

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

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

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 2

***EUTM DEFINITION
(Article 7(1)(a) EUTMR)***

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1 General Remarks

Article 7(1)(a) EUTMR reflects the Office's obligation to refuse signs that do not conform to the requirements of Article 4 EUTMR.

As from 01/10/2017, according to Article 4 EUTMR, a European Union trade mark may consist of any **signs**, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of **distinguishing** the goods or services of one undertaking from those of other undertakings and being **represented on the Register** of European Union trade marks (the Register) in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

According to Article 39(2)(a) EUTMIR, 'Title II [application procedure] shall not apply to applications for an EU trade mark entered before 01/10/2017, as well as to international registrations for which the designation of the Union was made before that date'.

To be capable of constituting a trade mark for the purposes of Article 4 EUTMR, the subject matter of an application must satisfy three conditions:

- (a) it must be a sign;
- (b) it must be capable of distinguishing the goods or services of one undertaking from those of others;
- (c) it must be capable of being represented on the Register in a way that allows the competent authorities and the public to determine the clear and precise subject matter of protection.

a) Signs

Article 4 EUTMR and Article 3(3) EUTMIR, read in conjunction, draw up a non-exhaustive list of signs that may constitute an EUTM: word marks, figurative marks, shape marks, position marks, pattern marks, single colour and combination of colour marks, sound marks, motion marks, multimedia marks, and hologram marks.

Where the mark does not fall within the definition of any of the specific types of marks listed in Article 3(3) EUTMIR, it can qualify as an 'other' mark provided for by Article 3(4) EUTMIR, provided it complies with the representation requirements set out in Article (3)1 EUTMIR.

Within this context, abstract concepts and ideas or general characteristics of goods are not specific enough to qualify as a sign, as they could apply to a variety of different manifestations (21/04/2010, T-7/09, Spannfutter, EU:T:2010:153, § 25). For this reason, the Court rejected, for example, an application for a 'transparent collecting bin forming part of the external surface of a vacuum cleaner', as the subject matter was not a particular type of bin, but rather, in a general and abstract manner, all conceivable shapes of a transparent bin with a multitude of different appearances (25/01/2007, C-321/03, Transparent bin, EU:C:2007:51, § 35, 37).

b) Distinguishing character

Article 4(a) EUTMR refers to the capacity of a sign to distinguish the goods of one undertaking from those of another. Unlike Article 7(1)(b) EUTMR, which concerns the distinctive character of a trade mark with regard to specific goods or services, Article 4 EUTMR is merely concerned with the abstract ability of a sign to serve as a badge of origin, regardless of the goods or services.

Only in very exceptional circumstances is it conceivable that a sign could not possess even the abstract capacity to distinguish the goods or services of one undertaking from those of another. An example for the lack of abstract capacity in the context of any goods or services could be the word 'Trademark'.

c) Representation on the Register

According to Article 4(b) EUTMR, the sign applied for needs to be capable of being represented on the Register, in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

Regarding the representation of the sign, Article 3(3) EUTMIR lays down a non-exhaustive list of trade marks together with their definition and representation requirements. Article 3(4) EUTMIR deals with 'other' types of marks. For more information in this regard, see the Guidelines, Part B, Examination, Section 2, Formalities.

Article 3(1) EUTMIR states that the trade mark can be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor.

The criteria listed by the EUTMIR are identical to those established in the Sieckmann case (12/12/2002, C-273/00, Sieckmann, EU:C:2002:748) with respect to the requirement for a clear and precise acceptable 'graphical' representation under the previous wording of the EUTMR.

Article 3(9) EUTMIR clarifies that the filing of a sample or a specimen does not constitute a proper representation of a trade mark. The reason is that these cannot be clearly and precisely represented and are not generally available for inspection on the Register by means of commonly available technology. For example, a sample of a scent would not be a durable and stable representation of a trade mark, thereby not complying with the clarity and precision requirements.

Article 3(2) EUTMIR makes clear that the subject matter of the registration is defined by the **representation of the mark**. In the limited number of cases where the representation is accompanied by a description (see below), the description must accord with the representation and must not extend its scope.

Whenever the representation of the sign does not enable the competent authorities (namely trade mark offices and courts) and competitors to determine the clear and precise subject matter of the protection afforded to its proprietor, the mark has to be refused for not complying with Article 7(1)(a) EUTMR. This is an objective assessment

to be carried out by applying the criteria listed in Article 3(1) EUTMIR, for which no particular consumer segment has to be taken into account.

Where the applicant has duly complied with the formalities requirements (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 9) — that is, the filing of a representation of the sign in accordance with the corresponding requirements of Article 3(1) and (3) EUTMIR and correct indication of the type of mark — the representation of the sign on the Register should enable the competent authorities and the public to determine the clear and precise subject matter of protection of the mark.

Nevertheless, issues in this respect are more likely to arise pursuant to Article 31(1)(d) EUTMR where the mark applied for does not qualify as one of the types of marks listed in Article 3(3) EUTMIR but as an ‘other’ type of mark (Article 3(4) EUTMIR), for which there are no specific explicit rules on representation other than that of complying with the standards set out in Article 3(1) EUTMIR.

2 ‘Non-traditional’ Trade Marks and Article 7(1)(a) EUTMR

Assessing whether the representation of the sign enables the competent authorities and the public to determine the clear and precise subject matter of protection of the mark seems rather straightforward for traditional types of marks (word and figurative marks). To the extent that these marks have passed the Office’s formalities examination, they can, in general, be assessed directly under the other grounds of Article 7 EUTMR as there should not be any issues under Article 7(1)(a) EUTMR.

A closer examination of the requirements under Article 7(1)(a) and Article 4 EUTMR might, however, be needed in the case of less ‘traditional’ signs.

Although **graphical** representation as a general requirement has been abolished, the existing case-law dealing with the graphical representation of signs is still relevant in some cases for understanding the requirement that signs have to be capable of being adequately represented on the Register.

2.1 Shape marks

According to Article 3(3)(c) EUTMIR, a shape mark is a trade mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or its appearance.

The term ‘extending to’ means that these marks cover not only the shapes per se, but also shapes that contain word or figurative elements, labels, etc.

The representation of shape marks requires the one of the following to be submitted:

- a graphic reproduction of the shape, including computer-generated imaging;
- a photographic reproduction.

The graphic or photographic reproduction may contain different views. Where the representation is not provided electronically, it may contain up to six different views.

2.2 Position marks

According to Article 3(3)(d) EUTMIR, a position mark is a trade mark consisting of the specific way in which the mark is placed on or affixed to the goods.

The abovementioned article stipulates the following mandatory and optional representation requirements for position marks.

- a) An appropriate identification of the **position** of the mark and its size or proportion **with respect** to the relevant goods (mandatory).
- b) A visual disclaimer of those elements that are not intended to form part of the subject-matter of the registration (mandatory). The EUTMIR gives preference to broken or dotted lines.
- c) A description explaining how the sign is affixed to the goods (optional). The representation should by itself clearly define the position of the mark as well as its size or proportion with respect to the goods. Therefore, according to Article 3(2) EUTMIR, the description may only serve explanatory purposes; it cannot serve to substitute visual disclaimers.

An objection under Article 7(1)(a) EUTMR may be raised for those goods on which the positioning of the mark is unclear. For example, if a position mark is applied for in respect of *clothing, footwear and headgear*, but the representation identifies the position of the mark on *footwear* only, an objection should be raised for *clothing* and *headgear*.

2.3 Pattern marks

Article 3(3)(e) EUTMIR defines pattern marks as those trade marks consisting exclusively of a set of elements that are repeated regularly.

The article requires that pattern marks ‘be represented by submitting a reproduction showing the pattern of repetition.’ Descriptions detailing how its elements are repeated in a regular pattern are allowed for this type of mark. For other cases where the EUTMIR allows for the possibility of adding descriptions, the description must accord with the representation and must not extend its scope.

2.4 Colour marks

According to Article 3(3)(f) EUTMIR, colour marks are either single colour marks without contours or a combination of colours without contours.

- (i) Trade marks consisting exclusively of a single colour (without contours) require:
 - a reproduction of the colour (mandatory);
 - a reference to a generally recognised colour code (mandatory).

(ii) Trade marks consisting exclusively of a combination of colours (without contours) require:

- a reproduction of the colour combination that shows the systematic arrangement of the colour combination in a uniform and predetermined manner (mandatory);
- a reference to a generally recognised colour code (mandatory);
- a description detailing the systematic arrangement of the colours (optional).

For colour combinations, the EUTMIR has applied the case-law according to which the representation ‘must be systematically arranged by associating the colours concerned in a predetermined and uniform way’, as the Court of Justice stated that the mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours ‘in every conceivable form’, did not meet the requisite standards of precision and uniformity (24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33-34);

If a combination of colours without contours is not systematically arranged in a uniform and predetermined manner, too many different variations would be possible and this would not allow the competent authorities and economic operators to know the precise scope of the registrations.

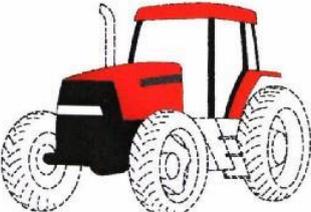
As the trade mark’s subject matter of protection is exclusively determined by the representation itself, any voluntary description detailing the systematic arrangement must accord with the representation (i.e. it cannot be inconsistent with the image shown) and must not extend beyond its subject matter (Article 3(2) EUTMIR). In addition, a lack of accord between the representation and the description leads to a lack of clarity and precision of the mark (Article 3(2) EUTMIR).

Example of signs that are **acceptable** (with or without a description):

Sign	Case No
	<p>EUTM 11 055 811</p> <p><u>Description:</u> The mark consists of five stripes of colour arranged horizontally and directly adjoining each other, their length being several times larger than their height. The colour distribution from the top to the bottom is: very light green, light green, medium green, dark green and very dark green. Proportion of the five colours: 20 % each.</p>

The sign can also indicate how the colours will be applied to the goods at issue where this is made by means of an iconic representation (as opposed to a naturalistic one), as shown in the following examples:

Sign	Case No
<div style="text-align: center;">  </div> <p><u>Colour indication:</u> RAL 9018; NCS S 5040G50Y + RAL 9018 1 : 4; NCS S 5040G50Y + RAL 9018 2 : 3; NCS S 5040G50Y + RAL 9018 3 : 2; NCS S 504050Y + RAL 9018 4 : 1: NCS S 5040G50Y.</p> <p><u>Description:</u> none</p> <p><i>Class 7 — Wind energy converters, and parts therefor.</i></p>	<p style="text-align: center;">EUTM: 2 346 542</p> <p>03/05/2017, T-36/16, BLENDED SHADE OF GREEN, EU:T:2017:295</p>
<p>[T]he contested mark was registered as a colour mark (§ 36).</p> <p>Consequently ... the upright trapezoidal shape is not part of the subject matter of the protection sought and that element does not set contours to the colours, but only serves to indicate how the colours will be applied on the goods at issue. The protection sought is thus for a specific combination of colours applied on the lower section of a shaft, irrespective of the shape of that shaft, which is not part of the subject matter of the protection sought. (§ 40)</p>	

<div style="text-align: center;">  </div> <p><u>Colours indicated:</u> Red, black and grey</p> <p><u>Description:</u> The mark consists of the combination of the colours red, black and grey as applied to the exterior surfaces of a tractor, namely red as applied to the bonnet, roof and wheel arches, light and dark grey as applied to the bonnet in a horizontal stripe and black as applied to the front bonnet grill, chassis and vertical trim — as depicted in the illustrative representation attached to the application.</p>	<p style="text-align: center;">EUTM 9 045 907</p> <p>(This mark was applied for as ‘other’ under the previous regime, indicating that it was a position mark. The example is given here to show that it can also be filed as a colour mark (combination of colours), showing how the combination appears on the products.)</p>
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2.5 Sound marks

Article 3(3)(g) EUTMIR defines sound marks as trade marks consisting exclusively of a sound or combination of sounds.

EUTM applications for sound marks can **only** be an audio file reproducing the sound **or** an accurate representation of the sound in musical notation (for technical information and further details on **valid means** of representation of sound marks, see the Guidelines, Part B, Examination, Section 2, Formalities).

Other means of representation, such as onomatopoeia, musical notes alone and sonograms will not be accepted as representations of sound marks for EUTM applications. In all cases, these representations would not sufficiently enable the competent authorities and the public to determine the clear and precise subject matter of protection.

- *Description of a sound in words*

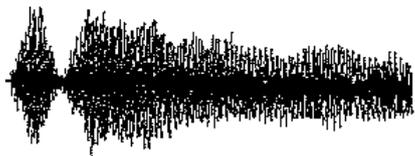
A description such as certain notes of a piece of music, e.g. ‘the first 9 bars of *Für Elise*’, or a description of the sound in words, e.g. ‘the sound of a cockcrow’, is not sufficiently precise or clear and therefore does not make it possible to determine the scope of the protection sought (27/11/2003, C-283/01, Musical notation, EU:C:2003:641, § 59).

- *Onomatopoeia*

There is a lack of consistency between the onomatopoeia itself, as pronounced, and the actual sound or noise, or the sequence of actual sounds or noises, that it purports to imitate phonetically (27/11/2003, C-283/01, Musical notation, EU:C:2003:641, § 60).

- *Musical notes alone*

A sequence of musical notes alone, such as E, D#, E, D#, E, B, D, C, A, does not constitute a graphical representation. Such a description, which is neither clear, nor precise nor self-contained, does not make it possible, in particular, to determine the pitch and duration of the sounds forming the melody for which registration is sought and that constitute essential parameters for the purposes of knowing the melody and, accordingly, of defining the trade mark itself (27/11/2003, C-283/01, Musical notation, EU:C:2003:641, § 61).

Example of an unacceptable sound mark	
<p>EUTM 143 891 R 0781/1999-4 (ROARING LION)</p> <p>The (alleged) sonogram was considered incomplete, as it did not contain a representation of scale of the time axis and the frequency axis (para. 28).</p>	

2.6 Motion marks

Article 3(3)(h) EUTMIR defines motion marks as ‘trade mark(s) consisting of, or extending to, a movement or a change in the position of the elements of the mark’.

The definition does not restrict motion marks to those depicting movement. A sign may also qualify as a motion mark if it is capable of showing a change in the position of the

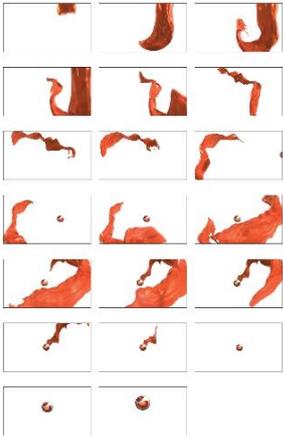
elements (for instance a sequence of stills). Motion marks do not include sound (see the definition of a multimedia mark below).

Pursuant to Article 3(3)(h) EUTMIR, motion marks must be represented by submitting one of the following.

- A video file showing the movement or change of position.
- A series of still sequential images showing the movement; the images may be numbered or accompanied by a description explaining the sequence.

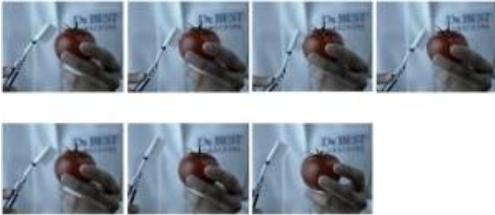
A motion mark **may only be refused** registration under Article 7(1)(a) EUTMR when a reasonably observant person with normal levels of perception and intelligence would, upon consulting the EUTM register, not be able to understand precisely what the mark consists of, without expending a huge amount of intellectual energy and imagination (23/09/2010, R 443/2010-2, RED LIQUID FLOWING IN SEQUENCE OF STILLS (MOVEMENT MARK), § 20).

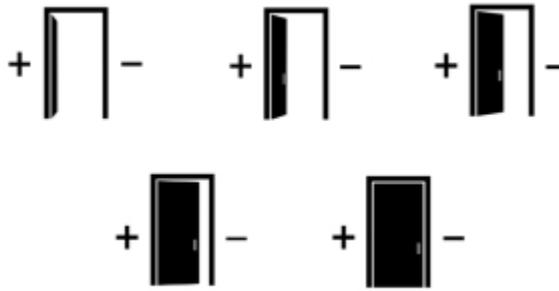
Examples of **acceptable** representations for motion marks:

Sign	Case No
 <p>Description: This is a motion mark in colour. The nature of the motion is that of a trailing ribbon with a liquid-like appearance (ribbon). The ribbon flows around and ultimately into a spherical shape (sphere). The motion takes approximately 6 seconds. The stills in the sequence are spaced approximately 0.3 seconds apart and are evenly spaced from the beginning to the end of sequence. The first still is at top left. The last still (20th) is the middle one in the bottom row. The stills follow a progression from left to right within each row, before moving down to the next row. The precise sequence of the stills is as follows: In the 1st still, the ribbon enters the frame in the upper edge of the frame and flows down the right edge of the frame, before flowing upward in the 2nd to 6th stills. During that phase of motion (in the 4th still) the end of the ribbon is shown, producing the effect of a trailing ribbon. In the 6th to 17th stills, the ribbon flows counterclockwise around the frame. From the 9th still onwards, the sphere appears in the centre of the frame. The interior of the sphere is the same colour as the ribbon. The ribbon flows around the sphere. In the 14th still, the ribbon enters the sphere, as if being pulled inside. In the 15th to 17th stills, the ribbon disappears inside the sphere. In the 19th and 20th stills, the sphere moves toward the viewer, gaining in size and ending the motion.</p>	<p>EUTM 8 581 977 RED LIQUID FLOWING IN SEQUENCE OF STILL (MOVEMENT MARK)</p> <p>R 443/2010-2</p>

Sign	Case No
 <p><u>Description:</u> The mark is an animated sequence with two flared segments that join in the upper right portion of the mark. During the animation sequence, a geometric object moves upwards adjacent to the first segment and then downwards adjacent to the second segment, while individual chords within each segment turn from dark to light. The stippling in the mark is for shading only. The entire animated sequence lasts between 1 and 2 seconds.</p>	<p>EUTM 5 338 629</p>

Examples of **unacceptable** representations for motion marks:

Sign	Case No
 <p><u>Description:</u> The mark comprises a moving image consisting of a toothbrush moving towards a tomato, pressing onto the tomato without breaking the skin, and moving away from the tomato.</p>	<p>EUTM 9 742 974</p>
<p>The Office rejected the application as it was not possible to establish the precise movement from the description provided along with the representation.</p>	

Sign	Case No
 <p data-bbox="223 649 1029 873">Description: The mark consists of an animated sequence on a plain background, namely a door that can be opened in the following three stages: open/mid-open/closed or closed/mid-open/open, using the symbols '+' and '-'. The length of the animation between the stages is half a second. The door and its frame are rectangular and are in the style of a basic geometric drawing with a small rectangular handle, opening onto a plain background. The symbols '+' and '-' are placed by each of the long edges of the frame.</p>	<p data-bbox="1101 537 1300 571">EUTM 16 023 095</p>
<p data-bbox="223 884 1364 1064">The Office rejected the application as it was not possible to establish the precise movement from the description provided along with the graphic representation. A sign that consists of the opening and closing of a door by pushing buttons on the left or right of the latter is subject to the consumer's personal interpretation. The sign therefore cannot fulfil the clarity and precision requirements under Article 4 EUTMR because each consumer would interpret it in a different way and would be subjected to a different sequence of the movement mark.</p>	

2.7 Multimedia marks

According to Article 3(3)(i) EUTMIR, a multimedia mark is a trade mark consisting of, or extending to, the combination of image and sound.

The article requires that multimedia marks 'be represented by submitting an audiovisual file containing the combination of the image and the sound'.

2.8 Hologram marks

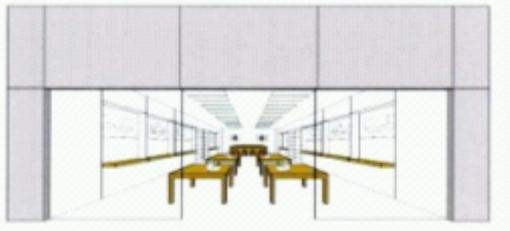
Article 3(3)(j) EUTMIR defines a hologram mark as a trade mark consisting of elements with holographic characteristics, and adds that it 'shall be represented by submitting a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety.'

2.9 Other marks

The following types of marks are not explicitly included in the non-exhaustive list of types of marks provided by Article 3(3) EUTMIR. They fall under the category of the mark type 'other'.

2.9.1 Layout of a retail store

In its judgment of 10/07/2014, C-421/13, Apple Store, EU:C:2014:2070, § 19, the Court of Justice found that a representation that depicts the layout of a retail store may constitute a trade mark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings. The layout was represented by means of a single design, combining lines, curves and shapes, without any indication of the size or proportions.

Sign	Case No
	<p>10/07/2014, C-421/13, Apple Store, EU:C:2014:2070</p>

Following the abovementioned judgment, it cannot be excluded that the requirements for the representation of the layout of a retail store could be satisfied by a design alone, combining lines, curves and shapes, without any specific indication of the size or proportions in the description. The Court indicated that in such a case, the trade mark could be registered, provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings and if no other grounds for refusal apply.

As a representation that depicts the layout of a retail store is not strictly covered by any of the types of marks listed in Article 3(3) EUTMIR, the representation must comply with the standards set out in Article 3(1) EUTMIR and may be accompanied by a description clearly specifying the subject matter for which protection is sought.

2.9.2 Smell/olfactory marks

It is currently not possible to represent smells in compliance with Article 4 EUTMR, as the subject matter of protection cannot be determined with clarity and precision **with generally available technology**.

Article 3(9) EUTMIR specifically excludes the filing of samples.

The following are examples of non-satisfactory means of representation of a smell.

- *Chemical formula*

Only specialists in chemistry would recognise the odour in question from such a formula.

- *Representation and description in words*

The representation requirements are not satisfied by:

- a graphic representation of the smell;

- a description of the smell in words;
- a combination of both (graphic representation and description in words).

Sign	Case No
 Mark description: Smell of ripe strawberries	EUTM No 1 122 118
<p>27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34 The Court considered that the smell of strawberries varies from one variety to another and the description 'smell of ripe strawberries' can refer to several varieties and therefore to several distinct smells. The description was found neither unequivocal nor precise and did not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed.</p>	

In its judgment of 12/12/2002, C-273/00, Sieckmann, EU:C:2002:748, § 69-73, the Court dismissed the possibility of representing an olfactory mark by a chemical formula, by a description in writing, by the deposit of an odour sample or by a combination of those elements.

There is no generally accepted international classification of smells that would make it possible — as with international colour codes or musical notation — to identify an olfactory sign objectively and precisely by attributing a name or precise code specific to each smell (27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34).

2.9.3 Taste marks

It is currently not possible to represent a taste in compliance with Article 4 EUTMR as Article 3(9) EUTMIR specifically excludes the filing of samples and the subject matter of protection cannot be determined with clarity and precision **with generally available technology**.

The arguments mentioned above under paragraph 2.9.2 similarly apply to taste marks (04/08/2003, R 120/2001-2, THE TASTE OF ARTIFICIAL STRAWBERRY FLAVOUR (GUSTATORY MARK)).

2.9.4 Tactile marks

It is currently not possible to represent the tactile effect of a certain material or texture in compliance with Article 4 EUTMR as Article 3(9) EUTMIR specifically excludes the filing of samples and the subject matter of protection cannot be determined with clarity and precision with generally available technology.

The arguments mentioned above under paragraph 2.9.2 similarly apply to tactile marks (27/05/2015, R 2588/2014-2, EMBOSSED PATTERN ON A SMOOTH BOTTLE SURFACE (TACTILE MARK)).

3 Relationship with Other EUTMR Provisions

Article 7(1)(a) EUTMR reflects the Office's obligation to refuse signs that do not conform to the requirements of Article 4 EUTMR. If the sign does not meet these requirements and the representation is not clear and precise, the application will not be examined on the basis of the other absolute grounds for refusal.

According to Article 7(3) EUTMR, the absolute grounds for refusal under Article 7(1)(a) EUTMR cannot be overcome through acquired distinctiveness in consequence of use of the mark.