

Practice Paper

DISTINCTIVENESS -

Mixed Marks containing descriptive/
non-distinctive words

**Superintendencia de Industria y Comercio de
Colombia**

Note of the IP Office:

This Practice Paper has been prepared in line with the Common Communication resulting of the Common Practice of Trade Marks developed by the European Union Intellectual Property (EUIPN) and aimed to give guidance for the examination procedures on how to examining mixed marks¹ containing exclusively descriptive/non-distinctive words passing the absolute grounds for refusal because the graphic elements² render sufficient distinctiveness.

This document has been tailor-made to the specificities of Colombia, providing for an overview of the Office' quality standards for applications received by electronic means and by paper.

This Practice Paper, adopted at national level, is made public with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

¹ Different terminology is applied in Colombia and in the European Union in relation to the type of trade mark covered by this practice, that is, in the case of Colombia, the so-called mixed trade mark (consequently terminology used in this Practice Paper), and in the case of the European Union, the so-called figurative trade mark (terminology used in the Common Communication referred to above and reflecting the Common Trade Mark Practice developed by the EUIPN). For the purposes of this Practice Paper, the nature of the marks to be studied will be mixed.

² This also applies to the term 'graphic element(s)' in the case of Colombia and 'figurative element(s)' in the case of the European Union.

1. BACKGROUND

This Practice is in relation to cases where a mixed mark containing purely descriptive or non-distinctive words passes the absolute grounds examination because the graphic element renders sufficient distinctive character.

This Practice is made public through this Practice Paper, with the purpose of widely publicising it in a way providing a clear and comprehensive explanation of the principles on which the new Practice is based, further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

The following issues are out of the scope of the project:

- *Language issues: consider for the sake of the project that the word elements are totally descriptive and non-distinctive in your language.*
- *Interpretation of disclaimers: the practice does not affect the acceptance or interpretation of disclaimers by the IP offices.*
- *Use of the trade mark (including acquired distinctiveness and how the mark is actually used in trade).*

2. THE PRACTICE

The following text summarizes the key messages and main statements of the principles of the Practice. The full text can be found at the end of this Practice Paper.

In order to determine if the threshold of distinctiveness is met due to the graphic features in the mark the following criteria are considered:

Note: the signs containing 'Tomates Orgánicos' seek protection for **tomatoes in class 31; the signs containing 'Construcción Segura' seek protection for the **construction services** in class 37.*

WITH RESPECT TO THE WORD ELEMENTS IN THE MARK

Criterion	Typeface and font
Practice	<ul style="list-style-type: none"> • In general, descriptive/non-distinctive word elements appearing in basic or standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable. <p><u>Non-distinctive examples:</u></p> <p>Tomates Orgánicos ConsTrucción SegUra CONSTRUCCIÓN Segura</p> <p>Tomates Orgánicos <i>Tomates Orgánicos</i></p>

- Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

Distinctive examples:

**TOMATES
ORGANICOS**

Criterion *Combination with colour*

Practice

- The mere ‘addition’ of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, will not be sufficient to give the mark distinctive character.
- Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

Non-distinctive examples:

Tomates Orgánicos Tomates Orgánicos Tomates Orgánicos

Criterion *Combination with punctuation marks and other symbols*

Practice

- In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements.

Non-distinctive examples:

TomatesOrgánicos. ConstrucciónSegura® “Tomates Orgánicos”

Criterion *Position of the word elements (sideways, upside-down, etc.)*

Practice

- In general, the fact that the word elements are arranged in vertical, upside-down or in one or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.








Non-distinctive examples:











Construcción Segura Construcción Segura

T
o
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O
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WITH RESPECT TO THE GRAPHIC ELEMENTS IN THE MARK

Criterion	<i>Use of simple geometric shapes</i>
Practice	<ul style="list-style-type: none"> Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, in particular when the above-mentioned shapes are used as a frame or border. <p><u>Non-distinctive examples:</u></p> <div style="display: flex; justify-content: space-around; align-items: center;"> <div style="border: 1px solid black; border-radius: 15px; padding: 5px; text-align: center;">Tomates Orgánicos</div> <div style="text-align: center;">  </div> <div style="text-align: center;">  </div> </div> <ul style="list-style-type: none"> On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive. <p><u>Distinctive examples:</u></p> <div style="text-align: center;">  </div> <div style="text-align: center; margin-top: 20px;">  </div>
Criterion	<i>The position and proportion (size) of the graphic element in relation to the word element</i>
Practice	<ul style="list-style-type: none"> In general, when a graphic element that is distinctive on its own is added to a descriptive or non-distinctive word element, then the mark is registrable, provided that said graphic element is, due to its size and position, clearly recognisable in the sign. <p><u>Non-distinctive examples:</u></p> <div style="text-align: center; font-size: 1.2em;"> Tomates Orgánicos Construcción Segura  </div> <p><u>Distinctive examples:</u></p> <div style="display: flex; justify-content: space-around; align-items: center; margin-top: 20px;"> <div style="text-align: center;">  </div> <div style="text-align: center;"> Tomates Orgánicos </div> <div style="text-align: center;">  </div> <div style="text-align: center;"> Construcción Segura </div> </div>

<p>Criterion</p>	<p><i>Whether the graphic element is a representation of, or has direct link with, the goods and/or services</i></p>
<p>Practice</p>	<p>➤ A graphic element is considered to be descriptive and/or devoid of distinctive character whenever:</p> <ul style="list-style-type: none"> - it is a true-to-life portrayal of the goods and services; - it consists of a symbolic/stylised portrayal of the goods and services that does not depart significantly from the common representation of said goods and services. <p><u>Non-distinctive examples:</u></p> <div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p><u>Distinctive examples:</u></p> <div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p>➤ A graphic element which does not represent the goods and services but has a direct link with the characteristics of the goods and services will not render the sign distinctive, unless it is sufficiently stylised.</p> <p><u>Non-distinctive examples:</u></p> <div style="text-align: center;">  </div> <p><u>Distinctive examples:</u></p> <div style="display: flex; justify-content: space-around; align-items: center;">   </div>
<p>Criterion</p>	<p><i>Whether the graphic element is commonly used in trade in relation to the goods and/or services applied for</i></p>
<p>Practice</p>	<ul style="list-style-type: none"> • In general, graphic elements that are commonly used or customary in trade in relation to the goods and/or services claimed do not add distinctive character to the mark as a whole. <p><u>Non-distinctive examples:</u></p> <div style="display: flex; justify-content: space-around; align-items: center;">    </div>

WITH RESPECT TO BOTH THE WORD AND GRAPHIC ELEMENTS IN THE MARK

Practice	<p><i>How combinations of the criteria affect distinctiveness</i></p> <ul style="list-style-type: none">• In general, a combination of graphic elements and word elements, which if considered individually are devoid of distinctive character, does not give rise to a distinctive mark.• Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case when the combination results in an overall impression which is sufficiently far removed from the descriptive or non-distinctive message conveyed by the word element. <p><u>Examples:</u> In order for a sign to be registrable, it must have a minimum level of distinctiveness. The purpose of the scale is to illustrate where that threshold is. The examples below from left to right contain elements with an increasing impact on the distinctiveness of the marks, resulting in marks which are either non-distinctive in their totality (red column) or distinctive in their totality (green column).</p>
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Informative note: It should be noted that the applicant will not obtain exclusive rights over descriptive or non-distinctive terms when it is the graphic element that gives the mark distinctiveness as a whole. The scope of protection is limited to the overall composition of the mark.

Non-distinctive

Distinctive

1.

Tomates Orgánicos

Tomates Orgánicos

Tomates Orgánicos

Tomates Orgánicos

Tomates Orgánicos

TOMATES ORGANICOS

2.

Construcción Segura

Construcción Segura

Construcción Segura

construcción segura

Construcción Segura

3.

Tomates Orgánicos

Tomates orgánicos

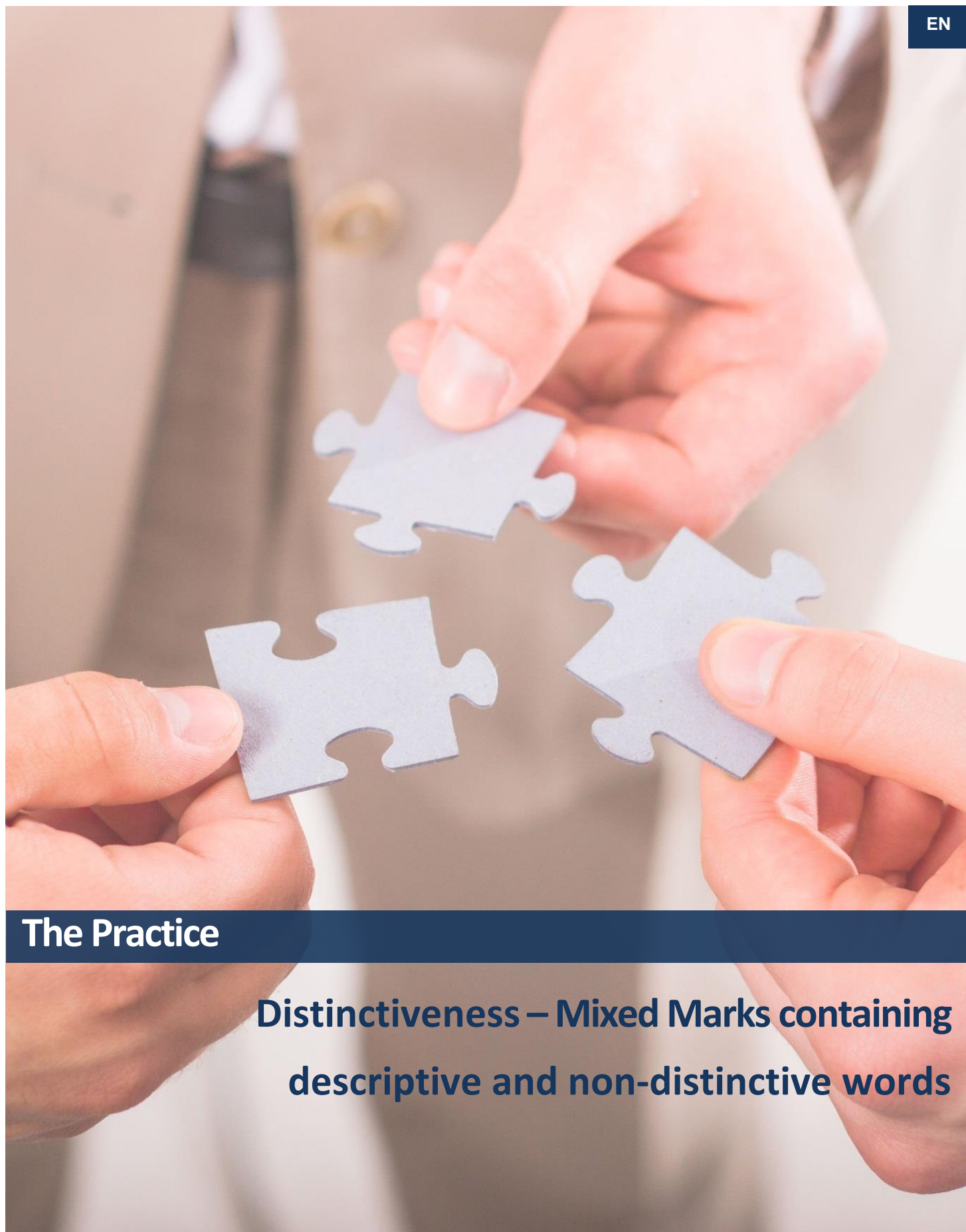
Tomates Orgánicos

Tomates Orgánicos

Tomates Orgánicos

Tomates Orgánicos

Tomates Orgánicos



The Practice

**Distinctiveness – Mixed Marks containing
descriptive and non-distinctive words**

Index

1	INTRODUCTION.....	1
2	THE PROJECT SCOPE	1
3	THE PRACTICE	2
	3.1. Descriptive words without distinctive character.....	2
	3.2. What are the graphic thresholds for passing the absolute grounds examination?	4
	A. With respect to the word elements of the mark.....	6
	A.1. Typeface and font.....	6
	A.2. Combination with colour	8
	A.3. Combination with punctuation marks and other symbols.....	9
	A.4. Position of the word elements (side-ways, upside-down, etc.)	10
	B. With respect to the graphic elements in the mark.....	11
	B.1. Use of simple geometric shapes	11
	B.2. The position and proportion (size) of the graphic element in relation to the word element.	13
	B.3. The graphic element is a representation of, or has a direct relationship with, the goods and services.	14
	B.4. The graphic element is commonly used in trade in relation to the goods and/or services applied for	19
	C. How do combinations of the above criteria affect distinctiveness?	21

1 INTRODUCTION

This document is the reference for IP offices, user associations, applicants and agent³, on the Practice determining when a mixed mark containing purely descriptive or non-distinctive words passes the absolute grounds examination because the graphic element renders the mark as a whole with sufficient distinctive character. It will be made widely available and will be easily accessible, providing a **clear and comprehensive explanation of the principles on which the Practice is based**. These principles will be generally applied, and aimed at covering the large majority of the cases.

2 THE PROJECT SCOPE

The **scope** of the project reads:

*“The objective of this project is to find a practice in relation to when a **mixed mark, containing purely descriptive or non-distinctive words, passes the absolute grounds examination because the graphic element renders sufficient distinctive character.**”*

The following issues are out of the scope of the project:

- *Language issues: consider for the sake of the project that the word elements are fully descriptive/non- distinctive in your language.*
- *Interpretation of disclaimers.*
- *Use of the trade mark (including acquired distinctiveness and how the mark is actually used in trade).*

In order to determine if the threshold of distinctiveness is met due to the graphic features in the mark the following criteria are considered:

- With respect to the **word** elements in the mark:
 - Typeface and font.
 - Combination with colour.
 - Combination with punctuation marks and other symbols.

³ Explanatory note on the different terminology used in Colombia and in the European Union: the figure of ‘agent’ in the case of Colombia corresponds to the figure of ‘representative’ in the case of the European Union.

- Position of the word elements (sideways, upside-down, etc.).
- With respect to the **graphic** elements in the mark:
 - Use of simple geometric shapes.
 - The position and proportion (size) of the graphic element in relation to the word element.
 - Whether the graphic element is a representation of, or has a direct link with, the goods and/or services.
 - Whether the graphic element is commonly used in trade in relation to the goods and/or services applied for.
- With respect to **both** the word and graphic elements in the mark:
 - How combinations of the criteria affect distinctiveness.

3 THE PRACTICE

3.1. Descriptive words without distinctive character.

For the purpose of the project the word elements in the mark (see Article 134 of Decision 486 from the Andean Community Commission) are deemed to be fully descriptive without distinctive character, as the main purpose is to converge the approach on when the addition of a graphic element renders the mark as a whole sufficiently distinctive, thus enabling the mark to perform its essential function and pass the absolute grounds examination.

According to the regulations and settled case-law from the Andean Community, for a trade mark to possess **distinctive character** it must be capable of fulfilling its **essential function**, namely to **guarantee the identity of the commercial origin** of the marked goods and services **to the consumer or end-user** by enabling him/her, without any possibility of confusion, to **distinguish the goods or services from others which have another origin**, thus to repeat the experience, if proved to be positive, or to avoid it, if proved to be negative (see Articles 134 and 135(b) of Decision 486 of the Andean Community Commission and the preliminary ruling 369-IP-2018 of the Court of Justice of the Andean Community).

In accordance with those ideas, according to the Court of Justice of the Andean Community in preliminary ruling 369-IP-2018, distinctiveness is understood as follows:

“Distinctiveness is the capacity of a sign to individualise, identify and differentiate goods or services on the market, making it possible for the consumer or user to select them. It is considered as an essential characteristic that any sign must meet in order to be registered as a trade mark and constitutes the essential prerequisite for it to fulfil its function of indicating the business origin and, where appropriate, even the quality of the product or service, without causing a risk of confusion and/or association in the consumer public”.

Indissociable from the capability of a trade mark to **perform its essential function**, the general interest underlying is that of ensuring that **descriptive** signs or **indications relating to the characteristics** of goods or services in respect of which registration is sought may be **freely used by all** traders offering such goods and services, preventing such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see Article 135(e) of Decision 486 of the Andean Community Commission).

Expressions that are exclusively descriptive⁴ of the goods or services that the sign intends to distinguish, because they are common in the sector in which they are marketed, do not achieve the required distinctiveness and for this reason are called to constitute the absolute ground of unregistrability referred to in Article 135(e) of Decision 486 of the Andean Community Commission.

With regards to the distinctiveness of the sign to be registered, Article 135(b) of Decision 486 of the Andean Community Commission establishes that the absence of distinctiveness constitutes an independent and absolute ground of unregistrability.

As established by the Court of Justice of the Andean Community in preliminary ruling 369-IP-2018:

⁴ Regarding expressions with descriptive character, in the preliminary ruling 07-IP-2019 the Court of Justice of the Andean Community has stated the following:

“Descriptive expressions are those which exclusively inform about the characteristics or properties of the goods, such as quality, quantity, functions, ingredients, size, value, destination etc. Therefore, the descriptive denomination is the one that responds to the formulation of the question ‘what is it like?’ in relation to the product or service in question, since it is answered precisely with the expression appropriate to its characteristics, qualities or properties, as the case may be”.

“Distinctiveness has a dual aspect: a) intrinsic distinctiveness or distinctiveness in the abstract, by which the capacity that the sign must have to distinguish goods or services in the market is determined and b) extrinsic distinctiveness or distinctiveness in concrete terms, by which the capacity of the sign to differentiate itself from other signs in the market is determined”.

Although each of the grounds for refusal listed in Article 135 of Decision 486 of the Andean Community Commission is independent of the others and calls for separate examination, there is nonetheless a clear **overlap** between the scope of each of the grounds for refusal set out in Article 135(e) of Decision 486.

It is settled case-law that a sign which is **descriptive** of the characteristics of the goods or services for the purpose of Article 135(e) of Decision 486 is, on that account, necessarily **devoid of any distinctive character** in relation to those goods or services within the meaning of Article 135(e) of Decision 486. A mark **may nonetheless be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.**

Thus, a descriptive trade mark is necessarily devoid of any distinctive character, although a trade mark may lack distinctiveness due to reasons other than descriptiveness.

3.2. What are the graphic thresholds for passing the absolute grounds examination?

Despite containing purely descriptive without distinctive words, a mixed mark can still pass the absolute grounds examination if there are other elements in the mark which render the mark distinctive as a whole.

In fact, the study of a mixed mark whose nominative element is merely descriptive, but at the same time contains additional graphic or word elements that give it distinctiveness, thereby obtaining protection through its registration, falls outside the scenario described in section 3.1. Therefore, although in principle it would be prohibited to register signs with descriptive or non-distinctive expressions, these may be combined with other elements to generate fully distinctive signs, in which case they would be eligible for registration.

In this regard, the Court of Justice of the Andean Community has stated in extensive jurisprudence⁵ that *mixed signs are composed of a word element (one or several words) and a graphic element (one or several images)* and in this regard, it has also expressed that the combinations of these elements when appreciated as a whole produce in the consumer an idea about the sign that allows him to differentiate it from the others existing in the market⁶.

However, the distinctiveness of a trade mark which contains descriptive/non-distinctive word elements cannot rely on graphic elements which have no distinctive character in their own right or are minimal in nature, unless the resulting combination is distinctive as a whole.

Thus, the graphic threshold that will allow overcoming the absolute ground of irregistrability for lack of distinctiveness or descriptiveness of the word element for being merely descriptive or lacking distinctiveness, will be in the high distinctive component deposited in the graphic element of the mixed sign.

⁵ Court of Justice of the Andean Community. Preliminary rulings 46-IP-2013, 472-IP-2016, 611-IP-2018; 106-IP-2015.

⁶ In the analysis of mixed signs, it must be determined which element, whether word or graphic, penetrates more deeply into the consumer's mind. Thus, the competent authority must determine in the specific case whether the word element of the mixed sign is the most characteristic, or whether the graphic element is, or both, considering the expressive capacity of the words and the size, colour and placement of the graphic elements, and also whether the latter are likely to evoke concepts or whether they are abstract elements.

Generally, in mixed signs, the predominant element is usually the word element, because the words generate a greater impact on the consumer. However, it may happen that the predominant element is not the word element, but the graphic element, either because of its size, colour, design or other relevant characteristics that cause a significant impact on the consumer's mind, always considering the particularities of the trade mark as a whole.

For the purpose of determining the distinctive character endowed by the graphic elements in the mixed sign, the following criteria were agreed:

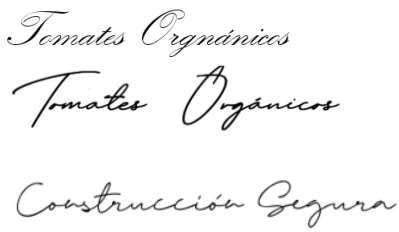
A. With respect to the word elements of the mark.


A.1. Typeface and font.

- In general, descriptive/non-distinctive word elements appearing in basic or standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable.
- Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

Examples

Non-distinctive		
Reasoning	Sign	Goods and services
<i>Basic typefaces, with or without font effects (bold, Italics)</i>	<p>Tomates Orgánicos</p> <p>TOMATES ORGÁNICOS</p> <p>Construcción Segura</p> <p>Construcción Segura</p> <p><i>Construcción Segura</i></p>	<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>
<i>Slight font variations (i.e. word in bold)</i>	<p><i>Tomates</i> Orgánicos</p> <p>Construcción Segura</p>	<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>





Non-distinctive		
Reasoning	Sign	Goods and services
<i>Handwritten and handwriting style typefaces</i>		Class 31: Tomatoes Class 37: Construction services
<i>Lower case + capital letters</i>	Tomates ORGÁNICOS CONSTRUCCIÓN Segura	Class 31: Tomatoes Class 37: Construction services
<i>Tipo de letra normal y cursivas</i>	Tomates Orgánicos Construcción Segura	Class 31: Tomatoes Class 37: Construction services
<i>Internal capitalization of letters which does not affect the meaning of the word element</i>	ToMates OrGánicos ConsTrucción SegUra	Class 31: Tomatoes Class 37: Construction services
<i>Typeface with a certain peculiarity, but remaining largely normal</i>	Tomates Orgánicos CONSTRUCCIÓN SEGURA	Class 31: Tomatoes Class 37: Construction services

Distinctive		
Reasoning	Sign	Goods and services
<i>Graphically designed typeface. Some letters are harder to recognize.</i>		Class 31: Tomatoes

A.2. Combination with colour.

- The mere 'addition' of a single colour to a descriptive/non-distinctive word element, either to the letters or as a background, will not be sufficient to give the mark distinctive character.
- Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

Examples

Non-distinctive		
Reasoning	Sign	Goods and services
<i>Addition of one single colour to a basic or normal typeface (Coloured letters).</i>		Class 31: Tomatoes Class 37: Construction services
<i>Addition of one single colour to a basic or normal typeface (Coloured background or frame).</i>		Class 31: Tomatoes Class 37: Construction services
<i>Addition of one single colour to a basic or normal typeface (Coloured outline).</i>		Class 31: Tomatoes Class 37: Construction services
<i>Addition of one single colour to a basic or normal typeface (Gradient colour).</i>		Class 31: Tomatoes

Non-distinctive		
Reasoning	Sign	Goods and services
<p><i>In this example, the application of many different colours to the lettering may catch the eye of the consumer, but it will do nothing to help the consumer to distinguish the goods and services of one undertaking from those of others, as the particular arrangement of colours will neither be perceived nor remembered by the consumers.</i></p>		<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>

A.3. Combination with punctuation marks and other symbols.

- In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements.

Examples

Non-distinctive		
Reasoning	Sign	Goods and services
<p><i>Addition of a full stop or a 'registered trade mark' sign does not add distinctive character to the sign.</i></p>		<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>

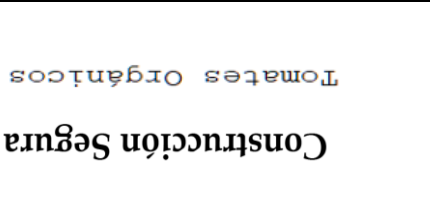
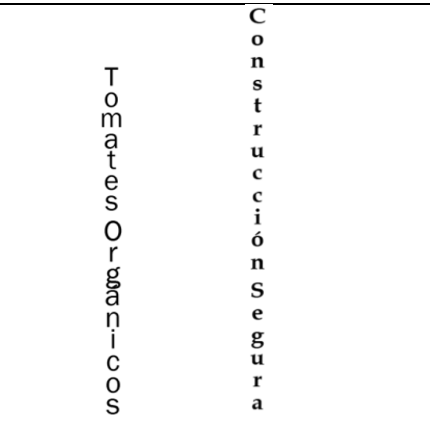
Non-distinctive		
Reasoning	Sign	Goods and services
<i>Addition of quotation marks does not add distinctive character to the sign.</i>	“Tomates Orgánicos”	Class 31: Tomatoes

A.4. Position of the word elements (side-ways, upside-down, etc.).

- The way in which the word elements are positioned can add distinctive character to a sign when it is capable of affecting the consumer’s perception of the meaning of said word elements. In other words, the arrangement must be of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message. In general, the fact that the word elements are arranged in vertical, upside-down or in one, two or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.

Examples

Non-distinctive		
Reasoning	Sign	Goods and services
<i>Text in two or more lines read from left to right.</i>	<p>Tomates Orgánicos</p> <p>Construcción Segura</p>	<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>

Non-distinctive		
Reasoning	Sign	Goods and services
<i>All the text is upside-down.</i>	 <p>Tomates Organicos Construcción Segura</p>	Class 31: Tomatoes Class 37: Construction services
<i>All the text is vertical.</i>	 <p>Tomates Organicos Construcción Segura</p>	Class 31: Tomatoes Class 37: Construction services

B. With respect to the graphic elements in the mark.


B.1. Use of simple geometric shapes.


- Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses⁷ are unlikely to be acceptable, in particular when the above-mentioned shapes are used as a frame or border.
- This is because a geometric shape which merely serves to underline, highlight or surround the word element will not have sufficient impact on the mark as a whole to render it distinctive.

⁷ The list of simple geometric shapes is not exhaustive.

- On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive.

Examples



Non-distinctive		
Reasoning	Sign	Goods and services
<p><i>Examples of simple geometric shapes which are used <u>as a frame or border</u>, not considered to be acceptable.</i></p>		<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>



Distinctive		
Reasoning	Sign	Goods and services
<p><i>Examples of particular combinations of geometric shapes with descriptive words, which render each of the marks distinctive as a whole.</i></p>		<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>

B.2. The position and proportion (size) of the graphic element in relation to the word element

- In general, when a graphic element that is distinctive on its own is added to a descriptive or non-distinctive word element, then the mark is registrable, provided that said graphic element is, due to its size and position, clearly recognisable in the sign.

Examples

Non-distinctive		
Reasoning	Sign	Goods and services
<i>The green figure appearing on the letter 'a' is hardly recognisable.</i>		Class 31: Tomatoes
<i>The graphic element is so small that is not recognisable.</i>		Class 31: Tomatoes Class 37: Construction services

Distinctive		
Reasoning	Sign	Goods and services
<i>The graphic element is distinctive in itself and large enough to be recognised in the mark as a whole.</i>	 	Class 31: Tomatoes Class 37: Construction services

B.3. The graphic element is a representation of, or has a direct relationship with, the goods and services.

As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods and services in respect of which registration is sought, without introducing any unusual variations, itself remains descriptive and cannot result in anything other than a mark consisting exclusively of signs and indications which may serve, in trade, to designate characteristics of the goods and services concerned.

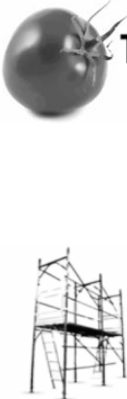

However, such a combination may not be descriptive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements with the result that it is more than the sum of its parts.


- In some cases, the graphic element consists of a representation of the goods and services claimed. In principle, said representation is considered to be descriptive or non-distinctive character whenever:
 - it is a true-to-life portrayal of the goods and services;
 - it consists of a symbolic or stylised portrayal of the goods and services that does not depart significantly from the common representation of said goods and services.
- In other cases, the graphic element may not represent the goods and services but may still have a direct link with the characteristics of the goods and services. In such cases the sign will be considered non-distinctive, unless it is sufficiently stylised.



Examples


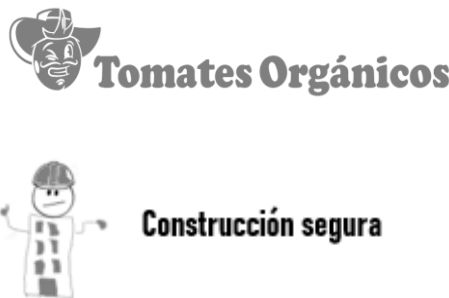
In the following examples, the marks resulting from the combination of a descriptive or non-distinctive graphic element and a non-distinctive or descriptive word element do not create an impression which is more than the sum of its parts.


Whether the graphic and the word elements are considered descriptive or non-distinctive the outcome will be the same.

Non-distinctive		
Reasoning	Sign	Goods and services
<p>Descriptive graphic element + descriptive word element.</p> <p><i>The graphic element shows the picture of a tomato and a scaffolding building frame, and therefore a true-to-life portrayal of the goods/services. Neither the typeface (basic/standard), the position of the word elements, the overall composition of the mark, nor any other elements endow the mark with the required minimum degree of distinctive character.</i></p>	 <p>Tomates Orgánicos</p> <p>Construcción segura</p>	<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>
<p>Descriptive graphic element + descriptive word element.</p> <p><i>The graphic element shows the picture of a tomato, and therefore a true-to-life portrayal of the goods/services. Neither the typeface (basic/standard), the position of the word elements, the overall composition of the mark, nor any other elements endow the mark with the required minimum degree of distinctive character.</i></p>	 <p>Productores</p>	<p>Class 31: Tomatoes</p>

Non-distinctive		
Reasoning	Sign	Goods and services
<p>Non-distinctive graphic element + non-distinctive word element.</p> <p><i>The graphic element shows a symbolic or stylised representation of a tomato that does not depart significantly from a common representation of said goods. Neither the typeface (basic/standard), the position of the word elements, the overall composition of the mark, nor any other elements endow the mark with the required minimum degree of distinctive character.</i></p>		<p>Class 31: Tomatoes</p>

Non-distinctive		
Reasoning	Sign	Goods and services
<p>Non-distinctive graphic element + descriptive word element.</p> <p><i>The graphic element shows a typical tomato, which is commonly used in trade and therefore consists of a symbolic or stylised portrayal of the goods that does not depart significantly from a common representation of said goods. Neither the typeface (basic/standard), the position of the word elements, the overall composition of the mark, nor any other elements endow the mark with required minimum degree of distinctive character.</i></p>		Class 31: Tomatoes
<p><i>The graphic element does not represent the product/services but still has a direct link with the characteristics of the product/services. The sign is not sufficiently stylised.</i></p>		<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>




Distinctive		
Reasoning	Sign	Goods and services
<p>Exception: a special combination or com-position (overall distinctiveness of two descriptive or non-distinctive elements together).</p> <p><i>By using a combination of tomatoes to represent letters 'O' this sign creates an impression which is sufficiently far removed from that produced by the mere combination of descriptive or non-distinctive graphic and word elements, being more than the sum of its parts.</i></p>		<p>Class 31: Tomatoes</p>
<p>Distinctive graphic element + descriptive word element.</p> <p><i>The graphic element consists of a personalised tomato and an animated building (construction), and therefore a symbolic or stylised representation of the goods/services that departs significantly from a common representation of said goods/services.</i></p>		<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>


Distinctive		
Reasoning	Sign	Goods and services
<p>The graphic element has a direct link with the characteristics of the goods/services, but the sign is sufficiently stylised.</p>		<p>Class 31: Tomatoes</p> <p>Class 37: Construction services</p>

B.4. The graphic element is commonly used in trade in relation to the goods and/or services applied for

- In general, graphic elements that are commonly used or customary in trade in relation to the goods or services claimed do not add distinctive character to the mark as a whole.

Examples

Non-distinctive		
Reasoning	Sign	Goods and services
<p><i>The claimed mark would be understood by the relevant public as a clear and direct indication of quality and not as an indication of the origin of the goods.</i></p> <p><i>The graphic elements are devoid of any striking, unusual or original features and will simply be seen as a common label which will not be retained by the average consumer as distinctive.</i></p>		<p>Class 31: Tomatoes.</p> <p>Class 37: Construction services</p>
<p><i>Coloured price tags are commonly used in trade for all kinds of goods, and the combination with the descriptive word elements is not sufficient to render the mark distinctive.</i></p>		<p>Class 31: Tomatoes.</p>
<p><i>Price tags are commonly used in trade for all kinds of goods.</i></p>		<p>Class 31: Tomatoes.</p>

Non-distinctive		
Reasoning	Sign	Goods and services
<i>The 'scales of justice' are commonly used in trade for legal services.</i>	<p>Servicio de asesoría jurídica</p> 	Class 45: Legal services

C. How do combinations of the above criteria affect distinctiveness?

- In general, a combination of graphic elements and word elements, which are – considered individually – devoid of distinctive character, does not give rise to a distinctive mark.
- Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case where the combination results in an overall impression which is sufficiently far removed from the descriptive or non-distinctive message conveyed by the word element.

The following table contains a selection of examples all of which contain combinations of the individual criteria assessed in the previous sections of the Practice document. The combinations presented under the red column are those which, in view of their simplicity or common nature, do not lead to a finding of distinctiveness. In contrast, the combinations presented under the green column are considered to be distinctive.

Examples

In order for a sign to be registrable, it has to have a minimum level of distinctiveness. The purpose of the scale is to illustrate where that threshold is. The examples below from left to right contain elements with an increasing impact on the distinctiveness of the marks, resulting in marks which are either non-distinctive in their totality (red column) or distinctive in their totality (green column).

Row 1:

From left to right, the first two examples combine basic or standard typeface with a word in bold/capital letters/italic. In the following case adding the colour red and the positioning of the word elements might take it a step further, but the combination (i.e. standard typeface, positioning of word elements and one colour) still does not give rise to a distinctive mark. In the third example the addition of a number of colours adds something extra but still its presentation and composition does not create an overall impression which is sufficiently far removed from that produced by the simple combination of those elements, besides consumers are unable to remember too many colours and their sequence. The fourth example combines basic or standard typeface, positioning and size of word elements and two colours, which still remains non-distinctive.

The combination of graphic elements in the two distinctive examples on the right side when considered as a whole can be perceived as a badge of origin due to the presentation and composition of the sign, creating a visual impression that is sufficiently far removed from the descriptive or non-distinctive message conveyed by the word elements.

Row 2:

From left to right, the first two examples in this set combine simple geometric shapes used as frames (rectangular and oval shape respectively) with basic or standard typeface, followed by basic or standard typeface combined with a star shape and pink colour. None of these three examples create an overall impression which is sufficiently far removed from that produced by the simple combination of those elements.

On the right-side column, non-arbitrary combinations of shapes in combination with colour and position of the word elements create a visual impression which is sufficiently far removed from the descriptive or non-distinctive message conveyed by the word element. This enables the mark in totality to be perceived as a badge of origin due to the presentation and composition of the sign.

Row 3:

From left to right, this set of examples begins with a true to life portrayal of the goods combined with two basic typefaces and font effects, followed by the addition of positioning of the word elements and colour, and subsequent addition of geometrical shape to the combination, and ending with typeface slightly stylised but still remaining largely normal. None of these examples create a visual impression that is sufficiently far removed from the descriptive or non-distinctive message conveyed. As a result, these marks will not be perceived as badges of origin.

On the right side of the line, the presentation and composition of the marks, and on the far right the presence of a recognisable graphic element which is distinctive on its own right, endows the marks with the required minimum degree of distinctive character.

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