

PROVING ACQUIRED DISTINCTIVENESS

IPCLC
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PUBLIC INTEREST

- **PREVENTION OF ANTI-COMPETITIVE MONOPOLIES (WORD MARKS, SLOGANS, COLOURS, FIGURATIVE MARKS AND SHAPES)**
- **ACQUIRED DISTINCTIVENESS CAN SAVE REFUSED REGISTRATION OR CANCELLATION**

ACQUIRED DISTINCTIVENESS SPECTRUM

'CHIEMSEE' CRITERIA

- ✓ Market share
- ✓ Intensity, geographical spread and duration of use
- ✓ Market surveys
- ✓ Chamber of Commerce or trade association statements

ALL MARKS ARE EQUAL, BUT...

CONSIDERING DIVERSE CHALLENGES

- ✓ Word and semi-figurative marks
- ✓ Slogans
- ✓ Colour and shape marks

WORD AND SEMI-FIGURATIVE MARKS

□ Problematic in any part of the EU

- T-520/12, 'gifflar', 09.07.2014,



SV + FIN ['pastries'; 'breads']

- R 2538/2014-5 , 'gifflar', 10.11.2015
- ✓ Survey evidence
- ✓ Turnover
- ✓ Market share

SLOGANS

□ PART OF A SLOGAN

- C-215/14, *Société des Produits Nestlé SA v Cadbury UK Ltd* (“HAVE A BREAK”), 16.09.15



COLOUR AND FIGURATIVE MARKS

➤ C-25/05P, **Storck v OHIM**, 22.06.2006

✓ EU-wide

➤ C-98/11 P, **Chocoladefabriken Lindt & Sprüngli AG v OHIM**, 24.05.2012



✓ Substantial part

➤ T-359/12 & T-360/12, **Louis Vuitton v OHIM**, 24.02.2016



➤ T-137/08, **BCS SpA v OHIM**, 28.10.09



SHAPES

➤ T-411/14, **The Coca Cola Company v OHIM**, 24.02.16



CONCLUSIONS

- **Acquired distinctiveness easiest for word and semi-figurative marks**
- **Slogans face similar challenges to word marks**
- **Continued uncertainty regarding geographical extent of use for colour, figurative and shape marks**



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