

JUDGMENT OF THE COURT

12 December 2002 *

In Case C-273/00,

REFERENCE to the Court under Article 234 EC by the Bundespatentgericht (Germany) for a preliminary ruling in proceedings brought by

Ralf Sieckmann,

on the interpretation of Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1),

THE COURT,

composed of: G.C. Rodríguez Iglesias, President, M. Wathelet, R. Schintgen, C.W.A. Timmermans (Presidents of Chambers), C. Gulmann, D.A.O. Edward, A. La Pergola, V. Skouris, F. Macken (Rapporteur), N. Colneric and J.N. Cunha Rodrigues, Judges,

* Language of the case: German.

Advocate General: D. Ruiz-Jarabo Colomer,

Registrar: D. Louterman-Hubeau, Head of Division,

after considering the written observations submitted on behalf of:

— Mr Sieckmann, by himself, Patentanwalt,

— the Austrian Government, by C. Pesendorfer, acting as Agent,

— the United Kingdom Government, by R. Magrill, acting as Agent, and
D. Alexander, Barrister,

— the Commission of the European Communities, by K. Banks, acting as
Agent, and W. Berg, Rechtsanwalt,

having regard to the Report for the Hearing,

after hearing the oral observations of Mr Sieckmann and the Commission at the
hearing on 2 October 2001,

after hearing the Opinion of the Advocate General at the sitting on 6 November
2001,

gives the following

Judgment

- 1 By order of 14 April 2000, received at the Court on 10 July 2000, the Bundespatentgericht (Federal Patents Court) referred to the Court for a preliminary ruling under Article 234 EC two questions on the interpretation of Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1; 'the Directive').

- 2 Those questions were raised in proceedings brought by Mr Sieckmann against the refusal of the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office) to register an olfactory mark in respect of various services in Classes 35, 41 and 42 of the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Relevant provisions

Community legislation

- 3 According to the first recital in the preamble thereto, the purpose of the Directive is to approximate the trade mark laws of the Member States in order to abolish

existing disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market. According to the third recital in the preamble thereto, the Directive is not intended to achieve full harmonisation of those laws.

4 The seventh recital in the preamble to the Directive states:

‘... attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States;... to this end, it is necessary to list examples of signs which may constitute a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings;...’.

5 Article 2 of the Directive contains a list of examples of signs of which a trade mark may consist. It is worded as follows:

‘A trade mark may consist of any sign 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.’

- 6 Paragraph 1 of Article 3 of the Directive, entitled ‘Grounds for refusal or invalidity’, provides:

‘The following shall not be registered or if registered shall be liable to be declared invalid:

(a) signs which cannot constitute a trade mark;

(b) trade marks which are devoid of any distinctive character;

...’.

National legislation

- 7 The Gesetz über den Schutz von Marken und sonstigen Kennzeichnungen (German Law on the Protection of Trade Marks and other Identification Marks) of 25 October 1994 (BGBl. 1994 I, p. 3082; ‘the Markengesetz’) transposed the Directive into German law. It entered into force on 1 January 1995.

8 Paragraph 3(1) of the Markengesetz states:

‘Any sign, particularly words, including personal names, designs, letters, numerals, acoustic signs and three-dimensional forms, including the shape of goods or of their packaging and other aspects of their presentation, including colours and colour combinations, which are capable of distinguishing the goods or services of one undertaking from those of other undertakings, may be protected as a trade mark.’

9 Under Paragraph 8(1) of the Markengesetz, signs ‘which are not capable of being represented graphically’ are not to be registered and, under Paragraph 8(2)(1), trade marks which are devoid of any distinctive character are not to be registered.

The main proceedings and the questions referred for a preliminary ruling

10 Mr Sieckmann deposited with the Deutsches Patent- und Markenamt a trade mark in respect of various services in Classes 35, 41 and 42 of the Nice Agreement of 15 June 1957, as revised and amended, which include advertising, business management, business administration and office functions (Class 35), education, providing of training, entertainment and sporting and cultural activities (Class 41), providing of food and drink, temporary accommodation, medical, hygienic and beauty care, veterinary and agricultural services, legal services, scientific and industrial research, computer programming and services that cannot be placed in other classes (Class 42).

- 11 In the section of the application form headed 'Reproduction of the Trade Mark', required under Paragraph 8(1) of the Markengesetz and pursuant to Article 2 of the Directive, provisions under which, to be able to constitute a mark a sign must be capable of being represented graphically, Mr Sieckmann referred to a description attached as an annex to his registration application. That description reads as follows:

'Trade mark protection is sought for the olfactory mark deposited with the Deutsches Patent- und Markenamt of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester), whose structural formula is set out below. Samples of this olfactory mark can also be obtained via local laboratories listed in the Gelbe Seiten (Yellow Pages) of Deutsche Telekom AG or, for example, via the firm E. Merck in Darmstadt.



- 12 In the event that the description set out in the previous paragraph was not sufficient to satisfy the application requirement under Paragraph 32(2) and (3) of the Markengesetz, the applicant in the main proceedings made the following addendum to that description:

'The trade mark applicant hereby declares his consent to an inspection of the files relating to the deposited olfactory mark "methyl cinnamate" pursuant to Paragraph 62(1) of the Markengesetz and Paragraph 48(2) of the Markenverordnung (Trade Mark Regulation).'

- 13 Mr Sieckmann also submitted with his registration application an odour sample of the sign in a container and stated that the scent was usually described as 'balsamically fruity with a slight hint of cinnamon'.

- 14 The Deutsches Patent- und Markenamt refused the application for registration on the ground that it was doubtful whether the trade mark applied for was capable of being registered under Paragraph 3(1) of the Markengesetz and of being represented graphically in accordance with Paragraph 8(1) thereof. Ultimately, it was not necessary to determine whether the sign was capable of being registered as a trade mark and of being represented graphically because, under Paragraph 8(2) of the Markengesetz, that sign's lack of any distinctive character precluded its registration in any event.

- 15 In the appeal lodged against that refusal by Mr Sieckmann, the Bundespatentgericht held that in theory odours may be capable of being accepted in trade as an independent means of identifying an undertaking, in accordance with Paragraph 3(1) of the Markengesetz.

- 16 The referring court found that the mark deposited would be capable of distinguishing the abovementioned services and would not be regarded as purely descriptive of the characteristics of those services.

- 17 By contrast, that court found that there are doubts as to whether an olfactory mark, such as that at issue in the case before it, can satisfy the requirement of graphic representability set out in Paragraph 8(1) of the Markengesetz.

- 18 According to the Bundespatentgericht, the graphic representability of a sign constitutes a registration criterion which, in appeal proceedings, must be examined as a matter of course in priority to the other grounds for refusal set out in Paragraph 8(2) of the Markengesetz; a sign cannot be registered if it is incapable of being represented graphically even if it has become accepted in trade as the trade mark of a specific undertaking and is thus not caught by the grounds for refusal set out in Paragraph 8(2)(1) to (3) of the Markengesetz, in particular, that of lack of distinctive character.
- 19 Since it took the view that Paragraph 8(1) of the Markengesetz must be interpreted in a manner consistent with Article 2 of the Directive, the Bundespatentgericht decided to stay proceedings and to refer the following questions to the Court for a preliminary ruling:

- ‘(1) Is Article 2 of the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC) to be interpreted as meaning that the expression “signs capable of being represented graphically” covers only those signs which can be reproduced directly in their visible form or is it also to be construed as meaning signs — such as odours or sounds — which cannot be perceived visually *per se* but can be reproduced indirectly using certain aids?
- (2) If the first question is answered in terms of a broad interpretation, are the requirements of graphic representability set out in Article 2 satisfied where an odour is reproduced:

- (a) by a chemical formula;

(b) by a description (to be published);

(c) by means of a deposit; or

(d) by a combination of the abovementioned surrogate reproductions?’

20 By application lodged at the Court Registry on 30 April 2002, Mr Sieckmann sought the reopening of the oral procedure, which had been closed on 6 November 2001 with the delivery of the Advocate General’s Opinion.

21 In support of his request, Mr Sieckmann submits that that Opinion does not deal specifically with the present case and that the Advocate General made a mistake in paragraph 42 of his Opinion.

22 The Court may of its own motion, on a proposal from the Advocate General or at the request of the parties order the reopening of the oral procedure, in accordance with Article 61 of its Rules of Procedure, if it considers that it lacks sufficient information or that the case must be dealt with on the basis of an argument which has not been debated between the parties (see Joined Cases C-270/97 and C-271/97 *Deutsche Post* [2000] ECR I-929, paragraph 30, and Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 20).

- 23 The Court considers that it has all the information it needs to answer the questions raised in the main proceedings.
- 24 Accordingly, Mr Sieckmann's request must be rejected.

The first question

- 25 By its first question, the referring court seeks essentially to ascertain whether Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually.

Observations submitted to the Court

- 26 Mr Sieckmann claims that Article 2 of the Directive does not preclude an olfactory mark from being capable, in principle, of being registered. He submits that such a mark is covered by that provision, as are acoustic marks, colours, holograms and other 'non-traditional' marks.
- 27 He submits that 'represented graphically' should be understood as 'represented, or electronically represented or deposited in another way'. In his submission, the structural chemical formula should always be deposited at the Deutsches Patent- und Markenamt with a description or a deposit of the sign. He also claims that the mark at issue in the main proceedings can be obtained in normal quantities

from local laboratory suppliers or in part directly from manufacturers and distributors of fine organic chemicals. By knowing the chemical name, which should be published, once they had purchased that chemical and irrespective of the sample's deposit and of publication of the mark's olfactory description, third parties would be able to form an exact, objective idea of the mark and, where appropriate, to compare it with other olfactory characteristics.

- 28 The Austrian Government considers that the field of protection of registered marks results from entries in the trade marks register, which enable the public to find out about third parties' rights to exclusivity. It submits that the possibility of perceiving registered marks visually, by consulting that register, is extremely important. It recalls that, according to the long-established practice of the Austrian Patents Office, the protection afforded to trade marks may be enjoyed not only by signs which are capable of being directly represented graphically, that is, two-dimensional marks, but also three-dimensional marks, which must be specifically designated as such in the registration procedure.
- 29 According to that Government, it seems to be necessary to assess sound or acoustic signs differently from olfactory signs in respect of the degree to which such signs can be determined by means of graphic representation. As regards acoustic signs, it is possible for graphic representation to determine to a relatively high degree the object to be protected. It is however different, according to the Austrian Government, for olfactory signs.
- 30 According to the United Kingdom Government, it is recognised that the effective operation of the trade mark system requires clarity and precision in the definition of any mark entered in public registers. It points out that, in the Directive, there is no restriction on the manner in which a mark may be represented graphically and

it is sufficient for the mark proposed for registration to be capable of representation in a form which enables it to be identified and which is sufficiently clear and precise for a user of the trade mark register to be able accurately to ascertain what the sign is from that register.

- 31 The United Kingdom Government submits that the representation as it appears on the register must satisfy the following requirements: first, it should be a sufficiently self-contained representation of the sign in question; next, it should be able to stand in place of the sign used or proposed to be used by the applicant because it clearly and precisely represents solely that sign; finally, it must be understandable by persons inspecting the register. That Government considers that there is no reason in principle why an olfactory mark should not be capable of being graphically represented within the meaning of Article 2 of the Directive.
- 32 The Commission submits that, because of the wording of Article 2 of the Directive, which contains a non-exhaustive list of signs of which a trade mark may consist, it is possible that trade marks may also consist of signs — such as olfactory signs — which admittedly cannot be perceived visually *per se*, but can be made visible by being represented graphically.
- 33 However, in the Commission's submission, a sign is capable of being registered as a trade mark only if the subject of the registration application can be clearly and precisely defined. The purpose of graphic representation is to give a clear, precise and objective image of the mark. That point is particularly important in a legal system where rights in a trade mark are acquired by deposit and entry in a public register. In such a system, complete graphic representation of a mark must thus be guaranteed by the register itself so that the exact scope of the protection resulting from registration is determined and the rights conferred by the mark are in particular demarcated from those arising from other marks.

Findings of the Court

- 34 It should first be recalled that, as is stated in the 10th recital in the preamble to the Directive, the function of the protection afforded by a trade mark is in particular to guarantee the mark as an indication of origin.
- 35 It is also clear from the Court's case-law that the essential function of a trade mark is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish that product or service from others which have another origin and that, for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (see, in particular, Case C-349/95 *Loendersloot* [1997] ECR I-6227, paragraphs 22 and 24; Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and *Philips*, paragraph 30).
- 36 The purpose of the Directive, as stated in the first and seventh recitals in the preamble thereto, is to approximate the trade mark laws at present applicable in the Member States and to make the conditions for obtaining and continuing to hold a registered trade mark identical in all Member States, in order to abolish disparities between those laws which may impede the free movement of goods and freedom to provide services and may distort competition within the common market.
- 37 The registration system for trade marks constitutes an essential element of their protection, which contributes, in respect of both Community law and the different national laws, to legal certainty and sound administration.

- 38 In that regard it should be noted, first, as is stated in the fourth recital in the preamble to the Directive, that acquisition of the rights in a mark results, on the one hand, from depositing and registering the mark and, on the other, from use. However, Article 1 thereof provides that the Directive is to apply only to trade marks which are the subject of registration or of an application for registration in a Member State or in the Benelux Trade Mark Office or of an international registration having effect in a Member State. Furthermore, the sixth recital in the preamble to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) also states that the rights in a Community trade mark may not be obtained otherwise than by registration.
- 39 Next, Article 2 of the Directive provides that a trade mark may consist of any sign, provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.
- 40 Furthermore, according to the rule laid down in Article 3(1)(a) of the Directive, signs which cannot constitute a trade mark are not to be registered or if registered are to be liable to be declared invalid.
- 41 Finally, under Article 5(1) of the Directive, the registered trade mark is to confer on the proprietor exclusive rights therein. The exact scope of those rights is guaranteed by registration itself.
- 42 In the light of those considerations, it must be determined whether Article 2 of the Directive is to be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually.

- 43 The purpose of Article 2 of the Directive is to define the types of signs of which a trade mark may consist. That provision states that a trade mark may consist of ‘particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging...’. Admittedly, it mentions only signs which are capable of being perceived visually, are two-dimensional or three-dimensional and can thus be represented by means of letters or written characters or by a picture.
- 44 However, as is clear from the language of both Article 2 of the Directive and the seventh recital in the preamble thereto, which refers to a ‘list [of] examples’ of signs which may constitute a trade mark, that list is not exhaustive. Consequently, that provision, although it does not mention signs which are not in themselves capable of being perceived visually, such as odours, does not, however, expressly exclude them.
- 45 In those circumstances, Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically.
- 46 That graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified.
- 47 Such an interpretation is required to allow for the sound operation of the trade mark registration system.

- 48 First, the function of the graphic representability requirement is, in particular, to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor.
- 49 Next, the entry of the mark in a public register has the aim of making it accessible to the competent authorities and the public, particularly to economic operators.
- 50 On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of registration applications and to the publication and maintenance of an appropriate and precise register of trade marks.
- 51 On the other hand, economic operators must, with clarity and precision, be able to find out about registrations or applications for registration made by their current or potential competitors and thus to receive relevant information about the rights of third parties.
- 52 If the users of that register are to be able to determine the precise nature of a mark on the basis of its registration, its graphic representation in the register must be self-contained, easily accessible and intelligible.

- 53 Furthermore, in order to fulfil its role as a registered trade mark a sign must always be perceived unambiguously and in the same way so that the mark is guaranteed as an indication of origin. In the light of the duration of a mark's registration and the fact that, as the Directive provides, it can be renewed for varying periods, the representation must be durable.
- 54 Finally, the object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. Consequently, the means of graphic representation must be unequivocal and objective.
- 55 In the light of the foregoing observations, the answer to the first question must be that Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The second question

- 56 By its second question, the referring court seeks essentially to ascertain whether Article 2 of the Directive must be interpreted as meaning that, in respect of an olfactory sign such as that at issue in the main proceedings, the requirements of graphic representability are satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.

Observations submitted to the Court

- 57 Mr Sieckmann advocates a broad interpretation of ‘represented graphically’ within the meaning of the Directive. In the systematic interpretation and practice of trade mark offices, ‘represented graphically’ should be understood as ‘represented, or electronically represented or deposited in another way’.
- 58 As regards the representation of the odour by a chemical formula, the applicant in the main proceedings observes that, although the molecular formula, in this case $C_{10}H_{10}O_2$, does not in any way show how the various atoms of those elements are joined together, the structural formula, in this case $C_6H_5-CH=CHCOOCH_3$, makes it possible to distinguish clearly a pure chemical substance as such. In addition, a pure chemical substance, in this case methyl cinnamate, can be distinguished by its chemical name.
- 59 In respect of the representation of the odour by a description, Mr Sieckmann points out that olfactory marks already exist in the European Union and the United States and that, in the main proceedings, the olfactory sign which was the subject of the registration application is based on ‘a balsamically fruity scent with a slight hint of cinnamon’, which corresponds to the classification of the perfume industry in the European Union.
- 60 As regards the representation of the mark to be protected by the deposit of a sample of it, Mr Sieckmann claims, as he explained in his registration application, that that mark may be obtained from local laboratory suppliers or from manufacturers and distributors of fine organic chemicals.

- 61 On the subject of a combination of the surrogate reproductions of that mark, he proposes, in respect of the application to register an olfactory mark on the basis of a pure chemical substance, as in the main proceedings, that differentiation be effected by means of the reproduction of the exact chemical name, which would appear beneath a contact address at which the odour could be obtained, supplemented where appropriate by the structural chemical formula of that odour, and by means of a deposit, for example, at the trade marks office carrying out examinations, in combination, where appropriate, with its description in words.
- 62 The Austrian and United Kingdom Governments and the Commission submit that, at the present stage of scientific knowledge, the uniform graphic representation of odours poses considerable problems.
- 63 In their submissions, the mere indication of the chemical formula as the graphic representation of an odour does not make it possible to identify the odour with certainty, because of different factors which influence the manner in which it can actually be perceived, such as concentration, quantity, temperature or the substance bearing the odour. Furthermore, those elements preclude the possibility of representing odours by means of olfactory samples.
- 64 The United Kingdom Government contends, in particular, that the chemical formula does not represent the odour of the chemical itself. Upon reading a chemical formula few people will understand what product it represents and, even if they do, they may well not understand what the product smells like. Furthermore, identifying the nature of the sign from a number of chemical formulae would cast an undue burden on those consulting the register.

- 65 As to the possibility of describing an odour in words, the Commission submits that such a description is imbued with subjectivity and can be interpreted in a subjective way, that is, differently by different people.
- 66 The United Kingdom Government considers that it is possible that a description in words of an odour could graphically represent it, for the purposes of Article 2 of the Directive. The circumstances in which such a representation would be acceptable are likely to be rare, mainly because it would be difficult to make such a description sufficiently clear and precise properly to represent the sign in question.
- 67 As regards the deposit of an odour sample, the Austrian Government and the Commission submit that an odour changes over time because of volatilisation or other phenomena and that a deposit can therefore not produce a lasting olfactory impression capable of constituting a graphic representation.
- 68 The United Kingdom Government states further that to allow such a form of representation in the trade mark registers of Member States and the Office for Harmonisation in the Internal Market (Trade Marks and Designs) would require considerable changes to those registers and to the systems of registration in Member States and at the Office and, as a result, the accessibility embodied by the existing system of public registers would be diminished.

Findings of the Court

- 69 As regards a chemical formula, as the United Kingdom Government has rightly noted, few people would recognise in such a formula the odour in question. Such

a formula is not sufficiently intelligible. In addition, as that Government and the Commission stated, a chemical formula does not represent the odour of a substance, but the substance as such, and nor is it sufficiently clear and precise. It is therefore not a representation for the purposes of Article 2 of the Directive.

- 70 In respect of the description of an odour, although it is graphic, it is not sufficiently clear, precise and objective.
- 71 As to the deposit of an odour sample, it does not constitute a graphic representation for the purposes of Article 2 of the Directive. Moreover, an odour sample is not sufficiently stable or durable.
- 72 If, in respect of an olfactory sign, a chemical formula, a description in words or the deposit of an odour sample are not capable of satisfying, in themselves, the requirements of graphic representability, nor is a combination of those elements able to satisfy such requirements, in particular those relating to clarity and precision.
- 73 In the light of the foregoing considerations, the answer to the second question must be that, in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.

Costs

- 74 The costs incurred by the Austrian and United Kingdom Governments and by the Commission, which have submitted observations to the Court, are not recoverable. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court.

On those grounds,

THE COURT,

in answer to the questions referred to it by the Bundespatentgericht by order of 14 April 2000, hereby rules:

1. Article 2 of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

2. In respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.

Rodríguez Iglesias

Wathelet

Schintgen

Timmermans

Gulmann

Edward

La Pergola

Skouris

Macken

Colneric

Cunha Rodrigues

Delivered in open court in Luxembourg on 12 December 2002.

R. Grass

G.C. Rodríguez Iglesias

Registrar

President