



FACULTY OF LAW

**THE LEGAL PROTECTION OF SOUND, SCENT AND COLOUR MARKS IN
SOUTH AFRICA: LESSONS FROM THE EUROPEAN UNION AND THE UNITED
STATES OF AMERICA'**

Mini-thesis submitted in partial fulfilment of the requirements for the LLM degree in the

Department of Private Law

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DECLARATION

I declare that 'The legal protection of sound, scent and colour marks in South Africa: lessons from the European Union and the United States of America' is my own work, that it has not been submitted before for any degree or examination in any other university, and that all the sources I have used or quoted have been indicated and acknowledged as complete references.

Student: Garth Ernest Kallis

Signature:

A handwritten signature in black ink, appearing to read 'G. Kallis', written over a horizontal line.

Date: 7 June 2018

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KEY WORDS

- Non-traditional trade mark
- Registrability
- Graphical representation
- Distinguishing function
- Colour marks
- Scent marks
- Sound marks
- Free competition
- Sieckmann test
- Technological development

ABBREVIATIONS

ASA-	Advertising Standard Authority
DSU-	Dispute Settlement Understanding
EU-	European Union
EUTMR-	European Union Trade mark Regulation
IP	Intellectual Property
IPR	Intellectual Property Rights
NBC-	National Broadcasting Commission.
SA-	South Africa
TLT-	Trade mark Law Treaty 1994.
TRIPS-	Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.
USA-	United States of America
UK	United Kingdom
WIPO-	World Intellectual Property Organisation
WTO-	World Trade Organisation
YSL-	Yves Saint Laurent

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CHAPTER 1

INTRODUCTION

1.1 BACKGROUND

A trade mark is defined as a sign that is capable of distinguishing the goods or services of one enterprise from those of other enterprises.¹ Trade marks, copyright, patents and designs are some of the forms of intellectual property. Trade marks can be divided into traditional trade marks and non-traditional trade marks. Traditional trade marks are capable of being represented graphically, for example logos, service marks or company names. Non-traditional trade marks are generally not capable of being represented graphically. Examples of these marks are *inter alia*, scent, taste, touch and sound marks.

Technology is changing the way business is being conducted.² The registration of non-traditional trade marks has grown exponentially as businesses seek to use innovative ways to protect their brands.³ Non-conventional trade marks may be visible signs, examples of which include colours, shapes, moving images, holograms and positions or non-visible signs such as sounds, scents, tastes, textures.⁴ Visible signs may easily be registered since they satisfy the requirement of graphical representation. Non-visible marks do not generally meet this requirement which makes their registration more complicated.⁵ An example of a registered visible non-traditional trade marks is the four finger shape of Kit Kat chocolates.⁶

¹ 'World Intellectual Property Organisation website' available at <http://www.wipo.int/trademarks/en/> (accessed on 14 May 2016).

² Mullineux A *Technology and Finance: Challenges for Financial Markets, Business Strategies and Policy Makers* (2003) 49.

³ Saez C 'Some See Rise In Non-Traditional Trade marks; National Registries Not Yet' available at <http://www.ip-watch.org/2008/06/20/some-see-rise-in-non-traditional-trademarks-national-registries-not-yet/> (accessed on 12 December 2016).

⁴ Radhakrishnan R & Balasubramanian S *Intellectual Property Rights: Text and Cases* (2008) 113.

⁵ Mezulanik E 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 30 March 2017).

⁶ *Soci t  des Produits Nestl  SA v International Foodstuffs* 100/14 [2014] ZASCA 187 para 71.

1.2 THE BASIS OF TRADE MARK PROTECTION

One of the primary reasons for the existence and protection of trade marks is that they facilitate and enhance consumer decisions.⁷ Trade marks inhibit confusion in the market place.⁸ Consumers are able to differentiate between different trade marks and can thus appreciate whether or not a product is linked with a brand or not.⁹ Trade marks therefore fulfil an important function in the marketplace. Firstly, a trade mark is used to distinguish one's goods from those of another.¹⁰ In *Adidas AG and another v Pepkor Retail Limited*¹¹ the court held that the distinguishing function prevents confusion amongst consumers as it allows them to differentiate between goods and services.¹² This means that when a consumer buys a product there must be no doubt in his mind that the product comes from a particular trade mark proprietor.¹³ In the European case, *Hoffman La Roche & Co v Centrafarm Vertriebsgesellschaft. Pharmazeutischer Erzeugnisse*¹⁴ the Court held that the identification of where a product comes from is of paramount importance since this may lead to repeated purchases.¹⁵ The distinguishing function of a trade mark prevents the possibility of confusion by differentiating one product from other products.¹⁶

Secondly, a trade mark is used to indicate the origin of the goods and services.¹⁷ The essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin.¹⁸ This means that a trade mark informs the consumers that products with the same trade mark originate from the same source.¹⁹ It also serves as a personal connection between the supplier and consumer as the consumer sees the trade mark associated with product and trusts it based on the consumer's opinion of the product

⁷ Calboli I & de Werra J *The Law and Practice of Trade Mark Transactions: A Global and Local Outlook* (2016) 424.

⁸ Bouchoux D *Intellectual Property: The Law of Trade Marks, Copyrights, Patents, and Trade Secrets* (2016) 127.

⁹ Michaels A & Norris A *A Practical Approach to Trade Mark Law* (2010) 187.

¹⁰ Klopper H, Pistorius T, Tong L *et al*, *Law of Intellectual Property in South Africa* 2ed (2017) 115.

¹¹ *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3.

¹² *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3 para 3.

¹³ *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3 para 29.

¹⁴ *Hoffmann-La Roche & Co. AG v. Centrafarm Vertriebsgesellschaft. Pharmazeutischer Erzeugnisse mbH*, Case 102/77, [1978] ECR 1139 para7.

¹⁵ *Hoffmann-La Roche & Co. AG v. Centrafarm Vertriebsgesellschaft. Pharmazeutischer Erzeugnisse mbH*, Case 102/77, [1978] ECR 1139.

¹⁶ *Adidas AG & Another v Pepkor Retail Limited* (187/12) [2013] ZASCA3 para 29.

¹⁷ Klopper H, Pistorius T, Tong L *et al*, (2017) 115.

¹⁸ Klopper H, Pistorius T, Tong L *et al*, (2017) 115.

¹⁹ Klopper H, Pistorius T, Tong L *et al*, (2017) 115.

and the general reputation of the product.²⁰ In *Verimark (Pty) Limited vs. Bayerische Motoren Werke Aktiengesellschaft*²¹ the court held that a trade mark must serve as a badge of origin.²² The origin and distinguishing functions are two sides of the same coin. In order to differentiate the products, the consumer needs to know the origin of the different brands.

Thirdly, affixing trade marks to goods or services also serves as a guarantee to consumers that all products with the same trade mark have the same quality.²³ Consumers are influenced by trade marks when deciding on what or what not to buy,²⁴ and they tend to purchase brands with a good reputation.²⁵ Trade marks serve as a reminder of the quality a certain manufacturer's products possess.²⁶ The quality function of a trade mark thus ensures that consumers can be sure of the reputation of the product.²⁷ In the *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another*,²⁸ the court held that trade marks facilitate choice amongst consumers by guaranteeing the product's presumed quality.²⁹

Finally, a trade mark fulfils an advertising function as it reminds consumers of the goods or services associated with the trade mark. It thus serves as a promotional method in commercial transactions.³⁰ There is a growth in advertising in modern commerce and in this way a trade mark is used to create demand for a product.³¹ It is argued that advertising is not meaningful without the use of a trade mark because the trade mark appeals to the consumer.³² The advertising function is said to be a secondary function of a trade mark, whilst the origin and

²⁰Naser M 'Re-examining the Functions of Trade Mark Law' (2008) *Chicago-Kent Journal of Intellectual Property* 100.

²¹ *Verimark (Pty) Ltd v Bayerische Motoren Werke Aktiengesellschaft; Bayerische Motoren Werke Aktiengesellschaft v Verimark (Pty) Ltd* 2007 (6) SA 263 (SCA) para 6.

²² *Verimark (Pty) Ltd v Bayerische Motoren Werke Aktiengesellschaft; Bayerische Motoren Werke Aktiengesellschaft v Verimark (Pty) Ltd* 2007 (6) SA 263 (SCA) para 5.

²³ Klopper H, Pistorius T, Tong L *et al*, (2017) 115.

²⁴ Hanak E 'The Quality Assurance Function of Trade Marks' (1974) 43 *Fordham Law Review* 364.

²⁵ Ang L *Integrated Marketing Communications: A focus on new technologies and advanced theories* (2014) 73.

²⁶ Duquenois P, Jones S & Blundell B *Ethical, Legal and Professional Issues in Computing* (2008) 62.

²⁷ Aumir Z 'Legal Importance and Functions of Trade Marks' available at http://courtingthelaw.com/2015/10/02/commentary/legal-importance-and-functions-of-trademarks-2/#_ftn61 (accessed on 02 June 2016).

²⁸ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 80.

²⁹ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC).

³⁰ Klopper H, Pistorius T, Tong L *et al*, (2017) 115.

³¹ Wilkof N, Burkitt D *Trade Mark Licensing* (2005) 36.

³² Cohen T *European Trade Mark Law: Community Trade Mark Law and Harmonized National Trade Mark Law* (2010) 13.

distinguishing function of a trade mark are seen as the most important functions.³³ The latter are thus seen as the primary functions.³⁴ Non-traditional trade marks fulfil the above functions, but the extent to which they can be protected is a contentious issue.

1.3 THE DEVELOPMENT AND RISE OF NON-TRADITIONAL TRADE MARKS

While the norm was initially to distinguish brands through visual means³⁵ the rise in technology has provided a means to trade mark proprietors for the creation of marks which appeal to other senses of the human body such as scent and sound.³⁶ Competition is increasing and in order to grow, businesses have to find ways of attracting consumers.³⁷ This thesis will focus on colour, scent and sound marks.

Scent is one of the most potent types of human memory.³⁸ As such business people find this an attractive option to engrave their reputation into consumer minds.³⁹ A very important aspect of designing a trade mark is creating a way to attract the attention of consumers and eventually leave a lasting impression on them.⁴⁰

Jay Burgett argues that scents have the ability to ‘conjure up images.’⁴¹ Examples of this include the smell of fresh cut grass, which may lead a consumer to think about springtime and the smell of salty air, which may induce consumers to think of the beach.⁴² Kumar argues that people interact with the world around them and that they respond consciously and sub-consciously to scent.⁴³ This differs from visual and sound marks which can only be perceived

³³ Naser M *Revisiting the Philosophical Foundations of Trade Marks in the US and UK* (2009) 78.

³⁴ Naser M (2009) 78.

³⁵ Norman H *Intellectual Property Law Directions* (2011) 349.

³⁶ Norman H (2011) 349.

³⁷ Boone L & Kurtz D *Contemporary Marketing, Update 2015* (2014) 65.

³⁸ Graham Beaumont J *Brain power: unlock the power of your mind* (1990) 101.

³⁹ Vaver D *Intellectual Property Rights: Critical Concepts in Law, Volume 5* (2006) 213.

⁴⁰ Shilling D *Essentials of Trade Marks and Unfair Competition* (2002) 163.

⁴¹ Burgett J ‘Hmm...What’s That Smell? Scent Trade Marks—A United States Perspective’ available at <http://www.inta.org/INTABulletin/Pages/Hmm%E2%80%A6What%E2%80%99sThatSmellScentTrademarks%E2%80%94AUnitedStatesPerspective.aspx> (accessed on 12 March 2017).

⁴² Burgett J ‘Hmm...What’s That Smell? Scent Trade Marks—A United States Perspective’ available at <http://www.inta.org/INTABulletin/Pages/Hmm%E2%80%A6What%E2%80%99sThatSmellScentTrademarks%E2%80%94AUnitedStatesPerspective.aspx> (accessed on 12 March 2017).

⁴³ Kumar A ‘Protecting Smell Marks: Breaking Conventionality’ 2016 *Journal of Intellectual Property Rights* 130.

consciously.⁴⁴ Scent mark registration is thus attractive as consumers can form an emotional bond with scent.⁴⁵

Sound marks are another form of trade marks that have emerged from the development of technology.⁴⁶ Music and sounds have become more accessible and may be played on various mediums such as MP3 players, computers and even mobile phones.⁴⁷ Sounds and music have the ability to affect one's mind set and emotions.⁴⁸ A simple jingle can be associated with a company that has built a reputation with that particular sound.⁴⁹ It is thus another effective and innovative mechanism to fulfil the functions of a trade mark.

1.4 PROBLEM STATEMENT

A trade mark is defined by the Trade Marks Act 194 of 1993 (hereinafter referred to as the Act) as:

‘... a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing those goods or services from the same kind of goods or services connected in the course of trade with any other person’.⁵⁰

A ‘mark’ is defined as ‘any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods, or any combination thereof’.⁵¹ Not all ‘marks’ constitute a trade mark. A ‘mark’ must satisfy the graphic representation requirement. Non-traditional signs, particularly the invisible signs, are different from the traditional trade marks, and their registration may accordingly be problematic since they are generally not capable of being represented graphically. It is against this background, that the research examines the registration of non-traditional signs, particularly sound, scent and colour marks in South Africa. The question that springs to mind is: to what extent can sound, scent and colour trade signs be protected in terms of South African trade mark law?

⁴⁴ Kumar A ‘Protecting Smell Marks: Breaking Conventionality’ 2016 *Journal of Intellectual Property Rights* 130.

⁴⁵ Mogelonsky L *Llamas Rule* (2013) 93.

⁴⁶ Grainge P *Brand Hollywood: Selling Entertainment in a Global Media Age* (2007) 89.

⁴⁷ Sterne J *MP3: The Meaning of a Format* (2012) 1.

⁴⁸ Harris M *Music and the Young Mind: Enhancing Brain Development and Engaging Learning* (2009) 11.

⁴⁹ Bouchoux D (2016) 33.

⁵⁰ Section 2 of the Trade Marks Act 194 of 1993.

⁵¹ Section 2 of the Trade Marks Act 194 of 1993.

In order to answer this overarching question certain sub-questions will be addressed in the thesis, namely:

- Which categories of non-traditional trade marks are registrable in South Africa and what is the best way of regulating these marks?
- What are the difficulties posed in affording sound, scent and colour marks extensive protection?
- How can a balance be struck between the interests of trade mark proprietors vis-à-vis the interests of the public?
- Should South Africa restrict or expand the definition of a trade mark?
- Alternatively, should the graphic representation be removed from the requirements which a mark must satisfy to qualify for registration?

1.5 AIM OF THE THESIS

The aim of this thesis is to examine the registrability of non-traditional trade marks and to what extent they can be registered in South Africa. The thesis will provide a comparative study regarding how non-traditional trade marks are registered in South Africa, the United States of America and the European Union. The United States of America will be discussed because of its liberal approach to the registration of non-traditional trade marks⁵² and the European Union⁵³ will be discussed because of its more conservative approach to the registration of non-traditional trade marks. The registration of trade marks confers exclusive rights on its proprietors to use the trade mark in respect of goods and services in their relevant business. This creates a monopoly which diminishes competition since the public is restricted from using these marks. This becomes problematic since, for example, there are a limited number of basic colours that exist. This thesis will discuss the competing interests of the proprietor of the said trade marks vis-à-vis the interest of the broader society and how a balance can be struck between these competing interests.

The thesis will also discuss the advantages and disadvantages of affording non-traditional trade marks extensive protection in South Africa. Therefore, it will discuss why it may be necessary to do so, and possible solutions will also be explored.

⁵²See chapter 5 part 5.3.2.

⁵³ See chapter 5 part 5.3.2.

1.6 SIGNIFICANCE OF STUDY

This study is important because trade marks facilitate commerce or trade.⁵⁴ Trade marks fulfil an important function as products are being sold all over the world. The registration trade marks allows the proprietor the positive right to use the mark and the negative right to prevent competitors from using it.⁵⁵

Times are changing and businesses are looking for innovative ways to distinguish their products from those of the competitor. The registration of non-traditional is thus significant because it gives rise to new ways of marketing their goods and services. The thesis provides a detailed insight on the importance of the legal protection of non-traditional marks. It also seeks to make a contribution to academic discourse on the protection of sound, scent and colour marks.

1.7 RESEARCH METHODOLOGY

This thesis will adopt the desktop research methodology which will involve the reading and analysis of primary sources such as statutes, treaties, and international conventions governing trade marks as well as case law. It will also rely on secondary sources such as books, journal articles and the internet sources. The thesis will also undertake a comparative study to determine the best approach that South Africa should adopt insofar as the protection of scent, sound and colour marks are concerned.

⁵⁴ Britt D 'Impact of Globalization in Creating Sustainable Competitive Advantage' available at <http://www.sdcexec.com/article/10289694/impact-of-globalization-in-creating-sustainable-competitive-advantage> (accessed on 29 April 2016).

⁵⁵ Klopper H, Pistorius T, Tong L *et al*, (2017) 103.

1.8 CHAPTER OUTLINE

This thesis has six chapters:

Chapter 1

This chapter is an introductory chapter. It introduces the topic by giving an overview of the legal protection of non-traditional trade marks in South Africa. It will also discuss the functions of a trade mark and why they are important in promoting trade.

Chapter 2

This chapter discusses the international conventions governing trade mark law. These international conventions include the Agreement on Trade-Related Aspects of Intellectual Property Rights,⁵⁶ the Madrid system,⁵⁷ the Paris Convention for the Protection of Industrial Property,⁵⁸ the International Classification of Goods and Services⁵⁹ and the Singapore Treaty on the Law of Trade Marks.⁶⁰ The advantages and disadvantages of these international conventions are also discussed.

Chapter 3

This chapter focuses on the requirements for registration of trade marks in South Africa. The Trade Mark Act of 1993 is examined and the requirements that the Act prescribes in order for a trade mark to be registered in South Africa, as well as the Guidelines which were published by the registrar in the Patent Journal.⁶¹ The guidelines regulates the registration of sound, scent and colour marks in South Africa.

Chapter 4

This chapter examines the registration of traditional and non-traditional trade marks such as sound, scent and colour trade marks in the United States of America (USA) and in the European Union (EU). The purpose of this chapter is to provide insight into the different approaches to build a basis for a comparative analysis.

⁵⁶ Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

⁵⁷ The Protocol relating to the Madrid Agreement 1989 & The Madrid Agreement Concerning the International Registration of Marks 1891.

⁵⁸ The Paris Convention for the Protection of Industrial Property (1883).

⁵⁹ The Nice Agreement on the Classification of Goods and Services 1957.

⁶⁰ The Singapore Treaty on the Law of Trade Marks 2006.

⁶¹ CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' *2009 Patent Journal* 460.

Chapter 5

This chapter provides a comparative analysis of the USA, EU and South Africa. The purpose of the analysis is to ascertain the differences and similarities in terms of their approaches to the registration of colour, scent and sound marks. It is to also ascertain what would be the best approach. Furthermore, the chapter discusses the question whether will be beneficial to grant sound, scent and colour trade marks extensive protection and how a balance may be struck between the competing interests. .

Chapter 6

This chapter contains the conclusion and the recommendations with regards to the registration of sound, scent and colour in South Africa. The chapter further provides a brief summary of the findings in each chapter and draws some lessons from the approaches adopted in the countries under study.

CHAPTER 2

THE INTERNATIONAL LEGAL FRAMEWORK GOVERNING TRADE MARK

2.1 INTRODUCTION

Trade increased in the nineteenth century and this created the need for the removal of obstacles to free trade.⁶² The existence of different laws intellectual laws across countries became an obstacle to trade.⁶³ To ease this situation, various international treaties were adopted.⁶⁴ Some of these international treaties have the aim of facilitating trade while others were aimed at harmonising trade mark laws and establishing minimum standards.⁶⁵ This chapter examines the international instruments governing trade marks, namely the Paris Convention for the Protection of Industrial Property,⁶⁶ the Madrid system,⁶⁷ the International Classification of Goods and Services,⁶⁸ the Agreement on Trade-Related Aspects of Intellectual Property Rights, the Trade Mark Law Treaty⁶⁹ and the Singapore Treaty on the Law of Trade Marks.⁷⁰ The extent to which these instruments accommodate for non-traditional trade marks such as scent, sound and colour marks are also discussed. It should, however, be noted that the legal provisions governing registration are the same for all types of marks. The significance and disadvantages of these international conventions are also discussed.

Trade marks are national rights.⁷¹ This means that a registered trade mark is only protected in the country in which the trade mark is registered.⁷² This is where trade marks differ from copyright where there is an automatic extension of protection to other countries.⁷³ Therefore ordinarily a separate application for the registration of a trade mark would be required in every

⁶²Dadkhah K *The Evolution of Macroeconomic Theory and Policy* (2009) 233.

⁶³Hart T, Fazzani L and Clark S (2006) 150.

⁶⁴Hart T, Fazzani L and Clark S (2006) 150.

⁶⁵MacLaren T *Licensing Law Handbook: Intellectual Property and Licensing Law. The European Union and Asia* (2004) 7.

⁶⁶The Paris Convention for the Protection of Industrial Property (1883).

⁶⁷The Protocol relating to the Madrid Agreement 1989 & The Madrid Agreement Concerning the International Registration of Marks 1891.

⁶⁸The Nice Agreement on the Classification of Goods and Services 1957.

⁶⁹The Trade Mark Law Treaty 1994.

⁷⁰The Singapore Treaty on the Law of Trade Marks 2006.

⁷¹Bodenhausen G *Guide to the Application of the Paris Convention for the Protection of Industrial Property, as Revised at Stockholm in 1967 (1968)* 35.

⁷²Hart T, Fazzani L and Clark S *Intellectual Property Law* 4ed (2006) 150.

⁷³Hart T, Fazzani L and Clark S (2006) 150.

country that the proprietor wishes to have protection in.⁷⁴ This of course can be a very expensive and time consuming process.⁷⁵ There are costs associated with trade mark applications, firstly one needs an attorney in the said country which gives rise to legal fees. Secondly, the applicant has to pay application fees in every country where registration is sought.⁷⁶

2.2. THE PARIS CONVENTION

The Paris Convention for the Protection of Industrial Property (hereinafter referred to as the Paris Convention) was one of the first international conventions on trade marks.⁷⁷ It was signed in Paris, France on March 20th, 1883.⁷⁸ It is administered by the World Intellectual Property Organisation (WIPO)⁷⁹ The Paris Convention has 176 signatories.⁸⁰ South Africa, the United States of America (USA) and many European Union (EU) countries like Finland and France are all members of the Paris Convention.⁸¹ The Paris Convention is aimed at harmonising intellectual property law.⁸²

2.2.1 PROVISIONS OF THE PARIS CONVENTION

The substantive provisions of the Convention fall into three main categories: national treatment, right of priority and common rules.⁸³ National treatment will be discussed first.

National Treatment requires a country to afford proprietors of other nations the same protection as those from its country.⁸⁴ Article 2.1 of the Paris Convention⁸⁵ reads as follows;

‘Nationals of any country of the Union shall, as regards the protection of industrial property,

⁷⁴Shieh J ‘The Paris Convention versus the PCT’ available at <https://www.inovia.com/2013/02/the-paris-convention-versus-the-pct/> (accessed on 25 May 2016).

⁷⁵ Shieh J ‘The Paris Convention versus the PCT’ available at <https://www.inovia.com/2013/02/the-paris-convention-versus-the-pct/> (accessed on 25 May 2016).

⁷⁶Finkelstein W *The Intellectual Property Handbook: A Practical Guide for Franchise, Business, and IP Counsel* (2005) 58.

⁷⁷Michaels A *A Practical Guide to Trade Mark Law* (2002) 98.

⁷⁸ Mandeville T *Understanding Novelty: Information, Technological Change, and the Patent System* (1996) 16.

⁷⁹ Fawcett J & Torremans P *Intellectual Property and Private International Law* (2011) 688.

⁸⁰ World Intellectual Property Organisation ‘Contracting Parties > Paris Convention’ available at http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=2 (accessed on 24 August 2016).

⁸¹World Intellectual Property Organisation ‘Contracting Parties > Paris Convention’ available at http://www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=2 (accessed on 24 August 2016).

⁸²World Intellectual Property Organisation ‘International Treaties and Conventions on Intellectual Property’ available at <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> (accessed on 3 June 2016).

⁸³Nakagawa J *International Harmonization of Economic Regulation* (2011) 138.

⁸⁴Article 2.1 of the Paris Convention for the Protection of Industrial Property (1883).

⁸⁵Article 2.1 of the Paris Convention for the Protection of Industrial Property (1883).

enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.⁸⁶

The objective of this provision is to prevent discrimination between members.⁸⁷ This helps facilitate trade and prevent unfair competition.⁸⁸ Where a member state to the Paris Convention provides extensive protection for trade marks for its own nationals then that member state should also provide extensive treatment for trade marks owned by nationals of other member states seeking protection.⁸⁹

Right to priority means that, when the first regular application is filed in one of the contracting states, the applicant may, within 6 months apply for trade mark protection in any of the other contracting states.⁹⁰ These subsequent applications ‘will be regarded as if they had been filed on the same day as the first application.’⁹¹ They are given priority over other applications filed during that period for the same mark.⁹² The advantage of this is that applicants who want to protect their trade marks have 6 months to secure this protection.⁹³

The Paris Convention prescribes a few common rules that all members must follow.⁹⁴ One of these rules is that a member may not refuse or invalidate an application, by a national of another member state, for the registration of a mark on the ground that ‘filing, registration or renewal has not been effected in the country of origin.’⁹⁵ This means that registration is independent and not linked to prior registration in the country of origin.

⁸⁶Article 2.1 of the Paris Convention for the Protection of Industrial Property (1883).

⁸⁷Weiss F, Denters E & de Waart P *International Economic Law With a Human Face* (1998) 461.

⁸⁸Henning-Bodewig F & Hilty R *Law Against Unfair Competition: Towards a New Paradigm in Europe?* (2007) 55.

⁸⁹Article 2.1 of the Paris Convention for the Protection of Industrial Property (1883).

⁹⁰Article 4 of the Paris Convention for the Protection of Industrial Property (1883).

⁹¹World Intellectual Property Organisation ‘Summary of the Paris Convention for the Protection of Industrial Property (1883)’ available at http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (accessed on 10 June 2016).

⁹²Bodenhause G *Guide to the Application of the Paris Convention for the Protection of Industrial Property, as Revised at Stockholm in 1967* (1968) 35.

⁹³Klopper H, Pistorius T, Tong L *et al*, *Law of Intellectual Property in South Africa* 2ed (2017) 142.

⁹⁴Bodenhause G (1968) 35.

⁹⁵Article 6.2 of the Paris Convention for the Protection of Industrial Property (1883).

2.2.2 SIGNIFICANCE AND DISADVANTAGES OF THE PARIS CONVENTION

An important advantage of the Paris Convention is that it was one of the first instrument that sought to harmonise trade mark law.⁹⁶ The national treatment clause is pertinent because it prevents member states from using trade mark laws to discriminate against other nations.⁹⁷ The right to priority saves time and money. The non-discrimination principle and right of priority are been embraced in other instruments governing trade marks

One of the disadvantages of the Paris Convention is that it does not provide for any sanctions if member states do not comply with the minimum standards of protection set out in the Convention.⁹⁸ This could lead to non-compliance of the provisions as members can ignore these provisions without fear of punishment.⁹⁹ Another shortcoming of the Paris Convention is that it did not provide a mechanism for international applications of marks.¹⁰⁰ This was provided for by the Madrid System¹⁰¹ which will be discussed next.

2.3. THE MADRID SYSTEM

The Madrid System consists of the Madrid Agreement Concerning the International Registration of Marks (the Madrid Agreement) and the Protocol relating to the Madrid Agreement (the Madrid Protocol).¹⁰² The Madrid Agreement and the Madrid Protocol are two separate treaties but the way they are regulated and the members overlap.¹⁰³ The Madrid Agreement was concluded in 1891 while the Madrid Protocol was concluded in 1989.¹⁰⁴ South Africa is not a member of the Madrid System while the European Union (EU) and the United States of America (USA) became members in 2004 and 2006 respectively.¹⁰⁵

⁹⁶Mighty Recruiter 'Information About the Paris Convention for the Protection of Industrial Property' available at <https://www.mightyworks.com/recruiter/learn/information-about-the-paris-convention-for-the-protection-of-industrial-property/> (accessed on 25 May 2016).

⁹⁷Article 2.1 of the Paris Convention for the Protection of Industrial Property (1883).

⁹⁸Isaac B (2000) 47.

⁹⁹Isaac B (2000) 47.

¹⁰⁰Bentley L & Sherman B *Intellectual Property Law* 4ed (2014) 820.

¹⁰¹Bentley L & Sherman B (2014) 820.

¹⁰²Bryer L, Lesbon S & Asbell M *Intellectual Property Strategies for the 21st Century Corporation: A Shift in Strategic and Financial Management* (2016) 73.

¹⁰³World Intellectual Property Organisation *Guide to the International Registration of Marks Under the Madrid Agreement and the Madrid Protocol* (2004) xxiii.

¹⁰⁴Shin Tang Y *The International Trade Policy for Technology Transfers: Legal and Economic Dilemmas on Multilateralism Versus Bilateralism* (2009) 94.

¹⁰⁵World Intellectual Property Organisation 'Madrid Agreement Concerning the International Registration of Marks and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks' available at http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf (accessed on 25 August 2016).

2.3.1 SIGNIFICANCE OF THE MADRID SYSTEM

The Madrid System ensures that a trade mark can be registered in many countries by way of one application.¹⁰⁶ The Madrid Agreement was adopted because there was a need for simplification in the filing process for trade mark registration in many countries.¹⁰⁷ Before the adoption of the Madrid Agreement, countries had to file separate applications in every country they wished to obtain trade mark protection in.¹⁰⁸ The Madrid Agreement changed this position.¹⁰⁹ It permits a person to file an international application for trade mark registration in many countries which are members to the Madrid Agreement.¹¹⁰ This is subject to the requirements that the person must be domiciled or established in a member state and that he has an existing registration in that country.¹¹¹ There is also an examination period under the Madrid Agreement¹¹² and if no objection is made during the 12 months, then registration takes place.¹¹³ This period has been extended to 18 months under the Madrid Protocol.¹¹⁴

International registration of all trade marks under the Madrid System is based on registration in a trade mark owner's home country.¹¹⁵ This requirement may, however, become a problem for the international registration of some non-traditional trade marks as they can only be registered if they are protected in terms of national law.¹¹⁶ The aim of the Madrid System is to facilitate the international registration of trade marks.¹¹⁷ It therefore covers all forms of trade marks even though it does not explicitly refer to non-traditional trade marks.¹¹⁸

2.3.2 DIFFERENCES BETWEEN MADRID AGREEMENT AND MADRID PROTOCOL

Although under the Madrid Agreement only countries could be members,¹¹⁹ the Madrid Protocol makes provision for intergovernmental organisations.¹²⁰ An example of this is the EU,

¹⁰⁶Bryer L, Lesbon S & Asbell M (2016) 73.

¹⁰⁷Sreenivasulu N *Law Relating to Intellectual Property* (2013) 45.

¹⁰⁸Schechter R & Thomas J *Intellectual property: The Law of Copyrights, Patents, and Trade Marks* (2003) 829.

¹⁰⁹Hart T, Fazzani L and Clark S (2006) 151.

¹¹⁰Article 1.2 of the Madrid Agreement Concerning the International Registration of Marks 1891.

¹¹¹Article 1.3 of the Madrid Agreement Concerning the International Registration of Marks 1891.

¹¹²Hart T, Fazzani L and Clark S (2006) 152.

¹¹³Klopper H, Pistorius T, Tong L *et al*, (2017) 143.

¹¹⁴Article 5.2 (b) of the Protocol relating to the Madrid Agreement 1989.

¹¹⁵Article 1.3 of the Madrid Agreement Concerning the International Registration of Marks 1891.

¹¹⁶Article 1.3 of the Madrid Agreement Concerning the International Registration of Marks 1891.

¹¹⁷Sreenivasulu N (2013) 45.

¹¹⁸Dharni K & Pandey N *Intellectual Property Rights* (2014) 77.

¹¹⁹Cogen M *An Introduction to European Intergovernmental Organizations* (2016) 54.

¹²⁰Article 14 of the Protocol relating to the Madrid Agreement 1989.

which is a member of the Madrid Protocol.¹²¹ Members have 12 months in terms of the Madrid Agreement in which to object an application for international registration.¹²² As previously discussed, this period is extended to 18 months under the Madrid Protocol.¹²³ The Madrid Agreement gave rise to a disadvantage called central attack.¹²⁴ The central attack occurs when a trade mark owner's home country cancels registration within five years after the date of registration.¹²⁵ This then leads to the international registrations being cancelled as they are based on registrations in the home country.¹²⁶ The Madrid Protocol remedies this shortcoming by allowing cancelled applications to be filed again with the same priority date as the original application.¹²⁷

2.4. THE INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES

The International Classification of Goods and Services for the Purposes of the Registration of Marks¹²⁸ (hereinafter referred to as the Nice Classification) came into force after an agreement was concluded at the Nice Diplomatic Conference on June 15, 1957.¹²⁹ It was revised in Stockholm, in 1967, at Geneva, in 1977, and was amended in 1979.¹³⁰ The eleventh edition came into force in January 2017 and includes additions such as 'biochips', 'humanoid robots with artificial intelligence', 'smart clothes', 'virtual reality headsets' and batteries for electronic cigarettes' in class 9.¹³¹ This displays an attempt to keep in line with technological advancements.¹³² The USA and all EU countries except Cyprus and Malta are members of the Nice Classification.¹³³ Although South Africa is not a party to the Nice Agreement, section 11(1) of the Trade Mark Act recognises the classification of goods and services.¹³⁴

¹²¹Cogen M (2016) 54.

¹²²Colston C *Principles of Intellectual Property* (1999) 11.

¹²³Article 5.2 (b) of the Protocol relating to the Madrid Agreement 1989.

¹²⁴ Seville C *EU Intellectual Property Law and Policy* (2009) 216.

¹²⁵Halpern S, Nard C & Port K *Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trade mark* (2007) 305.

¹²⁶Halpern S, Nard C & Port K (2007) 305.

¹²⁷Cogen M (2016) 55.

¹²⁸ The Nice Agreement on the Classification of Goods and Services 1957.

¹²⁹Roberts J *International Trade Mark Classification: A Guide to the Nice Agreement* (2012) xiii.

¹³⁰May C *World Intellectual Property Organization (WIPO): Resurgence and the Development Agenda* (2006) 40.

¹³¹ Class 9 of the Nice Agreement on the Classification of Goods and Services 2017 (11th edition).

¹³² Osseiran N 'What's new in 2017? The 11th Edition of the Nice Classification system' available at <http://www.cwblegal.com/whats-new-2017-11th-edition-nice-classification-system/> (accessed 14 December 2017).

¹³³Friedmann D *Trade Marks and Social Media: Toward Algorithmic Justice* (2015) 26.

¹³⁴ Section 11 (1) of the Trade Mark Act 194 of 1993 states that. A trade mark shall be registered in respect of goods or services falling in a particular class or particular classes in accordance with the prescribed

The Nice Agreement establishes a classification of goods and services for the purpose of registering trade mark and service marks. Trade mark offices have to indicate the number of classes of the classification to which the goods or services belong, for which the mark is registered. The Nice Classification simplifies trade mark registration.¹³⁵ An important advantage of the Nice Classification is that it allows for different types of goods and services to be easily identified.¹³⁶ Where there is a detection of confusingly similar trade marks, there will be an improved process to examine the execution of those trade marks.¹³⁷ The classification of goods and services exists in many languages such as French, Italian and Chinese and this simplifies the process of execution of an application for registration.¹³⁸

2.5 THE AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is an international agreement that is administered by the World Trade Organisation (WTO)¹³⁹ TRIPS prescribes minimum standards as to how various forms of intellectual property should be regulated.¹⁴⁰ The negotiations for this agreement took place at the end of the Uruguay Round of the General Agreement on Tariffs and Trade in 1994.¹⁴¹ It came into effect on 1 January 1995.¹⁴² South Africa, the European Union (EU) and the United States of America (USA) are all members of TRIPS.¹⁴³

Article 15 of TRIPS defines a trade mark. It provides that:

‘Any sign, or any combination of signs, capable of distinguishing the goods or services of one

classification: Provided that the rights arising from the registration of a trade mark shall be determined in accordance with the prescribed classification applicable at the date of registration thereof.

¹³⁵Valentine C & Meyerson M *World Class Speaking in Action: 50 Certified Coaches Show You How to Present, Persuade, and Profit* (2014) 266.

¹³⁶MKTU info ‘The International Classification of Goods and Services’ available at <http://www.en.mktu.info/intro/> (accessed on 15 June 2016).

¹³⁷MKTU info ‘The International Classification of Goods and Services’ available at <http://www.en.mktu.info/intro/> (accessed on 15 June 2016).

¹³⁸MKTU info ‘The International Classification of Goods and Services’ available at <http://www.en.mktu.info/intro/> (accessed on 15 June 2016).

¹³⁹Reber M *The influence of intellectual property rights on international business* (2004) 17.

¹⁴⁰Smith K *The Politics of Libraries and Librarianship: Challenges and Realities* (2008) 27.

¹⁴¹Reinisch A *Essentials of EU Law* (2012) 252.

¹⁴²Sinjela M *Human Rights and Intellectual Property Rights: Tensions and Convergences* (2007) 252.

¹⁴³World Trade Organisation ‘Contracting Parties/Signatories > Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) available at http://www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=231&group_id=22 (accessed on 31 August 2016).

undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements *and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks.* Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.¹⁴⁴

The above provision determines what amounts to a trade mark and therefore what can be afforded trade mark protection under TRIPS.¹⁴⁵ One of the main requirements prescribed by Article 15 is that the trade mark must be capable of having a distinguishing function.¹⁴⁶ The list of signs include colour and is not exhaustive. Non-traditional trade marks that fulfil the distinguishing function requirement are thus included under Article 15.¹⁴⁷ There is nothing in this provision suggesting that a trade mark should be represented graphically.¹⁴⁸ What makes a mark distinctive will be discussed in chapter 3, which will deal with the registration of trade marks in South Africa.¹⁴⁹

Article 16 provides the rights which trade mark owners enjoy under TRIPS.¹⁵⁰

Article 16.1 of TRIPS deals with infringement and provides as follows:

‘The owner of a registered trade mark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of members making rights available on the basis of use.’¹⁵¹

Trade mark owners enjoy exclusive rights and third parties or unauthorised persons have to refrain from using similar or identical marks on their products as those of the registered trade

¹⁴⁴Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994: my own emphasis.

¹⁴⁵Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁴⁶Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁴⁷Kongolo T *African Contributions in Shaping the Worldwide Intellectual Property System* (2016) 45.

¹⁴⁸Gervais D *The TRIPS Agreement: Drafting, History and Analysis* 3ed (2008) 266.

¹⁴⁹ See part 3.2.2.

¹⁵⁰Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁵¹Article 16.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

mark owners.¹⁵² Article 16.2 further provides for protection of well-known trade marks.¹⁵³ It does this by incorporating Article 6bis of the Paris Convention.¹⁵⁴ Article 6bis of the Paris Convention allows members, if their legislation permits, to refuse to accept marks which infringe upon the rights of owners of well-known trade marks.¹⁵⁵

Article 3.1 of TRIPS provides that:

‘Each Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property....’¹⁵⁶

As is the case with the Paris Convention, TRIPS contains the national treatment principle. This provision is contained in TRIPS because it is a WTO agreement and these are the core principles of the WTO.¹⁵⁷ National treatment requires a country to treat proprietors of other nations the same as those from its country.¹⁵⁸ As previously mentioned under the discussion on the Paris Convention, this helps facilitate trade and prevent unfair competition as nations will be encouraged to trade.¹⁵⁹

Article 4 provides that:

‘With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members...’¹⁶⁰

Article 4 gives rise to the most-favoured nation principle. The most-favoured nation principle requires member states not to discriminate between member states.¹⁶¹ As is the case with national treatment, this principle is also one of the core principles of the WTO.¹⁶²

TRIPS goes a long way in bringing certainty as to how Intellectual Property rights are protected

¹⁵² Article 16.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁵³ Article 16.2 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁵⁴ Article 16.2 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁵⁵ Article 6bis of the Paris Convention for the Protection of Industrial Property (1883).

¹⁵⁶ Article 3.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁵⁷ Sanders A *The Principle of National Treatment in International Economic Law: Trade, Investment and Intellectual Property* (2014) 125.

¹⁵⁸ Article 3 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁵⁹ Weiss F, Denters E & de Waart P *International Economic Law With a Human Face* (1998) 461.

¹⁶⁰ Article 4 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁶¹ Article 4 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

¹⁶² Sanders A *The Principle of National Treatment in International Economic Law: Trade, Investment and Intellectual Property* (2014) 125.

around the world.¹⁶³ The minimum standards of protection facilitate trade.¹⁶⁴ Another advantage of TRIPS is that it provides sanctions if members do not comply with its provisions, unlike the Paris Convention.¹⁶⁵ Developing nations have, however, criticised TRIPS for having taken away much of the needed policy space.¹⁶⁶ It has been said that developing members are at a disadvantage compared to developed countries under TRIPS.¹⁶⁷ This is because developed nations generally already provide adequate protection for intellectual property and most holders are based in these developed nations.¹⁶⁸ It could prove expensive to raise the level of intellectual property protection to the level TRIPS requires, particularly in the case of least developed nations.¹⁶⁹ This would take funds away from other areas where they are required such as health and education.¹⁷⁰

Developing countries can make use of the TRIPS Council and the WTO Dispute Settlement Understanding (DSU) to resolve disputes related to intellectual property and trade that arise between member states.¹⁷¹ The DSU sets out the WTO dispute settlement system's procedures and rules.¹⁷² It is important to note that the current dispute settlement system has evolved through rules, procedures and practices over time.¹⁷³ Another disadvantage of TRIPS is that it fails to make provision for new developments in technology¹⁷⁴ in the same way as the Singapore Treaty which is discussed below.

¹⁶³World Trade Organisation 'Overview: the TRIPS Agreement' available at https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (accessed on 14 June 2016).

¹⁶⁴Smith K *The Politics of Libraries and Librarianship: Challenges and Realities* (2008) 27.

¹⁶⁵ Evenson R & Santaniello V *The Regulation of Agricultural Biotechnology* (2004) 123.

¹⁶⁶ Roffe P & Meléndez-Ortiz R *Intellectual Property and Sustainable Development: Development Agendas in a Changing World* (2009) 54.

¹⁶⁷ de Carvalho N (2011) 96.

¹⁶⁸ Willis B 'The Arguments For and Against the TRIPS Agreement' available at <http://www.e-ir.info/2013/12/23/the-arguments-for-and-against-the-trips-agreement/> (accessed on 2 August 2016).

¹⁶⁹ Willis B 'The Arguments For and Against the TRIPS Agreement' available at <http://www.e-ir.info/2013/12/23/the-arguments-for-and-against-the-trips-agreement/> (accessed on 2 August 2016).

¹⁷⁰ Willis B 'The Arguments For and Against the TRIPS Agreement' available at <http://www.e-ir.info/2013/12/23/the-arguments-for-and-against-the-trips-agreement/> (accessed on 2 August 2016).

¹⁷¹ Yi-Chong X 'Last Chance? Multilateralism, TRIPS an developing countries' in Malbon J and Lawson C (ed) *Interpreting and Implementing the TRIPS Agreement. Is it fair?* (2008) 46.

¹⁷² World Trade Organisation *A Handbook on the WTO Dispute Settlement System: A WTO Secretariat Publication* (2004) 1.

¹⁷³ World Trade Organisation 'Introduction to the WTO dispute settlement system' available at https://www.wto.org/english/tratop_e/dispu_e/dispu_settlement_cbt_e/c1s2p1_e.htm (accessed on 06 January 2018).

¹⁷⁴ Hamilton M 'The TRIPS Agreement: Imperialistic, Outdated, and Overprotective' in Moore A (ed) *Intellectual Property: Moral, Legal and International Dilemmas* (1997) 243.

2.6. THE TRADE MARK LAW TREATY AND THE SINGAPORE TREATY

On October 27, 1994, the Trade Mark Law Treaty (hereinafter referred to as the TLT) was adopted by members of the World Intellectual Property Organization (WIPO).¹⁷⁵ South Africa,¹⁷⁶ the USA¹⁷⁷ and the EU are all parties of the TLT 1994.¹⁷⁸ The TLT 1994 was an attempt to internationally harmonise and simplify the administrative procedures of various trade mark offices worldwide.¹⁷⁹ The TLT 1994 was also aimed at making the trade mark application process in multiple countries easier.¹⁸⁰ The TLT has 54 contracting parties.

However, there has been a shift towards electronic filing and advancements in technology coupled with and changes in the way trade marks are protected.¹⁸¹ This led to the need to update the TLT 1994.¹⁸² This update came in the form of the Singapore Treaty on the Law of Trade Marks.¹⁸³ The Singapore Treaty on the Law of Trade Marks (Singapore Treaty) was adopted by its members in 2006.¹⁸⁴ It came into force in 2009.¹⁸⁵

2.6.1 IMPORTANCE OF THE SINGAPORE TREATY

The Singapore Treaty aims to ‘create a modern and dynamic international framework for the harmonisation of administrative trade mark registration procedures.’¹⁸⁶ The Singapore Treaty is a fairly new treaty unlike the previously discussed treaties.¹⁸⁷ It applies to a wider scope and addresses recent developments regarding communication technologies.¹⁸⁸ The Singapore Treaty also recognises the Paris Convention.¹⁸⁹ Article 15 of the Singapore Treaty prescribes

¹⁷⁵ Trade mark Law Treaty 1994.

¹⁷⁶ Keitumetse S *African Cultural Heritage Conservation and Management: Theory and Practice from Southern Africa* (2016) 46.

¹⁷⁷ Schwabach A (2014) 235.

¹⁷⁸ Ilardi A *The New European Patent* (2015) 4.

¹⁷⁹ Calboli I & de Werra J *The Law and Practice of Trade Mark Transactions: A Global and Local Outlook* (2016) 31.

¹⁸⁰ Sreenivasulu N *Law Relating to Intellectual Property* (2013) 45.

¹⁸¹ WIPO Magazine ‘The New Singapore Treaty on the Law of Trade Marks – What Does It Change?’ available at http://www.wipo.int/wipo_magazine/en/2006/03/article_0002.html (accessed on 17 July 2016).

¹⁸² WIPO Magazine ‘The New Singapore Treaty on the Law of Trade Marks – What Does It Change?’ available at http://www.wipo.int/wipo_magazine/en/2006/03/article_0002.html (accessed on 17 July 2016).

¹⁸³ Sreenivasulu N (2013) 47.

¹⁸⁴ Abbott F, Cottier T & Gurry F *International Intellectual Property in an Integrated World Economy* (2007) 372.

¹⁸⁵ Waelde C, Laurie G, Brown A *et al Contemporary Intellectual Property: Law and Policy* (2013) 569.

¹⁸⁶ Kobuss J, Bretz A & Hassani A *Become a Successful Designer. Protect and Manage Your Design Rights Internationally: Protect and Manage Your Design Rights Internationally* (2013) 124.

¹⁸⁷ International Trade Mark Association ‘Board Resolutions Singapore Treaty on the Law of Trade Marks’ available at <http://www.inta.org/Advocacy/Pages/SingaporeTreatyonthelawofTrademarks.aspx> (accessed on 13 June 2016).

¹⁸⁸ Calboli I & de Werra J (2016) 31.

¹⁸⁹ Article 15 of the Singapore Treaty on the Law of Trade Marks 2006.

an obligation for members to comply with the Paris Convention.¹⁹⁰ The USA and some EU members such as Ukraine, Austria and Belgium are members of the Singapore Treaty. South Africa is, however, not a party to the Singapore Treaty.¹⁹¹

The Singapore Treaty was very much drawn up with a modern view in mind¹⁹² and it is an improvement on the TLT.¹⁹³ One of these improvements was the creation of an Assembly.¹⁹⁴ The TLT did not make provision for an assembly which made it impossible to amend the treaty regulations.¹⁹⁵ Article 23 of the Singapore Treaty thus makes provision for such an Assembly.¹⁹⁶ The role of the assembly is to ‘deal with matters concerning the development of the Singapore Treaty’,¹⁹⁷ ‘amend the Regulations, including the Model International Forms’,¹⁹⁸ ‘determine the conditions for the date of application of each amendment’¹⁹⁹ and ‘perform such other functions as are appropriate to implementing the provisions of the Singapore Treaty.’²⁰⁰ This is important because amendments to regulations may be needed to keep up with new technological advancements.²⁰¹

During the era of the TLT communications with trade mark offices were mainly made through post or fax machines,²⁰² a position that has since changed.²⁰³ Electronic communications have now become prevalent.²⁰⁴ Article 8 of the Singapore Treaty allows for members to choose suitable methods of communication.²⁰⁵ This ensures that electronic communication is used to facilitate technological advancements.²⁰⁶

¹⁹⁰ Article 15 of the Singapore Treaty on the Law of Trade Marks 2006.

¹⁹¹ World Intellectual Property Organisation ‘Contracting Parties > Singapore Treaty’ available at http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=30 (accessed on 5 August 2016).

¹⁹² Veron P *Concise International and European IP Law: TRIPS, Paris Convention, European Enforcement and Transfer of Technology* (2011) 202.

¹⁹³ Veron P (2011) 202.

¹⁹⁴ Waelde C, Laurie G, Brown A *et al Contemporary Intellectual Property: Law and Policy* (2013) 569.

¹⁹⁵ Waelde C, Laurie G, Brown A *et al* (2013) 569.

¹⁹⁶ Article 23 of the Singapore Treaty on the Law of Trade Marks 2006.

¹⁹⁷ Article 23(2) (i) of the Singapore Treaty on the Law of Trade Marks 2006.

¹⁹⁸ Article 23(2) (ii) of the Singapore Treaty on the Law of Trade Marks 2006.

¹⁹⁹ Article 23(2) (iii) of the Singapore Treaty on the Law of Trade Marks 2006.

²⁰⁰ Article 23(2) (iv) of the Singapore Treaty on the Law of Trade Marks 2006.

²⁰¹ Wong K, Darsan K & Spruson E ‘Singapore – Singapore Treaty on the Law of Trade Marks’ available at https://www.aippi.org/enews/2009/edition08/Singapore_Treaty.html (accessed on 14 June 2016).

²⁰² Wong K, Darsan K & Spruson E ‘Singapore – Singapore Treaty on the Law of Trade Marks’ available at https://www.aippi.org/enews/2009/edition08/Singapore_Treaty.html (accessed on 14 June 2016).

²⁰³ Elmslie M & Portman S *Intellectual Property: The Lifeblood of Your Company* (2014) 3.

²⁰⁴ Sreenivasulu N *Law Relating to Intellectual Property* (2013) 47.

²⁰⁵ Article 8 of the Singapore Treaty on the Law of Trade Marks 2006.

²⁰⁶ International Trade Mark Association ‘Board Resolutions Singapore Treaty on the Law of Trade Marks’ available at <http://www.inta.org/Advocacy/Pages/SingaporeTreatyontheLawofTrademarks.aspx> (accessed on 13 June 2016).

2.6.2 NON-TRADITIONAL TRADE MARKS UNDER THE SINGAPORE TREATY

The Singapore Treaty is significant in that it is the first trade mark law treaty to explicitly recognise non-traditional trade marks.²⁰⁷ It applies to all types of marks, which includes non-traditional marks which are visible, such as ‘holograms, three-dimensional marks, colour, position and movement marks’, and marks such as ‘sound, olfactory or taste and feel marks’, which are not visible.²⁰⁸

The Singapore Treaty has a few rules on non-traditional trade marks.²⁰⁹ When applying for the registration of a colour mark or different type of colours, the applicant must provide the trade mark office with a sample of the colour or colours.²¹⁰ For sound marks, this requirement will be fulfilled with a 'musical notation on a stave, or a description of the sound constituting the mark, or an analogue or digital recording of that sound, or any combination thereof.'²¹¹ The required form of representation for scent marks is left to the rules and legislation of the contracting party.²¹²

Bretonnière and Rodarl laud the Singapore Treaty.²¹³ They correctly argue that it is a positive step towards the growth of non-traditional trade marks world-wide.²¹⁴ Hopperger states that despite the low number of registered non-traditional trade marks around the world, it is only a matter of time before there is an increase in the registration of these kinds of marks.²¹⁵ The Singapore Treaty addresses the legal and administrative issues surrounding these types of marks.²¹⁶

²⁰⁷Seville C *EU Intellectual Property Law and Policy* (2009) 219.

²⁰⁸Seville C *EU Intellectual Property Law and Policy* (2009) 219.

²⁰⁹ Regulations under the Singapore Treaty on the Law of Trade Marks 2006.

²¹⁰ Rule 3(7) of the Regulations under the Singapore Treaty on the Law of Trade Marks 2006.

²¹¹ Rule 3(9) of the Regulations under the Singapore Treaty on the Law of Trade Marks 2006.

²¹² Rule 3(10) of the Regulations under the Singapore Treaty on the Law of Trade Marks 2006. This rule does not expressly mention scent marks but applies to all non-visual marks which are not sound marks.

²¹³ Bretonnière J & Rodarl S ‘Protecting and enforcing non-traditional trade marks’ available at <http://www.iam-media.com/Intelligence/IP-Value/2009/Law-litigation-Global/Protecting-and-enforcing-non-traditional-trademarks> (accessed on 17 October 2017).

²¹⁴ Bretonnière J & Rodarl S ‘Protecting and enforcing non-traditional trade marks’ available at <http://www.iam-media.com/Intelligence/IP-Value/2009/Law-litigation-Global/Protecting-and-enforcing-non-traditional-trademarks> (accessed on 17 October 2017).

²¹⁵ Hopperger M ‘Non-Traditional Marks – Singapore Treaty Enters into Force’ available at http://www.wipo.int/wipo_magazine/en/2009/01/article_0002.html (accessed on 23 October 2017).

²¹⁶ Hopperger M ‘Non-Traditional Marks – Singapore Treaty Enters into Force’ available at http://www.wipo.int/wipo_magazine/en/2009/01/article_0002.html (accessed on 23 October 2017).

2.7 CONCLUSION

This chapter set out to discuss the international conventions governing trade mark law. This chapter discussed various international conventions namely the Paris Convention, the Madrid System, the Nice Classification, TRIPS, the TLT and the Singapore Treaty. The aim of Paris Convention was to harmonise intellectual property laws to reduce the divergences that existed in the laws. This provided a solution to the problem of having various intellectual property laws across different jurisdictions since this was a barrier to trade. The main shortcoming of this convention, however, is the absence of a mechanism for the international registration of trade marks.

Due to the deficiencies of the Paris Convention, the Madrid Agreement and Protocol were adopted. The significance of the Madrid System is that it allows members to obtain registration in many countries by means of one application. The main shortcoming of the Madrid Agreement was the effect of central attack. The Madrid Protocol remedied this by allowing the international reregistration of these domestically cancelled marks with the same priority date as before.

The Nice Agreement provides a classification for the registration of goods and services. This simplifies the trade mark registration process and also makes it easier to establish which marks have already been registered to prevent infringement. The latest edition of this classification includes various technological goods which shows an attempt to keep in line with modern developments.

TRIPS provides minimum standards on how member states should regulate various forms of intellectual property, it also provides sanctions if members do not comply with these provisions. It also greatly assisted with harmonising trade mark law by providing universal definitions for a trade mark and trade mark infringement. What is important to note is that there is no graphical representation requirement contained in this definition, which means it accommodates non-traditional trade marks.

Technology has improved over the years and this has led to changes in the way trade marks are protected. The Singapore Treaty is significant as it is the first international treaty to explicitly make provision for non-traditional trade marks. It has a wider scope of application and it was very much drafted with a modern view in mind since it caters for recent developments in the field of communication technologies, something which the previous TLT had failed to do. The

next chapter examines the requirements for registration of trade marks in South Africa including sound, scent and colour.

CHAPTER 3

THE REGISTRATION OF TRADE MARKS IN SOUTH AFRICA

3.1 INTRODUCTION

Trade marks in South Africa are protected either by statute or in terms of common law.²¹⁷ In order to enjoy statutory trade mark protection the proprietor needs to register the mark.²¹⁸ The previous chapter discussed the registration of trade marks under various international instruments. This chapter discusses the registrability of, firstly, traditional and secondly, non-traditional trade marks such as colour, scent and sound marks. Non-traditional trade marks can be divided into visible non-traditional trade marks such as colour marks and non-visible marks such as sound and scent marks. The discussion focuses on these three marks in an attempt to show the differences in registration between visual and non-visual non-traditional trade marks. Reference is made to the Guidelines which were published by the registrar in the Patent Journal.²¹⁹ The Guidelines govern the registration of the non-traditional marks including non-visible trade marks.

3.2 STATUTORY TRADE MARK PROTECTION

The registration of a trade mark in South Africa grants the trade mark owner an exclusive right to the trade mark.²²⁰ There are many benefits that come with the exclusive right as the trade mark owner; firstly, acquires the right to 'use the trade mark in relation to the goods or services in respect of which the mark is registered'.²²¹ Secondly, it 'prevents others from registering that very trade mark or a 'confusingly similar mark in relation to the same or similar goods or services'.²²² Thirdly, it 'prevents others from infringing the trade mark'²²³ unless the owner grants a third party a licence for the use of the trade mark²²⁴ or 'transfers the trade mark'.²²⁵ Finally the owner can hypothecate the trade mark by means of a deed of security.²²⁶

²¹⁷ Mukuka G *Reap what You Have Not Sown: Indigenous Knowledge Systems and Intellectual Property Laws in South Africa* (2010) 22.

²¹⁸ Govindjee A, Holness D, Driver S *et al Fresh Perspectives: Commercial Law 2* (2007) 316 and Klopper H, Pistorius T, Tong L *et al*, (2017) 103..

²¹⁹ CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' *2009 Patent Journal* 460.

²²⁰ Section 29 of the Trade Marks Act 194 of 1993.

²²¹ Klopper H, Pistorius T, Tong L *et al*, (2017) 139.

²²² Section 10 (14) of the Trade Marks Act 194 of 1993.

²²³ Section 34 of the Trade Marks Act 194 of 1993.

²²⁴ Section 38 of the Trade Marks Act 194 of 1993.

²²⁵ Section 39 of the Trade Marks Act 194 of 1993.

²²⁶ Section 41 of the Trade Marks Act 194 of 1993.

Registration of a trade mark thus grants trade mark proprietors a monopoly over the particular mark.²²⁷

Freibrun likens trade mark registration to insurance in that trade marks affect the value of businesses.²²⁸ If a trade mark is not registered and the owner wishes to sell the business, he will not be able to assure the buyer that the company owns the mark. This uncertainty could affect the sale of a business.²²⁹ A trade mark has economic value.²³⁰ An example of this is the ‘Google’ trade mark. It is one of the most valuable trade mark in the world, according to the Forbes list.²³¹ As of 2014, its trade mark value was \$44.3 billion.²³² This shows the importance of trade marks in the business sector and consequently on the economy. Trade mark registration also has an effect on consumer protection.²³³ As consumers can differentiate between brands, trade marks enable consumer choice.²³⁴ Consumers tend to purchase brands with reputations²³⁵ and trade marks serve as a reminder of the quality a certain manufacturer’s products possess.²³⁶ This stems from the quality function of trade marks.

The Trade Mark Act 194 of 1993 (the Trade Mark Act) and the regulations thereof regulate the registration of trade marks in South Africa.²³⁷ There are a number of important sections in the Trade Mark Act that are applicable to registration of both traditional and non-traditional trade marks in South Africa.²³⁸ The requirements for registration can be divided into procedural and substantive requirements.

²²⁷ Blackett T *Trade Marks* (2016) 44.

²²⁸ Freibrun E ‘The Importance of Trademark Registration’ available at <https://www.springcm.com/blog/the-importance-of-trademark-registration> (accessed on 20 May 2017).

²²⁹ Freibrun E ‘The Importance of Trademark Registration’ available at <https://www.springcm.com/blog/the-importance-of-trademark-registration> (accessed on 20 May 2017).

²³⁰ Griffiths A *An Economic Perspective on Trade Mark Law* (2011) 56.

²³¹ Post A ‘Google tops list of 10 most valuable trademarks’ available at <http://www.insidecounsel.com/2011/06/15/google-tops-list-of-10-most-valuable-trademarks> (accessed on 12 March 2017).

²³² Post A ‘Google tops list of 10 most valuable trademarks’ available at <http://www.insidecounsel.com/2011/06/15/google-tops-list-of-10-most-valuable-trademarks> (accessed on 12 March 2017).

²³³ Colston C & Middleton K *Modern Intellectual Property Law* (2005) 53.

²³⁴ Wilkof N & Burkitt D *Trade Mark Licensing* (2005) 37.

²³⁵ Ang L *Integrated Marketing Communications: A focus on new technologies and advanced theories* (2014) 73.

²³⁶ Duquenoey P, Jones S & Blundell B *Ethical, Legal and Professional Issues in Computing* (2008) 62.

²³⁷ The Trade Marks Regulations 1993 published under Government Notice R578 in Government Gazette 16373 of 21 April 1995.

²³⁸ The Trade Mark Act 194 of 1993.

3.2.1 PROCEDURAL REQUIREMENTS FOR REGISTRATION

An application to register a trade mark must be made on the correct form, namely the TM1 form.²³⁹ The application must be dated and signed by the applicant or his agent.²⁴⁰ These procedural requirements are significant for a number of reasons. The main function of the signature is to identify and authenticate the applicant.²⁴¹ The date is important as the trade mark proprietor may, in terms of the Paris Convention, apply for trade mark protection in any of the contracting states within 6 months of the first application in the home state.²⁴² The use of a specific form saves time and prevents wasted costs associated with searching through numerous forms.²⁴³ For every proposed mark and every class of goods or services, a separate application is, however, required and each application needs to be in triplicate for administrative purposes.²⁴⁴

A representation of the proposed mark, which is suitable for reproduction, must be attached to the application for registration.²⁴⁵ The representation of a mark is important since it provides the Registrar and the public with an accurate display of the proposed mark, ensuring that there is no confusion of the mark proposed to be registered.²⁴⁶ This representation is limited in size and may not exceed 8.5 cm in width and 10 cm in length.²⁴⁷ Providing a size limit allows for the representation to fit onto the application, making the process easier and more convenient.²⁴⁸ Where a trade mark is represented in a manner other than a word, letter, numeral or combination thereof, two additional representations of the mark is also required.²⁴⁹ This provides a mechanism for the representation of non-traditional trade marks. The registrar may also request additional representations if he or she deems it necessary.²⁵⁰

The representations referred to above should be on one side of the paper only and should be of

²³⁹ Regulation 11(1) of the Trade Marks Regulations 1993.

²⁴⁰ Regulation 11(2) of the Trade Marks Regulations 1993.

²⁴¹ Dutta S, Lanvin B & Paua F *The Global Information Technology Report 2002-2003: Readiness for the Networked World* (2003) 34.

²⁴² Article 4 of the Paris Convention for the Protection of Industrial Property (1883).

²⁴³ Sarantis H 'Business Guide To Paper Reduction A Step-by-Step Plan to Save Money by Saving Paper' available at <http://sustainability.tufts.edu/wp-content/uploads/BusinessGuidetoPaperReduction.pdf> (accessed on 14 March 2017).

²⁴⁴ Regulation 11(3) of the Trade Marks Regulations 1993.

²⁴⁵ Regulation 13(1) of the Trade Marks Regulations 1993.

²⁴⁶ MacDonald R 'Trade-marks year in review 2012' available at <https://www.lexology.com/library/detail.aspx?g=a95233ba-58d4-4ace-9930-0c161fce8d0b> (accessed on 13 March 2017).

²⁴⁷ Regulation 13(2) of the Trade Marks Regulations 1993.

²⁴⁸ Hoffman L *Longitudinal Analysis: Modeling Within-Person Fluctuation and Change* (2015) 102.

²⁴⁹ Regulation 13(3) (a) of the Trade Marks Regulations 1993.

²⁵⁰ Regulation 13(3) (b) of the Trade Marks Regulations 1993.

a durable nature²⁵¹ to ensure that the scope of protection can easily be determined. The proposed mark should be ‘clear and distinct.’²⁵² If in the opinion of the registrar the proposed mark is not clear and distinct, he or she may request that these representations be substituted before proceeding with the application.²⁵³ The rationale for this requirement is to ensure that the Registrar and members of the public are able to ascertain the scope and extent of the protection of the proposed trade mark without confusion.²⁵⁴ The fact that the regulations prescribe that representations should be of a durable nature and be ‘clear and distinct’ closely resembles the Sieckmann criteria which is discussed later in the thesis.²⁵⁵ The purpose is to promote legal certainty.²⁵⁶

Where it is not possible for representations to be provided in the manner discussed above, a specimen or copy of the trade may be sent to the Registrar. If a mark cannot conveniently be shown by representation, the registrar may request a deposit in the office of a specimen or copy of any trade mark.²⁵⁷ Non-traditional trade marks such as scent would be represented in the form of a specimen.²⁵⁸ Regulation 13 (5) of the Trade Marks Act accordingly makes provision for the registration of both traditional and non-traditional trade marks.

3.2.2 SUBSTANTIVE REQUIREMENTS

Firstly, in order for a mark to be registered in South Africa it must satisfy the requirements of a mark in terms of section 2(1) of the Trade Marks Act.²⁵⁹ Section 2(1) of the Trade Mark Act provides the definition of a mark and a trade mark.²⁶⁰ It defines a mark as

‘any sign capable of being *represented graphically*, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, *colour or container for goods, or any combination thereof*’.²⁶¹

The definition of a mark includes traditional and non-traditional marks such as colour, shape

²⁵¹ Regulation 13(4) of the Trade Marks Regulations 1993.

²⁵² Regulation 13(4) of the Trade Marks Regulations 1993.

²⁵³ Regulation 13(4) of the Trade Marks Regulations 1993.

²⁵⁴ MacDonald R ‘Trade-marks year in review 2012’ available at <https://www.lexology.com/library/detail.aspx?g=a95233ba-58d4-4ace-9930-0c161fce8d0b> (accessed on 13 March 2017).

²⁵⁵ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] ECR I-11737 Case C-273/00 para 52-55.

²⁵⁶ Waelde C, Brown A, Cornwell J & Kheria S *Contemporary Intellectual Property: Law and Policy* (2016) 593.

²⁵⁷ Regulation 13(6) of the Trade Marks Regulations 1993.

²⁵⁸ Regulation 13(5) of the Trade Marks Regulations 1993.

²⁵⁹ Section 2(1) of the Trade Mark Act 194 of 1993.

²⁶⁰ Section 2(1) of the Trade Mark Act 194 of 1993.

²⁶¹ Section 2(1) of the Trade Mark Act 194 of 1993: my own emphasis.

and configurations.²⁶² This is not a closed list as the definition merely provides common examples of signs that may constitute a mark. Section 2(1) requires a mark to be represented graphically.²⁶³ In order for a sign to be represented graphically, it must be represented ‘in a form that can be recorded and reproduced.’²⁶⁴ Examples of this include writing, drawings and images.²⁶⁵ The graphic representation requirement poses challenges to marks such as sound marks and scent marks as they are not easily capable of being represented or reproduced.²⁶⁶

In *Triomed v Beecham Group plc and Others*,²⁶⁷ the court applied section 2(1) of the Trade Mark Act and held that a mark which is not capable of being represented graphically cannot be registered.²⁶⁸ This case concerned the proposed registration of a bi-convex shaped tablet.²⁶⁹ The court held, inter alia, that the description of the mark was too vague for it to meet the requirement of graphical representation.²⁷⁰ The tablet was described as elliptical and bi-convex with a band.²⁷¹ The purposes of graphical representation are to ‘define the scope of the rights of the trade mark proprietor’ and to allow the public to ‘ascertain the precise nature of the mark.’²⁷² It is thus a requirement to promote clarity on what exactly is protected by trade mark law.²⁷³

A trade mark is defined as:

‘... a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person.’²⁷⁴

To qualify as a trade mark, there must be a mark, which has been used or proposed to be used on goods or services. Therefore, if a mark has never been used and there is no intention to use the mark it cannot be registered as a trade mark. Non-use of a mark is further prohibited by

²⁶² Dean O ‘Quo vadis South African Trade Marks?’ *South African Mercantile Law Journal* 92, see also Klopper H, Pistorius T, Tong L et al, (2017) 112.

²⁶³ Section 2(1) of the Trade Mark Act 194 of 1993.

²⁶⁴ Regulation 13 of the Trade Marks Regulations 1993.

²⁶⁵ Klopper H, Pistorius T, Tong L et al, (2017) 103.

²⁶⁶ Dean O & Dyer A *et al Introduction to Intellectual Property Law* (2014) 93.

²⁶⁷ *Triomed (Pty) Ltd v Beecham Group plc and others* 2001 (2) SA 522 (T)

²⁶⁸ *Triomed (Pty) Ltd v Beecham Group plc and others* 2001 (2) SA 522 (T) pg 523.

²⁶⁹ *Triomed (Pty) Ltd v Beecham Group plc and others* 2001 (2) SA 522 (T) pg 128.

²⁷⁰ *Triomed (Pty) Ltd v Beecham Group plc and others* 2001 (2) SA 522 (T) pg 139.

²⁷¹ *Triomed (Pty) Ltd v Beecham Group plc and others* 2001 (2) SA 522 (T) pg 138.

²⁷² Simons T & Hausmann R *The European Legal Forum, Volume 4* (2004) 178.

²⁷³ Simons T & Hausmann R (2004) 178.

²⁷⁴ Section 2(1) of the Trade Mark Act 194 of 1993.

section 10 of the Trade Mark Act.²⁷⁵

The requirement of distinctiveness is contained in the definition of a trade mark. The main purpose of trade marks is to distinguish a proprietor's goods and services from those of its competitors and this means that the trade mark must be distinctive. The mark should be used 'in the course of trade' which means the mark has to be attached to goods and services for the purpose of sale.²⁷⁶

Secondly, a mark has to comply with sections 9²⁷⁷ of the Trade Mark Act.²⁷⁸ Distinctiveness is the cornerstone of trade mark protection and this requirement is thus contained in both the definition and s9 of the Trade Marks Act. This means that the mark must enable consumers to differentiate between the goods and services of the applicant and its competitors.²⁷⁹ In determining whether a mark is distinctive the court will look at two main factors namely acquired distinctiveness and inherent distinctiveness.²⁸⁰ When a mark is not inherently distinctive it has to be established that the mark has acquired distinctiveness through use.²⁸¹

A case illustrating these factors is *Beecham Group plc v Triomed (Pty) Ltd*,²⁸² which concerned the proposed registration of a bi-convex shaped tablet.²⁸³ The Supreme Court of Appeal confirmed that it must first determine whether the mark is inherently distinctive.²⁸⁴ The court held that the shape of the tablet was not inherently distinctive.²⁸⁵ The next enquiry was to establish whether distinctiveness was acquired through use.²⁸⁶ The court was not satisfied that

²⁷⁵ See under discussion of unregistrable marks contained later in this section.

²⁷⁶ Sakulin W *Trade Mark Protection and Freedom of Expression: An Inquiry Into the Conflict Between Trade Mark Rights and Freedom of Expression Under European Law* (2011) 241.

²⁷⁷ In terms of section 9, a mark must be 'capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person.'

²⁷⁸ Klopper H, Pistorius T, Tong L *et al*, (2017) 119.

²⁷⁹ World Intellectual Property Organization *Introduction to Intellectual Property, Theory and Practice* (1997) 184.

²⁸⁰ Klopper H, Pistorius T, Tong L *et al*, (2017) 120.

²⁸¹ *Beecham Group Plc and Others v Triomed (Pty) Ltd* 2002 (4) All SA 193 (SCA) para 24 This is the appeal case of the High Court judgment of *Triomed (Pty) Ltd v Beecham Group plc and Others* 2001 (2) SA 522 (T) discussed earlier in this chapter.

²⁸² *Beecham Group Plc and Others v Triomed (Pty) Ltd* 2002 (4) All SA 193 (SCA).

²⁸³ *Beecham Group Plc and Others v Triomed (Pty) Ltd* 2002 (4) All SA 193 (SCA) para 1.

²⁸⁴ *Beecham Group Plc and Others v Triomed (Pty) Ltd* (100/01) [2002] ZASCA 109; [2002] 4 All SA 193 (SCA) para 23.

²⁸⁵ *Beecham Group Plc and Others v Triomed (Pty) Ltd* (100/01) [2002] ZASCA 109; [2002] 4 All SA 193 (SCA) para 23.

²⁸⁶ *Beecham Group Plc and Others v Triomed (Pty) Ltd* (100/01) [2002] ZASCA 109; [2002] 4 All SA 193 (SCA) para 23.

distinctiveness was acquired and the appellant was unsuccessful.²⁸⁷

A mark is inherently distinctive when it does not require an establishment of a reputation prior to registration.²⁸⁸ Examples of this include fancy words and invented words such Nike.²⁸⁹ An example of marks which are not inherently distinctive are laudatory epithets and descriptive marks.²⁹⁰ Such marks describe the quality and characteristics of a mark.²⁹¹ Examples of descriptive marks include Speedy for delivery services and Gobble Gobble for turkeys.²⁹²

The case of *Adidas AG and Another v Pepkor Retail Limited*²⁹³ showed how a mark can acquire distinctiveness. This case concerned Adidas' three stripe mark on sports shoes.²⁹⁴ The court held that this mark acquired distinctiveness through use as a result of extensive advertising and the fact that consumers readily identified the three stripe mark as a badge of Adidas products.²⁹⁵

A mark can, however, lose its capability of distinguishing.²⁹⁶ This occurs when the public regards a mark as the generic name for a certain type of goods. Examples of these are 'asprin', 'sellotape', 'elevator' and 'windsurfer'.²⁹⁷ The implication of this is that consumers will no longer be able to distinguish the goods and services of that particular proprietor from the goods and services of competitors.²⁹⁸ Once a mark loses its ability to function as a trade mark it is removed from the trade mark register.²⁹⁹

*Lotte Confectionary Co Ltd v Orion Corporation*³⁰⁰ is a case which illustrates how a mark can lose its distinctiveness. This was an application for the removal of registered trade mark 'CHOCOPIE' from the register in relation to confectionary.³⁰¹ The court held that the respondent's mark had lost its distinctiveness because evidence was submitted that there was

²⁸⁷ *Beecham Group Plc and Others v Triomed (Pty) Ltd* (100/01) [2002] ZASCA 109; [2002] 4 All SA 193 (SCA) para 24.

²⁸⁸ Mullin B, Hardy S & Sutton W *Sport Marketing 4th Edition* (2014) 400.

²⁸⁹ Companies and Intellectual Property Commission 'Trade Marks' available at http://www.cipro.co.za/products_services/trademarks.asp (accessed on 29 March 2017).

²⁹⁰ McJohn S *Intellectual Property: Examples & Explanations* (2009) 364.

²⁹¹ DeGeeter M *Technology Commercialization Manual: Strategy, Tactics, and Economics for Business Success* (2004) 84.

²⁹² Shilling D *Essentials of Trade Marks and Unfair Competition* (2002) 26.

²⁹³ *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3.

²⁹⁴ *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3 para 3.

²⁹⁵ *Adidas AG & another v Pepkor Retail Limited* (187/12) [2013] ZASCA 3 para 38.

²⁹⁶ Ramsden P A *Guide to Intellectual Property Law* (2011) 105.

²⁹⁷ Ramsden P (2011) 105.

²⁹⁸ Paradise P *Trade Mark Counterfeiting, Product Piracy, and the Billion Dollar Threat to the U.S. Economy* (1999) 125.

²⁹⁹ Klopper H, Pistorius T, Tong L (2017) 121.

³⁰⁰ *Lotte Confectionary Co Ltd v Orion Corporation* (49422/2013) [2015] ZAGPPHC 316.

³⁰¹ *Lotte Confectionary Co Ltd v Orion Corporation* (49422/2013) [2015] ZAGPPHC 316 para 1.

widespread and extensive use of the abbreviation ‘choco’ in that particular industry and that other traders, in good faith, were using the same mark on their goods in the ordinary course of business.³⁰²

Similarly in *Cadbury v Beacon Sweets & Chocolates*³⁰³ the court applied section 9 of the Trade Marks Act and held that a mark which is not capable of distinguishing cannot be registered as a trade mark.³⁰⁴ The issue before the court was whether the term ‘Liquorice Allsorts’ was capable of distinguishing the particular liquorice confectionary of Beacon from the same product of its competitors.³⁰⁵ The court held that the term is not distinctive because competitors were using the terms to describe their products and that registration should be subject to a disclaimer.³⁰⁶ The rationale behind not affording non-distinctive marks protection is that if a trade mark is not distinctive it is unable to fulfil its function of allowing consumers to differentiate between different brands and prevent confusion.³⁰⁷

Thirdly, a mark should not fall within the scope of unregistrable marks in terms of Section 10 of the Trade Mark Act.³⁰⁸ Some of these unregistrable marks will be discussed next since it is not possible to exhaust all the grounds upon which a mark is not registrable.

Section 10(3) of the Act states that a mark cannot qualify to be a trade mark if the applicant ‘has no *bona fide* claim to proprietorship’. The applicant cannot therefore register the mark.³⁰⁹ A person has no *bona fide* claim to proprietorship if the mark is not inherently distinctive or if he has not acquired or adopted it and used it to the extent that it acquired a reputation in the marketplace.³¹⁰ If the applicant has no *bona fide* intention to use the mark as a trade mark, the mark also cannot be registered.³¹¹ At the time of registration the applicant must have some definite or present intention to use the mark, either at that time or in the future to trade

³⁰² *Lotte Confectionary Co Ltd v Orion Corporation* (49422/2013) [2015] ZAGPPHC 316 para 21-22.

³⁰³ *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd and Another* (573/97) [2000] ZASCA 2; 2000 (2) SA 771 (SCA); [2000] 2 All SA 1 (A).

³⁰⁴ *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd and Another* (573/97) [2000] ZASCA 2; 2000 (2) SA 771 (SCA); [2000] 2 All SA 1 (A) para 3.

³⁰⁵ *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd and Another* (573/97) [2000] ZASCA 2; 2000 (2) SA 771 (SCA); [2000] 2 All SA 1 (A) para 3.

³⁰⁶ *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd and Another* (573/97) [2000] ZASCA 2; 2000 (2) SA 771 (SCA); [2000] 2 All SA 1 (A) para 15.

³⁰⁷ Klopper H, Pistorius T, Tong L *et al*, (2017) 121.

³⁰⁸ Section 10 of the Trade Mark Act 194 of 1993.

³⁰⁹ Section 10(3) of the Trade Mark Act 194 of 1993.

³¹⁰ *Global Vitality Incorporated v Enzyme Process Africa (Pty) Limited and Others* (20884/2013) [2015] ZAWCHC para 38.

³¹¹ Section 10(4) of the Trade Mark Act 194 of 1993.

commercially.³¹²

In the case of *South African Football Association v Stanton Woodrush (Pty) Ltd t/a Stan Smidt & Sons and Another* a dispute arose over the registration of the mark 'Bafana Bafana' in respect of clothing.³¹³ A group of journalists registered the mark in relation to clothing and the South African Football Association wished to have the registration of this mark removed from the register.³¹⁴ The court held that the journalists could not register the mark because they had no intention to use the mark in relation to goods and services but rather for publication purposes.³¹⁵

A mark which is 'inherently deceptive' or would cause confusion, or be against the law or public policy or would offend a class of people cannot be registered³¹⁶ A mark is inherently deceptive if it would cause likely confusion in the average customer's mind.³¹⁷ An average consumer is a consumer who is not overly careful but at the same time not careless in knowing the characteristics of the product he or she wishes to purchase.³¹⁸ The average consumer knows the quality of the goods he or she purchases but does not over examine it.

A mark would be against the law if contravenes a statutory provision, for example a mark that promotes child pornography. Such a mark would be inconsistent with the Criminal Law (Sexual Offences and Related Matters) Amendment Act.³¹⁹ The registration of a mark that would threaten public safety will be against public policy.³²⁰ In an application by Lewis Thomas Edwards, it was held that the use of the trade mark Jardex for disinfectants would be against

³¹² Klopper H, Pistorius T, Rutherford B *et al*, (2011) 92.

³¹³ *South African Football Association v Stanton Woodrush (Pty) Ltd t/a Stan Smidt & Sons and Another* (5/2002) [2002] ZASCA 142; [2003] 1 All SA 274 (SCA) para 2.

³¹⁴ *South African Football Association v Stanton Woodrush (Pty) Ltd t/a Stan Smidt & Sons and Another* (5/2002) [2002] ZASCA 142; [2003] 1 All SA 274 (SCA) para 2.

³¹⁵ *South African Football Association v Stanton Woodrush (Pty) Ltd t/a Stan Smidt & Sons and Another* (5/2002) [2002] ZASCA 142; [2003] 1 All SA 274 (SCA) para 19.

³¹⁶ Section 10(12) of the Trade Mark Act 194 of 1993.

³¹⁷ *Shoprite Checkers (Pty) Ltd v Charoen Pokphand Group Co Ltd* (72005/2015) [2016] ZAGPPHC 655 para 4.

³¹⁸ Klopper H, Pistorius T, Tong L *et al*, (2017) 64.

³¹⁹ Section 19 of the Criminal Law (Sexual Offences and Related Matters) Amendment Act 32 of 2007 provides that

“A person ('A') who unlawfully and intentionally exposes or displays or causes the exposure or display of- (a) any image, publication, depiction, description or sequence of child pornography or pornography; (b) any image, publication, depiction, description or sequence containing a visual presentation, description or representation of a sexual nature of a child, which may be disturbing or harmful to, or age-inappropriate for children, as contemplated in the Films and Publications Act, 1996 (Act 65 of 1996), or in terms of any other legislation; or (c) any image, publication, depiction, description or sequence containing a visual presentation, description or representation of pornography or an act of an explicit sexual nature of a person 18 years or older, which may be disturbing or harmful to, or age-inappropriate, for children, as contemplated in the Films and Publications Act, 1996, or in terms of any other law, to a child ('B'), with or without the consent of B, is guilty of the offence of exposing or displaying or causing the exposure or display of child pornography or pornography to a child.”

³²⁰ Klopper H, Pistorius Tong L *et al*, (2017) 127.

public policy.³²¹ This is because there was a likelihood that members of the public might confuse the disinfectant with Jardox meat extracts, and this could be dangerous since it could negatively affect one's health if swallowed by a person.³²² Section 10 of the Trade Marks Act therefore is aimed at preventing an influx of trade mark registrations that serve no purpose, are harmful to the public at large, or promote unfair competition. Once it is determined that a mark can be registered, it is necessary to understand the procedure of registering a mark which is discussed below.

3.3 THE REGISTRATION OF NON-TRADITIONAL TRADE MARKS

This part discusses the registration of non-traditional trade marks in South Africa and the challenges posed by their registration. It is significant to note that the registration of non-traditional marks is not as straightforward as that of traditional trade marks.³²³ This is because non-traditional marks especially non-visible marks cannot be seen and are different from visible marks. They generally do not meet the graphic representation requirement of a 'mark' set out in Section 2(1) of the Trade Mark Act.³²⁴ The idea of non-traditional trade marks has, however, been accepted internationally³²⁵ and nationally.³²⁶ The discussion examines CIPC Guidelines which make provision for the registration of colour, scent and sound marks.

3.3.1 COLOUR MARKS

When trade mark proprietors solely use a single colour or a combination of colours to distinguish their goods and services from other competitors and propose to register this as a trade mark, it is known as a colour mark.³²⁷ Unlike other non-traditional trade marks, colour is contained in the definition of a mark in the Trade Mark Act.³²⁸ Colour is usually registered in conjunction with other types of marks such as words or images.³²⁹ An example of this is the registered BP mark which features the letters BP with the colours green and yellow³³⁰ and the

³²¹ Application by Lewis Thomas Edwards [1946] RPC 19.

³²² Application by Lewis Thomas Edwards [1946] RPC 19.

³²³ Greeff A 'Non-traditional trade marks' available at <http://www.nsb.org.za/emailers/newsletter-2013/articles/article-28-nov-adams.html> (accessed on 24 October 2016).

³²⁴ Section 2(1) of the Trade Mark Act 194 of 1993.

³²⁵ Kobuss J, Bretz A & Hassani A *Become a Successful Designer. Protect and Manage Your Design Rights Internationally: Protect and Manage Your Design Rights Internationally* (2013) 124.

³²⁶ Greeff A 'Non-traditional trade marks' available at <http://www.nsb.org.za/emailers/newsletter-2013/articles/article-28-nov-adams.html> (accessed on 24 October 2016).

³²⁷ Michaels A & Norris A *A Practical Approach to Trade Mark Law* (2010) 37.

³²⁸ Section 2(1) of the Trade Mark Act 194 of 1993.

³²⁹ Kudrjavceva J 'Issues surrounding registration of colour trade marks' available at http://www.rgs.edu.lv/uploads/files/RP_9_Kudrjavceva_final.pdf (accessed on 30 March 2017).

³³⁰ Muhlberg H *The Law of the Brand: A Practical Guide to Branding Law in South Africa* (2005) 15.

Coca Cola trade mark with the words Coca Cola with a red background.³³¹

A single colour is, accordingly regarded as not inherently distinctive. Acquired distinctiveness will need to be shown in order for a single colour to be registered as a trade mark.³³² This is based on the colour depletion theory.³³³ This theory states that if a single colour is registered by one person or entity, the available colours that are available for use by competitors will be limited.³³⁴ As the number of colours registered increases, the amount of colours available to other competitors will decrease and other enterprises cannot use the registered colours.³³⁵ This will harm competition as competitors will not be able to use essential colours in the marketplace.³³⁶ Careful consideration has to be taken before granting a proprietor exclusive rights of a colour as there is only a limited range of colours.³³⁷

The Guidelines prescribe the procedural requirements that must be satisfied and it provides that a colour mark should consist of a sample of the colour.³³⁸ This sample should be contained on paper or in electronic format.³³⁹ The application should 'contain an indication of the internationally recognised colour codes'.³⁴⁰ The application must also be accompanied by a description, in writing, explaining how the colour is to be applied in the goods or used in relation to the services.³⁴¹ There haven't been any High Court decisions on colour marks that deal with a single colour mark in South Africa but there has been an application by Cadbury for the registration of the colour purple in respect of chocolate.³⁴² The application was rejected because there was not sufficient proof that the colour had become distinctive in the marketplace.³⁴³ The decision to reject this application was justified since registration of the colour purple would grant a monopoly on the colour to Cadbury. As a result of this, a single colour can only be registered if it has acquired a secondary meaning. The decision is thus

³³¹ Companies and Intellectual Property Commission 'Trade Marks' available at http://www.cipro.co.za/products_services/trademarks.asp (accessed on 29 March 2017).

³³² Webster G and Page N *South African law of trade marks, unlawful competition, company names and trading names* (2008) para [3.40.2]. See also Peter A and Ramsden A *Guide to intellectual property law* (2011) 105.

³³³ De Carvalho N *The TRIPS Regime of Trade Marks and Designs* (2011) 317.

³³⁴ Denoncourt J *Q&A Intellectual Property Law* (2015) 160.

³³⁵ Denoncourt J (2015) 160.

³³⁶ Denoncourt J (2015) 160.

³³⁷ Denoncourt J (2015) 160.

³³⁸ CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' *2009 Patent Journal* 460.

³³⁹ CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' *2009 Patent Journal* 460.

³⁴⁰ CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' *2009 Patent Journal* 460.

³⁴¹ CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' *2009 Patent Journal* 460.

³⁴² *Cadbury Ltd v Beacon Sweets & Chocolates (Pty) Ltd* 2004 Trade Mark Tribunal decision.

³⁴³ Van Zyl C 'Colour Trade Marks and Cadbury's Case: Precision Defined Imprecisely by the Courts' available at <http://www.vonseidels.com/colour-trade-marks-and-cadburys-case-precision-defined-imprecisely-by-the-courts/> (accessed on 12 December 2016).

correct as no proof of distinctiveness was submitted.

It seems most proprietors prefer to lodge their complaints regarding colour marks to at the Advertising Standards Authority (the ASA).³⁴⁴ The ASA is an independent, self-regulatory body developed by the marketing and communications industry.³⁴⁵ Its primary purpose is to regulate the advertising industry so that it works in the public's interest as well as to settle disputes within the industry.³⁴⁶ As trade marks have an advertising function, a close relationship exists between the Trade Mark Act and the ASA.³⁴⁷ One such successful complaint was *South African Breweries v Brandhouse Beverages*.³⁴⁸ South African Breweries (SAB), lodged a complaint against Brandhouse in terms of clause 8 of section 2 of the ASA Code for the use of the colours silver and green accompanied by the words 'Lite' on one of their beer products, namely Amstel Lite, claiming that this passed off on their product namely Castle Lite.³⁴⁹ This clause states that competitors must not 'take advantage of the advertising goodwill relating to the trade name or symbol of another company.'³⁵⁰ After SAB submitted evidence that Castle Lite was on the market for over 20 years and that 84% of people who were showed the Amstel Lite mark, identified it with Castle Lite, the ASA held that SAB built up an advertising goodwill in the colour combination of silver and green.³⁵¹ ASA then ordered Brandhouse to change Amstel Lite's packaging.³⁵² This case indicates that factors such as the period of use and the overall perception of the public can result in acquired distinctiveness. This case dealt with passing off but the same principles apply to registered trade marks as trade marks in South Africa are protected either by statute or in terms of common law.³⁵³ Owners of registered trade

³⁴⁴ Steyn W 'fifty shades of silver and ...' available at <https://www.ensafrica.com/news/fifty-shades-of-silver-and?Id=1748&STitle=IP%20ENSight> (accessed on 14 March 2017). The aim of ASA is to protect consumers and producers of advertisements by ensuring that advertising is legal, decent, honest and truthful. It achieves this by means of the Code of Advertising Practice, which is the official code of conduct of the authority.

³⁴⁵ 'The Advertising Standards Authority of South Africa' available at <http://www.asasa.org.za/> (accessed on 8 August 2018).

³⁴⁶ 'The Advertising Standards Authority of South Africa' available at <http://www.asasa.org.za/> (accessed on 8 August 2018).

³⁴⁷ 'The Advertising Standards Authority of South Africa' available at <http://www.asasa.org.za/> (accessed on 8 August 2018).

³⁴⁸ *South African Breweries v Brandhouse Beverages* Advertising Standard Authority directorate decision 6 February 2015.

³⁴⁹ *South African Breweries v Brandhouse Beverages* Advertising Standard Authority directorate decision 6 February 2015.

³⁵⁰ Advertising Standards Authority of South Africa Code of Advertising Practice 1999.

³⁵¹ *South African Breweries v Brandhouse Beverages* Advertising Standard Authority directorate decision 6 February 2015.

³⁵² *South African Breweries v Brandhouse Beverages* Advertising Standard Authority directorate decision 6 February 2015.

³⁵³ Mukuka G *Reap what You Have Not Sown: Indigenous Knowledge Systems and Intellectual Property Laws in South Africa* (2010) 22.

marks can institute an action for both.³⁵⁴ If a trade mark is not registered, protection is limited to the common law.³⁵⁵ In terms of the common law an action for passing off is available if a trade mark, trade name or get has acquired a reputation.³⁵⁶ Passing off is a form of unlawful competition.³⁵⁷ It occurs when a competitor falsely represents that his products are related or originate from another competitor.³⁵⁸

3.3.2 SOUND MARKS

A sound mark can be defined as a trade mark which uses audio rather than visual means to distinguish the goods and services of a proprietor from those of another.³⁵⁹ Examples of sound marks in general include the sound a device makes when it switches on,³⁶⁰ a film making company theme songs and sounds such as the lions roar for MGM films.³⁶¹

In terms of the procedural requirements, the Guidelines require the sound mark to be reflected in a musical notation on a stave, which is in essence an illustration of musical notes. A written description of the mark should accompany the musical notation as well as an analogue or digital recording.³⁶² The guidelines do not specify the format which should be used for the digital recording and as correctly submitted by Mupangavanhu MP3 format should be allowed as this enables electronic filing, which keeps in line with technological developments.³⁶³ This promotes speed and efficiency.³⁶⁴ The Nokia tone is an example of a sound mark registered in South Africa.³⁶⁵

The guidelines for sound marks appear not to be in line with current technological developments. This is because only musical marks are able to be reflected in a musical notation

³⁵⁴ Klopper H, Pistorius T, Rutherford B *et al*, *Law of Intellectual Property in South Africa* (2011) 71.

³⁵⁵ Woker T *The Franchise Relationship Under South African Law* (2012) 185.

³⁵⁶ Mukuka G *Reap what You Have Not Sown: Indigenous Knowledge Systems and Intellectual Property Laws in South Africa* (2010) 22.

³⁵⁷ Brand R *Media Law in South Africa* (2011) 117.

³⁵⁸ *Capital Estates & General Agencies (Pty) Ltd v Holiday Inns Inc* [1977] 3 All SA 306 (A) pg 314.

³⁵⁹ Sreenivasulu N (2013) 123.

³⁶⁰ Greeff A 'Non-traditional trade marks' available at <http://www.nsb.org.za/emailers/newsletter-2013/articles/article-28-nov-adams.html> (accessed on 24 October 2016).

³⁶¹ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017).

³⁶² CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' *2009 Patent Journal* 460.

³⁶³ Mupangavanhu Y 'The Protection Of Scent, Taste and Sound Marks in South Africa: Threats and Possibilities' *SA Intellectual Property Law Journal* 23.

³⁶⁴ Mupangavanhu Y 'The Protection Of Scent, Taste and Sound Marks in South Africa: Threats and Possibilities' *SA Intellectual Property Law Journal* 23.

³⁶⁵ Greeff A 'Non-traditional trade marks' available at <http://www.nsb.org.za/emailers/newsletter-2013/articles/article-28-nov-adams.html> (accessed on 24 October 2016).

on a staff and this excludes other sound marks such as noises, which are also sound marks.³⁶⁶ Sound marks also pose problems as a musical notation might be played differently by a musician and an intellectual property law expert.³⁶⁷ This could lead to different impressions of what sound is actually registered and this could lead to a situation where registered sound mark is different from the sound mark that is actually used by the proprietor.³⁶⁸

Elements such as style, rhythm, volume and emotion also need to be taken into account in sound marks.³⁶⁹ These cannot be recorded in a musical notation.³⁷⁰ These elements constitute important aspects of sound and without them a holistic representation is not provided.³⁷¹ There is also the challenge that the registration of sound marks could overlap with copyright, as audio intellectual property is generally protected by copyright³⁷² which is another form of intellectual property. The difference between copyright and trade mark is that they protect different areas of intellectual property.³⁷³ Trade marks are concerned with the protection and regulation of source identifiers of goods and services whereas copyright is concerned with the protection of works such as books and movies itself.³⁷⁴

3.3.3 SCENT MARKS

A scent mark is any smell that is used to distinguish the goods of its proprietor from those of its competitors and that does not stem from the nature of the product itself.³⁷⁵ Scent marks are

³⁶⁶ Trilett G *Registrability of smells, colours and sound: How to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within the European Union Law?* (published thesis at the University of Strasbourg, France) 16.

³⁶⁷ Majumdar A, Sadhu S & Majumdar S 'The Requirement of Graphical Representability for Non-Conventional Trade Marks' *Journal of Intellectual Property Rights* 316.

³⁶⁸ Majumdar A, Sadhu S & Majumdar S 'The Requirement of Graphical Representability for Non-Conventional Trade Marks' *Journal of Intellectual Property Rights* 316.

³⁶⁹ Zaitseva A 'Challenging Aspects of the Legal Protection of Non-Traditional Trade Marks' available at <http://www.jwpat.com/en/index.php?m=content&c=index&a=show&catid=17&id=17> (accessed on 14 March 2017).

³⁷⁰ Zaitseva A 'Challenging Aspects of the Legal Protection of Non-Traditional Trade Marks' available at <http://www.jwpat.com/en/index.php?m=content&c=index&a=show&catid=17&id=17> (accessed on 14 March 2017).

³⁷¹ Zaitseva A 'Challenging Aspects of the Legal Protection of Non-Traditional Trade Marks' available at <http://www.jwpat.com/en/index.php?m=content&c=index&a=show&catid=17&id=17> (accessed on 14 March 2017).

³⁷² Scungio M 'Non-Traditional Marks in the U.S. –A Perspective' available at http://aippi.org/wp-content/uploads/2014/11/Maria_Scungio_PS_VII_091015.pdf (accessed on 12 December 2016).

³⁷³ Truex L 'Differences Between Copyright and Trade Mark' available at <http://smallbusiness.chron.com/differences-between-copyright-trademark-3218.html> (accessed on 18 June 2017).

³⁷⁴ Truex L 'Differences Between Copyright and Trade Mark' available at <http://smallbusiness.chron.com/differences-between-copyright-trademark-3218.html> (accessed on 18 June 2017).

³⁷⁵ Mezulanik E 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 30 March 2017).

also known as olfactory trade marks or smell trade marks.³⁷⁶ At the very least, a written description of the mark that should be filed.³⁷⁷ The registrar may also set any other conditions for the purpose of examination, such as requiring a specimen of the mark.³⁷⁸ The Sieckmann test also applies.³⁷⁹

The Sieckmann test was formulated in the case of *Ralf Sieckmann v Deutsches Patent- und Markenamt*.³⁸⁰ In this case the applicant wished to register a ‘menthyl cinnamate’ scent which was described as ‘balsamically fruity with a slight hint of cinnamon.’³⁸¹ The applicant wished to represent this scent by means of a chemical formula of the substance, a written description of the mark and a physical sample of the scent.³⁸² The criteria are that the mark must be ‘clear, precise, self-contained, easily accessible, intelligible, durable and objective.’³⁸³ The court rejected written descriptions as a manner in which scent marks can be represented in terms of the Sieckmann test as they are not a clear and precise representation of a mark.³⁸⁴ The chemical formula and physical sample of the scent were also rejected as they were not sufficiently clear, precise, intelligible and durable.³⁸⁵ The smell mark could thus not be registered as it did not meet the graphical representation requirement.³⁸⁶

To date, no scent mark has been registered in South Africa.³⁸⁷ The question which arises is whether South Africa should retain the Sieckmann test. There are two options that exist. South Africa may choose to retain the Sieckmann test since it provides certainty and will reduce the number of applications for scent marks that cannot be properly represented. The other option would be to totally disregard the Sieckmann test and adopt a more liberal approach in terms of

³⁷⁶ Kongolo T *African Contributions in Shaping the Worldwide Intellectual Property System* (2016) 47.

³⁷⁷ CIPRO office ‘Guidelines with regard to the lodging of non-traditional marks’ 2009 *Patent Journal* 460.

³⁷⁸ CIPRO office ‘Guidelines with regard to the lodging of non-traditional marks’ 2009 *Patent Journal* 460.

³⁷⁹ CIPRO office ‘Guidelines with regard to the lodging of non-traditional marks’ 2009 *Patent Journal* 460.

³⁸⁰ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), Case C-273/00 [2002] ECR I-11737

³⁸¹ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 11.

³⁸² *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 11.

³⁸³ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), Case C-273/00 [2002] ECR I-11737 para 52-55.

³⁸⁴ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), Case C-273/00 [2002] ECR I-11737 para 70.

³⁸⁵ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), Case C-273/00 [2002] ECR I-11737 para 70.

³⁸⁶ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002 Case C-273/00] ECR I-11737 para 72.

³⁸⁷ Scott G ‘South Africa: IP Protection For Fragrances’ available at <http://www.mondaq.com/southafrica/x/336746/Trademark/IP+Protection+For+Fragrances> (accessed 12 December 2016).

which written descriptions of the mark can be accepted, such as the position adopted in the United States of America (the USA), which is discussed in chapter 4.

The challenge that is posed by the registration of scent marks is that scent is subjective in nature and is not uniform.³⁸⁸ The challenging nature of scent makes it difficult as consumers will easily be confused when they have to identify the scent.³⁸⁹ A scent is a mixture of substances, some of which may be hard to identify.³⁹⁰ Scent is also not durable and a bottled sample of a smell would decay over time, this makes the sample of a scent difficult to ascertain by the registrar after a period of time.³⁹¹ It is also important to note that if consumers dislike the scent, it could discourage them from buying the goods or services of the scent mark proprietor.³⁹² The functionality doctrine prevents marks which are essential to the use of the goods to be registered as a trade mark.³⁹³ Therefore, scent of a perfume does not qualify as a scent mark as it stems from the nature of the perfume.³⁹⁴ Furthermore, the registration of scent marks may be further problematic as a result of the requirement of graphical representation. Scent marks are not visibly perceptible and therefore they cannot easily be represented graphically. The same applies to sound marks.

3.4 REGISTRATION PROCEDURE

Before applying to register a trade mark the applicant should conduct a preliminary registrability search on the trade mark register to determine whether there are any confusing or deceptively similar trade marks or identical trade marks which has already been registered.³⁹⁵ As previously discussed, a trade mark cannot be registered if it is confusing or deceptively similar to an existing mark.³⁹⁶ The purpose of the preliminary search is to prevent the unnecessary process of having to remove a mark which is similar or identical to another registered mark from the register and to prevent further court proceedings for trade mark

³⁸⁸ Barkkume A *Hidden Scents: The Language of Smell in the Age of Approximation* (2016) 60.

³⁸⁹ Goldstein E *Sensation and Perception* (2013) 373.

³⁹⁰ Zumdahl S & DeCoste D *Basic Chemistry* (2014) 49.

³⁹¹ Hart T, Clark S & Fazzani L *Intellectual Property Law* (2013) 110.

³⁹² Ratner D *Creating Customer Love: Make Your Customers Love You So Much They'll Never Go Anyplace Else!* (2009) 4.

³⁹³ Mezulanik E 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 30 March 2017).

³⁹⁴ Mezulanik E 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 30 March 2017).

³⁹⁵ Dun and Bradstreet International Services *Exporters' Encyclopedia* (1999) 1074.

³⁹⁶ Section 10(12) of the Trade Mark Act 194 of 1993.

infringement.³⁹⁷ The preliminary search thus potentially saves time and money.³⁹⁸

Section 11(1) of the Trade Mark Act states:

‘A trade mark shall be registered in respect of goods or services falling in a particular class or particular classes in accordance with the prescribed classification: Provided that the rights arising from the registration of a trade mark shall be determined in accordance with the prescribed classification applicable at the date of registration thereof.’³⁹⁹

The applicant then has to choose the correct class of goods and services he wishes to register the trade mark in terms of the Nice Classification.⁴⁰⁰ There are 45 different classes⁴⁰¹ and the purpose of classification of goods and services is to simplify trade mark registration.⁴⁰² The Nice Classification, established by the Nice Agreement of 1957 is an international classification system used for trade mark applications.⁴⁰³ The Nice Classification allows for narrower searches for existing marks when doing preliminary searches on the trade mark register. This is achieved by providing a detailed list of classes available, this ensures that each mark is properly filed under a specific class for the proper administration of the trade mark registration system.⁴⁰⁴

Once the application is submitted, the registrar examines it to see whether or not any of the grounds of refusal discussed above apply.⁴⁰⁵ Once the registrar has made a decision he must notify the applicant within a reasonable time.⁴⁰⁶ The applicant should within three months notify the registrar if he accepts or objects to the registrar's decision.⁴⁰⁷ If he objects he must provide written arguments or request a hearing to argue the application before the registrar.⁴⁰⁸ This is important because it provides the applicant with a fair chance to set out the basis of his argument as to why his mark should be registered.⁴⁰⁹ The applicant is allowed to appeal against

³⁹⁷ Bryer L & Simensky M *Intellectual Property Assets in Mergers and Acquisitions* (2002) 26.

³⁹⁸ Bryer L & Simensky M (2002) 26.

³⁹⁹ Section 11 (1) of the Trade Mark Act 1993.

⁴⁰⁰ Regulation 4 of the Trade Marks Regulations 1993.

⁴⁰¹ Regulation 4 of the Trade Marks Regulations 1993.

⁴⁰² Valentine C & Meyerson M *World Class Speaking in Action: 50 Certified Coaches Show You How to Present, Persuade, and Profit* (2014) 266

⁴⁰³ Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks 1957.

⁴⁰⁴ The International Classification of Goods and Services is a system used for the process discussed above. South Africa is not a member of his system but also use the classification process.

⁴⁰⁵ Section 16(2) of the Trade Marks Act 1993.

⁴⁰⁶ Section 16(3) of the Trade Marks Act 1993.

⁴⁰⁷ Regulation 15 of the Trade Marks Regulations 1993.

⁴⁰⁸ Regulation 15 of the Trade Marks Regulations 1993.

⁴⁰⁹ Sreenivasulu N *Law Relating to Intellectual Property* (2013) 100.

the registrar's decision to the High Court.⁴¹⁰

If the registrar accepts the application, the applicant should ensure that the acceptance is advertised in the Patent Journal.⁴¹¹ The application may be opposed on any of the grounds trade mark registration can be refused, by interested parties within three months from the date on which the application's acceptance is advertised.⁴¹² This complies with Article 15(5) of TRIPS.⁴¹³ If those opposing are still not satisfied with the decision of the registrar, they may appeal to the High Court⁴¹⁴ and then the Supreme Court of Appeal.⁴¹⁵ This allows opposing parties a fair chance to challenge the decision and set out the basis of their arguments as well.⁴¹⁶ Once the application has been accepted and advertised for a period of three months and it has not been opposed or unsuccessfully opposed, the trade mark is registered and the registrar issues the applicant with a certificate of registration.⁴¹⁷

3.5 CONSTITUTIONAL APPROACH

The Constitution is the supreme law of South Africa.⁴¹⁸ Any law which is inconsistent with the Constitution is invalid.⁴¹⁹ This includes trade mark law.⁴²⁰ Trade mark law must thus be interpreted in a way that does not unduly restrict the fundamental rights contained in the Bill of Rights.⁴²¹ This does not mean that trade mark law should take a back seat to the rights found in the Bill of Rights.⁴²² In any case, a trade mark is a form of intellectual property and is protected in terms of section 25 of the Constitution. Section 36 of the Constitution allows rights to be limited by a law of general application to an extent that is reasonable and justifiable in an open and democratic society.⁴²³ This section thus allows limitation of rights in order to achieve

⁴¹⁰ Section 53 of the Trade Marks Act 194 of 1993.

⁴¹¹ Section 17 of the Trade Marks Act 194 of 1993 & Regulation 18 of the Trade Marks Regulations 1993.

⁴¹² Section 21 & 45(3) of the Trade Marks Act 194 of 1993 & Regulation 52 of the Trade Marks Regulations 1993.

⁴¹³ Article 15(5) of the Agreement on Trade Related Aspects of Intellectual Property states that 'Members shall publish each trade mark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trade mark to be opposed'.

⁴¹⁴ Section 53(4) of the Trade Marks Act 194 of 1993.

⁴¹⁵ Section 53(5) & 53(6) of the Trade Marks Act 194 of 1993.

⁴¹⁶ Sreenivasulu N (2013) 100.

⁴¹⁷ Section 29 of the Trade Marks Act 194 of 1993.

⁴¹⁸ Section 2 of the Constitution of the Republic of South Africa 1996.

⁴¹⁹ Section 2 of the Constitution of the Republic of South Africa 1996.

⁴²⁰ Klopper H, Pistorius T, Tong L *et al*, (2017) 108.

⁴²¹ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 18.

⁴²² Klopper H, Pistorius T, Tong L *et al*, (2017) 109.

⁴²³ Section 36 of the Constitution of the Republic of South Africa 1996.

a balance between the rights of trade mark proprietors and the rights of the public at large.

A case in point is the case of *Laugh it Off Promotions CC v South African Breweries International*.⁴²⁴ In this case, the appellant sold T-shirts which mocked the respondent's brand replacing their famous slogan 'America's lusty, lively beer, Carling Black Label beer, enjoyed by mean around the world' with the words 'Black Labour, White Guilt, Africa's lusty lively exploitation since 1652, no regard given world-wide'.⁴²⁵ The court held that it had to balance the right to freedom of expression provided in section 16 of the Constitution and the right to trade mark protection.⁴²⁶ The court further held that the respondent could not show real or even probable likelihood that the T-shirts caused them economic harm and ruled in favour of the appellant.⁴²⁷ The decision shows that freedom of expression cannot simply be disregarded by an overzealous application of trade mark law in a way which would be detrimental to other rights such as freedom of expression.⁴²⁸

Deacon and Govender submit that while trade marks deserve protection, a careful balance needs to be drawn between their protection and other fundamental rights.⁴²⁹ Dean lauds this judgment as a good balancing act as the court afforded equal status to the trade mark proprietor and the rights enshrined in the Bill of Rights.⁴³⁰ Sikwane agrees with this and adds that trade mark proprietors need to accept that their rights are limited and that the public needs to accept that it is only limited to a certain extent.⁴³¹ Brickhill submits that the purpose of s 34 (1) (c) is

⁴²⁴ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC). This case deals with balancing the interests of trade mark proprietors and the right to freedom of speech however the balancing act used here would apply equally to striking a balance between trade mark proprietors and the public at large.

⁴²⁵ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 8.

⁴²⁶ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 2-3.

⁴²⁷ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 74.

⁴²⁸ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 87.

⁴²⁹ Deacon J & Govender I 'Trade mark parody in South Africa' *Journal for Juridical Science* (2007)18.#

⁴³⁰ Dean O 'Spoor & Fisher Comment on the SAB vs Laugh it Off. Case: Both Rights Enjoy Equal Status Before Court' available at <http://www.spoor.com/en/News/spoor-&-fisher-comment-on-the-sab-vs-laugh-it-off-case-both-rights-enjoy-equal-status-before-court/> (accessed on 9 October 2017).

⁴³¹ Sikwane R 'a take-off, not a rip-off' available at <https://www.ensafrica.com/news/a-take-off-not-a-rip-off?Id=1448&STitle=IP%20ENSight> (accessed on 9 October 2017).

to preserve the economic value of the trade mark.⁴³² He therefore agrees with the court that the respondent needed to prove economic harm in order to restrain the appellant from using the mark as a parody.⁴³³ Devenish opines that it is important for the courts to weigh up conflicting values and interests in society.⁴³⁴ He applauds the Constitutional Court for weighing up these values well.⁴³⁵ He notes that while everyone may not be pleased with the judgment, it is not the court's job to please everyone but to do justice in a complex society that has many conflicting interests.⁴³⁶

This judgment is significant as it shows how the Constitution enables courts to contribute towards striking a balance between the interests of trade mark proprietors and the public at large. Along with the legislative provisions in the Trade Mark Act, South Africa has an impressive framework for purposes of striking a balance regarding the above mentioned tension. The Trade Mark Act provides the legal certainty of codified rules and the Constitution provides courts with the power to develop balancing approaches as the needs of society changes.

3.6 CONCLUSION

This chapter set out to discuss the requirements for the registration of both traditional and non-traditional trade marks in South Africa since some of the provisions apply to both traditional and non-traditional trade marks. The chapter examined sections 2, 9 and 10 of the Trade Marks Act insofar as they deal with the requirements for registration. All trade marks must comply with the same substantive requirements including non-traditional marks. A mark should thus fall within the definition of a trade mark, and it should be capable of distinguishing the goods or services of one enterprise from those of another. A mark should not fall within section 10 which sets out examples of trade marks that are unregistrable. Lastly, a mark should satisfy the procedural requirements provided in the Regulations. All of these requirements need to be met in order for a mark to qualify for registration as a trade mark.

⁴³² Brickhill J 'Breaking down the boardroom doors with a snigger and a smirk - laugh it off laughs last : case note' *SA Public Law* (2006) 218

⁴³³ Brickhill J 'Breaking down the boardroom doors with a snigger and a smirk - laugh it off laughs last : case note' *SA Public Law* (2006) 223.

⁴³⁴ Devenish G 'We Are Amused: Laugh It off Promotions CC v SAB International (Finance) BV t/a Sabmark International' *The South African Law Journal* (2005)802.

⁴³⁵ Devenish G 'We Are Amused: Laugh It off Promotions CC v SAB International (Finance) BV t/a Sabmark International' *The South African Law Journal* (2005)803.

⁴³⁶ Devenish G 'We Are Amused: Laugh It off Promotions CC v SAB International (Finance) BV t/a Sabmark International' *The South African Law Journal* (2005)803.

The chapter also examined the requirements for the registration of non-traditional trade marks as provided in the Guidelines in relation to sound, colour and scent marks. The Trade Marks Act does not explicitly make reference to non-traditional marks with the exception of colour, shape and configuration marks. It seems the Trade marks Act was designed for traditional trade marks. This led the Registrar publish guidelines for the registration of non-traditional marks such as scent and sound marks.

It would seem that non-visual non-traditional trade marks are more difficult to register than visual non-traditional marks due to the graphical representation requirement prescribed by the Trade Mark Act. This view is further strengthened by the low number of registered marks in this category. The Guidelines set out different requirements which these marks must satisfy to qualify for registration. For example, it provides that sound marks must be represented by means of a musical notation on a staff. This provides a mechanism for musical sound marks to be graphically represented. There is, however, no provision made for noise marks. Further challenges of musical notations on staff include the concern that it might be played differently by a musician and an intellectual property law expert. The style, rhythm, volume and emotion must also be taken into consideration. These cannot be recorded in a musical notation.

Scent marks must satisfy Sieckmann criteria. Written descriptions were rejected as a manner in which scent marks can be represented in terms of the *Ralf Sieckmann v Deutsches Patent- und Markenamt* ('*Methylcinnamat*') case. This is the judgment that established the Sieckmann criteria. It is thus uncertain how the Sieckmann criteria will be applied in South Africa.

Trade mark law in South Africa is not only regulated by the Trade Mark Act but also subject to Constitutional scrutiny. As the Constitution is the supreme law of the land, its values cannot be ignored by the courts. As a result of the strength of these values, the Constitutional approach adopted by South Africa provides a mechanism for balancing the competing interests of trade mark proprietors and the public at large as shown in *Laugh it Off Promotions CC v South African Breweries International*.⁴³⁷

The publication of the Guidelines for the registration of non-traditional trade marks provide hope for the future but South Africa has a long way to go to keep up with the pace of the growth

⁴³⁷ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC). This case deals with balancing the interests of trade mark proprietors and the right to freedom of speech however the balancing act used here would apply equally to striking a balance between trade mark proprietors and the public at large.

of non-traditional trade marks, notwithstanding the impressive Constitutional approach. The next question would be how the position of South Africa compares with other jurisdictions. The next chapter will discuss the registration of traditional and non-traditional marks in the USA and in the EU.

CHAPTER 4

THE REGISTRATION OF TRADE MARKS IN THE UNITED STATES OF AMERICA AND THE EUROPEAN UNION

4.1 INTRODUCTION

As with most laws, the legal position of non-traditional trade marks varies with different jurisdictions.⁴³⁸ The previous chapter discussed the registration of trade marks in South Africa. This chapter will discuss the legal protection of non-traditional trade marks, more specifically colour, sound and scent marks in the United States of America (the USA) and the European Union (the EU). It will include a comparison between the legal position of non-traditional trade marks in these jurisdictions and that of South Africa.

4.2 REGISTRATION OF TRADITIONAL TRADE MARKS

4.2.1 UNITED STATES OF AMERICA

There are two registers available for trade mark registration in the USA.⁴³⁹ These are the Principal and Supplemental Registers.⁴⁴⁰ A mark is registered on the Principal Register if it is inherently distinctive or if it has acquired distinctiveness.⁴⁴¹ The Principal Register provides the proprietor of a mark with the presumption that the mark is valid, prima facie evidence of ownership of the mark and an acknowledgment that it is being continuously and exclusively used.⁴⁴² In addition to this there is the possibility, after five years of continuous, uninterrupted use from the date of registration of achieving incontestable status.⁴⁴³

When marks are not yet distinctive but merely descriptive, they can be registered on the Supplemental register until distinctiveness is acquired.⁴⁴⁴ Although the Supplemental Register does not provide the benefits of the Principal Register, it does provide some important

⁴³⁸ Carapeto R 'A reflection about the introduction of non-traditional trade marks' *Wasedo Bulletin of Comparative Law* (2016) 34.

⁴³⁹ Sharpe C *Patent, Trade Mark, and Copyright Searching on the Internet* (1999) 71.

⁴⁴⁰ Sharpe C *Patent, Trade Mark, and Copyright Searching on the Internet* (1999) 71.

⁴⁴¹ Lanham Act § 1052, 15 U.S.C. § 1127.

⁴⁴² Gurfinkel D 'The U.S. Trade Mark Registers: Supplemental vs. Principal' available at <https://www.inta.org/INTABulletin/Pages/TheUSTrademarkRegistersSupplementalvsPrincipal.aspx> (accessed on 16 August 2017).

⁴⁴³ Lanham Act § 1065, 15 U.S.C. § 1127.

⁴⁴⁴ Lanham Act § 1091, 15 U.S.C. § 1127.

benefits.⁴⁴⁵ Registration on the Supplemental Register allows the mark to appear in trade mark searches.⁴⁴⁶ In addition to this, marks which are registered on the Supplemental Register may, through treaties, assist in achieving registration and providing priority to the application for the mark in some foreign countries and regions.⁴⁴⁷ The registration on the Supplemental Register may also be used to prove exclusive use of a mark for a five year period, one of the aspects of proving distinctiveness for registration on the Principal register.⁴⁴⁸

The Lanham Act,⁴⁴⁹ which regulates trade mark law in the USA, defines a trade mark as:

'any word, phrase, symbol or design, or combination thereof that identifies and distinguishes the source of the goods of one party from those of others.'⁴⁵⁰

The definition requires the trade mark to 'identify' and also 'distinguish' the source of the goods. The definition thus incorporates both the origin and distinguishing function. This means that consumers must be able to make a mental connection between the mark and the trade mark proprietor.⁴⁵¹ More so, the consumer must be able to differentiate the goods of the trade mark proprietor from those of its competitors.⁴⁵² Naser opines that the source identifying function of a trade mark is its primary function.⁴⁵³

Section 1127 is similar to Article 15 of TRIPS insofar as the list of what constitutes a trade mark is not exhaustive.⁴⁵⁴ The definition provided for by the Lanham Act is broad and this allows various kinds of marks, including non-traditional trade marks such as sound, scent and

⁴⁴⁵ Gurfinkel D 'The U.S. Trade Mark Registers: Supplemental vs. Principal' available at <https://www.inta.org/INTABulletin/Pages/TheUSTrademarkRegistersSupplementalvsPrincipal.aspx> (accessed on 16 August 2017).

⁴⁴⁶ Soodek C *Birth to Buyout: Law for the Life Cycle of Your Business* (2011) 126.

⁴⁴⁷ Soodek C *Birth to Buyout: Law for the Life Cycle of Your Business* (2011) 126.

⁴⁴⁸ Soodek C *Birth to Buyout: Law for the Life Cycle of Your Business* (2011) 126.

⁴⁴⁹ The Trade Mark Act 1946.

⁴⁵⁰ Lanham Act § 45, 15 U.S.C. § 1127.

⁴⁵¹ Finkelstein W *The Intellectual Property Handbook: A Practical Guide for Franchise, Business, and IP Counsel* (2005) 48.

⁴⁵² Mann R & Roberts B *Business Law and the Regulation of Business* (2016) 941.

⁴⁵³ Naser M 'Re-examining functions of a trade mark' *Chicago-Kent Journal of Intellectual Property* (2008) 100.

⁴⁵⁴ Article 15 of the Agreement on Trade Related Aspects of Intellectual Property states that 'Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.'

colour.⁴⁵⁵ Distinctiveness is one of the substantive requirements for registration. A mark is inherently distinctive when the mark is a new invention.⁴⁵⁶

Section 2(f) of the Lanham Act provides that:

‘Nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.’⁴⁵⁷

This section makes provision for a mark which is not inherently distinctive. Distinctiveness may be acquired through use. A mark that is functional does not qualify for registration. This is in terms of the functionality doctrine which prohibits the registration of a mark that is essential to the use of a product or significantly increases the value thereof.⁴⁵⁸ Finally, the proposed mark must fall outside of the list of unregistrable trade marks provided in section 1052 of the Lanham Act.⁴⁵⁹

The Lanham Act prohibits the registration of a mark that consist of scandalous matter.⁴⁶⁰ Examples of trade marks that were considered scandalous include the word ‘Cocaine’⁴⁶¹ on soft drinks and energy drinks, and the word ‘Bullshit’ when attached to any products.⁴⁶²

A mark which creates a false suggestion of affiliation with persons, institutions, beliefs or national symbols does not qualify for registration.⁴⁶³ The prohibition is aimed at eliminating confusion amongst the public, leading to the impression that the goods and services of the proposed proprietor are linked to the said person, institution, belief or national symbol.⁴⁶⁴ Similarly, a mark consisting of the flag or coat of arms of the USA also cannot be registered.⁴⁶⁵ This is to avoid the impression that the goods and services of the proposed proprietor are linked to the government of the USA.⁴⁶⁶

⁴⁵⁵ Lanham Act § 45, 15 U.S.C. § 1127.

⁴⁵⁶ Mullin B, Hardy S & Sutton W *Sport Marketing 4th Edition* (2014) 400.

⁴⁵⁷ Lanham Act § 2(f), 15 U.S.C. § 1127.

⁴⁵⁸ Schwabach A *Intellectual Property: A Reference Handbook* (2007) 27. The functionality doctrine applies mainly to non-traditional trade marks and will be discussed from part 4.3 onwards in this chapter.

⁴⁵⁹ Lanham Act § 1052, 15 U.S.C. § 1127.

⁴⁶⁰ Lanham Act § 1052(a), 15 U.S.C. § 1127.

⁴⁶¹ *In re Kirby*, 2008 TTAB LEXIS 156 (T.T.A.B. 2008).

⁴⁶² *In re Red Bull GmbH*, 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006).

⁴⁶³ Lanham Act § 1052(c), 15 U.S.C. § 1127.

⁴⁶⁴ Bartholomew J ‘The Scope of Protection Under §§ 2 & 43 of the Lanham Act’ available at <https://law.lclark.edu/live/files/13423-bartholomewlanhamact2v43pdf> (accessed on 30 June 2017).

⁴⁶⁵ Lanham Act § 1052(b), 15 U.S.C. § 1127.

⁴⁶⁶ Bartholomew J ‘The Scope of Protection Under §§ 2 & 43 of the Lanham Act’ available at <https://law.lclark.edu/live/files/13423-bartholomewlanhamact2v43pdf> (accessed on 30 June 2017).

4.2.2 THE EUROPEAN UNION

On 24 December 2015, the EU passed a new reform package with amendments to the Community Trade Mark Regulation and the Trade Marks Directive.⁴⁶⁷ The removal of the graphical representation requirement took effect from 1 October 2017.⁴⁶⁸ The new reform will have a big impact on the registration of non-traditional trade marks.⁴⁶⁹ The Community Trade Mark Regulation has been renamed to the European Union Trade Mark Regulation⁴⁷⁰ (the EUTMR).

Article 4 of the EUTMR⁴⁷¹ which is similar to Article 3 of the amended Trade Mark Directive⁴⁷² define a trade mark as follows:

‘A trade mark may consist of 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:’

1. Distinguishing the goods or services of one undertaking from those of other undertakings; and
2. 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.⁴⁷³

The above definition similarly requires signs which are capable of constituting a trade mark to be capable of distinguishing the goods or services of one undertaking from those of other undertakings. It also requires the sign to be capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. It can thus be noted that the requirement of graphical representation has been removed from the new definition of a trade mark. This was a big stumbling block for the registration of non-traditional trade marks in the EU. The removal of this requirement has now paved the way for noises to

⁴⁶⁷ Grimshaw R ‘Reforms to European Trade Mark Law’ available at <http://mewburn.com/resource/reforms-to-european-union-trade-mark-law/> (accessed on 4 April 2017).

⁴⁶⁸ Kulbaba T ‘EU Trade Mark Law Reform Series: Implications for Non-traditional Marks’ available at http://www.inta.org/INTABulletin/Pages/EU_TM_Reform_7103.aspx (accessed on 4 April 2017).

⁴⁶⁹ Kulbaba T ‘EU Trade Mark Law Reform Series: Implications for Non-traditional Marks’ available at http://www.inta.org/INTABulletin/Pages/EU_TM_Reform_7103.aspx (accessed on 4 April 2017).

⁴⁷⁰ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) (Text with EEA relevance).

⁴⁷¹ Article 4 of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015

⁴⁷² Article 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁴⁷³ Article 4 of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 & Article 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

be registered as sound marks as a musical notation on a staff is no longer required.⁴⁷⁴ A sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.⁴⁷⁵

The registration of scent marks will, however, remain difficult. The requirement of graphical representation has been replaced with the ‘clear and precise requirement.’ This indicates that the Sieckmann criteria will continue to be applied. There is still room for the protection of scent marks in the future as scent domes can be used to form a representation, this would make online registration easier as domes are digitally activated.⁴⁷⁶

The registration of colour marks was not affected by the new reform. The test for graphical representation set out in *Libertel Groep BV v Benelux-Merkenbureau*⁴⁷⁷ that for the representation for colour marks should be clear and precise. The removal of the graphical representation requirement has been greeted with positivity. Friedmann opines that the removal of this requirement will open the door for the positive development of trade mark law in the EU as the graphical representation requirement was a barrier for the growth of trade mark law in the EU.⁴⁷⁸

The registration of trade marks in the EU are regulated by the Trade Mark Regulation⁴⁷⁹ and the Trade Mark Directive.⁴⁸⁰ Although Directives stipulate results that must be achieved, member states are, however, free to decide how the result will be achieved.⁴⁸¹ Members must adapt their legislation to achieve these results.⁴⁸² Regulations are binding and become immediately enforceable as law in all the member states.⁴⁸³ Over time these Directives and

⁴⁷⁴ Article 4 of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 & Article 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁴⁷⁵ Para 13 of the Preamble to the Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁴⁷⁶ Holden G *Internet Babylon: Secrets, Scandals, and Shocks on the Information Superhighway* (2004)423.

⁴⁷⁷ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793 para 35-37.

⁴⁷⁸ Friedmann D ‘EU opens door for sound marks: will scent marks follow?’ *Journal of Intellectual Property Law & Practice* (2015) 932.

⁴⁷⁹ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015.

⁴⁸⁰ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁴⁸¹ Article 288 of the Treaty on the Functioning of the European Union 2007.

⁴⁸² Article 288 of the Treaty on the Functioning of the European Union 2007.

⁴⁸³ Article 288 of the Treaty on the Functioning of the European Union 2007.

Regulations have been reformed to keep in line with how trade mark law have developed. The last time these were reformed was in 2015.⁴⁸⁴

It is important to examine the EU trade mark system before the new trade mark reform since South Africa's Trade Mark Act has provisions that mirror those in the old Directive and Regulation.

A trade mark is defined in the European Trade Mark Directive 2008/95/EC as follows:

‘A trade mark may consist of any *signs capable of being represented graphically*, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.’⁴⁸⁵

In terms of the 2015 Directive, a trade mark is defined as follows:

‘A trade mark may consist of any sign, 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:

- (a) Distinguishing the goods or services of one undertaking from those of other undertakings:
and
- (b) *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.*⁴⁸⁶

To qualify as a trade mark, a mark must consist of a sign. In the Directive 2008/98/EC examples of signs that should be registered included words, designs and shape. The list did not expressly include non- visible trade marks. In the 2015 Directive, the examples of signs that constitute a trade mark expressly includes colour and sound. **The inclusion of colour and sound is a new development which is consistent with the technological developments taking place.** A sign ‘covers any message which may be perceived by one of the five senses’ and can thus consist of anything ranging from a colour, word, drawing, scent, sound⁴⁸⁷

⁴⁸⁴ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 & Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015

⁴⁸⁵ Article 2, Directive 2008/95/EC of the European Parliament and of the Council. This Directive was amended in 2015 by Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015: my emphasis

⁴⁸⁶ Article 4 of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 & Article 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015: my emphasis.

⁴⁸⁷ *Dyson Ltd. v Registrar of Trade Marks* [2007] Case C-321/03 2 CMLR 14 (ECJ) para 30.

The EU initially had the requirement that the mark must be capable of being represented graphically.⁴⁸⁸ This was an obstacle for the registration of non-visual marks and this limited the amount of trade marks that could be registered.⁴⁸⁹ Since 1 October 2017, the graphical representation requirement no longer applies when submitting a trade mark application. The position has accordingly since changed. The requirement of graphical representation has been replaced by the ‘clear and precise’ requirement.⁴⁹⁰ The new development is aimed at accommodating the registration of non-traditional trade marks.⁴⁹¹

The EU also requires a mark to be distinctive. In *CNH Global NV v OHIM*⁴⁹² the applicant wished to register a combination of the colours red, black and grey applied to the exterior surfaces of tractors.⁴⁹³ The court held that because of the unitary nature of the community trade mark, distinctiveness must be shown in the whole EU.⁴⁹⁴ Article 1 of the old Council Regulation (EC) No 207/2009 provided that the community trade mark has an equal effect throughout the entire EU.⁴⁹⁵ The applicant failed to show distinctiveness in ten member states and subsequently the application for a community trade mark was rejected.⁴⁹⁶

Another illustration of this difficulty was shown in *Société des Produits Nestlé SA v Cadbury UK Ltd*.⁴⁹⁷ This case concerned the registration of a four finger shape mark on chocolates.⁴⁹⁸ The issue was whether the mark was distinctive.⁴⁹⁹ The court held that distinctiveness was only shown in certain countries and not in all EU member states.⁵⁰⁰ As a result registration was not granted in the EU.

Finally, a mark must fall outside of the absolute grounds for the refusal.⁵⁰¹ Article 4(1) (e) of the 2015 Trade Mark Directive states that:

Signs which consist exclusively of:

⁴⁸⁸ Article 2, Directive 2008/95/EC of the European Parliament and of the Council.

⁴⁸⁹ Eeckhout P & Tridimas T *Yearbook of European Law 2009, Volume 28* (2010) 469.

⁴⁹⁰ Article 4 of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 & Article 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁴⁹¹ See part 4.4 of this chapter.

⁴⁹² *CNH Global NV v OHIM*. Case T-378/07.

⁴⁹³ *CNH Global NV v OHIM* Case T-378/07 para 1.

⁴⁹⁴ *CNH Global NV v OHIM* Case T-378/07 para 45.

⁴⁹⁵ Article 1 of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark [2009] L78/1 The Community Trade Mark has been renamed to the European Union Trade Mark.

⁴⁹⁶ *CNH Global NV v OHIM* Case T-378/07 para. 50.

⁴⁹⁷ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331.

⁴⁹⁸ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331 para 2.

⁴⁹⁹ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331 para 7.

⁵⁰⁰ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331 para 124.

⁵⁰¹ Article 4 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

- (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..⁵⁰²

The words ‘resulting from the nature of the goods itself’ mean that the mark is the essence of the product.⁵⁰³ An example of this is the scent of deodorant. In *Hauck GmbH & Co KG v Stokke A/S and others*⁵⁰⁴ the respondent sold ‘Tripp Trapp’ children's chairs which were famous in the Scandinavian and Dutch area for many years.⁵⁰⁵ The chair comprised of sloping uprights and sliding plates, which can be adjusted so that the chair continues to fit a child as it grows older and this shape mark was registered.⁵⁰⁶ The appellant designed similar chairs and was subsequently sued for trade mark infringement by the respondent.⁵⁰⁷ The appellant counterclaimed for the removal of the mark from the trade mark register on the basis that the mark was functional.⁵⁰⁸ The court held that the mark was an essential part of the product and it resulted from the nature of the product. The mark had to be removed from the trade mark register.⁵⁰⁹

*Philips v Remington*⁵¹⁰ concerned the issue of a shape trade mark, which consisted of the head of a three-headed rotary electric shaver developed by Philips in the sixties, which comprises three circular heads with rotating blades in the shape of an equilateral triangle.⁵¹¹ Philips sued Remington for trade mark infringement for using a similar mark.⁵¹² Remington countersued for the removal of the mark from the register, arguing that it fell within the prohibited grounds of trade mark registration.⁵¹³ The court held that the rationale of the grounds for refusal was to prevent the granting of a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. A ‘characteristic’ can be

⁵⁰² Article 4 (1) (e) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁵⁰³ Mezulanik E ‘The Status of Scents as Trade Marks: An International Perspective’ available at <https://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 16 August 2017).

⁵⁰⁴ *Hauck GmbH & Co. KG v Stokke A/S and others* Case C-205/13.

⁵⁰⁵ *Hauck GmbH & Co. KG v Stokke A/S and others* Case C-205/13 para 5.

⁵⁰⁶ *Hauck GmbH & Co. KG v Stokke A/S and others* Case C-205/13 para 7.

⁵⁰⁷ *Hauck GmbH & Co. KG v Stokke A/S and others* Case C-205/13 para 9.

⁵⁰⁸ *Hauck GmbH & Co. KG v Stokke A/S and others* Case C-205/13 para 9.

⁵⁰⁹ *Hauck GmbH & Co. KG v Stokke A/S and others* Case C-205/13 para 40.

⁵¹⁰ *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99.

⁵¹¹ *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 para H2.

⁵¹² *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 para H2.

⁵¹³ *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 para H2.

defined as 'a feature or quality belonging typically to a thing serving to identify it.'⁵¹⁴ It is further held that the objective was 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. This is because the exclusive right granted to the trade mark owners form an obstacle that prevent competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.⁵¹⁵

4.3 THE REGISTRATION OF NON-TRADITIONAL MARKS IN THE USA

4.3.1 COLOUR MARKS

A colour mark is a single colour or a combination of colours solely used by trade mark proprietors to distinguish their goods and services from other competitors.⁵¹⁶ The requirements for the registration of colour marks in the USA are that: the mark must, first, have developed a secondary meaning and second, it must be not be functional.⁵¹⁷ Developing a secondary meaning means that consumers have come to identify a mark that is not inherently distinctive as a mark of a particular proprietor.⁵¹⁸ In addition to proving that the colour mark is distinctive and not functional, an application for a colour mark should be accompanied by a drawing of the colour, a colour claim naming the colour that is the feature of the mark and a statement showing where the colours appear and how it is proposed to be used in the mark.⁵¹⁹

Previously, colour marks could not be registered in the USA. In *Leschen & Sons Rope Co. v. Broderick Jacobson Products Co.*,⁵²⁰ the court held that colour could not function as a trade mark because it is incapable of fulfilling the source indicating function of a trade mark.⁵²¹ In this case, the applicant wished to register the colour red as a trade mark to distinguish his ropes from those of competitors.⁵²² Similarly, the court also rejected colour trade mark applications

⁵¹⁴ Oxford English Dictionary 'Definition of characteristic' available at <https://en.oxforddictionaries.com/definition/characteristic> (accessed on 20 May 2017).

⁵¹⁵ *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* Case C-299/99 para H12.

⁵¹⁶ Michaels A & Norris A *A Practical Approach to Trade Mark Law* (2010) 37.

⁵¹⁷ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995) para 166.

⁵¹⁸ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995) para 174.

⁵¹⁹ International Trade Mark Association 'Filing a Trade Mark Application in the United States' available at <http://www.inta.org/TrademarkBasics/FactSheets/Pages/FilinginUSFactSheet.aspx> (accessed on 04 April 2017).

⁵²⁰ *Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U. S. 166, 171 (1906).

⁵²¹ *Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U. S. 166, 171 (1906) para 14.

⁵²² *Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U. S. 166, 171 (1906) para 2.

in *Diamond Match Co. v. Saginaw Match Co.*,⁵²³ which concerned the proposed registration of a combination of red and blue heads for matches.⁵²⁴

In *Campbell Soup Co. v. Armour & Co.*,⁵²⁵ which concerned the proposed registration of a red and white label for food products the court refused to register the colour mark,⁵²⁶ as in both instances the court held that there are only so many colours and thus the registration of colour marks would restrict competition and lead to confusion.⁵²⁷ This is based on the colour depletion theory.

The position regarding the registration of colour was changed in *Qualitex Co. v. Jacobson Products Co Inc.*⁵²⁸ In this case the applicant wished to register the colour green in relation to cleaning pads. The court held that the plaintiff's mark had developed a secondary meaning and thus could be registered as a trade mark.⁵²⁹ Factors that are used to determine whether a secondary meaning has been acquired are *inter alia*, the use of the mark over a long period of time, successful sales during this time, advertising expenditure and media coverage.⁵³⁰

The decision in *Qualitex Co. v. Jacobson Products Co Inc*⁵³¹ has nonetheless been criticised by academics such as Bartow⁵³² and Port.⁵³³ They argue that colour on its own should never be allowed to be registered as a trade mark as colour is inherently functional and would harm competition.⁵³⁴

In *Re- Owens Fiberglas Corporation*⁵³⁵ the applicant sought to register the colour pink as a trade mark in relation to insulation materials.⁵³⁶ The court held that the colour pink had acquired a secondary meaning, after taking into account that the colour had been used for 29 years by the applicant. A large amount of money had been spent on advertising costs and the evidence

⁵²³ *Diamond Match Co. v. Saginaw Match Co.* 142 F. 727, 730 (6th Cir. 1906).

⁵²⁴ *Diamond Match Co. v. Saginaw Match Co.* 142 F. 727, 730 (6th Cir. 1906) para 8.

⁵²⁵ *Campbell Soup Co. v. Armour Co.*, 175 F.2d 795,798 (3d Cir. 1949).

⁵²⁶ *Campbell Soup Co. v. Armour Co.*, 175 F.2d 795,798 (3d Cir. 1949) pg 1.

⁵²⁷ *Campbell Soup Co. v. Armour Co.*, 175 F.2d 795,798 (3d Cir. 1949) pg 798.

⁵²⁸ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995).

⁵²⁹ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995) para 174.

⁵³⁰ Asbell M 'Acquired distinctiveness of trade marks in the United States' available at <http://adas.com/education-center/acquired-distinctiveness-trademarks-united-states/> (accessed on 6 February 2017).

⁵³¹ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995).

⁵³² A. Bartow, "The True Colors of Trade Mark Law: Greenlighting a Red Tide of Anti Competition Blues", 97 KY. L.J. (*Kentucky Law Journal*) 263 (2009), 266.

⁵³³ Port K 'On Nontraditional Trade Marks' *Northern Kentucky Law Review* (2011) 19.

⁵³⁴ Port K 'On Nontraditional Trade Marks' *Northern Kentucky Law Review* (2011) 19.

⁵³⁵ *In Re Owens-corning Fiberglas Corporation*, 774 F.2d 1116 (Fed. Cir. 1985).

⁵³⁶ *In Re Owens-corning Fiberglas Corporation*, 774 F.2d 1116 (Fed. Cir. 1985) para 1.

that many people recognised pink as the source of the applicant's goods and services.⁵³⁷ The consumers therefore associated the colour with the applicant's goods, which means it had acquired a secondary meaning.

The next issue in determining whether a colour mark is registrable or not is whether the mark is functional or not.⁵³⁸ The functionality doctrine is divided into two parts namely utilitarian functionality and aesthetic functionality.⁵³⁹ The utilitarian or functionality test is based on whether the mark is essential to the use of the product. If the mark is essential to the use of the product, the mark cannot be registered.⁵⁴⁰ An example of this would be an attempt to register a colour blue for paint. Colour is at the very essence of paint and is therefore would not be able to function as a trade mark as the colour mark would be functional.⁵⁴¹ Another factor that can be taken into account is whether the proposed mark affects the cost and quality of the product.⁵⁴²

The aesthetic functionality test is based on whether the proposed registration of a mark would "put competitors at a significant non-reputation related disadvantage."⁵⁴³ An example of this is a red Valentine's Day container.⁵⁴⁴ The colour red could, arguably, be said to be aesthetically functional in relation to Valentine's Day gifts because that is the theme colour for Valentine's Day. Granting a monopoly to one enterprise in such circumstances would put other competitors at a significant disadvantage.⁵⁴⁵

A case illustrating aesthetic functionality is *Christian Louboutin v. Yves Saint Laurent*.⁵⁴⁶ Christian Louboutin is a well-known brand which produces shoes which contain a 'bright-red lacquered outsole.'⁵⁴⁷ In 2008 trade mark registration was granted to Christian Louboutin for

⁵³⁷ *In Re Owens-corning Fibreglas Corporation*, 774 F.2d 1116 (Fed. Cir. 1985) para 52-68.

⁵³⁸ Epstein M *Epstein on Intellectual Property* (2006) 7.

⁵³⁹ Landes W & Posner R *The Economic Structure of Intellectual Property Law* (2009) 198.

⁵⁴⁰ *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001) para 1263.

⁵⁴¹ Gallagher M 'Who owns Blue? An examination of the Functionality Doctrine in University sport colour.' (2014) *The Law Journal of the International Trade Mark Association* 769.

⁵⁴² Dinwoodie G & Janis M *Trade Mark Law and Theory: A Handbook of Contemporary Research* (2008) 402.

⁵⁴³ Barrett M *Intellectual Property* (2008) 47.

⁵⁴⁴ Fish & Richardson 'Trade Mark Functionality: Job's Daughters Has Risen Again!' available at <http://www.fr.com/files/Uploads/attachments/trademark/20110505-TrademarkFunctionalityOutline.pdf> (accessed on 6 February 2017).

⁵⁴⁵ Fish & Richardson 'Trade Mark Functionality: Job's Daughters Has Risen Again!' available at <http://www.fr.com/files/Uploads/attachments/trademark/20110505-TrademarkFunctionalityOutline.pdf> (accessed on 6 February 2017).

⁵⁴⁶ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013)

⁵⁴⁷ Lago M 'Shoe Wars: Christian Louboutin vs. Yves Saint Laurent' available at <http://sashahalima.com/blog/2011/04/shoe-wars-christian-louboutin-vs-yves-saint-laurent/> (accessed on 6 February 2016).

the bright-red lacquered outsole' in relation to shoes.⁵⁴⁸ In 2011, Yves Saint Laurent (YSL) released a collection of monochrome footwear in various colours, including red and Christian Louboutin sought a preliminary injunction preventing YSL from marketing its own the red monochrome shoes or any other shoe incorporating Louboutin's red sole Red Sole trade mark.⁵⁴⁹ In response, YSL filed a counterclaim, seeking to have the court cancel Louboutin's Red Sole trade mark, on that grounds that it lacked distinctiveness and/or was merely ornamental or functional, thereby making it ineligible for trade mark protection.⁵⁵⁰

The court held that it would place competitors at an unfair disadvantage to grant Christian Louboutin trade mark registration for the colour red in relation to shoes.⁵⁵¹ Instead the court ordered the U.S. Patent and Trade Mark Office to limit Louboutin's trade mark protection of the colour red to the sole of the shoe, with the rest of the shoe being a contrasting colour.⁵⁵² This judgment displayed a good balancing act between trade mark proprietors and the public as this allowed the trade mark proprietor to continue as the registered owner of the colour mark but with a limitation that ensures that the trade mark does not unduly restrict competition.

The registration of colour marks in the USA has increased over the years. Other examples of colour marks registered include the United Parcel Service's registered colour brown⁵⁵³ applied to vehicles; the registered colour canary yellow⁵⁵⁴ which is registered for 3M's adhesive notes and lastly, robin egg blue for Tiffany's catalogue services.⁵⁵⁵

4.3.2 SCENT MARKS

A scent mark is any scent that does not stem from the nature of the product itself.⁵⁵⁶ The position of scent marks in the USA, is that a scent mark may be granted registration if it is distinctive and not functional.⁵⁵⁷ The test for registration of a scent mark is set out in *In Re Celia Clarke, DBA Clarke's Osewez*⁵⁵⁸ a case in which the first scent mark was registered in

⁵⁴⁸ Lago M 'Shoe Wars: Christian Louboutin vs. Yves Saint Laurent' available at <http://sashahalima.com/blog/2011/04/shoe-wars-christian-louboutin-vs-yves-saint-laurent/> (accessed on 6 February 2016).

⁵⁴⁹ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) pg 447.

⁵⁵⁰ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) pg 447.

⁵⁵¹ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) pg 452.

⁵⁵² *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) pg 454.

⁵⁵³ United States Trade Mark Reg. No 2, 131, 693.

⁵⁵⁴ United States Trade Mark Reg. No 2, 390, 667.

⁵⁵⁵ United States Trade Mark Reg. No 2, 416, 794.

⁵⁵⁶ Mezulanik E 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 30 March 2017).

⁵⁵⁷ Schwabach A *Intellectual Property: A Reference Handbook* (2007) 27.

⁵⁵⁸ *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990).

the USA.⁵⁵⁹ In this case the applicant wished to register a scent that was a ‘high impact, fresh, floral fragrance that was reminiscent of Plumeria blossoms’ in relation to sewing thread and embroidery yarn.⁵⁶⁰ The court held that the scent mark in question should be registered because he was the only person using this scent on sewing thread and embroidery yarn.⁵⁶¹ Fragrance was not a natural characteristic of sewing thread and the applicant had emphasized the scent in advertising to the extent that consumers associated the scent mark with his products.⁵⁶²

The court developed a four stage enquiry which must be followed when registering a scent trade mark: firstly, whether the scent mark distinguishes the applicant’s goods from the goods of his competitors. Secondly, whether the scent is a natural characteristic of the product. Thirdly whether the mark has been used for the purposes of advertising the product. Finally, whether the applicant has established that consumers associate the scent mark with the goods of the applicant.⁵⁶³

Additional requirements include a written description of the scent and a sample of the scent that matches the description to represent the mark.⁵⁶⁴ Examples of successful scent mark registration include Grendente’s bubble-gum scent⁵⁶⁵ for sandals. The application for the scent mark was filed in 2014 and was registered in 2015.⁵⁶⁶ The applicant sent a sandal containing the scent as a sample to secure registration.⁵⁶⁷

Hisamitsu Pharmaceutical Co’s mint scent⁵⁶⁸ for pain relief patches is another such example. In 2008 they filed the application and it was registered in 2009.⁵⁶⁹ It is described as a smell produced by a ‘mixture of highly concentrated methyl salicylate and menthol’.⁵⁷⁰

⁵⁵⁹ Burgett J ‘Hmm...What’s That Smell? Scent Trade Marks—A United States Perspective’ available at <http://www.inta.org/INTABulletin/Pages/Hmm%E2%80%A6What%E2%80%99sThatSmellScentTrademarks%E2%80%94AUnitedStatesPerspective.aspx> (accessed on 27 February 2017).

⁵⁶⁰ *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990) para 2.

⁵⁶¹ *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990) para 1239.

⁵⁶² *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990) para 1239.

⁵⁶³ *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990) para 1239.

⁵⁶⁴ Mezulanik E ‘The Status of Scents as Trade Marks: An International Perspective’ available at <http://inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 26 February 2017).

⁵⁶⁵ United States Trade Mark Reg. No 4754435.

⁵⁶⁶ United States Trade Mark Reg. No 4754435.

⁵⁶⁷ United States Trade Mark Reg. No 4754435.

⁵⁶⁸ United States Trade Mark Reg. No 3589348.

⁵⁶⁹ United States Trade Mark Reg. No 3589348.

⁵⁷⁰ United States Trade Mark Reg. No 3589348.

The application for Lactona's strawberry scent for toothbrushes⁵⁷¹ was filed in 2004 and registered in 2007.⁵⁷² It is described as 'toothbrushes impregnated with the scent of strawberries.'⁵⁷³ Undoubtedly, the USA has seen the registration of numerous scent marks.

4.3.3 SOUND MARKS

A sound mark is regarded as a trade mark which uses audio rather than visual means to distinguish the goods and services of a proprietor from those of another.⁵⁷⁴ Sound marks should 'register in the subliminal mind of the listener.'⁵⁷⁵

The USA has recognised sound marks for quite some time; the NBC chimes was the first registered sound trade mark in the USA in 1950.⁵⁷⁶ This sound mark was used by the National Broadcasting Company in relation to radio and television networks.⁵⁷⁷

In order to be successful in registering a sound mark, the applicant must firstly: show that the mark is not functional⁵⁷⁸ and that it is distinctive.⁵⁷⁹ The test for functionality is the same as discussed above for colour and scent marks, and was dealt with in relation to sound marks in *re Vertex Grp. LLC*.⁵⁸⁰ In this case the applicant sought to register 'a descending frequency sound pulse' in relation to alarm clocks.⁵⁸¹ The court held that sounds are essential to the functioning of alarm clocks and thus that this sound mark could not be registered.⁵⁸² If the sound mark is not inherently distinctive, the applicant will have to show acquired distinctiveness.⁵⁸³

Sounds that are emitted in the ordinary course of business are not inherently distinctive.⁵⁸⁴ In the ordinary course of business can be defined as the usual practices of a particular business.⁵⁸⁵ In *Re Powermat*,⁵⁸⁶ the issue before the court was whether an 'electric chirp' could be registered

⁵⁷¹ United States Trade Mark Reg. No 333 2910.

⁵⁷² United States Trade Mark Reg. No 333 2910.

⁵⁷³ United States Trade Mark Reg. No 333 2910.

⁵⁷⁴ Sreenivasulu N.S *Law Relating to Intellectual Property* (2013) 123.

⁵⁷⁵ Sullivan R *Non-Traditional Trade Marks through the lens of the USPTO* (2016) 217.

⁵⁷⁶ United States Trade Mark Reg. No. 916522.

⁵⁷⁷ United States Trade Mark Reg. No. 916522.

⁵⁷⁸ *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1702-03 (TTAB 2009) pg 26.

⁵⁷⁹ *In re General Electric Broadcasting Co.*, 199 USPQ para 563.

⁵⁸⁰ *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1702-03 (TTAB 2009) pg 26.

⁵⁸¹ *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1702-03 (TTAB 2009) pg 1.

⁵⁸² *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1702-03 (TTAB 2009) pg 32.

⁵⁸³ *In re General Electric Broadcasting Co.*, 199 USPQ para 563.

⁵⁸⁴ *In re Powermat Inc.*, 105 USPQ2d 1789 (TTAB 2013) pg 8.

⁵⁸⁵ Cones J *The Feature Film Distribution Deal: A Critical Analysis of the Single Most Important Film Industry Agreement* (1997) 90.

⁵⁸⁶ *In re Powermat Inc.*, 105 USPQ2d 1789 (TTAB 2013)

as a sound trade mark in relation to battery chargers.⁵⁸⁷ The court held that sounds are usually emitted from battery chargers and therefore the proposed sound mark is one that is emitted in the ordinary course of business of a battery charger. The sound mark could not be deemed inherently distinctive.⁵⁸⁸

Second, the applicant must attach a digital file which contains the audio representation of the proposed mark in the case of online applications or a compact disc, DVD, video tape, or audio tape containing the proposed mark in the case of paper applications.⁵⁸⁹ Third; the applicant should provide a detailed description of the proposed mark.⁵⁹⁰ An example of this is the description of NBC's registered sound trade mark.⁵⁹¹ The description provided is "a sequence of chime-like musical notes which are in the key of C and sound the notes G, E, C, the 'G' being the one just below middle C, the 'E' the one just above middle C, and the 'C' being middle C, thereby to identify applicant's broadcasting service."⁵⁹²

Examples of successful trade mark applications in the USA include MGM lion's roar,⁵⁹³ and Fox fanfare,⁵⁹⁴ which are both registered in respect of motion picture films and entertainment services⁵⁹⁵ MGM's lion roar qualifies as a commonplace sound but was registered on the basis that it had acquired distinctiveness through use.⁵⁹⁶ The lion roar is readily associated by consumers in relation to motion picture films and entertainment services.⁵⁹⁷ In contrast to the MGM lion roar, the Fox Fanfare sound mark is inherently distinctive as it was not a

⁵⁸⁷ *In re Powermat Inc.*, 105 USPQ2d 1789 (TTAB 2013) pg 1.

⁵⁸⁸ *In re Powermat Inc.*, 105 USPQ2d 1789 (TTAB 2013) pg 9.

⁵⁸⁹ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017).

⁵⁹⁰ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017).

⁵⁹¹ United States Trade Mark Reg. No. 916522.

⁵⁹² United States Trade Mark Reg. No. 916522.

⁵⁹³ United States Trade Mark Reg. No. 1,395,550.

⁵⁹⁴ United States Trade Mark Reg. No. 4,623,610.

⁵⁹⁵ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017).

⁵⁹⁶ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017).

⁵⁹⁷ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017).

commonplace sound.⁵⁹⁸ Further examples include the Intel inside⁵⁹⁹ and Mac start up sounds⁶⁰⁰ which are both registered for computers and operating system software, and the James Bond theme which is registered for CDs, DVDs and entertainment services.⁶⁰¹

The USA's approach to the registration of sound marks has been praised by academics such as Carapeto, who argues that such an approach takes into account both the interests of the trade mark proprietor and the public at large.⁶⁰² He cites the NBC chimes trade mark registration as an example of this as it is not functional. Competitors have the choice of various other sounds to choose from, making this mark suitable for trade mark registration.⁶⁰³ On the other hand, Roth criticises USA's approach and argues that the USA's reliance on a written description for scent marks leads to difficulties in proving trade mark infringement as this makes it difficult to ascertain the scope of the protection granted to the trade mark proprietor.⁶⁰⁴

This part discussed the registration of non-traditional trade marks in the USA. It is important to note that as the main requirements for the registration of a trade mark in the USA is distinctiveness and non-functionality. There is no graphical representation requirement. Proprietors in the USA are able to register non-visual marks easier than jurisdictions with strict graphical representation requirements. The position in the EU will be discussed next.

4.4 THE REGISTRATION OF NON-TRADITIONAL MARKS IN THE EUROPEAN UNION

The EU trade mark, is a convenient system allowing trade mark registration in all member states by means of one application.⁶⁰⁵ This is as opposed to filing a separate application in each member state.⁶⁰⁶ This is important for all trade mark registrations including non-traditional trade marks because of the system's unitary character.⁶⁰⁷ If any of the EU members object to a

⁵⁹⁸ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017).

⁵⁹⁹ United States Trade Mark Reg. No. 2,315,261.

⁶⁰⁰ United States Trade Mark Reg. No. 4,257,783.

⁶⁰¹ United States Trade Mark Reg. No. 4,065,012.

⁶⁰² Carapeto R 'A reflection about the introduction of non-traditional trade marks' *Wasedo Bulletin of Comparative Law* (2016) 34.

⁶⁰³ Carapeto R 'A reflection about the introduction of non-traditional trade marks' *Wasedo Bulletin of Comparative Law* (2016) 34.

⁶⁰⁴ Roth M 'Something old, something new, something borrowed, something blue: A new tradition in non-traditional trade mark registrations' *CARDOZO LAW REVIEW* (2006) 474.

⁶⁰⁵ Mantrov V *EU Law on Indications of Geographical Origin: Theory and Practice* (2014) 355.

⁶⁰⁶ Mantrov V *EU Law on Indications of Geographical Origin: Theory and Practice* (2014) 355.

⁶⁰⁷ Onishi H *Well-Known Trade Marks: A Comparative Study of Japan and the EU* (2015) 83.

particular community trade mark application, the entire application could be unsuccessful.⁶⁰⁸ When discussing the position of the EU in this thesis, the Trade Mark Directive and Regulation are discussed and not the laws in EU member states.

4.4.1 COLOUR MARKS

As previously mentioned, colour marks are rarely inherently distinctive.⁶⁰⁹ Acquired distinctiveness thus needs to be shown.⁶¹⁰ The requirement of distinctiveness has proven to be the biggest stumbling block for the registration of colour marks in the EU.⁶¹¹ This requirement is very important because the essence of trade mark protection is distinguishing one's goods and services from those of another.⁶¹²

This means that in determining whether distinctiveness has been acquired, it needs to be shown that the relevant public associate the colour with the particular brand. An example on how acquired distinctiveness can be proved is the *Whiskas* case⁶¹³ in which the applicant wished to register the colour purple as a trade mark in relation to cat food.⁶¹⁴ In order to prove acquired distinctiveness, the applicant provided a survey as evidence proving that the relevant public associated the colour with the product of the applicant.⁶¹⁵ The survey showed that most of the people who were interviewed associated the colour purple with Whiskas cat food.⁶¹⁶ The colour purple had thus acquired a secondary meaning.

The test for clear and precise representation in the EU is discussed in *Libertal Groep BV v Benelux-Merkenbureau*.⁶¹⁷ The test used is derived from *Ralf Sieckmann v Deutsches Patent- und Markenamt*⁶¹⁸, and is known as the Sieckmann test. This is the same test which was adopted in South Africa with respect to the registration of non-traditional marks such as scent marks.⁶¹⁹ According to the test, the mark must be 'clear, precise, self-contained, easily

⁶⁰⁸ World Trade Organization *Dispute Settlement Reports 2002: Volume 2* (2004) 605.

⁶⁰⁹ Decision of the Third Board of Appeal of 12 February 1998 in Case R 7/97-3 (*Orange*), para. 16.

⁶¹⁰ Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions und Vertriebs GmbH (WSC) v. Boots- und Segelzubehör Walter Huber and Franz Attenberger*, [1999] ECR I-2779 para 52.

⁶¹¹ D. I. Bainbridge, 'Smell, sound, colour and shape trade marks: an unhappy flirtation?' J.B.L. (*Journal of Business Law*) 2004 232.

⁶¹² Joined cases C-53/01 to 55/01 *Linde AG (C-53/01), Winward Industries Inc. (C-54/01) and Rado Uhren AG (C-55/01)*, [2003] E.T.M.R. 78 para 40.

⁶¹³ Decision of the Second Board of Appeal of 4 May 2007 in Case R 1620/2006-2 (*Purple*).

⁶¹⁴ Decision of the Second Board of Appeal of 4 May 2007 in Case R 1620/2006-2 (*Purple*) para 4.

⁶¹⁵ Decision of the Second Board of Appeal of 4 May 2007 in Case R 1620/2006-2 (*Purple*) para 24.

⁶¹⁶ Decision of the Second Board of Appeal of 4 May 2007 in Case R 1620/2006-2 (*Purple*) para 24.

⁶¹⁷ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793 para 29.

⁶¹⁸ *Ralf Sieckmann v Deutsches Patent- und Markenamt ('Methylcinnamat')*, [2002] Case C-273/00 ECR I-11737.

⁶¹⁹ See part 3.4.3 see also CIPRO office 'Guidelines with regard to the lodging of non-traditional marks' 2009 Patent Journal 460.

accessible, intelligible, durable and objective.⁶²⁰ For a mark to be easily accessible and intelligible it should not be complicated to understand.⁶²¹ Advocate General Léger in his opinion on *Libertel Groep BV v Benelux-Merkenbureau* stating that ‘it should not be necessary to go to inordinate lengths to ascertain what sign the applicant wishes to use.’⁶²² These requirements lead to a strict approach. The rationale for the Sieckmann test was that it encourages legal certainty.⁶²³

In *Libertel Groep BV v Benelux-Merkenbureau*, the applicant wished to register the colour orange as a trade mark.⁶²⁴ In the application form, the applicant described the colour by means of an orange rectangle.⁶²⁵ The court held that in order to meet the requirements of the Sieckmann test, an application for a colour mark should include a description in words, a sample of the colour and the ‘designation of a colour using an internationally recognised identification code.’⁶²⁶ The court held that only providing a description of the colour is not sufficient as it not precise or durable as it may fade with time.⁶²⁷ The importance of accompanying a description in words, a sample of the colour and the use of an internationally recognised colour code is to promote legal certainty.⁶²⁸ It is important that all of these are present and not merely one, as words alone will not provide an adequate description and colour is perceived differently by individuals so providing a mere sample of the mark also would not suffice.⁶²⁹ A colour code system is a system displaying information about various colours.⁶³⁰ Examples of colour code systems are Pantone, RAL and Toyo.⁶³¹

It is important for the colour mark to be in a specific combination in order for it to be represented adequately.⁶³² This issue was discussed in *Heidelberger Bauchemie GmbH v*

⁶²⁰ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 52-55.

⁶²¹ Opinion of Advocate General Léger in *Libertel*, para. 64.

⁶²² Opinion of Advocate General Léger in *Libertel*, para. 64.

⁶²³ A. Bartow, “The True Colors of Trade Mark Law: Greenlighting a Red Tide of Anti Competition Blues”, 97 KY. L.J. (Kentucky Law Journal) 263 (2009), 266.

⁶²⁴ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793 para 15.

⁶²⁵ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793 para 15.

⁶²⁶ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793 para 35-37.

⁶²⁷ *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793 para 31 & 32.

⁶²⁸ A. Bartow, “The True Colors of Trade Mark Law: Greenlighting a Red Tide of Anti Competition Blues”, 97 KY. L.J. (Kentucky Law Journal) 263 (2009), 266.

⁶²⁹ A. Bartow, “The True Colors of Trade Mark Law: Greenlighting a Red Tide of Anti Competition Blues”, 97 KY. L.J. (Kentucky Law Journal) 263 (2009), 266.

⁶³⁰ Galitz W *The Essential Guide to User Interface Design: An Introduction to GUI Design Principles and Techniques* (2007) 696.

⁶³¹ UK IPO Official web page, ‘Filling the Application Form’, [Section2] available at <http://www.ipo.gov.uk/types/tm/t-applying/t-apply/t-fillform.htm>. (accessed on 20 February 2017).

⁶³² Guidance from ECJ on registration of colour trade marks”, July 2004, [Practical Implications] available at <http://www.out-law.com/page-369> (accessed on 20 February 2017).

Deutsches Patent- und Markenamt.⁶³³ The applicant wished to register the colours blue and yellow in relation to building products ‘in every conceivable form.’⁶³⁴ The court held that this is not possible as it would lead to the registration of numerous different combinations.⁶³⁵ This would lead to uncertainty and would defeat the purpose of trade mark protection as consumers would not associate all these combinations with the particular brand.⁶³⁶

Other registered colour marks in the EU include the colour lilac⁶³⁷ for Milka confectionary packaging, T-Mobile’s magenta colour⁶³⁸ in relation to mobile phone services and the colour orange⁶³⁹ for the label of Veuve Cliquot champagne.

4.4.2 SCENT MARKS

The requirements for a mark to be represented graphically were laid down in *Ralf Sieckmann v Deutsches Patent- und Markenamt*⁶⁴⁰ which has already been discussed in terms of *Libertel Groep BV v Benelux-Merkenbureau* in terms of colours.⁶⁴¹

As previously stated, the applicant wished in this case to register a ‘menthyl cinnamate’ scent which was described as being ‘balsamically fruity with a slight hint of cinnamon’.⁶⁴² He accompanied this description with a sample of this odour and the chemical formula of the scent.⁶⁴³ The court held that the mark could not be registered because a written description of a scent is not ‘clear, precise and objective’.⁶⁴⁴ A sample of the odour is not durable as it can fade with time⁶⁴⁵ and that the chemical formula depicting a scent does not represent its odour.⁶⁴⁶ As a result of this decision, there does not seem to be a way to graphically represent a scent in

⁶³³ *Heidelberger Bauchemie GmbH v Deutsches Patent- und Markenamt*, [2004] Case C-49/02 ECR I-6129.

Heidelberger Bauchemie GmbH v Deutsches Patent- und Markenamt, [2004] Case C-49/02 ECR I-6129 para 2.

⁶³⁵ *Heidelberger Bauchemie GmbH v Deutsches Patent- und Markenamt*, [2004] Case C-49/02 ECR I-6129 para 35.

⁶³⁶ Decision of the First Board of Appeal of 1 July 2005 in Case R 799/2004-1 (*IKEA, Blue & Yellow*), para. 21.

⁶³⁷ Community Trade Mark 31336. (Now European Union Trade Mark).

⁶³⁸ Community Trade Mark 212753. (Now European Union Trade Mark).

⁶³⁹ Community Trade Mark 747949. (Now European Union Trade Mark).

⁶⁴⁰ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 52-55.

⁶⁴¹ See part 4.4.1 *Libertel Groep BV v Benelux-Merkenbureau*, [2003] Case C-104/01 I-03793 para 35-37.

⁶⁴² *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 11.

⁶⁴³ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 11.

Ralf Sieckmann v Deutsches Patent- und Markenamt (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 70.

⁶⁴⁵ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 71.

⁶⁴⁶ *Ralf Sieckmann v Deutsches Patent- und Markenamt* (‘Methylcinnamat’), [2002] Case C-273/00 ECR I-11737 para 72.

the EU, thus making it seem impossible to register a scent in the EU.⁶⁴⁷ It is important to note that not a single scent mark is registered in the EU at the moment.⁶⁴⁸

Some scent marks were however, registered in the past. In *Vennootschap Onder Firma Senta Aromatic Marketing's Application*,⁶⁴⁹ the court had to consider an application for the registration of a scent mark described as 'the smell of fresh cut grass.'⁶⁵⁰ The court held that this scent was distinctive and the description was adequate and allowed the registration of the scent mark.⁶⁵¹ This scent mark registration lapsed in 2006 and it was never renewed.⁶⁵²

Another obstacle that scent marks need to overcome is that the scent must not result from the nature of the product itself.⁶⁵³ An example of this is attempting to register the scent of perfume.⁶⁵⁴ To release a scent is the sole purpose of perfume and therefore results from the nature of the product itself as thus cannot be registered as a trade mark.⁶⁵⁵ This was shown when Chanel's application to register the scent of its perfume No.5 was rejected on the basis that the proposed scent mark was the essence of the product.⁶⁵⁶

4.4.3 SOUND MARKS

Initially, sound marks had to be capable of being represented graphically in the EU. As previously stated, this has made it difficult to register non-visual marks.⁶⁵⁷ The leading case for

⁶⁴⁷ WIPO Magazine 'Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks' available at http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html (accessed on 23 May 2016).

⁶⁴⁸ International Trade mark Association 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 21 February 2017).

⁶⁴⁹ *Vennootschap Onder Firma Senta Aromatic Marketing's Application*, Case R 156/1998-2 February 11, 1999.

⁶⁵⁰ *Vennootschap Onder Firma Senta Aromatic Marketing's Application*, Case R 156/1998-2 February 11, 1999 para 1.

⁶⁵¹ *Vennootschap Onder Firma Senta Aromatic Marketing's Application*, Case R 156/1998-2 February 11, 1999 para 15.

⁶⁵² International Trade mark Association 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 21 February 2017).

⁶⁵³ Paugam L, André P, Philippe H & Harfouche R *Brand Valuation* (2016) 3.

⁶⁵⁴ Paugam L, André P, Philippe H & Harfouche R *Brand Valuation* (2016) 3.

⁶⁵⁵ International Trade mark Association 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 21 February 2017).

⁶⁵⁶ International Trade mark Association 'The Status of Scents as Trade Marks: An International Perspective' available at <http://www.inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 21 February 2017).

⁶⁵⁷ WIPO Magazine 'Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks' available at http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html (accessed on 23 May 2016).

sound marks in the EU is *Shield Mark BV v Kist*⁶⁵⁸ in which Shield Mark registered the first nine notes of Beethoven's 'Für Elise' as well as a cockcrow noise as sound marks and Kist infringed these marks, Shield Mark wished to enforce its right against trade mark infringement.⁶⁵⁹ The way these marks were depicted differed.⁶⁶⁰ The Beethoven sound mark application was accompanied by a musical stave with the first notes of 'Für Elise' and a written description of the mark and the cockcrow sound mark was accompanied only by a written description of the mark.⁶⁶¹ The court held that sound mark applications should not be refused as long as they meet the requirements for graphical representation set out in *Ralf Sieckmann v Deutsches Patent- und Markenamt*.⁶⁶²

The court further held that a written description of a sound mark is not a clear or precise representation of the mark and that an onomatopoeic description lacks 'precision and clarity.'⁶⁶³ This limits the ways in which a sound mark can be represented for purposes of registration.⁶⁶⁴ The Court further stated that the Sieckmann test would be met if the representation of a sound mark consists of a 'stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals (sharps, flats and naturals)'⁶⁶⁵ This means that sound mark applications accompanied by music notes on a music score would satisfy the requirement of graphical representation in terms of the Sieckmann test.⁶⁶⁶

Whilst at first glance the above judgment may seem significant for sound marks as a whole, it only partially addressed the issue of the registration of sound marks in the EU.⁶⁶⁷ The only sound mark applications that can be accompanied by music notes on a music score are musical

⁶⁵⁸ *Shield Mark BV v Joost Kist h.o.d.n. Memex Case C-283/01.*

⁶⁵⁹ *Shield Mark BV v Joost Kist h.o.d.n. Memex Case C-283/01 para 16.*

⁶⁶⁰ *Shield Mark BV v Joost Kist h.o.d.n. Memex Case C-283/01 para 17.*

⁶⁶¹ *Shield Mark BV v Joost Kist h.o.d.n. Memex Case C-283/01 para 25.*

⁶⁶² *Shield Mark BV v Joost Kist h.o.d.n. Memex Case C-283/01 para 35*

⁶⁶³ *Shield Mark BV v Joost Kist h.o.d.n. Memex Case C-283/01 para 60.*

⁶⁶⁴ Trilett G *Registrability of smells, colours and sound: How to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within the European Union Law?* (published thesis at the University of Strasbourg, France) 16.

⁶⁶⁵ *Shield Mark BV v Joost Kist h.o.d.n. Memex Case C-283/01 para 2 of the operative part of the judgment.*

⁶⁶⁶ Trilett G *Registrability of smells, colours and sound: How to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within the European Union Law?* (published thesis at the University of Strasbourg, France) 16.

⁶⁶⁷ Trilett G *Registrability of smells, colours and sound: How to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within the European Union Law?* (published thesis at the University of Strasbourg, France) 16.

marks. This therefore excludes noise marks such as the ‘bark of a dog’.⁶⁶⁸ There have accordingly been developments of alternative ways to meet the requirements of graphical representation of such marks.⁶⁶⁹ These include representations using spectrum, spectrogram, sonogram and oscillogram.⁶⁷⁰ There are, however, fears that these methods are too technical and not ‘accessible and intelligible enough for the public at large.’⁶⁷¹ There have been no court rulings on these methods in the EU but it has been understood that these methods may be used provided they are clear enough.⁶⁷² This seemed to pave the way for the registration of non-musical marks in the EU, but a groundbreaking development has since taken place which will be discussed next.

4.5 CONCLUSION

This chapter discussed the registration of traditional and non-traditional trade marks in the EU and the USA. Initially the EU required marks to be represented graphically which made it difficult for sound and scent marks to be registered, in contrast to the USA. This requirement has since been removed but a challenge remains for the registration of scent marks as an appropriate mechanism to clearly and precisely represent a scent has not yet been found.

The registration of colour marks has been a topic of debate amongst academics in the USA. As the registration of these marks are only dependent on whether they are non-functional and have developed a secondary meaning it would seem that the USA lean towards the promotion of colour marks. Academics argue that this would seriously harm competition. With regard to scent and sound marks distinctiveness and non-functionality are the requirements for registration. How these requirements are satisfied is determined on a case by case basis which allows for flexibility in the regulation of these marks.

The next chapter provides a comparative analysis of the registration requirements of non-traditional trade marks between South Africa, the EU and the USA. Providing extensive

⁶⁶⁸ Trilett G *Registrability of smells, colours and sound: How to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within the European Union Law?* (published thesis at the University of Strasbourg, France) 16.

⁶⁶⁹ WIPO Magazine ‘Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks’ available at http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html (accessed on 23 May 2016).

⁶⁷⁰ WIPO Magazine ‘Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks’ available at http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html (accessed on 23 May 2016).

⁶⁷¹ WIPO’s Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications: ‘Nineteenth Session. 2008. Representation and Description of Non-Traditional Marks. Possible Areas of Convergence.’ available at http://www.wipo.int/meetings/en/details.jsp?meeting_id=15323 (accessed on 21 February 2017).

⁶⁷² Decision No Ex-05-3 of the President of the Office of 10 October 2005 concerning electronic filing of sound marks. Rule 3(6) of the Commission Regulation (EC) 2868/95 of December 13 1995 as amended.

protection of sound, scent and colour marks is bound to have an effect on the broader public at large. The next chapter will also discuss the approaches these jurisdictions use to strike a balance between these competing interests.

CHAPTER 5

COMPARATIVE ANALYSIS OF THE APPROACHES TO THE REGISTRATION OF SOUND, SCENT AND COLOUR MARKS

5.1 INTRODUCTION

The previous chapter examined the individual approaches to the registration of firstly traditional and secondly non-traditional trade marks in the United States of America (the USA) and the European Union (the EU). This chapter will provide a comparison between the approaches taken by these two jurisdictions and South Africa. It will also discuss whether the registration of sound, scent and colour marks lessen competition as well as certain approaches used by these jurisdiction to prevent competition from being stifled by the registration of these marks namely the USA's case-by-case approach, the EU's legislative approach and South Africa's constitutional approach.

5.2 APPROACHES TO THE REGISTRATION OF SOUND, SCENT AND COLOUR MARKS

5.2.1 THE UNITED STATES OF AMERICA

While the USA accepts scent mark registration, conditions are put in place that assists them in controlling an overflow of monopolies.⁶⁷³ The USA eliminated barriers to the registration of scent mark by not prescribing the strict graphical representation requirement.⁶⁷⁴ The USA have allowed written descriptions as a means to represent scent marks.⁶⁷⁵ On the other hand, the functionality doctrine has restricted the amount of scent marks that can be registered.⁶⁷⁶ The USA has thus found a way to ensure that they keep up with the pace in which scent marks are growing but prevent an influx of scent mark registration that would harm competition.

Commonplace sounds are the most likely sound marks to harm competition.⁶⁷⁷ Again, the USA accepts written descriptions of sound marks as a means of representation which is not difficult

⁶⁷³ See part 4.3.

⁶⁷⁴ Lanham Act § 45, 15 U.S.C. § 1127 see also part 4.2.1.

⁶⁷⁵ Mezulanik E 'The Status of Scents as Trade Marks: An International Perspective' available at <http://inta.org/INTABulletin/Pages/TheStatusofScentsasTrademarksAnInternationalPerspective.aspx> (accessed on 26 February 2017) see also 4.3.2.

⁶⁷⁶ *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990 para 1239).

⁶⁷⁷ *Burgunder L* (2010) 361 see also part 4.3.3.

to comply with.⁶⁷⁸ The functionality doctrine has become an important mechanism in balancing the competing interests of proprietors of non-traditional trade marks and competitors.⁶⁷⁹ As explained in chapter 4 the functionality doctrine prevents proprietors from registering marks which are essential to the use of a particular product or would harm competition.⁶⁸⁰ A few judgments which were discussed in chapter 4 are once again important for this discussion.

The USA has managed to strike a balance between the interests of colour trade mark proprietors and competitors using the functionality doctrine in *Christian Louboutin v. Yves Saint Laurent*.⁶⁸¹ As discussed in chapter 4 this case concerned the registration of the colour red in relation to shoes.⁶⁸² The court held that it would place competitors at an unfair disadvantage to grant Christian Louboutin trade mark registration of the colour red in relation to shoes.⁶⁸³ Instead the court ordered the U.S. Patent and Trade Mark Office to limit Louboutin's trade mark protection of the colour red to the sole of the shoe, with the rest of the shoe being a contrasting colour.⁶⁸⁴ This allowed the trade mark proprietor to continue as the registered owner of the colour mark but with a limitation that ensures that the trade mark does not unduly restrict competition.

In re Vertex Grp. LLC,⁶⁸⁵ the court held that sounds are essential to the functioning of alarm clocks and thus that this sound mark could not be registered.⁶⁸⁶ *In re Celia dba Clarke's Osewez*⁶⁸⁷ the court held that fragrance was not a natural characteristic of sewing thread and therefore was not functional.⁶⁸⁸ In a nutshell, the USA's approach to the registration of scent, sound and colour marks is flexible. The USA does not have strict approach since it does not have the graphic representation requirement. This is because the USA is striving to achieve a balance between trade mark protection and free competition.

⁶⁷⁸ Cadwell J 'What's That Sound? It Might Just Be a Trade Mark' available at <http://www.lexology.com/library/detail.aspx?g=521c8c6d-0dee-4d6f-bf56-37919bf367f7> (accessed on 11 February 2017) see also part 4.3.3.

⁶⁷⁹ LI K 'Co-ordinating Extensive Trade Mark Rights and Competition Policy' available at <https://ssrn.com/abstract=2231558> (accessed on 20 May 2017) see also part 4.3.

⁶⁸⁰ See part 4.3.

⁶⁸¹ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013).

⁶⁸² See part 4.3.1

⁶⁸³ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) pg 452.

⁶⁸⁴ *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, No. 11-3303 (2d Cir. 2013) pg 454.

⁶⁸⁵ *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1702-03 (TTAB 2009).

⁶⁸⁶ *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1702-03 (TTAB 2009) pg 32.

⁶⁸⁷ *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990).

⁶⁸⁸ *In re Celia, dba Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990) para 1239.

5.2.2 THE EUROPEAN UNION

As discussed in chapter 4, the EU passed a new reform on 24 December 2015.⁶⁸⁹ The EU's approach used to be conservative but this has since changed with the adoption of the 2015 Trade Mark Directive and Regulation 2015/2424. The requirement of graphical representation was deleted from the definition of what constitutes a trade mark. The rationale was to cater for the development of new ways of representation of marks which may be equally informative and reliable.⁶⁹⁰ The graphical representation requirement used to make it almost impossible to register non-visible marks such as scent and sound marks. A mark may now qualify for registration as long as it is 'clear and precise'.⁶⁹¹ The EU 2015 Trade Mark Directive and Regulation 2015/ 2424 allows for flexibility as well as legal certainty with respect to the registration on trade marks. Therefore, the EU has moved towards a flexible approach.

The 2015 Trade Mark Directive and Regulation amended the absolute grounds for refusal in terms of Article 7(1) (e) of the old Community Trade Mark Regulation, which stated that the following cannot be registered as trade marks:

signs which consist exclusively of:

- (i) the shape which results from the nature of the goods themselves;
- (ii) the shape of goods which is necessary to obtain a technical result;
- (iii) the shape which gives substantial value to the goods,⁶⁹²

Article 4(1) (e) of the new Directive, which is similar to Article 71(e) of the Regulation, states that:

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;

⁶⁸⁹ Grimshaw R 'Reforms to European Trade Mark Law' available at <http://mewburn.com/resource/reforms-to-european-union-trade-mark-law/> (accessed on 4 April 2017) see also 4.2.2.

⁶⁹⁰ See chapter 4 part 4.4 See also Y Mupangavanhu 'The protection of scent, taste and sound marks in South Africa' (2017) *SAIPLJ* 20.

⁶⁹¹ Recital 9 of the amending Regulation 2015/2424. See also Y Mupangavanhu 'The protection of scent, taste and sound marks in South Africa' (2017) *SAIPLJ* 20.

⁶⁹² Article 7(1) (e) of the Community Trade Mark Regulation (Council Regulation (EC) No. 207/2009

(iii) the shape, or another characteristic, which gives substantial value to the goods;⁶⁹³

Under the new reform the words 'or another characteristic' has been added to the sub points of Article 7(1) (e).⁶⁹⁴ A 'characteristic' can be defined as 'a feature or quality belonging typically to a thing serving to identify it.'⁶⁹⁵ A characteristic could thus include colours, sounds and scents. This is the functionality doctrine and its effect is to prevent the registration of the product itself such as perfume as a trade mark. Any non-traditional trade marks which is part of the characteristics which gives substantial value to the goods cannot thus be registered.⁶⁹⁶ This controls the possible monopolies that the removal of graphical representation requirement could present and is thus aimed at creating a balance between trade mark protection and free competition.⁶⁹⁷

5.3 COMPARATIVE ANALYSIS OF THE USA, THE EU AND SA

5.3.1 SIMILARITIES IN APPROACHES

All three jurisdictions emphasise the importance of the distinctiveness of trade marks, and that distinctiveness can either be inherent or acquired.⁶⁹⁸ By allowing marks that have acquired distinctiveness to be registered, a common understanding is shown that limiting registration to marks that are only inherently distinctive would unfairly exclude marks that are commonplace but have acquired a secondary meaning.⁶⁹⁹ The position in the EU, South Africa and the USA is that colour per se is not inherently distinctive.⁷⁰⁰ Therefore, in all three jurisdictions an applicant should show that a colour mark has acquired distinctiveness in order to be registered as a trade mark.

Another similarity between the three jurisdictions relates to the application of the functionality doctrine.⁷⁰¹ These jurisdictions prohibit the registration of a mark that is an essential

⁶⁹³ Article 4 (1) (e) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁶⁹⁴ Article 7(1) (e) of the European Union Trade Mark Regulation No. 2015/2424.

⁶⁹⁵ Oxford English Dictionary 'Definition of characteristic' available at <https://en.oxforddictionaries.com/definition/characteristic> (accessed on 20 May 2017).

⁶⁹⁶ Kulbaba T 'EU Trade Mark Law Reform Series: Implications for Non-traditional Marks' available at http://www.inta.org/INTABulletin/Pages/EU_TM_Reform_7103.aspx (accessed on 20 May 2017).

⁶⁹⁷ Kulbaba T 'EU Trade Mark Law Reform Series: Implications for Non-traditional Marks' available at http://www.inta.org/INTABulletin/Pages/EU_TM_Reform_7103.aspx (accessed on 20 May 2017).

⁶⁹⁸ See Chapter 3 & 4 parts 3.2.2 & 4.2.

⁶⁹⁹ See Chapter 3 & 4 parts 3.2.2 & 4.2.

⁷⁰⁰ Decision of the Third Board of Appeal of 12 February 1998 in Case R 7/97-3 (*Orange*), para. 16 & *Qualitex Co. v. Jacobson Products Co, Inc.*, 514 U.S. 159 (1995) para 166.

⁷⁰¹ See Chapters 3 & 4 parts 3.4, 4.2 & 4.3.

characteristic of that particular product.⁷⁰² This shows that trade mark laws an inherent mechanism that is aimed at limiting trade mark protection in order to balance the interests of trade mark proprietors and the public at large. The rationale for the functionality doctrine is thus to prevent monopolies.⁷⁰³

Monopoly can be defined as the ‘exclusive control of a commodity or service in a particular market.’⁷⁰⁴ This means that potential competitors are not able to enter the market for that particular commodity or service.⁷⁰⁵ In terms of trade mark registration, it refers to the exclusive control of a particular mark.⁷⁰⁶ A monopoly of a trade mark takes places upon registration providing the proprietor with exclusive rights to the mark.⁷⁰⁷ Exclusive rights are conferred only to the mark and not to the actual goods or service it identifies.⁷⁰⁸ This is different from other forms of intellectual property such as copyright and patents, where the work or article itself is protected.⁷⁰⁹

All the three jurisdictions make provision for the registration of sound, scent and colour marks. While the USA’s approach is liberal, the EU has also moved towards a less restrictive approach. The removal of the graphic representation is significant as it will create room for the registration of especially non-visible marks as long as the representation is clear and precise. It remains to be seen whether South Africa will reform its trade mark law in order to adopt a more liberal approach.

5.3.2 DIFFERENCES IN APPROACHES

The main difference between the USA, the EU and South Africa is on the requirement of graphical representation.⁷¹⁰ The USA does not require marks to be represented graphically for purposes of trade mark registration.⁷¹¹ This has made the registration of sound and scent marks easier in the USA.⁷¹² Marks which have acquired distinctiveness qualify for registration as trade marks.⁷¹³ Marks which have not yet acquired distinctiveness can be registered on the

⁷⁰² See Chapter 3 & 4 parts 3.4, 4.2 & 4.3

⁷⁰³ See Chapter 3 & 4 parts 3.4, 4.2 & 4.3.

⁷⁰⁴ Dwivedi D *Principles of Economics* 2ed (2009) 247.

⁷⁰⁵ Dwivedi D *Principles of Economics* 2ed (2009) 247.

⁷⁰⁶ Tomkowicz R *Intellectual Property Overlaps: Theory, Strategies, and Solutions* (2013) 91.

⁷⁰⁷ See Chapter 3 part 3.1 for a discussion on the exclusive rights obtained upon registration.

⁷⁰⁸ See Chapter 3 part 3.1.

⁷⁰⁹ Fishman S *Trade Mark: Legal Care for Your Business & Product Name* (2016) 48.

⁷¹⁰ See Chapter 3 part 3.1.

⁷¹¹ See Chapter 4 part 4.2.1.

⁷¹² See Chapter 4 part 4.3.2 & 4.3.3.

⁷¹³ See Chapter 4 part 4.2.1.

Supplemental register until they have acquired distinctiveness so that they may be placed on the Principal register.⁷¹⁴ This approach indicates that even marks which are not inherently distinctive are afforded some form of protection while being afforded the time to acquire distinctiveness. The USA only require marks to be distinctive and non-functional in order to meet the substantive requirements for trade mark registration. The USA therefore adopted a lenient approach to the registration of scent, sound and colour marks.⁷¹⁵ This is illustrated by the registration of marks in the Supplemental Register even before distinctiveness has been acquired.⁷¹⁶ This also strengthens the argument that the USA has a lenient approach to trade mark registration.⁷¹⁷

By contrast, South Africa requires marks to be, firstly, represented graphically. Secondly, the mark must be distinctive and should not fall within section 10 of the Trade Marks Act which prohibits the registration of certain marks such as marks that are against public policy. The existence of graphic representation requirement indicates that South Africa has a strict approach particularly with regards to non-visible marks. Be that as it may, South Africa seems to use a lower standard to determine whether distinctiveness has been acquired or not.⁷¹⁸ Its decision regarding the registration of the four finger shape mark of the Kit Kat chocolate, which is discussed later, is instructive. South Africa thus appears to have the characteristics of a strict and lenient approach which means that it follows an ‘in-between’ approach.

Initially, the EU also required marks to be represented graphically but this requirement was removed in October 2017.⁷¹⁹ This indicates a change in approach with the EU willing to accept alternative mechanisms of representing marks which are consistent with the developments in technology.⁷²⁰ Another difference between the three jurisdictions relates to the distinctiveness as a requirement for the registration of a trade mark.⁷²¹ In order to register a trade mark in the EU, distinctiveness needs to be shown throughout all member states.⁷²² Trade mark proprietors

⁷¹⁴ See Chapter 4 part 4.2.1.

⁷¹⁵ See Chapter 4 part 4.3.

⁷¹⁶ See Chapter 4 part 4.2.1.

⁷¹⁷ See Chapter 4 part 4.2.1.

⁷¹⁸ Hobson-Jones S & Karjiker S ‘Is South African trade mark law out of shape? A comparative analysis of shape marks, in light of the recent SCA and CJEU Kit Kat decisions’ *Stellenbosch Law Review* 597.

⁷¹⁹ See Chapter 4 part 4.2.

⁷²⁰ See Chapter 4 part 4.2.

⁷²¹ See Chapter 4 part 4.2.2.

⁷²² See Chapter 4 part 4.2.2.

in the USA and South Africa, however need only prove distinctiveness in that specific country.⁷²³

Although all three jurisdictions allow marks which have acquired distinctiveness to be registered as trade marks, the tests to determine whether a mark has in fact acquired distinctiveness varies. An illustration of this are the judgments of *Société des Produits Nestlé SA v Cadbury UK Ltd*⁷²⁴ in the EU and *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others*⁷²⁵ in South Africa. Although these cases dealt with shape marks the findings are equally important to the discussion.

In *Société des Produits Nestlé SA v Cadbury UK Ltd*,⁷²⁶ the issue before the court was whether or not the four finger Kit Kat shape, *inter alia* had acquired distinctiveness.⁷²⁷ The court held that although the shape was well-known and used for a long period of time this does not automatically mean that the mark had acquired distinctiveness.⁷²⁸ The court further held that consumers must view the mark as a badge of origin of the goods and services.⁷²⁹ The court therefore concluded that the mark did not acquire distinctiveness.⁷³⁰

In *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others*⁷³¹, an application by the respondent was brought before the court for the removal of the appellant's registered four finger shape mark.⁷³² Just as in *Société des Produits Nestlé SA v Cadbury UK Ltd*⁷³³ the issue before the court was whether or not the four finger Kit Kat shape, *inter alia* had acquired distinctiveness.⁷³⁴ The court held that the appellant had marketed and sold the Kit Kat chocolate bar for more than fifty years and had promoted and advertised it extensively and therefore the mark had acquired distinctiveness.⁷³⁵

⁷²³ See Chapter 3 & 4 parts 3.2.2 & 4.2.1.

⁷²⁴ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331.

⁷²⁵ *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others* (100/2014) [2014] ZASCA 187; [2015] 1 All SA 492 (SCA).

⁷²⁶ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331.

⁷²⁷ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331 para 13.

⁷²⁸ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331 para 116.

⁷²⁹ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331 para 116.

⁷³⁰ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331 para 65.

⁷³¹ *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others* (100/2014) [2014] ZASCA 187; [2015] 1 All SA 492 (SCA).

⁷³² *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others* (100/2014) [2014] ZASCA 187; [2015] 1 All SA 492 (SCA) para 4.

⁷³³ *Societe Des Produits Nestle Sa v Cadbury Uk Ltd* [2017] EWCA Civ 358, [2017] WLR(D) 331.

⁷³⁴ *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others* (100/2014) [2014] ZASCA 187; [2015] 1 All SA 492 (SCA) para 43.

⁷³⁵ *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others* (100/2014) [2014] ZASCA 187; [2015] 1 All SA 492 (SCA) para 61.

The respective courts in EU and South Africa thus arrived at different conclusions despite the cases having similar facts. These cases illustrate that it is easier to acquire distinctiveness in South Africa than in the EU. Hobson-Jones and Karjiker argue that South Africa's approach to the registration of the Kit Kat shape mark is controversial since South Africa and the EU have similar trade mark legislation.⁷³⁶ They further argue that South Africa has a lower standard when deciding whether or not distinctiveness had been acquired.⁷³⁷

5.3.3 CAUSES FOR SIMILARITIES AND DIFFERENCES

The similarities in the laws in the three jurisdictions may be attributed to international instruments that regulate trade marks. For example, TRIPS prescribe minimum requirements which all members have to meet. This results in similarities in the laws of all the member states. All three jurisdictions are signatories to this agreement.⁷³⁸ The definition of a trade mark contained in TRIPS is similar to the one in the three jurisdictions.⁷³⁹ The definition in the agreement emphasises the importance of trade marks being distinctive.⁷⁴⁰ All three jurisdictions have incorporated this requirement into their definition of a trade mark. The TRIPS definition also allows member states to make visual representation a requirement for the registration of a trade mark.⁷⁴¹ Graphic representation is thus not prescribed.⁷⁴² Visual representation suffices and this explains the reasons why USA and the EU moved away from the graphical representation requirement.⁷⁴³

⁷³⁶ Hobson-Jones S & Karjiker S 'Is South African trade mark law out of shape? A comparative analysis of shape marks, in light of the recent SCA and CJEU Kit Kat decisions' *Stellenbosch Law Review* 597.

⁷³⁷ Hobson-Jones S & Karjiker S 'Is South African trade mark law out of shape? A comparative analysis of shape marks, in light of the recent SCA and CJEU Kit Kat decisions' *Stellenbosch Law Review* 597.

⁷³⁸ World Trade Organisation 'Contracting Parties/Signatories > Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) available at http://www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=231&group_id=22 (accessed on 31 August 2016).

⁷³⁹ Article 15 of TRIPS states that 'Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trade marks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.'

⁷⁴⁰ Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

⁷⁴¹ Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

⁷⁴² Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

⁷⁴³ Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994.

The EU and South Africa are also trading partners. The similarities in the EU and South Africa's trade mark law is partly influenced by their trading relationship⁷⁴⁴ These two jurisdictions are parties to a Free Trade Agreement called the Trade, Development and Co-operation Agreement.⁷⁴⁵ As the purposes of Free Trade Agreements are to 'reduce import tariffs, remove non-tariff barriers and grant companies better effective access to each other's markets' reducing differences between parties⁷⁴⁶ intellectual property rights are essential to the proper functioning of the Agreement.⁷⁴⁷

A major reason for the differences in the three jurisdictions is because trade mark laws are territorial and protection is limited to the borders of the country in which the trade mark is registered. The other reason is because of the different pace at which technology is developing in the three jurisdictions.⁷⁴⁸ Technology in the USA has grown at a faster pace and this has facilitated the growth in the registration of non-traditional trade marks compared to South Africa.⁷⁴⁹

The three jurisdictions also have different approaches insofar as the protection of trade marks is concerned. This is because the USA has largely adopted a case-by-case approach while the EU and South Africa had a legislative –orientated approach. The case-by-case approach in the USA has ensured that they are able to develop mechanisms to balance e competing interests in line with new technological developments.⁷⁵⁰

5.4 CONCLUSION

This chapter set out to discuss certain approaches used by the USA, the EU and South Africa regarding the registration of certain non-traditional trade marks namely colour, scent and sound marks in a way which is not unduly harmful to competition. It provided a comparison between these jurisdictions.

⁷⁴⁴ Leon P 'EU trade agreement enters into effect with five southern African countries' available at <http://www.lexology.com/library/detail.aspx?g=66e5490e-ad0a-4772-a3b4-3f33c720a81b> (accessed on 15 May 2017).

⁷⁴⁵ European Commission 'Countries and regions' accessed at <http://ec.europa.eu/trade/policy/countries-and-regions/countries/south-africa/> (accessed on 16 August 2017).

⁷⁴⁶ European Commission 'Protection of Intellectual Property in Free Trade Agreements' available at http://trade.ec.europa.eu/doclib/docs/2012/november/tradoc_150081.pdf (accessed on 16 August 2017).

⁷⁴⁷ European Commission 'Protection of Intellectual Property in Free Trade Agreements' available at http://trade.ec.europa.eu/doclib/docs/2012/november/tradoc_150081.pdf (accessed on 16 August 2017).

⁷⁴⁸ Organisation for Economic Co-operation and Development 'Innovation and growth-rationale for innovative strategy' available at <http://www.oecd.org/sti/inno/39374789.pdf> (accessed on 15 May 2017).

⁷⁴⁹ Organisation for Economic Co-operation and Development 'Innovation and growth-rationale for innovative strategy' available at <http://www.oecd.org/sti/inno/39374789.pdf> (accessed on 15 May 2017).

⁷⁵⁰ See part 5.3.3.

Colour, scent and sound marks may be registered in the three jurisdictions. All three jurisdictions emphasise the importance of the distinctiveness of trade marks. This is because distinctiveness is the cornerstone of trade mark law. It is also included in the definition of a trade mark provided in TRIPS. And all three jurisdictions are signatories. This definition does not prescribe graphic representation as one of the requirements which a mark should satisfy to qualify for registration. Accordingly, for the EU and USA do not require marks to be represented graphically. South Africa currently requires a mark to satisfy the graphical representation requirement. All three jurisdictions prohibit the registration of functional marks which indicates the importance of competition in each jurisdiction.

The pace at which technology has grown and the case- by- case approach in deciding trade mark law in the USA has resulted in a more liberal approach to the registration of non-traditional trade marks in the USA. It is certainly more difficult to obtain registration of non-traditional trade marks in the EU and South Africa as opposed to the USA. The USA also makes provision for the protection of marks that are not yet distinctive in the Supplemental Register while South Africa and the EU do not provide protection to such marks. . South Africa's approach to the registration of scent, sound and colour marks is strict because of the extra requirements that are prescribed for the registration of trade marks. South Africa, however, seems to require have a lower standard of distinctiveness compared to the EU as evidenced by the four finger shape mark in *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others*.⁷⁵¹

The EU has shown a willingness to relax their strict approach with the removal of the graphical representation requirement. The new requirement is that the representation of these marks should be 'clear and precise'. This shows a move towards a less restrictive approach even though the new requirement may still make it difficult to register a scent mark.

Although South Africa may not be at an advanced stage regarding the registration of non-traditional trade marks, it adopted the CIPC Guidelines to the registration of non-traditional marks. It has also developed a comprehensive framework to balance the rights of trade mark proprietors and members of the public. The Constitution has proven to be an important vehicle that could be used to balance the rights of owners and the public. South Africa has a long way to go in providing a framework that enables extensive protection of non-traditional trade marks

⁷⁵¹ *Societe Des Produits Nestle SA and Another v International Foodstuffs Co and Others* (100/2014) [2014] ZASCA 187; [2015] 1 All SA 492 (SCA).

because of the graphic representation requirement. The next chapter will conclude this thesis and provide recommendations.

CHAPTER 6

CONCLUSION AND RECOMMENDATIONS

6.1 INTRODUCTION

The registration of non-traditional trade marks and the extent to which these marks can be protected has been a topic of debate worldwide. The aim of this thesis was to examine the registrability of sound, colour and scent marks and to what extent they can be registered in South Africa. In order to answer this overarching question certain sub-questions were addressed in the thesis. Firstly, should South Africa restrict or expand the definition of a trade mark? Secondly, what are the difficulties posed in affording non-traditional trade marks extensive protection? Thirdly, which categories of non-traditional marks are registrable in South Africa and what is the best way of regulating such marks? Lastly, how can a balance be struck between the interests of trade mark proprietors vis-a-vis the rights of the public? In this chapter, conclusions are drawn regarding the various issues identified within the thesis and further recommendations are made regarding the protection of scent, sound and colour marks in South Africa.

Chapter 2 showed that trade mark laws are territorial in nature and as a result, trade mark rules vary from jurisdiction to jurisdiction.⁷⁵² Attempts to harmonise trade mark laws came in the form of international conventions such as the Paris Convention, the Madrid System, TRIPS and the Singapore Treaty.⁷⁵³ Despite these conventions, major differences appear in various jurisdictions such as graphical representation requirement, which is prescribed in South Africa but not in the United States of America (USA) and no longer in the European Union (EU).⁷⁵⁴

Chapter 3 examined the trade mark regulatory framework in South Africa. The Trade Marks Act and Regulations set out the substantive and procedural requirements which a mark must satisfy to be able to qualify for registration. The Guidelines govern the registration of non-traditional marks and these were also analysed with a specific focus on smell, sound and colour marks. With regards to the definition of a trade mark, the chapter showed the main elements of the definition contained in the Trade Mark Act. There must be mark which must be used or proposed to be used to distinguish goods and services of one enterprise from those of its

⁷⁵² See chapter 2 part 2.1.

⁷⁵³ See chapter 2 parts 2.2-2.6.

⁷⁵⁴ See chapter 5 part 5.2.2

competitors in the course of trade.⁷⁵⁵ The mark must be capable of being represented graphically. The graphic representation requirement poses challenges to the registration non-traditional marks especially non-visible marks such as scent and sound.⁷⁵⁶ A mark should also either be inherently distinctive or it should acquire distinctiveness. Similarly, this requirement applies to both traditional and non-traditional marks. As a result, South African trade mark law has not been able to keep up with the pace at which technology is growing.

The registration of a single colour marks may pose a challenge as there are limited colours. Granting a monopoly would prevent others in the market from using the same colour.⁷⁵⁷ This could have a negative effect on competition.⁷⁵⁸ Colour is also common and it would appear unfair for one enterprise to have exclusive rights over it. A single colour that has acquired distinctiveness is nonetheless registrable in South Africa. Sound marks also pose problems as a musical notation might be played differently by a musician and an intellectual property law expert.⁷⁵⁹ This could lead to different impressions of what sound is actually registered. This could lead to a situation where the registered sound mark is different from the sound mark that is actually being used by the proprietor.⁷⁶⁰

The challenge that is posed by the registration of scent marks is that scent is subjective in nature.⁷⁶¹ What smells a certain way for one individual might smell differently to another.⁷⁶² A scent is a mixture of substances, some of which may be hard to identify.⁷⁶³ Scent is also not durable, therefore a sample would not last long enough for the registrar to ascertain the true nature of the scent. Just as in the case of sound marks, there may be difficulties in determining whether confusion is likely to arise between two scent marks.⁷⁶⁴ It is also important to note that if consumers dislike the scent, it could discourage them from buying the goods or services of the scent mark proprietor.⁷⁶⁵

⁷⁵⁵ Section 2(1) of the Trade Mark Act 194 of 1993.

⁷⁵⁶ See chapter 3 part 3.3

⁷⁵⁷ See chapter 3 part 3.3.1.

⁷⁵⁸ Denoncourt J *Q&A Intellectual Property Law* (2013) 145.

⁷⁵⁹ Majumdar A, Sadhu S & Majumdar S 'The Requirement of Graphical Representability for Non-Conventional Trade Marks' *Journal of Intellectual Property Rights* 316.

⁷⁶⁰ Majumdar A, Sadhu S & Majumdar S 'The Requirement of Graphical Representability for Non-Conventional Trade Marks' *Journal of Intellectual Property Rights* 316.

⁷⁶¹ See chapter 3 part 3.4.3.

⁷⁶² Goldstein E *Sensation and Perception* (2013) 373.

⁷⁶³ Zumdahl S & DeCoste D *Basic Chemistry* (2014) 49.

⁷⁶⁴ Alibekova A & Campbell D *The Comparative Law Yearbook of International Business 2007, Volume 29* (2007) 485.

⁷⁶⁵ Ratner D *Creating Customer Love: Make Your Customers Love You So Much They'll Never Go Anyplace Else!* (2009) 4.

The extensive protection of scent, sound and colour marks is sometimes in conflict with the idea of promoting competition in the marketplace.⁷⁶⁶ On the one hand, competition is good because it encourages the production of better quality goods and better prices for consumers. On the other hand, trade mark law seeks to reward proprietors for their trade marks as this promotes innovation. The effect of the exclusive rights is that third parties are excluded from using the mark and this can have a negative effect on competition.⁷⁶⁷

The registration of scent, sound and colour marks in the EU and USA was discussed in chapter 4. The Lanham Act which regulates trade marks in the USA and the EU Trade Mark Directive and Regulation were examined. The USA requires marks to be distinctive and non-functional.⁷⁶⁸ Graphical representation is not a prerequisite for registration. This has opened a door for the registration of various non-traditional trade marks such as sound and scent in the USA.⁷⁶⁹ It has also allowed the USA's trade mark law to keep up the pace with the growth in technology. The USA has followed a case-by-case approach in order to constantly develop trade mark law in order to keep it line with the way business is changing.⁷⁷⁰ The functionality doctrine is an inherent mechanism that prevents trade mark proprietors from obtaining a monopoly over a mark that would result in serious harm to competition.⁷⁷¹ This doctrine is also followed in South Africa and the EU.⁷⁷²

The EU initially required marks to be represented graphically in order to be registered as a trade mark.⁷⁷³ The test for graphical representation was laid out in *Ralf Sieckmann v Deutsches Patent- und Markenamt*. According to the test, the mark must be 'clear, precise, self-contained, easily accessible, intelligible, durable and objective.'⁷⁷⁴ For a mark to be easily accessible and intelligible it should not be complicated to understand.⁷⁷⁵ It should not be necessary to go to inordinate lengths to ascertain what sign the applicant wishes to use.

In the 2015 Directive and Council Regulation, the graphical representation requirement was removed and replaced with the 'clear and precise' requirement.⁷⁷⁶ Although there are no current

⁷⁶⁶ See chapter 5 part 5.3.

⁷⁶⁷ Anderman S *The Interface Between Intellectual Property Rights and Competition Policy* (2007) 394.

⁷⁶⁸ See chapter 4 part 4.3.

⁷⁶⁹ See chapter 4 parts 4.3.2- 4.3.3.

⁷⁷⁰ See chapter 4 part 4.3.

⁷⁷¹ See chapter 4 part 4.3.

⁷⁷² See chapter 5 part 5.2.1.

⁷⁷³ See chapter 4 part 4.2.

⁷⁷⁴ See chapter 4 part 4.3.1 & 4.3.2.

⁷⁷⁵ See chapter 4 part 4.3.

⁷⁷⁶ See chapter 4 part 4.2.

accepted methods for the ‘clear and precise’ representation of scent marks in the EU, scent domes can be used and this is likely going to make the process of online filing easier.⁷⁷⁷

The EU’s approach to the registration to scent, sound and colour marks is less restrictive since the graphical representation requirement no longer applies when submitting a trade mark application as of 1 October 2017. This is an important development. As is the case in the USA, this is expected to open the door for the registration of non-traditional trade marks such as noise marks, which were previously difficult to register because of the graphical representation requirement.⁷⁷⁸ The EU has thus used a legislative approach in an attempt to balance the rights of trade mark proprietors’ vis-à-vis free competition.⁷⁷⁹ The registration of marks which result from the nature of the goods themselves or is necessary to obtain a technical result is proscribed in all the jurisdictions.⁷⁸⁰

The comparative analysis in chapter 5 showed that in addition to limitations prescribed by the Trade Mark Act, South Africa has shown potential in a constitutional approach to balance the competing interests.⁷⁸¹ The Constitution is the highest law of the land and any conduct that is inconsistent with it is susceptible to being struck down. It contains the Bill of Rights, a comprehensive list of rights enjoyed by the public but also a limitation clause to ensure that rights are not absolute. This provides an opportunity on the part of the judiciary to balance between various competing interests in society as evidenced by the decision in *Laugh it Off Promotions CC v South African Breweries International*.⁷⁸² The court held that it had to balance the right to freedom of expression provided for in Section 16 of the Constitution and the right to trade mark protection.⁷⁸³ The court further held that the respondent had to show a real or probable likelihood of economic harm caused by the sale of the T-shirts.⁷⁸⁴ Freedom of

⁷⁷⁷ See chapter 4 part 4.2.

⁷⁷⁸ See chapter 4 part 4.2.

⁷⁷⁹ See chapter 4 part 4.2.

⁷⁸⁰ Article 4 (1) (e) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015.

⁷⁸¹ See chapter 3 part 3.4

⁷⁸² *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC).

⁷⁸³ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 2-3.

⁷⁸⁴ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 22.

expression trumped trade mark protection since the appellant had not suffered any economic harm.⁷⁸⁵

6.2 RECOMMENDATIONS

6.2.1 REPLACING THE GRAPHIC REPRESENTATION REQUIREMENT

It is submitted that the requirement to graphically represent marks in order for them to be registered as trade marks should be removed in South Africa. This requirement is no longer consistent with technological development since business people want to find innovative ways of distinguishing their products from those of the competitors. The graphical representation requirement should be replaced by new ways of representation which are appropriate as long as the representation is ‘clear and precise’ to enable the examiner and members of the public to ascertain the scope of the protection. This will allow trade mark law to develop in line with the growth in technology as new types of marks such as sound and scent are not easily graphically represented. The ‘clear and precise’ requirement would provide proprietors with a wider scope of mechanisms for the representation of marks while still prohibiting marks which are not properly represented. It will also create legal certainty in the protection of non-traditional marks.

In relation to sound marks the Guidelines prescribe that they should be represented as a musical notation on a staff.⁷⁸⁶ Only musical marks are able to be represented in this way and this excludes noise marks, which are also a form of sounds.⁷⁸⁷ It is submitted that this required form of representation be removed from the Guidelines. Sound marks must be represented by means of digital recordings of the marks. This would allow all types of sound marks to be represented.

The Sieckmann criteria must be followed when registering a scent mark as provided the Guidelines,⁷⁸⁸ Proprietors also need to attach a written description of the mark. In *Ralf Sieckmann v Deutsches Patent- und Markenamt*, the court rejected written descriptions as a manner in which scent marks can be represented.⁷⁸⁹ It is thus not clear exactly how South Africa

⁷⁸⁵ *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another* (CCT42/04) [2005] ZACC 7; 2006 (1) SA 144 (CC); 2005 (8) BCLR 743 (CC) para 87.

⁷⁸⁶ See chapter 3 part 3.3.2.

⁷⁸⁷ See chapter 3 part 3.3.2.

⁷⁸⁸ See chapter 3 part 3.3.3.

⁷⁸⁹ See chapter 3 part 3.3.3.

will interpret the Sieckmann criteria. To date, no scent mark has been registered in South Africa.⁷⁹⁰ It is submitted that it will be best for South Africa to apply the Sieckmann test as it is applied in EU. Written descriptions should be excluded expressly. This will provide certainty and will reduce the number of applications for scent marks that cannot be properly represented.

6.2.2 LEGISLATIVE APPROACH VERSUS USA'S CASE-BY-CASE APPROACH

USA's case-by-case approach to the registration of sound, scent and colour marks has provided the flexibility required for the law to develop along with the growth of these marks. South Africa's approach is regarded as too rigid and conservative compared to the USA's approach. It is recommended that South Africa should retain the legislative approach. Such an approach is better than a case-by-case approach since this can create problems. It means this will place a huge responsibility on courts, and judges will have to determine the registration of non-traditional marks based on what they regard as registrable. The legislative approach creates legal certainty and will be consistent with the constitutional approach which is currently used to balance competing rights. The protection of non-traditional marks should not harm competition.

6.2.3 SIGNING AND RATIFYING OF THE SINGAPORE TREATY

The Singapore Treaty is the first of its kind to expressly recognise non-traditional trade marks.⁷⁹¹ It was drafted with a modern idea in mind.⁷⁹² It is submitted that South Africa should sign and ratify this treaty in order to keep up with technological advances in trade mark law. It is further submitted that the ratification of this treaty would assist South Africa in drafting better guidelines for the registration of sound, colour and scent marks as the rules of the treaty provide mechanisms for the representation of these marks.

6.3 CONCLUSION

This thesis has shown that the registration of sound, scent and colour marks is a complex issue in South Africa. At the rate in which technology is developing worldwide, it is submitted that these type of marks will become more prevalent in the future. South Africa's approach currently is too rigid to facilitate the protection of non-visible marks. South Africa can draw lessons from the both the EU and USA. Whilst the USA's advantage from a technological point

⁷⁹⁰ See chapter 3 part 3.3.3.

⁷⁹¹ See chapter 2 part 2.6.

⁷⁹² See chapter 2 part 2.6.

of view has played a pivotal role in the number of successful registrations, the flexibility afforded to courts is what allowed these marks to progress from innovations to registered trade marks. For the EU, the strict approach, in the form of graphic representation, which it originally adopted has been removed paving way for the registration of non-traditional marks. This gives an indication that the world is adapting to the registration of sound, scent and colour marks and so should South Africa.

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