

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

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

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 14

***ACQUIRED DISTINCTIVENESS
THROUGH USE***

(ARTICLE 7(3) EUTMR)

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1 Introduction

According to Article 7(3) EUTMR, a trade mark may still be registered despite the fact that it does not comply with Article 7(1)(b), (c) or (d) EUTMR, provided that it ‘has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it’.

Article 7(3) EUTMR constitutes an exception to the rule laid down in Article 7(1)(b), (c) or (d) EUTMR whereby registration must be refused for trade marks that are per se devoid of any distinctive character, for descriptive marks, and for marks that consist exclusively of indications that have become customary in the current language or in the bona fide and established practices of the trade.

Distinctive character acquired through use means that, although the sign *ab initio* lacks inherent distinctiveness with regard to the goods and services claimed, owing to the use made of it on the market, at least a significant proportion of the relevant public has come to see it as identifying the goods and services claimed in the EUTM application as originating from a particular undertaking. Thus, the sign has become capable of distinguishing those goods and services from those of other undertakings because they are perceived as originating from a particular undertaking. In this way, a sign originally unable to be registered under Article 7(1)(b), (c) or (d) EUTMR can acquire new significance, and its connotation, no longer purely descriptive or non-distinctive, allows it to overcome those absolute grounds for refusal of registration as a trade mark.

2 Requests

The Office will only examine acquired distinctive character following a request from the EUTM applicant. The Office is not bound to examine facts showing that the mark claimed has become distinctive through use within the meaning of Article 7(3) EUTMR unless the applicant has pleaded them (judgment of 12/12/2002, T-247/01, Ecopy, EU:T:2002:319, § 47).

According to Article 2(2) EUTMIR, the application may include a claim that the sign has acquired distinctive character through use within the meaning of Article 7(3) EUTMR, as well as an indication of whether this claim is meant as a principal or subsidiary one. Such claim may also be made within the period referred to in Article 42(2), second sentence, EUTMR.

Therefore, as from 01/10/2017 and in accordance with Article 2(2) EUTMIR, the applicant can make the claim as a **principal** one (i.e. irrespective of the outcome on inherent distinctiveness), in which case the Office will take a single decision both on the mark’s inherent distinctiveness and, where there is none, on the claim of acquired distinctiveness through use.

The second (new) option is to make the claim as a **subsidiary** one subject to a decision on inherent distinctiveness. In this case the Office will take **two** separate decisions at different points in time: first, one on the mark’s inherent distinctiveness and then, once that decision (finding lack of inherent distinctiveness) has become final, another on the claim of acquired distinctiveness through use.

The claim must clearly and precisely identify what type it is.

As regards the timing of the request, both types of claim may be made:

- together with the application; or
- at the latest, in reply to the examiner's first objection.

Therefore, it will not be possible to raise the claim of acquired distinctiveness through use for the first time in appeal proceedings.

Where the applicant has validly made a **subsidiary claim**, the examiner will only decide on the **inherent distinctiveness** of the mark applied for and allow (in application of Article 66(2) EUTMR) this partial decision to be appealed in a separate appeal. Once that partial decision has become final, the examiner will resume the examination proceedings regarding the claim for acquired distinctiveness through use, specifying — with reference to the final findings on lack of inherent distinctiveness (public, territory, goods and services) — the time limit for submitting the corresponding evidence to substantiate that claim.

3 The Point in Time for which Acquired Distinctiveness has to be Established

The evidence must prove that distinctiveness through use was acquired prior to the EUTM application's filing date. In the case of an IR, the relevant date is the date of registration by the International Bureau or, if the designation takes place at a later stage, the designation date. Where priority is claimed, the relevant date is the priority date. Hereafter, all these dates are referred to as the 'filing date'.

3.1 Examination proceedings

Since a trade mark enjoys protection as of its filing date, and since the filing date of the application for registration determines the priority of one mark over another, a trade mark must be registrable on that date. Consequently, the applicant must prove that distinctive character was acquired through use of the trade mark prior to the date of application for registration (judgments of 11/06/2009, C-542/07 P, Pure Digital, EU:C:2009:362, § 49, 51; 07/09/2006, C-108/05, Europolis, EU:C:2006:530, § 22). Evidence of use made of the trade mark after this date should not be automatically disregarded, insofar as it may provide indicative information regarding the situation prior to the date of application (judgment of 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 49).

3.2 Cancellation proceedings

In cancellation proceedings, a trade mark that was registered in breach of the provisions of Article 7(1)(b), (c) or (d) EUTMR may nevertheless no longer be declared invalid if, in consequence of the use that has been made of it, it has, **after registration**, acquired distinctive character for the goods or services for which it is registered (Article 59(2) EUTMR).

The precise purpose of this norm is to maintain the registration of those marks that, due to the use that has been made of them, have in the meantime — that is to say, after their registration and in any event before the application for an invalidity request

— acquired distinctive character for the goods or services for which they were registered, in spite of the fact that, when registration took place, they were contrary to Article 7 EUTMR (judgments of 14/12/2011, T-237/10, Clasp lock, EU:T:2011:741, § 52-53, 86; 15/10/2008, T-405/05, Manpower, EU:T:2008:442, § 127, 146; 10/12/2008 T-365/06, BATEAUX MOUCHES, EU:T:2008:559, § 37-38).

4 Consumers

Distinctive character of a sign, including that acquired through use, must be assessed in relation to the perception of the average consumer for the category of goods or services in question. These consumers are deemed to be reasonably well informed, and reasonably observant and circumspect. The definition of the relevant public is linked to an examination of the intended purchasers of the goods or services concerned, since it is in relation to those purchasers that the mark must perform its essential function. Consequently, such a definition must be arrived at by reference to the essential function of a trade mark, namely to guarantee the identity of the origin of the goods or services covered by the mark to consumers or end users by enabling them, without any possibility of confusion, to distinguish the goods or services from others of another origin (judgment of 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 33, 38).

The relevant consumer includes, therefore, not only persons who have actually purchased the goods and services but also any potentially interested person in the strict sense of prospective purchasers (judgment of 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 41 et seq.).

Who prospective purchasers are is defined according to the precise product or service for which registration is sought. If the claimed goods or services are broad (for example, bags or watches), it is irrelevant that the actual products offered under the sign are extremely expensive luxury items — the public will include all the prospective purchasers for the goods claimed in the EUTM application, including non-luxury and cheaper items if the claim is for a broad category.

5 Goods and Services

Since the main function of a trade mark is to guarantee the origin of goods and services, acquired distinctiveness must be assessed in respect of the goods and services at issue. Consequently, the applicant's evidence must prove a link between the sign and the goods and services for which the sign is applied for, establishing that the relevant class of persons, or at least a significant proportion thereof, identify the goods and services as originating from a particular undertaking because of the trade mark (judgments of 04/05/1999, C-108/97 and C-109/97, Chiemsee, EU:C:1999:230, § 52; 19/05/2009, T-211/06, Cybercrédit et al., EU:T:2009:160, § 51).

6 Territorial Aspects

Pursuant to Article 1 EUTMR, a European Union trade mark has a unitary character and has equal effect throughout the European Union. Accordingly, a mark must be refused registration even if it is devoid of distinctive character only in part of the European Union. That part of the European Union may be comprised of a single

Member State (see, to that effect, judgments of 22/06/2006, C-25/05 P, *Bonbonverpackung*, EU:C:2006:422, § 81-83; 29/09/2010, T-378/07, *Représentation d'un tracteur en rouge, noir et gris*, EU:T:2010:413 § 45 and the case-law cited).

As a logical consequence, acquired distinctiveness must be established throughout the territory in which the trade mark did not *ab initio* have distinctive character (judgments of 22/06/2006, C-25/05 P, *Bonbonverpackung*, EU:C:2006:422, § 83, 86; 29/09/2010, T-378/07, *Représentation d'un tracteur en rouge, noir et gris*, EU:T:2010:413, § 30).

This may prove difficult and burdensome for the applicant, particularly with regard to three-dimensional or colour marks, where consumer perception of a potential lack of inherent distinctiveness will most likely be the same in each and every Member State of the European Union. In this respect, the Court has held that, despite the fact that acquired distinctiveness must be shown **throughout the European Union**, it would be **unreasonable** to require proof of acquired distinctiveness for **each individual Member State** (judgment of 24/05/2012, C-98/11 P, *Hase*, EU:C:2012:307, § 62).

In this context the question arises whether the Office can **extrapolate** from selective evidence to draw broader conclusions. This concerns the extent to which evidence showing distinctiveness acquired through use in certain Member States can be used to make inferences with regard to the market situation in other Member States not covered by the evidence (see paragraph 6.3 below).

Evidence of acquired distinctiveness must be **examined as a whole**, taking into account, in particular, the market share held by the trade mark, and the intensity, frequency and duration of use of the mark (see paragraph 8 below). The evidence must establish that a significant proportion of the relevant public is able, by virtue of that mark, to identify the goods or services concerned as originating from a particular undertaking. Evidence from non-EU states is irrelevant, except insofar as it might enable conclusions to be drawn about use within the EU (judgment of 24/06/2014, T-273/12, *Ab in den Urlaub*, EU:T:2014:568, § 45).

6.1 Special provisions with respect to the accession of new Member States

In accordance with the provisions of the EU Accession Treaties, an EUTM applied for before the date of accession of a given Member State may only be rejected for reasons that already existed before the date of accession. Hence, in the Office's examination proceedings, acquired distinctiveness must be demonstrated only with respect to Member States of the EU at the time of the EUTM application, and not those that have joined the EU subsequently.

6.2 Language area

Without prejudice to the possibility of extrapolating the evidence (see paragraph 6.3 below), acquired distinctiveness through use must be shown, in principle, with respect to all those Member States/territories in which the EUTM applied for is objected to because:

- of its meaning in the official language of one or more Member State(s) (e.g. German in Austria and Germany); and/or

- it is in a Member State language understood by the relevant public of another Member State(s) in which it is not an official language (e.g. basic English words); and/or
- it is in a language understood by a significant section of the relevant public in at least part of the European Union (e.g. the Turkish word ‘hellim’ in Cyprus, judgment of 13/06/2012, T-534/10, Hellim, EU:T:2012:292).

For further explanations about the different scenarios listed above, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4: Descriptive Trade Marks (Article 7(1)(c) EUTMR), paragraph 1.1.2.

Particular care should be taken when a language is an official language in more than one EU Member State. In such cases, when dealing with an absolute grounds objection based on the meaning of wording in a certain language, acquired distinctiveness through use must be proven for each of the Member States in which that language is official (as well as any other Member States or markets where it will be understood).

Examples of languages that are official in more than one EU Member State:

Language	Official language in the following Member States
German	Belgium, Germany, Luxembourg and Austria
Greek	Greece and Cyprus
English	Ireland, Malta and the United Kingdom,
French	Belgium, France and Luxembourg
Dutch	Belgium and Netherlands
Swedish	Finland and Sweden (judgment of 09/07/2014, T-520/12 Giffjar, EU:T:2014:620, upholding the decision of the Second Board of Appeal from 18/09/2012, R 46/2012-2, giffjar)

It should also be taken into account that in some regions there are **substantial minorities** who have as their native language a language (or languages) other than the official language(s) of the Member State concerned and which is/are often also protected as minority language(s). By way of example, German is on a par with Italian in the Italian Autonomous Region Trentino-Alto Adige (decision of 10/10/2014, R 574/2013-G, SUEDTIROL, § 17) and is French with the Italian region of Valle d’Aosta, while Denmark has a substantial German-speaking minority (judgment of 24/06/2014, T-273/12, Ab in den Urlaub, EU:T:2014:568, § 44).

6.3 Extrapolation

As indicated above, the acquisition of distinctive character through use must be proven for the part of the European Union in which the trade mark concerned did not **initially** have such character.

This may prove difficult and burdensome for the applicant, particularly when the objection exists throughout the European Union. This is normally the case for **3D marks, colours per se and figurative trade marks consisting exclusively of the depiction of the goods** in question, as it may be assumed that the assessment of their distinctiveness will be the same throughout the European Union, unless there is

concrete evidence to the contrary (judgment of 24/02/2016, T-411/14, Shape of a bottle (3D), EU:T:2016:94, § 68).

However, the Court has held that, despite the fact that acquired distinctiveness must be shown throughout the European Union, **it would be unreasonable to require proof of acquired distinctiveness for each individual Member State** (judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 62). This principle implies that, if one considers the European territory as a puzzle, failure to prove acquired distinctiveness for one or more specific national markets may not be decisive, provided that the 'missing piece' of the puzzle does not affect the general picture that a significant proportion of the relevant European public perceives the sign as a trade mark in the various parts or regions of the European Union.

In light of the above, the Office considers that, in certain cases, it is possible to **extrapolate from selective evidence to draw broader conclusions**. As a result, evidence showing distinctiveness acquired through use in certain Member States can be used to make inferences with regard to the market situation in other Member States not covered by the evidence.

Extrapolating in this way to make broader inferences is of particular relevance to an enlarged European Union comprising many Member States, since it is highly likely that a party will not be able to provide comprehensive evidence with respect to the whole European Union, but will rather tend to concentrate on some areas.

Extrapolation is possible where the following **two conditions** are met.

- **The market is homogeneous** (i.e. the area where acquired distinctiveness is proven and the area where evidence is extrapolated): market conditions and consumer habits have to be comparable. Consequently, it is particularly important that the applicant submits data concerning the size of the market, its own market share and, if possible, that of its main competitors, as well as its marketing expenses. The Office can only extrapolate the results from one territory to another if all the data is comparable. For instance, in the case of surveys covering only some Member States, the applicant will have to demonstrate that the Member States' markets covered by the surveys are comparable to those of the other Member States and that the results of the surveys can be extrapolated (judgment of 24/02/2016, T-411/14, Shape of a bottle (3D), EU:T:2016:94, § 80).
- **At least some evidence of use is submitted for the area where the evidence is extrapolated**. Therefore, where the EUTM is used in the entire relevant territory but most of the evidence only refers to part of it, inference is possible if the circumstances are comparable and some evidence of use in another part/other parts of the relevant territory is submitted.

Evidence of acquired distinctiveness for the 'combination of the colours green and yellow' throughout the European Union was **accepted** despite a **lack of evidence** with regard to current turnover figures and no official statements on the relevant public's perception for **two Member States** (judgment of 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 38 et seq.)

On the other hand, the Court rejected the claim of acquired distinctiveness for a 'chequerboard pattern' because the applicant had not provided any relevant evidence in **4** out of the then 15 relevant Member States, without examining the evidence filed for

the other 11 Member States (judgment of 21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 101 et seq., under appeal).

7 Standard of Proof

The requirements to prove acquired distinctiveness through use pursuant to Article 7(3) EUTMR are not the same as those to prove genuine use pursuant to Article 47(2) EUTMR. Whilst under Article 7(3) EUTMR it is necessary to prove qualified use, such that the relevant public perceives as distinctive a sign that per se is devoid of distinctive character, the reason behind the proof of genuine use is completely different, namely to restrict the number of trade marks registered and protected, and consequently the number of conflicts between them.

Furthermore, the Court has held that the case-law relating to Article 7(3) EUTMR must not be confused with the case-law relating to the acquisition of reputation (which must be proven in a substantial part of the European Union but not in every Member State). The applicant must prove the acquisition of distinctive character through use in the part of the European Union in which the contested mark was devoid of any distinctive character. The case-law related to Article 7(3) EUTMR, therefore, must not be confused with the test on acquisition of reputation (judgment of 21/04/2015, T-359/12, Device of a checked Pattern (maroon & beige), EU:T:2015:215, § 119-120 and case-law quoted therein).

Therefore, the EUTM applicant must submit evidence that enables the Office to find that at least a significant proportion of the relevant section of the public identifies the products or services concerned as originating from a particular undertaking because of the trade mark (judgment of 15/12/2015, T-262/04, Briquet à Pierre, EU:T:2005:463, § 61 and the case-law cited therein).

The evidence must be clear and convincing. The EUTM applicant must clearly establish all the facts necessary to safely conclude that the mark has been used as a badge of origin, that is to say, that it has created a link in the mind of the relevant public with the goods or services provided by a specific company, despite the fact that, in the absence of such use, the sign at issue would lack the necessary distinctiveness to create such a link.

For example, the combination of the colours green and yellow was found to have acquired distinctiveness through use because it referred to the machines manufactured by a certain company. The means of evidence were a number of statements from professional associations according to which such combination referred to agricultural machines manufactured by that company and the fact that the company had been using the same combination of colours on its machines consistently in the European Union for a considerable time prior to 1996 (judgment of 28/10/2009 T-137/08, Green/Yellow, EU:T:2009:417, § 36-37).

Therefore, acquired distinctiveness must be the result of the use of the mark as a trade mark, not as purely functional packaging (judgment of 25/09/2014, T-474/12, Shape of goblets (3D), EU:T:2014:813, § 56-58 and the case-law cited therein) or as a descriptive indication on packaging. For example, use of the sign 'Gifflar' (which indicates a kind of bread in Swedish) on the packaging of pastries, together with descriptive indications of flavours, is made in a descriptive context, not as a badge of origin (judgment of 09/07/2014, T-520/12, Gifflar, EU:T:2014:620, § 44-45).

For a finding of acquired distinctiveness through use, the case-law does not prescribe fixed percentages of market penetration or of recognition by the relevant public (judgment of 19/06/2014, C-217/13 and C-218/13, Oberbank e.a., EU:C:2014:2012, § 48). Rather than using a fixed percentage of the relevant public in a given market, the evidence should show that a significant proportion of the public perceives the mark as identifying specific goods or services from a particular undertaking.

The evidence must relate to each of the goods and services claimed in the EUTM application. After an initial absolute grounds objection under Article 7(1)(b), (c) or (d) EUTMR, only the goods and services claimed for which acquired distinctiveness through use has been proven may proceed to registration.

8 Assessment of the Evidence

In establishing acquired distinctiveness, account may be taken of, inter alia, the following **factors**:

- the market share held by the mark with regard to the relevant goods or services;
- how intensive, geographically widespread and long-standing use of the mark has been;
- the amount invested by the undertaking in promoting the mark for the relevant goods or services;
- the proportion of the relevant public who, because of the mark, identifies the goods or services as originating from a particular undertaking.

See judgments of 04/05/1999, C-108/97 and C-109/97, Chiemsee, EU:C:1999:230, § 31; 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, § 32.

Article 97 EUTMR contains a non-exhaustive list of **means of giving or obtaining evidence** in proceedings before the Office, which may serve as guidance to applicants. Examples of evidence that may help to show acquired distinctiveness include, inter alia:

- sales brochures
- catalogues
- price lists
- invoices
- annual reports
- turnover figures
- advertising investment figures and reports
- advertisements (press cuttings, billboard posters, TV adverts), together with evidence of their intensity and reach
- customer and/or market surveys
- affidavits.

For further details on means of evidence, see by analogy the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

The basic rules on the **evaluation of evidence** are also applicable here. The Office must make an **overall assessment of all the evidence** submitted (judgment of

04/05/1999, C-108/97 and C-109/97, Chiemsee, EU:C:1999:230, § 49), weighing up each indication against the others.

Applicants should take great care to make sure not only that the evidence shows use of the **mark applied for** but also that it is sufficient to identify the **dates** of such use and the specific **geographical** territory of use within the EU. Evidence that cannot be related to a certain point in time will normally be insufficient to show that distinctiveness had been acquired before the filing date, and evidence of use outside the EU cannot show the required market recognition of the relevant public within the EU. Furthermore, evidence that mixes material relating to the EU with that relating to non-EU territories, and does not permit the Office to identify the specific extent of EU-only use, will be similarly devoid of probative value for the relevant EU public.

The Court has declared that direct evidence such as declarations by professional associations and market studies are usually the most relevant means for proving acquired distinctiveness through use. Invoices, advertising expenditure, magazines and catalogues may help to corroborate such direct evidence (judgment of 29/01/13, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 74).

In order to assess the evidential value of a document, regard should be had to its **credibility**. It is also necessary to take into account the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, superficially, the document appears sound and reliable (judgments of 07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42; 16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 46 et seq.).

8.1 Opinion polls and surveys

Opinion polls concerning the level of recognition of the trade mark by the relevant public on the market in question can, if conducted properly, constitute one of the most direct kinds of evidence, since they can show the actual perception of the relevant public. However, it is not an easy matter to correctly formulate and implement an opinion poll so that it can be seen to **be truly neutral and representative**. Leading questions, unrepresentative samples of the public, and undue editing of responses should be avoided, as these can undermine the probative value of such surveys.

Accordingly, any opinion poll evidence must be assessed carefully. It is important that the questions asked are not leading ones (judgment of 13/09/12, T-72/11, Espetec, EU:T:2012:424, § 79). The criteria for selecting the public interviewed must be assessed carefully. The sample must be indicative of the entire relevant public and must be selected randomly (judgment of 29/01/13, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 88).

The Court does not exclude that a survey compiled some time before or after the filing date could contain useful indications, although it is clear that its evidential value is likely to vary depending on whether the period covered is close to or distant from the filing date or priority date of the trade mark application at issue. Furthermore, its evidential value depends on the survey method used (judgment of 12/07/2006, T-277/04, Vitacoat, EU:T:2006:202, § 38-39).

However, the Court of Justice has made it clear that the results of a consumer survey cannot be the only decisive criterion in support of the conclusion that distinctive character has been acquired through use (judgment of 19/06/2014, C-217/13 and

C-218/13, Oberbank e.a., EU:C:2014:2012, § 48). They must therefore be complemented by other means of evidence.

For further details on the assessment of opinion polls, see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

8.2 Market share, advertising and turnover

The **market share** held by the trade mark in relation to the goods and/or services applied for may be relevant for assessing whether that mark has acquired distinctive character through use, since such market penetration might enable the Office to infer that the relevant public would recognise the mark as identifying the goods or services as originating from a specific undertaking, and thus distinguish them from the goods and services of other undertakings.

The **investment** in advertising or promoting the mark in the relevant market for the goods or services claimed may also be relevant for assessing whether the mark has acquired distinctive character through use (judgment of 22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 76 et seq.). However, many attempts to prove distinctiveness acquired through use fail because the evidence provided by the applicant is not sufficient to prove a link between the market share and advertising, on the one hand, and consumer perceptions on the other.

Information concerning **turnover** and advertising expenses is one of the most readily available forms of evidence. These figures can have a significant impact on the assessment of the evidence, but in the great majority of cases are not sufficient alone to prove acquired distinctiveness of a trade mark through use. This is because turnover/advertising costs alone, without additional corroborative details, are frequently too general to allow specific conclusions to be drawn about the use of one particular trade mark. It is thus necessary to identify precisely the turnover/advertising figures and evidence relating to the mark applied for, as well as their link to the relevant goods and services. Furthermore, it is desirable that the figures be segregated on an annual and market-by-market basis. The evidence should show the specific period(s) of use (including details of when use commenced), so that the Office is able to establish whether the evidence proves that the trade mark acquired distinctiveness before the filing date.

Goods and services are often marketed under several trade marks, which makes it difficult to see the relevant customer's perception of the EUTM applied for on its own, that is to say, without such perception being affected by the other marks present. Turnover and advertising figures can often include sales or promotion of other trade marks, or of significantly different forms of the trade mark at issue (for example, figurative trade marks rather than word marks, or differing word elements in a figurative mark), or are too general to allow identification of the specific markets under consideration. As a consequence, broadly consolidated turnover or advertising figures may not be sufficient to prove whether the relevant public perceives the trade mark at issue as a badge of origin or not.

For further details on the assessment of market share, advertising and turnover, see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

8.3 Declarations, affidavits and written statements

Pursuant to Article 97(1)(f) EUTMR, ‘statements in writing, sworn or affirmed or having a similar effect under the law of the State in which [they are] drawn up’, are valid means of evidence. With regard to **admissibility**, only in cases where the statements have not been sworn or affirmed is it necessary to consider the rules of law of the national jurisdiction as to the effects of a written statement (judgment of 07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 40). In case of doubt as to whether a statement has been sworn or affirmed, it is up to the applicant to submit evidence in this regard.

The weight and **probative value** of statutory declarations is determined by the general rules applied by the Office to the assessment of such evidence. In particular, both the capacity of the person giving the evidence and the relevance of the contents of the statement to the particular case must be taken into account.

Statements from **independent trade associations, consumer organisations and competitors** are an important means of evidence insofar as they come from independent sources. However, they must be examined carefully, as they might not be enough to prove distinctiveness acquired through use if, for example, they refer to ‘the trade marks of the applicant’ instead of to the specific mark in question (judgment of 13/09/12, T-72/11, *Espetec*, EU:T:2012:424, § 83-84).

Evidence from **suppliers or distributors** should, generally, be given less weight, since it is less likely that their evidence will be from an independent perspective. In this regard, the degree of independence of the latter will influence the weight to be given to the evidence by the Office (judgment of 28/10/2009 T-137/08, *Green/Yellow*, EU:T:2009:417, § 54-56).

Insofar as a declaration is **not made by an independent third party**, but by a person connected to the applicant through an employment relationship, it cannot in itself constitute sufficient evidence that the mark applied for has acquired distinctive character through use. In consequence, it must be treated as merely indicative and needs to be corroborated by other evidence (judgment of 21/11/2012 T-338/11, *Photos/com*, EU:T:2012:614, § 51)

As regards **statements from chambers of commerce and industry or other trade and professional associations and certifications and awards**, the Court has noted that such statements and certifications must identify precisely the trade mark applied for (judgment of 13/09/2012, T-72/11, *Espetec*, EU:T:2012:424, § 82 et seq.).

However, **cease and desist letters** against competitors or letters to newspapers complaining against the use of the sign in a generic sense have been considered evidence against acquired distinctiveness (judgment of 21/05/2014, T-553/12, *BATEAUX MOUCHES*, EU:T:2014:264, § 66)

For further details on the assessment of means of evidence, see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

8.4 Prior registrations and acquired distinctiveness

For evidence that consists of or includes Member State registrations **obtained on the basis of acquired distinctiveness**, the date to which the evidence filed at national

level refers will usually be different from the filing date of the EUTM application. These registrations are not binding, but may be taken into account, provided that the Office is able to assess the evidence submitted to the national IP office in question.

The applicant may also refer to **prior national registrations** where no acquired distinctiveness is claimed. Nevertheless, it is established case-law that such registrations do not bind the Office. Moreover, the Office is not bound by its previous decisions and such cases must be assessed on their own merits (judgment of 21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264, § 72-73).

8.5 Manner of use

Acquired distinctiveness must be demonstrated with respect to the sign applied for. The evidence should show examples of how the trade mark is actually used (brochures, packaging, samples of the goods, etc.). Only insignificant variations may be acceptable.

It is possible to prove acquired distinctiveness of a sign that **has been used together with other trade marks** (judgment of 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 27), provided that the relevant consumer attributes to the sign in question the function of identification (judgments of 07/07/2005, C-353/03, Have a break, EU:C:2005:432; 30/09/2009, T-75/08, !, EU:T:2009:374, § 43; 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 46).

The Court further ruled that, although the trade mark for which registration is sought may have been used as part of a registered trade mark or in conjunction with such a mark, the fact remains that, for the purposes of the registration of the mark itself, the trade mark applicant must prove that that mark alone, as opposed to any other trade mark that may also be present, identifies the particular undertaking from which the goods originate (judgment of 16/09/2015, C-215/14, Nestlé KIT KAT, EU:C:2015:604, § 66). See also in this respect, judgments of 24/02/2016 in T-411/14, Shape of a bottle (3D), EU:T:2016:94, § 76; 16/03/2016 in T-363/15, LAATIKON MUOTO (3D), EU:T:2016:149, § 51.

Moreover, the Court has held on numerous occasions that **advertising material** on which a sign that is devoid of any distinctive character always appears with other marks that, by contrast, do have distinctive character does not constitute proof that the public perceives the sign applied for as a mark that indicates the commercial origin of the goods. For instance, the Court considered that the use of the sign 'Gifflar' (which indicates a kind of bread in Swedish) on the packaging of pastries, together with the trade mark Pågen, was made in a descriptive context, not as a badge of origin (judgment of 09/07/2014, T-520/12, Gifflar, EU:T:2014:620, § 44-45).

8.6 Length of use

The evidence should indicate when use commenced and should also show that the use was continuous or indicate reasons if there are gaps in the period of use.

As a general rule, long-standing use is likely to be an important persuasive element in establishing acquired distinctiveness. The longer customers and potential customers have been exposed to a mark the more likely they are to have made the connection between that mark and a single source in trade.

Considering, however, that length of use is only one of the factors to be taken into account, there may be situations where exceptions to the above rule are justified, in particular when other factors may also come into play that are capable of making up for a short length of use. For example, where products or services are the subject of a major advertising launch and/or the sign applied for is a mere variant of a sign already in long use, it may be the case that acquired distinctiveness can be achieved quite quickly.

This could be the case, for instance, where a new version of an existing and widely used computer-operating system is launched under a sign that essentially reproduces the structure and/or contents of the trade mark applied to previous versions of the product. The trade mark for such a product would be capable of achieving widespread acquired distinctiveness within a fairly short period of time simply because all existing users will immediately be made aware that the sign applied for refers to the upgrading to the new version.

In the same vein, it is in the nature of certain major sporting, musical or cultural events that they take place at regular intervals and are known to have extremely wide appeal. These major events are anticipated by millions, and the knowledge that the event is due on a particular date precedes the formal announcement of where it will take place. This circumstance creates intense interest in the nominated location of such events and in the announcement thereof ('city/country+year' marks). It is therefore reasonable to suppose that the moment a particular event, tournament or games is announced as having been allocated to a particular city or country, it is likely to become known instantly to practically all relevant consumers with an interest in the sector concerned or to professionals in the sector. This may thereby give rise to the possibility of very rapid acquired distinctiveness of a mark concerning a forthcoming event, in particular where the sign reproduces the structure of previously used trade marks with the result that the public immediately perceives the new event as a sequel to a series of well-established events.

The assessment of such rapid acquired distinctiveness will follow the general criteria regarding, for instance, extent of use, territory, relevant date or targeted public, as well as regarding the onus on the applicant to provide evidence thereof. The only particularity refers to length of use and the possibility that, under certain circumstances, the acquisition of acquired distinctiveness may occur very rapidly, or even instantaneously. As under any other claim for acquired distinctiveness, it is for the applicant to demonstrate that the public is able to perceive the trade mark in question as a distinctive sign.

8.7 Post-filing date evidence

The evidence must show that, prior to the filing date, the trade mark had acquired distinctive character through use.

However, this does not preclude the possibility that account may be taken of evidence that, although subsequent to the filing date, enables conclusions to be drawn regarding the situation as it was on the filing date (judgment of 19/06/2014, C-217/13, Oberbank e.a., EU:C:2014:2012, § 60). Therefore, evidence cannot be rejected merely because it post-dates the filing date. Accordingly, such evidence must be assessed and given due weight.

As an example, a trade mark that enjoys particularly relevant recognition on the market or a substantially relevant market share a few months after the filing date may have had acquired distinctiveness also on the filing date.

9 Consequences of Acquired Distinctiveness

A trade mark registered in accordance with Article 7(3) EUTMR enjoys the same protection as any other trade mark that was found inherently registrable upon examination.

If the EUTM application is accepted based on Article 7(3) EUTMR, this information is published in the EUTM Bulletin, using INID code 521.