

**THE APPLICABILITY OF THE GRAPHICAL
REPRESENTATION REQUIREMENT ON THE
REGISTRATION OF NON-TRADITIONAL
TRADEMARKS: COMPARATIVE ANALYSIS
OF A POSSIBLE UPDATE IN THE ANDEAN
COMMUNITY REGULATION IN THE LIGHT OF
THE EUROPEAN AND CHINESE EXPERIENCES**

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ABSTRACT

This article aims to explore the question of whether the international harmonization of the abolition of the graphical representation requirement is necessary to facilitate the registration of new types of trademarks that may not be easily represented graphically. By examining the trademark systems of the European Union, Andean Community, and China, this research examines the advantages and disadvantages associated with removing the graphical representation requirement and its impact on the registration of non-traditional trademarks.

Through a comparative study, this research provides insights into the benefits and challenges that arise from the abolition of the graphical representation requirement, highlighting the importance of accommodating evolving trademark practices and ensuring effective protection for innovative forms of trademarks.

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Fecha de recepción: 26 de febrero de 2024. Fecha de aceptación: 26 de marzo de 2024. Para citar el artículo: Pérez Acevedo, Natalia, “The Applicability of the Graphical Representation Requirement on the Registration of Non-Traditional Trademarks: Comparative Analysis of a Possible Update in the Andean Community Regulation in the Light of the European and Chinese Experiences”, en *Revista La Propiedad Inmaterial* n.º 38, Universidad Externado de Colombia, julio-diciembre 2024, pp. 73-108. DOI: <https://doi.org/10.18601/16571959.n38.04>.

Keywords: Andean Community Regulation, comparative analysis, European Trademark Regulation, graphical representation requirement, non-traditional trademarks, regulatory update, Singapore Treaty, TRIPS (Agreement on Trade-Related Aspects of Intellectual Property Rights).

LA APLICABILIDAD DEL REQUISITO DE REPRESENTACIÓN GRÁFICA EN EL REGISTRO DE MARCAS NO TRADICIONALES: ANÁLISIS COMPARATIVO DE UNA POSIBLE ACTUALIZACIÓN EN LA REGULACIÓN DE LA COMUNIDAD ANDINA A LA LUZ DE LAS EXPERIENCIAS EUROPEA Y CHINA

RESUMEN

Este artículo tiene como objetivo explorar la cuestión de si la armonización internacional de la abolición del requisito de representación gráfica es necesaria para facilitar el registro de nuevos tipos de marcas que pueden no ser fácilmente representables gráficamente. Al examinar los sistemas de marcas de la Unión Europea, la Comunidad Andina y China, esta investigación analiza las ventajas y desventajas asociadas con la eliminación del requisito de representación gráfica y su impacto en el registro de marcas no tradicionales.

A través de un estudio comparativo, esta investigación proporciona información sobre los beneficios y desafíos que surgen de la abolición del requisito de representación gráfica, destacando la importancia de adaptarse a las prácticas de marcas en evolución y de asegurar una protección efectiva para las formas innovadoras de marcas.

Palabras clave: Decisión 486 de la Comunidad Andina, análisis comparativo, Reglamento de Marcas Europeas, requisito de representación gráfica, marcas no tradicionales, actualización normativa, Tratado de Singapur, ADPIC (Acuerdo sobre los Aspectos de los Derechos de Propiedad Intelectual relacionados con el Comercio).

INTRODUCTION

A trademark right confers an exclusive right that implies that the sign can be only used by its owner. In addition, registration provides legal certainty as well as protection from dilution and misappropriation. The requirements for such registration are governed by each jurisdiction sometimes including the graphical representation of the mark. Still, fulfillment of this requirement is not always easy when speaking about non-traditional trademarks, such as sounds, scents, motion, textures, etc.

Indeed, the necessity to critically appraise this topic has become highly relevant with the evolving market needs, to provide a guarantee of protection for the

new type of trademarks and legal certainty for the third parties and competitors. Nevertheless, it is still not clear if the removal of the graphical representation requirement on the registration has merely theoretical rather than practical effects.

The Andean legislation, applicable to the member countries of the Andean Community such as Bolivia, Colombia, Ecuador, and Peru, defines a trademark solely based on its distinctiveness. However, the system recognizes the graphical representation as a purely procedural requirement. To obtain the registration, one needs to provide the National Trademark Offices with key points to facilitate a precise identification of the subject matter of protection. Nevertheless, certain signs, such as olfactory, tactile, or gustatory marks, cannot be graphically depicted despite conforming to the legal definition of trademarks in Andean legislation. As a result, this structure hinders the registration of non-traditional trademarks.

The question as to whether the Andean Community should follow in the footsteps of the European Union and adhere to the latest international provisions, such as the Singapore Treaty on the Law of Trademarks, by permitting the use of flexible representation methods to precisely ascertain the subject matter of protection is a current topic of discussion in the light of the updating intentions for the Andean Decision 486. Thus, and in order to develop a proposal for possible changes for such revision, this research will analyze the outcome of the recent abolition in the European Union as well as the revisions of the Chinese legislations by means of which the visibility requirement has been removed but the graphical representation was kept so to allow registration of sound trademarks.

The research is divided into six chapters followed by a conclusion. The first chapter will highlight the meaning of the graphical representation requirement, where it still exists and how it has been interpreted. It will also lay the international framework for registrable subject matter and will assess the requirements for protection laid down in the Andean Community, European Union and China.

The two main jurisdictions addressed will be the European Union and Chinese, to carry out a comprehensive analysis of the drawbacks and advantages of having the graphical representation requirement, and due to their significant importance for the world economy and preference for the entrepreneurs to protect their signs.

Chapter two will further make reference to the main issues for non-traditional trademarks that are difficult to represent. It will address alternative criteria and interpretations used in order to allow the registration of olfactory, tactile, gustatory and motion trademarks.

The third chapter will address the most accurate intention of international harmonization of administrative trademark registration procedures, its applicability, influence and effectiveness.

Chapter four will assess the benefits and consequences of the graphical representation requirement for the trademark registration systems that still include it and how its elimination widens the scope for new and upcoming signs to be registered as trademarks but also the underlying legal concept of trademarks.

Lastly, the final chapter will include the recommendations for the upcoming revision of the Andean Decision 486.

I. MEANING AND INTERPRETATION OF THE GRAPHICAL REPRESENTATION REQUIREMENT

According to the Cambridge Dictionary, the term “*representation*”¹ refers to the way in which someone or something is shown or described. As such, it can be considered the act of depicting, portraying, or symbolizing something in a particular way. Meanwhile, the term “*graphical*” generally refers to something that is presented visually, often in the form of a chart, graph, or other similar visual representation. This typically involves the use of graphical elements such as lines, bars, colors, symbols, or shapes to convey information in a clear and easily understandable manner.

In light of the above, graphical representation can be interpreted as the visual depiction of a sign that enables its identification.

Although some countries have relaxed the graphical representation requirement in recent years, it still remains an important part of trademark registration in many jurisdictions such as the Andean Community, Brazil, Canada, Australia, Japan, among others.

I.1. INTERNATIONAL PROVISIONS ON TRADEMARK PROTECTION: TRIPS AGREEMENT AND PARIS CONVENTION

Under the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS), World Trade Organization (WTO) members must comply with the substantive provisions of the Paris Convention. However, trademark registration requirements are not regulated by the Paris Convention. Instead, each member state must determine its own guidelines based on its local laws.

On the other hand, Article 15.1 of the TRIPS Agreement defines a trademark as “*any sign capable of distinguishing the goods or services of one undertaking from those of other undertakings*”. The agreement lists a variety of potential signs that can constitute trademarks, including words, letters, numerals, figurative elements and combinations of colours, as well as any combination of signs. “*This means that in principle there is no limitation on the type of signs that can constitute trademarks under the TRIPS Agreement. Rather, the emphasis is on distinctiveness*”².

1 ‘Representation’, Cambridge Dictionary (Cambridge University Press & Assessment, 2023). <https://dictionary.cambridge.org/dictionary/english/representation> [accessed 21 May 2023].

2 World Trade Organization, ‘*A Handbook on the WTO TRIPS Agreement*’ (Cambridge University Press, 2020). https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/modules3_e.pdf [accessed 21 May 2023].

Moreover, the same article stipulates that members may require signs to be visually perceptible as a prerequisite for registration³. This gives members the freedom to decide whether or not to permit the registration of “non-traditional” trademarks, such as smells, sounds, textures, and other non-visual signs.

This language suggests that a trademark must be capable of graphical representation in order to be registered. Nonetheless, the visual perception of a sign may not always be an indicator of its graphical representation, since there are non-visual signs that can be depicted graphically, i.e., sounds represented with musical notes in a pentagram.

1.2. ANDEAN COMMUNITY (CAN)

The Andean Decision 486 establishes the Common Industrial Property Regime and outlines the general definition of a trademark in Article 134⁴. According to this provision, any sign capable of distinguishing goods and services in the market is considered a trademark within the Andean system. This indicates that the definition of a trademark is primarily based on the distinctiveness of the sign.

Moreover, the provision states that signs that can be represented graphically may be eligible for trademark registration. However, it does not explicitly exclude signs that cannot be represented graphically from eligibility. This suggests that the requirement of graphical representation may not necessarily be a fundamental conceptual element of a trademark.

When interpreting the trademark-related provisions contained in the Andean Decision 486, the Court of Justice of the Andean Community (TJCA) - which serves as the judicial body responsible for interpreting the Andean legal system - has acknowledged in certain preliminary interpretations the graphical representation as a conceptual element of the trademark⁵. In other cases, the TJCA has focused solely on the distinctive ability as the conceptual component⁶. This interpretation is conducted upon request from national judges to ensure consistent and uniform application of the provisions across the Member Countries. However, the differing approaches taken by the TJCA highlight the ambiguity surrounding the legal concept of trademarks in the Andean Community, as the judicial authority has

³ Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). Article 15 (1): “[...] Moreover, the same article stipulates that members may require signs to be visually perceptible as a prerequisite for registration.”

⁴ Andean Decision n.º 486 Establishing the Common Industrial Property Regime. Title VI: Marks, Chapter I: Requirements for the Registration of Marks. Article 134: “For the purposes of these Provisions, any sign capable of distinguishing goods or services on the market shall constitute a mark. Signs that are susceptible of graphic representation may be registered as marks. The nature of the product or service to which a mark is to be affixed shall in no case be an obstacle to the registration thereof. [...]”

⁵ Court of Justice of the Andean Community (TJCA), Preliminary Interpretation for Process n.º 12-IP-2014; Process n.º 70-IP-2013 and Process n.º 38-IP-2008.

⁶ Court of Justice of the Andean Community (TJCA), Preliminary Interpretation for Process n.º 421-IP-2019; Process n.º 36-IP-99 and Process n.º 120-IP-2021.

not provided a clear and explicit determination regarding the nature of graphical representation⁷.

To illustrate this ambiguity, one can consider the preliminary interpretation issued for Process 70-IP-2013^[8], initiated by the Council of State of Colombia in a Nullity Action case concerning the registration of the mark “MUJER LATINA” (wordmark) in Class 25. In this case, the TJCA analyzed Article 134 of the Andean Decision 486, considering graphical representation as an integral part of the conceptual meaning of a trademark. The interpretation states:

The trademark is an intangible asset consisting of a sign composed of words or a combination of words, images, figures, symbols, graphics, etc., which, capable of graphic representation, serve to distinguish products or services in the market, so that the average consumer or user can identify, evaluate, differentiate, and select them without the risk of confusion or error regarding the origin or quality of the product or service.⁹

In contrast, in the preliminary interpretation for Process 120-IP-2021^[10], initiated by the Council of State of Colombia in a Nullity Action case concerning the registration of a color mark, specifically the color PINK (PANTONE 183 C) for sodas, the TJCA omitted any reference to graphical representation while explaining the concept of a trademark but listed it later as one of the prerequisites for registration.

Furthermore, the TCJA recently issued an “Index of Clarified Act Criteria” which encompasses all the Andean provisions related to Industrial Property that are now considered clarified and no longer require further interpretations. Among these provisions, Article 134 of the Andean Decision 486 is listed, and the most recent interpretation referenced is the one issued for Process 344-IP-2022^[11]. In this interpretation, the TJCA concludes that “the trademark is an intangible asset that allows for the identification or distinction of various products or services offered in the market”¹². Hence, it can be inferred that the graphical representation is mandatory for the registration process only on procedural grounds.

7 See María Emilia Torres Montenegro. *‘Exclusion of the graphic representation requirement in the Andean Community of Nations’ trademark regime’*. (Universidad San Francisco de Quito - USFQ Law Review, 2021) <https://revistas.usfq.edu.ec/index.php/lawreview/article/download/2316/2875?inline=1#fn12> [accessed 21 May 2023].

8 Court of Justice of the Andean Community (TJCA), Preliminary Interpretation for Process n.º 70-IP-2013.

9 Ibid.

10 Court of Justice of the Andean Community (TJCA), Preliminary Interpretation for Process n.º 120-IP-2021.

11 Court of Justice of the Andean Community (TJCA), Preliminary Interpretation for Process 344-IP-2022.

12 Ibid.

1.3. EUROPEAN UNION (EU)

Since October 1, 2017, the European Union Trademark Regulation (EUTMR)¹³ no longer requires a trademark to have a graphic representation. Instead, trademarks can be represented in any appropriate form, using commonly available technology, provided that the representation is clear, precise, self-contained, easily accessible, intelligible, durable, and objective. This change has led to a wider range of representations so that video files, sound files and a 3D-model viewer became suitable when representing EU trademarks.

The outcome is a system that follows the principle of *'what you see is what you get'*, that aims to *"make the trademark entries on the EUTM Register clearer, more accessible and easier to search for"*¹⁴. Therefore, and according to Article 4 from the European Trademark Regulation (EUTMR), in addition to distinctiveness, a trademark is required to be clearly defined to ensure that third parties are certain about its scope of protection.

Prior to this change, the presence of the graphical representation requirement along with the case law of the Court of Justice of the European Union (CJEU), stipulated that a trademark did not necessarily have to be visually perceptible but had to be capable of graphical representation through images, lines, and/or characters¹⁵. Despite this, visually perceptible signs were more likely to fulfill these requirements and therefore were the most likely to be registered.

Overall, the elimination of the graphical representation requirement represents a significant change aimed at modernizing the European trademark system. However, the complete impact of this change on trademark applications will be examined in the following chapters, allowing for a comprehensive analysis of its effects.

1.4. CHINA

The Chinese Trademark law underwent its first revision in 2001 to comply with the minimum requirements set by TRIPS, defining trademark as "any visible sign that can serve to distinguish the goods of a natural person, legal person, or other organization from those of another, including any word, design, letter of the alphabet, numeral, three-dimensional symbol and color combination, or any combination of the above, may be made a trademark for application for registration"¹⁶.

¹³ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trademark. OJ L 154/1.

¹⁴ European Union Intellectual Property Office, *'Elimination of the graphical representation requirement'* (EUIPO) <https://euipo.europa.eu/ohimportal/en/elimination-of-graphical-representation-requirement> [accessed 21 May 2023].

¹⁵ *Ralf Sieckmann v Deutsches Patent und Markenamt* (2002) Case C-273/00, Paragraph 55.

¹⁶ Trademark Law of the People's Republic of China (as amended up to Decision of October 27, 2001, of the Standing Committee of the National People's Congress, revising

The second revision in 2013 removed the visibility requirement and allowed for the registration of sound marks, clarifying the scope of eligible marks in China. According to the revised provision “Any signs, including words, graphs, letters, numbers, three-dimensional symbols, color combinations, sound or any combination thereof, that are capable of distinguishing the goods of a natural person, legal person or other organization from those of others may be applied for registration as trademarks”¹⁷. However, despite this change, the registration process still follows the graphic representation regime, and protection for non-traditional marks, such as smell, taste, and motion marks, remains uncommon in China since the revised version did not expand the registration to these types of marks.

In January 2023, the China National Intellectual Property Administration (CNIPA) proposed new amendments to the Trademark Law, which slightly adjusted the scope of elements that can be legally registered as a trademark. As such, Article 4 of the draft amendment maintains the basic definition of a trademark, which includes the same list of symbols that can be registered, such as text, graphics, letters, numbers, three-dimensional symbols, color combinations, and sounds, as well as combinations of the aforementioned elements. However, it also adds the expression “*and other elements*”, which may expand the scope of permissible elements and potentially provide stronger legal grounds for unusual types of signs, such as smells or flavors, to be registered as trademarks¹⁸.

CONCLUSION

The evolution of trademark legislation has been influenced by technological advancements, resulting in notable changes over time. Traditionally, the emphasis of the representation requirement in trademarks was focused on the visual aspects of the sign. However, in recent years, significant expansions have been observed to encompass non-traditional marks, such as sounds and motions, which can be represented through alternative means. This transformation in trademark laws reflects the acknowledgement of emerging forms of trademarks that extend beyond conventional visual representations.

Nonetheless, in certain jurisdictions like China and CAN, the graphical representation requirement can be perceived as a restriction that hinders the

the Trademark Law of the People’s Republic of China; promulgated by Order n.º 10 of August 23, 1982, of Standing Committee of the National People’s Congress), Article 8.

17 Trademark Law of the People’s Republic of China (as amended up to Decision of August 30, 2013, of the Standing Committee of National People’s Congress on Amendments to the Trademark Law of the People’s Republic of China), Article 8.

18 See Arendse Huld. *Amendments to China Trademark Law: Improving IP Use and Protection* (China Briefing. Dezan Shira & Associates, 2019) <https://www.china-briefing.com/news/amendments-to-china-trademark-law-improving-ip-use-and-protection/> [accessed 21 May 2023].

registration of emerging types of signs that could potentially differentiate goods and services but cannot be represented graphically.

2. COMPLEXITY OF GRAPHICAL REPRESENTATION FOR NON-TRADITIONAL TRADEMARKS

Trademark registration is an essential tool for businesses to protect their identity and reputation. With the development of technology, non-traditional trademarks, including sounds like the famous ‘Intel Inside’ jingle, colors like the iconic ‘Tiffany blue,’ and even scents like the distinctive ‘Play-Doh smell’, have become increasingly popular as a means of distinguishing goods and services in the market. However, registering non-traditional marks can be challenging due to the complexity of their graphical representation.

Traditionally, trademarks were registered based on their visual representation, but with the emergence of non-traditional marks, new methods of graphical representation have been developed to limit the scope of protection of these marks. This has led to a complex legal landscape, where different jurisdictions have different requirements for the graphical representation of non-traditional marks. In this context, it is essential to explore the complexity of graphical representation for non-traditional trademarks and the challenges that the applicants face when trying to obtain registration for these signs.

2.1. OLFACTORY TRADEMARKS AND THE SIECKMANN CRITERIA

As the world becomes more sensory-driven, businesses usually explore new ways to stand out and create a unique identity in the marketplace for their products and services. One of these ways is through the use of olfactory marks, which are non-traditional trademarks that consist of scents or smells. One notable example of such a famous scent is the renowned fragrance known as Chanel No. 5, which was introduced by the luxury fashion house Chanel in 1921. This distinctive floral-aldehydic fragrance was created by perfumer Ernest Beaux and has since become an iconic olfactory sign associated with the Chanel brand.

However, registering olfactory marks poses a complex legal challenge due to the difficulty of representing scents graphically and the potential for consumer confusion. It is therefore crucial to explore into the intricacies of olfactory marks, the challenges involved in their registration, and the legal landscape surrounding them.

*Sieckmann v. Deutsches Patent- und Markenamt*¹⁹ established an important precedent in the registration of non-traditional trademarks, particularly those based on sensory perception such as scents and tastes. In this case, the European Court

19 ‘*Ralf Sieckmann v Deutsches Patent und Markenamt*’ (2002) Case C-273/00.

of Justice (ECJ) was called upon to clarify the meaning of graphical representation and determine whether a scent described as “*balsamically fruity with a slight hint of cinnamon*” could be registered as a trademark.

The German Patent and Trademark Office refused the registration of such scent on the grounds that it was not capable of being represented graphically in a clear, precise, and self-contained manner, as required under the European Union Trademark Directive. Ralf Sieckmann, the applicant, represented the trademark by way of a chemical formula and provided the German Trademark Office with a verbal description of the mark and a sample. However, the European Court ruled that the chemical formula used as a representation of the mark was not intelligible nor the description of such smell was sufficient. Finally, the sample of the smell was considered as not durable or stable.

Therefore, the Court then established a set of criteria, known as the Sieckmann criteria, which must be satisfied for a scent, or any other non-traditional mark, in order to be registered. The Sieckmann criteria aim to ensure that the mark is capable of being accurately represented and include the requirement that the representation must be clear, precise, self-contained, easily accessible, intelligible, durable, and objective.

The representation has to be clear, which means that it cannot be ambiguous and must lead only to one interpretation; precise as it has to be accurate; self-contained, having all that is needed in itself; easily accessible, being easy to reach; intelligible as it has to be able to be understood; durable, since the same must remain consistent in time; and objective, not being influenced by personal beliefs.

Trademark offices in the European Union use the Sieckmann criteria to assess the registrability of non-traditional trademarks. While the Court did not entirely prohibit the registration of smell marks, the criteria for meeting the representation requirement seem to be challenging and, at times, impossible to fulfill, requiring applicants to provide more information than usual or adopt alternative forms of representation.

Regarding the Andean regulation, although it expressly permits the registration of smells as trademarks, a comprehensive investigation conducted in the public databases of the four Andean Trademark Offices reveals minimal discussion about the registration of such signs in these countries, except for Colombia²⁰. This lack of discussion is mainly attributed to the limited entrepreneurial initiative

20 See Vanessa Cure Villa. ‘*Graphic representation of olfactory marks in Colombia in the light of the Decision 486 of 2000 of the Andean Community Commission*’. (Universidad de los Andes – Anuario de Derecho Privado 02, 2020) <https://anuarioderechoprivado.uniandes.edu.co/images/pdfs/anuario2/3Curetesis.pdf> [accessed 21 May 2023].

See Jonathan Rafael García Enríquez. ‘*The necessity of regulating non-traditional trademarks in Peru*’ (Universidad Continental, 2021) https://repositorio.continental.edu.pe/bitstream/20.500.12394/10492/2/IV_FDE_312_TE_Garcia_Enriquez_2021.pdf [accessed 21 May 2023].

in this area. Consequently, the trademark offices in the other countries have not extensively explored the interpretation and application of Article 134(c) of the Andean Decision 486²¹.

The primary hindrance to registering smells as trademarks in Colombia has been the requirement for graphic representation, which has resulted in non-traditional marks being expected to be represented similarly to traditional marks. In fact, the trademark office has rejected some alternative methods of representing this type of trademarks, considering that olfactory marks cannot be graphically reproduced. For instance, back in 2005, the chemical formula was deemed inadequate to represent the scent of a well-known diaper rash cream in Colombia²², as it represents the substance itself rather than the scent. In parallel, given its complexity, it can be inferred that only a few people would be able to decode a scent from the formula that represents the product from which it emanates.

Such stance was recently upheld in December 2022 when the Colombian Trademark Office rejected the registration of a scent for massage oils and soaps in Class 3, as well as antibacterial gels and insecticides in Class 5²³. The applicant, a prestigious university for engineering, provided a description of the scent as follows:

A fragrance of natural origin, which incorporates essential oils obtained from aromatic plants. It is a fragrance of the citrus floral olfactory family. Top notes are ylang-ylang, neroli and orange; heart notes are fruity jasmine, citrus herbaceous, fresh lemon and rose; base notes are musk, patchouli, woody, earthy and vetiver.²⁴

Furthermore, the applicant submitted the chemical formula, a chromatographic description, and a physical sample of the product. Nevertheless, the Trademark Office reiterated that the formula as well as the chromatographic description lacked clarity and did not represent the scent itself but rather the substance. As for the product sample, the Office deemed it inadequate since it lacked the necessary stability and durability. Due to the volatility of its components, the scent of the sample would diminish over time, resulting in a loss of its distinctive characteristics.

Finally, olfactory trademarks have been a relatively new and controversial subject in China. The Chinese Trademark Office has not yet established a clear policy on the registration of olfactory trademarks. As mentioned before, China's Trademark law removed the visibility requirement in 2013, theoretically allowing for the registration of scent marks. "However, there is still a gap in China's active legislation on smell trademarks, because there is still no positive legislation which

21 Andean Decision n.º 486 Establishing the Common Industrial Property Regime. Title VI: Marks, Chapter I: Requirements for the Registration of Marks. Article 134: "[...] The following signs, among others, may constitute marks: [...] (c) sounds and aromas".

22 Superintendence of Industry and Commerce. Distinctive Signs Office. Resolution n.º 11956 of April 30, 2007. Trademark Application n.º 05047635.

23 Superintendence of Industry and Commerce. Distinctive Signs Office. Resolution n.º 90504 of December 22, 2007. Trademark Application n.º SD2017/0012803.

24 Colombian Trademark Application n.º SD2017/0012803.

tell people in a textual manner that smell can be registered as trademark”²⁵, since it is not expressly mentioned in the list of registrable signs.

2.2. TACTILE TRADEMARKS AND THE USE OF SAMPLES

Tactile trademarks are a type of non-traditional trademark that consist of a texture, shape or surface that can be felt by touch. For instance, one example often associated with Louis Vuitton is the distinctive texture found on their bags and suitcases, which is recognized as part of the brand’s identity. Although it is primarily a visual trademark, the raised texture of the Louis Vuitton pattern can contribute to its tactile appeal and recognition.

Another example is the Coca-Cola bottle, which has a distinct tactile feature known as the “hobble skirt” design. In 1915, the Coca-Cola Company aimed to create a bottle that would be recognizable by touch, even in the dark. Earl R. Dean of the Root Glass Company developed the iconic “hobble-skirt” design, which contributes to the bottle’s tactile recognition and helps establish a unique brand identity while deterring imitation brands²⁶.

These type of trademarks are not eligible for registration in China yet, since the only non-traditional marks allowed by the Chinese Trademark law are sound, color, and three-dimensional marks.

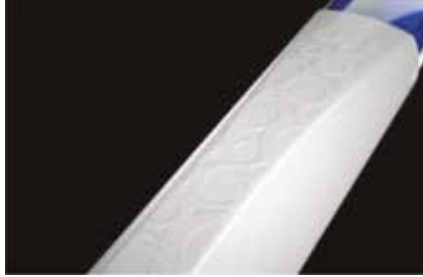
Similarly, the European Union Intellectual Property Office (EUIPO) states in its Guidelines that it is currently not possible to represent the tactile effect of a certain material or texture in compliance with Article 4 EUTMR as Article 3(9) EUTMIR specifically excludes the filing of samples and the subject matter of protection cannot be determined with clarity and precision with generally available technology.

The above was confirmed by the Board of Appeals in Decision R 2588/2014-2²⁷, which resulted in the rejection of a tactile trademark application submitted by The Procter & Gamble Company. The application included a verbal description of the mark as a “tactile feeling constituted by the imprinted embossed pattern on the smooth bottle surface” and a photograph provided as a visual representation, with a disclaimer stating it was solely for informational purposes. However, these elements were deemed insufficient as a “clear” and “self-contained” representation of the mark itself.

25 FU Shuju. ‘*Proceedings of the 2021 International Conference on Enterprise Management and Economic Development: New Challenge on Intellectual Property: Smell Trademark*’. (Atlantis Press - Advances in Economics, Business and Management Research, Volume 178, 2021) <https://www.atlantis-press.com/article/125957360.pdf> [accessed 21 May 2023].

26 See Bill Lockhart and Bill Porter. ‘*The Dating Game: Tracking the Hobble-Skirt Coca-Cola Bottle*’. (Bottles and Extras, 2010) <https://sha.org/bottle/pdffiles/coca-cola.pdf> [accessed 21 May 2023].

27 European Union Intellectual Property Office. Appeal R 2588/2014-2 of May 27, 2015. Trademark Application n.º 012112462.



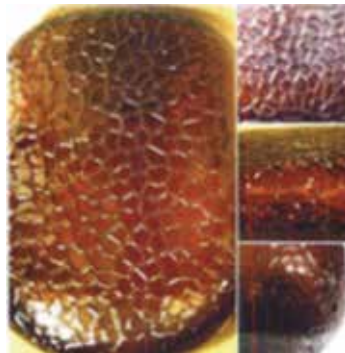
EU Trademark Application n.º 012112462

Source: <https://euipo.europa.eu/eSearch>

Unlike the European Union and China, the Andean Community allows for the registration of several types of non-traditional trademarks without explicitly limiting their nature. The milestone case par excellence about the registration of tactile trademarks in the region, took place in Colombia. The Colombian Trademark Office requested a preliminary interpretation from the Andean Court of Justice regarding the registration of tactile trademarks in order to decide on the application filed by Diageo Brands B.V. for a trademark described as follows:

A hard, cracked, wrinkled texture (surface), that is, striated or scratched in the form of a cluster of irregular geometric shapes that mostly include pentagons, rhombuses, and hexagons, whose shared walls measure in length between 3 and 6 millimeters, in height between 0.08 and 0.5 millimeters, and in thickness between 0.1 and 1 millimeter. The walls and the areas contained within the walls are smooth. The material in which this texture is used will normally be glass and will be used in different sizes.²⁸

The applicant also filed the following image of the described texture:



Colombian Trademark Application n.º 15045738

Source: <https://sipi.sic.gov.co>

²⁸ Superintendence of Industry and Commerce. Distinctive Signs Office. Resolution n.º 90504 of December 22, 2007. Trademark Application n.º 15045738

In preliminary interpretation issued for process 242-IP-2015, the Court impressively highlighted the importance of senses in modern marketing developments by stating:

Marketing researchers have understood the impact of engaging the senses on consumer behavior. With regard to touch, the studies of the new scientific branch called “haptics”, the science of touch, guide efforts in this regard. Tactile or texture marks are those new types of marks that precisely allow the consumer to identify the texture of a product, its container, wrapper or packaging with a specific business origin.²⁹

Additionally, the Court, citing the Sieckmann criteria, did not deem graphical representation alone as sufficient. It broadly interpreted the concept of graphic representation and imposed the fulfillment of two conditions:

- i) the clear, precise and complete description of the sign, including a three-dimensional drawing or photograph; and,
- ii) physical sample of the tactile mark.

The Court further stipulated that the National Trademark Offices should provide access to the aforementioned items upon request.

The need to provide a physical sample has significant implications, including legal and practical issues which have been extensively debated by scholars ever since. Trademark offices will now need to possess the necessary infrastructure to receive, store, and provide access to such samples to interested parties³⁰. While it is reasonable for the Court to maintain that a mere description cannot provide examiners and society with sufficient information to ascertain the subject matter intended to be registered; it remains unclear whether the provision of samples can be extended to non-visual trademark applications, such as olfactory ones.

In parallel, requiring physical samples poses operational and logistical challenges for national offices, which will need to have the capacity to receive, store, and provide access to them³¹. This can be difficult in an era where electronic applications and communication between Trademark Offices and parties are prevalent.

2.3. GUSTATORY TRADEMARKS

Despite the potential value of gustatory trademarks, registering them is not yet common practice due to various challenges. One such challenge is the difficulty in accurately describing taste or flavor, which is a highly subjective experience.

²⁹ Court of Justice of the Andean Community (TJCA). Preliminary Interpretation for Process n.º 242-IP-2015.

³⁰ See. Manuel Guerrero Gaitán Ph.D. *‘Interpretation of the Andean Court of Justice imposes the presentation of physical samples for the registration of tactile trademarks’* (Universidad Externado de Colombia, 2015) <https://propintel.uexternado.edu.co/en/interpretacion-del-tribunal-andino-de-justicia-impone-la-presentacion-de-muestras-fisicas-para-el-registro-de-marcas-tactiles/> [accessed 21 May 2023].

³¹ Ibid.

Additionally, the inability to represent taste or flavor graphically poses a significant obstacle in the registration process.

The subjective nature of taste also hinders its protection through other disciplines, such as copyright. This was demonstrated in the case of *Levola Hengelo BV v. Smilde Foods BV*.³² Although the dispute was about copyright protection, the CJEU concluded that the taste of a food product is subjective and cannot be precisely and objectively identified or determined, thus not meeting the criteria for copyright protection.

Similar to tactile trademarks, the EUIPO guidelines explicitly mention that the current available technology does not allow for a clear and precise representation of gustatory trademarks.

In the European Union, back in 2003, the OHIM Board of Appeal declined the application filed by Eli Lilly, a pharmaceutical company, to register the flavor of artificial strawberries, by noting that

any manufacturer [...] is entitled to add the flavor of artificial strawberries to those products for the purpose of disguising any unpleasant taste that they might otherwise have or simply for the purpose of making them pleasant to taste.³³

Moreover, the taste is unlikely to be perceived by consumers as a trademark; they are far more likely to assume that it is intended to disguise the unpleasant taste of the product [...].³⁴

One can infer from the aforementioned case that consumers tend to perceive the taste of a product as a characteristic or ingredient of the product, rather than an indicator of its origin. As such, gustatory trademarks may not be able to fulfill the most important function of a trademark, which is identifying the source of goods or services.

Even highly specific and distinctive flavors, such as the renowned ‘Marmite’ spread made from yeast extract or “Tabasco” sauce made from tabasco peppers, vinegar, and salt, which could potentially claim acquired distinctiveness, face challenges in being precisely represented. This is because flavors are often essential functional aspects of such products.

In the Andean Community, there is currently no jurisprudential development clarifying the registrability of gustatory trademarks. However, if a sign that is perceived through taste can effectively distinguish a product or service and set it apart from its competitors, it may, in principle, qualify as a trademark under the Andean trademark regime. The hindrance lies in graphically representing it to enable registration.

32 ‘Levola Hengelo BV v Smilde Foods BV’ (2018) Case C-310/17.

33 European Union Intellectual Property Office. Appeal R 120/2001-2 (Paragraph. 15) of August 4, 2003. Trademark Application n.º 001452853.

34 Ibid. Paragraph 16.

To this extent, although the registration of gustatory marks would provide greater protection for food and beverage producers, the practical challenges associated with their registration and enforcement may limit their widespread adoption. Additionally, granting exclusive trademark rights to a specific flavor could potentially impede competition and prohibit other companies from offering similar products with comparable flavors. This is because flavors are frequently employed to enhance product appeal and taste, and allowing exclusive ownership of a flavor could curtail consumer options and impede fair competition.

2.4. MOTION TRADEMARKS

The advancement of multimedia technology has led to the emergence of several non-traditional forms of trademarks, including motion or moving image marks. These marks utilize dynamic visuals or animations to represent a brand. Examples of famous motion marks include Nokia's opening display featuring two hands reaching out and ending in a handshake, as well as the iconic opening motion logo of Microsoft Windows. These trademarks leverage the power of motion to create memorable and distinctive brand identities in the digital age.

In the European Union, there has been a particular focus on the development and examination of motion trademarks, also referred to as animated trademarks. The EUIPO has established guidelines for the examination and registration of motion trademarks³⁵. These guidelines require a clear and precise representation of the mark, which can be achieved by submitting either a video file showing the movement or change of position, or a sequence of still images showing the movement. The images may be numbered or accompanied by a description explaining the sequence³⁶.

In contrast, China stands out as an exception to this trend as motion trademarks are still prohibited from registration. To address this limitation, some possible alternatives include seeking copyright protection for works similar to films or registering a series of trademarks depicting static images of different steps in the animation of the mark³⁷.

35 European Union Intellectual Property Office. 'Examination Guidelines for EU trademarks (EUTMs) and registered Community designs (RCDs). Part B - Examination. Section 4 - Absolute Grounds for Refusal. Chapter 2 - EUTM definition (Article 7(1)(a) EUTMR). 2 'Non-traditional' Trademarks and Article 7(1)(a) EUTMR. 2.6 Motion marks' (EUIPO, 2023) <https://guidelines.euipo.europa.eu/2058843/1937397/trade-mark-guidelines/2-6-motion-marks> [accessed 21 May 2023].

36 Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union Trademark, and repealing Implementing Regulation (EU) 2017/1431 (EUTMIR). Article 3(3)(h).

37 See Belinda J. Scrimenti. 'Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around The World' (Pattishall Insights, 2019) <https://www.pattishall.com/pdf/2019-10%20Pattishall%20Insights.pdf> [accessed 21 May 2023].

Finally, the Andean Community also allows registration of motion trademarks and when assessing its graphical representation refers to what WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)³⁸, stated during its Nineteenth Session in 2008:

With respect to the application for registration of an animated or multimedia mark, the representation of this type of mark will consist of a series of fixed images that, together, describe the movement. The application will include a written description explaining the movement. Additionally, offices may require a recording of the sign in analog or digital format.³⁹

Therefore, the requirements for representation of motion trademarks appear to be the most standardized among jurisdictions, as a description and a sequence of fixed images can be deemed sufficient to identify and protect the subject matter. While the European Union has established guidelines for representing and registering such trademarks, China is still grappling to find a balance between the appropriate means of representation and examination to allow new types of non-traditional marks.

CONCLUSION

The registration of non-traditional trademarks presents significant challenges, especially concerning the graphical representation requirement. The emergence of non-traditional marks, including olfactory, tactile, gustatory, and motion trademarks, has pushed the boundaries of traditional trademark registration, which traditionally relies on visual representation. The Sieckmann criteria, established by the ECJ, impose strict requirements for the representation of non-traditional marks, aiming for clarity, precision, self-containment, accessibility, intelligibility, durability, and objectivity. However, meeting these criteria can be a complex and sometimes impossible task, making it challenging for applicants to obtain registration for non-traditional signs.

In response to these challenges, the European Union has embraced the potential of digital formats, such as MP4 files and other audiovisual formats, to capture motion marks with greater dynamism and precision. Although the requirement for graphical representation has been removed, the EU still recognizes

38 Established in 1998, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) functions as a platform to facilitate dialogue, coordination, and guidance on the continuous development of international law pertaining to trademarks, industrial designs, and geographical indications. This encompasses efforts towards harmonizing national laws and procedures in these areas.

39 World Intellectual Property Organization. Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT). *Representation and Description of Non-Traditional Marks Possible Areas of Convergence* (Nineteenth Session, Geneva, July 21 to 25, 2008) https://www.wipo.int/meetings/en/details.jsp?meeting_id=15323 [accessed 21 May 2023].

the importance of supplementing these formats with detailed descriptions of the movement. By combining digital representations with accompanying descriptions, the EU aims to provide a comprehensive and inclusive approach to representing motion marks.

Interestingly, a similar flexibility characterizes the approach of the Andean Community but towards tactile trademarks, which may require a physical sample for an accurate assessment of the scope of protection. However, they also emphasize the significance of providing a precise description of the sign, accompanied by a 3D drawing or photograph to fulfill the graphical representation requirement.

Moreover, the emergence of non-traditional trademarks, including olfactory and gustatory marks, further complicates matters, with all jurisdictions grappling with the appropriate means of representation and examination. Despite these challenges, recognizing and registering non-traditional trademarks is crucial in adapting to changing times and ensuring the continued effectiveness of intellectual property protection.

3. INTERNATIONAL HARMONIZATION OF ADMINISTRATIVE TRADEMARK REGISTRATION PROCEDURES UNDER THE SINGAPORE TREATY

The Singapore Treaty on the Law of Trademarks, administered by the World Intellectual Property Organization (WIPO), aims to harmonize administrative trademark registration procedures among its member countries. As of May 2023, there are 54 contracting parties, including 52 states such as Canada, the United States, Australia, Russia, Japan, the United Kingdom, several EU countries, as well as the African Intellectual Property Organization and the Benelux Organization for Intellectual Property.

Effective since 2009, the Singapore Treaty consists of 32 articles, 10 rules, and 12 standard forms. Built upon the foundation of the Trademark Law Treaty of 1994 (TLT), it establishes uniform criteria for various aspects of trademark registration, including application filing, examination, opposition, recordals, and renewals of registrations.

While the Singapore Treaty and the TLT are distinct international instruments designed to standardize and streamline national and regional trademark registration procedures, these treaties can be ratified or acceded to independently. Notably, the Singapore Treaty has a broader scope compared to the TLT, as it encompasses not only visible marks but also advancements in communication technologies that have emerged in recent times.

Furthermore, the Singapore Treaty provides a multilateral framework for defining criteria for the reproduction of non-traditional marks. It is the first international instrument to explicitly recognize non-traditional marks, setting out guidelines for including them in trademark applications and registers. However,

it does not create an international obligation for the registration and protection of these types of marks⁴⁰.

Article 3 of the Singapore Treaty outlines several provisions related to the elements that must be included in or accompany a trademark application. These provisions allow Contracting Parties to require specific indications such as the type of mark and any specific requirements applicable to that type of mark⁴¹. Additionally, applicants are required to provide a statement if they, for example, intend to claim color as a distinctive feature of the mark⁴². The detailed requirements and guidelines for these provisions are delegated to the Regulations.

The delegation of specifics to the Regulations is indeed necessary due to the diverse approaches to non-traditional trademark registration among WIPO Member States and the potential emergence of new types of non-traditional trademarks. These differences are evident in how non-traditional marks are recognized, examined, and protected, varying based on the legal systems, cultural backgrounds, and practices in each country. However, the Regulations play a crucial role by providing the necessary guidance and procedures for the national application process. This ensures that the implementation of the treaty's provisions aligns with the unique practices and developments in each member country.

In summary, the articles of the Singapore Treaty serve as the foundation, establishing the fundamental principles, requirements, and objectives of the treaty. They provide a general framework and guiding principles for member countries to follow. On the other hand, the Regulations provide more specific guidelines and procedures for the practical implementation of the treaty's provisions.

In relation to non-traditional marks, Rules 3(2) to 3(9) of the Treaty specifically address the application requirements for hologram⁴³, motion⁴⁴, color⁴⁵,

40 See Marcus Höpferger. 'Non-Traditional Marks – Singapore Treaty Enters into Force' (WIPO Magazine, 2009) https://www.wipo.int/wipo_magazine/en/2009/01/article_0002.html [accessed 21 May 2023].

41 The Singapore Treaty on the Law of Trademarks. Article 3: "a) Any Contracting Party may require that an application contain some or all of the following indications or elements: (...) (x) Where applicable, a statement, as prescribed in the Regulations, indicating the type of mark as well as any specific requirements applicable to that type of mark".

42 Ibid. "(xii) Where applicable, a statement, as prescribed in the Regulations, indicating that the applicant wishes to claim color as a distinctive feature of the mark".

43 Ibid. Rule (3)(5) [Hologram Mark] Where the application contains a statement to the effect that the mark is a hologram mark, the representation of the mark shall consist of one or several views of the mark capturing the holographic effect in its entirety. Where the Office considers that the view or views submitted do not capture the holographic effect in its entirety, it may require the furnishing of additional views. The Office may also require the applicant to furnish a description of the hologram mark.

44 Ibid. Rule (3)(6) [Motion Mark] Where the application contains a statement to the effect that the mark is a motion mark, the representation of the mark shall, at the option of the Office, consist of one image or a series of still or moving images depicting movement. Where the Office considers that the image or images submitted do not depict movement, it may require the furnishing of additional images. The Office may also require that the applicant furnish a description explaining the movement.

45 Ibid. Rule (3)(2) [Mark Claiming Color] Where the application contains a statement to the effect that the applicant wishes to claim color as a distinctive feature of the mark,

position⁴⁶, sound⁴⁷, and 3D marks⁴⁸. Rule 3(10) is applicable to non-visible signs other than sound marks, providing further guidance for their registration and protection⁴⁹.

The Singapore Treaty has identical provisions as the TLT with regard to the form and representation of three-dimensional marks and color as a feature of the mark, which have been recognized to have a harmonizing effect among the Contracting Parties of the TLT. However, the representation of hologram, motion, color per se, position marks, and any non-visible signs are not harmonized under the Singapore Treaty, since the door was left open for the National IP Offices to set out the specific requirements for the reproduction or representation of these marks.

A notable example is Rule 3(10), which grants contracting parties the freedom to determine the format and other details regarding the representation of non-visible signs. This rule enables Contracting Parties to demand one or more-mark

the Office may require that the application indicate the name or code of the color or colors claimed and an indication, in respect of each color, of the principal parts of the mark which are in that color.

Rule(3)(7) [Color Mark] Where the application contains a statement to the effect that the mark is a color per se mark or a combination of colors without delineated contours, the reproduction of the mark shall consist of a sample of the color or colors. The Office may require a designation of the color or colors by using their common names. The Office may also require a description on how the color is or the colors are applied to the goods or used in relation to the services. The Office may further require an indication of the color or colors by a recognized color code chosen by the applicant and accepted by the Office.

46 Ibid. Rule (3)(8) [Position Mark] Where the application contains a statement to the effect that the mark is a position mark, the reproduction of the mark shall consist of a single view of the mark showing its position on the product. The Office may require that matter for which protection is not claimed shall be indicated. The Office may also require a description explaining the position of the mark in relation to the product.

47 Ibid. Rule (3)(9) [Sound Mark] Where the application contains a statement to the effect that the mark is a sound mark, the representation of the mark shall, at the option of the Office, consist of a musical notation on a staff, or a description of the sound constituting the mark, or an analog or digital recording of that sound, or any combination thereof.

48 Ibid. Rule (3)(4) [Three-Dimensional Mark] (a) Where the application contains a statement to the effect that the mark is a three-dimensional mark, the reproduction of the mark shall consist of a two-dimensional graphic or photographic reproduction. (b) The reproduction furnished under subparagraph (a) may, at the option of the applicant, consist of one single view of the mark or of several different views of the mark. (c) Where the Office considers that the reproduction of the mark furnished by the applicant under subparagraph (a) does not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, up to six different views of the mark and/or a description by words of that mark. (d) Where the Office considers that the different views and/or the description of the mark referred to in subparagraph (c) still do not sufficiently show the particulars of the three-dimensional mark, it may invite the applicant to furnish, within a reasonable time limit fixed in the invitation, a specimen of the mark. (e) Notwithstanding subparagraphs (a) to (d), a sufficiently clear reproduction showing the three-dimensional character of the mark in one view shall be sufficient for the granting of a filing date.

49 Ibid. Rule (3)(10) [Mark Consisting of a Non- Visible Sign Other Than a Sound Mark] Where the application contains a statement to the effect that the mark consists of a non-visible sign, other than a sound mark, a Contracting Party may require one or more representations of the mark, an indication of the type of mark and details concerning the mark, as prescribed by the law of that Contracting Party.

representations but does not specify whether these representations must be graphical. Such omission has allowed for a more inclusive definition of trademark representation. As a result, the term “representation” is intended to encompass various forms of representation, including graphic or photographic reproductions, descriptions, and electronic data files⁵⁰. This flexible approach allows for more creativity in the registration of non-traditional trademarks and has helped to streamline the registration process by removing the requirement for a graphical representation.

While the European Union itself is not a member of the Singapore Treaty, several individual EU member states have joined and ratified the treaty. Countries such as France, Germany, Spain, Italy, and the Benelux Organization for Intellectual Property, along with Nordic countries including Iceland, Norway, Denmark, Sweden, and Finland, are all members. By ratifying the treaty, these countries have gone through the formal process of giving legal consent and binding the treaty to their national laws. Consequently, they are obliged to uphold the commitments outlined in the treaty. Conversely, just few European countries, such as Portugal, the Czech Republic, Austria, Hungary, and Bosnia and Herzegovina, have signed the agreement but are yet to complete the ratification process.

The European Union Trademark Regulation (EUTMR), in Article 4, sets out the requirements for a sign to be eligible for EU trademark protection. According to the regulation, an EU trademark can be any distinctive sign that can be represented 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. Such representation requirement is comparable to those described in Rule 3 of the Singapore Treaty. Both aim to ensure the accurate identification and understanding of the protected subject matter.

Furthermore, Recital 10 of EUTMR highlight the adaptability towards non-traditional trademarks while also ensuring legal clarity for all parties involved by requiring the representation of trademarks to meet the seven prerequisites set out in the Sieckmann judgement.

On the other hand, while Peru, as an individual country, has become a signatory and ratified the Singapore Treaty by the end of 2018, the Andean Community as a whole has not signed the treaty. Consequently, Peru may have witnessed an increase in the number of non-traditional trademark applications⁵¹.

50 See Denis Croze, *The Protection of Non-Traditional Trademarks: Critical Perspectives. Chapter 1: Making a Large Universe Visually Perceptible: The Development of Non-Traditional Trademarks in WIPO Treaties* (Oxford, 2018) <https://doi.org/10.1093/oso/9780198826576.003.0002> [accessed 21 May 2023].

51 See Catherine Escobedo, *Peru receives first two post-treaty applications to register motion marks* (World Trademark Review, 2019) <https://www.worldtrademarkreview.com/article/peru-receives-first-two-post-treaty-applications-register-motion-marks> [accessed 21 May 2023].

Since the Singapore Treaty allows countries to establish their own requirements for the representation of non-visible signs in Rule 3(9) and Rule 3(10), it can be concluded that the Andean Decision 486, which governs Peru and requires a graphical representation, does not conflict with Peru's signature of the treaty.

Other Andean countries have not made any public statements regarding their intention to sign the Singapore Treaty. However, due to the ongoing effort to update the Andean Decision 486 within the Andean Community, it is possible for these countries to consider joining the treaty.

Finally, China signed the Singapore Treaty in 2007 but has yet to ratify it. While signing the treaty indicates China's intention to eventually become bound by it, the ratification process entails domestic legal procedures that China must undertake to bind itself legally to the treaty's terms. Presently, China has not yet made the necessary changes to its domestic laws to ensure compliance with the Singapore Treaty. It is noteworthy that the current Chinese trademark law only permits registration of three types of non-traditional marks, namely sound, 3D, and color combinations. As a result, the treaty continues to be non-binding on China.

CONCLUSION

In conclusion, the Singapore Treaty on the Law of Trademarks plays a significant role in the international registration of trademarks by removing the graphical representation requirement and enabling the registration of non-traditional trademarks among its 54 contracting parties. Through its comprehensive provisions and guidelines, the treaty aims to establish uniform criteria for both traditional and non-traditional marks, facilitating a more flexible and streamlined registration process while promoting simplification among the contracting parties.

While the treaty does not harmonize all types of non-traditional trademarks, it provides valuable guidelines and flexibility for each contracting party to establish their own specific requirements for registration. This approach encourages creativity in the registration of non-traditional trademarks while ensuring clarity and accuracy in identifying and protecting the subject matter of protection.

Although the European Union itself is not a member of the Singapore Treaty, the ratification by several EU member states highlights its influence and significance in the field of trademark law. Additionally, the participation of major economies such as Canada, the United States, and Australia, along with the pending ratification by China, and the potential for more countries to join, demonstrate the growing recognition of the benefits of harmonization and the need to adapt to advancements in non-traditional trademarks. Despite challenges, such as the differing approaches to non-traditional marks across jurisdictions, the Singapore Treaty represents a significant step towards standardizing trademark registration procedures worldwide and promoting effective trademark protection in the digital age. However, it is important to note that countries that are not signatories to the

treaty may potentially forfeit the benefits of its harmonization efforts, which aim to establish greater consistency in trademark laws and regulations.

4. ADVANTAGES AND CONSEQUENCES OF THE RELAXATION OF THE REPRESENTATION REQUIREMENT IN TRADEMARK REGISTRATION SYSTEMS

Removing the graphical representation requirement has significant implications for trademark registration systems. On the one hand, it allows for a wider range of non-traditional marks to be registered. This promotes innovation and competition within the market, driving businesses to think more creatively about their branding strategies and encouraging the development of more distinctive and memorable marks. On the other hand, it raises challenges in terms of how to adequately describe and represent non-visible marks such as sounds, smells, and tastes, but also it may require adjustments to existing trademark laws and regulations to ensure legal certainty for third parties.

4.1. EXPERIENCE IN THE EUROPEAN UNION

The reform to the EUTMR demonstrates a willingness to accept the widest possible variety of trademarks. Despite this increased openness of EU trademark law, certain limitations remain in practice regarding the registration of non-visual trademarks, such as those related to olfactory, taste, and tactile aspects, since trademarks must still be capable of being represented in a clear and precise manner and meeting the seven Sieckmann criteria.

In this regard, a written description could be considered the most precise way to represent non-visual trademarks. Nevertheless, it is worth noting that Article 3(2) of the EUTMR⁵² stipulates that a description can only be employed for explanatory purposes, not for the purpose of representing a trademark. Consequently, if a trademark solely comprises non-visual elements, the use of a description as a means of representation cannot be deemed sufficient under the revised EU legal provisions⁵³. This is further affirmed by Article 3(4)⁵⁴, which refers to representations of marks that diverge from the traditional ones, as well as from the 3D, color, multimedia, hologram, motion, or sound marks.

52 EUTMR. *Op. Cit.* Article 3(2): “The representation of the Trademark shall define the subject matter of the registration. Where the representation is accompanied by a description pursuant to paragraph 3(d), (e), (f)(ii), (h) or paragraph 4, such description shall accord with the representation and shall not extend its scope”.

53 See LL.M. Inês Ribeiro da Cunha and Dr. Jurgita Randakevičiūtė-Alpman. ‘*New types of marks available after the European Union Trademark Reform: An Analysis in the light of the U.S. Trademark law*’ (2019) 10(3) JIPITEC. Paragraph 47. <https://www.jipitec.eu/issues/jipitec-10-3-2019/5032/#N10876> [accessed 21 May 2023].

54 EUTMR. *Op. Cit.* Article 3(4): “Where the Trademark is not covered by any of the types listed in paragraph 3, its representation shall comply with the standards set out in paragraph 1 and may be accompanied by a description”.

The clear and precise representation of a trademark, as required by the EU law system, serves not only to determine its subject matter and nature but also enables its holders, authorities, consumers, and competitors to easily ascertain the scope of protection to eventually determine any unlawful use⁵⁵.

Therefore, regardless of the needs that may arise from sensory branding strategies, in order to ensure legal certainty and secure the interests of the stakeholders, it should not come as a surprise that the EU Trademark law was not amended in a way to include a description as an appropriate form of representation, and, consequently, making smells, tastes or tactile signs available for Trademark registration.⁵⁶

The EUIPO website provides information on the preferred types of Trademarks, the need for a description, and the accepted format for Trademark applications filed after 1 October 2017 as follows:

GRAPHICAL I. REPRESENTATION - TYPES OF MARK

Type of trade mark	Description required?	Format required
Word	No	N/A
Figurative	No	JPEG
Shape	No	JPEG OBJ STL X3D
Position	Optional (previously mandatory)	JPEG
Pattern	Optional	JPEG
Colour (single)	No	JPEG
Colour (combination)	Optional (previously mandatory)	JPEG
Sound	No	JPEG MP3 (max 2 Mb)
Motion	Optional (previously mandatory)	JPEG MP4 (max 20 Mb)
Multimedia	No	MP4 (max 20 Mb)
Hologram	No	JPEG MP4 (max 20 Mb)

Source: <https://euipo.europa.eu/ohimportal/en/elimination-of-graphical-representation-requirement>

The requirement for a description is optional for position, pattern, color combination, and motion trademarks, while it is not necessary for the remaining types.

The removal of the graphical representation requirement has allowed for the submission of MP4 and other electronic files that encompass the intended trademark. Such reform has allowed for more opportunities to obtain Trademark protection for sound and motion signs, as well as the registration of multimedia

⁵⁵ See LL.M. Inês Ribeiro da Cunha and Dr. Jurgita Randakevičiūtė-Alpman. *Op. Cit.* Paragraph 49.

⁵⁶ *Ibid.*

trademarks. However, non-visual non-traditional marks still face challenges in obtaining protection due to current technological limitations. Ongoing technological developments may allow for the representation of more types of Trademarks in the future, potentially leading to their registration under the current EU legal framework.

4.2. REMOVAL OF THE VISIBILITY REQUIREMENT IN CHINA

The removal of the visibility requirement in China has resulted in at least one benefit for trademark registration, namely the ability to register sounds that were previously not protected under Chinese law. However, despite the relaxation of the visibility requirement, the graphical representation requirement still remains. This means that while sounds can now be registered, other non-traditional trademarks such as smells, tastes, and tactile marks may still face obstacles in obtaining registration due to the requirement for graphical representation, but most importantly because they are not included in the exhaustive list of registrable subject matter in the Chinese Trademark law.

Trademark registration in China follows the graphic representation regime, which means that sound trademarks are primarily registered through graphic representation, using stave or numbered musical notations in combination with notes in words. For a sound trademark that could not be explained in stave or numbered musical notations, descriptive representation could be made in words. On the whole, the sound trademark registration in China is generally by graphic representation, with descriptive representation as an exception⁵⁷.

Article 13 of the Regulations for the Implementation of the Trademark Law of the People's Republic of China⁵⁸ outlines the formal requirements for sound trademark registration in China. The law requires a statement to be made in the application, a qualified sound sample, and a description of the sound to be submitted. The description of the sound should use stave or numbered musical notations with all necessary elements that determine that music (eg, tones and beats) in combination with notes in words. If the sound cannot be described by stave or

⁵⁷ See Song Jianbao. *'Registration Formal Requirements for Sound Trademarks in China, US, and EU'* (China Intellectual Property Magazine, 2019) <http://www.chinaipmagazine.com/en/journal-show.asp?id=1686> [accessed 21 May 2023].

⁵⁸ Regulations for the Implementation of the Trademark Law of the People's Republic of China (Promulgated by Decree No. 358 of the State Council of the People's Republic of China on August 3, 2002, revised and promulgated by Decree No. 651 of the State Council of the People's Republic of China on April 29, 2014, and effective as of May 1, 2014). Chapter I: General Provisions. Article 13: "(...) Where an application is filed for registration of sound as a trademark, a statement shall be made in the application, a qualified sound sample and a description of the sound for registration as the trademark shall be submitted, and the method of use of the trademark shall be indicated. The description of the sound trademark shall use stave or numbered musical notations of the sound in combination with notes in words; where the sound is unable to be described by stave or numbered musical notations, it shall be described in words; the description of the trademark shall be in conformity with the sound sample. (...)".

numbered musical notations, it should be described in words, but the description must conform to the sound sample. Therefore, the standard requirement for sound trademark registration in China is primarily through graphic representation, with descriptive representation being the exception.

The first sound mark in China was registered in 2016 in the name of China Radio International, following the revision of the Trademark Law in 2013. It should, however, be highlighted that the inherent distinctiveness of sound marks in China tends to be low. As a result, applicants must first use the marks to acquire a certain level of distinctiveness prior to filing for trademark protection. Hence, the distinctiveness of a sound trademark emerges as a crucial factor determining its eligibility for registration⁵⁹.

GRAPHICAL 2. OPENING SONG OF CHINA RADIO INTERNATIONAL
CHINESE TRADEMARK APPLICATION NO. 1450361



该声音商标是中国国际广播电台广播节目的开始曲，全长 40 秒，共 18 小节，四分之二拍慢板节奏，G 大调和 C 大调交替转换。前四小节为整段声音商标前奏部分，曲调为 G 大调；中间 11 小节为整段声音商标主题部分，曲调为 C 大调，其中第十二、十三小节播音员报出“中国国际广播电台”的呼号后音乐延续两小节，主题部分结束；最后三小节钢琴再次奏响主题音乐，转调回 G 大调，该声音商标结束。

Source: wcjs.sbj.cnipa.gov.cn/

Finally, while the Chinese Trademark Law specifically lists the types of trademarks that can be registered, the famous ‘Red Sole Trademark case’, which involved a single color / position trademark not defined in the Chinese Trademark Law, demonstrates how case law has expanded the interpretation of Article 8 and allowed for the use of new elements as trademarks, promoting innovation and creativity in branding and strengthening intellectual property protection in China.

⁵⁹ See Arthur Wu. ‘Protection of non-traditional trademarks lags behind in China’ (World Trademark Review, 2019) <https://www.worldtrademarkreview.com/article/protection-non-traditional-trademarks-lags-behind-in-china> [accessed 21 May 2023].

See Sherry Meng. ‘The Status Quo of the Sound Trademarks in China’ (Linda Liu & Partners, 2022) https://www.lindapatent.com/en/info/insights_trademark/2022/0215/1459.html [accessed 24 May 2023].

The Chinese Trademark Office initially rejected Christian Louboutin's International trademark application⁶⁰ for his renowned red sole, deeming it devoid of distinctive character. However, during the administrative litigation process, the Beijing IP Court argued that the mark should not be assessed as a device mark, but rather as a 3D mark. This classification considered the dotted line outlining the shape of the high-heeled shoes and the application of the red color to the shoe's sole. Consequently, the Court instructed the Trademark Office in China to reassess the mark's distinctiveness in line with the actual type of the trademark.

Despite this ruling, both the applicant and the Trademark Office remained unsatisfied and filed an appeal before the Beijing High Court. The High Court ruled that the mark did not qualify as a three-dimensional mark and, as a result, the examination should be based on the information published by WIPO, defining it as a single-color mark with a specified placement.

GRAPHICAL 3. COLOR RED (PANTONE NO. 18.1663TP)
APPLIED TO THE SOLE OF A SHOE AS SHOWN IN THE REPRESENTATION



Note: the outline of the shoe is not part of the mark but is intended only to show the placement of the mark.

Source: <https://www3.wipo.int/madrid/monitor/en/#>

Unconvinced by the High Court's decision, the Trademark Office decided to appeal before the Supreme People's Court, arguing that Article 8 of the Chinese Trademark Law prohibited the registration of single-color marks since they are not explicitly listed. However, the Supreme Court upheld the Beijing High Court's decision, clarifying that the list of eligible elements is not exclusive, and elements not explicitly excluded by the Trademark Law could also be registered⁶¹.

⁶⁰ WIPO International Registration n.º 1031242.

⁶¹ *Christian Louboutin v National Intellectual Property Administration*. Supreme People's Court of the People's Republic of China (Administrative Division), Decision of 24 December 2019.

This case not only sparked a debate about the potential to register other types of non-traditional trademarks, but also stimulated a more expansive interpretation of the Chinese Trademark Law, rather than viewing it as a closed list of subject matter.

CONCLUSION

The EU trademark reform has allowed the registration of sound and motion signs by accepting digital music files as an alternative to musical notation, or a video file instead of sequential static images to depict motion. However, non-visual marks are still not registrable due to the current technological limitations. As technological advancements continue, the registration of these non-visual marks may become possible in the future.

On the other hand, the removal of the visibility requirement in China also poses some challenges, such as difficulties in protecting non-traditional marks due to the remaining requirement for graphical representation. As such, it remains to be seen how the new proposed revision released for public comment this year will impact the future of trademark registration in the country.

The relaxation of the representation requirement in both the EU and China has brought about significant benefits, including the ability to register new non-traditional trademarks in each jurisdiction. However, it has also led to challenges in the interpretation and examination of these marks. Overall, the relaxation of the representation requirement has its advantages and represents a step forward in adapting to the changing nature of trademarks and in protecting them in the modern world.

5. RECOMMENDATIONS TO AMEND THE ANDEAN LEGISLATION

The previous analysis revealed that the requirement for graphical representation presents challenges, especially for the registration of non-visual trademarks. These obstacles encompass sensory perception limitations, as purely visual methods may fail to capture and fully represent multi-sensory experiences derived from trademarks such as scents. They also include issues concerning the insufficient provision of precise information about the subject matter—for instance, natural sounds that can be transcribed musically—and technological constraints, as traditional forms of graphical representation may not keep pace with technological advancements, which could potentially facilitate new types of trademarks in the future.

Furthermore, the analysis highlighted the lack of clarity within the existing Andean framework regarding whether graphical representation is an integral aspect of the conceptual meaning of a trademark, leaving room for different interpretations—those who view it as an essential component, and those who see it merely as a

procedural requirement. However, the graphical reproduction of the mark remains a prerequisite for achieving registration in any of the Andean countries.

5.1. REMOVING “GRAPHICAL REPRESENTATION”

To provide conclusive clarity for the Andean trademark framework, it would be beneficial to eliminate the grammatical limit of the term ‘graphical’ from mark representations. By removing this constraint, the Andean Community can establish a more inclusive framework that encompasses diverse forms of representation. This change would foster greater accessibility and harmonization with the latest international provisions, such as the Singapore Treaty, within the trademark registration process.

Simultaneously, this decisive action could alleviate the burden for users of the trademark system, as they would no longer need to submit a description or a graphical depiction of the mark alongside digital files or any other potential innovative representation of the sign. It would also restore the safeguard functions of the general registration requirements, minimizing the risk of representations that may deceive or confuse consumers. By opening the door to a wider variety of representation formats, the registration process can offer a more accurate and comprehensive depiction of non-traditional trademarks. For instance, a digital file reproducing a sound could suffice, eliminating the need for an additional musical transcription; or a tactile mark might only require a sample and description without the need for a photograph or drawing.

5.2. ESTABLISHING A THRESHOLD FOR THE REPRESENTATION OF THE SIGN

The requirement for ‘representation’ can remain ambiguous in the absence of well-defined boundaries. Without explicit legal definitions and guidelines, the term ‘representation’ can be variously interpreted by Courts and legal practitioners, potentially leading to disputes and legal uncertainty. Hence, to ensure the effective operation of the system, it is recommended that the Andean regime adopts the approach taken by the European Union. This would entail allowing for the representation of trademarks using means that are clear, precise, complete, intelligible, durable, and objective, and that can be perceived by any of the five human senses.

This suggested solution aligns with the latest interpretation by the TJCA regarding tactile trademarks⁶², which recognizes the admissibility of non-graphic sign representations when they are better suited for identifying the trademark.

Defining boundaries for the representation requirement plays a crucial role in providing legal certainty to all parties involved and contributes to the overall

⁶² Court of Justice of the Andean Community (TJCA). Preliminary Interpretation for Process n.º 242-IP-2015.

effectiveness of the registration system. Clear and well-defined criteria for representation could simplify the application process, making it more expeditious. With clear guidelines about the representation, applicants can ensure their filings meet the requirements, reducing the chance of delays caused by insufficient or unclear representations. Similarly, for the trademark examiners, having defined criteria could streamline the evaluation process, leading to faster decisions.

Ensuring precision and clarity in the representation, regardless of whether it's graphical or not, enables consumers, competitors, and authorities to accurately identify the sign and understand its scope of protection. This precision and clarity are not only crucial in facilitating proper enforcement of trademark rights, but also in fostering a reliable trademark registration process, thereby reducing the likelihood of misinterpretations. Moreover, providing an objective and durable representation can address potential ambiguities, thereby creating a solid foundation for a robust trademark registration system.

CONCLUSION

The recommendations, which aim to address the limitations of the existing framework, may potentially be incorporated into the Article 134 of the Andean Decision 486 as follows:

For the purposes of these Provisions, any sign capable of distinguishing goods or services on the market shall constitute a mark. *Signs that are susceptible of clear, precise, self-contained, easily accessible, intelligible, durable and objective representation shall be registered as marks.* The nature of the product or service to which a mark is to be affixed shall in no case be an obstacle to the registration thereof.

This updated provision emphasizes the importance of adhering to the Sieckmann criteria in the representation of trademarks, regardless of their form, and incorporates them as integral aspects of the trademark's conceptual meaning. Simultaneously, it offers no room for judicial interpretation, thus minimizing ambiguity and enhancing legal certainty for applicants. Hence, the inclusion of these criteria in the Andean legislative framework in this manner is of utmost significance. Furthermore, the revised language reflects the growing need for adaptability and accessibility in the evolving landscape of trademark protection.

GENERAL CONCLUSION

The necessity of graphical representation in trademark registration and its capacity to fulfill the purpose of trademarks have been topics of debate due to the emergence of new technology and non-traditional marks. Historically, graphical representation was seen as vital for accurate identification and protection of trademarks. However,

recent developments in trademark law and advancements in technology have triggered reconsideration of its continued relevance.

Removing the graphical representation from trademark registration requirements can have both benefits and consequences for the trademark system and its users. On the positive side, it can lead to increased flexibility and adaptability in the registration process, allowing for a broader range of non-traditional marks to be recognized and protected. This can foster innovation and provide opportunities for businesses to obtain trademark rights for unconventional signs such as scents, holograms, or textures.

Additionally, removing the requirement can reduce barriers to entry and streamline the registration process, potentially making it more accessible and cost-effective for businesses. It can also align trademark law with advancements in technology, allowing for the representation of trademarks in various digital and non-visual formats.

However, there are potential consequences to consider. The removal of graphical representation may result in challenges related to the identification, comparison, and enforcement of trademarks. With a broader range of representations, it can become more difficult to determine similarities and potential infringements, potentially leading to an increase in trademark conflicts and disputes. This can pose additional burdens on businesses and the legal system, requiring more comprehensive search and examination processes to maintain the integrity of trademark rights.

Ultimately, the benefits and consequences of removing the graphical representation depend on how well the system adapts to these changes. Clear guidelines and standards should be established to ensure that the representation of trademarks, whether visual or non-visual, remains precise, clear, and capable of fulfilling the primary functions of trademarks. Striking the right balance between adaptability and trademark clarity will be essential to maintain the integrity and effectiveness of the trademark system for all stakeholders.

BIBLIOGRAPHY

LEGISLATION

Agreement on Trade-Related Aspects of Intellectual Property Rights (adopted 15 April 1994, entered into force 1 January 1995).

Andean Decision No. 486 Establishing the Common Industrial Property Regime (adopted 14 September 2000, entered into force 1 December 2000).

Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European

Union Trademark, and repealing Implementing Regulation (EU) 2017/1431 (EUTMIR).

Paris Convention for the Protection of Industrial Property (adopted 20 March 1883, entered into force 7 July 1884).

Regulation (EU) 2017/1001 of the European Parliament and the Council of 14 June 2017 on the European Union Trademark [2017] OJ L154/1 (entered into force 6 July 2017).

Regulations for the Implementation of the Trademark Law of the People's Republic of China (Promulgated by Decree No. 358 of the State Council of the People's Republic of China on August 3, 2002, revised and promulgated by Decree No. 651 of the State Council of the People's Republic of China on April 29, 2014, and effective as of May 1, 2014).

Singapore Treaty on the Law of Trademarks (adopted 27 March 2006, entered into force 16 March 2009).

Trademark Law of the People's Republic of China (as amended up to Decision of August 30, 2013, of the Standing Committee of National People's Congress on Amendments to the Trademark Law of the People's Republic of China).

GUIDELINES

Andean Community and IP Key Latin America by EUIPO. '*Compendium of Andean Resolutions on Trademarks*'. 2021.

Court of Justice of the Andean Community (TJCA). '*Index of Clarified Act Criteria*'. 2023.

European Union Intellectual Property Network. '*Common Communication. New Types of Marks: Examination of Formal Requirements And Grounds For Refusal*'. 2021.

European Union Intellectual Property Office. '*Guidelines for examination of European Union Trademarks*'. 2023.

Superintendence of Industry and Commerce of the Republic of Colombia. Distinctive Signs Office. '*Guidelines for Trademark Registration*'. 2022.

World Intellectual Property Office. Standing Committee on the Law of Trademarks, Industrial Designs And Geographical Indications. '*Methods of Representation and Description of New Types of Marks*'. Seventeenth Session, 2007.

CASE LAW

Christian Louboutin v. National Intellectual Property Administration. Supreme People's Court of the People's Republic of China (Administrative Division), Decision of 24 December 2019.

Court of Justice of the Andean Community (TJCA) Preliminary Interpretation for Process n.º 36-IP-99.

- Court of Justice of the Andean Community (TJCA). Preliminary Interpretation for Process n.º 38-IP-2008.
- Court of Justice of the Andean Community (TJCA). Preliminary Interpretation for Process n.º 70-IP-2013.
- Court of Justice of the Andean Community (TJCA). Preliminary Interpretation for Process n.º 12-IP-2014.
- Court of Justice of the Andean Community (TJCA). Preliminary Interpretation for Process n.º 242-IP-2015.
- Court of Justice of the Andean Community (TJCA). Preliminary Interpretation for Process n.º 421-IP-2019.
- Court of Justice of the Andean Community (TJCA) Preliminary Interpretation for Process n.º 120-IP-2021.
- Court of Justice of the Andean Community (TJCA), Preliminary Interpretation for Process 344-IP-2022.
- European Union Intellectual Property Office. Appeal R 120/2001-2 of August 4, 2003. Trademark Application n.º 001452853.
- European Union Intellectual Property Office. Appeal R 2588/2014-2 of May 27, 2015. Trademark Application n.º 012112462.
- Court of Justice of the European Union. Ralf Sieckmann v. Deutsches Patent und Markenamt. (2002) Case C-273/00.
- Court of Justice of the European Union. Levola Hengelo BV v. Smilde Foods BV. (2018) Case C-310/17.
- Court of Justice of the European Union-Eden SARL v. OHIM (2005) Case T-305/04.
- Superintendence of Industry and Commerce of the Republic of Colombia. Distinctive Signs Office. Resolution n.º 11956 of April 30, 2007. Trademark Application No. 05047635.
- Superintendence of Industry and Commerce. Distinctive Signs Office. Resolution No. 90504 of December 22, 2007. Trademark Application n.º 15045738.
- Superintendence of Industry and Commerce of the Republic of Colombia. Distinctive Signs Office. Resolution n.º 90504 of December 22, 2007. Trademark Application n.º SD2017/0012803.

BOOKS

- Croze, D. 'Making a Large Universe Visually Perceptible: The Development of Non-Traditional Trademarks in WIPO Treaties', in Irene Calboli, and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford, 2018; online edn, Oxford Academic, 21 Feb. 2019), <https://doi.org/10.1093/oso/9780198826576.003.0002>.

- Guerrero Gaitán, M. 'The New Trademark Law. Perspective in Colombia, the United States and the European Union' (Universidad Externado de Colombia, 2016).
- Haochen, S. 'Protecting Non-Traditional Trademarks in China: New Opportunities and Challenges', in Irene Calboli, and Martin Senftleben (eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives* (Oxford, 2018; online edn, Oxford Academic, 21 Feb. 2019), <https://doi.org/10.1093/oso/9780198826576.003.0010>.
- Tritton, G. and Davis, R. 'Intellectual Property in Europe' (London, Sweet & Maxwell, 2018).

ACADEMIC PUBLICATIONS AND ARTICLES

- Adekola, T. 'Abolition of Graphical Representation in EU Trademark Directive: Should Countries with Similar Provisions Follow EU's Footsteps?' (2020). *Journal of Intellectual Property Rights*. https://www.researchgate.net/publication/339952926_Abolition_of_Graphical_Representation_in_EU_Trademark_Directive_Should_Countries_with_Similar_Provisions_Follow_EU%27s_Footsteps.
- Bolte, J. 'The Removal of the Requirement for Graphical Representation of EU Trademarks The Impact of the Amending Trademark Regulation' (2016) Örebro Universitet. <http://oru.diva-portal.org/smash/get/diva2:1072679/FULLTEXT01.pdf>.
- Cure Villa, V. 'Graphic representation of olfactory marks in Colombia in the light of the Decision 486 of 2000 of the Andean Community Commission' (2020) Universidad de los Andes. *Anuario de Derecho Privado*. <https://anuarioderechoprivado.uniandes.edu.co/images/pdfs/anuario2/3Curetesis.pdf>.
- Danciu, V. 'The scent of a trademark: removal of graphic representability requirement'. (2019) Dennemeyer, The IP Group. <https://www.dennemeyer.com/ip-blog/news/the-scent-of-a-trademark-removal-of-graphic-representability-requirement/>.
- Demcak, I. 'Guide to non-traditional trademarks in the EU and the US: definitions, laws, and examples'. (2023) Trama TM. <https://www.tramatm.com/blog/category/legal/guide-to-non-traditional-trademarks-in-the-eu-and-the-us-definitions-laws>.
- Escobedo, C. 'Peru receives first two post-treaty applications to register motion marks' (2019) *World Trademark Review*. <https://www.worldtrademarkreview.com/article/peru-receives-first-two-post-treaty-applications-register-motion-marks>.
- García Enríquez, J.R. 'The necessity of regulating non-traditional trademarks in Peru' (2021) Universidad Continental. https://repositorio.continental.edu.pe/bitstream/20.500.12394/10492/2/IV_FDE_312_TE_Garcia_Enriquez_2021.pdf.

- Guerrero Gaitán, M. 'Interpretation of the Andean Court of Justice imposes the presentation of physical samples for the registration of tactile trademarks' (2015) Universidad Externado de Colombia. <https://propintel.uexternado.edu.co/en/interpretacion-del-tribunal-andino-de-justicia-impone-la-presentacion-de-muestras-fisicas-para-el-registro-de-marcas-tactiles/>.
- GRUR International. 'Protection of Louboutin's Red Sole Trademark' (2020) Volume 69, Issue 10. <https://doi.org/10.1093/grurint/ikaa127>.
- Höpferger, M. 'Non-Traditional Marks – Singapore Treaty Enters into Force' (2009) WIPO Magazine. https://www.wipo.int/wipo_magazine/en/2009/01/article_0002.html.
- Huld, A. 'Amendments to China Trademark Law: Improving IP Use and Protection' (2019) China Briefing. Dezan Shira & Associates. <https://www.china-briefing.com/news/amendments-to-china-trademark-law-improving-ip-use-and-protection/>.
- Jianbao, S. 'Registration Formal Requirements for Sound Trademarks in China, US, and EU' (2019) China Intellectual Property Magazine. <http://www.chinaipmagazine.com/en/journal-show.asp?id=1686>.
- Lockhart, B. and Porter, B. 'The Dating Game: Tracking the Hobble-Skirt Coca-Cola Bottle'. (2010) Bottles and Extras. <https://sha.org/bottle/pdf/files/coca-cola.pdf>.
- Meng, S. 'The Status Quo of the Sound Trademarks in China'. (2021) Linda Liu & Partners. https://www.lindapatent.com/en/info/insights_trademark/2022/0215/1459.html.
- Pereira Cabral, J. 'The elimination of the "graphical representation" requirement and its effect on non-traditional EU trademarks'. (2020) Inventa. <https://inventa.com/en/news/article/564/the-elimination-of-the-graphical-representation-requirement-and-its-effect-on-non-traditional-eu-trademarks>.
- Ribeiro da Cunha, I. and Randakevičiūtė-Alpman, J. 'New types of marks available after the European Union Trademark Reform: An Analysis in the light of the U.S. Trademark law' (2019) 10(3) JIPITEC. <https://www.jipitec.eu/issues/jipitec-10-3-2019/5032/#N10876>.
- Scrimenti, B.J. 'Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around The World' (2019) Pattishall Insights. <https://www.pattishall.com/pdf/2019-10%20Pattishall%20Insights.pdf>.
- Shuju, F. 'Proceedings of the 2021 International Conference on Enterprise Management and Economic Development: New Challenge on Intellectual Property: Smell Trademark'. (2021) Volume 178. Atlantis Press - Advances in Economics, Business and Management Research, <https://www.atlantispress.com/article/125957360.pdf>.
- Starke (Beijing) Intellectual Property Co. Ltd. 'Latest News about Non-Traditional Trademarks in China' (2019). <https://www.starke-ip.com/en/news/latest-news-about-non-traditional-trademarks-in-china>.

- Torres Montenegro, M.E. 'Exclusion of the graphic representation requirement in the Andean Community of Nations' trademark regime'. (2021) Vol 8. No 2. Universidad San Francisco de Quito. USFQ Law Review. <https://revistas.usfq.edu.ec/index.php/lawreview/article/download/2316/2875?inline=1#fn12>.
- World Intellectual Property Office. 'Existing Methods of Representation and Description of New Types of Marks or Non-Traditional Marks'. https://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/au_2.pdf.
- World Trade Organization. 'A Handbook on the WTO TRIPS Agreement' (2020) Cambridge University Press. https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/modules3_e.pdf.
- Wininger, A. R. 'China's Supreme Court Rules in Favor of Christian Louboutin's Red Sole Trademark' (2020) Schwegman Lundberg & Woessner. <https://www.slwip.com/resources/chinas-supreme-court-rules-in-favor-of-christian-louboutins-red-sole-trademark/>.
- Wu, A. 'Protection of non-traditional trademarks lags behind in China' (2019) World Trademark Review. <https://www.worldtrademarkreview.com/article/protection-non-traditional-trademarks-lags-behind-in-china>.