

**GUIDELINES CONCERNING
PROCEEDINGS BEFORE THE OFFICE FOR
HARMONIZATION IN THE INTERNAL
MARKET (TRADE MARKS AND DESIGNS)**

PART B

EXAMINATION

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1. GENERAL PRINCIPLES

1.1. The system established by the Community Trade Mark Regulation is intended to afford proprietors the possibility of securing by registration a right with validity throughout the European Community to the extent that it does not impinge on others' rights. While the rights conferred by the Regulation can only be accorded in conformity with its provisions it is not the function of examiners to obstruct, but rather to facilitate applicants.

1.2. Each application must be considered on its own merits, taking account of its own particular circumstances and having particular regard to the trade mark and the goods or services the subject of the application. The examiner has to bear in mind the nature of the trade concerned, the manner in which the goods or services are provided and the relevant public, for example whether they are specialised or the general public.

1.3. Examiners must consider words in the mark and the list of goods or services by reference to the Community as a whole.

It follows from Article 7 (2) that an absolute ground for refusal applies if there is a ground for objection in any part of the Community. A part of the Community is one Member State, or a group of Member States, but not a part of a Member State, however large that might be. As regards the meaning of a word, all the official languages of the European Community must be consulted. To this end, a language check is undertaken in all these languages. If, for example, a trade mark consists of a word which in French is the name of the goods or services then the examiner must object, irrespective of the language in which the application was filed. Other languages are not to be taken in consideration.

Where an objection applies with respect to the meaning in a particular language, or to one or more Member States, as part of the Community, the applicant may seek to overcome this through proof of acquired distinctiveness (Article 7 (3)). Such proof must then relate to all those Member States, or to all those Member States in which the language is either an official language or readily understood. If, for example, a word is descriptive in English and French and acquired distinctiveness is shown based on use of the mark in the United Kingdom, the mark must still be refused because the ground for refusal relating to the French language and thereby to France persists. To refer to: CFI, T-91/99, "Options".

Since conversion is excluded for those Member States for which the Office has found a ground for refusal to exist and this decision must be made by the Register Service, examiners should use clear and neat language when referring to the language or Member State to which a ground for refusal relates. Vague assumptions such as that a mark "is probably also understood in country X" should be avoided. Objections should be limited to those grounds which can be established with certainty.

1.4. The Implementing Regulation lays down general time limits and these guidelines specify the time limits that will apply in particular cases. If before the

expiry of a time limit a request is made for its extension then a similar further period should be allowed. Further extensions should be granted only if proper reasons are given.

1.5. In all cases where examiners take decisions adverse to applicants the grounds for the decision must be given. They shall address any arguments raised by the applicant in his observations, to the extent they are pertinent. These letters will give references to the appropriate parts of the Regulation and Implementing Regulation but except in the most self-evident cases (e.g. absence of a document or fee) the reasons for any decision must be spelled out. Where, for example, a decision is given on the basis of earlier decisions or internet hits, the examiner shall provide the applicant with an appropriate reference. When evidence whose source is the internet is used to support an objection or a later decision, the examiner must in addition to providing the links, include the evidence in the notification. This arises from CFI case CFI T-317/05. Each item should show the date on which it is extracted from the site. The evidence should be copied and pasted into the notification of an objection or a decision. Where full information has been provided in an objection and a decision is subsequently based on evidence from the internet, the full information should be contained in the decision. Information which is no longer available should not form the basis of a decision adverse to the party concerned.

1.6. Applicants have a right to appeal against any decision that terminates proceedings and that adversely affects them (Article 57). For practical purposes any decision taken by an examiner which terminates proceedings and which is not accepted by the applicant falls into this category. Any written communication of such a decision will include in it a notice that the decision may be appealed within two months.

Appeals have suspensive effect. Even within the period in which an appeal may be lodged examiners should not take any step which is not easily reversible (e.g. publication). The same goes for the period until the decision becomes final if the case is brought to the CFI or ECJ by an action under Article 63.

1.7. Presently the sequence of the examination procedure is Receipt and filing date check // Classification check // Formalities check // Absolute grounds check // Translations and searches. However this changed in the past and may again change in the future (depending on the functionalities of the most recent version of EUROMARC) and therefore the original sequence of chapters has been maintained in these Guidelines.

2. RECEIPT OF APPLICATION AND FORMALITIES

2.1. Applications may be received directly or through national offices, as well as through the Benelux Trade Mark Office. The Office will mark the application with the date of receipt and its file number and issue a receipt (Rule 5) which will contain details of the applicant and the list of goods and services as entered

in the Office's database. Where the application contains indications such as "all goods in class X" or simple references to class numbers the Office will enter the respective class headings. Where the application has not been received directly the date of receipt in the Office will be shown on the receipt.

2.2. Immediately upon receipt of the application, the Office will check whether the filing date requirements under Article 26 (see 2.3.1 (i) – (iv) below) are fulfilled and if that is the case, the receipt will state that the date of receipt will also be the filing date provided that the basic application fee will be paid within one month from filing.

For applications filed through national offices, the applicant will also receive a receipt from the national office; the filing date will be the date of receipt by the national office if the application reaches the Office within two months from that date. Both dates will be shown on the receipt. If the application reaches the Office after two months, the date of receipt at the Office will become the filing date (Article 25 as amended by Regulation No 422/2004).

2.3. *Accordinging a filing date*

2.3.1. In order to accord a filing date the application must be checked to ensure that it contains (Article 26):

- (i) a request for registration of the mark as a Community trade mark
- (ii) information identifying the applicant
- (iii) a list of goods and services for which the mark is to be registered and
- (iv) a representation of the trade mark.

A check must also be done to ensure that the basic fee has been paid within one month of filing (Article 27).

As far as (i) is concerned if the application is on the Office application form or made electronically the request for registration is clear.

In relation to (ii) the full details set out in 2.5. are not required but the examiner must be clear who the applicant is.

It is not necessary under (iii) that the list of goods and services be properly classified in order to accord a filing date. The presence of a list is the minimum requirement. However, it is preferable for speed and accuracy that the applicant provide an already classified list. Office databases (EUROCLASS) provide assistance in this respect. A reference, by CTM number, to a previous CTM may replace the list of goods and services. This will facilitate and expedite the processing of the application. The Office will convert indications such as "all goods in class X" or simple references to class numbers into lists comprising the respective class headings.

Under (iv) it is essential that a representation of the mark be present. The representation of the mark must be a graphic one, i.e. an image. It cannot be replaced by a description of the mark.

For smells, there is presently no means of representing them graphically. To cite: ECJ C- 273/00, "Sieckmann", par. 70 - 72, OJ OHIM 2003, 728.

For sounds, the Office usually accepts musical notations. A verbal description of the sound such as onomatopoeia or naming the notes are not sufficient. To cite: ECJ C-283/01, "Shield mark", par. 59 - 61. However, electronic sound files are also permitted if submitted through e-filing and accompanied by any graphic representation of the sound.

Where a graphic representation (on a sheet of paper or attached file) is given but the conditions as to its preciseness are not fulfilled (e.g., if it is not in line with the ECJ judgment "Heidelberger" or "Shield mark"), a filing date will be given but later an objection will be raised.

2.3.2. If there is a deficiency in any of these respects the examiner will issue a notification, indicating that a date of filing cannot be given to the application and allowing two months for the deficiencies to be remedied or to make observations (Rule 9 (2)). If the deficiencies are not remedied within that period the file will be closed by a decision of the examiner and the applicant will be notified. The examiner will notify Finance Department that a refund of any fees paid should be made to the applicant.

If all the deficiencies are remedied within the two month period, the date on which that is done will be the date of filing. The examiner will note this on the file and inform the applicant. If the applicant's observations satisfy the examiner that the objections were unfounded, he will issue a notification allowing the date of receipt as the filing date.

2.4. Entitlement

Any natural or legal person, or person assimilated to these persons under the national law applicable to them, including authorities established under public law, may be proprietor of a Community trade mark irrespective of his nationality or domicile.

2.5. Applicant's address and address for service

The applicant must state his name, address, nationality and the State in which he is domiciled or has his seat or establishment (Rule 1 (1) b)). Names of natural persons must be indicated by the person's family name and given name(s). Companies, firms and other legal entities must indicate their official designation, which may be abbreviated (e.g. PLC, S.A.). The names of legal entities should be given in full and only their official designation may be abbreviated. The address should contain, if possible, the street, street number, city or county, postal code and country.

The applicant should indicate only one address but if there are several the first one mentioned will be recorded by the examiner as the address for service, unless the applicant specifically designates another one as an address for service.

The examiner may use the means of communication indicated by the applicant. If the telephone, fax numbers or other means of communication have not been supplied this does not constitute a formal deficiency.

Where a representative is appointed his name and business address must comply with the requirements of the first indent of this paragraph. If the representative has more than one business address or if there is more than one representative with different business addresses, the application should indicate which address should be used as an address for service. If this is not done the examiner will record the first mentioned address as the address for service.

Where ID numbers have been assigned to an applicant, a representative or an association of representatives it will be sufficient for that entity to indicate its name and number.

2.6. Professional Representation

2.6.1. Natural or legal persons not having either their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community must appoint a qualified representative to act for them in all proceedings except the filing of an application for a Community trade mark. If an application is made in these circumstances and a representative has not been appointed a notice of deficiency will be issued asking the applicant to do so. If there is more than one applicant the appointment will be governed by Rule 75 CTMIR.

2.6.2. Natural or legal persons having their domicile or their principal place of business or a real and effective industrial or commercial establishment in the Community do not need to appoint a representative but they may if they wish. For details see Part A chapter 6 of these guidelines.

2.6.3. Unless there are serious doubts, for example where there is a dispute between two representatives about who is authorised, the examiner shall not look for an authorisation. An employee must have an authorisation from his employer.

2.7. Representation of the mark

2.7.1 Categorisation of marks

The categorisation of marks (word, figurative etc) serves a number of functions. Firstly, by reference to Rule 3 CTMIR it establishes the legal requirement for the mark to be represented, secondly it can help understand what the applicant is seeking to register and finally it facilitates research in our database.

If the applicant does not wish to claim any special graphic feature or colour the mark must be reproduced in normal script, for example by typing the letters numerals and signs in the space provided in the application form (paper or online). The use of small and capital letters is permitted. This is a word mark. If

colour or special scripts are used the mark is categorised as figurative.

In other cases the mark must be reproduced on a separate sheet of paper, no larger than A4 size and the space used for the reproduction must be no larger than 26.2 cm x 17cm, with a minimum margin of 2.5 cm on the left hand side. The correct orientation of the mark, where this is necessary, must be indicated by adding “top” to each reproduction. The mark must be capable of being reproduced clearly in a space 8cm wide by 16cm high. One copy is sufficient when filed on paper. An attachment must be made in jpg format when filed electronically.

Where registration of a three-dimensional mark is applied for the application must indicate this fact. The representation must consist of a photographic reproduction or a graphic representation of the mark. Up to six different perspectives may be supplied on the one sheet.

Where registration in colour is applied for the representation must be in colour and the colours making up the mark must be indicated. It is recommended to add the reference to an internationally accepted colour code. The applicant is free to use his own description of the colours.

Where a coloured representation is supplied the application is implicitly a colour claim and is therefore considered to be for registration of a coloured mark. It is not possible to change to a black and white mark. The only option for the applicant is to file a new application with a black and white representation.

Where the representation of the mark is in black white and shade(s) of grey the mark will be categorised as black and white unless the applicant describes it otherwise, by for example providing a colour code for grey.

The representation of a colour mark *per se* must consist of a representation of the colour(s) without contour. Where there is more than one colour the proportion of each colour and how they will appear must be specified. If this has not been done in the application the examiner will notify the deficiency. If the representation contains other matter, such as words or images, it is not a colour mark *per se*.

Smell or olfactory marks are currently not capable of being represented graphically. The same appears to apply to holograms.

Other marks

Applicants may, in their applications, categorise their marks other than by the terms used above. If they do not fit within any of the above categories (e.g. position mark) they will be categorised as “other marks” and recorded accordingly in the Office database.

Applicants may identify their option for categorisation in the application but the decision on how to categorise rests with the examiner, subject to appeal. In case of a difference of opinion between the examiner and the applicant the

choice is between accepting the categorisation or facing refusal of the application under Rule 3 for word marks, colour marks, 3D marks and sound marks. For other categorisations, given simply to facilitate search, the examiner's categorisation will prevail.

2.7.2. Mark descriptions

Descriptions of marks are not compulsory but can be useful in assisting an understanding of what the applicant is seeking to register. Any description supplied must match what is shown in the representation of the mark. If there is a discrepancy the applicant should be asked to delete the description or amend it to bring it into conformity with the representation filed. The representation itself cannot be changed.

2.7.3. Adequacy of the representation

The representation of the mark together with a description, if any, must be sufficient for the examiner to see and understand what is being sought to be registered. Any deficiency can be remedied only by supplying or amending a description. No new representation may be accepted. The deficiency notice must make this clear.

2.8. *Rule 9(3) formalities checklist*

The application must also be checked to ensure that the following, where appropriate, has been provided:

CTMIR 9(3)c (i), a declaration claiming the priority of one or more previous application(s), together with the date on and country in which the previous application(s) was filed

CTMIR 9(3)d (ii), a declaration claiming exhibition priority together with the name of the exhibition and the date of first display of the goods or services

CTMIR 9(3)a (iii), a declaration claiming seniority of one or more registrations together with an indication of the Member State(s) in or for which the earlier mark is registered, the number(s) of and date(s) from which the relevant registration(s) was effective and the goods or services for which it is registered and for which seniority is claimed

(iv) an indication that the application is for registration of a Community collective mark

(v) an indication of the language in which the application was filed and of the second language indicated by the applicant

(vi) the signature of the applicant or his representative

(vii) where the mark is in colour the indication of the colours in words.

If there is any deficiency in relation to aspects of this checklist the applicant will be notified giving him two months within which to remedy the deficiency (Rule 9 (4)). If the deficiency is not remedied within that time the application will be refused by a decision of the examiner. If, however, the deficiency concerns priority or seniority the relevant right will be lost.

2.9. The examiner will need to check whether classification changes made

affect the number of classes covered by the application and then check that all the class fees have been paid. If the outstanding class fees are not paid in time the application will be deemed to have been withdrawn unless it is clear which class or classes the amount paid is intended to cover. The examiner, in the absence of other information, will take the classes into account in the order of the classification. The application will be deemed to be withdrawn for any class in respect of which the full fee has not been paid.

The examiner will note the file and issue the applicant a notification setting out the extent to which the application has been refused or deemed to be withdrawn.

2.10. Translation

2.10.1. Once the application is classified, to the extent that translation is required (i.e. if the terms are not included in EURONICE, a check which is made automatically), the list of goods and services and any other text matter (such as colour claims, descriptions) will be sent to the Translation Centre of the Bodies of the Union. The Office will take into account any translation submitted by the applicant, in particular into the second language of the application. If the Translation Centre needs to establish a translation into the second language, the applicant must be consulted on this where the first language is not one of the five Office languages, offering him a period of two months within which to propose changes in the translation. If he does not respond within this period or if the examiner considers any proposed changes to be inappropriate, the translation proposed by the Office will stand. The examiner will communicate this to the applicant. See Communication of the President No. 5/97 of 26 September 1997

2.10.2. The translations into the other official languages of the European Community will not be transmitted to the applicant. The further examination will be carried out on the basis of the language which is controlling under Article 116 (3) (the “reference language”), i.e. the first language or, where this is not one of the five languages of the Office, the second language.

3. CLASSIFICATION

3.1. The most recent version of the Classification under the Nice Agreement will be applied to the classification of the goods or services in an application (for transitional problems, see 12.6 below). Rule 2 requires the applicant to furnish a list of goods and services in the following manner:

- the list must be worded in such a way as to indicate clearly the nature of the goods or services and to allow each item to be classified preferably in only one class of the Nice Classification;
- the goods or services must be grouped according to the Nice Classification, each group preceded by the number of the class to which the goods or services belong and presented in the order of the classification.

3.2. The Nice Classification consists of, for each class, class headings,

explanatory notes, and an alphabetical list. The class headings are general indications relating to the field to which, in principle, the goods or services belong. The explanatory notes explain which goods are meant or not meant to fall under the class headings and are to be considered an integral part of the Classification. The Alphabetical List lists practically all individual goods or services under only one class. Applicants are free to choose other terms provided that they are clear and allow the term to be classified under one particular class of the Classification. However, for practical purposes (ease of classification, consistency, legal certainty), use of the terms of the Nice Classification should be encouraged.

3.3. The examiner will accept, for classification purposes, specifications that use the terms of any of the 45 class headings. Specifications that consist exclusively of “all goods in class X” will not be acceptable and will be converted into the respective class headings. None of the class headings or the terms of the Alphabetical List may be objected to as being too vague, since it allows the term to be classified correctly. For example, “transport” is acceptable without specification of the type of goods to be transported, as it is contained in the class heading of Class 39.

As regards “retail services” or other services in class 35 limited to activities around the sale of goods, the Office applies ECJ C-418/02, “Praktiker”: “Retail services” are acceptable, with or without specification of the nature of the retail activity (e.g., “supermarket”), as long as the type of goods sold at retail is indicated. For details, see Communication No 7/05 of the President of the Office.

3.4. If a term cannot be classified in accordance with the class headings or Alphabetical List the following criteria should be applied:

Goods

(a) Finished products are classified, in principle, according to their function or purpose; if that criterion is not provided for in the List of Classes, finished products are classified by analogy with other comparable finished products contained in the Alphabetical List. If none is found, other subsidiary criteria such as the material of which the goods are made or the mode of operation should be applied.

(b) Finished products which are multipurpose composite objects, for instance clocks incorporating radios, may at the request of the applicant be classified in all the classes that correspond to each of their functions or intended purposes. If those criteria are not provided in the List of Classes, then other criteria indicated in (a) should be applied.

(c) Raw materials, unworked or semi-worked, are classified, in principle, according to the material of which they consist.

(d) Goods intended to form part of another product are, in principle, classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases (a) applies.

(e) Where goods, whether finished or not, are classified according to the material of which they are made and where they are made of different materials,

such goods are in principle classified according to the material which predominates.

(f) Cases adapted to the product they are intended to contain (e.g. violin cases) are classified, in principle, in the same class as the product.

Services

(g) Services are classified, in principle, according to the branches of activity specified in the headings of the service classes and their explanatory notes or, otherwise, by analogy with other comparable services contained in the Alphabetical List.

(h) Rental services are classified, in principle, in the same classes as the service provided by means of the rented objects (e.g. rental of telephones is Class 38).

(i) Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl. 35), financial consultancy (Cl. 36), beauty consultancy (Cl. 44). The rendering of the advice, information or consultancy by electronic means (e.g., telephone, computer) does not affect the classification of these services.

3.5. Where the examiner considers that there is a need to amend the list of goods and services he should, if possible, discuss the issue with the applicant. Wherever reasonably possible he should make a proposal for a correct classification. If, however, a long list is filed which is not grouped nor classified at all (old German practice), the examiner should simply object and ask the applicant to furnish the list in a form that complies with Rule 2 and par. 3.1 above. In no circumstances may a change in the list of goods or services extend that list. A class heading covers all the goods or services that fall under that class, and restricting a class heading to a particular good falling under that class does not constitute an extension. Example: "Musical instruments" (which is the class heading for Class 15) may be restricted to "cases for violins" which fall under the Alphabetical List of Class 15, although one cannot play music on a case. To refer to: Communication No 4/03, OJ OHIM 2003/10. Where the applicant has not at all, or incorrectly, identified the class(es) for the goods or services and putting them in the correct classes extends the number of classes, this does not mean that the list itself has been extended. Example 1: An application covering beer, wines and tea in Class 33 should be corrected to Class 30 Tea, Class 32 Beer; Class 33 Wine. Although the classes are now three the list of goods and services has not been extended. Example 2: An application for "tea" may be amended into "Class 5, Medicinal tea; Class 30, Tea". Once, however, a class number is correctly attributed to a particular term by the applicant or with his agreement, this limits the goods to those falling under that class. Example 3: A list "Class 30 Tea" may not be amended into "Class 5, Medicinal tea; Class 30, Tea" as that would extend the list to goods not initially covered.

3.6. Where there is a need to amend the classification the applicant he will be advised either to file a correct classification or to agree to the examiner's proposal within two months, failing which the application will be refused. The

refusal will relate only to those goods or services which are disputed by the examiner.

3.7. *Classification of figurative elements*

As part of the search procedure the examiner will classify all applications which contain elements which are not letters or numbers according to the Vienna Classification system. This will be done without consulting the applicant.

4. **PRIORITY**

4.1. *Convention priority (Article 29)*

The applicant may claim the priority of one or more previous trade mark applications, namely a national (or Benelux) application filed in or for a State party to the Paris Convention, a Member of the TRIPS Agreement, a State for which the Commission has confirmed reciprocity, or a Community trade mark application. He may do so either in the CTM application or subsequent to the filing of the application, in which case he must submit the declaration of priority, indicating the date on which and the country in which the previous application was made, within a period of two months from the filing date. Priority may be claimed for part of the goods and services covered by the application for a Community trade mark or for part of the goods and services of the previous application(s). Within three months from the receipt of the declaration of priority the applicant must provide the Office with the file number(s) of the previous application(s), an exact copy of the previous application(s) from the authority that received it stating the date of filing of the previous application(s) ("priority document"); pursuant to Decision No EX-05-5 of the President of the Office of 1.6.2005, submitting such a priority document is not necessary where the required information is available to the Office on the Website of the respective national Office. If the priority document is not submitted, the examiner will thus first seek it on the respective Website himself and only if the information is not available, he will ask for it. In accordance with Decision No EX - 03-5, certified copies are not necessary. If the language of the previous application is not one of the languages of the Office the examiner will give the applicant three months within which to file a translation into one of the languages of the Office. This period may be extended at the request of the applicant if good reasons are provided. Extension in this case may be for up to three months.

Priority will be granted where the trade mark in the earlier application and the application for a Community trade mark are the same and the goods or services are identical or the goods or services of the Community application are contained within those of the earlier one and the proprietor in each case is the same. If the application itself or the right to priority has been assigned to the CTM applicant the proprietorship is considered to be the same. The examiner will object only if there is a clear discrepancy in any of these respects. Priority can only be granted where the application for a Community trade mark is filed within six months of the previous application(s).

If the priority claim does not satisfy these requirements, the applicant will be invited to remedy the deficiency or make observations within two months. If it is not so remedied, the examiner will inform the applicant that the priority right is lost (Rule 9 (7) and that he may request a decision on this loss of rights pursuant to Rule 54. If there is no objection from the examiner the priority claim will be noted on the file.

In order to enjoy a right of priority, the first filing must have been made in a State party to the Paris Convention or to the Agreement establishing the World Trade Organization.

In addition, Rule 101 CTMIR establishes that "*The President of the Office shall request the Commission to enquire whether a State which is not party to the Paris Convention or the Agreement establishing the WTO accords reciprocal treatment within the meaning of Article 29 (5) of the Regulation*". Up to now, three Communications on the outcome of a reciprocity search carried out by the Commission have been published in the Official Journal of the Office for Taiwan (OJ 2/1999, accepted), Andorra (OJ 3/2000, accepted) and Cayman Islands (OJ 9/2001, refused for priority).

Since then entry into force of Commission Regulation (EC) No 1041/2005 of 29 June 2005 amending Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, reciprocity findings of Rule 101 CTMIR are limited to priority within the meaning of Article 29 CTMR, (they used to include Article 5 on "Persons who can be proprietors of CTMs" as well).

The below mentioned States and other entities are not members of any of the relevant conventions nor do they benefit from reciprocity findings. Therefore, priority claims based on filings in these countries shall be refused.

Independent States (not member of PC, WTO or reciprocity agreement):	Other entities (not member of PC, WTO or reciprocity agreement):
Afghanistan (AF)	
	American Samoa (AS)
	Anguilla (AI)
Aruba (AW)	
	Bermuda (BM)
Cape Verde Islands (CV)	
	Cayman Islands (KY)
Cook Islands (CK)	
Eritrea (ER)	
Ethiopia (ET)	
	Falkland Islands (FK)
	Guernsey (Channel Island) (GC)
	Isle of Man (IM)
	Jersey (Channel Island) (JE)

Kiribati (KI)	
Marshall Islands (MH)	
Micronesia (Federated States of) ((FM)	
	Montserrat (MS)
Nauru (NR)	
Palau (PW)	
	Pitcairn Island (PN)
	Saint Helena (SH)
Somalia (SO)	
	Turks and Caicos Islands (TC)
Tuvalu (TV)	
Vanuatu (New Hebrides) (VU)	
	(British) Virgin Islands (VG)
Western Samoa (WS)	

4.2. *Exhibition priority (Article 33)*

Where the applicant wishes to claim an exhibition priority subsequent to the filing of the application the declaration of priority, indicating the name of the exhibition and the date of first display of the goods or services, must be submitted within a period of two months from the filing date. Within three months from the receipt of the declaration of priority the applicant must provide the Office with a certificate issued at the exhibition by the responsible authority.

This certificate must state that the mark was in fact used for the goods or services, the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of the first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the authority.

Priority can only be granted where the application for a Community trade mark is filed within six months of first display at an exhibition recognised for this purpose, namely a world exhibition within the meaning of the Convention of 22 November 1928. These exhibitions are very rare (see Communication No 1/03, OJ OHIM 2003, 880); Article 33 does not protect the display at other, national, exhibitions.

5. SENIORITY

5.1. Where the applicant, in his application, claims the seniority of one or more earlier registered trade marks the applicant must, in principle, within three months from the filing date submit a copy of the relevant registration.

5.2. Where seniority is claimed subsequent to the filing of the application the declaration must be submitted within two months of the filing date. It must indicate the Member State or Member States of the Community in or for which seniority is claimed, the date from which the relevant registration was effective, the number of the registration and the goods or services for which the mark is registered and for which seniority is claimed, and must be accompanied by a copy of the relevant registration.

5.3. Pursuant to Decision No EX-05-5 of 1.6.2005, the applicant is not required to file a copy of the registration if the required information is available to the Office on the Website of the respective national Office. If the copy of the registration is not submitted, the examiner will thus first seek it on the respective Website himself and only if the information is not available, he will ask for it. Pursuant to Article 3 of Decision No EX-03-5, the copy of the relevant registration must consist of a copy (simply photocopies suffice) of the registration or renewal certificate or extract from the Register, or an extract from the relevant national Gazette, or an extract or printout from a database.

5.4. The trade mark must be registered before the seniority claim is made, in a Member State of the Community, which includes a Benelux registration and an international registration under the Madrid Agreement or Protocol with effect in a Member State. A valid seniority claim requires triple identity: The registered mark must be the same as the one in the application for a Community trade mark. The goods and services of the CTM application must be identical or contained within those for which the mark is registered. The proprietor must be the same. The examiner will object only if there is a lack of identity of the marks. See Communication of the President No. 2/00 of 25 February 2000.

5.5. "Word marks" will generally be considered without reference to the type face in which they are registered. In considering whether word marks are identical the examiner will not object if, for example, one mark is in capitals and the other in lower case. The addition to or subtraction of a single letter in a word mark is sufficient for marks not to be considered identical. As far as figurative marks are concerned the examiner will object if there is any obvious difference in the appearance of the marks.

5.6. Subsidiary or associated companies of the applicant are not the same proprietor as the applicant.

5.7. Applicants may claim seniority for part of the goods and services covered by the application for a Community trade mark or for part of the goods and services of the previous registration(s). Effectively the claim to seniority will be valid to the extent that there is an overlap between the goods and services of the application and the registration relied on. The applicant is not required to specify those goods and services but may simply claim "seniority for all the goods which are found in the earlier mark to the extent they are also found in the application" (generic seniority claim).

5.8. Examination of seniority claims is limited to the formal requirements and, as regards the triple identity requirement, to the identity of the marks. If the claim to seniority does not satisfy these formal requirements or if there is a lack of identity of the marks, a notification will be issued inviting to remedy the deficiency or make observations within two months. If it is not so remedied, the examiner will inform the applicant that the right to seniority is lost (Rule 9 (7) and that he may request a decision on this loss of rights pursuant to Rule 54. Once the claim to seniority is in order the examiner will accept the claim and inform the relevant central industrial property office(s) of the Member State(s)

concerned (Rule 8 (3)).

6. SEARCH

6.1. Applications that have been given a filing date and have been properly classified will be sent to the national offices which have declared to participate in the search system.

For marks filed from 10 March 2008 and onwards (or for International Registrations, applications received by OHIM from WIPO after that date), the following will apply:

- Community search reports will be produced in all cases whereas national search reports will be prepared only on applicant's explicit request.
- A specific fee per participating national office (16 offices as of March 2008¹) must be paid for the request for national searches to be valid. The optional search fee to be paid is €192. This fee results from multiplying €12 by the number (16) of national offices participating in the optional search system.
- National search reports will be prepared by the offices that have chosen to participate in the new system. The period given to the offices for producing searches is reduced from three to two months.
- A request for national searches implies that all participating national offices will carry out the search, all of which must be paid for (all-or-nothing policy which means that the applicant cannot select for the search only some countries among the participating offices and leave out others).
- The format of the search reports is harmonized.
- National search reports will have to comply with Rule 5a of Commission Regulation (EC) No 2868/95² regarding the following minimum contents:
 - (a) the name of the national office that carried out the search;
 - (b) the number of the trade mark applications or registrations mentioned in the search report;
 - (c) the date of application and if applicable date of priority of the trade mark applications or registrations mentioned in the search report;
 - (d) the date of registration of the trade marks mentioned in the search report;
 - (e) the name and contact address of the holder of the trade mark applications or registrations mentioned in the search report;
 - (f) a representation of the trade marks applied for or registered mentioned in the search report;
 - (g) an indication of the classes, according to the Nice Classification, for which the earlier national trade marks are applied for or registered or of the goods and services for which the trade marks mentioned in the search report are either applied for or registered.

CTM application:

¹ Austria, Bulgaria, Czech Republic, Denmark, Finland, Greece, Hungary, Ireland, Lithuania, Poland, Portugal, Romania, Slovak Republic, Spain, Sweden and United Kingdom

² As modified by Commission Regulation (EC) No 1041/2005

- The request can only be made at the same time as filing the application. OHIM's official application form as well as the e-filing forms will be modified to include this option.
- The payment deadline coincides with that of the application's basic fee, namely one month from the date of filing at OHIM. Late or missing search fee payments will be dealt with as if request for national searches had not been filed and only the Community search report will be prepared in such cases.
- Payment can be made using any of the means of payment accepted by OHIM for CTM applications (currently bank transfer, current account or e-payment).

6.2. In respect of each application a Community search will be carried out of (i) Community trade mark applications with a filing date or priority date which is earlier than that of the application in question and (ii) and Community trade marks already registered. The search is designed to identify earlier marks filed for the same class, or classes considered by the Office as being neighboured (see the list in Communication No 4/99, OJ OHIM 1999, 1140).

6.3. The Community search report will be sent to the applicant by means of a standard letter together with the search reports received from national offices. At the same time, the Office will send a notice to the holders of earlier Community trade marks cited in a search report.

7. ABSOLUTE GROUNDS FOR REFUSAL

7.1. General principles

7.1.1. Reasoned objection

Where the examiner finds that an absolute ground for refusal exists he shall issue a reasoned objection in which he shall specify all the individual grounds for refusal found, and give a clear and distinct reasoning for each of them separately. Piecemeal objections, or salami tactics, or so called step by step objections, should be avoided. Each ground for refusal should have its own reasoning. In many instances some grounds for refusal, for example lack of distinctiveness and descriptiveness (Article 7 (1) (b) and (c) overlap but even in this case the grounds may not be mixed but must be given a separate reasoning. In particular, in the case of word marks having a semantic meaning, the examination shall start with Article 7 (1) (c), and in a separate paragraph Article 7 (1) (b) should be addressed, clearly mentioning whether the lack of distinctiveness arises out of the same, or different, considerations, than those which lead to considering the mark descriptive.

It suffices for the refusal of a Community trade mark that there is one of the grounds mentioned in Article 7, in only part of the Community. However, examiners are encouraged to list all grounds for refusal which are reasonably applicable, because it is not possible to substitute grounds for refusal at a later stage except if the applicant is again heard for the new ground for refusal; this applies even at the appeal stage and even in the case of a

substitution of 7 (1) (b) with 7 (1) (c) or vice versa.

It can happen that arguments brought forward by the applicant, or a restriction (partial withdrawal) of the list of goods and services, can lead to the application of another ground for refusal, but then the applicant must again be given the opportunity to submit his observations in that respect.

7.1.2. Dialogue with the applicant

In entertaining the examination proceedings the examiner should seek dialogue, not confrontation, with the applicant.

At any stage of the proceedings the examiner should carefully consider the observations submitted by the applicant, and he should equally consider on his own motion new facts or arguments that plead in favour of acceptance of the mark, as the application can only be refused if at the point in time the decision is taken the examiner is convinced that the objection is well founded. Even before the Court of First Instance will the Office bring forward all arguments that plead for accepting the mark. To refer to: CFI, T-379/03, "Cloppenburg".

Where the applicant has not submitted any observations, and provided that the examiner has not found any reasons on his own motion that might change his view, the application shall be refused by a notification which shall repeat the text of the objection, state that the application is hereby refused, and contain a notice on the availability of an appeal. It is not correct to limit the final decision to a refusal for "the reasons given in the objection".

If the applicant contests the reasons given in the original notification, the refusal should start repeating the original reasoning given and then address the arguments of the applicant.

Where the examiner needs to provide new facts or arguments to sustain a refusal the applicant must be given the opportunity of commenting on this before a final decision is taken.

Where the applicant tries to overcome the objection by restricting the list of goods and services, it may happen that this makes applicable a new ground for refusal (for example, deceptiveness in addition to descriptiveness) but in this case another objection should be issued so as to give the applicant the opportunity to comment on all grounds for refusal found pertinent.

Restrictions of the specification under a condition, for example if the examiner accepts the rest of a list of goods and services, are not valid. It is, however, possible that the applicant seeks the view of the examiner whether an amended list would be acceptable. In this case the examiner has two options: he can declare his readiness to accept the amended specifications and to this end invite the applicant to formally declare a restriction, or he can directly refuse the application for the other goods and services, in which case it would be unlikely that the applicant appealed.

As regards the proof of acquired distinctiveness (Article 7 (3)), the applicant has the right to request registration on the basis of proof of acquired distinctiveness on an auxiliary basis. If the examiner wishes to accept the mark on the basis of Article 7 (3), the refusal shall at the same time contain a reasoning why the mark falls foul under Article 7 (1), and shall contain a statement on the availability of an appeal. The applicant may then appeal this decision with the view to seeking registration without the mention that it is based on acquired distinctiveness. When the examiner intends to refuse, the refusal shall contain a reasoning why the mark falls foul under any of the grounds mentioned in Article 7 (1) (to the extent that they can be overcome through acquired distinctiveness), and a separate reasoning why the applicant's claim of acquired distinctiveness fails.

7.1.3. European criteria

Article 7 (1) is a European provision and has to be interpreted on the basis of a common European standard. It would be incorrect to apply different standards of distinctiveness, based on different national traditions, or to apply different, that is more lenient or stricter, standards on the breach of public order or morality, depending on the country concerned.

However, Article 7 (2) excludes an application from registration if a ground for refusal pertains in only part of the Community.

That means that it suffices for a refusal if the mark is descriptive, or lacks distinctive character, in one or more official languages of the European Community, regardless of the size of the respective Member State or the number of the population of that Member State. It also suffices for refusal on the grounds of deceptiveness or breach of public morality if the deceptive, offensive or blasphemous meaning of the word is only apparent in one particular official language of the European Community, or is due to a particular situation in one Member State (for example, a blasphemous term in respect of a religion which exists in only one Member State).

Where the objection is not based on a semantic meaning of a word, the ground for refusal will normally pertain to the Community as a whole. However, the perception of the sign by the relevant public, the practice in trade, or the use or relevance of the goods and services claimed may be different throughout the European Community.

7.1.4. Irrelevant criteria

Frequently applicants advance arguments that have already been declared irrelevant by a CFI and ECJ case law and these should be rejected by citing the corresponding passages of those judgments.

Term not used

The fact that a descriptive use of the term applied for cannot be ascertained is

irrelevant. Examination of Article 7 (1) (c) has to be made by means of a prognostics (assuming that the mark would be used on or with respect to the goods or services claimed), and it follows clearly from the text of Article 7 (1) (c) that it suffices if the mark “may serve” to designate characteristics of the goods and services.

To cite: ECJ, C-191/01, “Doublemint”, par. 33

No need to keep free

Frequently it is advanced that other traders do not need the term applied for, can use more direct and straight forward indications or have synonyms at their disposal to describe the respective characteristics of the goods. All these arguments must be refused as irrelevant.

Although there is a public interest underlying Article 7 (1) (c) that descriptive terms should not be registered at trade marks so as to remain freely available to all competitors, it is not necessary for the Office to show that there is a present or future need or concrete interest of third parties to use the descriptive term applied for (no konkretes Freihaltebedürfnis). To cite: ECJ, C-108/97, “Chiemsee”, paragraph 35; ECJ, C-363/99, “Postkantoor”, paragraph 61.

Factual monopoly

Whether the applicant is the only person offering the goods and services for which the mark is descriptive, is not relevant for Article 7 (1) (c). However, in this case, he will be more likely to succeed on acquired distinctiveness.

Whether there are synonyms, or other, even more usual ways of expressing the descriptive meaning, is irrelevant. To cite: ECJ, C-265/00, “Biomild”, paragraph 42.

Term not “Exclusively descriptive”

If an applicant argues that the sign is not “exclusively descriptive”, it should be rebutted that this is an incorrect reading of the text of Article 7 (1) (c). The word “exclusively” in Article 7 (1) (c) refers to the terms the trade mark consists of, not to the descriptive meaning. To rely on: ECJ, C-191/01, “Doublemint”, paragraph 33.

Double meaning

The frequent argument of applicants that the terms applied for has more than one meaning, one of them not being descriptive for the goods, should be rejected: It suffices for a refusal under Article 7 (1) (c) if at least one of the possible meanings of the term is descriptive. To cite: ECJ, C-191/01, “Doublemint”, paragraph 32; confirmed by ECJ C-363/99, “Postkantoor”, paragraph 97.

It is even less relevant if one of the meanings applies to completely different

field (as the examination must focus on the goods and services claimed), for example for guitars, whether “Rockbass” is also a fish species, or whether from a composite word mark one of the individual elements has, on its own, several meanings, as the examination must focus on the trade mark as a whole. Even in those scenarios, “Doublemint” and “Postkantoor” should be cited a fortiori.

7.1.5. Scope of objections on the goods and services

Almost all absolute grounds for refusal, and in particular the most pertinent ones of lack of distinctiveness, descriptiveness, genericness and deceptiveness, have to be assessed with respect of the goods and services actually claimed.

As regards descriptiveness, an objection applies for those goods and services for which the term is directly descriptive, as well as for a generic term covering various terms one of them describing the characteristics of the goods and services. For example, “EUROHEALTH” is to be refused for “insurances” as a whole and not only for health insurances. To cite: CFI, T-359/99 “Eurohealth”, paragraph 33.

An objection also arises for those goods and services which are directly linked to those for which the descriptive meaning pertains. Furthermore, if the descriptive meaning arises for a complex activity involving the use of several goods or services mentioned separately in the specification, then the objection arises for all of them. To refer to: CFI, T-355/00, “Tele Aid”, for a number of goods and services that are in conjunction with, or are applied in, offering aid to car drivers at a distance.

It is possible to claim goods and services as so-called auxiliary goods or services in the sense that they are meant to be used with, or support, the use of the main goods or services. Typically, this covers paper and instruction manuals for the goods to which they belong or which are packed in them, advertisement or repair. The other side of the coin is that these auxiliary goods or services share the objection on lack of distinctiveness or descriptiveness, unless the list of goods and services does not contain these auxiliary goods and services.

7.1.6. Timing of objection

It has been said that the objections should be raised as early and as complete as possible. However, in rare cases, the Office will have to reopen the examination procedure if it would be clearly a mistake to accept the mark. This can happen at any time before registration, i.e. even after publication. This can happen as a result of third party observations (Article 41 CTMR), or even ex officio. For example, if an application is refused by a final decision, the examination of a similar application for which the same considerations apply can be reopened. To refer to as an example: T-289/02, “Telepharmacy Solutions”.

7.2. Relationship among various grounds of refusal

The objection and, eventually, the refusal shall include all grounds for refusal which are pertinent. Each ground for refusal should be reasoned separately. In particular so as to avoid confusion whether the refusal was based on Article 7 (1) (b) or 7 (1) (c) or both, each of those grounds for refusal should receive a separate heading. It should be avoided to throw in different grounds for refusal piecemeal through the course of the examination procedure. If, however, the applicant amends the mark in such a way that a new ground for refusal becomes operative, then that should be raised. Example: where the applicant restricts the list of goods and services in such a way that the mark becomes misleading.

Likewise, where an application has been judged by the Boards of Appeal or eventually by the Court of First Instance and the case is remitted to the examiner for further prosecution, it shall be limited to those grounds for refusal that had already been in issue, even where, strictly speaking, the *res judicata* effect of the judgement of the Court is limited. Reason: procedural economy and the need to give “*effet utile*” to the judgment of the Court.

If several grounds for refusal are raised, the applicant must overcome all of them. For reasons of procedural economy, the decision can then be based on the ground for refusal which has definitely not been overcome, as the existence of one ground for refusal suffices. To cite: ECJ C-104/00 P, “*Companyline*”, paragraph 28.

If a mark is descriptive, this shall be the first issue addressed in the objection and any eventual refusal.

If the descriptive meaning is immediately apparent to the target public, the mark is also non-distinctive. A term which is conveying a purely informational message about the goods or services is not apt to distinguish goods or services as to their commercial origin.

In these cases, it must be stated that for the same reasons, the mark is also non-distinctive. To cite: ECJ, “*Postkantoor*”, C-363/99, par. 86.

If in such a case the descriptive meaning is not upheld, or not upheld for all goods or services, the mark must, logically, also be accepted under Article 7 (1) (b).

The following chapters of these guidelines will firstly address descriptiveness (as regards word marks, be it a single term or a combination of descriptive terms) secondly combinations of descriptive terms with non-descriptive but non-distinctive terms or with non-distinctive figurative elements, and thirdly non-distinctive marks (word marks, including slogans and laudatory terms, figurative elements, other types of marks).

7.3. Descriptiveness (Article 7 (1) (c) CTMR)

7.3.1. Categories

Descriptive marks are those that limit themselves to provide information about the goods and services in question. The trade mark must consist *exclusively* of descriptive matter. Additional matter in the trade mark that is not descriptive brings the mark outside the scope of Article 7(1)(c).

The **reference base** is the ordinary understanding of the word in question.

That can be corroborated by **dictionary entries**, examples of the use of the term in a descriptive manner found on Internet **Websites**, or it may clearly follow from the **ordinary understanding** of the term. To that extent, it is not necessary for the examiner to refuse a trade mark, to prove that the word is as such subject to dictionary entries. In particular for a composite term, dictionaries do not mention all possible combinations. What matters is the ordinary and plain meaning. In addition, terms which are used in a specialist terminology to designate the respective relevant characteristics of the goods and services are to be considered descriptive. In these cases it is not required to show that the term is immediately apparent to the relevant consumers to which the goods and services are addressed, it suffices that the term is actually used, and meant to be used, in a descriptive way. Reason: the informational value of an information is not tempered by the fact that people without knowledge of the area in which the information is meant to arise do not understand it, or cannot place it in the appropriate context.

A second category of descriptive terms are those which consist of **abbreviations**. In order to be able to refuse them, it is not only necessary for the examiner to show that the abbreviation actually is a composition of terms which on their own are purely descriptive, but in addition it must be shown that this abbreviation is commonly used or at least understood by the relevant specialists in the fields, as an abbreviation identifying the goods as to their characteristics, rather than as an abbreviation used by only one or two traders to designate their own products. Again, in this group of cases, if the abbreviation is generally accepted in the relevant field, it is not necessary to show that the end consumer understands the abbreviation. Example: LITT descriptive for certain medical apparatus because used as an abbreviation in medicinal literature for “laser-induced thermo therapy” (CD, C 573).

A third category of descriptive terms are those which are, so to say, **descriptive as of law**, because the descriptive nature of the term has been specified in Community law or another legal instrument which is either binding or to be taken into account by the Office. This applies for all registered geographical indications, as well as for international non-proprietary names. Under this heading, all registered geographical indications, be it under Council Regulation 510/06, regulations governing wines or spirits or under bilateral agreements of the EC with third countries such as Australia, South Africa and Chile have to be refused. Some of them do not actually specify existing regions or cities but they have been declared geographic by virtue of law. Examples: Vinho verde, Cava. Also, international non-proprietary names fall into this category, which are protected by the World Health Organisation for

the purposes of identifying medicinal substances through unique, internationally accepted terms.

The public interest underlying Article 7 (1) (c) is that no exclusive rights should be created in purely descriptive terms which other traders might wish to use as well, as well as in the interest of the public that terms which have a purely informational value should not be reserved for one single trader (subject, of course, of the possibility to obtain registration through evidence of acquired distinctiveness). However, it is not necessary for the examiner to show that there is already a descriptive use by competitors of the CTM applicant. Nor is the examiner required to establish that third parties in the future might have a specific interest in using the term as a descriptive term. In that sense, the ECJ judgement C-108/97 "Chiemsee" has expressly rejected the so called "Freihaltebedürfnis" (the need to keep free for general use). This has in particular the consequence that if a word is descriptive in its ordinary and plain meaning, this ground for refusal cannot be overcome by showing that the applicant is the only person who produces, or is capable of producing, the goods in question. For example, if a trade mark for beer consists exclusively of the name of the city in which the beer is brewed, and if the name of the city is known to the public as a place name, it is not relevant if the trade mark applicant is the only producer in that city and if it is unlikely that other competitors will settle in that city because for many decades they have never done so. In that sense also, it is not appropriate to make the standards on assessment of descriptiveness contingent to the number of competitors that could be affected (in the sense of "the less competitors there are, the more descriptive must the mark be to be refused").

The following **subcategories** of Article 7 (1) (c) can be mentioned:

Kind of the goods:

- The goods or services themselves, that is, their type or nature. This is also referred to as generic terms. Examples: Bank for financial services, Universaltelefonbuch for a universal telephone directory.

Quality:

- Includes both laudatory terms, referring to a superior quality of the respective goods, as well as the inherent quality of goods. Covers terms such as "light", "extra", "fresh", "hyper light" for goods that can be extremely light (R 1215/00-3).

Quantity:

- Covers indications of the quantity in which the goods are usually sold, such as "six pack" for beer, "one litre" for drinks, "100" (gram) for chocolate bars, "2000" for referring to the size of the motor for cars. Only quantity measurements relevant in trade, not those that are hypothetically possible, count.

Intended purpose:

- The intended purpose can be the way, the means of application, or the function in which a good or service is to be used. This also covers the matter

of use. This ground for objection is frequently overlooked and in particular it is wrong to reduce Article 7 (1) (c) to generic indications as to the nature of the goods and services themselves. To refuse on this basis: “Inhale” for pharmaceuticals that can be inhaled (R 6/00-2), “Therapy” for massage tools (R 144/99-3). This objection also applies as regards accessories: A term that described the type of goods describes also the intended purpose for accessories to those goods. Therefore, “New Born Baby” is objectionable for accessories for dolls and “Rockbass” for accessories for rock guitars (CFI, T-315/03).

Value:

- Covers both the (high or low) price to be paid, as well as the value in quality. Covers therefore not only expressions such as “extra” or “top”, but also expressions such as “cheap” or “more for your money”. Covers also expressions indicating, in common parlance, goods that are superior in quality, such as “premium”.

Geographical origin:

- See paragraph 7.6.5 below

Time of production of the goods or of rendering of the service:

- Covers expressions concerning the time on which services are rendered, either expressly (“evening news”, “24 hours”) or in a usual manner (24/7). Also covers the time on which goods are produced if that is relevant for the goods (late vintage for wine). For wine, the numeral “1998” indicating the vintage year would be relevant, for chocolate not.

Other characteristics of the goods

This item must be construed as also covering other characteristics of the services. This item shows that the preceding list of items in Article 7 (1) (c) is only by way of example. Any relevant characteristic of the goods and services must lead to a refusal under Article 7 (1) (c).

Examples of “other characteristics”:

- the subject matter: “Elektronika” for fairs and exhibitions (CFI T-32/00)
- the definition of the targeted consumer: “children” or “ellos” (CFI, T-219/00) for clothing.

This also covers technical characteristics of the goods not falling under the above sub items, for example “Trustedlink” for goods and services in the IT-Sector aiming at securing a safe (trusted) link. (CFI, T-345/99).

Categories of marks

7.3.2. One word

Descriptive terms shall be refused under Article 7 (1) (c). Descriptive terms are those which consist 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 of rendering of the service, or other characteristics of the goods or services”.

Descriptive terms are those which consist of objective information about characteristics of the goods and services, so as to distinguish them because of their nature (rather as to their commercial origin) from like or similar goods and services and enable the consumer to make their choice in respect of the inherent quality, function, type or other characteristics of the goods and services, rather than as to their commercial origin. For that reason, descriptive terms cannot fulfil the function of a trade mark. For the same reason, the ground for refusal applies irrespective of whether the respective term is already used by other competitors in a descriptive manner for the respective goods and services.

The term need not be the precise and exact definition of a particular characteristic of the goods. It suffices for a refusal under Article 7 (1) (c) if there is a sufficiently direct and concrete relationship between the term and the goods and services. To rely on: CFI T-106/00, "Streamserve", paragraph 40; CFI T-173/03, "Nurseryroom", paragraph 20.

Article 7 (1) (c) covers scientific definitions of characteristics of the goods or services but are not limited to them. Also those terms are to be refused which are not scientifically correct but which have, from the standpoint of the relevant public, a purely informational meaning. Not only trade marks, but also descriptive messages are usually short and esays-to-grasp. Consumers do not tend to embark on analytical or complex analyses of indications on goods they are confronted with, and that is equally true for those indications which are descriptive.

In particular:

The mark is descriptive if either for the general public (if the goods are addressed to them) or for a specialized public (irrespective whether the goods are also addressed to the general public) the trade mark has a descriptive meaning. On this basis to be refused:

- SnTEM for goods consisting of tempered tin (CFI, T-367/02);
- Cupuaçu for food products that can contain this Amazonian fruit (CD,764C);

Furthermore, also those terms are descriptive which describe desirable characteristics of the goods and services. Examples:

- Extra (refused: XTRA, R 20/97-3, OJ OHIM 1998, 1044)
- TOP (R 314/99-1, OJ OHIM 2003, 282)
- PRIMA (R 83/99-2, OJ OHIM 2000, 1346)
- LITE (T-79/00).

Such terms are excluded from registration for almost all goods and services. However, it is important to distinguish laudatory terms in the sense that they describe, although in general terms, desirable characteristics of goods and services as being cheap, convenient, of high quality etc., which are excluded from registration, from those terms which are laudatory in a broader sense, without specifically referring to the goods and services, but referring to vague positive connotations or to the person of the purchaser or producer of the goods.

Not descriptive:

- BRAVO (to consult: C-517/99, "BRAVO") (who says "BRAVO" to whom, who praises what?)
- Best Partner (R 278/00-1); in this regard not to be followed: T-360/00, "ULTRA PLUS"

The relationship between the mark and the descriptive meaning must be concrete, direct and without further reflection (to refer to: CFI, T-345/99, "Trustedlink", paragraph 35). There must be a sufficiently close relationship between the goods and services and the mark (to rely on: CFI, T-219/00, "Ellos", paragraph 35).

On the other hand, Article 7 (1) (c) does not apply to those terms which are only suggestive or allusive as regards certain characteristics of the goods. Sometimes this is also referred to as vague or indirect references to the goods (to consult: CFI, T-135/99, "Cine Action", paragraph 29).

The dividing line is difficult to draw. Suggestive terms are those which suggest certain characteristics of the goods without really describing them, but it must be born in mind that it suffices for the application of Article 7 (1) (c) if there is a sufficiently direct relationship between the mark and the goods. A suggestive, registrable term is, for example, "Tee campaign", suggesting a publicity campaign for tea. Allusive terms can best be described as a play with words. For example, "it is only lunch" is allusive for match making agencies as this is exactly the opposite what the client expects.

As regards the reference base,

- language-wise,
- dictionary-wise,

the following principles apply:

The mark must be refused if it is descriptive in any of the official languages of the European Community, regardless of the size or population of the respective country (see in particular Article 7 (2) and CFI, T-91/99, "Options"). The objection should clearly state which language or languages are concerned, which makes the ground for refusal applicable at least for the Member States in which this language is the official language or one of the official languages, and excludes conversion for that Member State (see Rule 45 (4)).

An Internet search is also a valid means of evidence for the descriptive meaning, in particular for new terms or slang words, but the evidence should be carefully assessed whether the word is actually used in a descriptive manner, as often the difference between descriptive and trade mark use on the Internet is vague and the Internet contains a vast amount of unstructured, unverified information or statements.

7.3.3. *Two words*

As it is not necessary for a refusal to show that the mark appears in a dictionary or is actually in descriptive use, the mark must also be refused under Article 7(1) (c) if it consists of two descriptive terms which cannot be shown to have been used together, but which are juxtaposed in a grammatically correct structure and are actually understood in their descriptive meaning. This applies when the two terms create a new descriptive meaning or reinforce each other in their descriptive meaning.

The test is: As a general rule, a mere combination of elements each of which is descriptive of characteristics of the goods or services itself remains descriptive of those characteristics. Merely bringing those elements together without introducing unusual variations, in particular as to syntax or meaning, cannot result in anything other than a descriptive mark. A trade mark consisting of a neologism composed of elements each of which is descriptive of characteristics of the goods or services in respect of which registration is sought is itself descriptive, unless because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts. To cite: ECJ, C-265/00, "Biomild" paragraph 39, 43.

In the example "Biomild", this must be refused for yoghurt as referring to a yoghurt being mild and organic. Other terms which fall foul under Article 7 (1) (c): Companyline, Trustedlink, CineComedy, Teleaid, Quickgripp, Twist and Pour.

Those notions, "unusual nature of combination", "impression sufficiently far removed" and "more than the sum of its parts" have to be interpreted as meaning that Article 7 (1) (c) does not apply when the way in which the two descriptive elements are combined is in itself fanciful.

The exact grammatically correct use of nouns and adjectives is not decisive to check whether there is a syntactically unusual juxtaposition. Rather, it should be assessed whether the meaning of the word combination is changed if it is inverted. For example, "Vacations direct" (not registrable, R 33/00-3) is tantamount to "direct vacations", and "Cine Action" is tantamount to "Action Cine", whereas "BestPartner", is not the same thing as "PartnerBest" and the German term "Sportschule" is different in meaning from "Schulsport".

Combinations made up of two words from two different languages are registrable, provided however, that the use of the respective other term in both languages is unusual. Registrable: "Pan Spezialitäten" (CD, 507 C).

Duplicating a descriptive message remains descriptive. Thus, "Pure digital" to be refused for (digital) radios, irrespective of whether digital sound is always pure or whether particular measures are needed to transform digital signals into a pure sound (refused, R 108/04-2).

Inherent contradictions can make the mark registrable. They may have the

effect that the descriptive meanings cancel each other out. For example, registrable: "Mode=ADC" (R 90/98-1). On the other hand, antagonisms need not contradict themselves: "Inhouse-Outsourcing" should, contrary to R 57/99-3, be objectionable as the services might exactly be related to define those activities that are to be outsourced and those that remain in in-house.

7.3.4. Misspellings, omissions

Frequently a word, or word combination, will not be filed exactly in the correct way it is to be written, but slightly changed.

First of all, the mere writing together of two words without a back space, or the addition of or omission of a hyphen, is irrelevant and the mark remains objectionable. This is in particular truth for the English language.

Misspellings of letters that are usually misspelled, for example due to influences of American English, in slang language or to make the word more fashionable, remain all objectionable. Example of marks that have been refused: "XTRA", R 20/97-3, OJ OHIM 1998, 1044; "Lite", CFI, T-79/00, OJ OHIM 2002, 1068; "Xpert", R 1230/89-3; "EASI-CASH", R 96/98-1.

On the other hand, if the misspelling is fanciful and/or striking (accepted: "Indx", CTMA 1104710) or changes the meaning of the word (invented example: Minute Maid instead of Minute made), the mark is acceptable.

The Office reads paragraph 99 of ECJ, C-363/99, "Postkantoor" in the above way. The Office does not interpret this as meaning that a mark must be refused under Article 7 (1) (c) if the way it is to be pronounced leads to a descriptive term. Arguments of phonetic or visual similarity or identity have their place under Article 8 but not under Article 7.

As regards omissions, frequently applicants argue that the trade mark as filed is not the full descriptive term as it would be used. This argument has to be refused from the outset because it insinuates examination of another trade mark, not the one actually filed.

7.3.5. Abbreviations and acronyms

An exception applies for abbreviations. Abbreviations of descriptive terms are in themselves only descriptive if they have actually been used that way and the relevant (general or specialized) public recognizes them as being identical to the full descriptive meaning. The mere fact that an abbreviation is derived from a descriptive term is not enough.

Refused, because the descriptive meaning for the specialized public could clearly be shown:

- SnTEM, CFI, T-367/02, OJ OHIM 2005, 544
- TDI, CFI, T-16/02
- LIMO, CFI, T-311/02, OJ OHIM 2005, 734
- BioID, CFI, T-91/01, OJ OHIM 2003, 466;

- LITT, CD, 573 C.

If a clear, and not only hypothetical, descriptive function of the abbreviation cannot be ascertained or if there are so many possible meanings that the abbreviation is not directly referring to any of them, the mark is registrable.

Use of Internet databases such as “acronym finder” should be made with greatest care, as those show any abbreviations of meaningful words irrespective of whether these are used as trade marks or as descriptive indications. Much better are technical reference books or popular scientific literature for example in the field of computing.

7.3.6. Slogans

A slogan is always registrable if it contains a word (or words) which is (are) distinctive on its (their) own. Example: “Carlsberg - Probably the Best Beer in the World”.

A slogan can be descriptive (see above, criteria for descriptiveness of word combinations) if it is limited to highlighting desirable characteristics of the goods or services. Examples for descriptive slogans: “Mehr für Ihr Geld”, (CFI T-281/02) “Looks like grass, feels like grass, plays like grass” (CFI, T-130/01) “Real people, real solutions” (CFI T-130/01). Descriptive slogans are also non-distinctive.

Furthermore, those slogans are non-distinctive which are limited to general invitations to buy, laudatory statements or seek to promote the superior knowledge, client friendliness, economic success, or availability of the trade mark applicant. Examples: “WE KNOW INSURANCE” (class 36), “TWO DAYS A WEEK” (class 41) R943/04-4.

On the other hand, slogans are distinctive if they contain an element of fancifulness, for example by playing with words, using an element of irony, by alliteration and rhyme, or by conveying subliminal messages.

Examples: “YOUR SPARE CHANGE COULD CHANGE YOUR LIFE” (class 41), “FEEL AT HOME WHILE YOU ROAM” (class 38), “LISTEN AND YOU’LL SEE” (class 9), “IMPOSSIBLE IS NOTHING” (class 25, 28 and 41).

7.4. Descriptive terms + non distinctive word or device elements

When descriptive terms are combined with other elements which are not in themselves descriptive (be it word elements, letters, numerals or figurative elements), examination must start from the following principles:

A mark is distinctive if at least one of its elements is distinctive on its own. Therefore, if a descriptive term is coupled with a distinctive term, the mark is registrable (easy example: light is not registrable, Pepsi light is). These cases are not problematic. Problematic are those cases where the element which is added to the descriptive term is not distinctive on its own.

The mark is also distinctive if, although none of its elements is distinctive on its own, the overall combination (the mark as a whole) is distinctive.

The case where two words, each of them being descriptive, are combined has already been discussed above under 7.3.3. In this case the mark is distinctive if the way the two words are combined is a syntactically unusual juxtaposition, fanciful or “more than the sum of its parts”.

The same criteria must be applied if a descriptive term is coupled with the term which is not descriptive, but also not distinctive. Also in this case, combining two unregistrable elements can only render the mark distinctive as a whole if the way the two elements are combined has something fanciful or being “more than the sum of its parts”. The irony expressed by Advocate General Jacobs in his opinion on the case “SAT2” that all words are made up by unregistrable single letters is missing the point. The point is that if each of - separately recognizable, not artificially segregated- elements of a mark is non-distinctive, the distinctiveness of the combination can only lie in the way the combination is made up.

In this perspective, ECJ C-329/02, SAT2, does not even give an appropriate help for resolving this problem because on the one hand the statement that the mark must be assessed as a whole is self explanatory and on the other hand, “SAT2” has expressly stated that it is proper to take the criterion of fancifulness into account.

7.4.1. Descriptive words + verbal elements, letters or numerals

Merely combining a non-distinctive verbal element with another descriptive verbal element cannot make the combination distinctive. Therefore, combinations of “EURO” and purely descriptive terms must be refused where the “EURO” element reinforces the descriptiveness of the mark as a whole or where there is a reasonable connection between that term and the goods or services concerned..

- This is inline with CFI, T-359/99, “Eurohealth”. Not to be followed: CFI, T-334/03, “Europremium”, OJ OHIM 2005, 518.

To be relied on: R 219/04-1, “TRV4” (refused, based on the meaning of “Thermostatic radiator valve”).

7.4.2. Descriptive terms + figurative elements

Again, if a figurative element which is distinctive on its own is added to a descriptive term, the mark is clearly registrable.

In order for the mark to be registrable, the added figurative element, if in itself distinctive, needs not be “dominant” or “co-dominant”. It suffices that it is clearly recognizable.

Where the figurative element, separately recognizable, is not distinctive on its own, or where the descriptive term is presented in a non-standard type face or with coloured letters, underlining or other graphic presentation, the situation is:

Presenting a word as a figurative mark, or presenting it in standard type faces or italics, cannot render the mark distinctive. Examples: CFI, T-32/00, "Elektronica", OJ OHIM 2001, 608; CFI, T-91/01, "BioID", OJ OHIM 2003, 466.

In this sense, standard typefaces are not just Arial and Times New Roman, but all typefaces that by an average consumer would be perceived as just another common typeface.

It is common place in trade to use also descriptive terms in colour or in special graphic presentation. Also terms that appear on the goods in an eye catching way are descriptive. Therefore, merely presenting a descriptive term in coloured letters, inclined, in a frame, with standard ornaments or with other non-distinctive graphic elements cannot render the mark distinctive. The following cases where the mark has been refused show best the border line:

- CFI, T-122/01, OJ OHIM 2003, 2006



- Board of Appeal, R1155-2004



Anything that has a higher degree of fancifulness than those should be acceptable, if it can be satisfied that the mark as a whole, seen globally, appears as a distinctive device on its own and thus more than the sum of its individual parts. For example, the following have been accepted:

CTM 657627



CTM 788455



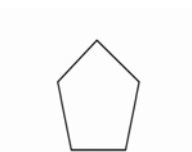
7.5. Distinctiveness (Article 7 (1) (b))

A mark is distinctive if it can fulfil its essential function to guarantee the identity of the origin of the marked goods or services to the consumer by enabling him without any possibility of confusion to distinguish the goods or services from others which have another origin. A trade mark must distinguish the goods or services concerned as originating from a particular undertaking. (ECJ, C-104/01, “Libertel”, paragraph 62, and constant case law of the ECJ and CFI). Whilst the ECJ derives the notion of distinctiveness from the function of a trade mark, the notion of distinctiveness is to be viewed from the stand point of the consumer (rather than of the competitor, who is also a stakeholder). Although it is commonly accepted that a minimum degree of distinctiveness suffices, it must also be taken into account that in order to be distinctive as a Community trade mark, the mark must be distinctive with regard to the Internal Market as a whole and not only if used in a particular local environment.

7.5.1. Simple geometric devices

Simple geometric devices such as rectangles, circles, or even pentagons, are non-distinctive.

Refused:



CFI case T304/05

7.5.2. Commonplace or usual figurative elements

Figurative representations that are commonly used either in relation to the goods and services applied for, or as such, in a decorative or functional – or even descriptive – manner have to be refused.

For example, the naturalistic representation of a wine leaf is not distinctive for wine. Commonly used pictograms, for example a white “P” on a blue background to designate a parking place or the design of an ice cream to designate that ice cream is sold in the vicinity, are not distinctive.

Also, graphic symbols commonly used in a functional manner have to be

refused, such as the @-symbol or the symbols representing currencies such as €, £, \$. This objection applies to all goods and services.

Figurative marks showing a graphic representation of a naturalistic reproduction of the goods themselves are only registrable under the same conditions as if they were filed as a 3-dimensional trade mark (CFI, T-30/00).

The representation of the place or building where the goods are supposed to be sold is not a distinctive for those goods. To be refused: A photo taken of the restaurant, for restaurant services, or the so called “smart turn” for cars (R-1/2003-4).

7.5.3. Numerals, single letters

Following the decision R 4/98-2, IX, OJ OHIM 1998, 1058, the Office no longer considers combinations of two letters or numerals being devoid of distinctive character (although these must be carefully assessed as to any descriptive meaning).

However, the Office still applies an objection under Article 7 (1) (b) for single letters or numerals. This is justified in particular in view of the limited number of letters or numerals available for other traders. For example, the numeral called “7” was refused for cars (R 63/99-3, OJ OHIM 2000, 208).

However, single letters or numerals are registrable if they are sufficiently stylized, in such a way that the overall graphic impression prevails over the mere existence of a single letter or numeral as such. For example, the following were accepted:

- CTM 545541
- CTM 930735
- CTM 914887
- CTM 270264

In other words, those signs are registrable if they are not just merely reproducing the numeral or letter in another typeface.

7.5.4. Verbal elements

Verbal elements are non-distinctive only if they are so frequently used that they have lost any capacity to distinguish goods and services.

The following terms, alone or in combination with other unregistrable elements, fall foul under this provision;

Top level domain endings, such as .com, only indicate the place where information can be reached on the Internet and thus cannot render a descriptive or otherwise objectionable mark registrable. Thus, www.books.com is as objectionable for printed matter as the term “books” alone. Likewise, abbreviations of the **legal form of a company** such as Ltd.,

GmbH cannot add to the distinctiveness of a sign.

Likewise, terms designating that the goods and services are rendered by a **group of people** are unregistrable, such as “company, people” (for establishments) “Club”. For example, “Kitchen Company” is unregistrable for kitchens.

This is different if the sign as a whole does not merely refer to the goods and services in the abstract but creates the overall impression of a distinct, identifiable entity. Examples: “Royal Society for the Prevention of Cruelty to Animals”, “International Trade Mark Association” “Institute of Engineers” would all be registrable.

The @ symbol is non-distinctive. The letter **e-** in front of goods and services to be delivered electronically is non-distinctive (e-learning, e-commerce, e-business, e-filing, etc.)

Likewise, indications that merely denote a superior geographic **scope of business** activity, such as national, international or global, are generally not registrable, either alone or in combination with descriptive terms. However, if the use of the term appears fanciful e.g. “Global Hairdressing” for hairdressing services it is acceptable.

The following terms merely denote a particular **superior quality or function** of the goods and services and should be refused, either alone or in combination with descriptive terms:

- Extra, R 20/97-1;
- FLEXI, synonymous for flexible;
- Multi;
- Mini, (R 62/1999-2);
- Plus, (R 329/1999-1);
- Bio;

provided, of course, that the respective goods or services can be organic, multiple, small, flexible etc.

The terms “**world**” and “**land**” mostly simply denote that a huge variety of a particular type of goods and services can be found in the same place and are not distinctive if applied together with the corresponding descriptive terms; to be refused: “Investorworld” for financial services (CFI, T-360/99, OJ OHIM 2001, 1192).

The terms “**series**” and “**type**” merely refer to the nature of the goods rather than to their commercial origin and cannot render an otherwise objectionable term distinctive.

The following do not fall foul under Article 7 (1) (b):

- Mega, Jumbo, Star, Trans.

Registrable: Transeuropa (R 125/98-3), Megatours (R 295/99-3).

Names of individual persons are usually distinctive, irrespective of the frequency of the name and even in the case of the most common surnames names such as Smith or García.

To refer to: ECJ, C 404/02, Nichols, paragraph 30, 26.

The same is true for names of prominent persons, including heads of states. The previous practice to object names of heads of states as non distinctive (see R-198/04-4, Queen Elizabeth II) shall no longer be followed.

7.6. Special categories of marks

This chapter discusses certain special categories of marks in their overall context, taking into account all grounds for refusal as well as the criterion of graphic representation.

7.6.1. Sound marks

Pursuant to Rule 3 (6), sound marks must be filed either in the form of a graphical representation or, if filed electronically, in the form of a graphic representation plus a sound file representing the sound itself. Presently the Office accepts as a graphic representation which is sufficient in particular to comply with the criterion of the ECJ judgement “Shield mark”, only traditional musical notations, not frequency oscilograms or sonograms. However, the Office accepts non traditional (non musical) sounds if the graphic representation by means of an oscilogram or sonogram is accompanied by the sound file, through electronic filing. See Decision of the President EX-05-3 of 10 October 2005.

7.6.2. 3-dimensional trade marks

3-Dimensional trade marks can be grouped into three categories:

- Shapes unrelated to the goods themselves:
- Shapes that consists of the shape of the goods themselves;
- The shape of packaging or containers.

Shapes which are unrelated to the goods or services themselves

Shapes which are unrelated to the goods or services themselves (for example, the Mercedes Star or the Michelin Man) do not cause any problems and should, for all practical purposes, always be considered distinctive.

Shape of the goods themselves

For the shape which is the shape of the goods themselves, examination should be conducted in three steps.

Firstly, it has to be ascertained whether one of the grounds for refusal under **Article 7 (1) (e)** applies, as they cannot be overcome through acquired distinctiveness. While it is true that the ground for refusal that the shape must not be necessary to achieve a technical result is to be interpreted as applying irrespective of whether there are other shapes that can achieve the result (to refer to: ECJ, C-299/99, “Philips”, par. 81, 83; CD, 63 C, shape of a Lego brick), this ground for refusal must still be interpreted narrowly and in particular only covers shapes whose modification would change the technical result itself, and not those which are merely functional. Article 7 (1) (e) (i) is limited to those shapes which are identical to the goods, for example the shape of a football for a football. Article 7 (1) (e) (iii), “the shape which gives substantial value to the goods”, is limited to shapes which exclusively realize an aesthetic function, such as the shape of an object of art for objects of art, and in particular has nothing to do with the commercial value of the goods.

Next, it has to be checked whether the representation of the 3-dimensional trade mark contains **other elements**, such as words or labels, which render the mark distinctive either alone or in combination with the shape. Communication of the President No 2/98 (OJ OHIM 1998, 701) applies. Typical examples are word marks or figurative marks that appear on the shape and remain clearly visible, or labels on bottles. Even the standard shape of the goods or the shape of a standard bottle can be registered as a 3-D mark if a distinctive word mark or label appears on it.

Finally, the criteria for **distinctiveness of the shape itself** must be checked. Taking into account that

- for trade marks which consists of the shape of the goods itself, no stricter criteria apply than for other marks, but it may be more difficult to come to a finding of distinctiveness as such marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark (to sight: ECJ, C-136/02, “Maglite”, paragraph 30);
 - that examination on distinctiveness is not a novelty test,
 - that registration of three dimensional trade marks should not confer a product monopoly,
- the following criteria are to be used when examining the distinctiveness of three dimensional trade marks consisting exclusively of the shape of the goods themselves:

(1) A shape is non-distinctive if it is a basic geometric shape (see the washing tablet cases) or a combination of basic geometric shapes (to refer to: R-263/99-3).

(2) Simple and banal shapes are not distinctive

(3) The more closely the shape resembles the shape most likely to be taken by the product in question, the greater the likelihood that it is not distinctive (to refer to: ECJ, C-136/02 P, “Maglite”, paragraph 31). In other terms, the shape must depart from the shape which is expected by the consumer.

(4) The shape must depart significantly from the norm or customs of the sector (to cite: ECJ, C-136/02 P, “Maglite”, paragraph 31).

(5) It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs. To rely on: ECJ, C-136/02 P, “Maglite”, paragraph 32, CFI, T-88/00, “Maglite”, paragraph 37.

(6) Functional shapes or features of a three dimensional mark will be perceived by the consumer in that manner for example, for washing tablets, bevelled edges avoid damage to the laundry, and layers in another colour represent the presence of another active ingredient.

Aesthetic originality, if achieved through reduction to basic shapes and colours or optimization of ergonomics (form follows function), does not plead in favour of trade mark distinctiveness.

The test is therefore whether the shape is so materially different from basic, common or expected shapes that it can enable a consumer to identify the goods just by their shape and to buy the same item again if he has made positive experiences with the goods. A good example for this are snacks in non-common shapes.

Containers, bottles

The same criteria apply for the shape of bottles or containers for the goods. The shape applied for must be materially different from a combination of basic or common elements and must be striking. Also in the area of containers, regard must be had to any functional character of a given element. As in the field of containers and bottles the usage in trade might be different for different types of goods and in order to forgo subjective considerations, it is recommended to make a search as to which shapes are on the market, by choosing a sufficiently broad category of the goods concerned (see, in that regard, the opinion of the Advocate General in the case “Standbeutel”, C-173/04).

UFOS (unidentified filing date-seeking objects)

If it is not clear from the representation of the mark read in conjunction with the list of goods and services what the shape applied for represents, there is an inherent difficulty: without knowing what the shape is, it cannot be ascertained whether it will be distinctive, nor can it be ascertained whether it is common or functional. The applicant should be requested to clarify the nature of the shape (here is a duty to cooperate and to provide truth information). In any event those shapes should be refused if they consist of basic geometric shapes or banal elements.

7.6.4. Colours

7.6.4.1.

- a) Colour marks may be filed
 - as figurative marks showing geometric shapes or goods in colour,
 - or for a single colour or a combination of colours as such (“colour *per se*”).

The graphic representation must consist of a sheet of paper or image showing the colours. In addition,

- the actual colours must be indicated in words;
- and for colours *per se*, it is recommended to specify the colour shade by use of an internationally recognised colour code (cf. Communication No 6/03, OJ OHIM 2004, 88).

Where a combination of colours *per se* is applied for, the graphic representation as filed will determine the mark, including the proportion and position of the various colours, which must be clear from the representation (“WYSIWYG”, what you see is what you get). This is required under par. 33 of the Judgment of the ECJ C-49/02 of 24.6.2004, “Heidelberger”. For example, a mark comprising a small yellow stripe on top of red is different from red and yellow presented in even proportion, red being on the left side. An abstract claim, in particular as to two colours “in any possible combination” or “in any proportion”, is not allowable and leads to an objection under Article 7 (1) (a) (“Heidelberger”, par. 34; BoA R 730/01-4 of 27.07.2004, “yellow/blue/red”).

This must be distinguished from the indication on how the colour combination would appear on the product, which is not required because what matters is the subject-matter of the registration, not the way it is or can be used on the product..

b) Where colours or colour combinations as such are applied for, the appropriate examination standard is whether they are distinctive either if applied to the goods or their packaging, or in relation to the services, or if used in advertisement in relation to the goods and services claimed. It is a sufficient ground for a mark to be refused if the mark is not distinctive in either of these situations. For colour combinations, examination of distinctiveness should be based on the assumption that the colour combination in the way it is filed appears on the goods or their packaging, or in advertisement or promotional material for the services.

7.6.4.2. *Single colours*

As has been confirmed by the Judgment of the Court of Justice C-104/01 “Libertel”, a single colour is not distinctive for any goods and services except under very special circumstances. Such very special circumstances require that the applicant demonstrates that the mark is absolutely unusual, that is striking, in relation to these specific goods. These cases will be extremely rare, for example in the case of the colour pink applied to insulating material. It is not necessary for a refusal that one of the factors listed in par. 3 below is present but if this is the case, it should be used as a further argument in support of the refusal.

7.6.4.3. *Colour combinations*

There is no *per se* rule for the exclusion of colour combinations consisting of two or more arbitrary colours. Rather, in these cases, a refusal can only be based on specific facts or arguments, and where such specific arguments to refuse are not established, the mark shall be accepted. The term "arbitrary colours" has been used in the sense that if one of the two colours is either the commonplace colour for the product or is the natural colour of the product, then we are in fact in the presence of the addition of one single colour to the usual or natural colour of the product, and an objection applies in the same way as if there was only one colour. Examples: grey is the usual colour for the grip of gardening tools, and white is the natural colour of washing tablets. Thus, a washing tablet which is white with another layer in red in fact is a case to be judged as a case which involves the addition of one colour.

The situations in which a combination of two arbitrary colours should nevertheless be refused chiefly comprise:

- In many instances, a colour would merely be a decorative element of the goods or comply with the consumer's request (typical examples: colours of cars or T-shirts), irrespective of the number of colours concerned.
- A colour can be the nature of the goods (e.g., for tints).
- A colour can be descriptive or technically functional (example: colour red for fire extinguishers, various colours used for electric cables).
- A colour may also be usual or generic (example: again, red for fire extinguishers; yellow for postal services).
- A colour may indicate a particular characteristic of the goods such as a taste (yellow for lemon taste, pink for strawberry taste).
- A colour combination should also be refused if the existence of the colour combination can already be proved on the market, in particular if used by several different competitors (example: we were able to prove that the colour combination red and yellow is used by various enterprises on beer or soft drink cans).

In all these cases the trade mark should be objected to but with the careful analysis of the goods and services concerned and the situation on the market.

If the number of colours exceeds three, the higher the number is, the less distinctiveness is likely, because of the difficulty to memorize a high number of different colours and their sequence.

7.6.5. Geographical indications

Preliminary remark: This chapter uses the notion of "geographical term" so as to cover any geographical indication or connotation of a verbal or figurative element in a Community trademark application, whereas the terms "geographical indication", "appellation of origin" and "indication of source" are used in the context of specific legislation protecting them. The list of geographical indications protected under EC legislation is available on the Intranet.

7.6.5.1. ARTICLE 7 (1) (c) CTMR

a) A CTM application containing a geographic term is only objectionable under this provision if it consists exclusively of such a term. This provision therefore does not apply if the mark contains elements which would be registrable on their own. If the mark contains other non-distinctive or distinctive elements, the registrability of the combination (of the mark as a whole) must be assessed in the same way as in other cases where descriptive elements are coupled with distinctive or non-distinctive elements.

b) Protected geographical indications enjoy special protection under Community law:

- geographical indications designating wines or spirits, according to various Community Regulations;
- geographical indications and designations of origin for agricultural products and foodstuffs protected by Council Regulation;
- indications protected under bilateral treaties concluded between the European Community and third countries (for example, Australia, Switzerland).

For the goods and services for which they are so protected, these indications are geographically descriptive as of law. This applies irrespective of consumer recognition and irrespective of whether the term actually designates an existing geographical place (which is for example not the case for "vinho verde" from Portugal). Furthermore, such indications may not be found generic by the Office.

Such indications shall therefore be refused.

c) Criteria for geographical terms not enjoying special protection

What follows concerns only those geographical terms which do not enjoy special protection as a geographical indication within the meaning of subparagraph b) above.

It must be emphasised that Article 7 (1) (c) CTMR does not exclude geographic indications, but "trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, geographical origin or other characteristics of the goods or services". Like for all other descriptive terms,

- the test is whether the geographic term describes objective characteristics of the goods and services,
- and. this must be assessed with reference to the goods and services claimed and with reference to the perception by the relevant public.

The descriptive character of the geographical term may pertain to

- the place of production of the goods,
- the subject matter of a good (for example, what city or region a travel guide is about, or the area covered by a newspaper),
- the place on which the services are rendered,
- the place where the company rendering the services has its seat and from where the rendering of the services is managed and controlled,

- the nature of the goods to which the service relates (e.g. "Chinese restaurant").

It must be checked that the trade mark is not descriptive in any of these respects.

However, the geographic origin of the consumers plays no role at all. (A Chinese restaurant is not targeted to Chinese clients; an insurer in Zürich could not survive with clients from Zürich only.)

d) Notion of geographical term

A geographical term is every existing name of a country, region, landscape, city, lake or river. Old fashioned terms fall under this notion only if still commonly used or generally understood as the synonym for the current indication (doubtful: "Batavia").

e) The first test: Is the term understood as a geographical term?

Where the term is an existing city, region etc., it must still, in a first test, be ascertained, whether the term is known to the relevant public as a geographical term. An objection under Article 7 (1) (c) CTMR therefore does not apply in respect of names of towns, villages etc., which are not readily understood as being a geographic term. This question shall not be ascertained through opinion polls, but rather in a normative way by taking as the basis a reasonably well informed consumer with a sufficient common knowledge, without being a specialist in geography.

Although the size of a city or village cannot be an absolute criterion (because small cities may be widely known for particular reasons), it is safe to say that already a high number of geographical terms from outside of the EC, and a high number of smaller villages or municipalities, are thus excluded from objection under of Article 7 (1) (c).

f) The second step: Is the geographical term not only recognised, but also perceived as such?

It is not only necessary that the relevant public knows the geographic term as such, but also understands it as a reference to the geographic place when used in connection with the claimed goods or services. In other words, the geographic term must not be understood as a mere suggestive or fanciful term. Example: whereas the North Pole and the Mont Blanc are commonly known, in the context of ice cream or sports cars, they would not be understood as a possible place of production, but as a merely suggestive and fanciful term.

g) The third step: the link between the geographical place and the goods or services

Even when the second step is passed, it is not enough to require that the goods or services can theoretically be produced or rendered in the given geographic place. Save where there are climatic restrictions, that would nowadays be possible almost everywhere in the world. Rather, the following criteria set up by the Court of Justice and the Court of First Instance in "Chiemsee" and "Oldenburger" must be satisfied:

(1) The geographical place must be currently associated, in the mind of the relevant public, with the category of goods in question, or the geographical name must be liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods (Chiemsee, par. 31, 37); in this assessment, regard must be had to the degree of familiarity amongst the public with the geographical name, with the characteristics of the place designated by the name, and with the category of the goods concerned (Chiemsee, par. 32).

(2) Registration is excluded not only for geographical names which are already famous or known for the goods concerned, but also for those geographical names which are liable to be used by undertakings and must remain available to such undertakings as indications of the geographic origin of the category of goods concerned (Oldenburger, par. 31); however, the registration of geographical names is not excluded, when, because of the type of place they designate, the public is unlikely to believe that the category of goods concerned originate there (Oldenburger, par. 33).

This has two consequences: on the one hand the assessment whether a geographical name, although not actually used to designate the geographic origin of the product, is liable to be so used in the future, must be made on the basis of the consumer perception of today and on the basis of objective criteria, taking into account in particular the relevance of the geographic origin for the goods in question and the use in trade to use geographical names to indicate the origin of the goods or to refer to certain qualitative and objective criteria of the goods. On the other hand Article 7 (1) (c) is not limited to geographic terms already having a reputation or for which the Office is able to demonstrate an actual need to keep it free for the competitors. Consequently, the very fact alone that the geographical term is used by only one producer is not sufficient to overcome an objection (although it will be a very important argument to be taken into account in assessing acquired distinctiveness).

h) In many instances, the second and third step will actually be one and the same mental operation.

Whether an existing geographical term will, for the relevant goods, be understood as having an informational value about the place of production, or rather as a fanciful term, also largely depends on the nature of the goods.

For all practical purposes, the most appropriate test is to check whether for the relevant goods, there is some sort of trade practice or tradition to refer to the geographical origin. It is a safe tip to ask somebody from the respective Member State.

For example, for wine, a geographical name is always perceived as an indicator of origin because wine must carry a correct indication of its origin.

For agricultural products or drinks (mineral water, beer), geographic names usually are meant to refer to the place of production. However, this may not be the case in all Member States, and depend on the size of the geographical place or zone. (Example: Oldenburger).

For textile and body care products, there may be a tradition of production in some places whereas for other places the term might be fanciful. In these cases it is necessary to establish whether there is an actual production of

these goods and whether that fact is known at national or international level (not to be confused with the reputation of a geographic indication as such). The mere fact that the goods can be produced in that place is not sufficient as a ground for refusal.

It is widespread practice to use fashionable city names for goods unrelated to the ground for which the city is known (Hollywood for chewing gum) or names of certain fashionable suburbs or shopping streets (Champs Élysées, Manhattan). These will be perceived as suggestive terms and shall not be refused.

For certain mechanical goods like cars where the public knows that they are not produced on a great number of different places, city names may serve to build up a series of model designations, such as SEAT Cordoba, Toledo, Malaga.

For hi—tech goods (computers, telecommunication products, consumer electronics) the place of production becomes ever less relevant. (Accepted: Germansat).

For services, the geographic term will, in many instances, be perceived as the place of the location of the enterprise and has to be kept free if that location is a relevant location for those services (to be refused: Munich financial services, Zürich for insurances).

In the area of hotels and restaurants, a geographical term might relate to the type of dishes, the place of origin of the owner of the restaurant, the suburb or street where the hotel is located, or have no relevance for the services at all (Hotel Bali in Benidorm).

The mere fact that the service can be rendered at the place concerned does not justify a refusal (position taken by the Office in the case “Cloppenburg”, as regards retail services).

7.6.5.2. ARTICLE 7 (1) (d)

This ground for refusal applies also only if the mark consists exclusively of a generic term. Whether a term designating a geographical place is a geographical indication or a generic term (e.g. Frankfurt sausages), can be left open as the mark shall be refused in both instances.

7.6.5.3. ARTICLE 7 (1) (g)

This ground for refusal relates to marks which are of such a nature as to deceive the public as to the geographical origin of the goods or services.

a) This ground for refusal also applies where the mark contains other elements than the geographical term.

b) For geographical indications protected under Regulation 510/06, bilateral treaties concluded by the EC, or protected by Community legislation in the field of wines and spirits, the specification must be limited to goods coming from the region for which the geographical indication may lawfully be used.

c) For geographical indications not protected under the above provisions, a likelihood to deceive the public can result from undue de-localising additions,

inherent contradictions ("Munich Beer brewed in Hamburg"). These cases will be quite rare. In principle it suffices that a non-deceptive use of the mark is conceivable under the circumstances. In no case shall an objection on deceptiveness be based on a geographic location of the applicant since this is irrelevant for the place of production of the goods.

7.6.5.4. ARTICLE 7 (1) (h)

Article 7 (1) (h) protects symbols etc. protected under Article 6ter of the Paris Convention and this includes all flags of states.

According to Article 7(1) (h) CTMR, trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention shall not be registered.

According to Article 6ter (1)(a) of the Paris Convention, the registration of armorial bearings, flags, and other State emblems of the countries of the Union, and any imitation from a heraldic point of view shall be refused.

Apart from flags of States, the emblems must be contained in "the list of State emblems".



The flag of the European Union

is included in the list.

In case T127/02 (ECA), the CFI decided on a refusal of a mark under Article 7(1)(h) CTMR in conjunction with Article 6 *ter* of the Paris Convention.

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The aim of Article 6 *ter*(1)(a) of the Paris Convention is to preclude the registration and use of trade marks which are identical to State emblems or which are to a certain degree similar to them. Such registration or use would adversely affect the right of the State to control the use of the symbols of its sovereignty and might, moreover, mislead the public as to the origin of the goods for which such marks are used. By virtue of Article 6 *ter*(1)(b) of the Paris Convention, that protection also covers the armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations.

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State emblems and emblems of international intergovernmental organisations are protected not only against the registration and use of marks which are identical to them or which incorporate them but also against the inclusion in such marks of any imitation of those emblems from a heraldic point of view.

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... The important question is whether, in the present case, the mark sought contains an element which may be regarded as the European

emblem or an imitation thereof from a heraldic point of view. That element need not necessarily be identical to the emblem in question. The fact that the emblem in question is stylised or that only part of the emblem is used does not mean that there is no imitation from a heraldic point of view.

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... When making a comparison 'from a heraldic point of view', regard must be had to the heraldic description and not to the geometric description, which is by nature much more detailed.

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Under the second sentence of Article 6 *ter*(1)(c), it is permissible, in the case of the emblem of an international organisation, to allow registration of a mark if it is not of such a nature as to suggest to the public that a connection exists between the organisation concerned and armorial bearings, flags, emblems, abbreviations and names or if such registration is probably not of such a nature as to mislead the public as to an existence of a connection between the user and the organisation.

In view of the above, when examining these kind of marks the following should be taken into account.

- a. Whether the emblem in question is contained in the “6ter list”;
- b. Whether the emblem is likely to be recognised in the mark;
- c. Whether it suggests to the public that a connection exists between applicant and the organization: The goods and services for which a mark is applied may be of influence.

In the following example taking into account that the stars are not outstanding elements in the mark and the goods and services for which the mark is applied, a connection between the European Union and the applicant is not suggested.



The same view (with the same reasoning) was taken concerning CTMA 4114062 applied for in the classes 19, 27, 35 and 37.



7.6.5.5. ARTICLE 7 (1) (j)

This provision excludes trademarks for wine or spirits which contain or consist of protected geographic indications (PGI) where the respective goods do not have the purported geographic origin.

Since the question whether the goods actually marketed under the mark come from the purported geographic place cannot be examined at the stage of examination, the sole consequence of this provision is that the list of goods and services must be limited to wines or spirits coming from the purported geographic region. Where a CTM contains a PGI the list of wines and spirits must be restricted to the precise geographical origin involved. If, for instance, the CTM contains the word BORDEAUX the list of wines must be restricted to “wines from Bordeaux” or an equivalent wording. Expressions such as “French wine” or “wine from South West France” are not sufficiently precise limitations. If the applicant does not accept the limitation the application must be refused.

Where the CTM contains a geographical indication that is not a PGI there is no need for a restriction of the list of goods and services. Similarly, restrictions need not be applied to sub-regions or localities that are not protected.

The database recently available to examiners provides details of all PGIs for wines and spirits and agricultural products and foodstuffs.

Where the trade mark consists of or contains a significant element of a PGI the same considerations apply. For example, “Ribera del Duero” is a PGI. A trade mark containing “Duero” such as “Castillo de Duero” would have to be restricted to wines from the Ribera del Duero. On the other hand “Napa Valley” is a PGI, but a trade mark containing “Valley”, such as “Shannon Valley” would not have to be limited.

7.6.5.6. Article 7 (1) (k) and Article 159

Geographical indications protected under Regulation 510/06 are protected also against the activities referred to in Article 13 (1) and 14 of the same Regulation, which are also based on the aim to prevent a deceptive use of the geographic indication, but have a slightly wider scope of application. This follows from Article 159 (ex Article 142) CTMR which constitutes a ground for

refusal on its own and separate from Article 7 (1). Article 7 (1) (k) simply reinforces this protection.

The same principles and practice as applied to wines and spirits apply to these cases.

It also applies where the trade mark itself contains a variation of the geographical indication liable to delocalising it and thereby on its own creating false impressions about the true origin of the goods (Example: Bergazola/Gorgonzola, or, invented example: Allgäuer Gorgonzola).

New Article 7 (1) (k) simply confirms Article 159 and does not lead to practice changes.

7.6.5.7. ARTICLE 64 (2)

A mark which is geographically descriptive under Article 7 (1) (c) (and provided that it is not deceptive under Article 7 (1) (g)) may still be registered as a Community collective mark, provided that the Regulations governing use contain an opening clause in accordance with Article 65 (2), second sentence, CTMR. Examples of accepted Community collective marks exclusively consisting of geographical indications coupled with generic terms: "Bayerisches Bier", "Dresdner Christstollen", "Spreewälder Gurken".

7.7. Genericness, Article 7 (1) (d)

Article 7 (1) (d) excludes from registration trade marks 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.

But the customary nature of the sign may refer to something else than the designation of the goods or services themselves. This ground for refusal also covers words which had originally no meaning or another meaning. It also covers abbreviations, as their meaning can only be perceived once they have become customary. It furthermore covers figurative elements which are either frequent or have even become the standard designation for goods and services, for example a white P on a blue background for parking places or the Aesculapian staff for pharmacy. In area of wines and spirits, it covers the so called traditional expressions which, although not being geographic terms, designate particular types of products as to their nature, although limited to certain geographical areas.

Article 7 (1) (d) largely overlaps with Article 7 (1) (b) and (c) and therefore it will be very rare that this provision will be relied on on its own. The reason is that the distinctiveness or descriptiveness of a mark must be assessed both with reference to the filing date and to the date of the decision so that the question whether a term or figurative element was non-descriptive or distinctive many years before that day, or when the term was first created, will in most cases be immaterial.

This is definitely different for developments after the point in time of registration; changes in meaning that lead to a genericness after registration do not lead to a declaration for invalidity *ex tunc* under Article 51 (1) (a), but can lead to a revocation with effect *ex nunc* under Article 50 (1) (b).

In any case, Article 7 (1) (d) has to be assessed with regard to the goods and services concerned and it is therefore not enough that a word is commonly used in the sense that it forms part of the general every day vocabulary (see ECJ, C-517/99, “Bravo”, paragraph 27, 31).

7.8. Other grounds for refusal

Other grounds for refusal play a quite limited role in practice but it is still necessary to check them carefully.

7.8.1. Public policy or morality, Article 7 (1) (f)

Article 7 (1) (f) excludes trade marks from registration which are contrary to public policy or to accepted principles of morality. Like all other grounds for refusal, this is a European criterion, irrespective of a looser or stricter level of morality in different regions of the Community, but Article 7 (2) remains applicable as to the meanings in different languages or to the presence of social, political or religious phenomena in different Member States of the EC.

It is necessary but not sufficient condition that the use of the mark applied for would be illegal and prohibited. However, illegality of the use of the mark is not enough to render it objectionable under Article 7 (1) (f).

“Public policy” is the body of all legal rules that are necessary for a functioning of a democratic society and a state of law. “Accepted principles of morality” are those that are absolutely necessary for the proper functioning of a society. Article 7 (1) (f) is thus not concerned with bad taste or protection with feelings of individuals. In order to fall foul under Article 7 (1) (f), a trade mark must be directly against the basic norms of the society. The rationale of Article 7 (1) (f) is to preclude trade marks from registrations where the grant of a Monopoly would undermine the state of law.

Article 7 (1) (f) thus excludes blasphemous, racist or discriminatory phrases, but only if that meaning is clearly conveyed by the mark applied for in an unambiguous manner; trade marks that might be considered in poor taste do not offend against this provision. Article 7 (1) (f) also excludes all direct references or incitements to commit criminal acts. Furthermore, Article 7 (1) (f) excludes names of terrorist organizations as they would be perceived as a direct support for them..

There is a clear danger that Article 7 (1) (f) is applied subjectively so as to exclude trade marks that are not to the personal taste of the examiner and that should be avoided. To be objectionable the word(s) must have a clear offensive impact on people of normal sensitivity.

7.8.2. Deceptiveness, Article 7 (1) (g)

Article 7 (1) (g) excludes marks which are of such a nature as to deceive the public for instance as to the nature, quality or geographical origin of the goods or services.

This ground for refusal does not require that the mark exclusively consists of such terms.

In order to fall foul under this provision, the mark must contain an objective indication about characteristics of the goods which is clearly in contrast to the reality contained in the list of goods and services. As long as the mark has not been used, this assessment can only be made with respect to the list of goods and services, assuming that the mark be used for the goods and services claimed but, if possible, in a non-deceptive manner. If there is a possible non-deceptive use, the mark must not be refused. Invented example: The mark “John Miller’s Genuine Leather Shoes” is objectionable for “plastic shoes” but not objectionable for “shoes” as these comprise leather shoes.

Article 7 (1) (g) does not apply where the term is merely suggestive: Example, “Metal Jacket” suggestive and non-deceptive for textile jackets (R 314/02-1).

Those marks will be refused as deceptive that falsely represent an official status or recognition. Example: “International star registry” for a private service consisting in giving names to stars (R 468/99-1, OJ, OHIM 2002, 1184). This does not apply if the reference to something official is merely allusive. Registrable: “The E-Commerce Authority”, R 803/00-1.

However, references in the mark to official recognition are deceptive if they cannot be proven to be true by the applicant, for example “by appointment of her majesty”, whereas “Royal” does not promise an official status.

Practice change: Names of Heads of States will no longer be considered as deceptive or contrary to public policy.

7.8.3. Article 6ter of the Paris Convention (Article 7 (1) (h) and (i))

Trade marks that fall foul under Article 6ter of the Paris Convention have to be refused, irrespective of the goods and services applied for. This covers on the one hand national flags, which are protected under Article 6ter without notification. This applies on the other hand for all those emblems, escutcheons, etc. which have been notified to and published by WIPO. Not only the exact representation of those names and emblems are protected, but also trade marks containing those emblems or that contain heraldic imitations. To refer to: CFI, T-127/02, “ECA”.

See also discussion on geographical indications and the criteria to be applied.

Examples for emblems or escutcheons which are not protected under Article 6ter of the Paris Convention but which fall under Article 7 (1) (i) have not yet

arisen.

7.9. Acquired distinctiveness (Article 7 (3))

Article 7 (3) provides that "Paragraph 1 (b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods and services for which registration is requested in consequence of the use which has been made of it." A trade mark is distinctive in this sense if it is recognized by a sufficiently large part of the relevant public as a mark of one single trader.

The criteria for showing acquired distinctiveness of colour marks are not different from those applied to all other types of trade marks.. It is not in itself an obstacle to the finding of acquired distinctiveness if the fact that the colour has been widely used, or obtained a market recognition, is due to a monopolistic situation, that is, that the CTM applicant is the only supplier of the particular goods or services, e.g. in the field of telephone or postal services (see Judgment of the ECJ, C-299/99 "Philips/Remington", par. 65); however, this must be the case in the Community as a whole and not just in one Member State.

It is important to note that:

- the evidence of use is to be assessed in order to judge whether that use has produced a situation where a mark which would otherwise have to be refused on one or several of the grounds listed in Article 7 (1) (b), (c), and (d) has become distinctive. It is not simply whether and to what extent there has been use;
- the use must be of the trade mark applied for and not a significantly different variation;
- the use must relate to the goods and services the subject of the CTM application;
- only objections under (b), (c) and (d) can be overcome in this fashion. An objection related to deceptiveness (g), for example, cannot be overcome in this way.

To which point in time must the evidence relate?

The mark must have acquired distinctiveness at the time of filing (filing date), and the distinctiveness must still be present at the time of decision on registrability.

To where must the evidence relate?

The examiner must bear in mind whether the ground for objection exists in the whole of the Community or only part of it.

Community as a whole

If the objection is based on lack of distinctiveness of a simple mark (e.g. single colour, simple geometrical shape, a single number or letter), or very complex one that merely decorates the product, the objection would almost always

concern the whole Community. This list of examples is not exhaustive.

If the objection concerns a language which, in relation to the goods/services in question, is well understood throughout the Community (e.g. English for goods/services in the computer field) the objection will likely extend to the whole Community. Similarly, some words are almost universally understood irrespective of their language source (e.g. extra, vino) and the objection would extend to the whole Community.

In such cases the evidence must relate to the Community as a whole and not just a part of it.

It is, however, possible to extrapolate evidence from one part of the Community to others. If, for example an opinion poll shows certain results arising from a particular extent (amount and time) of use in one part of the Community it is reasonable to assume, absent good grounds for taking a contrary view, that the same extent of use would have the same consequence elsewhere. In such a case a further opinion poll would not be necessary for each part of the Community.

The Community is taken as a whole and not merely as an addition of the territories of its Member States. This means in particular that the evidence must relate to all the relevant (territorial) markets in the Community. This will generally require a prior determination of the relevant (territorial) market. This exercise involves an evaluation of the goods or services in question and the relevant means of distribution sales and sales promotion. The relevant markets will generally comprise territories irrespective of national boundaries. The evidence must relate to each of the markets, but not necessarily to all of the sub-territories of each of these markets.

Part of the Community

Where the objection relates to part of the Community only in accordance with Article 7 (2) the evidence need only relate to that area. While this generally arises in respect of word marks with a limited linguistic understanding it may also arise in relation to other marks.

What has been said above about the relevant territorial markets in the Community applies mutatis mutandis to the relevant market in the part of the Community under consideration. For example, where a mark is descriptive in the Finnish language, the evidence must relate to the territory where Finnish is spoken or understood, but the evidence need not necessarily relate to each individual region or subregion in that territory.

To which (part of the) public must the evidence relate?

The evidence must relate to the (part of the) public to which the mark is addressed. The starting point for this exercise is the list of goods and services in the application. Unless these goods are by their nature addressed to specialists or a limited public, the goods or services are taken in their ordinary

meaning and will generally be addressed to the public in general. Thus, while products in Class 1 are generally intended for the trade, food and drink products are available to consumers generally.

The evidence must further demonstrate that a sufficiently large part of the public has the requisite knowledge that the sign constitutes a mark (even though its source may be unknown). It is not possible to give any fixed percentages in this regard - this would limit the available evidence essentially to public-opinion surveys. Rather, the examiner must evaluate whether, given all the evidence produced and the inferences to be drawn from it is likely that a relevant part of the public addressed is aware of the mark in the sense mentioned before.

Nature of evidence

It is a matter for the applicant to decide on the nature of the evidence to present. While Article 76 (1) lists some examples it is not exhaustive. Examiners must be prepared to accept opinion polls, surveys, statements from the trade and consumer organizations, articles, brochures, samples, evidence of turnover and advertising and other types of promotion, of successful prosecution of infringers, of trade mark registrations obtained, etc.

Assessment of the evidence

When examining and deciding on the amount, nature etc. of use necessary the examiner must bear in mind the nature of the trade concerned, the manner in which the goods and services are provided and the relevant public, for example, whether they are specialized or for the general public. The extent to which the trade mark is, on the face of it, lacking distinctive characteristics must be weighed against the evidence provided.

Opinion polls and surveys

Well-conducted opinion polls, namely where the questions asked are relevant, and not leading, and the sample interviewed is properly chosen with no inbuilt bias are particularly persuasive. This applies in particular to such polls or surveys when they are carried out by independent and well-recognized organizations or institutions.

Trade evidence

Evidence from independent trade associations, consumer organizations and competitors should also be given weight. Evidence from suppliers or distributors should, generally, be given less weight. The degree of independence of the latter will influence the weight to be given.

Turnover and advertising

Where figures for turnover or advertising are supplied these should relate only to the goods or services in respect of which registration is sought. If the

application is for "coffee" the figures supplied should not relate to "food". In order to provide a context for assessment of such evidence the applicant should give a general indication of the size of the relevant market (Community or part of the Community). It is desirable that the turnover figures be segregated on an annual basis. In all cases the evidence should show when the use commenced. There must be pre-filing date evidence. The greater the amount of use the more weight must be given to it.

Manner of use

The evidence should show examples of how the mark is used (brochures, packaging etc). Use of a substantially different mark should not be given much weight. It is sometimes the case that the use shown is of a sign which, while similar to the mark applied for, is in itself distinctive. In such cases the evidence should be disregarded.

In other cases the evidence shows use of the mark applied for as part of a more complex sign, frequently in association with a "House Mark" or more general identifier of the applicant. An assessment has to be made whether this constitutes use of the mark applied for.

Length of use

The length of use in addition to the amount (volume) of use is of particular relevance. Thus the evidence should show the commencement of use, unless that information is immaterial because the use has in any event begun long before the filing date. The evidence should also show that the use has been continuous or indicate reasons if this should not have been the case.

Post application use

Acquired distinctiveness must have been present at the filing date. It is not enough if it was acquired after that date. To rely on: CFI, T-247/01, "Ecopy", par. 36, 37.

Evidence that was collected after the filing date can only be accepted inasmuch as it is sufficient to prove that acquired distinctiveness was already present at that date. Evidence which relates to the period after the filing date of the application will be admitted but given less weight than that which relates to the period before the filing date. The distance in time between the filing date and the date to which the evidence relates, as well as the time factor (how long and intensive was the use before the filing date?) will have to be taken into account. The closer to the filing date the more weight should be given.

Where none of the evidence shows any use prior to the filing date, the evidence must be disregarded.

Indirect evidence of use

The evidence may consist of registrations obtained in a Member State on the basis of acquired distinctiveness. Unless there are good grounds for discounting such a registration the examiner should accept this indirect evidence.

Publication

If the mark is accepted based on Article 7 (3), this information must also be published (Rule 12 (i)). This applies also where the evidence is indirect, that is based on a registration in a member state as a result of acquired distinctiveness,.

In practice the publication in the CTM Bulletin is done by using the INID Code 521 without any further indication or explanation.

7.10. Disclaimers

7.10.1. Where the trade mark contains an element that is not distinctive the examiner may request the applicant to disclaim any exclusive right to that element where the inclusion of that element could give rise to real doubts as to the scope of protection of the mark. Examiners should not have recourse to this provision automatically when the mark contains elements that are not distinctive. Typically elements which designate the kind, quality, quantity, value or geographical origin of goods or services need not be disclaimed. Similarly, ordinary words which would be common to many marks (the, of, etc.) or other non-distinctive matter (borders, commonplace shapes of containers, etc.) do not need to be disclaimed.

Where a trade mark consists of a combination of elements each of which in themselves is clearly not distinctive there is no need for a disclaimer of the separate elements. For example, if a periodical had as its trade mark "Alicante Local and International News", the individual elements within it would not need to be disclaimed.

7.10.2. If the applicant's statement does not overcome the ground for refusing registration or he does not agree to the condition then the application must be refused to the extent that is required.

7.10.3. Where the applicant has made a disclaimer in his application the disclaimer should stay even if the examiner does not consider it necessary.

If the application is considered by the examiner to be acceptable he should inform the applicant.

8. PUBLICATION

8.1. Publication takes place no earlier than one month after the search reports have been issued to the applicant and only if the application now fulfils all the conditions required for acceptance.

8.2. The examiner must ensure that the following details, where applicable, are available:

- (a) the applicant's name and address
- (b) the name and business address of the representative, unless he is an employee of the applicant. If there is more than one representative with the same business address only the first named will be published followed by the words "and others". If there are more than one representative with different business addresses, only the address for service will be published. Where an association of representatives is appointed only its name and business address is needed.
- (c) a representation of the mark; an indication that the mark is three dimensional; the words "in colour" and a description of the colour(s) making up the mark.
- (d) the list of goods or services grouped according to the Nice classification, presented in the order of classes and each preceded by the number of the class.
- (e) the date of filing and file number
- (f) particulars of the claim to priority, namely, the file number(s) of the application, the date(s) on which and the country in which it was filed, indicated by a code,
- (g) particulars of the claim to exhibition priority,
- (h) particulars of the claim to seniority, namely the registration number(s), the date(s) from which the registration(s) is effective and the Member State(s) in or for which the registration(s) is effective,
- (i) a statement that the mark has become distinctive in consequence of the use that has been made of it
- (j) a statement that the application is for a community collective mark
- (k) a statement by the applicant disclaiming any exclusive right to an element of the mark. It will not be indicated whether the disclaimer arose at the initiative of the applicant (Rule 1(2)) or the Office (Rule 10(2)). If the disclaimed element is a word its meaning in all languages of the Community will be given.
- (l) an indication of the language of the application and the second language nominated by the applicant.

Once all these elements are in order the application can be dispatched to Publication Section.

8.3. Publication is effected in all official languages of the European Community.

9. OBSERVATIONS BY THIRD PARTIES AND REVIEW OF ABSOLUTE GROUNDS

9.1. Observations of third parties are possible under Article 41 if they are made after publication of the application and relate to the existence of an absolute ground for refusal; the observer will not become a party to the proceedings before the Office. Any such observations will be copied to the applicant, inviting him, to submit comments. The examiner shall consider whether the observations are well-founded, i.e. whether an absolute ground for refusal exists, If that is the case, he shall issue an objection, and eventually refuse. If

an issue raised in observations has already been considered during the examination of an application it would be unlikely for this to give rise to serious doubts after publication. The examiner shall inform the third party on the action taken, namely whether or not the observations gave rise to an objection, and if so, he shall also inform the observer about the outcome of the proceeding. See Communication No 1/00 of the President of the Office of 25 February 2000 and Communication No 3/02 of the President of the Office of 5 March 2002 concerning third parties observations.

9.2. The examiner may also re-open the examination on absolute grounds on any other ground and at any time prior to registration, namely either when observations of third parties were filed before publication of the application, or when the examiner finds on his own motion that a ground for refusal has been overlooked. After publication of the application, this faculty should be made use of only in clear-cut cases. (This paragraph does not apply to international registrations designating the EC because of the specific rules applying as a result of the Madrid Protocol.)

10. COMMUNITY COLLECTIVE MARKS

10.1. Applications for Community collective marks, which must be so indicated when the application is made, will be subject to broadly the same procedure and conditions as for ordinary marks. The exceptions are listed below.

10.2. Only associations of manufacturers, producers, suppliers of services, or traders which under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue or be sued, as well as legal persons governed by public law, may apply for collective marks. There are essentially two criteria to be met. Firstly the applicant must be an association and secondly it must exist as an entity in itself, so that, for instance, some unincorporated bodies would not qualify. Also if it is a public body, it must have members who have the right to influence the regulations of use of the mark (such as “consejos reguladores”, but not individual municipalities). The collective mark may or may not certify certain characteristics or quality of the goods but this must be done by a collective body. Certification marks in the sense that one individual entity unilaterally sets standards with which the goods shall comply if they may carry the mark cannot be Community collective marks but must be filed as Community individual marks.

10.3. As an exception to paragraph 7.2 the trade mark must be capable of distinguishing the goods or services of members of the association, rather than any one undertaking, from the goods or services of other undertakings. As an exception to Article 7 (1) (c) – (k) signs which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective marks but in this case the regulations of use must contain an opening clause (see 10.5. below).

10.4. An additional ground for refusal applies to applications for collective marks

which is not applicable to ordinary applications. The examiner must refuse the application if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark. A collective mark which is available for use only by members of an association which owns the mark is liable to mislead if it gives the impression that it is available for use by anyone who is able to meet certain objective standards.

10.5. An applicant for a collective mark must submit regulations governing its use. If they are not submitted within the two month time limit set in Rule 43 CTMIR then the examiner will refuse the application.

The regulations must specify:

- the name of the applicant's organisation and the address of its office
- the object of the organisation
- the bodies authorised to represent the organisation
- conditions for membership
- the persons authorised to use the mark
- if there are conditions for use of the mark, including sanctions, these must be included, and
- if the mark designates the geographical origin of goods or services, authorisation for any person whose goods or services originate in the geographical area concerned to become a member of the organisation.

If the regulations are contrary to public policy or accepted principles of morality they are not acceptable. For example, rules which discriminate on the grounds of sex, creed or race could be unacceptable. If the examiner is not satisfied on any of these points he should if possible discuss the issue with the applicant. If the issue is not resolved the examiner will issue a notification giving the applicant the details of the deficiencies and providing him with a period of two months within which to remedy the defect, failing which the application will be refused by the examiner.

10.6. A change of category (collective to individual or vice-versa) will not be allowed unless as an obvious error if the true intention is apparent from the application documents. Priority or seniority claims are not affected by differences in category.

11. TRANSITIONAL RULES (ENLARGEMENT, CHANGES OF CLASSIFICATION)

This paragraph discusses the transitional rules relating to the accession of new Member States to the European Community and revisions of the Nice Classification.

11.1. Extension of CTMs upon enlargement

With effect from 1 May 2004, ten new Member States have joined the

European Community (Czech Republic, Cyprus, Estonia, Latvia, Lithuania, Hungary, Malta, Poland, Slovakia, and Slovenia). With effect from 1 January 2007 a further two new Member States have joined (Bulgaria and Romania). By virtue of the Treaty of Accession, a new Article 159a (ex 142a) has been inserted in the CTMR with provisions relating to the enlargement of the Community. The basic rule is that all existing CTM applications and registered CTMs are extended to the new Member States automatically without any additional fee to be paid or any administrative formality to perform. These CTM applications and CTMs, that is, all CTM applications and registrations with a filing date prior to the enlargement date may not be refused or declared invalid on any absolute or relative ground if these grounds became applicable merely because of the accession of a new Member State, that is, if they were not applicable at the date of filing of the CTM application concerned. As regards relative grounds, this is subject to an exception contained in Article 159a (3) concerning the right to file oppositions against CTM applications filed six months prior to the enlargement date

The principle is therefore that CTM applications and registrations having a filing date prior to the enlargement date will continue to be dealt with as if the accession had not taken place, but for CTM applications and registrations having a filing date on or after the enlargement date any reference to the European Community will comprise the new Member States.

The practical consequences of this are as follows.

11.2 Filing at national offices

As from the enlargement date, a CTM application may also be filed through the national office of a new Member State (see paragraph 3.1 above).

11.3 Professional representation

As concerns professional representation, as from the enlargement date, applicants (as well as other parties to proceedings before the Office) having their seat or domicile in a new Member State need no longer be represented by a professional representative. As from the enlargement date, professional representatives from one of the new Member States may be entered on the list of professional representatives maintained by the Office pursuant to Article 89 CTMR and may then represent third parties before the Office.

11.4 First and second language

Since 1 May 2004, there are nine new official languages of the European Community, namely Czech, Estonian, Hungarian, Latvian, Lithuanian, Maltese, Polish, Slovak and Slovenian. A further two languages (Bulgarian and Romanian) were added on 1 January 2007. These languages may be used as the first language only for CTM applications filed on or after the enlargement date.

11.5. Translation

A translation and the publication of the application will only be made into those languages which have become official languages of the European Community as from the enlargement date, in respect of CTM applications which are filed on or after the enlargement date. CTM applications having a filing date prior to the enlargement date, or existing CTM registrations, will be neither translated into nor republished in these additional languages.

11.6. Classification

The Nice Classification is revised in periodic intervals; the 9th edition entered into force on 1 January 2007. It is applied by the Office in respect of all CTM applications having a filing date on or after 1 January 2007. CTM applications or registrations for which an earlier edition of the Nice Classification applied will not be reclassified, even not on request (see Communication No 3/06 of the President of the Office of 31 October 2006). For applications to be classified under the 9th edition, the Office accepts all class headings.

11.7. Seniority

Seniority may be claimed of a national trade mark which was registered before accession of the relevant new Member State or even before creation of the European Community. The seniority claim may, however, only be made after the enlargement date. The mark registered in the new Member State must be “earlier” than the CTM; as an extended CTM has, in the new Member State, an earlier right effect as of the enlargement date, it suffices when the earlier national mark has a filing or priority date prior to the enlargement date. Example: The same person files a CTM application on 1 April 1996 and a national trade mark application in Romania on 1 January 1999. After 1 January 2007, the seniority of that Romanian national trade mark application may be claimed.

11.8. Search

As concerns paragraph 7.1 above, national offices of new Member States may participate in the search system (Article 39 (2) CTMR) as from the enlargement date. Only those CTM applications which have a filing date on or after the enlargement date are sent for searching to these national offices .

11.9. Absolute grounds for refusal

Article 159a (2) enshrines the important principle that CTM applications pending on the enlargement date may not be refused on the basis of any absolute ground for refusal if this ground became applicable merely because of the accession of a new Member State, and Article 159a (4) contains the same principle in respect of cancellation proceedings.

This means in practice that if a mark is non-distinctive, descriptive or generic only in a language of a new Member State, or in the territory of a new Member

State, the CTM application must be refused if it has a filing date on or after the enlargement date but it may not be refused if the filing date is before that date. For applications having a filing date after the enlargement date, the consultation of dictionaries and reference materials must therefore be extended to all the twenty languages of the European Community.

However, this principle only means that the criteria for applying Article 7 (1) CTMR are not made more severe as a result of accession. The inverse conclusion that terms which are descriptive in a language or in respect to the territory of a new Member State may be registered for CTM applications having a filing date prior to the enlargement date would not be correct. For example, descriptive terms from languages of new Member States may have entered the customary language of existing Member States or be widely known therein (for example, *Vodka*), and geographical indications may have to be refused already now as descriptive terms (for example, *Balaton* or *Tokay*). Also, as regards geographical indications already protected in the new Member States, protection arising from Community legislation or bilateral treaties between the new Member States and the Community or existing Member States must be considered.

The grounds for refusal contained in Article 7 (1) (f) and (g) are only concerned by this provision to this extent that the deceptiveness or breach of public morality arises from a meaning which is only understood in a language of a new Member State. For the remainder, Article 7 (1) (f) follows a Community-wide interpretation.

The grounds for refusal contained in Article 7 (1) (e) and (i) are not concerned.

11.10. Distinctiveness acquired through use

As concerns paragraph 8.12 above, it is recalled that distinctiveness acquired through use (Article 7 (3) CTMR) must be present at the date of filing and still be present at the date of registration. Where the applicant for an existing (extended) CTM application was able to demonstrate that acquired distinctiveness was present at the filing date, Article 159a (2) precludes an objection based on the ground that it was however not distinctive through use in the new Member States. In these cases, the applicant therefore does not have to show acquired distinctiveness in the new Member States.

11.11. Bad faith

The Office will consider it as a filing made in bad faith if a CTM application is filed prior to the enlargement date for a term which is descriptive or otherwise not registrable with respect to a language of a new Member State for the sole purposes of obtaining exclusive rights in a non-registrable term or for otherwise objectionable purposes. The Office has no authority to object to such filings during the examination stage but will clearly exercise its duties in respect of bad faith filings in case that a request for declaration of invalidity will be filed (Article 51 (1) (b)). The national offices of the new Member States are equally determined to act against bad faith behaviour in the context of

enlargement. CTM applicants should therefore take into account that even if there are no grounds for refusal during the application stage, their registrations might remain contestable on the basis of Article 51 (1) (b) CTMR.

11.12. Conversion

As from the enlargement date, conversion may be requested into national trade mark applications of the new Member States. Conversion is also possible when the converted CTM has a filing date prior to the enlargement date. However, in this case, the converted application will, in a new Member State, have the earlier right effects under national law. National law in new Member States has enacted provisions equivalent to Article 159a (ex Article 142a) in the sense that extended CTMs have earlier right effect in the new Member States only with effect from enlargement date. The date of enlargement does not trigger a new 3 months time limit for requesting conversion under Article 108 (4).