

Zacco

Norway

Non-traditional marks are, by and large, protectable in Norway, with the restrictions imposed across the European Union also applicable in this non-EU country

Introduction

Norway is not a member of the European Union and accordingly, the Community Trademark Regulation (40/94) does not apply. However, as a member of the European Economic Area, Norway had to implement the EU First Trademarks Directive (89/104/EEC). Because the substantial part of the regulation corresponds to the provisions of the directive, EU case law relating to the regulation is decisive for the Norwegian interpretation of the directive. Accordingly, Norwegian trademark law practice is in line with that of the European Union.

The broad definition of 'non-traditional trademarks' encompasses "everything that is not a word mark and/or device mark". These marks may be further categorized into two groups: visible signs and non-visible signs.

Visible signs include:

- three-dimensional marks;
- holograms;
- colour marks;
- slogans;
- titles of films and books;
- motions or multimedia signs;
- gesture marks; and
- position marks.

Non-visible signs include:

- sound marks;
- olfactory marks;
- taste marks; and
- texture/feel marks.

The following article discusses the Norwegian practice (or lack of practice) for most of these types of mark.

Main requirements for registration

The registration of non-traditional trademarks raises several challenges, as a balance must be maintained between trademark protection and the need to keep signs available. In any event, marks must be distinctive and capable of being represented graphically.

Certain non-traditional marks have a

limited inherent capacity for distinguishing the goods and services to which they apply. Protection may thus depend on whether distinctiveness has been acquired through use.

According to case law from the European Court of Justice (ECJ) (ie, *Libertel* (C-104/01) and *Sieckmann* (C-273/00)), the graphical representation of the marks must be "clear, precise, self-contained, easily accessible, intelligible, durable, ...objective and concise". Even though recent technical and digital developments have made it easier for some types of non-traditional mark to meet these requirements, certain difficulties remain, especially for non-visible signs.

Visible marks

Three-dimensional marks

The Norwegian Industrial Property Office (NIPO) requires that the applicant submit a graphical representation of the mark that will enable NIPO to examine the mark in its three-dimensional form. The number of representations needed depends on the mark – that is, the application should contain as many representations as necessary to show clearly all features of the mark and what the applicant seeks an exclusive right to. The applicant should point out that the mark is a three-dimensional sign in the application. NIPO further requires that the mark "[depart] significantly from the norm or customs" (see ECJ Cases C-473/01 and C-474/01, *Procter & Gamble*). A written description of the mark is not needed.

NIPO applies the following criteria when examining three-dimensional signs:

- The sign must depart significantly from the norm or customs in the trade.
- The sign must be distinctive.
- The sign must not be a shape dictated by functionality or a technical result.
- The sign must not constitute a shape that serves the sole purpose of giving substantial value to the goods to which it applies.
- The duty to keep certain signs free and available for general use.

If NIPO rejects an application, the applicant may still be able to show that the mark has acquired distinctiveness through use.

Holograms

The requirements for registration are the same as for three-dimensional marks and the number of representations depends on the mark. Electronic representation is preferable to capture the hologram effect. NIPO may require that the applicant also submit a written description of the mark.

Colour marks

NIPO requires that the applicant submit a representation indicating the specific colour, for example by using the Pantone colour code. Colours are widely seen as elements to be kept free and available for general use. However, NIPO will allow registration where the applicant shows that the colour mark has acquired distinctiveness.

NIPO has registered only a limited number of marks stating colour *per se*. Some examples include the colour 'Warm Red C' registered for Rizla cigarette paper and the colour pink defined as Pantone 196C for isolation material, both based on distinctiveness acquired through use.

Slogans

Under current registration practice, a slogan mark must not:

- indicate the kind or quality of the related product or service;
- consist of an ordinary statement; or
- amount to a mere sales promotional statement.

NIPO's practice is in accordance with the reasoning from the ECJ in Case C-64/02 (*DAS PRINZIP DER BEQUEMLICHKEIT*) that the distinctiveness of a mark made up of signs or phrases which are also used as an advertising slogan has to be assessed on the basis of the general principles established by the ECJ with regard to trademarks.

Examples of slogans rejected by NIPO include:

- MAKEUP SO PURE YOU CAN SLEEP IN IT, because it is descriptive for goods in Class 3 of the Nice Classification;
- BUILDING INSIGHT THROUGH INVESTIGATION, found descriptive of services in Class 44; and
- IMAGINE THE POSSIBILITIES, found to lack distinctiveness.

Such slogans may however be registered on the basis of acquired distinctiveness.

A substantial number of slogans are registered in Norway, for example:

- HINT OF A TINT for hair-colouring products in Class 3;
- THE BIG PICTURE for projectors in Class 9; and
- I'M LOVING IT for McDonald's goods and services in Classes 29, 30, 32, 35, 42 and 43.

Motion and gesture marks

Only about one-third of trademark offices worldwide accept motion marks as trademarks. NIPO is one of these offices.

The representation of the mark must be in the form of an electronic file showing the moving mark, or a maximum of 16 still pictures showing the motion. The pictures have to indicate clearly and precisely the changes undergone by the mark in the designated period. The images should be numbered in sequence order and be followed by a clear and precise description of the picture sequence and the motion changes within it. The description should always include the total number of pictures in the sequence, a statement of the representation frequency (numbers of pictures per second) and the total time of the sequence. NIPO prefers electronic representation.

To the authors' knowledge, only two motion marks have been registered in Norway. One is owned by Microsoft for goods in Class 9 where the trademark is described as "an animated sequence with two conic shaped segments connected on the upper right part of the mark. During the animated sequence a geometrical object is moving up along the first segment and then down the other while individual chords or ribbons change from dark to light. The stippling as shown is only meant for gradation".

No application has yet been filed for a gesture mark. It is still under debate whether these marks are just another form of motion or figurative mark, or whether they are a different sort of mark.

Non-visible marks

Sound marks

NIPO accepts sound marks for registration. So far about a dozen applications have been filed and the majority have been accepted. Most applications have consisted of musical marks (ie, where the applicant submitted musical notes). Single tones or trivial sounds are not perceived as distinctive marks. Lengthy conversations or monologues will typically not be viewed as trademarks.



Lisbeth G Wolther
Associate lawyer
Lisbeth.Wolther@zacco.com

Lisbeth G Wolther joined Zacco in 2008. As an associate lawyer she works primarily with trademark law, patent law, employees' inventions and IP strategy. She has wide experience of intellectual property and related areas. Ms Wolther was director of legal and international affairs at NIPO before joining Zacco.



Line Schartum-Hansen
Associate
Line.Schartum-Hansen@zacco.com

Line Schartum-Hansen joined Zacco in 2008. She works on all IP matters including trademarks, copyrights, designs and dispute resolution. She has particular expertise in the field of anti-counterfeiting action stemming from seizures by Customs. Ms Schartum-Hansen graduated with a master's degree in law from the University of Oslo in December 2007. She is a member of the Norwegian Bar Association.

For sound marks that can be reproduced in musical form, the sound must be reproduced in a notation. The notation must be followed by a clear, written description of the sound. Such graphical reproduction can for example indicate the notes and instruments, the length of the sound, the beat/tempo, the volume or other characteristics of the sound, what objects or instruments are being used to produce the sound or sounds, the name of the piece of music or a quotation of the text that is being sung or read, together with a translation if necessary.

For sound marks that cannot be reproduced through musical notation, adequate representation may consist of:

- a verbal description;
- a sound sample;
- a sonogram;
- an onomatopoeia; or
- a combination of these.

NIPO also requests a soundtrack on a suitable medium and in a suitable format, such as mp3 or similar open format. A soundtrack will make it easier for both NIPO and a third party to form an idea of the mark.

Olfactory marks

NIPO has not yet received any applications for olfactory marks. Because EU case law is decisive for Norwegian registration practice, NIPO will place emphasis on the previously mentioned *Sieckman Case*, as well as the later *Smell of ripe strawberry Case* (T-305/04). Thus, such signs may in principle be registered as trademarks as long as the described smell is sufficiently clear, precise and unambiguous. However, in the *Smell of ripe strawberry Case* the European Court of First Instance found that the smell of strawberries differs from one variety to another and thus "the smell of ripe strawberry" is not unique.

Taste and texture marks

NIPO has not received any applications for either taste or texture marks. However, the marks would have to meet the requirements set out in *Libertel*, *Sieckmann* and *Smell of ripe strawberry Cases* – namely, being clear, precise, self-contained, easily accessible, intelligible, durable, objective and concise.

Final remarks

The use and registration of non-traditional marks raises a number of issues for which clarification is keenly awaited. In this regard, NIPO plays an active role in the World Intellectual Property Organization's trademark standing committee. [WTR](#)