

DISTINCTIVENESS FOR NON-VERBAL TRADEMARKS – THE CZECH, EUROPEAN AND AMERICAN LEGAL SYSTEMS COMPARISON

Mgr. Martina Zdvihalova, Ph.D.¹

Introduction

The submitted paper² covers distinctiveness for non-verbal trademarks across the Czech, European and American legal systems. The main goal of this article subsumes the interpretation of trademark institute with emphasis on key terms concerning its distinctiveness which comprise a distinctive legal capacity, inherent distinctiveness, distinctiveness acquired through use in business relation, relevant public or average consumer, and means of providing evidence on acquired distinctiveness. When interpreting the key term distinctiveness, authoress applies the method of extensive interpretation according to the general theory of law.

First, it is necessary to recall the fundamental difference between the legislation in the Czech Republic, hereinafter “CR”, the European Union, hereinafter “EU”, and the United States of America, hereinafter “USA”. The rights arising from trademark institute in the CR and EU originate exclusively by registration in relevant trademarks registers, but the rights arising from trademark institute in the US originate by its actual use because the American legal

¹ Authoress is a graduate of Ph.D. studies at the Metropolitan University Prague, in the field of International and Regional Relations in Industrial Property. Concurrently she acts as a patent attorney in the field of designation rights and industrial designs and at the same time as a European Union trade mark and Community design representative.

² The submitted contribution is the part of an internal grant of the Metropolitan University Prague, No. C011-35.

system is based on the so-called common law which has been developed on the basis of judicially created law system of states of federation.

To obtain the protection of used sign, it is not necessary to register trademark, but if this is done, the trademark gives a higher degree of protection, especially with regard to the enforcement of trademark rights. In the US, there coexists dual legislation – a federal and state – the state legislation is constituted by laws of individual states based on common law. It's very similar to the European Union trademark, hereinafter “EUTM”, when next to EU legislation relating to the EUTM, at the same time, there is the legislation at national level in each Member State. The subject of the submitted study is the analysis of the relevant provisions of the US legislation at the federal level.

American Trademark Act, hereinafter “Lanham Act”, has been enacted in 1946 and established the procedure for federal registration of trademarks. If a sign, respectively trademark³, meets certain qualifications, it can be listed on the Principal Register which affords its many benefits. Other trademarks can be listed on the Supplemental Register which exists to allow trademarks not otherwise registrable in the USA to be registered from foreign countries that require home-country registration first, and to allow registration for descriptive marks not distinctive enough to qualify for the Principal Register. The registration is not mandatory to receive trademark protection, as authoress mentioned above, but federal trademarks in the Principal Register receive significantly stronger protection than unregistered trademarks.⁴

³ Explanatory Note: The sign is becoming the trademark after its registration in trademark register.

⁴ Dudnikov, Karen and Meadors, Michael. The History of Trademark Law. In: *Tabberone Trademark Page*. [Online]. [cit. 2015-06-03]. Dostupné z WWW: <http://www.tabberone.com/Trademarks/TrademarkLaw/History/History.shtml>.

1 Trademark definition

1.1 Definition of the trademark institute according to the legal code of the CR

The trademark institute is defined in the Act No. 441/2003 Coll. of 3 December 2003 on Trademarks and on amendments to Act No. 6/2002 Coll. on judgements, judges, assessors and state judgement administration and on amendments to some other Acts (Act on Courts and judges), in the wording of later regulations, hereinafter “Czech Trademark Act”.

Section 1 of the above mentioned Czech Trademark Act determines: “Under the terms of this Act, a trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, colors, designs, letters, numerals, the shape of goods or their packaging, provided that such sign is capable of distinguishing goods or services of one undertaking from those of another undertaking.”⁵ This section is in full compliance with the Article 2 of the Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks which aims to approximate the laws of the Member States relating to trademarks for the functioning of the EU internal market, notably to allow the free movement of goods and services. Above cited legal sentence is considered for so-called positive definition of the trademark. It should be understood as demonstrative definition of kinds of designations capable of public protection under the legislation.

In its conclusions of 25 May 2010 on the future revision of the trademark system in the EU, the Council called on the Commission to present proposals for the revision of Regulation (EC) No. 207/2009 and Directive 2008/95/EC. The revision of that Directive should include measures to make it more consistent with Regulation (EC) No. 207/2009, which would thus reduce the areas of divergence within the trademark system in Europe as a whole, while maintaining national trademark protection as an attractive option for applicants. In this context the complementary relationship between the EU trademark system and national trademark systems should be ensured.⁶

⁵ Act No. 441/2003 Coll. of 3 December 2003 on Trademarks and on amendments to Act No. 6/2002 Coll. on judgements, judges, assessors and state judgement administration and on amendments to some other Acts (Act on Courts and judges), in the wording of later regulations.

⁶ Desiderata of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (recast version).

The Commission concluded in its communication of 24 May 2011 entitled “A single market for intellectual property rights” that in order to meet increased demands from stakeholders for faster, higher quality, more streamlined trademark registration systems, which are also more consistent, user friendly, publicly accessible and technologically up to date, there is a necessity to modernize the trademark system in the Union as a whole and adapt it to the internet era.⁷

Directive (EU) 2015/2436 of the European Parliament and of the Council to approximate the laws of the Member States relating to trademarks has been signed in Strasbourg on 16 December 2015, hereinafter “Directive 2015/2436”. Cited Directive will repeal above mentioned Directive 2008/95/EC with the effect from 15 January 2019. This creates an implementation period when all European Union Member States have an obligation to implement the Directive 2015/2436 into their legal systems.

Cited Directive 2015/2436 in Article 3, which defines signs of which trademark may consist, expressly specifies that a trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings; and being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.⁸ To the cited Article it should further be noted that the above conditions must be met cumulatively.

Desiderata to the cited Article states that it is necessary to list examples of signs which are capable of constituting a trademark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfil the objectives of the registration system for trademarks, namely to ensure legal certainty and sound administration, it is also essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. A sign should therefore be permitted to be represented in any

⁷ Ibid.

⁸ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (recast version).

appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.⁹

New Directive 2015/2436 has amended the general definition of trademarks substantially – it does not require the requirement of graphical representation of the sign applied for. The above mentioned change will bring breakthrough in non-traditional trademarks registration undoubtedly. Directive 2015/2436 further as the condition for designation registration declares that the sign must be represented on the register in a manner which enables the competent authorities and public to determine the clear and precise subject matter of the protection afforded to its proprietor. That condition replaces the original requirement of graphical representation of sign, and at the same time gives applicant the freedom in the way of sign submitting to trademark authority, but only provided that such method allows the competent authority and the relevant public to identify clearly and precisely the subject of the designation protection. In my opinion, stated change will be difficult, particularly technically, for trademark offices. They will have to adjust registers and gazettes of trademarks to new manners of submitting of designations.

1.2 Definition of the trademark institute according to the legal code of the EU

Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No. 207/2009 on the Community trademark and Commission Regulation (EC) No. 2868/95 implementing Council Regulation (EC) No. 40/94 on the Community trademark, and repealing Commission Regulation (EC) No. 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and Designs), hereinafter “Regulation”, which has entered into force on 23 March 2016, reforms system of EUTM, before reform called Community trademark.

The mentioned Regulation, which is binding in its entirety and directly applicable in all Member States, defines EUTM as united legal instrument valid throughout the EU. It is similar as federal Lanham Act which demarcates unitary federal protection of trademarks throughout the USA.

⁹ Desiderata of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (recast version).

Article 4 of above cited Regulation defines signs, of which EUTM may consist, when expressly states that EUTM may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings; and being represented on the register of EUTM 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.¹⁰

Above cited Article 4 of the Regulation is completely identical, including the above changes, with the wording of Article 3 of the reformed Directive 2015/2436.

Desiderata to the cited Article states that in order to allow for more flexibility while also ensuring greater legal certainty with regard to the means of representation of trademarks, the requirement of graphic representability should be deleted from the definition of an EUTM. A sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.¹¹

For comparison, previous Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trademark in Article 4 explicitly determined that Community trademark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.¹²

The reformed Regulation has amended the general definition of EUTM substantially when it does not require the requirement of graphical representation of the sign applied for.

¹⁰ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No. 207/2009 on the Community trademark and Commission Regulation (EC) No. 2868/95 implementing Council Regulation (EC) No. 40/94 on the Community trademark, and repealing Commission Regulation (EC) No. 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and Designs).

¹¹ Desiderata of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No. 207/2009 on the Community trademark and Commission Regulation (EC) No. 2868/95 implementing Council Regulation (EC) No. 40/94 on the Community trademark, and repealing Commission Regulation (EC) No. 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and Designs).

¹² Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trademark (codified version of Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trademark).

1.3 Definition of the trademark institute according to the American legal code

Definition of federal trademark has been stated in Trademark Act of 1946, as amended, Lanham Act, Title X – Construction and Definitions, § 45 (15 U.S.C. § 1127), which declares that the term trademark includes any word, name, symbol, or device, or any combination thereof to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”¹³

The Lanham Act also expressly defines term service mark as follows: “The term service mark means any word, name, symbol, or device, or any combination thereof to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor”. The Lanham Act also states that trademark and service mark must be used by a person, or which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter.¹⁴

From the above cited trademarks definitions authoress concludes differences in the overall concept of trademark in the USA in comparison with the EU and CR. The fundamental difference authoress sees in the fact that in the USA the focus is on the actual use of trademark at the time of its registration, as the federal trademark application may be made under its previous interstate use in commerce, respectively the consequences of which are reflected in another country, or on the basis affidavit of intent in good faith to use the mark in commerce in the near future, and subsequently to prove genuine use. This is the substantial difference to the EU and Czech legislation. The Czech and European examiners do not deal with the use of the sign if the designation has a sufficient degree of distinctiveness. The European and Czech legislation is in comparison with the American more benevolent to applicants in the sense that in the case that the sign meets the absolute grounds for

¹³ U.S. Trademark Law. Federal Statutes. Trademark Act of 1946, as amended. Title X – Construction and Definitions, § 45 (15 U.S.C. § 1127).

¹⁴ U.S. Trademark Law. Federal Statutes. Trademark Act of 1946, as amended. Title X – Construction and Definitions, § 45 (15 U.S.C. § 1127).

registration, trademark owner can begin to use his trademark within a period of five years from its registration.

From the trademarks definitions stated above simultaneously authoress concludes that the legislation of the CR and EU before above analyzed European reform was stricter in respect of signs of which a trademark may consist because the Lanham Act does not contain graphical requirement of sign as the fundamental condition for registration of sign in the trademark register. Therefore, for example, sound or olfactory trademarks in the USA are eligible for the registration, but even in these cases applicant must prove their use. However, also in Europe, there, for example, sound trademarks have been registered before reform, mainly based on the case law. The Court of Justice of the European Union, hereinafter “CJEU”, has decided that these kinds of signs cannot be automatically excluded from the registration, and it is particularly necessary to examine their distinctiveness. The Appeal Board of OHIM in its decision has recognized protection of the olfactory trademark – “The smell of fresh cut grass”. In the CR, there are registered no sound, hologram, olfactory, taste, position, tactile, light, motion or gesture trademarks.

2 Distinctiveness definition

The term distinctiveness can be found in all legal codes which subsume the institute of trademark. On all territories but its interpretation and application causes issues and disputes, not only in doctrine, but especially in practice. Common cause of issues and disputes related to the distinctiveness is the difficulty in determining whether the sign in a particular case has the distinctive character in order to be protected as the trademark.¹⁵

Institute of the distinctiveness is not expressly defined in the above mentioned legal systems. The Czech Trademark Act in Section 4 (b) only states that a sign which is devoid of any distinctive character shall not be registered. Also the Regulation in Article 7 paragraph 1 (b) determines that trademarks which are devoid of any distinctive character shall not be registered. In my subjective opinion, the term distinctiveness can be inferred by extensive interpretation from Section 1 of the Czech Trademark Act, and at the same time from Article 4 Regulation. The distinctiveness or distinctive capability, in my opinion, therefore means the capability to distinguish the goods or services of one person from those of another person.

Similarly in the US legislation, where the Lanham Act in Section 2 (15 U.S.C. § 1052), Title I – The Principal Register, analogously states that trademark by which the goods of the applicant may not be distinguished from the goods of others shall be refused registration on the principal register on account of its nature. It is the same case like authoress has said above – the term distinctiveness can be inferred by extensive interpretation from Section 45 (15 U.S.C. § 1127), Title X - Constructions and Definitions, Lanham Act. The analyzed term therefore exactly means the capability to identify and distinguish the goods of one person, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown, or to identify and distinguish the services of one person, including a unique service, from the services of others in the case of service mark.

In all above analyzed legal systems we can find two types of the distinctiveness – an inherent distinctiveness and a distinctiveness acquired through use in business relation. The inherent distinctiveness means that signification selected to serve as the trademark is distinctive as such. On the other hand, also signification not having the inherent distinctiveness can be

¹⁵ ČERMÁK, Karel: Rozlišovací způsobilost ochranné známky. [The distinctiveness of trademark]. *Průmyslové vlastnictví*. No. 1-2, 2000, p. 22-23.

registered in the trademark register, provided that the applicant establishes that sign acquired distinctiveness through use in business relation prior to the registration in the trademark register. This type of the distinctiveness is in the Czech and European practice also known as a trademark typicalness” or recognition – it will be analyzed as follows.

This condition is shown mainly in Section 5 Czech Trademark Act which states that a sign which is devoid of any distinctive character, a sign which consists exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of goods or of rendering of services, or other characteristics of goods or services, and a sign which consists exclusively of signs or indications which have become customary in the current language or in bona fide and established practices of the trade can be registered in the trademark register if the applicant proves that before registration of the sign in the register such a sign has acquired distinctive character in relation to goods or services of the applicant for which the registration is requested in consequence of use of the sign in the trade.¹⁶

Similar provision is contained in Article 7 paragraph 3 Regulation which declares that paragraph 1 (b), (c) and (d) shall not apply if the trademark has become distinctive in relation to the goods or services, for which registration is requested, in consequence of the use which has been made of it. Cited letters (b), (c), (d) subsume trademarks which are devoid of any distinctive character, trademarks which consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service, and trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.¹⁷

Also the Lanham Act declares that if the proposed trademark or service mark is not inherently distinctive it may be registered on the Principal Register only upon proof of acquired distinctiveness, or secondary meaning, that is proof that it has become distinctive as applied to

¹⁶ Act No. 441/2003 Coll. of 3 December 2003 on Trademarks and on amendments to Act No. 6/2002 Coll. on judgements, judges, assessors and state judgement administration and on amendments to some other Acts (Act on Courts and judges), in the wording of later regulations.

¹⁷ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No. 207/2009 on the Community trademark and Commission Regulation (EC) No. 2868/95 implementing Council Regulation (EC) No. 40/94 on the Community trademark, and repealing Commission Regulation (EC) No. 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and Designs).

the applicant's goods or services in commerce. If the applicant establishes to the satisfaction of the examining attorney that the matter in question has acquired distinctiveness as the mark in relation to the named goods or services, then the mark is registrable on the Principal Register under Section 2 (f) of the Lanham Act, 15 U.S.C. §1052(f).

The Lanham Act in Section 2 (f), (15 U.S.C. § 1052), Title I – The Principal Register, further sets out: “The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made”.¹⁸ The Lanham Act expressly states the period of five years for exclusive and continuous use the sign by the applicant in commerce before the date on which the distinctiveness claim is made – it is the fundamental difference in comparison with the EU and CR legislation.

To serve the sign as trademark, the sign must be distinctive – it must be capable to identify the source of particular goods or services – the mentioned legal requirement is the same in the American, EU and Czech legal systems.

In conclusion, it can be summarized that in connection with the institute distinctiveness of the trademarks, there are two different situations. The first one is characterized by the fact that the sign to serve as the trademark has the distinctive character as such. Mentioned according to the World Intellectual Property Organization is called the inherent distinctiveness. The second one concerns the trademark which is not distinctive as such but has acquired distinctiveness through use in business relations. Authoress will analyze these situations closer in the following text through the interpretation and legal analysis of the decision-making practice, mainly of the Industrial Property Office of the Czech Republic, hereinafter “CR IPO”, the European Union Intellectual Property Office, hereinafter “EUIPO”, and the CJEU.

2.1 Assessment of the distinctiveness according to the CR IPO

The CR IPO has established the following principal propositions which are applicable to all kinds of trademarks. To have the sign like the trademark the inherent distinctiveness, its design must be original, imaginative, and the characters must have the capability of

¹⁸ U.S. Trademark Law. Federal Statutes. Trademark Act of 1946, as amended., Title I – The Principal Register, § 2 (f), (15 U.S.C. § 1052).

identifying the commercial origin of the goods or services.¹⁹ The applicant has to prove the distinctiveness his sign from signs of other enterprises. The assessment of the trademarks distinctiveness is the complex problem which subsumes the combination of the objective and subjective elements. It always is necessary to take into account the overall impression, by which the trademark operates as the whole, with taking into account the nature of the goods and services and other relevant factors.²⁰ The sign has the distinctive character for certain products or services, provided if the average consumer is or will be able to differentiate products or services from a certain commercial source according to it.²¹

2.2 Definition of the term relevant consumer or public according to the Czech case law and the EU decision-making practice

Every sign is assessed especially in terms of so-called relevant public. The term relevant public means in particular contemporary or potential consumers of the goods or services, or those involved in the distribution networks of the goods or services, or business circles dealing with the goods in question or services.²² In other words, the relevant public is the relevant section of consumers to whom the products and services are intended.

It should be noted that the term relevant public according to the CR IPO is identical to the term average consumer. The High Court in Prague has determined that the distinctiveness must always be examined in relation to the perception of the average consumer usually in terms of visual, phonetic, semantic point of view, and comparing of the type of goods and services.²³

The European case law uses the term so-called relevant consumer. Earlier term the inattentive consumer was used. The CJEU has stated that the relevant consumer is intelligent and observant, and he has the so-called imperfect recollection – imperfect triggering capability. Without any doubts, that definition means a shift from previous model of inattentive consumer.

¹⁹ CR IPO decision ref. no. O-97527-95 of 18 February 1998.

²⁰ CR IPO decision ref. no. O-186725 of 28 June 2004.

²¹ CR IPO decision ref. no. O-97524-95 of 18 February 1998.

²² CR IPO decision ref. no. O-151565 of 1 June 2004.

²³ Judgement of High Court in Prague, ref. no. 5 A 8/98.

In the case of Lifting Crème the CJEU has decided that social, cultural, linguistic differences have a decisive impact on the relevant consumer to perceive information about the product or service. The CJEU has emphasized that the decision must be based on the consumer in the particular country as well.²⁴

In my opinion, for the EUIPO, which registers the EUTM, the fulfillment of above mentioned task is much more difficult because how certain signification is perceived by the average consumer; it is decided by examiners of different nationalities.

2.3 Acquired distinctiveness – means of providing evidence according to the CR IPO and the CJEU

When submitting evidence of use, it is possible to present any evidence to support the applicant. Authoress talks about the so-called freedom of evidence. It is exclusively the responsibility of the CR IPO if it recognizes the acquisition of distinctiveness of the trademark in the subconscious of consumers. To prove the typicalness or recognition of the trademark, it is necessary to lodge with the CR IPO relevant documents which are mostly as follows: orders, invoices, labels, delivery notes, customers correspondence, price lists, catalogues, promotional materials, or finished products from which is explicitly evident that the applicant really has used the sign.²⁵

Below authoress presents the key decisions of the CR IPO to this issue. Submitted documents should always be evaluated for long-term nature, frequency and manner of use of the sign. The applied sign must be typical exclusively in relation to the goods or services of the applicant.²⁶

The CR IPO further has declared that the proof of sales the product by dozens numbers of buyers on one narrow territory is inadequate because they do not show sufficient territorial extent, nor quantity of product required to obtain the distinctive character for the specific entity (factually, there were 60 pieces of products on the territory of Prague).²⁷

²⁴ Judgement of the EU Court of Justice in case C-220/98 Lifting Crème of 13 January 2000.

²⁵ Judgement of Municipal Court in Prague, ref. no. 10 Ca 294/2005 of 25 September 2007.

²⁶ CR IPO decision ref. no. O-65471-91 of 6 May 1996.

²⁷ CR IPO decision ref. no. O-87412 of 11 March 2003.

The CJEU has decided to the analyzed issue that it can be taken into account in particular: part of the market controlled by the trademark, the intensity, geographical extent and duration of use, the amount of investments spent on advertising support of the trademark, the proportion of relevant consumers, and the declaration of commercial and industrial chambers.²⁸

²⁸ Judgement of the EU Court of Justice in case C-353/03 Nestlé – Distinctiveness acquired through use, use as part of a registered trademark or in connection with it.

3 Distinctiveness for non-verbal trademarks

Next to settled forms of trademarks, so-called traditional trademarks, here are so-called non-traditional trademarks which have been heavily discussed by world bodies in recent years. The traditional trademarks subsume word, figurative, combined and spatial or 3D trademarks. The non-traditional trademarks subsume color or trademarks consisting exclusively of color, olfactory, taste, sound, position, tactile, hologram, motion and gesture trademarks.

3.1 Figurative trademarks

The figurative trademarks are created by a drawing or graphic symbol. The CR IPO has established the following principal proposition which is applicable to other kinds of trademarks. In order to acquire the distinctiveness of the figurative trademark, it shall be original, imaginative, and the characters must have the capability of identifying the commercial origin of the goods or services.²⁹

The above mentioned legal opinion of the CR IPO presents the practical application of general principles assessing of trademarks distinctiveness which has been declared by CR IPO in previous case law.

3.2 Combined trademarks

The combined trademarks consist of a combination of verbal and figurative elements. The CR IPO has declared to the distinctiveness of combined trademarks following propositions – the distinctiveness can be achieved by the graphical stylization of the word element and its layout. Both, the verbal element and figurative element are assessed individually as well as in their combination.³⁰

²⁹ CR IPO decision ref. no. O-72937-92 of 5 November 1997.

³⁰ CR IPO decision ref. no. O-58124-90 of 15 September 1995.
CR IPO decision ref. no. O-57941-90 of 30 June 1993.

3.3 Spatial or 3D trademarks

The spatial trademark is a three-dimensional representation of the trademark. Usually, it is created in the shape of a product or its packaging. In particular, it is the shape of bottles, jars, or design of drug.

The CR IPO has declared that the spatial sign having the shape of the regular product, in the case question it was the oval medical tablet, does not have the distinctiveness as such. The mentioned applies even if the product has diverse aesthetic form and the selected shape reproduces the common shape. Such sign has the generic character.³¹ The above stated decision is fully in accordance with the European decision-making practice.

In the USA, under the Lanham Act, the three-dimensional signs can serve as trademarks only if that the shapes of products or services have the distinctive character or has acquired it over time. Another condition is that the shapes have no purposeful functionality. In other words, the shapes as trademarks may not predetermine the functionality of the product.³²

Authoress believes that the three-dimensional trademarks would be better to protect by the institute of industrial designs, arguing that the average consumer with an average sense for detail perceives the shape of the product as the product itself, in connection with the shape the consumer does not think about its commercial origin which is in terms of protection the primary aspect of trademark. Authoress admits, however, that if the shape of the product would be original, unusual, imaginative, so the average consumer might associate that sign with the given manufacturer. In this case, the sign would include the distinctive character.

On the other side, it is pragmatic that applicants want to reach legal protection through the institute of trademarks because the trademark protection subsumes a huge advantage – the institute of trademarks renewal is not time-limited.

3.4 Trademarks consisting exclusively of color

The ability to protect the trademark consisting exclusively of color is possible in the CR in accordance with the EU case law, provided if the sign has the distinctive character. It must have the exact shade of the color specified by the internationally recognized color swatches,

³¹ CR IPO decision ref. no. O-104344-95 of 18 November 1997.

³² Protectability of Three-Dimensional Marks. In: *International Trademark Association*. [Online]. [cit. 2015-06-03]. Dostupné z WWW: <http://www.inta.org/Advocacy/Pages/ProtectabilityofThree-DimensionalMarks.aspx>.

such as “PANTONE”, “CMYK”, or the color scale “RAL”. Precisely specified shade of that color must be concretized in the application due to other reproduction, for example, providing with the shade number in accordance with the cited color swatches. The so-called basic colors with regard to their limited number must be available to everyone.

According to the CR IPO in assessing the distinctiveness of the sign consisting of usual color shade the presence of other distinctive elements is deciding and their effect on the average consumer. The CR IPO has also stated that the applicant may overcome the obstacles of eligibility of the sign by proving that the sign has acquired the distinctiveness for those goods or services by long term use in business.³³

Also in the USA, there the signs consisting exclusively of color are eligible for trademark registration. It has been confirmed by the US Supreme Court in the *Qualitex v. Jacobson Products* case³⁴ when the US Supreme Court has approved the registration of green and gold sign as the federal trademark for ironing board covers. Given that, but the colors as such are not distinctive, the US Supreme Court has limited the conditions for registration of color signs to those which has acquired the so-called secondary meaning. The secondary meaning means that consumers associate the color with the specific product or service. It means that the color signs can be registered into the federal register only if sign has been previously used and acquired the distinctiveness for the goods or services of the applicant.³⁵

³³ CR IPO decision ref. no. O-108398-96 of 20 September 2000.

³⁴ *Qualitex Co. v. Jacobson Products Co., Inc.* 514 U.S. 159, Washington, D.C.: U.S. Supreme Court, 1995.

³⁵ Non-Conventional Trademarks. In: *IPpro Services (India) Pvt. Ltd.* [Online]. [cit. 2015-06-03]. Dostupné z WWW: http://www.ipproinc.com/admin/uploads/Non-Conventional_Trademarks_-_Feb_24,_2009_59.pdf.

Conclusion

In all above analyzed legal systems we can find two types of the distinctiveness – the inherent distinctiveness and the distinctiveness acquired through use in business relation. The inherent distinctiveness means that the sign selected to serve as the trademark is distinctive as such. On the other hand, also the sign not having the inherent distinctiveness can be registered in the trademark register, provided that the applicant establishes that the sign acquired distinctiveness through use in business relation prior to the registration in the trademark register.

In respect of trademark distinctiveness, there exist the following principal propositions which are applicable to all kinds of trademarks. To have the sign like the trademark the inherent distinctiveness, its design must be original, imaginative, and the characters must have the capability of identifying the commercial origin of the goods or services. The applicant has to prove the distinction his signification from significations of other enterprises. The assessment of the trademarks distinctiveness is the complex problem which subsumes the combination of the objective and subjective elements. It always is necessary to take into account the overall impression, by which the trademark operates as the whole, with taking into account the nature of the goods and services and other relevant factors. The sign has the distinctive character for certain products or services if the average consumer is or will be able to differentiate the products or services from the certain commercial source according to it.

Resources

Act No. 441/2003 Coll. of 3 December 2003 on Trademarks and on amendments to Act No. 6/2002 Coll. on judgements, judges, assessors and state judgement administration and on amendments to some other Acts (Act on Courts and judges), in the wording of later regulations.

Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trademark (codified version of Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trademark).

Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No. 207/2009 on the Community trademark and Commission Regulation (EC) No. 2868/95 implementing Council Regulation (EC) No. 40/94 on the Community trademark, and repealing Commission Regulation (EC) No. 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trademarks and Designs).

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (recast version).

Fischerová, A. *Ochranná známka v kontextu evropského a amerického práva*. [Trademark in the context of European and American law]. Praha. Diplomová práce. Vysoká škola ekonomická v Praze. Prof. JUDr. Martin Boháček, CSc.

U.S. Trademark Law. Federal Statutes. Trademark Act of 1946, as amended.

Articles

ČERMÁK, Karel: Rozlišovací způsobilost ochranné známky. [The distinctiveness of trademark]. *Průmyslové vlastnictví*. No. 1-2, 2000, p. 22-23.

Electronic resources

ASPI [právní informační systém/Legal System of Information]. Wolters Kluwer ČR. [cit. 2016-01-30].

Dudnikov, Karen and Meadors, Michael. The History of Trademark Law. In: *Tabberone Trademark Page*. [Online]. [cit. 2015-06-03]. Dostupné z WWW: <http://www.tabberone.com/Trademarks/TrademarkLaw/History/History.shtml>.

eSearch Case Law. In: *Office for Harmonization in the Internal Market (Trademarks and Designs)*. [Online]. [cit. 2015-06-03]. Dostupné z WWW: <https://oami.europa.eu/eSearchCLW/#>.

Non-Conventional Trademarks. In: *IPpro Services (India) Pvt. Ltd.* [Online]. [cit. 2015-06-03]. Dostupné z WWW: http://www.ipproinc.com/admin/uploads/Non-Conventional_Trademarks_-_Feb_24,_2009_59.pdf.

Protectability of Three-Dimensional Marks. In: *International Trademark Association*. [Online]. [cit. 2015-06-03]. Dostupné z WWW: <http://www.inta.org/Advocacy/Pages/ProtectabilityofThree-DimensionalMarks.aspx>.

Case law

CR IPO decision ref. no. O-58124-90 of 15 September 1995.

CR IPO decision ref. no. O-57941-90 of 30 June 1993.

CR IPO decision ref. no. O-65471-91 of 6 May 1996.

CR IPO decision ref. no. O-72937-92 of 5 November 1997.

CR IPO decision ref. no. O-104344-95 of 18 November 1997.

CR IPO decision ref. no. O-97527-95 of 18 February 1998.

CR IPO decision ref. no. O-108398-96 of 20 September 2000.

CR IPO decision ref. no. O-87412 of 11 March 2003.

CR IPO decision ref. no. O-151565 of 1 June 2004.

CR IPO decision ref. no. O-186725 of 28 June 2004.

Qualitex Co. v. Jacobson Products Co., Inc. 514 U.S. 159, Washington, D.C.: U.S. Supreme Court, 1995.

Judgement of High Court in Prague, ref. No. 5 A 8/98.

Judgement of the EU Court of Justice in case C-220/98 Lifting Crème.

Judgement of the EU Court of Justice in case C-353/03 Nestlé.

Judgement of Municipal Court in Prague, ref. No. 10 Ca 294/2005.