

***GUIDELINES FOR EXAMINATION OF
EUROPEAN UNION TRADE MARKS***

***EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE
(EUIPO)***

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 1

GENERAL PRINCIPLES

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1 Reasoned Objection

Any one of the grounds listed in Article 7(1) EUTMR is sufficient for the refusal of a European Union trade mark.

For the sake of sound administration and economy of proceedings, the Office will raise any objections to registration of the sign under Article 7(1) EUTMR **as soon as possible and preferably all at once**. This is particularly important in those cases where the applicant cannot overcome the objection by demonstrating that the sign has acquired distinctive character through use (for instance, when Article 7(1)(e) EUTMR is invoked).

Each of the grounds for refusal listed in Article 7(1) EUTMR is **independent** and must be examined separately. Therefore, when various absolute grounds for refusal are invoked, a reasoned objection will be issued, specifying the individual grounds for refusal and providing clear and distinct reasoning **for each ground**. Even when some grounds for refusal overlap, each ground for refusal must be reasoned in the light of the general interest underlying each of them.

For example, where a word mark is found to have a semantic meaning that gives rise to an objection under both Article 7(1)(b) and (c) EUTMR, the notification of grounds for refusal should deal with each of those grounds in separate paragraphs. In such a case, it will be clearly indicated whether the lack of distinctiveness arises out of the same, or different, considerations from those that lead to the mark being deemed descriptive.

Occasionally, **arguments put forward by the applicant**, or a restriction (partial withdrawal) of the list of goods and services, will lead to the application of other grounds for refusal. In these cases, the party will always be given the opportunity to comment thereon.

2 Dialogue with the Applicant

During examination proceedings, the Office will seek a dialogue with the applicant.

At all stages of the proceedings, the observations submitted by the applicant will be considered carefully.

The Office will likewise consider, of its own motion, new facts or arguments that plead in favour of acceptance of the mark. The application can only be refused if the Office is convinced that the objection is well founded at the point in time when the decision is taken.

If several grounds for refusal are raised, the applicant must overcome all of them, since a refusal can be based on a single ground for refusal (judgment of 19/09/2002, C-104/00 P, Companyline, EU:C:2002:506, § 28).

- No observations submitted by the applicant

Where the applicant has not submitted any observations, if the application is to be refused, the notification to the applicant will include the original objection letter(s), state that the application is 'hereby refused', and contain a notice on the availability of an appeal.

- Observations submitted by the applicant

If the applicant contests the reasons given in the original notification, the refusal will first provide the original reasoning given, and then address the applicant's arguments.

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

- Restriction of goods and services

Where the applicant tries to overcome the objection by restricting the list of goods and services, it is possible that the restriction may give rise to a new ground for refusal, for example, deceptiveness in addition to descriptiveness. In this case another objection letter will be issued, so as to give the applicant the opportunity to comment on all grounds for refusal found pertinent.

A specification of goods or services that is restricted by a condition that the goods or services do not possess a particular characteristic should not be accepted (judgment of 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 114). For example, in respect of the trade mark 'Theatre', a specification claiming '*books, except for books about theatre*' should not be accepted. By contrast, restrictions that are worded in a positive way are usually acceptable, such as 'books about Chemistry'.

- Proof of acquired distinctiveness

The applicant has the right to claim that its mark has acquired distinctiveness through use (Article 7(3) EUTMR) and to submit relevant proof thereof.

The applicant must make its claim under Article 7(3) EUTMR either together with the application or, **at the latest, in reply to the Office's first objection** (Article 2(2) EUTMR). The claim can no longer be made for the first time at the appeal stage (Article 27(3)(a) EUTMDR).

The claim of acquired distinctiveness through use can be made either as a **principal** or as a **subsidiary** one (Article 2(2) EUTMR). The applicant must, however, clearly and precisely specify the type of claim, either together with the application or, at the latest, in reply to the Office's first objection.

Where the applicant has made a **principal** claim, the Office will take **one** (single) decision both on the mark's inherent distinctiveness and, where there is no inherent distinctiveness, on the submission of acquired distinctiveness through use.

Where the applicant has made a **subsidiary** claim, the Office will take a **first** decision on the mark's inherent distinctiveness and then, once that decision (finding lack of inherent distinctiveness) has become final, the applicant will be invited to submit its evidence on acquired distinctiveness through use.

For further information on acquired distinctiveness through use, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 14, Acquired Distinctiveness Through Use (Article 7(3) EUTMR).

3 Decision

After the dialogue with the applicant has taken place, the Office will take a decision if it considers that the objection is well founded despite the facts and arguments submitted by the applicant.

The decision will include the original objection, summarise the applicant's arguments, address the applicant's arguments and submissions, and give reasons and a detailed explanation as to why they are not convincing.

The objection can be waived in part if the Office considers that (i) **some** of the grounds have been overcome or (ii) **all** grounds have been overcome for some of the goods and services.

The decision will state that the application has been refused, either partly or in its entirety, indicating the goods and services rejected, and contain a notice on the availability of an appeal.

If a subsidiary claim of acquired distinctiveness through use has been made, the first decision will declare the inherent distinctiveness of the mark. It will be only after examining this evidence that the Office will decide whether to refuse the application.

The above, obviously, applies only to those cases where a claim under Article 7(3) EUTMR can be made. When an application is refused on the basis of a ground for refusal that cannot be overcome by means of Article 7(3) EUTMR (e.g. a refusal under Article 7(1)(e) i) to iii)), a subsidiary claim of acquired distinctiveness will fail.

4 European Criteria

Article 7(1) EUTMR 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 (i.e. more lenient or stricter) standards on the breach of public order or morality, depending on the country concerned.

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

For example, it suffices for a refusal if the trade mark is descriptive, or lacks distinctive character, in any one of the official languages of the EU (judgment of 03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57).

As regards other languages, a trade mark will be refused if it gives rise to an objection under Article 7(1) EUTMR in a language understood by a significant section of the relevant public in at least part of the European Union (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR), paragraph 1.2, and judgment of 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 35-36).

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

5 Irrelevant Criteria

Applicants often advance arguments that have already been declared irrelevant by the courts. These arguments should be rejected and the corresponding passages of the applicable judgments cited.

5.1 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) EUTMR has to be made by means of prognostics (assuming that the mark will be used with respect to the goods or services claimed). It follows clearly from the text of Article 7(1)(c) EUTMR that it suffices if the mark 'may serve' to designate characteristics of the goods and services (judgment of 23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 33).

5.2 Need to keep free

It is frequently claimed that other traders do not need the term applied for, can use more direct and straightforward 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) EUTMR that descriptive terms should not be registered as trade marks so as to remain freely available to all competitors, it is not necessary for the Office to show that there is, on the part of third parties, a present or future need to use, or concrete interest in using, the descriptive term applied for (*no konkretes Freihaltebedürfnis*) (judgments of 04/05/1999, C-108/97 and C-109/97, Chiemsee, EU:C:1999:230, § 35; 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 61).

Whether there are synonyms or other, even more usual, ways of expressing the descriptive meaning is thus irrelevant (judgment of 12/02/2004, C-265/00, Biomild, EU:C:2004:87, § 42).

5.3 Factual monopoly

The fact that 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) EUTMR. However, in this case the applicant will be more likely to succeed on acquired distinctiveness.

5.4 Double meaning

The frequent argument put forward by applicants that the terms applied for have more than one meaning, one of them not being descriptive for the goods/services, should be rejected. It suffices for a refusal under Article 7(1)(c) EUTMR if at least one of the possible meanings of the term is descriptive in relation to the relevant goods and services (judgment of 23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 32; confirmed by judgment of 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 97).

Given that the examination must focus on the goods/services covered by the application, arguments concerning other possible meanings of the word(s) making up the trade mark applied for (that are unrelated to the goods/services concerned) are irrelevant. Equally, when the trade mark applied for is a composite word mark, what matters for examination purposes is the meaning, if any, associated with the sign considered **as a whole**, and not the possible meanings of its individual elements considered separately (judgment of 08/06/2005, T-315/03, Rockbass, EU:T:2005:211, § 56).

6 Scope of Objections on the Goods and Services

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

If an objection is raised, the Office must state specifically which ground (or grounds) for refusal apply to the mark in question, for each product or service claimed.

It is sufficient that a ground for refusal applies to a **single homogenous category** of goods and/or services. A homogenous category is considered a group of goods and/or services that have a sufficiently direct and specific link to each other (judgment of 02/04/2009, T-118/06, Ultimate fighting championship, EU:T:2009:100, § 28). Where the same ground or grounds for refusal is/are given for a category or group of goods or services, only **general reasoning** for all of the goods or services concerned may be used (judgment of 15/02/2007, C-239/05, The Kitchen Company, EU:C:2007:99, § 38).

Sign	Case number
BigXtra	C-253/14 P EU:C:2014:2445
The Court confirmed the refusal in respect of goods and services in Classes 16, 35, and 41 to 43 by means of general reasoning because of a sufficiently concrete and direct link for all these goods and services. For all of them, 'BigXtra' will be perceived as indicating price reductions or other advantages (para. 48).	
Sign	Case number
PIONEERING FOR YOU	T-601/13 EU:T:2014:1067
The General Court allowed general reasoning in respect of goods and services in Classes 7, 9, 11, 37 and 42 because the promotional meaning of the sign applied for would be perceived identically for each of them (paras 36-37).	

As regards descriptiveness, an objection applies not only to those goods/services for which the term(s) making up the trade mark applied for is/are directly descriptive, but also to the **broad category** that (at least potentially) contains an identifiable subcategory or specific goods/services for which the mark applied for is directly descriptive. In the absence of a suitable restriction by the applicant, the descriptiveness objection necessarily affects the broad category as such. For example, 'EUROHEALTH' is to be refused for 'insurance' as a whole and not only for health insurance (judgment of 07/06/2001, T-359/99, EuroHealth, EU:T:2001:151, § 33).

An objection also arises for those goods and services that **are directly linked** to those for which the descriptive meaning pertains. Furthermore, if the descriptive meaning

applies to an activity involving the use of several goods or services mentioned separately in the specification, then the objection arises for all of them (see judgment of 20/03/2002, T-355/00, *Tele Aid*, EU:T:2002:79, for a number of goods and services offered in conjunction with, or applied in, remote assistance to car drivers).

It is possible to claim goods and services as what can be referred to as **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 with them, advertisement and repair. In these cases, the auxiliary goods are by definition intended to be used and sold together with the main product (e.g. vehicles and instruction manuals). It follows that if the EUTM is found to be descriptive of the main goods, logically it is also descriptive of the auxiliary goods, which are so closely related.

7 Timing of Objections

Objections should be raised **as early as possible**. In the majority of cases, the Office raises its objection *ex officio* before the publication of the EUTM application.

The Office can reopen the examination of absolute grounds on its **own initiative** at any time before registration (Article 40(3) EUTMR), and in particular, upon receiving observations from **third parties** relating to the existence of an absolute ground for refusal or following an interim decision from the **Boards of Appeal** proposing to re-examine the contested EUTM application on absolute grounds.

As to the observations from third parties, these must be submitted before the end of the opposition period or before the final decision on an opposition is taken when an opposition has been filed (Article 40(2) EUTMR). The Office can then decide to reopen the examination procedure as a result of these observations. See the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 3.1.

In the case of **international registrations** designating the EU, the Office can raise an objection as long as the opposition period (one month after republication) has not started (Article 193(7) EUTMR) and any interim status declaration previously sent would be revoked.

8 Disclaimers

Pursuant to Regulation No 2015/2424 amending Regulation No 207/2009 on the Community trade mark, it is no longer possible to file a disclaimer to indicate that protection is not requested for a specific element of a mark.

The Office will assess disclaimers filed **before** the date of entry into force of the abovementioned Regulation (23/03/2016) according to the former practice applicable.

- As a general rule, a disclaimer will not help to overcome an absolute grounds objection.
- Where a trade mark consists of a combination of elements, each of which in itself 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' with a figurative distinctive element, the individual word elements within it would not need to be disclaimed.

- If the applicant's disclaimer does not overcome the ground for refusing registration, the application must be refused to the extent that is required.
- Where the applicant has made a disclaimer of a non-distinctive element in its application, the disclaimer will stay even if the Office does not consider it necessary. **Disclaimers of distinctive elements will be refused by the Office** since they would result in a trade mark with an unclear scope of protection.