GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

1 General Principles

1.1 Reasoned objection

When there is an absolute ground for refusal, a reasoned objection will be issued that specifies the individual grounds for refusal and provides clear and distinct reasoning **for each ground separately**. Piecemeal objections (so-called step-by-step objections) should be avoided.

Each of the grounds for refusal listed in Article 7(1) EUTMR is independent of the others and calls for separate examination.

Even when some grounds for refusal overlap, each ground of refusal must be given separate reasoning 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 makes it objectionable under both Article 7(1)(b) and (c) EUTMR, the notification of grounds of refusal should deal with each of these 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.

Any one of the grounds listed in Article 7(1) EUTMR is sufficient for refusal of an EU trade mark. However, the Office will list all the grounds for refusal that are applicable at each stage.

Occasionally, arguments brought 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.

1.2 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 arguments of the applicant.

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 trademark 'Theatre', a specification claiming '*books, except for books about* theatre' should not be accepted. In contrast, restrictions that are worded in a positive way are usually acceptable, such as 'books about Chemistry'.

- Proof of acquired distinctiveness

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

The point in time where the applicant must send its proof of use is after the objection letter and before the final decision is taken by the Office. In that regard, the applicant may file a request for an extension of time limits after the objection letter pursuant to Rule 71 EUTMIR.

If the mark is accepted on the basis of Article 7(3) EUTMR, then no refusal letter will be sent.

If the proof of use does not demonstrate acquired distinctiveness, the refusal will contain the reasoning as to why the mark falls foul of any of the grounds mentioned in Article 7(1) EUTMR and separate reasoning as to why the applicant's claim of acquired distinctiveness has failed.

1.3 Decision

After the dialogue with the applicant has taken place, the Office will take a decision to refuse the application 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.

If the applicant has submitted evidence of acquired distinctiveness by use and this is considered **sufficient** to overcome the objection, then the Office will issue a communication that rebuts any new argument raised by the applicant and maintains the objection(s), but accepts the trade mark based on the acquisition of distinctiveness by use. If the evidence is **not considered sufficient**, a decision will be issued. It will contain a separate reasoning on the claim of acquired distinctiveness.

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 in its entirety or partly, with an indication of the rejected goods and services) and will contain a notice of the availability of an appeal.

1.4 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').

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

As regards other languages, a refusal will be raised if the trade mark is objectionable under Article 7(1) EUTMR in a language understood by a significant section of the relevant public in at least a part of the European Union (see below under paragraph 2.3.1.2. The reference base, 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.

1.5 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.

1.5.1 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).

1.5.2 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 a present or future need or concrete interest of third parties to use 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).

1.5.3 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.

1.5.4 Double meaning

The frequent argument of 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 (which 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).

1.6 Scope of objections on the goods and services

Almost all absolute grounds for refusal, and in particular the most pertinent ones of lack of distinctiveness, descriptiveness, genericness and deceptiveness, have to be assessed with respect to the goods and 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 and/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
The Court confirmed the refusal in respect of goods and services in Classes 16, 35, and 41 to 43 by means of a 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
The 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 'insurances' as a whole and not only for health insurances (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 that are in conjunction with, or are applied in, offering aid to car drivers at a distance).

It is possible to claim goods and services as so-called **auxiliary goods or services** in the sense that they are meant to be used with, or support the use of, the main goods or

services. Typically, this covers paper and instruction manuals for the goods to which they belong or which are packed in them, advertisement or repair. 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.

1.7 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);
- upon receiving observations from third parties relating to the existence of an absolute ground for refusal.

These observations 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 (six months after republication) has not started (Rule 112(5) EUTMIR) and any interim status declaration previously sent would be revoked.

1.8 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 according to the applicable former practice.

- 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.

The following paragraphs address each individual subsection of Article 7(1) EUTMR in alphabetical order, beginning with Article 7(1)(a) EUTMR and ending with Article 7(1)(e) EUTMR. This is followed by a paragraph regarding Article 7(3) EUTMR (acquired distinctiveness).

The second part addresses the remaining individual subsections of Article 7(1) EUTMR from Article 7(1)(f) to (m) EUTMR and ends with a paragraph covering collective marks.

2 Absolute Grounds (Article 7 EUTMR)

2.1 Article 7(1)(a) EUTMR

2.1.1 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.[1]

According to Article 4 EUTMR, an EU trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods and their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

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 being represented graphically,
it must be capable of distinguishing the goods or services of one undertaking from those of others (judgment of 25/01/2007, C-321/03, Transparent bin, EU:C:2007:51, § 28).

a) Signs

According to Article 4 EUTMR, a trade mark may consist of any sign, subject to certain conditions. Although the particular examples listed in this provision are all signs that are two- or three-dimensional and are capable of being perceived visually, the list is not exhaustive.

However, in order not to deprive Article 4 EUTMR of any substance, this provision cannot be interpreted so broadly as to allow any non-specific subject matter to

[1] The modifications introduced by Regulation No 2015/2424 in Article 4 EUTMR will enter into force on 01/10/2017. They are therefore **not** reflected in this version of the Guidelines.

necessarily qualify as a sign. Thus, 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 (judgment of 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 (judgment of 25/01/2007, C-321/03, Transparent bin, EU:C:2007:51, § 35, and 37).

b) Graphic representation

A sign that is not capable of being represented graphically will be excluded from registration as an European Union trade mark under Article 7(1)(a) EUTMR.

The function of the requirement of graphic representation is to define the mark itself in order to determine the precise subject matter of the protection afforded by the registered mark to its proprietor.

It has been clearly established by case-law that a graphic representation in terms of Article 2 of the Trade Mark Directive, which corresponds to Article 4 EUTMR, must enable the sign to be represented visually, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective (judgments of 12/12/2002, C-273/00, Methylcinnamat, EU:C:2002:748, § 46-55, and 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 28-29).

The requirement of 'objectivity' means that the sign must be perceived unambiguously and consistently over time in order to function as a guarantee of indication of origin. The object of the representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. Consequently, the means of graphic representation must be unequivocal and objective.

Moreover, in cases where a sign is defined by both a graphic representation and a textual description, in order for the representation to be precise, intelligible, and objective, it must coincide with what can be seen in the graphic representation (decision of 23/09/2010, R 443/2010-2, RED LIQUID FLOWING IN SEQUENCE OF STILLS (al.)).

Sign	Case number
 Description: 'Six surfaces being geometrically arranged in three pairs of parallel surfaces, with each pair being arranged perpendicularly to the other two pairs characterised by: (i) any two adjacent surfaces having different colours and (ii) each such surface having a grid structure formed by black borders dividing the surface into nine equal segments'.	EUTM No 8 316 184 14/06/2012, T-293/10, Colour per se, EU:T:2012:302

Sign	Case number
The General Court considered that the mark's description was too difficult to understand. A sign so defined is not a colour mark per se but a three-dimensional mark, or figurative mark, that corresponds to the external appearance of a particular object with a specific form — a cube covered in squares with a particular arrangement of colours. Even if the description had been clear and easily intelligible — which it was not — it would still have contained an inherent contradiction insofar as the true nature of the sign is concerned (paras 64 and 66).	

c) Distinguishing character

Article 4 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. A conceivable example for the lack of abstract capacity in the context of any goods or services could be, e.g. the word 'Trademark'.

2.1.2 Examples of trade mark applications refused or accepted under Article 7(1)(a) EUTMR

For formalities issues regarding some of the types of marks mentioned below, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 9.

2.1.2.1 Smell/olfactory marks

The requirements of graphic representation of an olfactory mark are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements (judgment of 12/12/2002, C-273/00, Methylcinnamat, EU:C:2002:748, § 69-73).

There is currently no means of graphically representing smells in a satisfactory way. 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 through the attribution of a name or a precise code specific to each smell (judgment of 27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34).

The following are examples of possible ways of graphically representing a smell but none is satisfactory:

- *Chemical formula*
  Few people would recognise the odour in question from such a formula.

- *Odour sample*
  A deposit of an odour sample would not constitute a graphic representation for the purposes of Article 4 EUTMR, as an odour sample is not sufficiently stable or durable.

- *Graphic representation and description in word*
  The requirements of graphical representation 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
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. Likewise, the image of a strawberry represents only the fruit that emits a smell supposedly identical to the olfactory sign at issue, and not the smell claimed, and therefore does not amount to a graphic representation of the olfactory sign.	

2.1.2.2 Taste marks

The arguments mentioned above under paragraph 2.1. are applicable in a similar way for taste marks (decision of 04/08/2003, R 120/2001-2, The taste of artificial strawberry flavour (gust.)).

2.1.2.3 Sound marks

According to the judgment of 27/11/2003, C-283/01, Musical notation, EU:C:2003:641, § 55, a sound must be represented graphically 'particularly by means of images, lines or characters' and its representation must be 'clear, precise, self-contained, easily accessible, intelligible, durable and objective'.

The following **are <u>not</u> valid means** to graphically represent a sound:

- *Description* of a sound *in words*

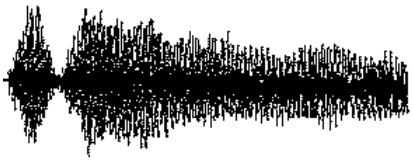
A description such as certain notes of a musical play, e.g. 'the first 9 bars of *Für Elise*', or a description of the sound in words, e.g. 'the sound of a cockcrow', is not sufficiently precise or clear and therefore does not make it possible to determine the scope of the protection sought (judgment of 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 (judgment of 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 the 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 (judgment of 27/11/2003, C-283/01, Musical notation, EU:C:2003:641, § 61).

Example of an unacceptable sound mark	
EUTM No 143 891 R 0781/1999-4 ('ROARING LION') The (alleged) sonograph was considered incomplete, as it did not contain a representation of scale of the time axis and the frequency axis (para. 28).	

The following **are valid means** of representing a sound graphically:

- *Musical notations* (stave)

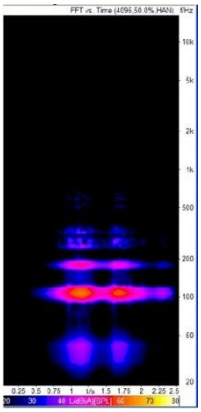
  A stave divided into bars and showing, in particular, a clef (a treble, bass, alto or tenor clef), musical notes and rests whose form (for the notes: semibreve, minim, crotchet, quaver, semiquaver, etc.; for the rests: semibreve rest, minim rest, crotchet rest, quaver rest, etc.) indicates the relative value and, where appropriate, accidentals (sharp, flat, natural) – all of this notation determining the pitch and duration of the sounds – constitutes a faithful representation of the sequence of sounds forming the melody in respect of which registration is sought (judgment of 27/11/2003, C-283/01, Musical notation, EU:C:2003:641, § 62).

- *MP3 files with another suitable graphic representation*

The applicant may file one sound file as an attachment to the electronic application form (Decision No EX-05-3 of the President of the Office of 10 October 2005 concerning electronic filing of sound marks, Article 2(2)). However such sound files must be filed together with a suitable graphic representation.

One graphic representation that may be filed along with an electronic file is a sonogram, i.e. a graphical representation of a sound, showing the distribution of energy at different frequencies, especially as a function of time, as long as the diagram itself indicates the scaling, orientation (rotation) and translation of the axes (time and frequency).

Examples of graphical representations which are **acceptable**:

Sign	Reasoning	Case No
	Stave divided into bars and showing, in particular, a clef, musical notes and rests	EUTM No 1 637 859
	Sonogram indicating time (x-axis), frequency (y-axis) and intensity (in colour), along with an electronic file	EUTM No 11 923 554

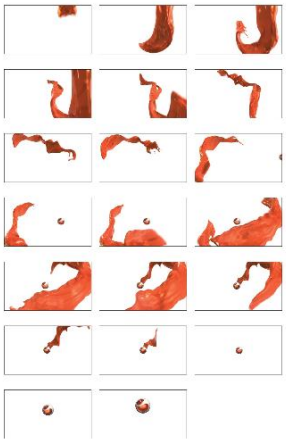
2.1.2.4 Movement marks

A movement 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 (decision of 23/09/2010, R 443/2010-2, RED LIQUID FLOWING IN SEQUENCE OF STILLS (al.), para. 20).

Therefore, in most cases, in order for the representation of a movement mark to be clear, precise, intelligible, and objective, the graphic representation must be accompanied by a **description**. The description must clearly **explain the movement** for which protection is sought and must be coherent with what can be seen in the representation of the sign.

The **number of stills** will depend on the movement concerned. No limit has been imposed.

Examples of graphical representations that are **acceptable for movement marks**:

Sign	Case No
	EUTM No 8 581 977 RED LIQUID FLOWING IN SEQUENCE OF STILLS (MOVEMENT MARK) R 443/2010 2
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.	

Sign	Case No
 Description: 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 one and two seconds.	EUTM No 5 338 629

Examples of graphical representations that are **not acceptable for movement marks**:

Sign	Case
 Description: 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.	EUTM No 9 742 974
The Office rejected the application as it was not possible to establish the precise movement from the description provided along with the graphic representation	

2.1.2.5 Colour marks

The formless and shapeless combination of two or more colours 'in any manifestation' does not satisfy the requirements under the 'Sieckmann' and 'Libertel' cases regarding the clarity and constancy of a graphical representation, which is a condition for the ability to act as a trade mark (see also decision of 27/07/2004, R 730/2001-4, YELLOW/BLUE/RED(col.)).

The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', does not exhibit the qualities of precision and uniformity required by Article 4 EUTMR (judgment of 24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 34).

Moreover, such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.

A graphic representation consisting of two or more colours, designated in the abstract, without contours and arranged by associating the colours concerned in a predetermined and uniform way will satisfy the requirement of graphical representation (judgment of 14/06/2012, T-293/10, Colour per se, EU:T:2012:302, § 50).

Example of a sign that is **acceptable**:

Sign	Case number
 **Colours indicated**: Green, Pantone 368 C, anthracite, Pantone 425 C, orange, Pantone 021 C **Description**: The trade mark consists of the colours green: Pantone 368 C; anthracite: Pantone 425 C; orange: Pantone 021 C, as shown in the illustration; the colours are applied to a basic component of the exterior of vehicle service stations (petrol stations) in the ratio green 60 %, anthracite 30 % and orange 10 %, creating the impression of a green and anthracite-coloured petrol station (green predominating) with small orange accents.	EUTM No 8 298 499

2.1.2.6 Position mark

In order to satisfy the requirements of graphical representation and be clear, precise, intelligible, and objective, the mark's representation must be filed with a description. This must indicate that the application is indeed for a position mark and detail its positioning.

The application could be objectionable for some of the goods if the positioning on those goods is unclear.

Examples of graphical representations of a trade mark filed as a position mark:

Sign	Case Number
	EUTM No 8 316 184
Initial description: 'a copper ring between two metal layers, which is visible at the upper rim of the body of a cooking utensil like a pot or a pan'.	
Final Description: *The trade mark is a positional trade mark whereby a narrow copper ring is positioned visibly between two metal layers on the upper rim of the body of a pot or pan*.	

The Office raised an objection on the basis of Article 7(1)(a) EUTMR. The applicant had chosen to apply for an 'other' type of mark. The interpretation of the mark description in combination with the representation of the mark did not allow the Office to understand the scope of the right claimed, i.e. it was not clear what 'a copper ring' was or what 'like a pot or pan' meant. The applicant was requested to file a more precise and detailed mark description. The description was modified by the applicant during the examination proceedings (see above) and the objection under Article 7(1)(a) EUTMR was waived as a consequence of the new description.

2.1.2.7 3D representation of a space

Following the judgment of 10/07/2014, C-421/13, Apple, EU:C:2014:2070, it cannot be excluded that the requirements of graphic representation of the layout of a retail store are satisfied by a design alone, combining lines, curves and shapes, without any indication of the size or the proportions. 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.

Sign	Case number
	10/07/2014, C-421/13, Apple, EU:C:2014:2070

2.1.3 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, there is no acceptable graphical representation and the application will be examined in the light 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 the use of the mark.

2.2 Distinctiveness (Article 7(1)(b) EUTMR)

2.2.1 General remarks

According to settled case-law, distinctiveness of a trade mark within the meaning of Article 7(1)(b) EUTMR means that the sign serves to identify the product and/or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (judgments of 29/04/2001, joined cases C-468/01 P to C-472/01 P, Tabs, EU:C:2004:259, § 32; 21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 42; and 08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 66; and 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 33).

According to settled case-law, such distinctiveness can be assessed only by reference first to the goods or services in respect of which registration is sought and, second, to the relevant public's perception of that sign (judgments of 29/04/2001, joined cases C-468/01 P - C-472/01 P, Tabs, EU:C:2004:259, § 33; of 08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 67; and of 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 34) (judgments of 14/062012, T-293/10, Colour per se, EU:T:2012:302; and of 12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 23).

According to the case-law of the European courts, a word mark that is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) EUTMR is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services for the purposes of Article 7(1)(b) EUTMR (judgment of 12/06/2007, T-190/05, TWIST & POUR, EU:T:2007:171, § 39).

In a similar vein, even though a given term might not be clearly descriptive with regard to the goods and services concerned, as to the point that an objection under Article 7(1)(c) EUTMR would not apply, it would still be objectionable under Article 7(1)(b) EUTMR on the ground that it will be perceived by the relevant public as only providing information on the nature of the goods and/or services concerned and not as indicating their origin. This was the case with the term 'medi', which was considered as merely providing information to the relevant public about the medical or therapeutic purpose of the goods or of their general reference to the medical field (judgment of 12/07/2012, T-470/09, Medi, EU:T:2012:369, § 22).

An objection under Article 7(1)(b) EUTMR would also apply in those cases where the lexical structure employed, although not correct from a grammatical point of view, can be considered to be common in advertising language and in the commercial context at issue. This was the case of the combination 'ECO PRO', where the laudatory element PRO is placed after the descriptive element ECO and which would be perceived by the relevant public as an indication that the designated goods are intended for 'ecological professionals' or are 'ecological supporting' (judgment of 25/04/2013, T-145/12, ECO PRO, EU:T:2013:220, § 29-32).

2.2.2 Word elements

Words are non-distinctive or cannot convey distinctiveness to a composite sign if they are so frequently used that they have lost any capacity to distinguish goods and services. The following terms, alone or in combination with other unregistrable elements, fall foul of this provision.

Terms merely denoting a particular **positive or appealing quality or function** of the goods and services should be refused if applied for either alone or in combination with descriptive terms:

- **ECO** as denoting 'ecological' (judgments of 24/04/2012, T-328/11, EcoPerfect, EU:T:2012:197, § 25 and of 15/01/2013, T-625/11, ecoDoor, EU:T:2013:14, § 21);

- **MEDI** as referring to 'medical' (judgment of 12/07/2012, T-470/09, medi, EU:T:2012:369);

- **MULTI** as referring to 'much, many, more than one' (decisions of 21/07/1999, R 0099/1999-1, MULTI 2 'n 1; 17/11/2005, R 0904/2004-2, MULTI);

- **MINI** as denoting ‘very small’ or ‘tiny’ (decision of 17/12/1999, R 0062/1999-2, MINIRISC);

- **Premium/PREMIUM** as referring to ‘best quality’ (judgments of 22/05/2012, T-60/11, Patrizia Rocha, EU:T:2013:162, § 46-49, 56 and 58; and of 17/01/2013, joined cases T-582/11 and T-583/11, PREMIUM XL/ PREMIUM L, EU:T:2013:24, § 26);

- **PLUS**, as denoting ‘additional, extra, of superior quality, excellent of its kind’. (decision of 15/12/1999, R 0329/1999-1, PLATINUM PLUS);

- **ULTRA**[2] as denoting ‘extremely’ (decision of 09/12/2002, R 333/2002-1, ULTRAFLEX);

- **UNIVERSAL** as referring to goods that fit for general or universal use (judgment of 02/05/2012, T-435/11, UniversalPHOLED, EU:T:2012:210, § 22 and 28).

Top level domain endings, such as ‘**.com’**, only indicate the place where information can be reached on the internet and thus cannot render a descriptive or otherwise objectionable mark registrable. Therefore, www.books.com is as objectionable for printed matter as the term ‘books’ alone. This has been confirmed by the General Court in its judgment of 21/11/2012, T-338/11, photos.com, EU:T:2012:614, § 22, where it was stated that the element ‘.com’ is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site. Furthermore, it may also indicate that the goods and services covered by the trade mark application can be obtained or viewed online, or are internet-related. Accordingly, the element in question must also be considered to be devoid of distinctive character in respect of the goods or services concerned.

Abbreviations of the **legal form of a company** such as Ltd., GmbH, etc. cannot add to the distinctiveness of a sign.

Names of individual persons are distinctive, irrespective of the frequency of the name and even in the case of the most common surnames (such as Jones or García, judgment of 16/09/2004, C-404/02, Nichols, EU:C:2004:538, § 26 and 30) or in the case of prominent persons (including heads of states). However, an objection will be raised if the name can **also** be perceived as a non-distinctive term in relation to the goods and services (e.g. ‘Baker’ for pastry products).

2.2.3 Titles of books

Trade marks consisting solely of a famous story or book title may be non-distinctive under Article 7(1)(b) EUTMR in relation to goods and services that could have that story as their subject matter. The reason for this is that certain stories (or their titles) have become so long established and well known that they have ‘entered into the language’ and are incapable of being ascribed any meaning other than that of a particular story.

[2] Amended on 23/06/2010.

For example, ‘Peter Pan’ or ‘Cinderella’ or ‘The Iliad’ are perfectly capable of being distinctive trade marks for paint, clothing or pencils, for instance. However, they are incapable of performing a distinctive role in relation to books or films, for example, because consumers will simply think that these goods refer to the story of Peter Pan or Cinderella, this being the only meaning of the terms concerned.

Objections should only be raised in such cases where the title in question is famous enough to be truly well known to the relevant consumer and where the mark can be perceived in the context of the goods/services as primarily signifying a famous story or book title. A finding of non-distinctiveness in this regard will be more likely where it can be shown that a large number of published versions of the story have appeared and/or where there have been numerous television, theatre and film adaptations reaching a wide audience.

Depending on the nature of the mark in question, an objection may be taken in relation to printed matter, films, recordings, plays and shows (this is not an exhaustive list).

2.2.4 Colours

This paragraph is concerned with single colours or combinations of colours as such (‘colour per se’).

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

2.2.4.1 Single colours

As regards the registration as trade marks of colours per se, the fact that the number of colours actually available is limited means that a small number of trade mark registrations for certain services or goods could exhaust the entire range of colours available. Such an extensive monopoly would be incompatible with a system of undistorted competition, in particular because it could have the effect of creating an unjustified competitive advantage for a single trader. Nor would it be conducive to economic development or the fostering of the spirit of enterprise for established traders to be able to register the entire range of colours that is in fact available for their own benefit, to the detriment of new traders (judgment of 06/05/2003, C-104/01, Libertel, EU:C:2003:244).

As has been confirmed by the Court of Justice, consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not used as a means of identification in current commercial practice (judgment of 06/05/2003, C-104/01, Libertel, EU:C:2003:244). A colour is not normally inherently capable of distinguishing the goods of a particular undertaking (para. 65). Therefore, single colours are not distinctive for any goods and services except under very special circumstances.

Such very special circumstances require the applicant to demonstrate that the mark is absolutely unusual or striking in relation to these specific goods. These cases will be extremely rare, for example in the case of the colour black for milk. It is not necessary for a refusal that one of the factors listed in paragraph 2.2.4.2 below is present, but if this is the case, it should be used as a further argument in support of the refusal. Where the single colour is found to be commonly used in the relevant sector(s) and/or to serve a decorative or functional purpose, the colour must be refused. The public interest is, according to the Court, an obstacle to the monopolisation of a single colour irrespective of whether the relevant field of interest belongs to a very specific market segment (judgment of 13/09/2010, T-97/08, Orange II, EU:T:2010:396, § 44-47).

2.2.4.2 Colour combinations

Where a combination of colours per se is applied for, the graphic representation filed must spatially delineate these colours so as to determine the scope of the right applied for. The graphic representation should clearly indicate the proportion and position of the various colours, thus systematically arranging them by associating the colours in a predetermined and uniform way (judgments of 24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33 and of 14/06/2012, judgment of 06/05/2003, C-104/01, Libertel, EU:C:2003:244).

For example, a mark comprising a small yellow stripe on top of red is different from red and yellow presented in even proportions, with red on the left side. An abstract claim, in particular to two colours ‘in any possible combination’ or ‘in any proportion’, is not allowable and leads to an objection under Article 7(1)(a) EUTMR (decision of 27/07/2004, R 0730/2001-4, ‘GELB/BLAU/ROT’, § 34). This must be distinguished from the indication of how the colour combination would appear on the product, which is not required because what matters in connection with the assessment of inherent distinctiveness is the subject matter of the registration, not the way it is or can be used on the product.

In the case of colour combination, a refusal can only be based on specific facts or arguments, and where such specific arguments to refuse are not established, the mark must be accepted. If one of the two colours is either the commonplace colour for the product or the natural colour of the product, that is to say, a colour is added to the usual or natural colour of the product, an objection applies in the same way as if there were only one colour. Example: grey is the usual colour for the grip of gardening tools, and white is the natural colour of washing tablets. Therefore, a washing tablet which is white with another layer in red is in fact to be judged as a case that involves the addition of a colour.

The situations in which a combination of two colours should nevertheless be refused include the following.

- In many instances, a colour would merely be a decorative element of the goods or comply with the consumer’s request (e.g. colours of cars or T-shirts), irrespective of the number of colours concerned.

- A colour can be the nature of the goods (e.g. for tints).

- A colour can be technically functional (e.g. colour red for fire extinguishers, various colours used for electric cables).

- A colour may also be usual or generic (e.g. again, red for fire extinguishers, yellow for postal services).

- A colour may indicate a particular characteristic of the goods such as a taste (yellow for lemon taste, pink for strawberry taste).

- A colour combination should also be refused if the existence of the colour combination can already be found on the market, in particular if used by several different competitors (e.g. we were able to demonstrate that the colour combination red and yellow is used by various enterprises on beer or soft drink cans).

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

The criteria to assess the distinctiveness of colour marks designating services should not be different from those applicable to colour marks designating goods (as recalled by the General Court in its judgment of 12/11/2010, T-404/09, Grau/Rot, EU:T:2010:466). In this case, the colour combination applied for was considered not to differ for the relevant consumer in a perceptible manner from the colours usually used for the services concerned. The General Court concluded that the colour combination applied for was very close to the combination 'white/red' used on the railway crossing gates and traffic signs associated with train traffic and that the sign, as a whole, would be recognised by the relevant public as a functional or decorative element and not as an indication of the commercial origin of the services.

The higher the number is, the less distinctiveness is likely, because of the difficulty of memorising a high number of different colours and their sequence.

For the names of colours see paragraph 2.3.2.9 below.

2.2.5 Single letters[3]

2.2.5.1 General considerations

In its judgment of 09/09/2010, C-265/09 P (α), EU:C:2010:508, the Court of Justice ruled that, in the case of trade marks consisting of single letters represented in standard characters with no graphic modifications, it is necessary to assess whether the sign at issue is capable of distinguishing the different goods and services in the context of an examination, based on the facts, focusing on the goods or services concerned (para. 39).

The Court recalled that, according to Article 4 EUTMR, letters are among the categories of signs of which an EU trade mark may consist, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings (para. 28), and emphasised that registration of a sign as a trade mark does not require a specific level of linguistic or artistic creativity or imaginativeness on the part of the applicant.

[3] This part deals with single letters under Article 7(1)(b) EUTMR. For single letters under Article 7(1)(c) EUTMR, see paragraph 2.3.2.8 below.

Although acknowledging that it is legitimate to take into account the difficulties in establishing distinctiveness that may be associated with certain categories of trade marks because of their very nature, and that it may prove more difficult to establish distinctiveness for marks consisting of a single letter than for other word marks (para. 39), the Court clearly stated that these circumstances do not justify laying down specific criteria supplementing or derogating from application of the criterion of distinctiveness as interpreted in the case-law (paras 33-39).

As to the burden of proof, the Court stated that when examining absolute grounds for refusal, the Office is required under Article 76(1) EUTMR to examine, of its own motion, the relevant facts that might lead it to raise an objection under Article 7(1) EUTMR and that that requirement cannot be made relative or reversed to the detriment of the EUTM applicant (paras 55-58). Therefore, it is for the Office to explain, with motivated reasoning, why a trade mark consisting of a single letter represented in standard characters is devoid of any distinctive character.

It is therefore necessary to carry out a thorough examination based on the specific factual circumstances of the case in order to assess if a given single letter represented in standard characters can function as a trade mark in respect of the goods/services concerned. This need for a factual assessment implies that it is not possible to rely on assumptions (such as that consumers are generally not accustomed to seeing single letters as trade marks).

Consequently, when examining single letter trade marks, generic, unsubstantiated arguments such as those relating to the availability of signs should be avoided, given the limited number of letters. The Office is obliged to establish, on the basis of a factual assessment, why the applied for trade mark would be objectionable.

It is therefore clear that the examination of single letter trade marks should be thorough and stringent, and that each case calls for careful examination of whether a given letter can be considered inherently distinctive for the goods and/or services concerned.

2.2.5.2 Examples

For instance, in technical domains such as those involving computers, machines, motors and tools, it is more likely that single letters will be perceived as technical, model or catalogue references rather than as indicators of origin, although the fact that this is the case should result from a factual assessment.

Depending on the outcome of the prior examination, a trade mark consisting of a single letter represented in standard characters might be objectionable under Article 7(1)(b) EUTMR on the ground that it is devoid of inherent distinctiveness for the goods and/or services concerned or part thereof.

This would be the case, for example, for a trade mark consisting of the single letter ‘C’ for ‘fruit juices’, as this letter is commonly used to designate vitamin C. The relevant public would not perceive it as a sign distinguishing the commercial origin of the goods in question.

Other examples of lack of distinctiveness would be single-letter trade marks applied for in respect of toy cubes, which are often used to teach children how to construct words by combining letters appearing on the cubes themselves, without however describing

the product as such, or single letters applied for in respect of lottery services, a sector in which letters are often used to indicate different series of numbers.

Although in both the above cases there is no direct descriptive relationship between the letters and the goods/services, a trade mark consisting of a single letter would lack distinctiveness, because when it comes to toy cubes and lotteries, consumers are more used to seeing single letters as having either a functional or a utilitarian connotation, rather than as indicators of commercial origin.

However, if it cannot be established that a given single letter is devoid of any distinctive character for the goods and/or services concerned, then it should be accepted, even if represented in standard characters or in a fairly basic manner.

For example, the letter  was accepted in respect of 'transport; packaging and storage of goods; travel arrangement' in Class 39 and 'services for providing food and drink; temporary accommodation' in Class 43 (decision of 30/09/2010, R 1008/2010-2, § 12-21).

For further examples see paragraph 2.3.2.8 below.

2.2.6 Slogans: assessing distinctive character

The Court of Justice has ruled that it is inappropriate to apply to slogans stricter criteria than those applicable to other types of signs when assessing their distinctive character (judgment of 12/07/12, C-311/11 P, WIR MACHEN DAS BESONDERE EINFACH, EU:C:2012:460 and case-law cited).
Advertising slogans are objectionable under Article 7(1)(b) EUTMR when the relevant public perceives them as a mere promotional formula. However, they are deemed to be distinctive if, apart from their promotional function, the public perceives them as an indication of the commercial origin of the goods or services in question.

The Court of Justice has provided the **following criteria** that should be used when assessing the distinctive character of a slogan (judgments of 21/01/2010, C-398/08 P, VORSPRUNG DURCH TECHNIK, EU:C:2010:29, § 47, and of 13/04/2011, T-523/09, WIR MACHEN DAS BESONDERE EINFACH, EU:T:2011:175, § 37).

An advertising slogan is likely to be distinctive whenever it is seen as more than a mere advertising message extolling the qualities of the goods or services in question because it:

- has a number of meanings and/or
- constitutes a play on words and/or
- introduces elements of conceptual intrigue or surprise, so that it may be perceived as imaginative, surprising or unexpected, and/or
- has some particular originality or resonance and/or
- triggers in the minds of the relevant public a cognitive process or requires an interpretative effort.

In addition to the above, the following characteristics of a slogan may contribute towards a finding of distinctiveness:

- unusual syntactic structures
- the use of linguistic and stylistic devices such as alliteration, metaphors, rhyme, paradox, etc.

However, the use of unorthodox grammatical forms must be carefully assessed because advertising slogans are often written in a simplified form, in such a way as to make them more concise and snappier (inter alia, judgment of 24/01/2008, T-88/06, SAFETY 1ST, EU:T:2008:15, § 40). This means that a lack of grammatical elements such as definite articles or pronouns (THE, IT, etc.), conjunctions (OR, AND, etc.) or prepositions (OF, FOR, etc.) may not always be sufficient to make the slogan distinctive. In 'SAFETY 1ST', the Court considered that the use of '1ST' instead of 'FIRST' was not sufficiently unorthodox to add distinctiveness to the mark.

A slogan whose meaning is vague or impenetrable or whose interpretation requires considerable mental effort on the part of the relevant consumers is also likely to be distinctive since consumers would not be able to establish a clear and direct link with the goods and services claimed.

The fact that the **relevant public is a specialist one** and its degree of attention is higher than average cannot decisively influence the legal criteria used to assess the distinctive character of a sign. As stated by the Court of Justice, 'it does not necessarily follow that a weaker distinctive character of a sign is sufficient where the relevant public is specialist' (judgment of 12/07/12, C-311/11 P, WIR MACHEN DAS BESONDERE EINFACH, EU:C:2012:460, § 48).

Moreover, according to well-established case-law from the General Court, the level of attention of the relevant public may be **relatively low** when it comes to promotional indications, whether what is involved are average end consumers or a more attentive public made up of specialists or circumspect consumers. This finding is applicable even for goods and/or services where the level of attention of the relevant public is generally high, such as financial and monetary services (judgments of 29/01/2015, T-609/13 SO WHAT DO I DO WITH MY MONEY, EU:T:2015:54, § 27 and T-59/14 INVESTING FOR A NEW WORLD, EU:T:2015:56, § 27 and quoted case-law).

The following examples show some of the different functions that slogans may serve and the arguments that can support an **objection** under Article 7(1)(b) EUTMR.

EUTM	Main function	Case No
EUTM No 5 904 438 MORE THAN JUST A CARD for Class 36 (*bank, credit and debit card services*)	Customer service statement	R 1608/2007-4
Objected to under Article 7(1)(b) EUTMR The slogan merely conveys information about the goods and services applied for. It is the kind of language an English speaker would use to describe a bank card that is a little out of the ordinary. It conveys the notion that the card has welcome features that are not obvious at first sight. The fact that the slogan leaves open what these features are, that is to say that the mark does not describe a specific service or characteristic of the 'card', does not make the mark distinctive.		

EUTM	Main function	Case No
EUTM No 7 394 414 WE PUT YOU FIRST. AND KEEP YOU AHEAD for Class 40	Customer service statement	(Examiner's decision without BOA case)
Objected to under Article 7(1)(b) EUTMR The mark is a promotional laudatory message, highlighting the positive aspects of the services, namely that they help to procure the best position in the business and maintain this position in the future.		
EUTM	**Main function**	**Case No**
EUTM No 6 173 249 SAVE OUR EARTH NOW for Classes 3, 17, 18, 20, 22, 24, 25 and 28	Value statement or political motto	R 1198/2008-4
Objected to under Article 7(1)(b) EUTMR The sign is a simple and straightforward appeal to take action and contribute to the earth's well-being by favouring the purchase of environment-friendly products. Contrary to the appellant's contentions that the word 'now' constitutes an original element since nobody will believe that by purchasing the goods in question they will literally save the Earth now, the word 'NOW' is an emotional word commonly used in marketing to urge consumers to consume, to get what they want without waiting; it is a call to action. The relevant consumer will immediately recognise and perceive the sign as a promotional laudatory expression indicating that the goods represent an environment-friendly alternative to other goods of the same sort, and not as an indication of commercial origin.		
EUTM	**Main function**	**Case No**
EUTM No 4 885 323 DRINK WATER, NOT SUGAR for Classes 32 and 33	Inspirational or motivational statement	R 718/2007-2
Objected to under Article 7(1)(b) EUTMR The mark is a banal slogan that merely conveys the idea that the consumer will be drinking real water rather than a sugary drink. The mark lacks any secondary or covert meaning, has no fanciful elements, and its message to the consumer is plain, direct and unambiguous. For these reasons, it is unlikely to be perceived as a sign of trade origin. It is easily seen that the mark consists merely of good counsel, namely that it is better from a health point of view to drink water that has not been sugared. What better way to promote such goods than by an expression such as DRINK WATER, NOT SUGAR? Consumers will read this with approval, but will look elsewhere on the product for the trade mark.		
EUTM	**Main function**	**Case No**
DREAM IT, DO IT! Classes 35, 36, 41 and 45	Inspirational or motivational statement	T-186/07
The relevant English-speaking public will see this as an invitation or encouragement to achieve their dreams and will understand the message that the services covered by that trade mark will allow them to do so.		
EUTM	**Main function**	**Case No**
VALORES DE FUTURO for Class 41	Value statement	Judgment of 06/12/2013, T-428/12
Objected to under Article 7(1)(b) EUTMR The relevant public when confronted with the expression VALORES DE FUTURO will perceive a laudatory message whose only objective is to give a positive view of the services involved.		

EUTM	Main function	Case No
INVESTING FOR A NEW WORLD Classes 35 and 36	Value statement	Judgment of 29/01/2015, T-59/14
Objected to under Article 7(1)(b) EUTMR The sign INVESTING FOR A NEW WORLD, considered as a whole, may be easily understood by the relevant public, in view of the common English words of which it consists, as meaning that the services offered are intended for a new world's needs. Given that the services covered by the mark applied for are all related to activities connected with finance and have a close link with the word 'investing', the Board of Appeal was right to find that the message conveyed by the expression 'investing for a new world' was that, when purchasing the services in question, the money or capital invested created an opportunity in a new world, which carried a positive connotation. The Court also found that the fact that the expression at issue could be interpreted in a number of ways did not alter its laudatory nature.		
EUTM	**Main function**	**Case No**
SO WHAT DO I DO WITH MY MONEY Classes 35 and 36	Value statement	Judgment of 29/01/2015, T-609/13
Objected to under Article 7(1)(b) EUTMR The expression 'so what do I do with my money' prompts consumers to ask themselves what they should do with their financial resources and assets. In the present case, the average reasonably well-informed and reasonably observant and circumspect consumer of the services covered by the application for registration will, on reading or hearing that expression, ask himself/herself whether he/she is using his/her money effectively.		
EUTM	**Main function**	**Case No**
PIONEERING FOR YOU Classes 7, 9, 11, 37 and 42	Value statement	Judgment of 12/12/2014, T-601/13
Objected to under Article 7(1)(b) EUTMR The sign would be understood as 'innovative for you'. The meaning of the sign is clear and does not leave any doubts. The structure of the sign is grammatically correct and does not trigger any mental process in order to arrive at its meaning. It is, as a whole, a simple message that could be attributed to any producer or service provider with the natural consequence that it does not indicate the origin of the goods or services		

Some examples of **accepted** slogans:

EUTM	Classes	Case No
SITEINSIGHTS	Classes 9 and 42	R 879/2011-2, EUTM No 9 284 597
EUTM	**Classes**	**Case No**
THE PHYSICIAN DRIVEN IMAGING SOLUTION	Classes 9, 16 and 42	IR No 01 096 100
EUTM	**Classes**	**Case No**
WET DUST CAN'T FLY	Classes 3, 7 and 37	T-133/13
The concept of 'wet dust' is literally inaccurate, since dust is no longer dust when it is wet. Consequently, the juxtaposition of those two words gives that concept a fanciful and distinctive character.		

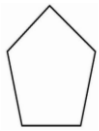
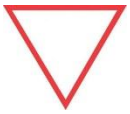
A slogan is objectionable under Article 7(1)(c) EUTMR if it immediately conveys information about the kind, quality, intended purpose or other characteristics of the goods or services (see paragraph 2.3.2.5 below).

2.2.7 Simple figurative elements

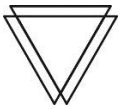
Simple geometric devices such as circles, lines, rectangles or common pentagons are unable to convey any message that can be remembered by consumers and will accordingly not be seen by them as a trade mark.

As set out by the Court, an extremely simple sign, composed of a basic geometric figure such as a circle, a line, a rectangle or a pentagon is not capable, as such, of conveying a message that consumers can remember, with the result that they will not consider it as a trade mark (T-304/05, § 22).

Examples of refused trade marks

Sign	G&S	Reasoning	Case
	Class 33	The sign consists merely of a normal pentagon, a simple geometric figure. The geometric form, if it happened to be the form of the label, would be perceived as having a functional or aesthetic purpose rather than an origin function.	Judgment of 12/09/2007, T-304/05, Pentagon, EU:T:2007:271
	Classes 9, 14,16, 18, 21, 24, 25, 28, 35-39, 41-45	The sign will be perceived as an excessively simple geometric shape, essentially as a parallelogram. To fulfil the identification function of a trade mark, a parallelogram should contain elements which singularise it in relation to other parallelograms' representations. The two characteristics of the sign are the fact that it is slightly inclined towards the right and that the base is slightly rounded and stretched out towards the left. Such nuances would not be perceived by the general consumer.	Judgment of 13/04/2011, T-159/10, Parallelogram, EU:T:2011:176
	Classes 14, 18, 25	The sign does not contain any elements that may be easily and instantly memorised by an attentive relevant public. It will be perceived only as a decorative element, regardless of whether it relates to goods in Class 14 or to those in Classes 18 and 25.	Judgment of 29/09/2009, T-139/08, Smiley, EU:T:2009:364
	Class 9	The sign consists of a basic equilateral triangle. The inverted configuration and red outline of the triangle do not serve to endow the sign with distinctive character. The sign's overall impact remains that of a simple geometric shape that is not capable of transmitting a trade mark message prima facie.	International registration No 01 091 415
	Classes 3, 18, 24, 43, 44	The sign consists of merely a simple geometric figure in green. The specific colour is commonly and widely used in advertising and in the marketing of goods and services for the power to attract without giving any precise message.	Judgment of 09/12/2010, T-282/09, Carré convexe vert, EU:T:2010:508

Example of an accepted trade mark

Sign	G&S	Reasoning	Case
	Classes 35, 41	The sign consists of a design featuring overlapping triangular elements. The overall impression created is far more complex than that of a simple geometric shape.	EUTM No 10 948 222

2.2.8 Commonplace figurative elements

The following representation of a vine leaf is not distinctive for wine:

Similarly, the following representation of a cow for milk products is not distinctive:

EUTM No 11 345 998, claiming Classes 29 (milk and milk products, etc.) and 35.

The above sign was refused, as representations of cows are commonly used in relation to milk and milk products. The fact that the subject mark consists of an 'aerial' picture of a cow is not sufficient to confer distinctive character to the sign, as slight alterations to a commonplace sign will not make that sign distinctive. The same reasoning would be applicable also to related goods such as 'milk chocolate'.

2.2.9 Typographical symbols

Typographical symbols such as a dot, comma, semicolon, quotation mark or exclamation mark will not be considered by the public as an indication of origin. Consumers will perceive them as a sign meant to catch the consumer's attention but not as a sign that indicates commercial origin. A similar reasoning applies to common currency symbols, such as the €, £, $ signs; depending on the goods concerned, these signs will only inform consumers that a specific product or service is traded in that currency.

The following marks were objected to.

Sign	G&S	Reasoning	Case
	Classes 14, 18 and 25	The GC confirmed the finding of the BoA that the trade mark applied for is devoid of the necessary degree of distinctive character. It consists merely of a punctuation mark with no special additional features immediately apparent to customers, and is a commonplace sign that is frequently used in business or in advertising. In view of its frequent use, the relevant consumer will see the exclamation mark as being merely laudatory advertising or something to catch the eye (see judgment of 30/09/2009, T-75/08, !, EU:T:2009:374).	EUTM No 5 332 184
	Classes 29, 30, 31 and 32	The sign applied for was refused because, in the case of the claimed goods (foodstuff and beverages), percentages are particularly important in relation to the price. For example, the percentage sign indicates clearly that there is a favourable cost/benefit ratio because the price has been reduced by a particular percentage in comparison with the normal price. Such a per cent sign in a red circle is also frequently used in connection with clearance sales, special offers, stock clearances or cheap no-name products, etc. The consumer will regard the sign merely as a pictogram conveying the information that the goods claimed are sold at a reduced price (see decision of 16/10/2008, R 998/2008-1, 'Prozentzeichen').	EUTM No 5 649 256

2.2.10 Pictograms

Pictograms are basic and unornamented signs and symbols that will be interpreted as having purely informational or instructional value in relation to the goods or services concerned. Examples would be signs that indicate mode of use (like a picture of a telephone in relation to pizza delivery services) or that convey a universally understandable message (like a knife and fork in relation to the provision of food).

Commonly used pictograms, for example a white 'P' on a blue background to designate a parking place (this sign could also be objectionable under Article 7(1)(d)) or the design of an ice cream to designate that ice cream is sold in the vicinity, are not distinctive in relation to the goods or services in respect of which they are used.

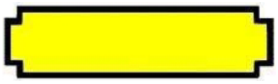
Sign	Reasoning	Case
	Taking into account the kind of goods and services applied for in Classes 9, 35, 36, 38 and 42 (for example cash dispensers, banking services), the public will see the sign as a practical indication or as directional arrows showing where the magnetic card has to be inserted into the distributor. The association of the triangles to the other elements of the trade mark applied for means that the public concerned will perceive them as directional arrows. Consumers see this type of practical information every day in all kinds of places, such as banks, supermarkets, stations, airports, car parks, telephone boxes, etc. (paras 37-42).	Judgment of 02/07/2009, T-414/07, Main tenant une carte, EU:T:2009:242
 EUTM No 9 894 528 for goods in Class 9	The above sign was refused as it is identical to the core of the international safety symbol known as 'high voltage symbol' or 'caution, risk of electric shock'. It has been officially defined as such by ISO 3864 as the standard high voltage symbol, whereby the device applied for is contained within the triangle that denotes that it is a hazard symbol. Because this sign essentially coincides with the customary international sign to indicate a risk of high voltage, it was refused under Article 7(1)(b) EUTMR.	Decision of 21/09/2012, R 2124/2011-5, 'Device of lightning bolt'

2.2.11 Common/non-distinctive labels

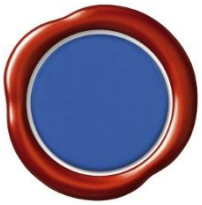
A figurative sign may be composed of shapes, designs or figures that will be perceived by the relevant public as non-distinctive labels. Moreover, in this case the reason for the refusal lies in the fact that such figurative elements are not capable of impressing themselves in the consumer's mind, since they are too simple and/or commonly used in connection with the goods/services claimed.

See the following examples

Sign	Reasoning	Case
 EUTM No 4 373 403, filed as a three-dimensional mark claiming goods in Class 16 (Adhesive labels; adhesive labels for use with hand labelling appliances; and labels (not of textile))	The mark applied for is 'devoid of any distinctive character' and was refused under Article 7(1)(b) EUTMR as it is as banal and ordinary as it is possible to get in relation to adhesive labels. The sign says a lot about the nature of the goods and very little, if anything, about the identity of the producer (para. 11).	Decision of 22/05/2006, R 1146/2005-2

Sign	Reasoning	Case
 EUTM No 9 715 319 for goods in Classes 6, 7, 8, 9 and 20	The mark was refused, as its basic shape combined only with a bright colour yellow could not, in the minds of the relevant professional and general public, serve to distinguish the goods applied for as originating from a particular undertaking. Here, the colour yellow may be perceived as a decoration for the goods, as well as for the purpose of attracting attention to the goods without giving any specific information or precise message as to the commercial origin of the goods. In addition, as is generally known, the bright colour yellow is commonly used in a functional way in relation to a wide range of goods, i.e., inter alia, for increasing the visibility of objects, highlighting or warning. For these reasons, the relevant consumers will not recognise this colour as a trade mark, but will perceive it in its alerting function or its decorative function.	Decision of 15/01/2013, R 0444/2012-2, Device of a label in yellow colour

In the same way, the following marks were rejected.



EUTM No 11 177 912 claiming Classes 29, 30 and 31

EUTM No 11 171 279 claiming Classes 29, 30 and 31

EUTM No 10 776 599 claiming, inter alia, goods in Classes 32 and 33

In the three preceding cases, both the colour and the shape of the labels are quite commonplace. The same reasoning applies to the stylised representation of the fruits in the last of the three cases. Furthermore, the said figurative element represents or at least strongly alludes to the ingredients of some of the claimed goods, such as, for example, fruit juices.

2.2.12 Three-dimensional trade marks

2.2.12.1 Preliminary remarks

Article 7(1)(b) EUTMR does not distinguish between different categories of trade marks in determining whether a trade mark is capable of distinguishing the goods or services of one undertaking from those of other undertakings (see judgment of 05/03/2003, T-194/01, Soap device, EU:T:2003:53, § 44). In applying this uniform legal standard to different trade marks and categories of trade marks, a distinction must be made in accordance with consumer perception and market conditions.

For signs consisting of the shape of the goods themselves, no stricter criteria shall apply than for other marks, but it may be more difficult to come to a finding of distinctiveness, as such marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark (see judgment of 08/04/2002, C-136/02 P, Torches, EU:C:2004:592, § 30).

Three-dimensional trade marks can be grouped into three categories:

- shapes unrelated to the goods and services themselves
- shapes that consist of the shape of the goods themselves or part of the goods
- the shape of packaging or containers.

2.2.12.2 Shapes unrelated to the goods or services themselves

Shapes that are unrelated to the goods or services themselves (e.g. the Michelin Man) are usually distinctive.

2.2.12.3 Shape of the goods themselves or shapes related to the goods or services.

The case-law developed for three-dimensional marks that consist of the representation of the shape of the product itself is also relevant for figurative marks consisting of two-dimensional representations of the product or elements of it (see judgment of 14/09/2009, T-152/07, Uhr, EU:T:2009:324).

For a shape that is the shape or the packaging of the goods applied for, the examination should be conducted in the three following steps.

Step 1: Article 7(1)(e) EUTMR analysis

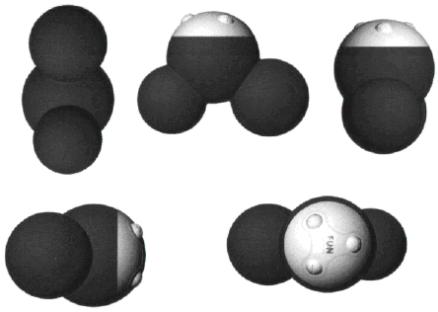
In principle, the examiner should first examine whether one of the grounds for refusal under Article 7(1)(e) EUTMR applies, as those cannot be overcome through acquired distinctiveness. With regard to this first step, see paragraph 2.5 below.

Step 2: Identifying the elements of the three-dimensional trade mark

In the second step, the examiner should determine whether the representation of the three-dimensional trade mark contains **other elements** such as words or labels that might give the trade mark a distinctive character. As a general principle, any element that on its own is distinctive will lend the 3D trade mark distinctive character as long as it is perceivable in the normal use of the product. Typical examples are words or figurative elements or a combination of these that appear on the exterior of the shape and remain clearly visible, such as labels on bottles. Consequently, even the standard shape of a product can be registered as a 3D trade mark if a distinctive word mark or label appears on it.

Sign	Case
	R 1354/2007-1
The clearly legible words 'BEN BRACKEN' on the base of the bottle suffice on their own to impart distinctive character to the trade mark as a whole (para. 19).	

However, non-distinctive elements or descriptive elements combined with a standard shape will not endow distinctiveness upon that shape (judgment of 18/01/2013, T-137/12, Vibrator, EU:T:2013:26, § 34-36).

Sign	Case
	T-323/11
An image depicting certain stones is embossed on the central part of the bottle. The Court confirmed the BoA decision when it considered that the applicant had failed to prove that European consumers have sufficient information and knowledge to recognise that the embossing on the central part of the bottle at issue depicts the twelve-angle stones used in Inca constructions. Without that proof, European consumers will merely perceive the embossing as such without being aware of its significance, from which it follows that they will simply perceive it as a mere decoration without any distinctive character, because it is not particularly original or striking and, therefore, it will not serve to differentiate the bottle in question from the other bottles widely used in the packaging of beers (para. 25 and following).	
Sign	**Case**
	T-137/12

Sign	Case
The Court considered that the descriptive element 'fun' could not confer distinctiveness on the 3D sign. Moreover, BoA was right not to take into account the element 'factory' written above the word 'fun' as it was illegible in the application (para. 34 and following).	
Sign	**Case**
	R 1511/2013-2 (T-390/14 appeal pending)
BoA confirmed that the figurative element 'KANGOO JUMPS' (in both the upper spring layer and the lower spring layer) and the letters 'KJ' and 'XR' (at the ends of the intermediate elastic plastic straps) could only be seen with great difficulty or were not visible at all. Therefore, parts that can only be noticed by detailed analysis, like the present ones, will, in general, not be perceived as an indication of origin (para. 29).	

Step 3: Criteria for distinctiveness of the shape itself

Lastly, the criteria for **distinctiveness of the shape itself** must be checked. The basic test is whether the shape is so materially different from basic, common or expected shapes that it enables a consumer to identify the goods just by their shape and to buy the same item again if he has had positive experiences with the goods. Frozen vegetables in the form of a crocodile are a good example for this.

The following criteria are relevant when examining the distinctiveness of three-dimensional trade marks consisting exclusively of the shape of the goods themselves:

- A shape is non-distinctive if it is a basic shape (judgment of 19/09/2001, T-30/00, TABS-SQUARE/RED/WHITE, EU:T:2001:223) or a combination of basic shapes (see BoA decision of 13/04/2000, R 0263/1999-3).

- To be distinctive, the shape must depart significantly from the shape which is expected by the consumer, and it must depart significantly from the norm or customs of the sector. The more closely the shape resembles the shape that is most likely to be taken by the product in question, the greater the likelihood that it is not distinctive (judgment of 08/04/2002, C-136/02 P, Torches, EU:C:2004:592, § 31).

- It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs (judgments of 08/04/2002, C-136/02 P, Torches, EU:C:2004:592, § 32 and 07/02/2002, T-88/00, Torches, EU:T:2002:28, § 37).

- Functional shapes or features of a three-dimensional mark will be perceived by the consumer as such. For example, for washing tablets, bevelled edges avoid damage to the laundry, and layers of different colours represent the presence of different active ingredients.

While the public is accustomed to recognising a three-dimensional mark as an indicator of source, this is not necessarily the case where the three-dimensional sign is indistinguishable from the product itself. Consequently, an assessment of distinctive character cannot result in different outcomes for a three-dimensional mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product (judgment of 19/09/2001, T-30/00, TABS-SQUARE/RED/WHITE, EU:T:2001:223, § 49).

Specific case: 3D toys, dolls and play figures

Applications for 3D marks in respect of toys, dolls and play figures in Class 28, or for figurative marks consisting of a faithful representation of such goods, must be assessed in the **same way as other 3D marks**.

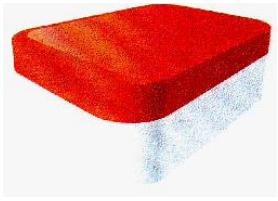
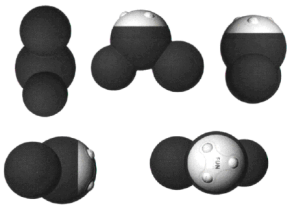
To be distinctive, the shape must depart significantly from the shape that is expected by the consumer. In other words, it must depart significantly from the norm or customs of the sector so that it enables a consumer to identify the goods just by their shape.

This may be complicated by the sheer volume and proliferation of toy animals, figures, dolls and assorted characters in this market sector. Simply adding a **basic** set of **clothing or basic human characteristics** such as eyes or a mouth to a common plush toy such as a rabbit or a cat will generally not suffice. It is commonplace to present toy dolls and animals in clothing and to provide separately a range of clothing options, so that the user of such goods can change the appearance of the toy. It is also common to humanise the toys to make them more attractive. Within such a high-volume marketplace, the presentation of these goods in such a way will invariably leave the relevant consumer struggling, without prior exposure, to perceive a badge of origin in such marks.

The more basic the character, the more unusual the additional elements must be in order to create a whole that serves to ensure that the relevant public is able to distinguish the applicant's goods from similar goods provided by other undertakings. The final conclusion must be based on the **appearance of the sign as a whole**.

Examples:

The following is a list of examples of shapes of goods applied for and an analysis of them.

Sign	Reasoning	Case
	Figurative marks showing a graphic representation of a naturalistic reproduction of the goods themselves are not distinctive in relation to such goods. The representation of a tablet for 'washing or dishwashing preparations in tablet form' was refused. The shape, namely a rectangular tablet, is a basic shape and an obvious one for a product intended for use in washing machines or dishwashers. The slightly rounded corners of the tablet are not likely to be perceived by the consumer as a distinctive feature of the shape at issue (judgment of 19/09/2001, T-30/00, TABS-SQUARE/RED/WHITE, EU:T:2001:223, § 44 and 53). The same approach has been confirmed by several judgments, including the judgment of 04/10/2007, C-144/06 P, Tabs, EU:C:2001:577.	Judgment of 19/09/2001, T-30/00, TABS - SQUARE/RED/WHITE EU:T:2001:223
	This shape was refused as it is merely a variant of a common shape of this type of product, i.e. flashlights (para. 31).	Judgment of 08/04/2002, C-136/02 P, Torches, EU:C:2004:592
	This shape was refused because it does not depart significantly from the norm or customs of the sector. Even though the goods in this sector typically consist of long shapes, various other shapes exist in the market that are spherical or round (para. 29). The addition of the small descriptive word element 'fun factory' does not remove the overall shape from the scope of non-distinctiveness (para. 36).	Judgment of 18/01/2013, T-137/12, Vibrator, EU:T:2013:26.

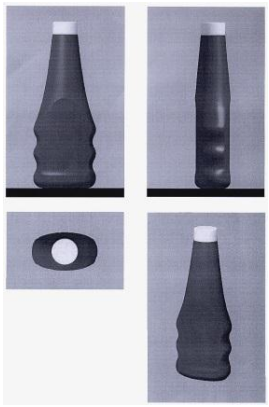
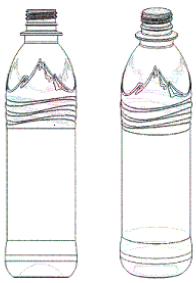
Sign	Reasoning	Case
  	The Court of Justice confirmed the refusal of this three-dimensional sign as being not sufficiently different from the shapes and colours of those commonly used in the sweets and chocolate sectors. The combination with figurative elements will not lead to the application of the criteria for two-dimensional marks.	Judgment of 06/09/2012, C-96/11 P, Milchmäuse, EU:C:2012:537
	This three-dimensional mark consisting of a handle, applied to goods in Class 8 (hand-operated implements used in agriculture, horticulture and forestry, including secateurs, pruning shears, hedge clippers, shearers (hand instruments), was refused.	Judgment of 16/09/2009, T-391/07, Teil des Handgriffes, EU:T:2009:336
	The Court confirmed the case-law on non-distinctiveness of three-dimensional trade marks in the form of a product or its packaging. Even if the oval shape in the EUTM application has a complex hollow on its surface, this cannot be considered as a significant difference to the shapes of confectionery available on the market.	Judgment of 12/12/2013, T-156/12 Oval, EU:T:2013:642
	The parrot figure applied for, on its own, does not depart from the usual form of parrot toys sufficiently to be seen as a trade mark. Its coat colour resembles the green colour quite common among parrots. Its head is bigger than normal and it is standing on its hind legs, but in the Board's opinion, the majority of consumers would perceive the parrot shape as an ordinary parrot-shaped toy design, a rather banal toy, but not as an indication of origin (para. 16).	R 2131/2013-5
	Accepted	EUTM No 10 512 218

Analogous criteria, *mutatis mutandis*, apply to shapes related to services, for example the device of a washing machine for laundry services.

2.2.12.4 Shape of the packaging

The same criteria apply for the shape of bottles or containers for the goods. The shape applied for must be materially different from a combination of basic or common elements and must be striking. Also in the area of containers, regard must be had to

any functional character of a given element. As in the field of containers and bottles, the usage in trade might be different for different types of goods, it is recommended to make a search as to which shapes are on the market, by choosing a sufficiently broad category of the goods concerned (i.e. in order to assess the distinctiveness of a milk container, the search must be carried out in relation to containers for beverages in general; see, in that regard, the opinion of the Advocate General of 14/07/2005 in C-173/04, Standbeutel, EU:C:2006:20).

Sign	Reasoning	Case
	The shape applied for was refused as it was considered that bunny-shaped chocolate with gold wrapping is a common phenomenon on the market corresponding to the concerned industry. An analysis of the individual elements, that is, the shape of a rabbit, the gold foil wrapping and the red ribbon with a bell, were held both individually and cumulatively devoid of distinctive character (paras 44-47).	Judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307
	The mark, the representation of a twisted wrapper serving as packaging for sweets (and thus not the product itself) was refused registration as it is a 'normal and traditional shape for a sweet wrapper and … a large number of sweets so wrapped could be found on the market' (para. 56). The same applies in respect of the colour of the wrapper in question, namely 'light brown (caramel)'. This colour is not unusual in itself, and neither is it rare to see it used for sweet wrappers (para. 56). Therefore, the average consumer will not perceive this packaging in and of itself as an indicator of origin, but merely as a sweet wrapper.	Judgment of 10/11/2004, T-402/02, Bonbonverpackung, EU:T:2004:330
	The refusal of the shape applied for was confirmed by the General Court. The elongated neck and the flattened body do not depart from the usual shape of a bottle containing the claimed goods, namely food products including *juices, condiments and dairy products*. In addition, neither the length of the neck, its diameter nor the proportion between the width and thickness of the bottle is in any way individual (para. 50). Furthermore, even if the ridges around the sides of the bottle could be considered distinctive, these alone are insufficient to influence the overall impression given by the shape applied for to such an extent that it departs significantly from the norm or customs of the sector (para. 53).	Judgment of 15/03/2006, T-129/04, Plastikflaschenform, EU:T:2006:84
	It is a well-known fact that bottles usually contain lines and creases on them. The relief at the top is not sufficiently striking but will be perceived as a mere decorative element. As a whole, a combination of the elements is not sufficiently distinctive. The average consumer of the goods in Class 32 would not consider the shape as an indicator of origin of goods in Class 32.	Judgment of 19/04/2013, T- 347/10, Getränkeflasche, EU:T:2013:201 'Shape of a drinking bottle'

2.2.13 Pattern marks

A figurative trade mark can be considered as a 'pattern' mark when it consists of a set of elements that are repeated regularly.

Pattern marks may cover any kind of goods and services. However, in practice they are more commonly filed in relation with goods such as paper, fabrics, clothing articles, leather goods, jewellery, wallpaper, furniture, tiles, tyres, building products, etc., that is to say, goods that normally feature designs. In these cases, the pattern is nothing else than the outward appearance of the goods. In this regard it must be noted that, although patterns may be represented in the form of square/rectangular labels, they should nonetheless be assessed as if they covered the entire surface of the goods applied for.

It must also be taken into account that when a pattern mark claims goods such as beverages or fluid substances in general, that is to say goods that are normally distributed and sold in containers, the assessment of the design should be made as if it covered the outward surface of the container/packaging itself.

It follows from the above that, as a rule, in the assessment of the distinctive character of patterns the examiner should use the same criteria that are applicable to three-dimensional marks that consist of the appearance of the product itself (see judgment of 19/09/2012, T-329/10, Stoffmuster, EU:T:2012:436).

With regard to services, examiners should bear in mind that pattern marks will be used in practice on letterheads and correspondence, invoices, internet web sites, advertisements, shop signs, etc.

In principle, if a pattern is commonplace, traditional and/or typical, it is devoid of distinctive character. In addition, patterns that consist of basic/simple designs usually lack distinctiveness. The reason for the refusal lies in the fact that such patterns do not convey any 'message' that could make the sign easily memorable for consumers. Paradoxically, the same applies to patterns composed of extraordinarily complex designs. In these cases the complexity of the overall design will not allow the design's individual details to be committed to memory (judgment of 09/10/2002, T-36/01, Glass pattern, EU:T:2002:245, § 28). Indeed, in many cases the targeted public would perceive patterns as merely decorative elements.

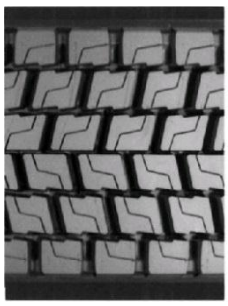
In this regard, it must be taken into account that usually the average consumer tends not to look at things analytically. A trade mark must therefore enable average consumers of the goods/services in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention (judgments of 12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 53, and of 12/01/2006, C-173/04, Standbeutel, EU:C:2006:20, § 29).

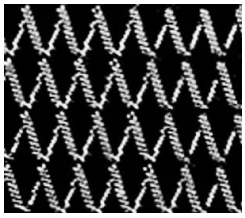
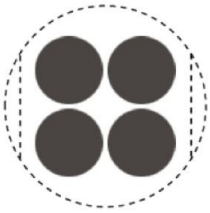
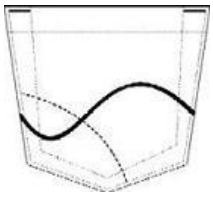
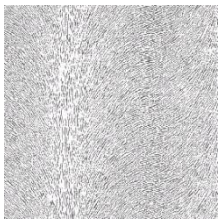
The fact that the pattern may also have other functions and/or effects is an additional argument to conclude that it lacks distinctive character. By contrast, if a pattern is fanciful, unusual and/or arbitrary, departs from the norm or customs of the sector or is, more generally, capable of being easily memorised by the targeted consumers, it usually deserves protection as an EUTM.

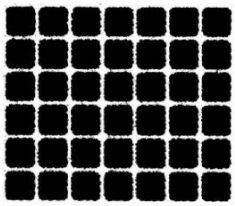
As seen above, the distinctive character of pattern marks must usually be assessed with regard to goods. Nevertheless, a pattern mark that has been considered devoid of

distinctive character for the goods it covers must also be regarded as lacking distinctiveness for services that are closely connected to those goods. For example, a stitching pattern that is devoid of distinctive character for clothing articles and leather goods must be regarded as lacking distinctiveness also for retail services concerning those goods (see by analogy decision of 29/07/2010, R 868/2009-4, Device of a pocket). The same considerations would apply to a fabric pattern with regard to services such as *manufacture of fabrics*.

The following is a non-exhaustive list of examples of pattern marks.

Sign	Reasoning	Case
 EUTM No 8 423 841, filed as a figurative mark in Classes 18, 24 and 25	The criteria for three-dimensional marks consisting of the appearance of the product itself are also applicable to figurative marks consisting of the appearance of the product itself. In general, a mark consisting of a decorative pattern that is simple and commonplace is considered devoid of any element that could attract the consumers' attention, and insufficient to indicate the source or origin of goods or services. The above pattern mark was a textile pattern and therefore considered to comprise the appearance of the products itself, as the mark was applied for in Classes 18, 24 and 25.	Judgment of 19/09/2012, T-326/10, Stoffmuster, EU:T:2012:436, § 47 and 48
 EUTM No 8 423 501, filed as a figurative mark in Classes 18, 24 and 25	In this case, similarly to the previous case, the General Court confirmed the refusal of the mark.	Judgment of 19/09/2012, T-329/10, Stoffmuster, EU:T:2012:436
 EUTM No 5 066 535 filed as a figurative mark in Class 12 (tyres)	Where the mark consists of a stylised representation of the goods or services, the relevant consumer will see prima facie the mere representation of a specific part of or the entire product. In this case of an application for *tyres*, the relevant consumer would perceive the mark as merely a representation of the grooves of a tyre, and not an indication of source or origin. The pattern is banal and the mark cannot fulfil its function as indicator of origin.	Examiner's decision without BOA case

Sign	Reasoning	Case
 EUTM No 9 526 261, filed as a figurative mark (Series of stylised V letters), claiming goods in Classes 16, 18, 25	The mark was rejected for Classes 18 and 25. It was accepted for Class 16. Though the sign was described as a 'series of stylised V letters', the sign would most probably be perceived by the relevant public either as a series of zigzag stitching or as a set of rhomboidal geometric figures. In any case, the pattern is quite simple and banal and thus devoid of any distinctive character.	Examiner's decision without BOA case
 EUTM No 9 589 219, filed as a figurative mark for goods in Class 9	The sign, applied for in respect of 'multi-well plates that can be used in chemical or biological analysis using electrochemiluminescence for scientific, laboratory or medical research use', was refused as it does not serve the purpose of indicating origin. The application described the mark as corresponding to a pattern contained on the bottom of the goods, and the examiner was found to be correct in stating that due to the lack of any eye-catching features, the consumer would be unable to perceive it as anything other than a mere decoration of the goods.	Decision of 09/10/2012, R 412/2012-2, Device of four identically sized circles
 EUTM No 6 900 898, for goods in Classes 18 and 25	The above mark was refused, as patterns stitched on pockets are commonplace in the fashion sector, and this particular pattern does not contain any memorable or eye-catching features likely to confer a minimum degree of distinctive character such as to enable a consumer to perceive it as anything other than a mere decorative element.	Judgment of 28/09/2010, T-388/09, DESIGN OF TWO CURVES CROSSED AT ONE POINT INSERTED ON A POCKET (FIG. MARK) EU:T:2010:410, § 19-27
 EUTM No 3 183 068, filed as a figurative mark, for goods in Classes 19 and 21	The mark, which was to be applied to glass surfaces, was refused under Article 7(1)(b) EUTMR. It was reasoned that the relevant consumer is not used to perceiving designs applied to glass surfaces as an indication of origin and that the design is recognisable as a functional component to make the glass opaque. Furthermore, the complexity and fancifulness of the pattern are insufficient to establish distinctiveness, attributable to the ornamental and decorative nature of the design's finish, and do not allow the design's individual details to be committed to memory or to be apprehended without the product's inherent qualities being perceived simultaneously.	Judgment of 09/10/2002, T-36/01, Glass pattern, EU:T:2002:245, § 26-28

Sign	Reasoning	Case
 EUTM No 10 144 848, filed as a figurative mark for goods in Classes 3, 5, 6, 10, 11, 12, 16, 18, 20 and 21	The mark was refused as it is composed of very simple elements and is a basic and banal sign as a whole. For the claimed goods, such as *cleaning cloths* and *antiseptic wipes*, the sign applied for can represent their appearance in the sense that the fabric used may have this structure. The sign is merely a repetition of identical squares that does not display any element or noticeable variation, in particular in terms of fancifulness or as regards the way in which its components are combined, that would distinguish it from the usual representation of another regular pattern consisting of a different number of squares. Neither the shape of each individual square nor the way they are combined are immediately noticeable features that could catch the average consumer's attention and cause the consumer to perceive the sign as a distinctive one.	Decision of 14/11/2012, R 2600/2011-1, Device of a black and white pattern
 EUTM No 370 445 Class 18	The chequerboard pattern is a basic and commonplace figurative pattern, since it is composed of a regular succession of squares of the same size that are differentiated by alternating different colours, in this case brown and beige. The pattern thus does not contain any notable variation from the conventional representation of chequerboards and is the same as the traditional form of such a pattern. Even applied to goods such as those falling within Class 18, the pattern in question does not differ from the norm or customs of the sector inasmuch as such goods are generally covered with fabrics of different kinds, and the chequerboard pattern, due to its great simplicity, might constitute precisely one of those patterns (para. 37).	T-359/12, Device of a chequered pattern (maroon & beige), EU:T:2015:215 and T-360/12, Coty Germany, EU:C:2014:1318

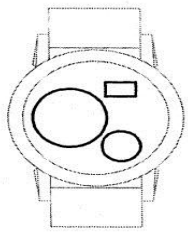
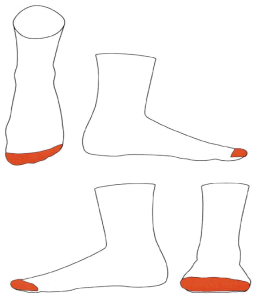
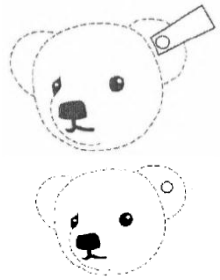
2.2.14 Position marks

Applications for position marks effectively seek to protect a sign that consists of elements (figurative, colour, etc.) positioned on a particular part of a product and in a particular proportion to the size of the product. The representation of the mark applied for must be accompanied by a description indicating the exact nature of the right concerned.

The factors to be taken into account when examining three-dimensional marks are also relevant for position marks. In particular, the examiner must consider whether the relevant consumer will be able to identify a sign that is different from the normal appearance of the products themselves. A further relevant consideration in dealing with position marks is whether the positioning of the mark upon the goods is likely to be understood as having a trade mark context.

Note that even where it is accepted that the relevant public may be attentive to the different aesthetic details of a product, this does not automatically imply that they will perceive it as a trade mark. In certain contexts, and given the norms and customs of particular trades, a position mark may appeal to the eye as an independent feature being distinguishable from the product itself and thus communicating a trade mark message.

The following are examples of the assessment of position marks.

Sign	Reasoning	Case
	In this case, the General Court upheld an objection under Article 7(1)(b) EUTMR. The mark description specified that 'The mark consists of the position of the circular and rectangular fields on a watch face'. The Court considered that the mark was not independent or distinguishable from the form or design of the product itself and that the positioned elements were considered not substantially different from other designs on the market.	Judgment of 14/09/2009, T-152/07, Uhr, EU:T:2009:324
	In this case involving hosiery consisting of an orange strip covering the toe area, the General Court considered that there was no evidence to suggest that the colouring of this part of the product would normally be perceived as having trade mark character. On the contrary it was considered that this feature would be likely to be perceived as a decorative feature falling within the norms and customs of the market sector. The Article 7(1)b EUTMR objection was therefore maintained.	Judgment of 15/06/2010, T-547/08, Strumpf, EU:T:2010:235
	Buttons are common decorative elements of soft toys. A button is a simple geometrical form which does not depart from the norm or customs of the sector. It is not uncommon to attach badges, rings, ribbons, loops and embroideries to the ears of a soft toy. The relevant public will therefore perceive the two signs applied for as ornamental elements but not as an indication of commercial origin.	Judgments of 16/01/2014 T-433/12, Knopff im Stofftierohr, EU:T:2014:8 and T-434/12, Fähnchen im Stofftierohr, EU:T:2014:6

2.2.15 Sound marks

The acceptability of a sound mark must, like words or other types of trade marks, depend upon whether the sound is distinctive per se, that is, whether the average consumer will perceive the sound as a memorable one that serves to indicate that the goods or services are exclusively associated with one undertaking.

Consumers are not in the habit of making assumptions about the origin of goods in the absence of any graphic or word element, because generally a sound per se is not commonly used in any field of commercial practice as a means of identification.

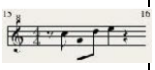
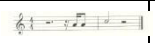
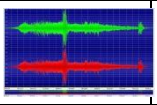
The perception of the relevant public is not necessarily the same in the case of a sign consisting of a sound per se as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods it denotes. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign is merely a sound (by analogy, judgment of 04/10/2007, C-144/06 P, Tabs, § 36). By the same token, **only a sound that departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin** is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (by analogy, judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 42).

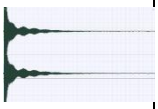
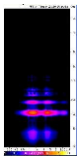
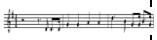
The kinds of sound marks that are **unlikely** to be accepted without evidence of factual distinctiveness include:

a) very simple pieces of music consisting of only one or two notes (see examples below);
b) sounds that are in the common domain (e.g. La Marseillaise, Für Elise);
c) sounds that are too long to be considered as an indication of origin;
d) sounds typically linked to specific goods and services (see examples below).

Where the sign applied for consists of a non-distinctive sound but includes **other distinctive elements**, such as words or lyrics, it will be considered as a whole.

Examples

Sign	Description	G&S	Result	Reasoning	Case
	sequence of four different tones initially falling by a fourth and then rising and ending on the mediant	16, 35, 42	Distinctive	jingle-like sound sequences, are capable of identifying goods and services.	R 2056/2013-4
	The first two shorter A notes sound less powerful than the following long and higher C note. The higher and longer C note is thus accentuated on account of its pitch, length and strength.	9, 16, 35, 36, 41, 42	Distinctive	According to general life experience, jingle-like sound sequences, enable distinction between goods and services.	R 0087/2014-5
	Piece of music, three seconds long, combining different tones	9, 14, 16, 21, 25, 28, 35, 38, 41, 43	Distinctive		EUTM 11 074 705
	Computer-generated sound of ten seconds	9, 28, 41	Distinctive		EUTM 11 654 209
	Computer-generated sound of nearly 30 seconds including the sounds of animals followed by the sound of a motor	9, 12	Distinctive		EUTM 10 654 374
	Two musical notes, F and C	35, 36, 38, 39, 41, 42	Not distinctive	A two note 'tune' has no impact on the consumer and will only be perceived by the consumer as a very banal sound, such as the 'ding-dong' of a doorbell.	EUTM 4 010 336

Sign	Description	G&S	Result	Reasoning	Case
	Two extremely short blips	9, 38	Not distinctive	Machine generated blip that is commonly emitted by computers and other electronic devices	EUTM 9 199 167
	'Ping' sound, resembling a warning signal	9, 16, 28	Not distinctive	Sound constitutes a warning signal and a direct characteristic of the goods applied for	R 2444/2013-1
	Machine-generated synthesised sound	9, 12, 35	Not distinctive	Sound typically linked to the goods and services applied for	R 1338/2014-4
	The first 13 notes of 'La Marseillaise'	Any	Not distinctive	A national anthem is in the public domain	Invented example

2.3 Descriptiveness (Article 7(1)(c) EUTMR)

2.3.1 General remarks

2.3.1.1 The notion of descriptiveness

A sign must be refused as descriptive if it has a meaning which is immediately perceived by the relevant public as providing information about the goods and services applied for. This is the case where the sign provides information about, among other things, the quantity, quality, characteristics, purpose, kind and/or size of the goods or services. The relationship between the term and the goods and services must be sufficiently direct and specific (judgments of 20/07/2004, T-311/02, Limo, EU:T:2004:245, § 30; 30/11/2004, T-173/03, Nurseryroom, EU:T:2004:347, § 20), as well as concrete, direct and understood without further reflection (judgment of 26/10/2000, T-345/99, Trustedlink, EU:T:2000:246, § 35). If a mark is descriptive, it is also non-distinctive.

Article 7(1)(c) EUTMR does not apply to those terms that are only suggestive or allusive as regards certain characteristics of the goods and/or services. Sometimes this is also referred to as vague or indirect references to the goods and/or services (judgment 31/01/2001, T-135/99, Cine Action, EU:T:2001:30, § 29).

The public interest underlying Article 7(1)(c) EUTMR is that exclusive rights should not exist for purely descriptive terms that other traders might wish to use as well. However, it is not necessary for the Office to show that there is already a descriptive use by the applicant or its competitors. Consequently, the number of competitors that could be affected is totally irrelevant. Therefore, if a word is descriptive in its ordinary and plain meaning, this ground for refusal cannot be overcome by showing that the applicant is the only person who produces, or is capable of producing, the goods in question.

2.3.1.2 The reference base

The **reference base** is the ordinary understanding of the relevant public of the word in question. That can be corroborated by **dictionary entries**, examples of the use of the term in a descriptive manner found on internet **websites**, or it may clearly follow from the **ordinary understanding** of the term.

It is not necessary for the Office to prove that the word is the subject of a dictionary entry in order to refuse a sign. In particular for composite terms, dictionaries do not mention all possible combinations. What matters is the ordinary and plain meaning. In addition, terms used as specialised terminology to designate the respective relevant characteristics of the goods and services are to be considered descriptive. In these cases it is not required to demonstrate that the meaning of the term is immediately apparent to the relevant consumers to which the goods and services are addressed. It suffices that the term is meant to be used, or could be understood by part of the relevant public, as a description of the claimed goods or services, or a characteristic of the goods and services (judgment of 17/09/2008, T-226/07, Pranahaus, EU:T:2008:381, § 36).

The following **principles** in respect of both language and dictionary use apply, with regards to the reference base.

- The sign must be refused if it is descriptive in any of the **official languages of the European Union**, regardless of the size or population of the respective country. Systematic language checks are only performed in the official languages of the European Union.

- Should there be convincing evidence that a given term has a meaning in a **language other than the official languages of the Union** and is understood by a significant section of the relevant public in at least a part of the European Union, this term must also be refused pursuant to Article 7(2) EUTMR (judgment of 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 35-36). For example, the term HELLIM is the Turkish translation of the word ‘Halloumi’, a type of cheese. Since Turkish is an official language in Cyprus, it is a language that is understood and spoken by part of the population of Cyprus, and therefore the average consumer in Cyprus may understand that HELLIM is a descriptive term for cheese (judgment of13/06/2012, T-534/10, Hellim, EU:T:2012:292).

The **evidence** can come by individual knowledge of the particular examiner, or is produced via third-party observations or by way of documentation included in cancellation requests.

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

- The objection should clearly state which language or languages are concerned, which makes the ground for refusal applicable at least for the Member State in which this language is the official language or one of the official languages, and excludes conversion for that Member State (see Rule 45(4) EUTMIR).

Article 7(1)(c) EUTMR also applies to **transliterations**. In particular, transliterations into Latin characters of Greek words must be treated in the same way for the purpose of examining absolute grounds for refusal as words written in Greek characters and vice versa (judgment of 16/12/2010, T-281/09, Chroma, EU:T:2010:537, § 34). This is because the Latin alphabet is known to Greek-speaking consumers. The same applies to the Cyrillic alphabet, which is used in the EU by Bulgarians, who are also familiar with Latin characters.

2.3.1.3 Characteristics mentioned under Article 7(1)(c) EUTMR

Kind of goods and services

This includes the goods or services themselves, that is, their type or nature. For example, 'bank' for financial services, 'Perlé' for wines and sparkling wines (judgment of 01/02/2013, T-104/11, 'Perle') or 'Universaltelefonbuch' for a universal telephone directory (judgment of 14/06/2001, T-357/99 and T-358/99, Universaltelefonbuch, EU:T:2001:162) or constituent parts or components of the goods (judgment of 15/01/2013, T-625/11, EcoDoor, EU:T:2013:14, § 26).

Quality

This includes both laudatory terms, referring to a superior quality of the respective goods or services, as well as the inherent quality of the goods or services. It covers terms such as 'light', 'extra', 'fresh', 'hyper light' for goods that can be extremely light (decision of 27/06/2001, R 1215/00-3,Hyperlite). In addition, figures may refer to the quality of a product or a service, such as 24/7 for service availability; '2000', which refers to the size of the motor or '75', which refers to the horse power (kW) of the motor.

Quantity

This covers indications of the quantity in which the goods are usually sold, such as 'six pack' for beer, 'one litre' for drinks, '100' (grams) for chocolate bars, Only quantity measurements relevant in trade, not those that are hypothetically possible, count. For example, 99.999 for bananas would be acceptable.

Intended purpose

The intended purpose is the function of a product or service, the result that is expected from its use or, more generally, the use for which the good or service is intended. An example is 'Trustedlink' for goods and services in the IT-sector aimed at securing a safe (trusted) link (judgment of 26/10/2000, T-345/99, Trustedlink, EU:T:2000:246). Marks that have been refused registration on this basis include 'Therapy' for massage tools (decision of 08/09/1999, R 0144/99-3, THERAPY) and 'SLIM BELLY' for fitness training apparatus, sport activities, medical and beauty care services (judgment of 30/04/2013, T-61/12, Slim belly, EU:T:2013:226). This objection also applies as regards accessories: a term that described the type of goods also describes the intended purpose for accessories to those goods. Therefore, 'New Born Baby' is objectionable for accessories for dolls and 'Rockbass' for accessories for rock guitars (judgment of 08/06/2005, T-315/03, Rockbass, EU:T:2005:211 (appeal C-301/05 P settled)).

Value

This covers both the (high or low) price to be paid, as well as the value in quality. It covers therefore not only expressions such as ‘extra’ or ‘top’, but also expressions such as ‘cheap’ or ‘more for your money’. It also covers expressions indicating, in common parlance, goods or services that are superior in quality.

Geographical origin

See paragraph 2.3.2.6 below.

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

This covers expressions concerning the time at which services are rendered, either expressly (‘evening news’, ‘24 hours’) or in a usual manner (24/7). It also covers the time at which goods are produced if that is relevant for the goods (late vintage for wine). For wine, the numeral ‘1998’ indicating the vintage year would be relevant, but not for chocolate.

Other characteristics

This covers other characteristics of the goods or services and shows that the preceding list of items in Article 7(1)(c) is not exhaustive. In principle, any characteristic of the goods and services must lead to a refusal under Article 7(1)(c) EUTMR. It does not matter whether the characteristics of the goods or services are commercially essential or merely ancillary or whether there are synonyms of those characteristics (judgments of 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 102; 24/04/2012, T-328/11, EcoPerfect, EU:T:2012:197, § 41).

Examples of ‘other characteristics’

- the subject matter contained within the claimed goods or services: (see paragraph 2.3.2.7 below

- the identification of the targeted consumer: ‘children’ or ‘ellos’ (judgment of 27/02/2002, T-219/00, Ellos, EU:T:2002:44) for *clothing*.

2.3.2 Word marks

2.3.2.1 One word

Descriptive terms are those that merely consist of information about the characteristics of the goods and services. This means that descriptive terms cannot fulfil the function of a trade mark. Consequently, the ground for refusal applies irrespective of whether a term is already used by other competitors in a descriptive manner for the goods and services at issue.

In particular, a word is descriptive if either for the general public (if the goods or services target them) or for a specialised public (irrespective of whether the goods or services also target the general public) the trade mark has a descriptive meaning:

- The term ‘RESTORE’, is descriptive for surgical and medical instruments and apparatus; stents; catheters; and guide wires (judgment of 17/01/2013, C-21/12 P, Restore, EU:C:2013:23)

- ‘CONTINENTAL’ is descriptive for ‘live animals, i.e., dogs’ and ‘the keeping and breeding of dogs, i.e. puppies and animals for breeding’. Indeed, the word ‘Continental’ indicates a breed of bulldogs (judgment of 17/04/2013, T-383/10, Continental, EU:T:2013:193).

Furthermore, as seen above, objections should also be raised against terms that describe desirable characteristics of the goods and services.

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

Not descriptive:

- ‘BRAVO’, as it is unclear who says ‘BRAVO’ to whom, and what is being praised (judgment of 04/10/2001, C-517/99, Bravo, EU:C:2001:510).

2.3.2.2 Combinations of words

As a general rule, a **mere combination of elements**, each of which is descriptive of characteristics of the goods or services themselves, remains descriptive of those characteristics. Merely bringing those elements together without introducing unusual variations, in particular as to syntax or meaning, cannot result in anything other than a descriptive sign.

However, if due to the **unusual nature of the combination** in relation to the goods or services a combination creates an **impression that is sufficiently far removed** from that produced by the mere combination of meanings lent by the elements of which it is composed, that combination will be considered **more than the sum of its parts** (judgment of 12/02/2004, C-265/00, Biomild, EU:C:2004:87, § 39 and 43). These notions, ‘unusual nature of the combination’, ‘impression sufficiently far removed’ and ‘more than the sum of its parts’ have to be interpreted as meaning that Article 7(1)(c) EUTMR does not apply when the way in which the two descriptive elements are combined is in itself fanciful.

The following examples have been **refused** registration:

- ‘Biomild’ for yoghurt being mild and organic (judgment of 12/02/2004, C-265/00, Biomild, EU:C:2004:87);

- ‘Companyline’ for insurance and financial affairs (judgment of 19/09/2002, C-104/00 P, Companyline, EU:C:2002:506);

- ‘Trustedlink’ for software for e-commerce, business consulting services, software integration services and education services for e-commerce technologies and services (judgment of 26/10/2000, T-345/99, Trustedlink, EU:T:2000:246);
- ‘Cine Comedy’ for the broadcast of radio and television programmes, production, showing and rental of films, and allocation, transfer, rental and other exploitation

of rights to films (judgment of 31/01/2001, T-136/99, Cine Comedy, EU:T:2001:31);

- 'Teleaid' for electronic devices for transferring speech and data, repair services for automobiles and vehicle repair, operation of a communications network, towing and rescue services and computing services for determining vehicle location (judgment of 20/03/2002, T-355/00, Tele Aid, EU:T:2002:79);

- 'Quickgripp' for hand tools, clamps and parts for tools and clamps (order of 27/05/2004, T-61/03, Quick-Grip, EU:T:2004:161);

- 'Twist and Pour' for hand held plastic containers sold as an integral part of a liquid paint containing, storage and pouring device (judgment of 12/06/2007, T-190/05, Twist & Pour, EU:T:2007:171);

- 'CLEARWIFI' for telecommunications services, namely high-speed access to computer and communication networks (judgment of 19/11/2009, T-399/08, Clearwifi, EU:T:2009:458);

- 'STEAM GLIDE' for electric irons, electric flat irons, electric irons for ironing clothes, parts and fittings for the aforementioned goods (judgment of 16/01/2013, T-544/11, Steam Glide, EU:T:2013:20);

- 'GREENWORLD' for, inter alia, gas fuels, fuels, electric power, gas for lighting, retail services in the areas of fuels, transmission and transport of electrical energy, heat, gas or water (judgment of 27/02/2015, T-106/04, Greenworld, EU:T:2015:123);

- 'ecoDOOR' for products on which doors have a significant impact, such as dishwashers, washing machines, vending machines, apparatus for cooking (judgment of 10/07/2014, C-126/13 P, EcoDoor, EU:C:2014:2065).

In the same way, combinations of the **prefix 'EURO'** with purely descriptive terms must be refused where the 'EURO' element reinforces the descriptiveness of the sign as a whole or where there is a reasonable connection between that term and the goods or services concerned. This is in line with the judgment of 07/06/2001, T-359/99, EuroHealth, EU:T:2001:151.

The following examples have been **accepted for** registration:

- GREENSEA for goods and services in Classes 1, 3, 5 and 42;
- MADRIDEXPORTA for Classes 16, 35, 36, 38, 39, 41 and 42 (judgment of 16/09/2009, T-180/07, Madridexporta, EU:T:2009:334);
- DELI FRIENDS for Classes 29, 30 and 35.

Combinations not following grammatical rules

A combination of words can be considered a descriptive indication even though it does not follow the usual grammatical rules. If, however, the combination does amount to more than the mere sum of its parts, it may be acceptable (judgment of 17/10/2007, T-105/06, WinDVD Creator, EU:T:2007:309, § 34).

- ‘HIPERDRIVE’ is considered descriptive of the intended purpose of setting devices for tools, despite the misspelling of the adjective ‘hyper’ as ‘hiper’ (judgment of 22/05/2014, T-95/13, Hiperdrive, EU:T:2014:270, § 33-42).

- ‘CARBON GREEN’ is descriptive for reclaimed rubber, namely, recycled carbonaceous materials, namely plastic, elastomeric, or rubber filled materials obtained from pyrolysed tire char and plastic, elastomeric, or rubber compounds formulated using such filler material, even though adjectives precede nouns in English (judgment of 11/04/2013, T-294/10, Carbon green, EU:T:2013:165).

Furthermore, in the world of advertising, definite articles and pronouns (the, it, etc.), conjunctions (or, and, etc.) or prepositions (of, for, etc.) are frequently omitted. This means that a lack of these grammatical elements will sometimes not be sufficient to make the mark distinctive.

Combinations of adjectives + nouns or verbs

For combinations consisting of **nouns and adjectives**, it should be assessed whether the meaning of the combination changes if its elements are inverted. For example, ‘Vacations direct’ (not registrable, decision of 23/01/2001, R 0033/2000-3) is tantamount to ‘direct vacations’, whereas ‘BestPartner’, is not the same thing as ‘PartnerBest’.

The same reasoning applies to words consisting of the **combination of an adjective and a verb**. Therefore, the word ‘ULTRAPROTECT’ must be considered descriptive for sterilising and sanitary preparations, even though it consists of the combination (grammatically incorrect) of an adjective (ULTRA) with a verb (PROTECT), since its meaning remains clearly understandable (decision of 03/06/2013, R 1595/2012-1; see also judgment of 06/03/2012, T-565/10, Highprotect, EU:T:2012:107).

Combinations of words in different languages

Combinations made up of words from different languages may still be objectionable if the relevant consumers will understand the descriptive meaning of all the elements without further effort. This may be the case, in particular, when the sign contains basic terms in a language that will be understood easily by the speakers of another language, or if the terms are similar in both languages. For instance, if a mark is composed of one basic descriptive term belonging to language ‘A’ and another descriptive word in language ‘B’, the sign as a whole will remain descriptive when it is assumed that the speakers of language ‘B’ will be able to grasp the meaning of the first term.

Applications that consist of descriptive words or expressions repeated in various languages are a special case in the sense that they are mere translations of each other. These trade marks should be considered descriptive if the relevant consumer will grasp that each of the words or expressions is in fact merely the translation of a descriptive meaning, for example, because the proximity of the terms contained in the mark to each other will lead the consumer to understand that they all have the same descriptive meaning in different languages. For instance:

- EUTM No 3 141 017 ‘Le salon virtuel de l’industrie — Industry virtual exhibition — Die virtuelle Industriemesse — Il salon virtuale dell'industria — El salon virtual de la industria’ for services in Classes 35, 38 and 42.

The following examples have been **refused** registration.

- EUTM No 12 596 169 'BABYPATAUGEOIRE' for Classes 20 and 42 related to chairs and design of chairs for babies. The sign is composed of an EN and a FR term that will be immediately understood by the French-speaking part of the public (the term 'baby' will be understood by the French-speaking part of the public).
- 'EURO AUTOMATIC PAIEMENT', for Classes 9 and 36 (judgment of 05/09/2012, T-497/11, Euro automatic paiement, EU:T:2012:402, combination of English and French terms).

2.3.2.3 Misspellings and omissions

A misspelling does not necessarily change the descriptive character of a sign. First of all, words may be misspelt due to influences of another language or the spelling of a word in non-EU areas, such as American English, in slang or to make the word more fashionable. Examples of signs that have been refused:

- 'Xtra' (decision of 27/05/1998, R 0020/1997-1),
- 'Xpert' (decision of 27/07/1999, R 0230/1998-3),
- 'Easi-Cash' (decision of 20/11/1998, R 0096/1998-1),
- 'Lite' (judgment of 27/02/2002, T-79/00, Lite, EU:T:2002:42),
- 'Rely-able' (judgment of (30/04/2013, T-640/11, Rely-able, EU:T:2013:225),
- 'FRESHHH' (judgment of 26/11/2008, T-147/06, Freshhh, EU:T:2008:528).

Furthermore, consumers will, without further mental steps, understand the '@' as the letter 'a' or the word 'at' and the '€' as the letter 'e'. Consumers will replace specific numerals by words, for example, '2' as 'to' or '4' as 'for'.

However, if the misspelling is fanciful and/or striking or changes the meaning of the word (accepted: 'D'LICIOUS', EUTM No 13 729 348 (instead of 'delicious'), 'FANTASTICK', EUTM No 13 820 378 (instead of 'fantastic')), the sign is acceptable.

As a rule, misspellings endow the sign with a sufficient degree of distinctive character when:

- they are striking, surprising, unusual, arbitrary and/or,

- they are capable of changing the meaning of the word element or require some mental effort from the consumer in order to make an immediate and direct link with the term that they supposedly refer to.

The following marks were refused:

Sign	Reasoning	Case
ACTIVMOTION SENSOR EUTM No 10 282 614 for goods in Class 7 (swimming pool and spa cleaning equipment, namely, sweepers, vacuums, and parts therefor)	The mark merely consists of 'ACTIV', an obvious misspelling of the word 'ACTIVE', 'MOTION' and 'SENSOR'. Combined, the words form a perfectly comprehensible and plainly descriptive combination, and was thus refused.	Decision of 06/08/2012, R 0716/2012-4 – 'ACTIVMOTION SENSOR', § 11

Sign	Reasoning	Case
XTRAORDINARIO International registration designating the EU No 930 778, for goods in Class 33 (tequila)	The above term is a non-existent word but closely resembles the Spanish adjective 'extraordinario'. Spanish and Portuguese consumers will perceive the sign as a misspelling of a word meaning 'remarkable', 'special', 'outstanding', 'superb' or 'wonderful', and as such, attribute a descriptive meaning to the sign.	Decision of 08/03/2012, R 2297/2011-5 – 'Xtraordinario', § 11-12

However, the following marks were **accepted**:

Sign	Reasoning	Case
LINQ EUTM No 1 419 415 covering goods and services in Classes 9 and 38	This word is an invented word, not existing in any known dictionary, and it was not shown that this word is a common misspelling used in the trade circles of interest to the appellant. Additionally, because the word is short, the ending letter 'Q' will be noticed as a peculiar element, and thus the fanciful spelling is obvious	Decision of 04/02/2002, R 0009/2001-1 – 'LINQ', § 13
LIQID EUTM No 5 330 832 initially covering goods in Classes 3, 5 and 32	In this word mark, the combination 'QI' is highly uncommon in the English language, as the letter 'Q' is normally followed by a 'U'. The striking misspelling of the word 'liquid' would allow even a consumer in a hurry to notice the peculiarity of the word 'LIQID'. Furthermore, the spelling would not only have an effect on the visual impression produced by the sign, but also the aural impression, as the sign applied for will be pronounced differently from the word 'liquid'.	Decision of 22/02/2008, R 1769/2007-2 – 'LIQID', § 25

2.3.2.4 Abbreviations and acronyms

Abbreviations of descriptive terms are in themselves descriptive if they are used in that way, and the relevant public, whether general or specialised, recognises them as being identical to the full descriptive meaning. The mere fact that an abbreviation is derived from a descriptive term is not sufficient (judgment of 13/06/2014, T-352/12, Flexi, EU:T:2014:519).

The following signs were refused because the descriptive meaning for the relevant public could clearly be shown:

- SnTEM (judgment of 12/01/2005, T-367/02 to T-369/02, SnTEM, SnPUR & SnMIX, EU:T:2005:3),
- TDI (judgment of 03/12/2003, T-16/02, TDI, EU:T:2003:327 (appeal C-82/04 P was settled),
- LIMO (judgment of 20/07/2004, T-311/02, Limo, EU:T:2004:245),
- BioID (judgment of 05/12/2002, T-91/01, BioID, EU:T:2002:300 (appeal C-37/03 P set aside GC judgment and dismissed decision of 2nd BoA)).

Note that use of internet databases such as 'AcronymFinder.com' as a reference base should be made with the greatest care. Use of technical reference books or scientific literature are preferable, for example, in the field of computing. Alternatively, use of the abbreviation by a number of traders in the appropriate field on the internet is sufficient to substantiate actual use of the abbreviation.

Signs consisting of an independently non-descriptive acronym that precedes or follows a descriptive word combination should be objected to as descriptive if it is perceived by the relevant public as merely a word combined with an abbreviation of that word combination, for example 'Multi Markets Fund MMF'. This is because the acronym and word combination together are intended to clarify each other and to draw attention to the fact that they are linked (judgment of 30/06/2009, T-285/08, Natur-Aktien-Index, EU:T:2009:230, § 32 and 40). This will be the case even where the acronym does not account for the mere 'accessories' in the word combination, such as articles, prepositions or punctuation marks, demonstrated in the following examples:

- 'NAI – Der Natur-Aktien-Index',
- 'The Statistical Analysis Corporation – SAC'.

While the above rule will cover most cases, not all instances of descriptive word combinations juxtaposed with an abbreviation of that word will be considered descriptive as a whole. This will be the case where the relevant public will not immediately perceive the acronym as an abbreviation of the descriptive word combination, but rather as a distinctive element that will make the sign as a whole more than the sum of its individual parts, as demonstrated in the following example:

- 'The Organic Red Tomato Soup Company — ORTS'.

2.3.2.5 Slogans

A slogan is objectionable under Article 7(1)(c) EUTMR when it immediately conveys the kind, quality, intended purpose or other characteristics of the goods or services.

The criteria established by case-law for the purpose of determining whether a slogan is descriptive or not are identical to those applied in the case of a word mark containing only a single element (judgment of 06/11/2007, T-28/06, Vom Ursprung her vollkommen, EU:T:2007:330, § 21). It is inappropriate to apply criteria to slogans that are stricter than those applicable to other types of signs, especially considering that the term 'slogan' does not refer to a special subcategory of signs (judgment of 12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 26 and 40).

Example of a descriptive slogan

- An application in Class 9 (*satellite navigation systems*, etc.) for 'FIND YOUR WAY', (decision of 18/07/2007, R 1184/2006-4) was objected to under Article 7(1)(b) and (c) EUTMR. The expression FIND YOUR WAY in relation to the goods applied for in Class 9 is clearly intended to inform the relevant consumer that the appellant's goods help consumers to identify geographical locations in order to find their way. The message conveyed by the sign applied for directly refers to the fact that consumers will discover the route for travelling from one place to another when using the specified goods.

- BUILT TO RESIST could have only one possible meaning in relation to *paper, paper goods* and *office requisites* in Class 16, *leather, imitations of leather, travel articles not included in other classes and saddlery* in Class 18 and *clothing, footwear and headgear* in Class 25, namely that the goods are manufactured to last and are, therefore, tough and resistant to wear and tear (judgment of 16/09/2009, T-80/07, Built to resist, EU:T:2009:332, § 27-28).

2.3.2.6 Geographical terms

A geographical term is every existing name of a place, for example a country, region, city, lake or river. This list is not exhaustive. Adjectival forms are not sufficiently different from the original geographical term to cause the relevant public to think of something other than that geographical term (judgment of 15/10/2003, T-295/01, Oldenburger, EU:T:2003:267, § 39). For example, 'German' will still be perceived as referring to Germany, and 'French' will still be perceived as referring to France. Furthermore, outdated terms such as 'Ceylon', 'Bombay' and 'Burma' fall within this scope if they are still commonly used or generally understood by consumers as a designation of origin.

It is in the **public interest** that signs that may serve to designate the geographical origin of goods or services remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer preferences by, for instance, associating the goods or services with a place that may elicit a favourable response (judgments of 15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 47; 25/10/2005, T-379/03, Cloppenburg, EU:T:2005:373, § 33).

This paragraph (2.3.2.6.) uses the words 'geographical term' to refer to **any** geographical indication in an EU trade mark application, whereas the terms 'protected geographical indication' and 'protected designation or appellation of origin' are used **only** in the context of specific legislation protecting them. Designations of origin and geographical indications protected under specific EU Regulations are dealt with under the section on Article 7(1)(j) EUTMR.

If the sign **contains other non-descriptive or distinctive elements**, the registrability of the combination (of the sign in its entirety) must be assessed in the same manner as in cases where descriptive elements are coupled with distinctive or non-descriptive elements (see paragraph 2.3.4 below).

Assessment of geographical terms

The registration of geographical names as trade marks is not possible where such a geographical name is either **already famous,** or is **known for the category of goods concerned**, and is therefore **associated** with those goods or services in the mind of the relevant class of persons, or is liable to be used by undertakings and must remain available to such undertakings as indications of the geographical origin of the goods and services concerned (judgments of 15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 48; 25/10/2005, T-379/03, Cloppenburg, EU:T:2005:373, § 34).

As with all other descriptive terms, the test is whether the geographical term **describes objective characteristics of the goods and services**. The assessment must be made with reference to the claimed goods and services and with reference to the perception by the relevant public. The descriptive character of the geographical term may relate to:

- the place of production of the goods;
- the subject matter of a good (e.g. the city or region a travel guide is about);
- the place where the services are rendered;
- the kind of cuisine (for restaurants); or
- the place that influences consumer preferences (e.g. lifestyle) by eliciting a favourable response (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 47 and Cloppenburg, EU:T:2005:373, § 33.

a) First step: term understood by the relevant public

The **first step** in assessing a geographical term is to determine whether it is understood as such by the relevant public. Article 7(1)(c) EUTMR does not in principle preclude the registration of geographical names that are unknown to the relevant public — or at least unknown as the designation of a geographical location (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 49; T-379/03, Cloppenburg, EU:T:2005:373, § 36). Whether or not this is the case will be determined by taking as a basis a reasonably well-informed consumer who has sufficient common knowledge but is not a specialist in geography. For an objection to be raised, the Office must prove that the geographical term is known by the relevant public as designating a place (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 51).

b) Second step: term designates a place associated with the goods and services

The **second step** is to determine whether the geographical term applied for designates a place that is currently associated with the claimed goods or services in the mind of the relevant public or whether it is reasonable to assume that such a name may, in the mind of the relevant public, designate the geographical origin of that category of goods or services (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 51, T-379/03, Cloppenburg, EU:T:2005:373, § 38), or if it will reasonably be associated with those goods or services in the future (judgment of 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 31).

In establishing whether such an association exists, the Court has clarified that the following **factors** should be taken into account (judgment of 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 32 and 37, T-379/03, EU:T:2005:373, § 38 *in fine*):

- the degree of familiarity of the relevant public with the geographical term
- the characteristics of the place designated by the term, and
- the category of goods or services.

It is **not necessary** to establish that the name actually designates the **true** geographical origin of the goods. It is enough to demonstrate that the connection between the name of the place and the goods may enable the relevant public to perceive the contested sign as an indication of the origin of those goods (judgment of 15/10/2003, T-295/01, Oldenburger, EU:T:2003:267, § 43). For example, 'Milano' should be refused for *clothing,* Switzerland for *financial services* and Islas Canarias for *tourist services*.
With regard to **reasonable future association,** an Article 7(1)(c) EUTMR refusal cannot be based solely on the argument that the goods or services can theoretically be produced or rendered in the place designated by the geographical term (judgment of 08/07/2009, T-226/08, Alaska, EU:T:2009:257). The abovementioned factors should be assessed (degree of familiarity of the relevant public with the geographical term, the characteristics of the place designated by the term, and the category of goods or services). In particular, such an assessment must take into account the **relevance** of the geographical origin of the goods in question, and the **customs of the trade** in using geographical names to indicate the origin of the goods or to refer to certain qualitative and objective criteria of the goods.

Sign	Reasoning	Case
BRASIL Class 32: Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages. Class 33: Whisky; whisky-based beverages.	The Board recognised that the mere existence of whisky production in Brazil was not sufficient in itself to presume that relevant consumers of whisky will associate the sign with the goods. However, it had to be assessed whether it was reasonable to assume that such an association might be established in the future. The BoA assessed a number of factors, including the fact that it is current practice in trade to indicate the geographical origin of whiskies and whisky-based beverages. It concluded that the designation 'Brasil' would be understood as an informative indication for whisky and whisky-based beverages (para. 29).	R 0434/2013-1

Sign	Reasoning	Case
THE SPIRIT OF CUBA Class 33: Alcoholic beverages.	The GC considered that the sign would be understood by the relevant public as a reference to the alcoholic spirit of Cuba or to an alcoholic beverage from Cuba, despite the structure of the sign ('the', singular form, 'of' instead of 'from') (para. 26)	T-207/13

Sign	Reasoning	Case
PORT LOUIS Class 18: Leather and imitations of leather, goods made of these materials and not included in other classes; animal skins, hides; trunks and traveling bags; umbrellas, parasols, canes and walking sticks; saddlery, harness and whips; horse blankets Class 24: Household textiles; bed and table covers; bedclothes; bath linen (except clothing); household linens; shower curtains of textile; curtains of textile or plastic; blinds of textile; coverlets; wax table cloths Class 25: Clothing, footwear, headgear.	The GC annulled a BoA decision because it had not established that the city of Port Louis (capital of the Republic of Mauritius) was sufficiently known by the relevant public of the former colonial powers of France and the United Kingdom. Nor was it established that Port Louis had a reputation for the relevant goods (textile manufacture) amongst the relevant public (paras 40-54)	T-230/06, 'Port Louis'

Geographical terms that are **merely allusive or fanciful should not be objected to on** this basis. For example, while the North Pole and Mont Blanc are commonly known

geographical terms, they would not be understood in the context of ice cream or sports cars as possible places of production, but as merely allusive and fanciful terms. The same applies to the fashionable use of city/country names for goods and services unrelated to what the city/country is known for (e.g. 'Hollywood' for *chewing gum*, 'Greenland' for *fresh fruits and vegetables* (R 0691/2000-1, GREENLAND), 'Sudan' for *paints* (R 0594/1999-2, SUDAN), and 'Denver' for *lighting equipment* (R 2607/2011-2, DENVER)) and the use of names of fashionable suburbs or shopping streets ('Champs Élysées' for *bottled water*, 'Manhattan' for *tomatoes*). The same applies by analogy to 'Port Louis' for *textiles*.

Finally, there are some geographical terms, such as **major geographical places or regions as well as countries**, which may be refused merely because of their **widespread recognition and fame for the high quality** of their goods or services. In such cases no detailed assessment of the association between the place and the goods and services is necessary (judgment of 15/12/2011, T-377/09, Passionately Swiss, EU:T:2011:753, § 43-45).

Sign	Reasoning	Case
Passionately Swiss	The GC held that BoA did not need to go into a detailed assessment of the association between the sign and each of the goods and services. It based its finding on Switzerland's reputation for quality, exclusiveness and comfort, which can be associated with the services in Classes 35, 41, 43 and 44 and the goods in Class 16 (para. 45).	T-377/09

Sign	Reasoning	Case
MONACO	The General Court found that the word 'monaco' corresponds to the name of a globally known principality, not least due to the renown of its royal family and its organisation of a Formula 1 Grand Prix and a circus festival. The Court considered that the trade mark MONACO had to be refused for goods and services in Classes 9, 16, 39, 41 and 43 as the word 'monaco' could be used, in trade, to designate origin, geographical destination or the place of supply of services. The trade mark was thus descriptive for the goods and services concerned.	T-197/13

The mere fact that a geographical term is used by only one producer is not sufficient to overcome an objection, although it is an important argument to be taken into account in assessing acquired distinctiveness.

2.3.2.7 Terms describing subject matter in goods or services

Where a sign consists exclusively of a word that describes what may be the subject matter or content of the goods or services in question, it should be objected to under Article 7(1)(c) EUTMR. Commonly known terms likely to be linked to a particular thing, product or activity by the relevant public are capable of describing subject matter and should therefore be kept free for other traders (judgment of 12/06/2007, T-339/05, Lokthread, EU:T:2007:172, § 27).

The essential question is whether the sign applied for **may be used in trade in relation to the goods or services applied for** in a manner that will be undoubtedly

perceived by the relevant public as descriptive of the subject matter of those claimed goods or services, and should therefore be kept free for other traders.

For example, a widely known name such as 'Vivaldi' will immediately create a link to the famous composer, just as the term 'skis' will immediately create a link to the sport of skiing. While Class 16 (books) is a prime example of a category of goods which contains subject matter or content, an objection made under this section may occur also with respect to other goods and services, such as data carriers, DVDs, CD-ROMs or editorial services. With regard to this section, the terms 'subject matter' and 'content' are used interchangeably. See also paragraph 2.2.3 above.

Names of famous persons (in particular musicians or composers) can indicate the category of goods, if due to wide spread use, the time lapse, the date of death, or the popularisation, recognition, multiple performers, or musical training, the public can understand them as generic. This would be the case, for example, with respect to 'Vivaldi', whose music is played by orchestras all over the world and the sign 'Vivaldi' will not be understood as an indicator of origin for music.

Objections based on the above:

- will apply only to goods (e.g. books) or services (e.g. education) that contain subject matter regarding other things, products and/or activities (e.g. a book about history, or an educational course on history),

- when the sign consists exclusively of the word identifying that subject matter (e.g. 'VEHICLES' or 'HISTORY'), and

- will be made on a case-by-case basis by assessing multiple factors, such as the relevant public, the degree of attention or the descriptive character of the term in question (see below).

Goods and services that may contain subject matter

For most cases, the goods or services that may consist of or contain objectionable subject matter are the following:

- Class 9: *Magnetic data carriers, software, recording discs, electronic publications (downloadable).*

    - Objectionable

        — STATISTICAL ANALYSIS for software
        — ROCK MUSIC for CDs.

- Class 16: Printed matter, photographs and teaching materials as long as these include printed matter.

    - Objectionable

        — HISTORY for books
        — PARIS for travel guides
        — CAR for magazines
        — ANIMALS for photographs
        — TRANSCENDENTAL MEDITATION for *instructional and teaching material.*

- Class 28: Board *games*
    - Objectionable
        - ‘Memory’ (order of 14/03/2011, C-369/10).
- Class 35: Trade fairs, advertising, retail services.
    - Objectionable
        - ELECTRONICA for trade fairs related to electronic goods (judgment of 05/12/2000, T-32/00, Electronica, EU:T:2000:283, § 42-44)
        - LIVE CONCERT for advertising services
        - CLOTHING for retail services.
- Class 38: Telecommunications
    - Objectionable
        - NEWS for telecommunications
        - MATH for providing online forums.
- Class 41: Education, training, entertainment, electronic publications (non-*downloadable).*
    - Objectionable
        - GERMAN for language courses
        - HISTORY for education
        - COMEDY for television programmes
        - TRANSCENDENTAL MEDITATION for *education services*.

The above list of Nice classes is not exhaustive, although it will apply to the vast majority of cases. Consequently, objections based on descriptive subject matter should be raised primarily in the context of the goods and services listed above.

Where the sign applied for is a descriptive term for a particular characteristic of goods or services, a designation of goods or services that excludes that particular characteristic described by the sign applied for will not avoid an objection based on subject matter. This is because it is unacceptable for an applicant to make a claim of goods or services subject to the condition that they do not possess a particular characteristic (judgment of 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 114-116). The following invented examples illustrate designations of goods or services that will not avoid an objection:

- COMEDY for television broadcasting, except for comedy *programming*
- PENGUINS (in plural!) for books, except for books about *penguins*
- TECHNOLOGY for classes, except for classes about computers and *technology*.

Distinguishable from the examples above are positive claims of goods or services, under which it is impossible for the sign applied for to describe any subject matter or content. For example, the following invented examples would not be objectionable, at least with regards to signs being descriptive of subject matter:

- COMEDY for television broadcasting of economic news, politics and *technology*
- PENGUIN for comic books with country western, medieval and ancient Roman *themes*
- TECHNOLOGY for classes about creative fiction *writing*.

2.3.2.8 Single letters and numerals

Single letters[4]

General considerations

In its judgment of 09/09/2010, C-265/09 P ('α'), the Court stated that when examining absolute grounds for refusal, the Office is required, under Article 76(1) EUTMR, to examine, of its own motion, the relevant facts which might lead it to raise an objection under Article 7(1) EUTMR and that that requirement cannot be made relative or reversed, to the detriment of the EUTM applicant (paras 55-58). Therefore, it is for the Office to explain, with motivated reasoning, why a trade mark consisting of a single letter represented in standard characters is descriptive.
Consequently, when examining single letter trade marks, generic, unsubstantiated arguments such as those relating to the availability of signs, given the limited number of letters, should be avoided. Similarly, it would not be appropriate to base an objection on speculative reasoning as to the different meanings that a sign could possibly have. The Office is obliged to establish, **on the basis of a factual assessment**, why the trade mark applied for would be objectionable.

It is therefore clear that the examination of single letter trade marks should be thorough and stringent, and that each case calls for a careful examination.

Examples

For instance, in **technical domains** such as those involving computers, machines, motors and tools, it may be that particular letters have a descriptive connotation if they convey sufficiently precise information about the goods and/or services concerned.

The **letter 'E'** was also considered to be descriptive in respect of 'wind power plants and parts thereof, generators, rotor blades for wind power plants, rotors for wind power plants' in Class 7, 'control switches for wind power plants, frequency converters, measuring, signalling and checking (supervision) instruments' in Class 9 and 'towers for wind power plants' in Class 19, since it may be seen as a reference to 'energy' or 'electricity' (judgment of 21/05/2008, T-329/06, E, EU:T:2008:161, § 24-31 and decision of 08/09/2006, R 0394/2006-1, § 22-26).

An objection might be justified also in respect of goods and/or services meant for a broader public. For example, **the letters 'S', 'M' or 'L'** in respect of clothing would be objectionable as these letters are used to describe a particular size of clothing, namely as abbreviations for 'Small', 'Medium' or 'Large'.

[4] This part deals with single letters under Article 7(1)(c) EUTMR. For single letters under Article 7(1)(b) EUTMR, see paragraph 2.2.5.

However, if it cannot be established that a given single letter is descriptive for the goods and/or services concerned, and provided that the applied for trade mark is not open to objection under another provision of Article 7(1) EUTMR, then the application should be **accepted**.

See paragraph 2.2.5.2 above for further examples of where an objection under Article 7(1)(b) EUTMR may be raised.

Numerals

In its judgment of 10/03/2011, C-51/10 P, '1000', the Court of Justice ruled that signs composed exclusively of numerals with no graphic modifications may be registered as trade marks (paras 29-30).

The Court referred by analogy to its previous judgment of 09/09/2010, C-265/09 P, (α) in respect of single letters (para. 31) and emphasised that trade marks consisting of numerals must be examined by with specific reference to the goods and/or services concerned (para. 32).

Therefore, a numeral may be registered as an EU trade mark only if it is distinctive in relation to the goods and services covered by the application for registration (para. 32) and is not merely descriptive or otherwise non-distinctive in respect of those goods and services.

For example, the Board confirmed the refusal of the trade mark '15' applied for in respect of 'clothing, footwear, headgear' in Class 25, on the ground that the numeral '15' is linked directly and specifically to these goods, as it contains obvious and direct information regarding their size. The Board also confirmed the refusal of this sign in respect of 'beers' in Class 32, as practical experience of the marketing of the relevant goods — relied upon by the Office — showed that a number of very strong beers with an alcohol content of 15 % vol. exist on the EU market (decision of 12/05/2009, R 0072/2009-2 '15', § 15-22).

It is well known that numerals are often used to convey relevant information as to the goods and/or services concerned. For example, in the following scenarios an objection would apply on the ground that the sign applied for is descriptive since it refers to:

- the **date** of production of goods/provision of services, when this factor is relevant in respect of the goods/services concerned. For instance, 1996 or 2000 for *wines* would be objectionable, since the age of the wine is a very relevant factor when it comes to the purchasing choice; 2020 would be objectionable also for 'events' as it could be considered the year of an event.

- **size**: 1600 for cars, 185/65 for tyres, 10 for women's clothing in the UK, 32 for women's clothing in France,

- **quantity**: 200 for cigarettes,

- **telephone codes**: 0800 or 0500 in the UK, 800 in Italy, 902 in Spain, etc.,

- the **time** of provision of services: 24/7,

- the **power** of goods: 115 for engines or cars,

- **alcoholic content**: 4.5 for lager, 13 for wines,

- the **number of pieces**: 1 000 for puzzles.

However, where the numeral does not appear to have any possible meaning in respect of the goods and services, it is acceptable, that is to say, '77' for financial services or '333' for 'clothing.

2.3.2.9 Names of colours

A sign consisting exclusively of the name of a colour must be objected to under Article 7(1)(c) EUTMR when the application claims any goods for which the colour can reasonably be perceived by the public as a description of one of its characteristics. For example, the name of the colour BLUE in relation to cheese describes a specific kind of cheese, the colour GREEN describes a specific kind of tea. The name of the colour BROWN in relation to sugar describes the colour and kind of the sugar. This rule applies mainly to common colours, for example, primary colours or SILVER and GOLD. When the claimed goods concern colorants, such as paint, ink, dyes, cosmetics, etc., the name of colours may describe the actual colour of the goods, and signs consisting exclusively of a colour should be objected to under Article 7(1)(c) EUTMR. In these cases, names of colours would not be seen as trade marks but merely as elements describing the principal characteristic of the goods.
The following guidelines should generally be applied:

- Where colour is a typical feature of the goods and relevant for consumer choice, such as clothing and motor cars, colour names such as EMERALD or APRICOT, which, although having alternative meanings, are recognised as having a strong connotation with definite colours, and should be objected to;

- Words such as SAPPHIRE, FLAMINGO or LAPISLAZULI do not have a sufficiently strong colour connotation to overwhelm the other non-colour meaning, and thus should generally not be objected to if they are not likely to be perceived as having a colour meaning with respect to the claimed goods or services (decision of 12/12/2013, 7950 C).

Colours in combination with other words may be registrable if the sign as a whole is distinctive: ICE COFFEE, VANILLA ICE and MISTY BLUE. Descriptive combinations such as DEEP BLUE should not be accepted. Dictionary words that are descriptive but obscure and unlikely to be used by others can be accepted: LUNA (alchemists' name for silver) and CARNELIAN (an alternative name for CORNELIAN, a red gem stone that is less well known).

2.3.2.10 Plant variety names

Plant variety names describe cultivated varieties or subspecies of live plants or agricultural seeds. As such, they will not be perceived as trade marks by the relevant public.

This section only concerns plant variety names that happen to be used in trade but which are **not simultaneously registered by the Community Plant Variety Office** in accordance with Council Regulation (EC) No 2100/94 of 27/07/1994 or registered in accordance with national law or international agreements to which the Union or the Member State concerned is a party. How to deal with EUTMs applied for that contain or

consist of a registered plant variety name is explained in another section of the Guidelines, in the context of Article 7(1)(m) EUTMR (see paragraph 2.6.1.2 below).

The criteria for assessing the descriptiveness of a trade mark for plants are no different from those applicable to other categories of trade marks. The provisions of trade mark law apply to plants in the same way as they apply to other categories of goods. It follows that the name of a plant variety must be rejected under Article 7(1)(c) EUTMR unless it has acquired distinctiveness under the conditions of Article 7(3) EUTMR.

Whenever an EUTM application consists of wordings for live plants, agricultural seeds, fresh fruits, fresh vegetables or equivalent ones, the Office will have to verify, by means of a search on the internet, whether the term making up the trade mark applied for coincides with the name of a specific plant variety that happens to be already used in trade.

If the search discloses that the term in question is already used in trade either in the EU or in another jurisdiction, then the Office must raise an **objection** under Article 7(1)(c) EUTMR, objecting that the term in question describes the nature of the goods concerned.

Depending on the circumstances of the case, and provided the evidence available demonstrates that the term in question has been used to such an extent as to have become **customary** in trade in the EU, then an objection both under Article 7(1)(c) and (d) EUTMR would be appropriate (see also paragraph 2.4.4 below).

For **example**, in its decision of 01/03/2012, R 1095/2011-5 SHARBATI, the Fifth Board of Appeal confirmed the refusal of the trade mark 'SHARBATI' applied for in respect of *rice; flour and preparations made from cereals, bread, pastry and confectionery* in Class 30, since it is descriptive thereof: Sharbati is a type of rice as well as a type of wheat that gives its name to a certain kind of flour, known in India.

Even though most of the evidence provided had its source in India, part of it referred to export trade on commodities markets. Therefore, the fact that a certain word is the name of a rice variety in India was already a strong indication that the product would be distributed in the European Union.

However, the Board considered that there was not sufficient evidence that the term SHARBATI had become generic in the European Union. Even though it had been demonstrated that Sharbati rice or Sharbati wheat had been offered to traders in the European Union, actually imported into the European Union and that there was no other precise name for that product, there was insufficient evidence that, at the filing date of the EUTM application, the products were known to the extent required under Article 7(1)(d) EUTMR.

An objection should also be raised when the applied for trade mark is only a **slight variation** (i.e. minor differences that do not alter the visual and aural perception of the sign) of the plant variety name used in trade, thus inducing consumers to believe that they are confronted with the descriptive or generic name of a plant variety.

Another **example** in this respect is to be found in decision of 03/12/2009, R 1743/2007-1, VESUVIA. The Board held that evidence that had its source in the United States and Canada was sufficient to conclude that the name 'Vesuvius' of a variety of roses *may* become a descriptive indication within the European Union in the sense of Article 7(1)(c) EUTMR and that the trade mark applied for, 'VESUVIA', came

close to it. The Board justified its refusal with the fact that roses are usually referred to in the feminine form.

Lastly, it should be noted that an objection should be raised not only in respect of applied for trade marks that are identical to (or are slight variations of) a plant variety name that is already used in trade, but also **in respect of any good and/or service that can be directly linked to the plant variety name in question** (for example, import-export of the plant variety in question).

2.3.2.11 Names of banks and newspapers/magazines

In the field of banks, newspapers and magazines, consumers are accustomed to recognising descriptive combinations of terms as badges of origin. This is due to:

- the relevant entity being identified as the only one with the right to use the combination (see, for example 'BANK OF ENGLAND' or 'BANCO DE ESPAÑA' or other central/national banks names) or

- the combination being likely to identify a specific entity (see, for example, 'DIARIO DE LAS PROVINCIAS DE VALENCIA', 'BANCO AZTECA' or 'BANCO GALLEGO)

In these cases, no objection should be raised. Nevertheless, descriptive combinations such as 'ONLINEBANK', 'E-BANK' or 'INTERNETNEWS' remain objectionable since they do not create, at least prima facie, the impression of a clearly identifiable entity.

2.3.2.12 Names of hotels

In the hotel sector, hotel names often consist of the combination of the word 'HOTEL' together with a geographical term (i.e. the name of an island, a city, a country etc.). They usually indicate specific establishments that d**o not have any link with the geographical term they refer to**, since they are not situated in that specific location. Consequently, due to these trade habits, consumers would not perceive expressions such as 'HOTEL BALI', 'HOTEL BENIDORM' or 'HOTEL INGLATERRA' as descriptive indications (describing that the services are provided by a hotel that is situated in that specific location) but rather as badges of origin.

Indeed, such expressions are not equivalent to the grammatically correct ones 'HOTEL IN BALI', 'HOTEL DE BENIDORM' or 'HOTEL EN INGLATERRA', which are clearly objectionable. This is even truer in cases where the hotel name consists of the names of two different cities, (or of two geographical terms in general), for example 'HOTEL LONDRES SAN SEBASTIAN'. Indeed, in this case the presence of the wording SAN SEBASTIAN (a city in the north of Spain) clearly indicates that 'HOTEL LONDRES' must be regarded as a fanciful expression. Therefore, no objection should be raised.

Nevertheless, in those **cases where the geographical term precedes the word 'HOTEL', the situation may change according to the different languages**. For example, in English the wording 'BALI HOTEL', would be perceived as an expression merely indicating any hotel located in the island of Bali, which is clearly objectionable. Consequently, each case should be assessed on its own merits. Finally, descriptive combinations such as 'LEADING HOTELS' remain objectionable since they do not create, at least prima facie, the impression of a clearly identifiable entity.

2.3.2.13 Combinations of names of countries/cities with a number indicating a year

Marks consisting of the combination of the name of a country/city with a number indicating a year must be refused under Article 7(1)(b) and (c) EUTMR **for all the goods and services claimed.**

As an example, the mark 'GERMANY 2006' has been considered as a descriptive indication for a wide list of goods and services, ranging from *unexposed films* in Class 1 to *vehicle maintenance* in Class 37. In particular, the decision in case R 1467/2005-1 of 21/07/2008 stated that this mark:

- is descriptive of the kind and content of those services 'of actually preparing, organising and promoting an event in Germany in 2006' (*ibidem*, para. 29, referring to the organisation of sporting events related to or associated with football championships, etc.);

- is descriptive of 'the purpose and thereby in part the level of quality of goods or services, during such competitions in Germany in the year 2006, as being suitable for competitions of the highest standard or that it has been successfully used in the context of such competitions' (*ibidem*, para. 30, referring to medical instruments, soccer balls, etc.);
- qualifies the goods as souvenir articles (*ibidem*, para. 31, referring to goods such as stickers, confetti, pyjamas, etc.).

With regard to **souvenir articles**, the Board underlined that 'merchandising and co-branding is not limited to "classic" souvenir products. It is public knowledge that there is a tendency to try to find new markets by combining various goods with the brand of some other unrelated popular event or names' (*ibidem*, para. 34, referring to goods such as eyeglasses, televisions, toilet paper, etc., all related to or associated with football championships).

2.3.2.14 INN codes

International Nonproprietary Names (INN) are assigned to pharmaceutical substances by the World Health Organisation (WHO), so that each substance can be recognised by a unique name. These names are needed for the clear identification, safe prescription and dispensing of medicines, and for communication and exchange of information among health professionals. INNs can be used freely because they are in the public domain. Examples of INNs are alfacalcido, calcifediol, calcipotriol.

Stems define the pharmacologically related group to which the INN belongs. INN stems serve to indicate the mode of action of groups of drugs. These stems and their definitions have been selected by WHO experts and are used when selecting new international non-proprietary names. An example of a stem is 'calci'.

The criteria for assessing the descriptiveness of a trade mark for pharmaceuticals are no different from those applicable to other categories of trade marks. The provisions of trade mark law apply to pharmaceuticals in the same way as to other categories of goods. The European Medicines Agency (EMA) assesses the single name under which a medicinal product will be marketed as part of its marketing authorisation for the European Union. EMA's assessment is based on public health concerns and takes into account the WHO World Health Assembly resolution (WHA46.19) on protection of INNs/INN stems to prevent any potential risk of confusion. The Office's assessment of the registrability of pharmaceutical trade marks, however, has no specific legal basis

for taking such health-related concerns into consideration (by analogy, judgment of 05/04/2006, T 202/04, Echinaid, EU:T:2006:106, § 31-32).

Considering the descriptive nature of INN codes and stems, an objection should be raised for Class 5 in the following scenarios:

- where the EUTM is an INN (the general rules on misspellings also apply, see paragraph 2.3.2.3 above); or
- where an INN appears within an EUTM and the other elements of the EUTM are descriptive/non-distinctive too (for instance BIO, PHARMA, CARDIO, MED, DERMA); or
- where the EUTM consists only of a stem.

A list of INN codes can be accessed after online registration on MedNet (https://mednet-communities.net). A list of common stems is available at the following link: http://www.who.int/medicines/services/inn/StemBook_2011_Final.pdf.

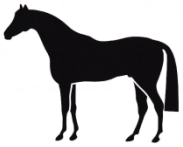
Office practice is to accept figurative trade marks containing INN codes or stems, applying the same criteria as to any other figurative trade mark containing descriptive word elements (i.e. whether the stylisation and/or the graphical features of a sign are sufficient for it to act as a trade mark).

An objection may also be based on Article 7(1)(g) EUTMR in the unlikely scenario that the list of goods in Class 5 refers to a different kind of drug from that covered by the INN. Where the list in Class 5 includes *pharmaceuticals*, the Office assumes good faith and no objection under Article 7(1)(g) EUTMR will be raised.

2.3.3 Figurative marks

Signs represented in languages other than Latin, Greek or Cyrillic are considered for formality purposes as figurative trade marks. However, this does not mean that the semantic content of these signs will not be taken into consideration for the purpose of the application of Article 7(1)(c).

Where a figurative mark consists exclusively of a basic natural form that is not significantly different from a true-to-life portrayal that serves to indicate the kind, intended purpose or other characteristic of the goods or services, it should be objected to under Article 7(1)(c) EUTMR as descriptive of a characteristic of the goods or services in question.

Sign	Case
	Judgment of 08/07/2010, T-385/08 'Representation of a dog'
	Judgment of 08/07/2010, T-386/08 'Representation of a horse'

In these cases the General Court held that for goods in Classes 18 and 31, the depiction of a dog or horse, respectively, serves to indicate the type of animal for which the goods are intended.

In the first case, the Court noted that the goods in Class 18 were specially produced for dogs, such as dog leads, dog collars and other dog accessories including bags. In the field of animal accessories, it is common practice for true-to-life or stylised but realistic portrayals of animals to be used for indicating the type of animal concerned. Therefore, for the goods in Class 18, the relevant public will immediately perceive the image's message that those goods are for dogs, without any further mental steps. The portrayal of a dog, therefore, indicates an essential characteristic of the goods concerned. The sign applied for is, therefore, descriptive (paras 25-28).

The same applies to goods in Class 31. As foodstuffs for domestic animals include dog food, the mark applied for is a descriptive indication for the goods at issue that will be immediately understood by the relevant public (para. 29).

In the second case, the Court held that for *clothing, headgear and belts* in Class 25, the portrayal of a horse was descriptive of the kind or intended purpose of the goods, namely that they are particularly developed or suitable for horse riding. As the relevant public would make a direct link between a horse and horse riding, the Court maintained that there was an immediate and concrete link between the portrayal of a horse and the goods concerned (paras 35-38).

By way of example, the sign below was held to be sufficiently highly stylised to significantly differ from a true-to-life portrayal serving to indicate the kind or intended purpose of the goods or services, and, thus, was registered.

Sign	EUTM No	Goods and services
	EUTM No 844	Classes 1, 3, 5, 6, 7, 8, 9, 11, 16, 17, 18, 19, 20, 21, 22, 26, 28, 31, 41, 42

2.3.4 Figurative threshold

2.3.4.1 Preliminary remarks

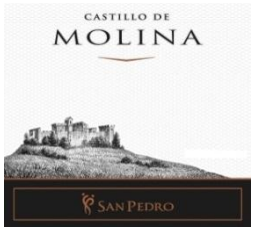
Terms or signs that are non-distinctive, descriptive or generic may be brought out of the scope of a refusal based on Article 7(1)(b), (c) or (d) EUTMR if combined with other elements that make the sign as a whole distinctive. In other words, refusals based on Article 7(1)(b), (c) and/or (d) may not apply to signs consisting of a non-distinctive, descriptive or generic element combined with other elements that take the sign as a whole beyond a minimum level of distinctiveness.

In practice this means that one of the main questions that the Office must answer is whether the mark is figurative enough to reach the minimum degree of distinctive character that is required for registration.

Finally, the fact that a sign contains figurative elements does not prevent it from still being misleading or contrary to public order or accepted principles of morality or from

falling under other grounds of refusal, such as those set forth by Article 7(1)(h), (i), (j) and (k) EUTMR.

Sign	EUTM No	Goods and services
	EUTM No 8 384 653	Classes 33, 35 and 39
(09/03/2012, T-417/10, ¡Que buenu ye! Hijoputa, EU:T:2012:120) The application was rejected since 'Hijoputa' is an offensive and vulgar word in Spanish. The application was considered to be against accepted principles of morality (irrespectively of the figurative elements of the sign) protected under Article 7(1)(f) EUTMR.		

Sign	EUTM No	Goods and services
	EUTM No 11 402 781	Class 33
The application was refused on the basis of Article 7(1)(j) EUTMR, because it contains the protected geographical indication for wines 'MOLINA' (protected under the agreement *establishing an association between the European Community and its Member States, of the one part, and the Republic of Chile, of the other part).* The distinctive figurative elements of the sign are irrelevant.		

2.3.4.2 Assessment of the figurative threshold

The presence of figurative elements may give distinctive character to a sign consisting of a descriptive and/or non-distinctive word element so as to render it eligible for registration as an EUTM. Therefore, the question to be considered is whether the stylisation and/or the graphical features of a sign are sufficiently distinctive for the sign to act as a badge of origin.

The examples below are taken from CP3 (Convergence Programme 3), where The IP offices of the European Trade Mark and Design Network agreed on a Common Practice in relation to when a figurative mark, containing purely descriptive/non-distinctive words, should pass the absolute grounds examination because the figurative element renders sufficient distinctive character.

The signs containing 'Flavour and aroma' seek protection for coffee in Class 30, the signs containing 'Fresh sardine' and 'Sardines' seek protection for sardines in Class 29, the sign containing 'DIY' seeks protection for **kits of parts for assembly**

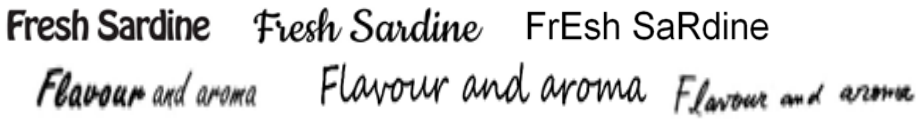
into furniture in Class 20 the signs containing 'Pest control services' seek protection for pest control services in Class 37, and the sign containing 'Legal advice services' seeks protection for legal services in Class 45.

Stylised word elements

- Typeface and font

In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces — with or without font effects (bold, italics) — are not registrable.

Non-distinctive examples:



Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

Distinctive examples:

- Combination with colour

The mere 'addition' of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, will not be sufficient to give the mark distinctive character.

Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

Non-distinctive examples:

- Combination with punctuation marks and other symbols

In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements.

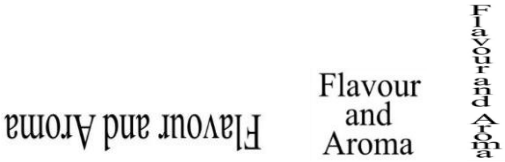
Non-distinctive examples:

FreshSardine. ™ "Flavour and aroma"

- Position of the word elements (sideways, upside-down, etc.)

In general, the fact that the word elements are arranged in vertical, upside-down or in one or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.

Non-distinctive examples:



However the way in which the word elements are positioned can add distinctive character to a sign when the arrangement is of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message.

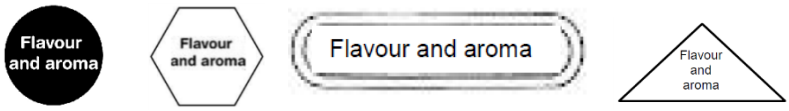
Distinctive examples:

Word element(s) and additional figurative element(s)

- Use of simple geometric shapes

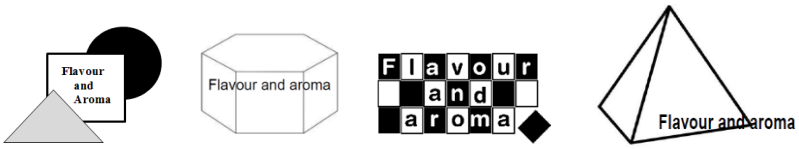
Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, in particular when the abovementioned shapes are used as a frame or border.

Non-distinctive examples:



However, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression that is sufficiently distinctive.

Distinctive examples:



- Position and proportion (size) of the figurative element in relation to the word element

In general, when a figurative element that is distinctive on its own is added to a descriptive and/or non-distinctive word element, then the mark is registrable, provided that said figurative element is, due to its size and position, clearly recognisable in the sign.

Non-distinctive examples:

Distinctive example:

- the figurative element is a representation of, or has a direct link with, the goods and/or services

A figurative element is considered to be descriptive and/or devoid of distinctive character whenever:

— It is a true-to-life portrayal of the goods and services.
— It consists of a symbolic/stylised portrayal of the goods and services that does not depart significantly from the common representation of said goods and services.

Non-distinctive examples:

Distinctive examples:

A figurative element that does not represent the goods and services but has a direct link with the characteristics of the goods and services will not render the sign distinctive, unless it is sufficiently stylised.

Non-distinctive example:

Distinctive example:

- the figurative element is commonly used in trade in relation to the goods and/or services applied for

In general, figurative elements that are commonly used or customary in trade in relation to the goods and/or services claimed do not add distinctive character to the mark as a whole.

Non-distinctive examples:

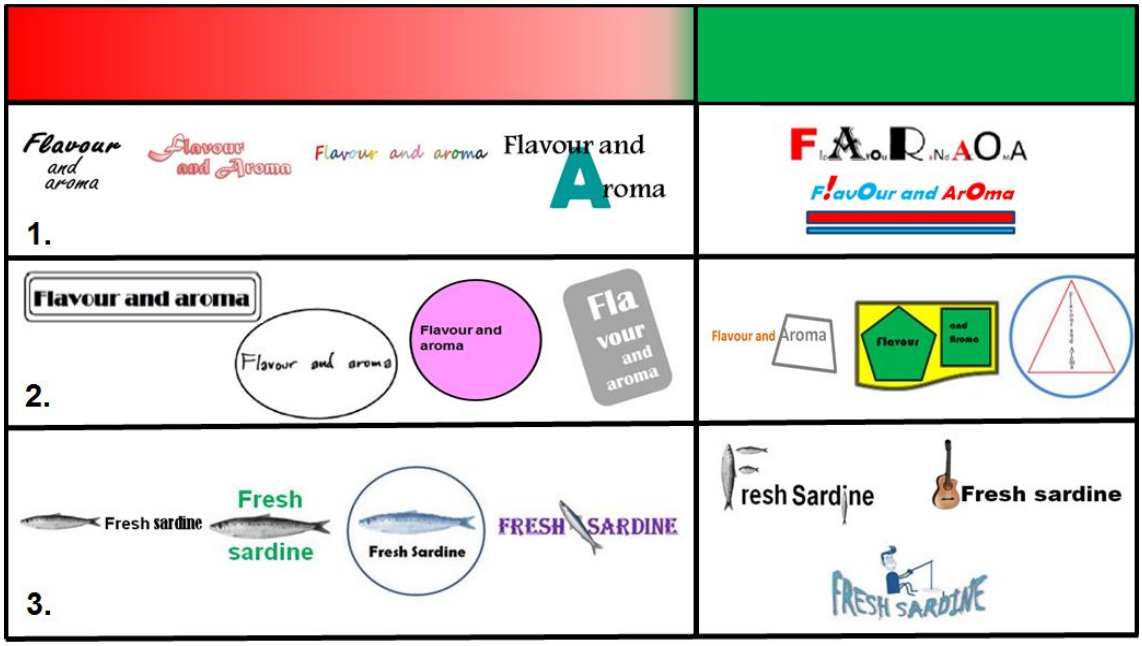
<u>Stylised word elements and additional figurative element(s)</u>

In general, a combination of figurative elements and word elements, which if considered individually are devoid of distinctive character, does not give rise to a distinctive mark.

Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case when the combination results in an overall impression that is

sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.

Examples: In order for a sign to be registrable, it must have a minimum level of distinctiveness. The purpose of the scale is to illustrate where that threshold is. The examples below from left to right contain elements with an increasing impact on the distinctiveness of the marks, resulting in marks which are either non-distinctive in their totality (red column) or distinctive in their totality (green column).



2.4 Customary signs or indications (Article 7(1)(d) EUTMR)

2.4.1 General remarks

Article 7(1)(d) EUTMR excludes from registration signs that consist **exclusively** of words or indications that have become customary in the current language or in the bona fide and established practices of the trade at the relevant point in time (see paragraph 2.4.2 below). In this context, the customary nature of the sign usually refers to something **other than** the properties or characteristics of the goods or services themselves.

Although there is a clear overlap between the scope of Article 7(1)(d) and Article 7(1)(c) EUTMR, signs covered by Article 7(1)(d) EUTMR are excluded from registration not because they are descriptive, but on the basis of their **current usage** in trade sectors covering the goods or services for which the mark is applied for (judgment of 04/10/2001, C-517/99, Bravo, EU:C:2001:510, § 35).

Moreover, signs or indications that have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that sign are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not, therefore, fulfil the essential function of a trade mark (judgment of 16/03/2006, T-322/03, Weisse Seiten, EU:T:2006:87, § 52).
This ground for refusal **also covers words that originally had no meaning** or had another meaning, for example, ‘weiße Seiten’ (= ‘white pages’). It also covers certain

abbreviations that have entered informal or jargon usage and have thereby become customary in trade.

Furthermore, a refusal based on Article 7(1)(d) EUTMR also covers **figurative elements** that are either frequently used pictograms or similar indications or have even become the standard designation for goods and services, for example a white 'P' on a blue background for parking places, the Aesculapian staff for pharmacies, or the silhouette of a knife and fork for restaurant services.

Sign	Reasoning	Case No
 EUTM No 9 894 528 covering goods in Class 9	'This device is identical to the international safety symbol known as "high voltage symbol" or "caution, risk of electric shock" ... It has been officially defined as such by the ISO 3864 as the standard high voltage symbol, whereby the device applied for is contained within the triangle which denotes that it is a hazard symbol ... Consequently, since it essentially coincides with the customary international sign to indicate a risk of high voltage, the Board deems it to be ineligible for registration as an EUTM in accordance with Article 7(1)(d) EUTMR' (paragraph 20)	R 2124/2011-5

2.4.2 Point in time of a term becoming customary

The customary character must be assessed with reference to the **filing date of the EUTM application** (judgments of 05/03/2003, T-237/01, BSS, EU:T:2003:54, § 46; 05/10/2004, C-192/03 P, BSS, EU:C:2004:587, § 39-40). Whether a term or figurative element was non-descriptive or distinctive long before that date, or when the term was first adopted, will in most cases be immaterial, since it does not necessarily prove that the sign in question had not become customary by the filing date (judgment of 05/03/2003, T-237/01, BSS, EU:T:2003:54, § 47; similarly, judgment of 21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264).

In some cases, a sign applied for may become customary **after the filing date**. Changes in the meaning of a sign that lead to a sign becoming customary after the filing date do not lead to a declaration for invalidity *ex tunc* under Article 52(1)(a) EUTMR, but can lead to a **revocation** with effect *ex nunc* under Article 51(1)(b) EUTMR. For example, the EUTM registration 'STIMULATION' was cancelled on the grounds that it had become a term customarily used in relation to energy drinks. For further information, see the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions.

2.4.3 Assessment of customary terms

Whether a mark is customary must be assessed, firstly, by reference to the goods or services in respect of which registration is sought, and, secondly, on the basis of the target public's perception of the mark (judgment of 07/06/2011, T-507/08, 16PF, EU:T:2011:253, § 53).

As regards the **link with the goods and services** in respect of which registration is sought, Article 7(1)(d) EUTMR will not apply where the mark consists of a more general laudatory term that has no particular customary link with the goods and services concerned (judgment of 04/10/2001, C-517/99, Bravo, EU:C:2001:510, § 27, 31).

As regards the **relevant public**, the customary character must be assessed by taking account of the expectations that the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (judgment of 16/03/2006, T-322/03, Weisse Seiten, EU:T:2006:87, § 50). The Court has clarified a number of issues in this respect:

- The relevant public to be taken into account in determining the sign's customary character comprises not only all consumers and end users but also, depending on the features of the market concerned, **all those in the trade who deal with that product commercially** (judgments of 29/04/2004, C-371/02, Bostongurka, EU:C:2004:275, § 26; 06/03/2014, C-409/12, Kornspitz, EU:C:2014:130, § 27).

- Where the trade mark targets both **professionals and non-professionals** (such as intermediaries and end users), it is sufficient for a sign to be refused or revoked if it is perceived to be a usual designation by any one sector of the relevant public, notwithstanding the fact that another sector may recognise the sign as a badge of origin (judgment of 06/03/2014, C-409/12, Kornspitz, EU:C:2014:130, § 23-26).

- The General Court has held that Article 7(1)(d) EUTMR is not applicable when the sign's use in the market is by **one sole trader** (other than the EUTM applicant) (judgment of 07/06/2011, T-507/08, 16PF, EU:T:2011:253). In other words, a mark will not be regarded as customary purely for the simple reason that a competitor of the EUTM applicant also uses the sign in question. For customary character to be demonstrated, it is necessary for the examiner to provide evidence (which will generally come from the internet) that the relevant consumer has been exposed to the mark in a non-trade mark context and that, as a result, they recognise its customary significance vis-à-vis the goods and services claimed.

2.4.4 Applicability of Article 7(1)(d) EUTMR in relation to plant variety names

The issue of generic character may arise in the context of the examination of trade marks that consist exclusively of the name of a plant variety that is **not simultaneously registered** by the Community Plant Variety Office in accordance with Regulation No 2100/94 or registered in accordance with national law or international agreements to which the Union or the Member State concerned is a party. In the latter case, the mark would be objectionable under Article 7(1)(m) EUTMR.

Therefore, if the evidence available shows that a given plant variety name has become customary in the European Union as the generic denomination of the variety in question, then the examiners — in addition to objecting to the trade mark applied for under Article 7(1)(c) and (b) EUTMR on the ground that the trade mark applied for is descriptive — should also object under Article 7(1)(d) EUTMR on the additional ground that the trade mark consists exclusively of a term that has become generic in the relevant field of trade in the European Union. See paragraphs 2.3.2.10 and 2.6.1.2, Plant variety names.

2.5 Shapes or other characteristics with an essentially technical function, substantial value or resulting from the nature of the goods (Article 7(1)(e) EUTMR)

2.5.1 General remarks

Article 7(1)(e) EUTMR excludes from registration signs that consist exclusively of (i) the shape or other characteristic that results from the nature of the goods themselves; (ii) the shape or other characteristic of goods that is necessary to obtain a technical result; or (iii) the shape or other characteristic of the goods that gives substantial value to the goods.

The wording of this provision infers that it does not apply to signs for which registration is sought in respect of services.

Regulation No 2015/2424 amending Regulation No 207/2009 of the Community trade mark introduced the reference to 'another characteristic' of the goods. To the Office's understanding, most of the trade marks that fall foul the new wording of this provision are currently objectionable under Article 7(1)(b) and/or (c) EUTMR, as they are descriptive or otherwise non-distinctive. However, an important practical difference lies in the fact that an objection under Article 7(1)(e) EUTMR cannot be overcome by invoking Article 7(3) EUTMR.

Importantly, unlike in the situation covered by Article 7(1)(b) EUTMR, the **average consumer's perception is not a decisive element** when applying the ground for refusal under Article 7(1)(e) EUTMR, but, **at most**, may be a relevant criterion for assessment by the Office when the latter identifies the sign's essential characteristics (judgment of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 34).

For these reasons, **an objection under Article 7(1)(e) EUTMR** to marks consisting of shapes or other characteristics that follow from the nature of the goods, shapes or other characteristics that are necessary to obtain a technical result or shapes or other characteristics giving substantial value to the goods **cannot be overcome** by demonstrating that they have **acquired distinctive character**. In other words, Article 7(3) EUTMR is not applicable to such shapes or other characteristics, regardless of whether that particular shape or other characteristic might actually be distinctive in the marketplace.

It is therefore advisable to **undertake a prior examination of the sign under Article 7(1)(e) EUTMR where several of the absolute grounds for refusal provided for in Article 7(1) EUTMR may apply** (judgment of 6/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 44).

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, including Article 7(1)(e) EUTMR, as soon as possible and preferably all at once, even if an objection under Article 7(1)(e) EUTMR based on the facts in question is less evident than, for instance, an objection for a lack of distinctiveness under Article 7(1)(b) EUTMR.

It may also be the case that following an initial objection under Article 7(1)(b) and/or (c) EUTMR, the evidence submitted by the applicant shows that the sign consists exclusively of a shape or other characteristic as listed in Article 7(1)(e) EUTMR. In these cases, a further objection under Article 7(1)(e) should be raised as well.

Article 7(1)(e) EUTMR does not define the category of mark that must be considered as a shape within the meaning of that provision. **It makes no distinction between 2D or 3D shapes, or 2D representations of 3D shapes**. Therefore, the applicability of Article 7(1)(e) EUTMR is not confined to 3D shapes but also applies to other categories of marks such as figurative signs representing shapes (judgment of 06/03/2014, C-337/12, Surface covered with circles, EU:C:2014:129, § 55).

The **objective** pursued by Article 7(1)(e) EUTMR is the same for all of its three grounds, namely to prevent the exclusive and permanent rights that a trade mark confers from serving to extend the life of other rights indefinitely, such as patents or designs, which the EU legislature has sought to make subject to limited periods (judgments of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 19-20; 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 43; 06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 65).

A sign consists '**exclusively**' of the shape of goods or other characteristics when all its essential characteristics — that is to say, its most important elements — result from the nature of the goods (Article 7(1)(e)(i) EUTMR), perform a technical function (Article 7(1)(e)(ii) EUTMR) or give substantial value to the goods (Article 7(1)(e)(iii) EUTMR). The presence of one or more minor arbitrary elements, therefore, will not alter the conclusion (judgments of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 21-22; and 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 51-52). However, an objection under Article 7(1)(e) EUTMR would not be justified if the sign applied for were to consist of a shape or other characteristic combined with additional, distinctive matter (whether word and/or figurative elements) as the sign in its entirety would then not consist exclusively of a shape or other characteristic (see paragraph 2.2.12.3, Step 3 above).

The correct application of Article 7(1)(e) EUTMR requires that **the essential characteristics of the sign at issue be properly identified**, and that the assessment may be based either on the overall impression that it produces or an examination of each of its components (judgments of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 21; 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 70).

This identification may, depending on the case and particularly in view of its degree of difficulty, be carried out by means of a simple visual analysis of the sign or, on the other hand, be based on a detailed examination in which relevant assessment criteria may be taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously for the goods concerned such as patents (judgment of 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 71, 85).

Once the sign's essential characteristics have been identified, it will have to be established **whether they all fall under the respective ground set out in Article 7(1)(e) EUTMR** (judgment of 14/09/2010, C-48/09 P, Lego brick, § 72). In this respect, each of the three grounds must be applied independently of the others. In addition, where none of those grounds is fully applicable for the entire shape or other characteristic, they do not preclude registration of the sign (judgment of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 39, 42). Therefore, if parts of the shape or other characteristic are necessary to obtain a technical result within the meaning of Article 7(1)(e)(ii) EUTMR, for instance, and the remaining parts merely give substantial value to the goods under Article 7(1)(iii) EUTMR, neither of these two provisions bars the registration of the shape or other characteristic as a sign.

2.5.2 Shape or other characteristic that results from the nature of the goods

Under Article 7(1)(e)(i) EUTMR, signs that consist exclusively of the shape or other characteristic that results from the nature of the goods themselves cannot be registered.

This ground of refusal will apply when the sign, whether 2D or 3D, consists exclusively of the only natural shape or other characteristic possible for the goods: for example, the realistic representation below of a banana for bananas:

Furthermore, the application of Article 7(1)(e)(i) EUTMR cannot be limited to apply only to signs that consist exclusively of shapes or to other characteristics that are indispensable to the function of the goods in question. Apart from '**natural' products** (which have no substitute) and **'regulated' products** (the shape or other characteristic of which is prescribed by legal standards), all shapes or other characteristics that are **inherent to the generic function or functions** of such goods must, in principle, also be denied registration (judgment of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 23-25).

The Court of Justice has not given any further guidance about exactly when a shape or other characteristic is inherent to the generic function(s) of goods. In the absence of any case-law in this respect, the examples given by the Advocate General may be referred to: legs with a horizontal level for a table; an orthopaedic-shaped sole with a V-shaped strap for flip-flops (opinion of 14/05/2014, C-205/13, § 59). Even considering that the opinion of the Advocate General is not binding, it can give useful guidance.

There is no practice yet on cases where a trade mark consists of 'other characteristics' that result from the nature of the goods. As an invented example, a sound mark representing the sound of a motorbike for *motorbikes* could be captured by Article 7(1)(e)(i) EUTMR if the sound results from the nature of the goods (in the sense of its technical performance).

In all cases where the EUTM applied for consists exclusively of the shape or other characteristic of the goods that follows from their nature, an objection may additionally be raised under Article 7(1)(b) and/or (c) EUTMR, on the ground that the shape or other characteristic in question lacks distinctive character and/or is descriptive of the nature of the goods.

2.5.3 Shape or other characteristic of goods necessary to obtain a technical result

Article 7(1)(e)(ii) EUTMR excludes from registration signs that consist exclusively of the shape or other characteristic of goods that is necessary to obtain a technical result.

The Courts have not yet ruled on the interpretation of 'another characteristic' of the goods. However, the Court of Justice has rendered two leading judgments concerning

the subject of essentially functional shapes, which provide guidance concerning the examination of trade marks consisting exclusively of functional shapes or other characteristics of the goods (preliminary ruling of 18/06/2002, C-299/99, Remington, EU:C:2002:377, and judgment of 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516), interpreting, inter alia, Article 3(1) TMD, which is the equivalent of Article 7(1) EUTMR.

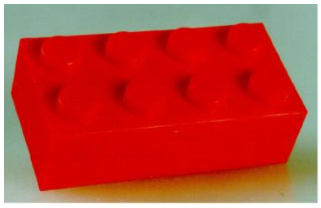
A sign consists 'exclusively' of the shape of goods that is necessary to obtain a technical result when **all the essential characteristics of a shape perform a technical function**, the presence of non-essential characteristics with no technical function being irrelevant in that context (judgment of 14/09/2010, C-48/09 P, Lego brick, § 51). The fact that there may be **alternative shapes** , with other dimensions or another design, capable of achieving the same technical result does not in itself preclude the application of this provision (judgment of 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 53-58).

In assessing an EUTM application against Article 7(1)(e)(ii) EUTMR, consideration should be given to the meaning of the **expression 'technical result'**. This expression should be interpreted broadly and includes shapes or other characteristics that, for example:

- fit with another article;
- give the most strength;
- use the least material;
- facilitate convenient storage or transportation.

Other characteristics of the goods that are necessary to obtain a technical result may include particular sounds. For instance, as an invented example, a sound mark for insect repellents may be objected to under Article 7(1)(e)(ii) EUTMR if the sound in fact repels insects.

In the 'Red Lego Brick' case, following a cancellation action, two instances of the Office declared the 3D shape of a building block in a construction toy set as invalid:

Sign	EUTM No	Goods and services
	EUTM No 107 029 R 856/2004 G T-270/06 C-48/09 P	Class 28 (construction toys)

In particular, the Grand Board held that the various features of the 'Red Lego brick' all performed particular technical functions, namely (i) *the bosses [studs]*: height and diameter for clutch power; number for fixing versatility; layout for fixing arrangement; (ii) *the secondary projections:* clutch-power; the number for best clutch-power in all positions; the thickness of the wall to act as a spring; (iii) *the sides:* connected with sides of other bricks to produce a wall; (iv) *the hollow skirt:* to mesh with the bosses and to enable fixing for clutch power and (v) *the overall shape:* brick shape for building; size for children to hold (decision of 10/07/2006, R 0856/2004-G, § 54).

The General Court dismissed the appeal against the above decision and confirmed the findings of the Grand Board, holding that the latter had correctly applied

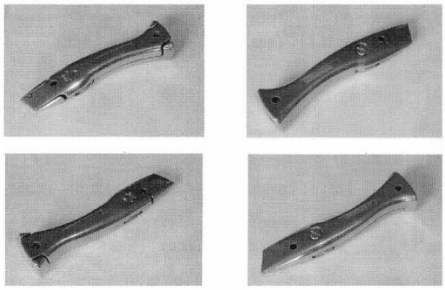
Article 7(1)(e)(ii) EUTMR (judgment of 12/11/2008, T-270/06, Lego brick, EU:T:2008:483).

Following an appeal, the Court of Justice, in its ruling of 14/09/2010, C-48/09 P, 'Lego brick', confirmed the judgment of the General Court, holding that:

> … the solution incorporated in the shape of goods examined is the technically preferable solution for the category of goods concerned. If the three-dimensional sign consisting of such a shape were registered as a trade mark, it would be difficult for the competitors of the proprietor of that mark to place on the market shapes of goods constituting a real alternative, that is to say, shapes which are not similar and which are nevertheless attractive to the consumer from a functional perspective' (para. 60).

The fact that the shape concerned is, or has been, the subject of a claim in a **registered patent or patent application** constitutes prima facie evidence that those aspects of the shape identified as being functional in the patent claim are necessary to achieve a technical result (this approach has been followed by the Boards of Appeal, for example, in their decision of 17/10/2013, R 0042/2013-1).

A case regarding the following shape for 'knives and knife handles' provides an example of how to identify the essential characteristics of a shape and how to assess if all of those characteristics perform a technical function:

Sign	Case
	Judgment of 19/09/2012, T-164/11, 'Shape of knife handles'

In this case, the shape applied for was described as

> ... a slightly curved knife handle characterised by a small angle of 5 to 10 degrees between the knife blade and the longitudinal axis of the shell grip, which has a middle section with a somewhat rounded outer cross section, which broadens towards a tapered rear end. The handle also incorporates a knurled screw in the shell of the knife.

The Court stated that

> As is apparent from that patent [relied upon by the invalidity applicant], the technical effect of the angle between the knife blade and the longitudinal axis of the mother-of-pearl handle is to facilitate cutting. The intermediate section is of particular importance for long cuts. It makes the cut more precise while allowing greater pressure to be exerted. Finally, the knurled screw allows the shell to be opened and the blades of the knife to be changed without using other tools and without hindering manipulation of the knife during use (para. 30).

and concluded that the most important elements of the sign, constituting its essential characteristics, are all exclusively functional (para. 33).

2.5.4 Shape or other characteristic that gives substantial value to the goods

Under Article 7(1)(e)(iii) EUTMR, signs that consist exclusively of the shape or other characteristic that gives substantial value to the goods cannot be registered, or if registered they are liable to be declared invalid.

Whereas the same shape or other characteristic can, in principle, be protected both as a design and as a trade mark, Article 7(1)(e)(iii) EUTMR only refuses trade mark protection for shapes or other characteristics in certain specific cases, namely, when the sign consists exclusively of a shape or other characteristic that gives substantial value to the product.

The **concept of 'value'** should be interpreted not only in commercial (economic) terms, but also in terms of 'attractiveness', that is to say, the likelihood that the goods will be purchased **primarily because of** their particular shape or of another particular characteristic. When other characteristics may give the product significant value in addition to this aesthetic value, such as functional value (for instance safety, comfort and reliability), Article 7(1)(e)(iii) EUTMR cannot be ruled out automatically. Indeed, the concept of 'value' cannot be limited purely to the shape or other characteristic of products having only artistic or ornamental value (judgment of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 29-32).

The concept of 'value' should not be interpreted as meaning '**reputation'**, since application of this absolute ground for refusal is justified exclusively by the effect on the value added to the goods **by the shape** or other characteristic and not by other factors, such as the reputation of the word mark that is also used to identify the goods in question (see in this regard, decision of 16/01/2013, R 2520/2011-5, § 19).

Furthermore, the fact that the shape or other characteristic may be **pleasing or attractive** is not sufficient to exclude it from registration. If that were the case, it would be virtually impossible to imagine any trade mark of a shape or other characteristic, given that in modern business there is no product of industrial utility that has not been the subject of study, research and industrial design before its eventual launch on the market (decision of 03/05/2000, R 0395/1999-3, Gancino quadrato singolo, § 1-2 and 22-36).

In assessing the value of the goods, account may be taken of **criteria** such as the nature of the category of goods concerned, the artistic value of the shape or other characteristic in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference compared with similar products, and the development of a promotion strategy that focuses on accentuating the aesthetic characteristics of the product in question (judgment of 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 35).

For the examination of these trade marks, a **case-by-case approach is necessary**. In most of these cases a proper examination will only be possible where there is evidence that the aesthetic value of the shape or other characteristic can, in its own right, determine the commercial value of the product and the consumer's choice to a large extent.

If a shape or other characteristic derives its appeal from the fame of its designers and/or marketing efforts rather than from the aesthetic value of the shape or other characteristic itself, Article 7(1)(e)(iii) EUTMR will not apply (decision of 14/12/2010, R 0486/2010-2, SHAPE OF CHAIR, § 20-21).

A leading case when it comes to shapes bestowing substantial value on the goods concerns the three-dimensional representation below of a loudspeaker.

Sign	Case	Goods
	Decision of 10/09/2008, R 0497/2005-1 Judgment of 06/10/2011, T-508/08 'Representation of a loudspeaker'	Apart from loudspeakers, other apparatus for the reception, processing, reproduction, regulation or distribution of sound signals in Class 9 as well as music furniture in Class 20.

The General Court confirmed the Board of Appeal's finding that the sign at issue fell within the scope of Article 7(1)(e)(iii) EUTMR (judgment of 06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575).

The General Court held that for goods such as those listed above, the design was an element that would be very important in the consumer's choice even if the consumer took other characteristics of the goods at issue into account. After having stated that the shape for which registration was sought revealed a very specific design and that it was an essential element of the applicant's branding, which increased the appeal of the product and, therefore, its value, the General Court also noted that it was apparent from the evidence on record, namely extracts from the distributors' websites and online auction or second-hand websites, that the aesthetic characteristics of that shape were emphasised first and that the shape was perceived as a kind of pure, slender, timeless sculpture for music reproduction, which made it an important selling point (judgment of 06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 75). The General Court thus concluded that, independently of the other characteristics of the goods at issue, the shape for which registration was sought bestowed substantial value on the goods concerned.

It follows from the above judgment that it is important to determine whether **the aesthetic value of a shape or other characteristic can, in its own right, determine the commercial value of the product and the consumer's choice to a large extent**. It is immaterial whether the overall value of the product is also affected by other factors, if the value contributed by the shape or other characteristic itself is substantial.

2.6 Acquired distinctiveness

2.6.1 Introduction

In accordance with 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 Articles 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, 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 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 a new significance, and its connotation, no longer purely descriptive or non-distinctive, permits it to overcome those absolute grounds for refusal of registration as a trade mark.

2.6.2 Request

The Office will only examine acquired distinctive character following a request from the EUTM applicant. This request may be filed at any time during the examination proceedings. 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).

2.6.3 The point in time

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'.

2.6.3.1 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 has been 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 and 51; and 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, to the extent that 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).

2.6.3.2 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 52(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, it was contrary to Article 7 EUTMR (judgments of 14/12/2011, T-237/10, Clasp lock, EU:T:2011:741, § 52, 53 and 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 and 38).

2.6.4 Consumer

Distinctive character of a sign, including that acquired through use must be assessed in relation to the presumed 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, RED/BLACK/GREY (Surface of a tractor), 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, RED/BLACK/GREY (Surface of a tractor), EU:T:2010:413, § 41 et seq.).

Prospective purchasers are defined by 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 the broad category.

2.6.5 Goods and Services

Since one of the main functions 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 goods as originating from a particular undertaking because of the trade mark (judgments of

04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 52; and 19/05/2009, T-211/06, Cybercrédit et al., EU:T:2009:160, § 51).

2.6.6 Territorial Aspects

Pursuant to Article 1 EUTMR, an European Union trade mark has a unitary character and has equal effect throughout the European Union. Article 7(2) EUTMR provides that a trade mark must be refused registration if an absolute ground exists only in part of the European Union.

As a logical consequence, acquired distinctiveness must be established throughout the territory in which the trade mark did not, *ab initio*, have such character (judgments of 22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 83, 86; and 29/09/2010, T-378/07, RED/BLACK/GREY (Surface of a tractor), EU:T:2010:413, § 30). Evidence from Non-EU states is irrelevant, except insofar as it might enable conclusions to be drawn about use within the EU (judgment of 24/07/2014, T-273/12, Ab in den Urlaub, EU:T:2014:568, § 45).

This is because the unitary character of the European Union trade mark requires a sign to possess distinctive character, inherent or acquired through use, throughout the European Union (judgment of 17/05/2011, T-7/10, 'υγεία', EU:T:2011:221, § 40). It would be paradoxical to accept, on the one hand, pursuant to Article 3(1)(b) TMD, that a Member State refuses to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other, that the same Member State has to respect a European Union trade mark relating to that sign for the sole reason that it has acquired distinctive character in the territory of another Member State (judgment of 14/12/2011, T-237/10, Clasp lock, EU:T:2011, § 100).

Examples:

Evidence of acquired distinctiveness of the word mark 'PHOTOS.COM' in **four Member States** (DK, FI, SE and UK) was considered **insufficient** to draw valid conclusions with regard to acquired distinctiveness in a substantial part of the territory of the European Union (judgment of 21/10/2012, T-338/11, Photos/com, EU:T:2012:614, § 49).

Evidence of acquired distinctiveness of a 'shape of two packaged goblets' relating to **eight Member States** (BE, DE, FR, IT, NL, AT, SE and UK) was considered i**nsufficient** to draw valid conclusions with regard to acquired distinctiveness in a substantial part of the European Union (decision of 26/07/2012, R 1301/2011-1, shape of goblets, § 62, application dismissed in T-474/12, on other grounds).

2.6.6.1 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.

2.6.6.2 3D marks, colours per se and figurative trade marks

If the objection exists throughout the European Union, as is normally the case for 3D marks, colours per se and figurative trade marks consisting exclusively of the depiction of the goods in question, acquired distinctiveness must be proven throughout the entire European Union (judgment of 25/09/2014, T-474/12, Shape of goblets, EU:T:2014:813, § 58). For the possibility of extrapolating the evidence, see paragraph 2.6.6.4 below.

2.6.6.3 Language area

Where the EUTM applied for is rejected with respect to its meaning in a specific language, acquired distinctiveness through use must be shown with respect to the Member States in which that language is an official language.

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 where that language is official (as well as any other Member States or markets where it will be understood).

(a) Examples of languages being official languages in more than one EU Member State

Language	Official language in the following Member States
German	Germany, Austria, Luxembourg and Belgium
Greek	Greece and Cyprus
English	United Kingdom, Ireland, Malta
French	France, Belgium, Luxembourg
Dutch	Netherlands and Belgium
Swedish	Sweden and Finland (judgment of 09/07/2014, T-520/12 Gifflar, EU:T:2014:620, upholding the decision of the Second Board of Appeal from 18/09/2012, R 0046/12-2, Gifflar)

Any claim that acquired distinctiveness through use enables the EUTM application to overcome an absolute grounds objection that is based on its meaning in any of the above languages must automatically be examined for all the countries where the language in question is an official one.

(b) Understanding of a Member State language in Member States where it is not an official language

In addition to the Member States where the language of a sign's wording is an official language, consideration must also be given to other Member States where it is not an official language but is understood. This may be because, depending on the goods and services claimed in the EUTM application, the relevant public in that Member State has an elementary understanding of the language in question, or because the relevant public consists of specialists for whom certain technical terms in another EU Member State's official language are understood. If so, then acquired distinctiveness must be proven for the relevant public in these other EU Member States as well as in the Member States where the language is an official one.

By way of example, the GC has held that a very large proportion of European consumers and professionals have an elementary knowledge of English (judgment of 26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 41). Accordingly, depending on the relevant consumer of the goods and services in question and whether the sign consists of an elementary English word or not, acquired distinctiveness may also have to be assessed with respect to further Member States.

Moving from the general public to a more specialist public for goods and services, the GC has held that certain English terms in the medical field (judgment of 29/03/2012, T-242/11, 3D eXam, EU:T:2012:179, § 26), in technical fields (judgment of 09/03/2012, T-172/10, Base-seal, EU:T:2012:119, § 54) and in financial matters (judgment of 26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 41) will be understood by the relevant professionals throughout the European Union, as English is the commonly used professional language in these areas.

On the other hand, since the understanding of languages is not strictly limited by geographical borders, it may well be that, for historical, cultural or cross-border market reasons, certain (usually elementary) vocabulary of a given language may spread and could be widely understood by the general public in other Member States, particularly those with contiguous land borders. By way of example, German and French are commonly used in the Italian regions of Trentino-Alto Adige and 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).

2.6.6.4 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 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). 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 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.

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 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 homogenous** (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. Only if all data is comparable, may the Office extrapolate the results from one territory to another.

- **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 GC 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 chequered pattern (maroon & beige), EU:T:2015:215, § 101 et seq., not yet final).

Finally, 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 shown in a substantial part of the European Union and 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 must therefore not be confused with the test on acquisition of reputation (judgment of 21/04/2015, T-359/12, Device of a chequered pattern (maroon & beige), EU:T:2015:215, § 119-120 and case-law quoted therein, not yet final).

2.6.7 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 42(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.

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 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 such 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, 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 & Banco Santander, 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.

2.6.8 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 & C-109/97, Chiemsee, EU:C:1999:230, § 31; and 29/09/2010, T-378/07, 'RED/BLACK/GREY (Surface of a tractor)', § 32.

Article 78 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 & 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 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 General 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; and 16/12/2008, T-86/07, DEITECH, EU:T:2008:577, § 46 et seq.).

2.6.8.1 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, Case 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 29/1/13, 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 & Banco Santander, 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.

2.6.8.2 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 distinguishing 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 with precision 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.

2.6.8.3 Declarations, affidavits and written statements

Pursuant to Article 78(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**, it is necessary only in cases where the statements have not been sworn or affirmed 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, Case 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)

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.

2.6.8.4 Prior registrations on 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 21/5/2014, T-553/12, EU:T:2014:264, Bateaux-Mouches, EU:T:2014:264, § 72 and 73).

2.6.8.5 Other means of evidence

Other means of evidence include **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.).

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

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 21/5/2014, T-553/12, Bateaux-Mouches, EU:T:2014:264, § 66)

2.6.8.6 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.). Use of a substantially different trade mark should not be given any weight. However, in accordance with Article 15(1)(a) EUTMR, minor amendments to the sign that do not alter its distinctive character may be allowed (decisions of 15/01/2010, R 0735/2009-2, PLAYNOW; and 09/02/2010, R 1291/2009-2, EUROFLORIST).

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, '!' (fig.), EU:T:2009:374, § 43; and 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 46). 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).

2.6.8.7 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 particular 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 be immediately 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.

2.6.8.8 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 & Banco Santander, 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.

2.6.9 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.