

No need to be graphic

UK implementation of the Trade Mark Directive

The Trade Mark Regulations 2018 (SI 2018/825), which implement the Trade Marks Directive (EU) 2015/2436, came into force on 14 January 2019. One of the key changes that this introduced to the UK Trade Marks Act is the non-graphical representation of trade marks.

The 10 most popular trade mark types

word

figurative

shape

position

pattern

colour (single)

colour (combination)

sound

motion

multimedia

hologram

➤ What has changed?

The requirement for graphical representation was removed, which allows new ways of depicting non-traditional marks. On a practical level, this means that you are able to upload a wide range of digital file formats; for example, audio files for sound marks or moving images for multimedia marks.

The European Union Intellectual Property Office (EUIPO) together with the European Commission and national offices have drafted a Common Communication on this very subject, which gives a provisional overview of the definitions, types of mark and file formats that each country intends to accept. These depend on progress that Member States make towards implementing their national legislation and, therefore, the Common Communication is updated every six months.

The latest version is available here:

<https://www.gov.uk/government/publications/common-communication-on-representation-of-new-types-of-trade-marks>

The removal of the graphical representation requirement means that, from 14 January 2019, signs can be represented in any appropriate form using generally available technology, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. This might make it easier for applicants to secure protection for non-traditional representations, such as sounds and smells, as well as electronic files, holograms and moving marks.

Ahead of the entry into force of this provision, the Common Communication provided information on the alternative media and

formats that are considered to comply with the new provision. New representation requirements apply for different types of marks, e.g. sound marks must be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation.

A non-exhaustive list of the 10 most popular trade mark types, including five new types (position, pattern, motion, multimedia and hologram) are listed in the table below. The definition of each type of trade mark is based on the definitions contained in Article 3 of the EU Implementing Regulation which came into effect from 1 October 2017 in respect of EUTMs. As regards UKTMs, the Common Communication states that “the UK regards trade mark type as an aid to administration and does not seek to define types per se”. Although position, pattern, motion, multimedia and hologram types of trade marks are not specially mentioned in current UK legislation, it will be possible to file these types of marks as “Other”. The electronic file formats that the UKIPO accept are listed under the column headed “format required”, and a full overview of the accepted electronic file formats for all types of trade marks that each Office accepts can be accessed here:

https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/768553/accepted-electronic-file-formats-2018.pdf

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Type of mark	Format required	Definition	Means of representation
word	n/a	A trade mark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof.	The mark shall be represented by submitting a reproduction of the sign in standard script and layout, without any graphic feature or colour.
figurative	JPEG GIF TIF PNG JFIF	A trade mark where nonstandard characters, stylisation or layout, or a graphic feature or a colour are used, including marks that consist exclusively of figurative elements or a combination of verbal and figurative elements.	Colour claims are no longer possible, the representation must contain the colours, where applicable, and all the elements of the sign.
shape	OBJ STL X3 JPEG GIF TIF PNG JFIF	A trade mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The term 'extending to' means that the mark may cover not only shapes per se, but also shapes that contain word or figurative elements, labels, etc.	The mark shall be represented by submitting either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction. The graphic or photographic reproduction may contain different views. If the electronic representation is not by means of a computer-generated image, it may consist of up to six views that must be submitted in one single JPEG file.
position	JPEG GIF TIF PNG JFIF	A trade mark consisting of the specific way in which the mark is placed or affixed on the product.	The mark shall be represented by submitting a reproduction which appropriately identifies the position of the mark and its size or proportion with respect to the relevant goods. The elements which do not form part of the subject-matter of the registration shall be visually disclaimed, preferably by broken or dotted lines. The representation may be accompanied by a description detailing how the sign is affixed on the goods.
pattern	JPEG GIF TIF PNG JFIF	A trade mark consisting exclusively of a set of elements which are repeated regularly.	The mark shall be represented by submitting a reproduction showing the pattern of repetition. The representation may be accompanied by a description detailing how its elements are repeated regularly.
colour (single)	JPEG GIF TIF PNG JFIF	A trade mark consisting exclusively of a single colour without contours.	The mark shall be represented by submitting a reproduction of the colour and an indication of that colour by reference to a generally recognised colour code.

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Type of mark	Format required	Definition	Means of representation
colour (combination)	JPEG GIF TIF PNG JFIF	A trade mark consisting exclusively of a combination of colours without contours.	The mark shall be represented by submitting a reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner, and an indication of those colours by reference to a generally recognised colour code. A description detailing the systematic arrangement of the colours may also be added.
sound	MP3 JPEG GIF TIF PNG JFIF	A trade mark consisting exclusively of a sound or combination of sounds.	The mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation.
motion	MP4 JPEG GIF TIF PNG JFIF	A trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark.	The mark shall be represented by submitting a video file or by a series of sequential still images showing the movement or change of position. Where still images are used, they may be numbered or accompanied by a description explaining the sequence.
multimedia	MP4	A trade mark consisting of, or extending to, the combination of image and sound.	The mark shall be represented by submitting an audio-visual file containing the combination of the image and the sound.
hologram	MP4 JPEG GIF TIF PNG JFIF	A trade mark consisting of elements with holographic characteristics.	The mark shall be represented by submitting a video file or a graphic or photographic representation containing the views which are necessary to sufficiently identify the holographic effect in its entirety.