, the test of distinctiveness appears to be more rigorous than for other traditional trademarks. Moreover, the fact that the trademarks are composed of a combination of several elements in themselves unusual for a trademark does not in itself confer distinctiveness for the mark. We therefore reiterate the conclusion that it is not the originality of the manner the elements are combined that is the one that takes precedence in appreciating the distinctiveness of the multimedia trademark, but the analysis of the perception of the sign as a whole.

Therefore, we believe that for these trademarks, the distinctiveness test will move from the realm of the analysis of the trademark – product – consumer trinomial and will rather concentrate on its ability to indicate a certain commercial origin. The objection of the Office in the example above is also analyzed among these lines. Thus, although it does examine the constituent elements of the mark, their combination and their distinctiveness in relation to the goods and services designated, the way in which the mark as a whole is capable of indicating a commercial origin seems to have more weight in the overall assessment. What is perhaps natural, since these types of trademarks are often not attached to the designated goods or services.

In fact, we consider that what is being analyzed is the overall message transmitted by such video material at a higher abstraction level than for traditional trademarks, so that the eventual distinctiveness of component elements is lost in what the trademark transmits overall. An example that we find interesting about this is referring to a trademark that, although it is a motion trademark, the basis for its partial refusal may also be applicable to multimedia trademarks. EUTM no. 016433369, consisting of a cook that spices a piece of meat with salt, was filed for registration:



Although the applicant argued that the way the chef spices that piece of meat is far from being a common one, explaining in detail every movement known as the “saltbae” technique belonging to the cook Nusret Gökçe, the Board of Appeal did not find this as a convincing argument. It held that this mark essentially consists of the image of a chef who seasoned a piece of meat with salt, the way he moves his hand not being of the essence of the mark. Therefore, the image of a chef who performs a banal act in the kitchen cannot be distinctive for some of the services designated under the trademark, so that the mark cannot fulfill its essential function³⁵. It is interesting to see that what the Board of Appeal has examined has been the overall message of the trademark, abstracted, without giving a significant importance to other creative elements of the motion trademark.

³⁴ EU IPO's Decision of 13.09.2018 on the refusal of EUTMA. 017889338;

³⁵ Decision of EU IPO's Fifth Board of Appeal of June 8, 2018, in the matter R 2661/2017-5;

5. Conflict with other intellectual property rights – copyright

Specific to some types of non-traditional trademarks is the fact that some of them are more likely to interfere with possible protection for other categories of intellectual property rights.

A good example of this is the three-dimensional trademark, where the shape of a product or packaging is traditionally the subject of industrial design protection. It would appear, at first sight, that a right-holder has a choice between two possibilities, namely to register the shape of his product both as an industrial design or as a trademark. The doctrine considered that although the industrial design appeared to have a competitor, namely the three-dimensional trademark, it must not be forgotten that although the trademark appears to offer a preferable protection, at least by the fact that the protection is unlimited in time, the possible objections to the registration of a three-dimensional sign as a trademark makes this a solution to be chosen only when that shape has the ability to distinguish the commercial origin of the designated product. Thus, an important point is emphasized, namely the need to synchronize the marketing strategy with the strategy of protection of intellectual property rights, since the acquired distinctiveness is proved by intensive use, whereas protection through industrial design registration implies the novelty as a condition³⁶.

Thus, the role and function of each means of protection must be taken into consideration: if a trademark has the role of determining the commercial origin of products and services, industrial designs have the function of protecting the aesthetic appearance to a product³⁷. In other words, the trademark protects the consumer against the risk of confusion, as long as the industrial design protects the product itself.

It should also be emphasized that through the imposed prohibitions, the trademarks law seeks to limit the cumulative protection of three-dimensional marks with other intellectual property rights, such as patents (when the form of the product is necessary for a technical result) or copyright (for forms which give a substantial value to the product)³⁸.

After the expiry of a certain patent, however, by prohibiting the registration of a three-dimensional sign consisting of a form necessary to obtain a technical result, it is also intended not to establish a monopoly by registering as a trademark on that shape. This would partly circumvent the legal provisions on the limited protection in time of the patent by monopolizing as a trademark a certain shape relevant from a technical perspective³⁹.

Reverting to the multimedia trademarks, the most likely overlap is copyright protection. However, with regard to this overlapping, the prohibition to exclude from protection those shapes which give substantial value to products has a low relevance, and may be applicable only to potential situations in which the multimedia trademarks contain the image of the designated product. Originality in the case of multimedia trademarks may consist of the way in which their elements are combined. Therefore, the overlapping of the two types of rights is more likely.

If, with regard to overlap between trademarks and industrial designs, the conditions for protection can be delimited with some clarity, the boundaries are not very clear when it comes to the intersection of multimedia trademarks and copyright.

With regard to the protection of copyrights, the condition of their protection is originality, which, without going into discussions about the objective and subjective conceptions about it, is generally defined in the continental legal system as *the personal footprint the author gives to his work* and, moreover, it is presumed, so that the infringer has the burden of proving, on a case-by-case basis, that the violated work is not, in fact, original⁴⁰.

However, although distinctiveness and originality are different notions, with different purposes, overlaps between them are not negligible. Most of the time, distinctiveness derives from a creative process, like the one behind the original creation. Elements of originality can also be found in traditional trademarks, in their figurative elements, or in non-traditional trademarks such as sound trademarks. Even more so, in the case of multimedia trademarks, which consist of combined sounds and images in a way so that they may be original.

The importance of this intersection is also due to the fact that copyright protection is spontaneous, starting with the creation of the work, while industrial design protection (with the exception of the unregistered European designs under certain conditions) or trademark protection depend on the choice of its holder to take the necessary steps to apply for registration.

Faced with these developments, the following issues, raised over time by jurisprudence and doctrine, go back to the present: circumventing the limited term of protection for copyrighted works by registering them as trademarks and the possibility or the impossibility of registering as a trademark the works fallen in the public domain, which we will especially analyze.

Regarding the registration as a trademark of works that fell into the public domain, the EU IPO

³⁶ Ekkehard Stolz, Relația dintre protecția modelelor și mărcile comerciale, Revista Română de Dreptul Proprietății Intellectuale, no. 2 / 2008, p. 55-56;

³⁷ Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, Op. cit., p.52;

³⁸ Idem, p.53-54;

³⁹ Ștefan Cocoș, Op. cit., p. 56 și urm;

⁴⁰ Viorel Roș, Dreptul Proprietății Intellectuale. Vol.I. Dreptul de autor, drepturile conexe și drepturile suis-generis, C.H. Beck Publishing, Bucharest, 2016, p. 210-217;

Guidelines does not seem to exclude this possibility. For example, in the case of sound trademarks, the Guidelines enumerates so-called sounds from the public domain, such as Beethoven's Für Elise, which may be registered as trademarks if the proprietor proves the distinctiveness acquired on the market⁴¹. Moreover, through a decision that triggered the criticism of part of the doctrine, EU IPO accepted, in 2017, the registration of the EUTM no. 016613903, on behalf of a known Intellectual Property Agency, consisting of the Rembrandt Harmenszoon van Rijn's painting *The Nightwatch*:



That law firm continued its "experiment" before the Benelux Office for Intellectual Property, which rejected the trademark, a decision maintained by the Hague Court of Appeal, which, in addition to the lack of distinctive character of the trademark due to the fact that it is a well-known work which may not indicate the commercial origin of a product, it held that the applicant has no interest in requesting this trademark for registration. The Benelux Office also claimed that the registration of such a trademark would be contrary to public policy, being unacceptable for a company to obtain protection in respect of a good belonging to the cultural heritage by applying the law on trademarks⁴².

Can we, however, consider the acquired distinctiveness to be sufficient to register a mark in spite of a public interest, perhaps greater?

In this regard, the *Shield Mark* judgment is not representative only for determining of the registration conditions for trademarks. The opinion of Advocate General Ruiz-Jarabo Colomer of 3 April 2003 contains a final remark which, although going beyond the framework of the questions referred, raises questions as to the possibility of registering works fallen in the public domain as trademarks: *it must not be overlooked that the sound signs which Shield Mark claims as being in its exclusive ownership are a cockcrow and the first notes of what is perhaps the best-known piece for piano in the history of music, a work by one of the great composers, whose genius was quickly recognized by the other composers of his day (...). Two points must be made. First, there are considerations of public interest*

that militate in favor of limiting the registrability of certain signs to enable them to be freely used by all traders. The theory of the need to keep certain signs available has been evaluated by the Court of Justice in its judgments in Windsurfing Chiemsee and Philips. I find it difficult to accept that individuals may, by means of a trade mark, perpetuate exclusive rights in natural indications and signs or those that are a direct manifestation of nature. I find it more difficult to accept, and this is the second refinement, that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys⁴³.

Another interesting decision in this respect is the one issued by the EFTA Court, whose role is the interpretation of the Treaty on the European Economic Area. The context in which this decision was issued was Oslo Municipality's application for registration of trademarks consisting of works that were to enter the public domain under Norwegian law, including the works of Gustav Vigeland, one of the most important Norwegian sculptors. Some of these requests have been refused entirely or partially. At the appeal stage, the Board of Appeal, following the ruling of the German Federal Court of Inventions in the *Mona Lisa* case, raised the question of whether, if well-known works of art are refused registration on grounds of lack of distinctiveness, raises the possibility of obtaining protection by proving the acquired distinctiveness, allowing, at least theoretically, any undertaking to obtain the trademark registration of a valuable work. On the basis of this issue, the Board of Appeal sent EFTA a preliminary question asking whether the trademark registration of works of art whose copyright period has expired may be rejected as trademarks contrary to public policy and morality, and if such rejection is conditioned by the well-known character or the value of the work.

In its recitals, the Court held that:

The term of copyright protection serves the principles of legal certainty and the protection of legitimate expectations, providing a pre-established timeframe, after which anyone can use the *creative content* of others. Considerations of the public domain serve, to a certain extent, the general interest in protecting the mind's creations from *commercial greed*. *The public domain entails the absence of individual protection for, or exclusive rights to, a work. Once communicated, creative content belongs, as a matter of principle, to the public domain. In other words, the fact that works are part of the public domain is not a consequence of the lapse of copyright protection. Rather, protection is the exception to the rule that*

⁴¹ <https://euipo01app.sdlproducts.com/819173/720963/trade-mark-guidelines/15-sound-marks>;

⁴² <http://www.chiever.com/uncategorized/nightwatch-trademark-application-rejected/>;

⁴³ Opinion of Advocate General Ruiz-Jarabo Colomer of April 3, 2003 in the matter C-283/01 *Shield Mark BV v. Joost Kist*;

creative content becomes part of the public domain once communicated. The Court also notes that the interest in rescuing the public domain is superior to individual protection or exclusive rights to the work that is the subject of a possible trade mark. Referring to the question referred to it, the Court emphasized that, in order to be applicable to that ground of refusal, it is not necessary to consider only the situation in which that mark is contrary to public policy but whether the very act of registration of such a trademark would be equivalent to a trademark removal in the public domain, is contrary to public order. This should be considered on a case-by-case basis. Thus, the Court concluded that the answer to the first three questions is that registration of a sign consisting of works for which copyright protection has expired as a trademark is not in itself contrary to public policy or to principles of morality. If registration of signs consisting of works of art as a trademark can be refused on the basis of the principles of accepted morality, it depends, in particular, on the status or perception of the relevant works of art in the relevant EEA State. The risk of misappropriation or profanity of a work may be relevant to this assessment. Registration of a sign can be refused only if the sign consists exclusively of a work belonging to the public domain and if the registration of that sign constitutes a genuine and sufficiently serious threat to a fundamental interest of society⁴⁴.

(To early for) Conclusions

Starting from the mere trademark definition, the registrability of nontraditional trademark encountered

References

- Viorel Roș, Octavia Spineanu-Matei, Dragoș Bogdan, *Dreptul Proprietății Intelectuale. Dreptul Proprietății Industriale. Mărcile și indicațiile geografice*, All Beck Publishing, Bucharest;
- Ioan Macovei, Nicoleta Rodica Dominte, *Reflecții asupra înregistrării semnelor netradiționale ca marcă*, Revista Română de Dreptul Proprietății Intelectuale, no. 2 / 2013;
- Ștefan Cocoș, *Mărci naționale și mărci comunitare*, Tribuna Economică Publishing, Bucharest, 2007;
- Viorel Roș, *Dreptul Proprietății Intelectuale. Vol.I. Dreptul de autor, drepturile conexe și drepturile sui-generis*, C.H. Beck Publishing, Bucharest, 2016;
- Ekkehard Stolz, *Relația dintre protecția modelelor și mărcile comerciale*, Revista Română de Dreptul Proprietății Intelectuale, no. 2 / 2008;
- Yolanda Eminescu, *Regimul juridic al mărcilor*, Lumina Lex Publishing, Bucharest;
- The EU IPO Practice Guidelines;
- Law no. 84 / 1998 regarding Trademarks and Geographical Indications, republished in the Official Gazette no. 337 from May 8, 2014;
- 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, published in the Official Journal of the European Union of November 08, 2008;
- Directive (EU) 2015/2436 of the European Parliament and of the Council of December 16, 2015 to approximate the laws of the Member States relating to trademarks, published in the Official Journal of the European Union of December 23, 2015;
- Judgement of the European Court of Justice of December 12, 2002 in the matter C-273/00;
- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, published in OJ from June 16, 2017;
- Regulations under the Singapore Treaty on the Law of Trademarks (as in force on November 1, 2011), ratified by Romania through Law no. 360 / 04.12.2007

⁴⁴ EFTA Judgement of April 6, 2007, in the matter E-5/16;

serious obstacles to registration mainly due to the condition that a trademark should be represented graphically. However, the changes brought by the EU legislation brought a fresh perspective on trademark registrability, and multimedia trademarks were created. Nevertheless, many steps are yet to be taken until the practice with respect to this type of marks will be harmonized at EU level, considering that now EU member states will need to find their own solutions for the purpose of implementing their new ways of representing non-traditional trademarks.

The complexity of such signs will probably create a very diverse practice with respect to assessing the distinctive character of such trademarks and to their enforcement. In these early stages, one can only anticipate that the distinctiveness assessment will focus on the overall message and concept transmitted by the trademark.

As for the potential overlap with copyright, an important issue that we see is the potential registration of works fallen in the public domain. To this end, the courts will need to assess whether transferring the cultural meaning of a short movie to a commercial one is acceptable, or it would represent a cultural impediment, considering that a monopoly established through trademark rights could represent a potential censorship of derivative work.

In any case, these recent changes represent, for sure, a new era in trademark protection, and we certainly look forward to practice developments.

- COMMISSION IMPLEMENTING REGULATION (EU) 2018/626 of 5 March 2018, laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431, published in the EU Official Gazette of June 16, 2017;
- Opinion of Advocate General Ruiz-Jarabo Colomer of April 3, 2003 in the matter C-283/01 Shield Mark BV v. Joost Kist;
- EFTA Judgement of April 6, 2007, in the matter E-5/16;
- EU IPO's refusal decision concerning EUTMA 000143891 issued on 29.09.199;
- Decision of the EU IPO's Fifth Board of Appeal of November 7, 2014;
- Decision of EU IPO's Fifth Board of Appeal of June 8, 2018, in the matter R 2661/2017-5
- EU IPO's Decision of 13.09.2018 on the refusal of EUTMA. 017889338;
- <https://euipo.europa.eu/knowledge/mod/scorm/player.php?a=2501¤torg=&scoid=7396&sesskey=J aHqNCHw5X&display=popup&mode=normal>;
- https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/768538/en-common-communication-2018.pdf;
- <https://euipo.europa.eu/ohimportal/en/trade-marks-examples>;
- WIPO - Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks, http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html;
- Decision no. EX-05-03 of the President of the Office of October 10, 2005 regarding the online filing of sound marks;
- <https://euipo.europa.eu/eSearch/#details/trademarks/004901658>;
- OHIM's press release CP/07/01 of November 5, 2007, General Affairs and External Relations Department;
- <https://www.gamesindustry.biz/articles/2018-02-19-multimedia-trademarks-kill-cloners>;
- <https://euipo.europa.eu/knowledge/mod/scorm/player.php?a=2501¤torg=&scoid=7396&sesskey=J aHqNCHw5X&display=popup&mode=normal>;
- <https://euipo01app.sdlproducts.com/819173/720963/trade-mark-guidelines/15-sound-marks>;
- <http://www.chiever.com/uncategorized/nightwatch-trademark-application-rejected/>;