

***GUIDELINES FOR EXAMINATION IN THE
OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET (TRADE MARKS AND
DESIGNS) ON COMMUNITY TRADE MARKS***

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

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1 General Principles

1.1 Reasoned objection

Where the examiner finds that an absolute ground for refusal exists, a reasoned objection must be issued which specifies all the individual grounds for refusal found and provides clear and distinct reasoning for each ground separately. Piecemeal objections (so-called step-by-step objections) should be avoided. In other words, each ground for refusal should have its own reasoning. In many instances some grounds for refusal overlap, e.g. distinctiveness and descriptiveness. Even in these cases, each ground of refusal must be given separate reasoning. For example, where a word mark is found to have a semantic meaning which makes it objectionable under both Articles 7(1)(b) and 7(1)(c) CTMR, the notification of grounds of refusal should deal with each of these grounds in separate paragraphs. In such a case it should be clearly indicated whether the lack of distinctiveness arises out of the same, or different, considerations from those which lead to the mark being deemed descriptive.

It suffices for the refusal of a Community trade mark that there is one of the grounds mentioned in Article 7 in only part of the European Union. However, examiners are encouraged to list at this stage all grounds for refusal which are applicable.

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. Examiners are reminded that if the rejection of the CTM applied for had to be based on new grounds for refusal or on new arguments, the party must be given the opportunity to comment thereon.

1.2 Dialogue with the applicant

During examination proceedings, the examiner should seek dialogue with the applicant.

At all stages of the proceedings, the examiner should carefully consider the observations submitted by the applicant. The examiner should equally consider, of his own motion, new facts or arguments that plead in favour of acceptance of the mark. This is because the application can only be refused if, at the point in time the decision is taken, the examiner is convinced that the objection is well founded.

Where the applicant has not submitted any observations, and provided that the examiner has not found any reasons of his own motion that might change his view, the application will be refused by a notification which will include the original objection letter(s), state that the application is hereby refused, and contain a notice on the availability of an appeal. It is not correct to limit the final decision to a refusal for 'the reasons given in the objection'.

If the applicant contests the reasons given in the original notification, the refusal should first provide the original reasoning given, and then address the arguments of the applicant. Where the examiner needs to provide new facts or arguments to sustain a refusal, the applicant must be given the opportunity of commenting on this before a final decision is taken.

Where the applicant tries to overcome the objection by restricting the list of goods and services, it is possible that the restriction raises a new ground for refusal, for example, deceptiveness in addition to descriptiveness. In this case another objection letter

should 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 which is restricted by a condition that the goods or services do not possess a particular characteristic should not be accepted (see judgment of 12/02/2004, C-363/99, 'Postkantoor', para. 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 which are worded in a positive way can usually be acceptable, such as 'books about Chemistry'.

As regards the proof of acquired distinctiveness [Article 7(3)], 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 shall send its proof of use is after the objection letter and before the final decision is taken by the examiner. In that regard, the applicant may file a request for an extension of time limits after the objection letter pursuant to Rule 71 CTMR. If the examiner wishes to accept the mark on the basis of Article 7(3), then no refusal letter should be sent. If in spite of the submitted proof of use the examiner determines that the CTMA still falls foul under Article 7(1) because the proof of use was not convincing, the refusal letter shall contain a statement on the availability of an appeal to be lodged before the Boards. It shall also contain the reasoning why the mark falls foul under any of the grounds mentioned in Article 7(1) and separate reasoning regarding why the applicant's claim of acquired distinctiveness fails.

1.3 European criteria

Article 7(1) CTMR 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) CTMR excludes an application from registration if a ground for refusal pertains in only part of the European Union.

That means that it suffices for a refusal if the trade mark is descriptive, or lacks distinctive character, in an official language in the UE. As regards other languages, a refusal will be raised if the trade mark is objectionable under Article 7(1) 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', paras 35-36).

Where the objection is not based on a semantic meaning of a word, the ground for refusal will normally pertain to the Community 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.

1.4 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.

1.4.1 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) CTMR 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) CTMR that it suffices if the mark 'may serve' to designate characteristics of the goods and services (see judgment of 23/10/2003, C-191/01, 'Doublemint', para. 33).

1.4.2 Need to keep free

Frequently it is 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) CTMR 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) (see judgment of 04/05/1999, C-108/97, 'Chiemsee', para. 35; judgment of 12/02/2004, C-363/99, 'Postkantoor', para. 61).

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

1.4.3 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) CTMR. However, in this case the applicant will be more likely to succeed on acquired distinctiveness.

1.4.4 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) CTMR if at least one of the possible meanings of the term is descriptive in relation to the relevant goods and services (see judgment of 23/10/2003, C-191/01, 'Doublemint', para. 32; confirmed by judgment of 12/02/2004, C-363/99, 'Postkantoor', para. 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 applied for trade mark (which are unrelated to the goods/services concerned) are irrelevant. Equally, when the applied for trade mark 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 (see judgment of 08/06/2005, T-315/03, 'Rockbass', para 56).

1.5 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 examiner must specifically state which ground (or grounds) for refusal apply to the mark in question, in relation to each claimed good or service. 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 which have a sufficiently direct and specific link to each other (judgment of 02/04/2009, T-118/06, 'ULTIMATE FIGHTING CHAMPIONSHIP', para. 28). Where the same ground or grounds for refusal is 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, 'Kitchen company', para. 38).

As regards descriptiveness, an objection applies not only to those goods/services for which the term/s making up the applied for trade mark is/are directly descriptive, but also to the broad category which contains (potentially at least) an identifiable subcategory or specific goods/services for which the applied for mark 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 (see judgment of 07/06/2001, T-359/99, 'Eurohealth', para. 33).

An objection also arises for those goods and services which are directly linked to those for which the descriptive meaning pertains. Furthermore, if the descriptive meaning arises for 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', 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 CTM is found to be descriptive of the main goods, logically it is also descriptive of the auxiliary goods which are so closely related.

1.6 Timing of objection

Objections should be raised as early and as completely as possible. However, in rare cases the Office will reopen *ex officio* the examination procedure if the mark had been clearly accepted by mistake or if according to new case-law the same conclusions apply to a mark that had been previously accepted (judgment of 08/07/2004, T 289/02, 'Telepharmacy Solutions'). In the case of CTM applications, this can happen at any time before registration, i.e. even after publication. In the case of international registrations designating the EU, this can happen as long as the opposition period (six months after republication) has not started (Rule 112(5) CTMIR) and any interim status declaration previously sent would be revoked. The Office can also reopen the examination procedure as a result of third party observations (Article 40 CTMR).

1.7 Disclaimers

Article 37(2) CTMR allows for the possibility of the examiner requesting, as a condition of registration, that an element of a mark which is not distinctive should be disclaimed. In practice examiners will not generally make recourse to this provision. Provided a mark is judged to be neither exclusively descriptive nor devoid of distinctive character it will generally be accepted without a disclaimer. 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', the individual elements within it would not need to be disclaimed.

If the applicant's disclaimer does not overcome the ground for refusing registration or the applicant does not agree to the condition, then 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 should stay even if the examiner does not consider it necessary. **Disclaimers of distinctive elements must be refused by the examiner** since they would result in a trade mark with an unclear scope of protection.

1.8 Relationship between the various grounds of refusal

An objection and any subsequent refusal shall include all grounds for refusal which are pertinent. Each ground for refusal should be reasoned separately. In particular, to avoid confusion as to whether a refusal was based on Article 7(1)(b) CTMR, Article 7(1)(c) CTMR or both, each of those grounds for refusal should receive a separate heading. If the applicant amends the list of goods and services in such a way that a new ground for refusal becomes relevant, the said ground should be raised. This may occur, for example, where the applicant restricts the list of claimed goods and services in such a way that the mark becomes misleading. 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', para. 28).

The following paragraphs of this Guideline will address each individual subsection of Article 7(1) CTMR in alphabetical order beginning with 7(1)(a) CTMR and ending with 7(1)(k). This is followed by a paragraph regarding acquired distinctiveness under Article 7(3) CTMR, and a final paragraph covering collective marks.

2 Absolute Grounds (Article 7 CTMR)

2.1 Article 7(1)(a) CTMR

2.1.1 General remarks

Article 7(1)(a) CTMR reflects OHIM's obligation to refuse signs that do not conform to the requirements of Article 4 CTMR. According to Article 4 CTMR, a Community 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. It follows that, to be capable of constituting a trade mark for the purposes of Article 4 CTMR, 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, and (c) 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', para. 28).

a) Sign

According to Article 4 CTMR 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. Therefore, the subject matter is not limited to signs that can be perceived visually.

On the other hand, in order not to deprive Article 4 CTMR of any substance, this provision cannot be interpreted so broadly as to allow any non-specific subject-matter to 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 (T-7/09, 'Spannfutter', para. 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 a 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', paras 35, 37).

b) Graphic representation

A sign that is not capable of being represented graphically will be barred from registration as a Community trade mark under Article 7(1)(a) CTMR.

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 CTMR, 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 (judgment of 12/12/2002, C-273/00, 'Sieckmann', paras 46-55, and judgment of 06/05/2003, 'Libertel', C-104/01, paras 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.

c) Distinguishing character

Article 4 CTMR refers to the **abstract** capacity of a sign to distinguish the goods of one undertaking from those of another. Unlike Article 7(1)(b) CTMR, which concerns the actual distinctive character of a trade mark with regard to specific goods or services, Article 4 CTMR is merely concerned with the theoretical 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. In practice, a sign that does not even possess abstract distinguishing character will already be objected to during the formalities examination and will not proceed to be examined in terms of substance under Article 7(1)(a) CTMR.

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

The list of examples given below is not exhaustive. Further examples and guidance on registrability under Article 4 CTMR can be found in the Guidelines, Part B, Section 2, Examination of Formalities, Chapter 9.4 – 9.8: Mark Type)

2.1.2.1 Smell / olfactory marks

There is currently no means of graphically representing smells in a satisfactory way. As regards a chemical formula, few people would recognise the odour in question in such a formula. Moreover, a deposit of an odour sample would not constitute a graphic representation for the purposes of Article 4 CTMR, as an odour sample is not sufficiently stable or durable. In other words, 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 (see judgment of 12/12/2002, C-273/00, 'Sieckmann', paras 69-73).

At the present time, there is no generally accepted international classification of smells which 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, 'Smell of ripe strawberries', para. 34). Although, as follows from 'Sieckmann', a description cannot graphically represent olfactory signs which are capable of being described in many different ways, it cannot however be ruled out that in the future an olfactory sign might possibly be the subject of a representation which satisfies all the requirements laid down by Article 4 CTMR, as interpreted by the case-law (judgment of 27/10/2005, T-305/04, 'Smell of ripe strawberries', para. 28).



In the above cited case neither the graphic representation (of a red strawberry) nor the description in words ('smell of ripe strawberries') were considered to satisfy the requirements set. 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 which 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 2.1.2.1 are applicable in a similar way for taste marks (see decision of 04/08/2003, R 120/2001-2 – 'The taste of artificial strawberry flavour').

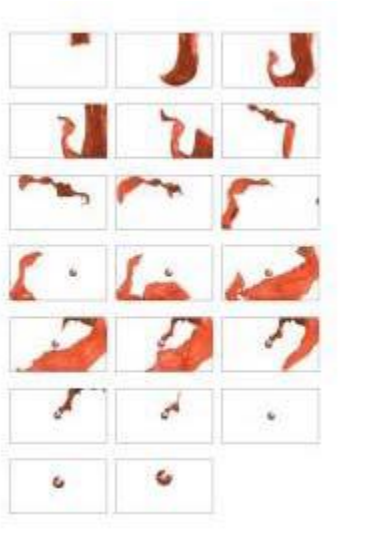
2.1.2.3 Sound marks

If a sound mark consists of music, the Office will accept traditional musical notation as a graphic representation of the sound applied for (in accordance with the criteria of the judgement of 27/11/2003, C-283/01, 'Shield Mark'). Where the mark consists of a non-musical sound, a mere description of the sound in words is not sufficient (R 708/2006-4, 'TARZAN YELL'). In such cases, a graphic representation consisting of an oscillogram or sonogram will be acceptable provided that it is accompanied by a corresponding sound file submitted via e-filing (see decision of the President EX-05-3 of 10/10/2005).

Examples of acceptable sound marks	
<p>CTM 9 199 134</p> <p>Sonograph that was accompanied by a sound file</p>	
<p>CTM 1 637 859</p> <p>Musical notation</p>	

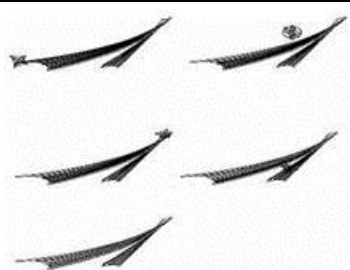
2.1.2.4 Movement marks

Movement marks must also comply with the requirements with respect to graphic representation. The mark's representation must be accompanied by a description clearly explaining the movement for which protection is sought. In its decision of 23/09/2010, R 443/2010-2 – 'RED LIQUID FLOWING IN SEQUENCE OF STILLS (MOVEMENT MARK)', the Second Board of Appeal stated that in cases where a sign is defined by both a graphic representation and a textual description, in order for the representation to be, inter alia, clear, precise, intelligible, and objective, the description must coincide with what can be seen in the graphic representation. In the present case, the examiner was of the opinion that the stills provided in the representation, in conjunction with the description, did not clearly indicate the movement, particularly as it was not sufficiently clear how the movement progressed between the different stills:



The Second Board, however, considered in this regard that the graphic representation and the verbal description of the sign are perfectly compatible and complementary. The applicant had supplied a sufficient number of stills to clearly represent the flow of the movement, together with a precise and detailed textual description of the progression, thus leaving no doubt as to the concept of the movement mark. According to the criteria established by the Second Board, a movement mark may only be refused registration under 7(1)(a) CTMR when a ‘reasonably observant person has to make particularly high intellectual efforts to perceive what the movement mark is’.

No limit has been set up and the number of stills depends on the movement concerned as long as they fulfil the formalities requirements. As for the description of the mark, its content has to be accurate and adapted to the consistency and complexity of the movement to properly and efficiently describe the sign.

Example of acceptable movement mark	
<p>CTM 5 338 629</p> <p><u>Description:</u> The mark is an animated sequence with two flared segments that join in the upper right portion of the mark. During the animation sequence, a geometric object moves up adjacent to the first segment and then down adjacent to the second segment, while individual chords within each segment turn from dark to light. Stippling down in the mark is for shading only. The entire animated sequence has a duration of between one and two seconds.</p>	 <p><u>Representations:</u> Mark representation in black and white and shades of grey only; no colour indication.</p>

2.1.2.5 Formless and shapeless combination of two or more colours ‘in any manifestation’

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’).

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 Guidelines for Examination in the Office, Part B, Examination.

qualities of precision and uniformity required by Article 4 CTMR (judgment of 24/06/2004, ‘Colours blue and yellow’, C-49/02, para. 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. Accordingly, a graphic representation consisting of two or more colours, designated in the abstract and without contours must be systematically arranged by associating the colours concerned in a predetermined and uniform way (judgment of 14/06/2012, T-293/10, ‘Colour per se’, para. 50)

2.1.2.6 Ambiguous and contradictory descriptions incoherent with the nature of the sign

A description which is ambiguous and contradictory is not acceptable. Furthermore, the description must be coherent with the nature of the sign. In its judgment of 14/06/2012, T-293/10, ‘SEVEN SQUARES OF DIFFERENT COLOURS’, the General Court considered that the mark’s 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.’) was too difficult to understand:



A sign so defined is not a colour mark per se but a three-dimensional mark, or figurative mark, which 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 in any event have contained an inherent contradiction in so far as concerns the true nature of the sign (paras 64 and 66).

2.1.3 Relationship with other CTMR provisions

When the mark is objectionable under Article 7(1)(a) CTMR, no further examination of the mark under the remaining possible grounds for refusal, such as 7(1)(b) or 7(1)(c) CTMR is necessary.

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

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

2.2.1 General remarks

According to settled case-law, the distinctiveness of a mark within the meaning of Article 7(1)(b) CTMR 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 (judgment of 29/04/2001, joined cases C-468/01 P to C-472/01 P, para. 32; judgment of 21/10/2004, C-64/02 P, para. 42; judgment of 08/05/2008, C-304/06 P, para. 66; and Audi v OHIM, para. 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 (judgment of 29/04/2001, joined cases C-468/01 P to C-472/01 P, para. 33; judgment of 08/05/2008, C-304/06 P, para. 67; and Audi v OHIM, para. 34) (judgment of 14/06/2012, T-293/10, 'Colour per se', judgment of 12/07/2012, C-311/11 P, 'Wir machen das Besondere einfach', paras 23).

Although it is commonly accepted that a minimum degree of distinctiveness suffices, it must also be taken into account that in order to be distinctive as a Community trade mark, the mark must be distinctive with regard to the European Union as a whole.

According to the case-law of the European Courts, a word mark which is descriptive of characteristics of goods or services for the purposes of Article 7(1)(c) CTMR 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) CTMR (see judgment of 12/06/2007, T-190/05, 'TWIST & POUR', para. 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) CTMR would not apply, it would still be objectionable under Article 7(1)(b) CTMR 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', para. 22).

An objection under Article 7(1)(b) CTMR 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', paras 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 under 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' (judgment of 24/04/2012, T-328/11, 'EcoPerfect', para. 25 and judgment of 15/01/2013, T-625/11, 'ecoDoor' para. 21);

- **MEDI** as referring to 'medical' (judgment of 12/07/2012, T-470/09, 'medi');
- **MULTI** as referring to 'much, many, more than one' (decision of 21/07/1999, R 99/1999-1 – 'MULTI 2 'n 1'; decision of 17/11/2005, R 904/2004-2 – 'MULTI');
- **MINI** as denoting 'very small' or 'tiny' (decision of 17/12/1999, R 62/1999-2 – 'MINIRISC');
- **Premium/PREMIUM** as referring to 'best quality' (judgment of 22/05/2012, T-60/11, paras 46-49, 56 and 58; and judgment of 17/01/2013, joined cases T-582/11 and T-583/11, 'PREMIUM L', 'PREMIUM XL', para. 26)
- **PLUS**, as denoting 'additional, extra, of superior quality, excellent of its kind'. (decision of 15/12/1999, R 329/1999-1 – 'PLATINUM PLUS');
- **ULTRA**¹ as denoting 'extremely' (decision of 09/12/2002, R 333/2002-1 – 'ULTRAFLEX')
- **UNIVERSAL** as referring to goods which fit for general or universal use (judgment of 02/05/2012, T-435/11, 'UniversalPHOLED', paras 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', para. 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 on-line, 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 cannot add to the distinctiveness of a sign.

Likewise, terms designating that the goods and services are rendered by a **group of people** are unregistrable, such as 'company, people' (for establishments) 'Club'. For example, 'Kitchen Company' is unregistrable for kitchens. This is different if the sign as a whole does not merely refer to the goods and services in the abstract but creates the overall impression of a distinct, identifiable entity. Examples: 'Royal Society for the Prevention of Cruelty to Animals', 'International Trade Mark Association' would all be registrable.

Names of individual persons are distinctive, irrespective of the frequency of the name and even in the case of the most common surnames names such as Smith or García. Refer to judgment of 16/09/2004, C-404/02, 'Nichols', paras 26 and 30. The same is true for names of prominent persons, including heads of states.

¹ Amended on 23/06/2010

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) in relation to goods and services which 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.

For example 'Peter Pan' or 'Cinderella' or 'The Iliad' are perfectly capable of being distinctive trade marks for (e.g.) paint, clothing or pencils. However, they are incapable of performing a distinctive role in relation to (e.g.) books or films 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 matters, 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 advertisement or promotional material for the services.

2.2.4.1 Single colours

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'). 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 that the applicant demonstrates 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 sectors 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, 'Shade of orange' paras 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 (what you see is what you get). 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 (judgment of 24/06/2004, C-49/02 'Blue and yellow', para. 33 and judgment of 14/06/2012, T-293/10, 'Colour per se', para. 50).

For example, a mark comprising a small yellow stripe on top of red is different from red and yellow presented in even proportion, red being on the left side. An abstract claim, in particular as to two colours 'in any possible combination' or 'in any proportion', is not allowable and leads to an objection under Article 7(1)(a) CTMR (decision of 27/07/2004, R 730/2001-4 – 'GELB/BLAU/ROT', para. 34). This must be distinguished from the indication on how the colour combination would appear on the product, which is not required because what matters 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 shall be accepted. If one of the two colours is either the commonplace colour for the product or is the natural colour of the product, i.e. a colour is added to the usual or natural colour of the product, an objection applies in the same way as if there was only one colour. Examples: 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 in fact is to be judged as a case which 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 show 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 the 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, 'GREY-RED'). 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 to memorise a high number of different colours and their sequence.

For the names of colours see paragraph 2.3.2.9.

2.2.5 Single letters²

2.2.5.1 General considerations

In its judgment of 09/09/2010, C-265/09 P (α), 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 CTMR, letters are among the categories of signs of which a Community 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 part of the applicant.

Although acknowledging that it is legitimate to take into account the difficulties in establishing distinctiveness which 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).

² This part deals with single letters under Article 7(1)(b). For single letters under Article 7(1)(c), see Point 2.3.2.8

As to the burden of proof, the Court stated that when examining absolute grounds for refusal, the Office is required under Article 76(1) CTMR to examine, of its own motion, the relevant facts which might lead it to raise an objection under Article 7(1) CTMR and that that requirement cannot be made relative or reversed, to the detriment of the CTM applicant (paras 55-58). Therefore, it is for the Office to explain, with a 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 of 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 trademarks).

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 a careful examination of whether a given letter can be considered inherently distinctive having regard to 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 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) CTMR 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, of a trade mark consisting of the single letter 'C' for 'fruit juices', as this letter is commonly used to designate the 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, 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 consumers are more used, when it comes to toy cubes and lotteries, to seeing single letters as having either a functional or a utilitarian connotation, rather than as indicators of commercial origin.

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

W

For example, the letter **W** 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 (see decision of 30/09/2010, R 1008/2010-2, paras 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' and case-law cited).

Advertising slogans are objectionable under Article 7(1)(b) CTMR when the relevant public perceives them only 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 in assessing the distinctive character of a slogan (judgments of 21/01/2010, C-398/08 P, 'VORSPRUNG DURCH TECHNIK', para. 47, and of 13/04/2011, T-523/09, 'WIR MACHEN DAS BESONDERE EINFACH', para. 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, metaphor, 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 (see, inter alia, judgment of 24/01/2008, T-88/06, 'SAFETY 1ST', para. 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 CJ, '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', para. 48).

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) CTMR.

CTM	Main function	Case No
CTM 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
<p>Objected to under Article 7(1)(b) CTMR</p> <p>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 which is a little out of the ordinary. It conveys the notion that the card has welcome features which are not obvious at first sight. The fact that the slogan leaves open what these features are, that is, that the mark does not describe a specific service or characteristic of the 'card', does not make the mark distinctive.</p>		
CTM	Main function	Case No
CTM No 7 394 414 WE PUT YOU FIRST. AND KEEP YOU AHEAD for Class 40	Customer service statement	-
<p>Objected to under Article 7(1)(b) CTMR</p> <p>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.</p>		
CTM	Main function	Case No
CTM 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
<p>Objected to under Article 7(1)(b) CTMR</p> <p>The sign is a simple and straightforward appeal to take action and contribute to the earth's wellbeing 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.</p>		

CTM	Main function	Case No
CTM No 4 885 323 DRINK WATER, NOT SUGAR for Classes 32 and 33	Inspirational or motivational statement	R 718/2007-2
<p>Objected to under Article 7(1)(b) CTMR</p> <p>The mark is a banal slogan, which 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.</p>		
CTM	Main function	Case No
VALORES DE FUTURO Ffor Class 41	Value statement	Judgment of 06/12/2013, T-428/12
<p>Objected to under Article 7(1)(b) CTMR</p> <p>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 to the services involved.</p>		

Some examples of accepted slogans:

- DEFINING TOMORROW, TODAY, decision of 07/02/2012, R 1264/2011-2, CTM No 9 694 431, for goods and services in Classes 9, 10, 16, 35, 41, 44 and 45.
- SITEINSIGHTS, Board of Appeal decision of 08/11/2011, R 879/2011-2, CTM No 9 284 597, for goods and services in Classes 9 and 42.
- THE PHYSICIAN DRIVEN IMAGING SOLUTION, IR No W 01 096 100, for goods and services in Classes 9, 16 and 42.
- UNMASKING THE SOCIAL NETWORK OF FRAUD, CTM No 10 477 941, for goods and services in Classes 9, 36 and 45.

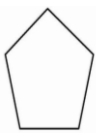


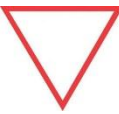

A slogan is objectionable under Article 7(1)(c) CTMR if it immediately conveys information about the kind, quality, intended purpose or other characteristics of the goods or services (see paragraph 2.3.2.5 below).

2.2.7 Simple figurative elements

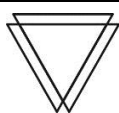
Simple geometric devices such as circles, lines, rectangles or common pentagons are unable to convey any message that can be remembered by consumers and will accordingly not be seen by them as a trade mark.

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 which the consumers can remember, with the result that they will not consider it as a trademark (see T-304/05, par. 22)

Examples of refused trade marks

Sign	G&S	Reasoning	Case
	Class 33	The sign consists merely of a usual 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'
	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'
	Classes 14, 18, 25	The sign does not contain any elements which 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, 'Representation of the half a smiley smile'
	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 which is not capable of transmitting a trade mark message prima facie.	International Registration No W01 091 415
	Class 3, 18, 24, 43, 44	The sign consists of merely a simple geometric figure and in a green colour. The specific colour is commonly and widely used in advertising and in the marketing of goods and services for their power to attract without giving any precise message.	Judgment of 09/12/2010, T-282/09, 'Green square'

Example of an accepted trade mark

Sign	G&S	Reasoning	Case
	Class 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.	CTM 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:




CTM 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 dot, coma, 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 services 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 which 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, '!').	CTM No 5 332 184

Sign	G&S	Reasoning	Case
	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 percent 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').	CTM No. 5649256

2.2.10 Pictograms

Pictograms are basic and unornamented signs and symbols which one will interpret as having purely informational or instructional value in relation to the goods or services concerned. Examples would be signs which indicate mode of use (like a picture of a telephone in relation to pizza delivery services) or which convey a universally understandable message (like a knife and fork in relation to 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, 'A hand holding a card with three triangles'
 CTM 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 which 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) CTMR.	Decision of 21/09/2012, R 2124/2011-5 – 'Device of lightning bolt'

2.2.11 Common / non-distinctive labels

The figurative element composing the sign may also consist A figurative sign may be composed of shapes, designs or figures that will be perceived by the relevant public as non-distinctive labels. Also 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
 <p>CTM No 4373403, 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))</p>	<p>The mark applied for is ‘devoid of any distinctive character’ and was refused under Article 7(1)(b) CTMR 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).</p>	<p>Decision of 22/05/2006, R 1146/2005-2</p>
 <p>CTM No 9 715 319 for goods in Classes 6, 7, 8, 9 and 20</p>	<p>The mark was refused, as its basic shape combined only with a bright colour yellow cannot, 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 of 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.</p>	<p>Decision of 15/01/2013, R 444/2012-2 – ‘Device of a label in yellow colour’</p>

In the same way, the following marks were rejected.

 <p>CTM No 11 177 912 claiming Classes 29, 30 and 31</p>	 <p>CTM No 11 171 279 claiming Classes 29, 30 and 31</p>	 <p>CTM No 10 776 599 claiming, inter alia, goods in Classes 32 and 33</p>
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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) CTMR 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, 'Ovoid tablet', para. 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, 'Maglite', para. 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 which 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 which consist of the representation of the shape of the product itself is also relevant for figurative marks consisting of 2-dimensional representations of the product or elements of it (see judgment of 14/09/2009, T-152/07, 'Representation of a watch').

For a shape which 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) CTMR analysis

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

with an essentially technical function, substantial aesthetic value or resulting from the nature of the goods.

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 which might render the trade mark a distinctive character. As a general principle, any element which on its own is distinctive will render 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 the combination of them 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.

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, 'Shape of a vibrator', paras 34-36).

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. A good example for this are frozen vegetables in the form of a crocodile

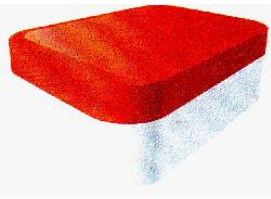

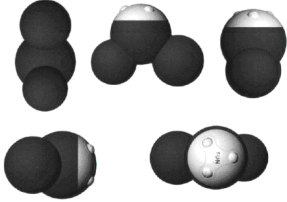

The following criteria are relevant when examining the distinctiveness of three dimensional trade marks consisting exclusively of the shape of the goods themselves:

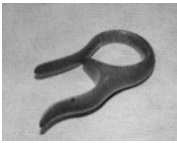

- A shape is non-distinctive if it is a basic shape (see judgment of 19/09/2001, T-30/00, 'TABS-SQUARE / RED / WHITE') or a combination of basic shapes (see decision of 13/04/2000, R 263/1999-3).
- To be distinctive, the shape must depart significantly from the shape which is expected by the consumer, 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 (see judgment of 08/04/2002, C-136/02 P, 'Maglite', para. 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 (see judgment of 08/04/2002, C-136/02 P, 'Maglite', para. 32 and judgment of 07/02/2002, T-88/00, 'Maglite', para. 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', para. 49).

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

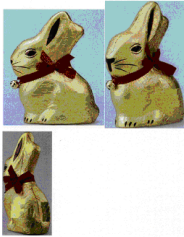

Sign	Reasoning	Case
	<p>Figurative marks showing a graphic representation of a naturalistic reproduction of the goods themselves are not distinctive in relation to such goods. The representation of a tablet for 'washing or dishwashing preparations in tablet form' was refused. The shape, namely a rectangular 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', paras 44 and 53). The same approach has been confirmed by several judgments, including the judgment of 04/10/2007, C-144/06 P, 'TABS'.</p>	<p>Judgment of 19/09/2001, T 30/00, 'TABS-SQUARE / RED / WHITE'</p>
	<p>This shape was refused as it is merely a variant of a common shape of this type of product, i.e. flashlights (para. 31).</p>	<p>Judgment of 08/04/2002, C-136/02 P, 'Maglite'</p>
	<p>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 which 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).</p>	<p>Judgment of 18/01/2013, T-137/12, 'Shape of a vibrator'.</p>
	<p>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.</p>	<p>Judgment of 06/09/2012, C-96/11 P, 'Milk mice'</p>

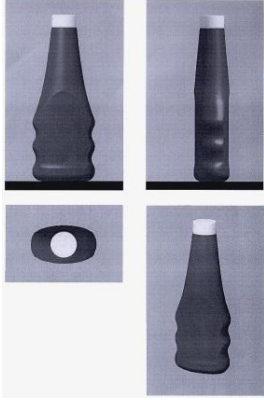
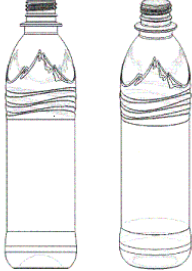
Sign	Reasoning	Case
	This three-dimensional mark consisting of a handle, applied for goods in Class 8 (hand-operated implements used in agriculture, horticulture and forestry, including secateurs, pruning shears, hedge clippers, shearers (hand instruments), was refused.	Judgment of 16/09/2009, T-391/07, 'Hand grip'
Sign	Reasoning	Case
	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 CTMA has a complex hollow on its surface, this cannot be considered as a significant difference to the shapes of confectionary available on the market.	Judgment of 12/12/2013, T-156/12 'Oval shape'

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, search must be effected in relation to containers for beverages in general; see, in that regard, the opinion of the Advocate General in C-173/04, 'Standbeutel').

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, 'Shape of a bunny made of chocolate with a red ribbon'
	The above 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 that 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, 'Sweet wrapper'

Sign	Reasoning	Case
	<p>The refusal of the applied for shape was confirmed by the General Court. The stretched neck and the flattened body do not depart from the usual shape of a bottle containing the claimed goods, namely food products including <i>juices, condiments and dairy products</i>. 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, alone it is 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).</p>	<p>Judgment of 15/03/2006, T-129/04, 'Shape of a plastic bottle'</p>
Sign	Reasoning	Case
	<p>It is a well-known fact that bottles usually contain lines and creases on it. The relief on 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.</p>	<p>Judgment of 12/12/2013, T-156/12, 'Shape of a drinking bottle'</p>

The following shapes were accepted.



BoA Decision of 04/08/1999, R 139/1999-1 – 'Granini Bottle'



Judgment of 24/11/2004, T-393/02, 'Shape of a white and transparent bottle'

The above bottle was held by the General Court to be unusual and capable of enabling the claimed goods, namely *washing agents and plastic boxes for liquid agents*, to be distinguished from the goods of a different commercial origin (para. 47). The Court

pointed out three features of the container. First, the container is particularly angular, and the angles, edges and surfaces make the container resemble a crystal. Secondly, the container gives the impression of being a single object, as the stopper of the container forms an integral part of the overall image. Lastly, the container is particularly flat, conferring on the container a particular and unusual appearance (para. 40).

2.2.13 Pattern marks

A figurative trade mark can be considered as a 'pattern' mark when it consists of a set of elements which 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., i.e. 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 though patterns may be represented in the form of squared/rectangular labels, they should nonetheless be assessed as if they cover 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, 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, 'Black, grey, beige and dark red coloured checked pattern').

With regard to services, examiners should bear in mind that pattern marks will be used in practice on letterhead 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, 'Texture of glass surface', para. 28). Indeed, in many cases the targeted public would perceive patterns as merely decorative elements.



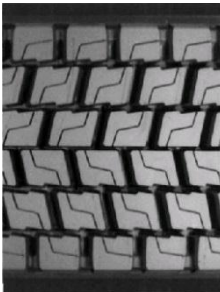
In this regard, it must be taken into account that usually the average consumer tends not to look at things analytically. A trade mark must therefore enable average consumers of the goods/services in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the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


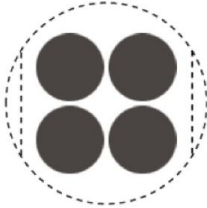
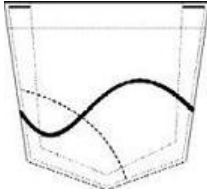
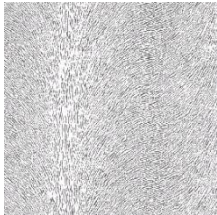
The fact that the pattern may also have other functions and/or effects is an additional argument to conclude that it lacks distinctive character. By contrast, if a pattern is

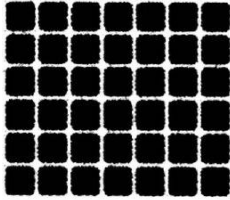
fanciful, unusual and/or arbitrary, departs from the norm or customs of the sector or is, more generally, capable of being easily memorised by the targeted consumers, it usually deserves protection as a CTM.

As seen above, the distinctive character of pattern marks must usually be assessed with regard to goods. Nevertheless, a pattern mark which has been considered devoid of distinctive character for the goods it covers must also be regarded as lacking distinctiveness for services which are closely connected to those goods. For example, a stitching pattern which 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
 <p data-bbox="240 1095 536 1173">CTM No 8 423 841, filed as a figurative mark in Classes 18, 24 and 25</p>	<p data-bbox="557 797 1091 1155">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.</p>	<p data-bbox="1118 887 1353 1077">Judgment of 19/09/2012, T-326/10, ‘Light grey, dark grey, beige, dark red and brown coloured checked pattern’, paras 47 and 48</p>
 <p data-bbox="240 1507 536 1585">CTM No 8 423 501, filed as a figurative mark in Classes 18, 24 and 25</p>	<p data-bbox="557 1368 1091 1420">In this case, similarly to the previous case, the General Court confirmed the refusal of the mark.</p>	<p data-bbox="1118 1328 1353 1462">Judgment of 19/09/2012, T-329/10, ‘Black, grey, beige and dark red coloured checked pattern’</p>
 <p data-bbox="236 1928 544 1980">CTM No 5 066 535 filed as figurative mark in Class 12 (t</p>	<p data-bbox="557 1659 1091 1935">Where the mark consists of a stylised representation of the goods or services, the relevant consumer will see <i>prima facie</i> the mere representation of a specific part of or the entire product. In this case of an application for <i>tyres</i>, 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.</p>	<p data-bbox="1118 1742 1353 1854">CTM No 5 066 535 filed as a figurative mark in Class 12 (tyres)</p>

Sign	Reasoning	Case
 <p>CTM No 9 526 261, filed as figurative mark (Series of styli)</p>	<p>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.</p>	<p>CTM No 9 526 261, filed as a figurative mark (Series of stylised V letters), claiming goods in Classes 16, 18, 25.</p>
 <p>CTM No 9 589 219, filed as a figurative mark for goods in Class 9</p>	<p>The sign, applied for '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 will be unable to perceive it as anything other than a mere decoration of the goods.</p>	<p>Decision of 09/10/2012, R 412/2012-2 – 'Device of four identically sized circles'</p>
 <p>CTM No 6 900 898, claiming goods in Classes 18 and 25</p>	<p>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 to enable a consumer to perceive it as anything other than a mere decorative element.</p>	<p>Judgment of 28/09/2010, T-388/09, paras 19-27</p>
 <p>CTM No 3 183 068, filed as a figurative mark, claiming goods in Classes 19 and 21</p>	<p>The mark, which was to be applied to glass surfaces, was refused under Article 7(1)(b) CTMR. 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 products inherent qualities being perceived simultaneously.</p>	<p>Judgment of 09/10/2002, T-36/01, 'Glass-sheet surface', paras 26-28</p>

Sign	Reasoning	Case
 <p data-bbox="233 551 544 663">CTM No 10 144 848, filed as a figurative mark claiming goods in Classes 3, 5, 6, 10, 11, 12, 16, 18, 20 and 21</p>	<p data-bbox="555 241 1093 734">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 <i>cleaning cloths</i> and <i>antiseptic wipes</i>, 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 which 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, which 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 which may catch the average consumer's attention and cause the consumer to perceive the sign as a distinctive one.</p>	<p data-bbox="1118 423 1355 562">Decision of 14/11/2012, R 2600/2011-1 – 'Device of a black and white pattern'</p>

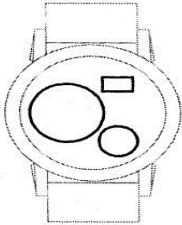
2.2.14 Position marks

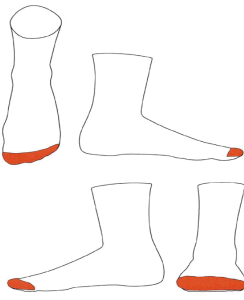
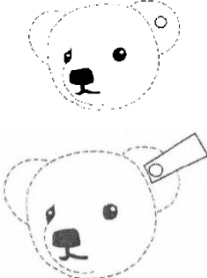
Applications for position marks effectively seek to protect a sign which consists of elements (figurative, colour, etc.) positioned on a particular part of a product and being in a particular proportion to the size of the product. The representation of the mark applied for must be accompanied by a description 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 which 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
	<p data-bbox="555 1673 1093 1946">In this case, the General Court upheld an objection under Article 7(1)(b) CTMR. 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.</p>	<p data-bbox="1118 1760 1355 1872">Judgment of 14/09/2009, T-152/07, 'Representation of a watch'</p>

Sign	Reasoning	Case
	<p>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 CTMR objection was therefore maintained.</p>	<p>Judgment of 15/06/2010, T-547/08, 'Orange colouring of the toe of a sock'</p>
	<p>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.</p>	<p>Judgments of 16/01/2014 T-433/12 and T-434/12</p>

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

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 (judgment of 20/07/2004, T-311/02, 'Limo', para. 30; judgment of 30/11/2004, T-173/03, 'Nurseryroom', para. 20), as well as concrete, direct and understood without further reflection (judgment of 26/10/2000, T-345/99, 'Trustedlink', para. 35). If a mark is descriptive, it is also non-distinctive.

Article 7(1)(c) CTMR does not apply to those terms which 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 of 31/01/2001, T-135/99, 'Cine Action', para. 29).

The public interest underlying Article 7(1)(c) CTMR is that exclusive rights should not exist for purely descriptive terms which other traders might wish to use as well. However, it is not necessary for the examiner 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 examiner 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 show 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 (see judgment of 17/09/2008, T-226/07, 'PRANAHAUS', para. 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. However, 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) CTMR (see judgment of 13/09/2012, T-72/11, 'Espetec', paras 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 (see judgment of 13/06/2012, T-534/10, 'HELLIM/HALLOUMI').

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) CTMIR).

Article 7(1)(c) 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', para. 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) CTMR

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, joined cases T-357/99 and T-358/99, 'Universaltelefonbuch') or constituent parts or components of the goods (judgment of 15/01/2013, T-0625/11, 'ecoDoor', para. 26).

Quality

This includes both laudatory terms, referring to a superior quality of the respective goods, as well as the inherent quality of the goods. 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, such as '2000' refers to the size of the motor or '75' 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 good 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'). Marks that have been refused registration on this basis include 'Therapy' for massage tools (decision of 08/09/1999, R 144/99-3 – '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'). 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' (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 that are superior in quality,

Geographical origin

See paragraph 2.3.2.6 below under Assessment of geographical terms.

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

This covers expressions concerning the time on 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) CTMR. 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 (judgment of 12/2/2004, C-363/99, 'Postkantoor', para. 102 and judgment of 24/04/2012, T-328/11, 'EcoPerfect', para. 41).

Examples of 'other characteristics'

- the subject matter contained within the claimed goods or services: (see paragraph 2.3.2.7 below under Goods and services which may contain subject matter)
- the identification of the targeted consumer: 'children' or 'ellos' (judgment of 27/02/2002, T-219/00, 'Ellos') for *clothing*.

Furthermore, a term can be objected to under Article 7(1)(c) when the characteristic indicated by the sign involves subjective assessments (for example, the word DELICIOUS for foodstuffs) or calls for further precision.

As stated by Advocate General Jacobs,

it is immediately possible to think of many other instances of general characteristics which may require further definition before the consumer can be sure of what is referred to but which none the less quite clearly remain characteristics of the product in question. To take but one example, to qualify a product as natural is undoubtedly to designate one of its characteristics, whilst leaving any consumer in

considerable doubt as to the precise nature of that characteristic, unless further details are provided. Indeed, it is relatively difficult to find indications which may serve to designate characteristics which do not call at some level for further precision (emphasis added).

(See, for example, Opinion of Advocate General Jacobs of 10/04/2003, C-191/01 P, 'Doublemint', – para. 43.)

2.3.2 Word marks

2.3.2.1 One word

Descriptive terms are those which 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 are addressed to them) or for a specialised public (irrespective whether the goods are also addressed to 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')
- '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').

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

However, it is important to distinguish laudatory terms which 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 which are laudatory in a broader sense, i.e. 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).

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 which 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', paras 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) CTMR 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)
- 'Companyline' for insurance and financial affairs (judgment of 19/09/2002, C-104/00 P)
- '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)
- '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)
- '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)
- 'Quickgripp' for hand tools, clamps and parts for tools and clamps (order of 27/05/2004, T-61/03)
- '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)
- 'CLEARWIFI' for telecommunications services, namely high-speed access to computer and communication networks (judgment of 19/11/2009, T-399/08)
- '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).
- 'GREEN CARBON' for reclaimed rubber, namely, recycled carbonaceous materials, namely plastic, elastomeric, or rubber filled materials obtained from pyrolyzed tire char and plastic, elastomeric, or rubber compounds formulated using such filler material (judgment of 11/04/2013, T-294/10).

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'.

The noncompliance with grammar rules does not prevent a combination of words from being held as a descriptive indication (judgment of 16/12/2008, T-335/07 'PATENTCONSULT', para. 22).

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 33/2000-3) 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. Consequently, the word 'ULTRAPROTECT' must be considered descriptive for sterilising and sanitary preparations even though it consists of the combination (not grammatically correct) of an adjective (ULTRA) with a verb (PROTECT), since its meaning remains clearly understandable (decision of 03/06/2013, R 1595/2012-1).

Furthermore, it must be taken into account that 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 such grammatical elements may not always be sufficient to make the mark distinctive.

Finally, combinations made up of words from different languages may still be objectionable, provided that the relevant consumers will understand both terms without further effort.

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 misspelled due to influences of another language or the spelling of a word in non-EU areas, such as American English, in slang language or to make the word more fashionable. Examples of signs that have been refused:

- 'Xtra' (decision of 27/05/1998, R 20/1997-1)
- 'Xpert' (decision of 27/07/1999, R 0230/1998-3)
- 'Easi-Cash' (decision of 20/11/1998, R 96/1998-1)
- 'Lite' (judgment of 27/02/2002, T-79/00)
- 'Rely-able' (judgment of 3074/2013, T-640/11).

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

On the other hand, if the misspelling is fanciful and/or striking or changes the meaning of the word (accepted: 'MINUTE MAID', CTM No 2 091 262, (instead of 'minute made')), 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
<p>ACTIVMOTION SENSOR</p> <p>CTM No 10 282 614 claiming goods in Class 7 (swimming pool and spa cleaning equipment, namely, sweepers, vacuums, and parts therefor)</p>	<p>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.</p>	<p>Decision of 06/08/2012, R 716/2012-4 – 'ACTIVMOTION SENSOR', para. 11</p>
<p>XTRAORDINARIO</p> <p>International registration designating the EU No 930 778, claiming goods in Class 33 (tequila)</p>	<p>The above term is a nonexistent 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.</p>	<p>Decision of 08/03/2012, R 2297/2011-5 – 'Xtraordinario', paras 11-12</p>

On the other hand, the following marks were **accepted**:

Sign	Reasoning	Case
<p>LINQ</p> <p>CTM No 1 419 415 covering goods and services in Classes 9 and 38</p>	<p>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</p>	<p>Decision of 04/02/2002, R 9/2001-1 – 'LINQ', para. 13</p>
<p>LIQID</p> <p>CTM No 5 330 832 initially covering goods in Classes 3, 5 and 32</p>	<p>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'. Further, 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'.</p>	<p>Decision of 22/02/2008, R 1769/2007-2 – 'LIQID', para. 25</p>

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 enough.

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)
- TDI (judgment of 03/12/2003, T-16/02 (appeal C-82/04 P was settled))
- LIMO (judgment of 20/07/2004, T-311/02)
- BiolD (judgment of 05/12/2002, T-91/01 (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 which 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 15/03/2012, C-90/11 and C-91/11, 'Natur-Aktien-Index / Multi Markets Fund', paras 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 which 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) CTMR 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', para. 21). It is inappropriate to apply to slogans criteria which 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', paras 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) CTMR. 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', paras 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', para. 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.

This paragraph uses the words 'geographical term' to refer to **any** geographical indication in a Community trade mark application, whereas the terms 'protected geographical indication' and 'protected designation of appellation of origin' are used **only** in the context of specific legislation protecting them.

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

Designations of origin and geographical indications protected under specific EU Regulations are dealt with under the section on Articles 7(1)(j) and (k).

Assessment of geographical terms

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)

The first step in assessing the geographical term is to determine whether it is understood as such by the relevant public. In most cases, this understanding will be determined by taking into account a reasonably well informed consumer with a sufficient common knowledge as a basis, without being a specialist in geography.

The second step is to determine whether the geographical term applied for designates a place which is currently associated with the claimed goods or services in the mind of the relevant public, or if it will *reasonably be associated in the future* (judgment of 04/05/1999, joined cases C-108/97 and C-109/97, 'Chiemsee', para. 31). In other

words, the geographical term must not be understood as a mere suggestive or fanciful term. For example, whereas the North Pole and Mont Blanc are commonly known geographical terms, in the context of ice cream or sports cars they would not be understood as a possible place of production, but as a merely suggestive and fanciful term. The same applies to fashionable city names for goods and services unrelated to the reason for which the city is known ('Hollywood' for *chewing gum*) or to names of certain fashionable suburbs or shopping streets ('Champs Élysées' for *bottled water*, 'Manhattan' for *tomatoes*, 'Denver' for *lighting equipment* or 'Port Louis' for *textiles*).

On the other hand, there are some geographical terms which may be refused, merely due to their widespread recognition and fame for the high quality of the products or services. A detailed assessment of the link is not necessary in such a case (judgment of 15/12/2011, T-377/09, 'Passionately Swiss', paras 43-45). For example, 'Milano' should be refused for *clothing*, Zürich for *financial services* and Islas Canarias for *tourist services*.

With regard to *reasonable future association*, an Article 7(1)(c) CTMR refusal cannot solely be based 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, case T-226/2008, 'ALASKA').

On the contrary, the degree of familiarity amongst the relevant public with the geographical term, the characteristics of the place designated by the term and the category of goods or services must be assessed (judgment of 04/05/1999, joined cases C-108/97 and C-109/97 'Chiemsee', paras 32 and 37).

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.

For agricultural products or drinks (mineral water, beer), geographical terms are usually meant to refer to the place of production. However, this may not be the case in all Member States, and depends on the size of the geographical place or zone (judgment of 15/10/2003, T-295/01, 'OLDENBURGER'). In this paragraph, the geographical terms referred to are neither protected geographical indications nor protected designations of origin.

For textile and body care products, it is helpful to establish whether there is an actual production of these goods and whether that fact is known at a national or international level by the relevant public. Nevertheless, this requirement is not to be confused with the reputation of a geographical indication as such, and does not necessarily satisfy the requirement that there be a link between the geographical term and the goods or services concerned (judgment of 15/10/2008, T-230/06, 'Port Louis', paras 28-35).

In the event of any doubt, it is advisable to consult a national from the respective Member State.

The abovementioned principles also apply to the names of countries.

Finally, 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) CTMR. Terms commonly known and likely to be linked to a particular thing, product or activity by the relevant public are capable of describing subject matter.

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 which will be perceived by the relevant public ineluctably 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 regards to this section, the terms ‘subject matter’ and ‘content’ are used interchangeably. See also 2.2.3. on ‘Titles of books’.

Names of famous persons (in particular musicians or composers) can indicate the category of goods if due to the 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) which 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 (see below).

Goods and services which may contain subject matter

For most cases, the goods or services which 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', paras 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 which 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 (see judgment of 12/02/2004, C-363/99, 'Postkantoor', paras 114-116).

The following invented examples illustrate designations of goods or services which 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 letters³

General considerations

The Court stated that when examining absolute grounds for refusal, the Office is required, under Article 76(1) CTMR, to examine, of its own motion, the relevant facts which might lead it to raise an objection under Article 7(1) CTMR and that that requirement cannot be made relative or reversed, to the detriment of the CTM 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 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 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.

³ This part deals with single letters under Article 7(1)(c). For single letters under Article 7(1)(b), see Point 2.2.5

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', paras 24-31 and decision of 08/09/2006, R 394/2006-1, paras 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'.

On the other hand, 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) CTMR, then the application should be accepted.

See paragraph 2.2.5.2 above for further examples.

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 trademarks (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 trademarks 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 a Community 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 direct 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 connected with the marketing of the relevant goods – and relied upon by the examiner – showed that a number of very strong beers with an alcohol content of 15% vol. exist on the Community market (decision of 12/05/2009, R 72/2009-2, paras 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,

- the **size**: 1600 for cars, 185/65 for tyres, 10 for women's clothing in the UK, 32 for women's clothing in France,
- the **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,
- the **alcoholic content**: 4.5 for lager, 13 for wines,
- the **number of pieces**: 1 000 for puzzles.

On the other hand, where the numeral does not appear to have any possible meaning in respect of the goods and services, it is acceptable, i.e. '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) CTMR 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 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) CTMR. 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 or FLAMINGO 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.

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 which 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 which 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 Regulation No 2100/94. How to deal with applied for CTMs that contain or consist of a registered plant variety names is explained in another section of the Guidelines, in the context of Article 7(1)(f) CTMR (see 2.6.1.2).

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) CTMR unless it has acquired distinctiveness under the conditions of Article 7(3) CTMR.

Whenever a CTM application consists of wordings for live plants, agricultural seeds, fresh fruits, fresh vegetables or equivalent ones, the examiner will have to verify, by means of a search in the Internet, whether the term making up the applied for trade mark coincides with the name of a specific plant variety which 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 examiner must raise an objection under Article 7(1)(c) CTMR, 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 shows 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) CTMR would be appropriate (see also 2.4.4).

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 which 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 CTM application, the products were known to the extent required under Article 7(1)(d) CTMR.

An objection should also be raised when the applied for trade mark is only a **slight variation** (i.e. minor differences which 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 which 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) CTMR 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 which are identical to (or are slight variations of) a plant variety name which is already used in trade, but also in respect of any good and/or service which 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 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 banks names) or
- a long standing and intensive presence on the market (see for example, ‘IL GIORNALE’ – the newspaper – in Italy) or
- the combination being still likely to identify a specific entity (see, for example, ‘COSTA BLANCA NEWS’ or ‘BANCO DE ALICANTE’)

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 do 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.

2.3.2.12 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) CTMR 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).

2.3.3 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 shall 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 which 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) CTMR 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 which 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, were registered.

Sign	CTM No	Goods and services
	CTM 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 threshold⁴

2.3.4.1 Preliminary remarks


Terms or signs which 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) CTMR if combined with other elements which 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 which bring the sign as a whole beyond a minimum level of distinctiveness.

In practice this means that one of the main questions that examiners must answer in their daily work is whether the mark is figurative enough to reach the minimum degree of distinctive character that is requested for registration.

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 a CTM. Therefore, the question to be considered by the examiner is whether the stylisation and/or the graphical features of a sign are sufficient to make it act as a trademark.

For the purposes of this document, the expression ‘figurative element’ includes any graphic element/stylisation appearing in the sign, such as the typeface, the font size, the colours and the position/arrangement of the words/letters. It also encompasses geometric shapes, labels, patterns and symbols, as well as any combination of the abovementioned elements.

As a rule, 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 the figurative element is, due its size and position, clearly recognisable in the sign.

Sign	CTM No	Goods and services
	CTM No 11 418 605	Class 24
The above sign was objected to, as the typeface is not distinctive, because it does not depart significantly from commonly used typefaces in trade, and since the red device appearing on the letter ‘i’ is hardly recognisable.		


Even when the figurative element complies with the abovementioned requisites, it is still necessary to assess the sign as a whole in relation to the goods and services claimed.

It must be taken into account that, when the verbal element is descriptive/devoid of distinctive character, it must be checked in particular if the figurative element is:

- striking and/or surprising, and/or unexpected, and/or unusual, and/or arbitrary;

⁴ NB: This part is intended to be updated in line with the developments of the Convergence Programme 3 (CP3). Some examples already agreed on in that CP3 have already been incorporated in the text

- capable to create in the consumers' mind an immediate and lasting memory of the sign by diverting their attention from the descriptive/non-distinctive message conveyed by the word element;
- of such a nature as to require an effort of interpretation from the part of the relevant public in order to understand/ the meaning of the word element.

Sign	CTM No	Goods and services
	CTM No 11 595 601	products in Class 3 (sign under examination)
<p>The above trade mark applied for was objected to as it is clearly descriptive (and devoid of distinctive character) in relation to the claimed goods in Class 3. The descriptive content of the term overrides the figurative appearance of the letter 'L', even if that figurative letter 'L' in isolation were to be considered registrable for the same goods and services.</p>		

Finally, the fact that a sign contains figurative elements does not prevent it from still being misleading or contrary to the public order or from falling under other grounds of refusal, such as those set forth by Article 7(1)(h), (i), (j) and (k) CTMR.

2.3.4.2 Stylised word elements

As a rule, descriptive or non-distinctive word elements appearing in basic or standard typeface, with or without font effects such as 'bold' or 'italics', are not registrable. The more legible and/or common a typeface is, the less distinctive it is. The same reasoning applies to handwritten typefaces. Easily legible and/or common handwritten typefaces are normally devoid of distinctive character. In other words, in order to add distinctive character to a sign, the typeface's stylisation should be of such a nature as to request a mental effort from consumers to understand the meaning of the verbal element in relation to the claimed goods and services.

- Lower case + capital letters

Sign	CTM No	Goods and services
CyberDOCS	CTM No 310 888	Classes 9 and 16
<p>'The use of capital letters for the final syllable of "CyberDOCS" does not enhance the distinctiveness of the mark. The Office rightly treats any sign as a word mark if it is written in standard characters, regardless of whether lower case or capital letters are used. A descriptive word mark does not cease to be descriptive simply because it is written partly in lower case letters and partly in capitals' (see decision R 133/1999-1, para. 14).</p>		

- Standard Typeface + Italics

Sign	CTM No	Goods and services
Foamplus	CTM No 4 651 683	inter alia, goods in Classes 1, 7 and 22.
<p>The above sign was refused. Here, 'Foam' is written in a standard font and 'plus' is written in simple italics. As neither of these forms is in any way striking or extraordinary, the relevant public will not regard the visual elements as conferring on the sign the function of indicating origin (decision of 07/05/2008, R 655/2007-1 – 'Foamplus', para. 16).</p>		

- Special Typeface

Sign	CTM No	Goods and services
<i>Superleggera</i>	CTM No 5 456 207	Classes 12, 25 and 28
<p>The term 'Superleggera' means 'Super light' in English, and the refusal of this mark was confirmed by the General Court (see judgment of 19/05/2010, T-464/08, 'Superleggera', paras 33-34). The GC observed that while the font contains a certain peculiarity, the fact remains that the style is not likely to create an immediate and lasting memory on the part of the relevant public, or to distinguish the applicant's goods from other suppliers in the market. This is because, as regards the form of handwritten letters, they are usual in the commercial field. Therefore, this style remains largely normal in the eyes of consumers and, in this case, the relevant public. As far as the applicant's argument that the use of a capital 'S' at the beginning changes the way the expression 'Superleggera' is perceived is concerned, the GC states that the use of a capital letter does not have as a consequence that the expression will not be perceived as giving information to the public as to the goods at issue.</p>		

Sign	CTM No	Goods and services
<i>Bollywood macht glücklich!</i>	Example taken from CP3	<i>cinematographic works on image medium or other data media; printed matter; organising large events; entertainment</i>
<p>The mark means: <i>Bollywood makes one happy</i></p>		

- Colour


The mere 'addition' of a colour or combination of colours that is basic and/or commonly used in the market is not sufficient to make a descriptive and/or non-distinctive word element registrable. See the following example of a mark which was refused despite the addition of a colour.

Sign	CTM No	Goods and services
intelligent ideas	CTM No 7 147 689	goods and services in Classes 9 and 38


- Typeface, font size or arrangement of the words and/or letters


The way in which the word elements are positioned can add distinctive character to a sign when it is capable to affect the consumer's perception of the meaning of the word elements. In other words, the arrangement must be of such a nature as to require a mental effort from the consumer to perceive the link existing between the word elements and the claimed goods and services. As a rule, the fact that the word

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

Sign	CTM No	Goods and services
	CTM No 8 294 233	goods in Class 3
<p>The above mark for <i>cosmetics, body and beauty care products</i> was refused registration, as the typeface is banal and the presentation of the two word elements, one over the other, cannot be regarded as unusual. The fact that the 'b' is larger than the rest of the letters in 'beauty' is barely perceptible. These facts alone cannot confer a distinctive character on the sign applied for (judgment of 11/07/2012, T-559/10, 'Natural beauty', para. 26).</p>		

The following marks are considered to be acceptable.

Sign	CTM No	Goods and services
	CTM No 2795771	goods and services in Classes 9 and 38.
<p>The acronym 'DVB' means 'Digital Video Broadcasting', an expression that indicates a particular type of broadcasting technology. 'Without being led by prior knowledge of the acronym DVB, some mental effort is required, followed by a measure of interpretation, to divine the meaning of the sign depicted above. The letters comprising the sign are not clearly identifiable individually, as the sign may be a stylised DV3, D13, DVB or even LV3 or LVB. Further, the typeface does not depart significantly from common typefaces. By possessing at least a minimum of distinctive character, the sign above is therefore capable of functioning as a trade mark (decision of 09/10/2008, R 1641/2007-2, paras 23-25).</p>		

Sign		Goods and services
	Example taken from CP3	<i>perfumery; services of a fashion designer; clothing</i>

2.3.4.3 Word elements combined with other figurative elements

Word elements combined with banal shapes or designs

Basic shapes and figures include points, lines, line segments, circles and polygons such as triangles, squares, rectangles, parallelograms, pentagons, hexagons etc. It must also be taken into account that there are shapes, figures and designs which despite not being 'geometric' are still too simple/banal to add distinctive character to a sign.


Descriptive or non-distinctive verbal elements are unlikely to be acceptable when they are combined with basic/simple/banal shapes/figures/designs, geometric or not. This is mainly due to the following circumstances:


- when consumers look at a mark, the verbal element is generally the element most likely to be recognised and to be easily remembered;


- such shapes/figures do not convey any ‘message’ to the consumers and therefore they are not able to divert their attention from the descriptive/non-distinctive meaning of the word element.

The use of a colour that is basic and/or commonly used in the market does not endow the mark with a sufficient degree of distinctive character.


The following marks are considered to be objectionable.

Sign	CTM No	Goods and services
	CTM No 6 039 119	goods in Class 24

Sign	Sign	Goods and services
	Example taken from CP3	<i>books and magazine editing</i>

Sign	Sign	Goods and services
	Example taken from CP3	<i>coffee</i>

On the other hand, complex shapes, figures and designs can add distinctiveness to a sign. As a rule, the more complex shapes/figures/designs are, the more distinctive they are. The following is an example of a distinctive sign (it is assumed that the geometrical shape is not a representation of the packaging of the goods).

Sign	Sign	Goods and services
	Example taken from CP3	<i>coffee</i>

Nevertheless, in order to conclude for the existence of a sufficient degree of distinctive character, other factors should also be taken into account, such as the following:

- the shape/figure/design should not consist of a non-distinctive combination of basic/simple/banal shapes/figures/designs, geometric or not. In these cases, it is also necessary to properly assess the ‘visual impact’ of the figurative element in relation to that of the word element;
- the shape/figure/design should not consist of a common/non-distinctive label;

- the shape/figure/design should not be commonly used in trade in relation with the claimed goods and services;
- the shape/figure/design should not be a pattern that cannot be easily memorised by the relevant public;
- the shape/figure/design should not possess merely decorative/functional features;
- the shape/figure/design should not consist of a descriptive/non-distinctive two-dimensional representation of the goods and/or services (or of a part of them) nor should it reinforce the descriptive and/or promotional message conveyed by the word element;
- the shape/figure/design should not consist of a non-distinctive two-dimensional representation of the container/packaging of goods claimed;
- the shape/figure/design should not consist of a non-distinctive representation of the external appearance/silhouette of the goods or of a part of them;
- the shape/figure/design should not consist of the non-distinctive two-dimensional representation of the place/space/area/location where the goods/services are sold/provided/distributed/displayed.

These ‘features’ may overlap and could also be present at the same time in the same sign.


Here below are listed some examples of figurative elements belonging to some of the abovementioned categories.


Figurative elements consisting of a descriptive / non-distinctive representation of the goods or services or of a part of them

In some cases the figurative element consists of a representation of the goods or services claimed (or of a part of them). In principle, the representation is considered to be descriptive and/or devoid of distinctive character whenever:

- it is a ‘faithful’ or ‘true-to-life’ representation of the goods and services;
- it consists of a symbolic/stylised – but still realistic – representation of the goods and services.

In both cases, to be objectionable, the representation of the goods/services should not depart significantly from those that are commonly used in trade. The following are considered to be non-distinctive.


Sign		Goods and services
 Fresh Sardine	Example taken from CP3	<i>fish</i>


Sign		Goods and services
 Fresh Sardine	Example taken from CP3	<i>fish</i>


Figurative elements that reinforce the descriptive and/or promotional ‘message’ conveyed by the verbal element

The figurative element is also regarded as descriptive and/or devoid of distinctive character when it merely reinforces the descriptive and/or promotional message conveyed by the verbal element.

Sign	CTM No	Goods and services
	International registration designating the EU No 1 131 046	Classes 36 (<i>charitable fund raising services</i>), 42 and 45.
The figurative element merely reinforces the message conveyed by the verbal elements, i.e. you can make a donation with a single click		



Sign	CTM No	Goods and services
	CTM No 1 088 576	Class 29
‘Fra Danmark’ means ‘From Denmark’ in English. The device element (though not a heraldic imitation of the Danish flag) clearly reinforces the message that the claimed goods originate from Denmark. The decision has been confirmed by the Board (see decision R 469/2013-1).		

Sign	CTM No	Goods and services
Hunde  sport	CTM No 10 909 109	Classes 5, 18, 21, 25, 28 and 31
‘Hundesport’ means ‘dog/canine sport’		

Sign	CTM No	Goods and services
	CTM No 9 117 219	inter alia, <i>coffee</i> in Class 30
The word MOCA indicates a kind of coffee in some European languages, for example, Italian, Spanish and Portuguese. The figurative element between the letters ‘MO’ and ‘CA’ consists of the colours of the Italian flag. Though not objectionable under Article 7(1)(h) CTMR, this element does not add any distinctive character to the sign since it clearly indicates to the consumers the geographical origin/destination of the goods		

Figurative elements commonly used in trade in relation to the goods or services

As a rule, figurative elements that are commonly used in trade in relation to the goods and/or services claimed do not add distinctive character to the sign as a whole. See the following marks.

Sign	TM No	Goods and services
	<p>International registration designating the EU No 1 116 291</p>	<p>goods and services in Classes 29, 30, 31 and 43</p>
<p>The German expression 'Einfach Gut!' in the above mark means 'Simply good! /Just Great!' in English. The red heart is a shape that is commonly used in the market in relation with goods and services, especially foodstuffs such as chocolate and sweets in general, and particularly during special occasions such as the Saint Valentine day. As such, the mark was refused registration.</p>		
Sign	Case	
	<p>Judgment of 15/09/2005, C-37/03 P, 'BioID'</p>	
<p>The above mark was refused for goods and services claimed in Classes 9, 38 and 42 regarding password management and security features for software and telecommunication. The relevant public will understand the sign as a whole to mean 'biometrical identification', which is indistinguishable from the claimed goods and services, and is not of a character which can guarantee the identity of the origin of the marked product or service to the end-user from the viewpoint of the relevant public (para. 70). Additionally, the absence of any particular distinctive element, the common 'Arial' typeface and characters of different boldness do not enable the trade mark applied for to serve as an indicator of origin (para. 71).</p>		


Figurative elements consisting of patterns

As a rule, patterns do not add distinctive character to signs consisting of descriptive/non-distinctive word elements whenever they are perceived by the relevant public as merely decorative elements. Indeed, in these cases they do not convey any 'message' that could make the sign easily memorable for consumers.


Combinations of non-distinctive and / or banal figurative elements

As a rule, combinations of banal figurative elements (geometric or not), do not add distinctive character to signs consisting of word elements whenever they are not capable to divert the consumer's attention from the descriptive/non-distinctive message conveyed by the latter. In these cases, it is necessary to properly assess the 'visual impact' of the figurative element in relation to that of the word element.



See, for example, the following rejected marks.

Sign	CTM No	Goods and services
	CTM No 11 439 932	For services in Classes 39 and 41 (including car club services) Withdrawn
<p>In this case the 'swoosh' is insufficient to add distinctive character to the mark. Indeed, it is not eye catching, noticeable or memorable nor is it dominant with regard to the remaining word and figurative elements. Furthermore, the swoosh (as well as the other figurative elements, i.e. the typefaces, the colours and the label) is not able to divert the consumers' attention from the clear descriptive/non-distinctive message conveyed by the expression 'SUPERCAR EXPERIENCE'.</p>		

A similar reasoning applies, *mutatis mutandis*, to the figurative element of the following sign.



Sign	CTM No	Goods and services
	CTM No 11 387 941	Classes 9, 35 and 41

On the other hand, the following marks have been considered acceptable.

Sign	CTM No	Goods and services
	CTM No 10 894 996	goods and services in Classes 12, 35 and 36 (registered)
	CTM No 10 834 299	goods and services in Classes 9, 38 and 42 (registered)
<p>In both cases some of the figurative elements (the sign before the word 'Specialized' and the five rectangles having a circular arrangement that are placed at the right side of the word 'ECO') have an autonomous visual impact, with the same level of influence on the overall impression of the sign as the word element, and are therefore capable of attracting the consumer's attention.</p>		

Word elements combined with common / non-distinctive labels


In some cases descriptive and/or non-distinctive word elements are combined with devices that, though not being simple geometric shapes, consist nonetheless of common/non-distinctive labels. These labels are not capable of impressing themselves in the consumer's mind since they are too simple and/or commonly used in trade in relation with the goods/services claimed. See the following example.

Sign	CTM No	Goods and services
	CTM No 116 434	Class 32 (refused)
Sign	CTM No	Goods and services
	CTM No 1 166 164	services in Classes 35, 37 and 42

With regards to the perception of the shape and colour of the price tag by the relevant public, coloured price tags are commonly used in trade for all kinds of goods and services. Therefore, the fact that the tag in the above mark may attract the public's attention will not affect the meaning of the dominant word elements. Moreover, the shape tends to reinforce the promotional character of the word elements in the minds of the relevant public (judgment of 03/07/2003, T-122/01, 'Best Buy', paras 33-37).

Also in these cases the addition of 'common' colours (or a combination of them) does not add distinctive character to the sign. This is even more so when the claimed colour possesses functions other than mere decoration.

See, as an example, the following mark.

Sign	CTM No	Goods and services
	CTM No 10 849 263	services in Classes 35, 36, 38, 41, 42, 43, 44 and 45 (refused).

The fact that this kind of label is normally used for goods (such as liquors, nougat etc.) is not sufficient to endow the sign with a sufficient degree of distinctive character in relation to services.

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

2.4.1 General remarks


Article 7(1)(d) CTMR excludes from registration signs which consist exclusively of words or indications which 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 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 7(1)(c) CTMR, signs covered by Article 7(1)(d) CTMR 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', para. 35).

Moreover, signs or indications which 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', para. 52).

This ground for refusal also covers words which had originally no meaning or had another meaning, for example, 'weiße Seiten' (= 'white pages'). It also covers certain abbreviations which have entered informal or jargon usage and have thereby become customary in trade.

Furthermore, a refusal based on Article 7(1)(d) CTMR also covers figurative elements which 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
 <p>CTM No 9 894 528 covering goods in Class 9</p>	<p>'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 a Community trade mark in accordance with Article 7(1)(d) CTMR' (paragraph 20)</p>	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 CTMA (judgments of 05/03/2003, T-237/01, 'BSS', para. 46, and of 05/10/2004, C-192/03, paras 39-40). Whether a term or figurative element was non-descriptive or

distinctive long before that day, 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', para. 47)

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) CTMR, but can lead to a revocation with effect *ex nunc* under Article 51(1)(b) CTMR. For example, the CTM registration 'STIMULATION' was cancelled on the grounds that it has become a term customarily used in relation to energy drinks.

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', para. 53).

As regards the relevant public, the customary character must be assessed by taking account of the expectations which 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', para. 50).

However, in cases where intermediaries participate in the distribution to the consumer or the end user of a product, the relevant public to be taken into account in determining the sign's customary character comprise not only all consumers and end users and, 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', para. 26 and of 06/03/2014, C-409/12, 'Kornspitz', para 27).

The General Court has held that Article 7(1)(d) CTMR is not applicable when the sign's use in the market is by one single trader (other than the CTM applicant) (judgment of 07/06/2011, T-507/08, '16PF'). In other words, a mark will not be regarded as customary purely for the simple reason that a competitor of the CTM 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.

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

2.4.4 Applicability of Article 7(1)(d) CTMR 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 which is not simultaneously registered by the Community Plant Variety Office in accordance with Guidelines for Examination in the Office, Part B, Examination. Page 67

Regulation No 2100/94. In the latter case, the mark would be objectionable under Article 7(1)(f) CTMR. 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 applied for trade mark under Article 7(1)(c) and (b) CTMR on the ground that the applied for trade mark is descriptive – should also object under Article 7(1)(d) CTMR 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 with an essentially technical function, substantial aesthetic value or resulting from the nature of the goods (Article 7(1)(e) CTMR)

2.5.1 General remarks

Article 7(1)(e) CTMR excludes from registration signs which consist exclusively of (i) the shape which results from the nature of the goods themselves; (ii) the shape of goods which is necessary to obtain a technical result; or (iii) the shape which 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.

It should be borne in mind that an objection under Article 7(1)(e) CTMR would not be justified when the applied for sign consists of a shape combined with additional, distinctive matter (be it word and/or figurative elements), as the sign as a whole would not then consist exclusively of a shape.

Article 7(1)(e) CTMR does not, however, define the type of signs which must be considered as shapes within the meaning of that provision. It makes no distinction between three-dimensional shapes, two-dimensional shapes, or two-dimensional representations of three-dimensional shapes. Hence, it must be held that Article 7(1)(e) CTMR may apply to trademarks reproducing shapes, regardless of the dimension in which they are represented (judgment of 08/05/2012, T-331/10, ‘Surface covered with black dots’, para. 24). Therefore, the applicability of Article 7(1)(e) CTMR is not confined to three-dimensional shapes.

It should be noted, in this respect, that according to settled case-law the classification of a mark as ‘figurative’ does not always rule out the applicability of the grounds for refusal foreseen in Article 7(1)(e) CTMR. The Court of Justice and the General Court have held that the case-law developed in respect of three-dimensional marks consisting of the appearance of the product also applies to ‘figurative’ marks that consist of two-dimensional representations of products (judgment of 22/06/2006, C-25/05 P, ‘Sweet wrapper’, para. 29; judgment of 04/10/2007, C-144/06, ‘Tabs’, para. 38).

Article 7(3) CTMR makes it clear that shapes which follow from the nature of the goods (whether existing in nature or manufactured), essentially functional shapes or shapes giving substantial value to the goods cannot overcome an objection under Article 7(1)(e) CTMR by demonstrating that they have acquired distinctive character. Accordingly, trade mark protection is excluded when a shape falls within Article 7(1)(e)

CTMR, regardless of whether that particular shape might actually be distinctive in the marketplace.

In this respect, it should be noted that the Court of Justice, in its preliminary ruling of 20/09/2007, C-371/06, 'BENETTON', concerning the interpretation of the third indent of Article 3(1)(e) of First Council Directive No 89/104 (TMD) (which is equivalent to Article 7(1)(e) CTMR) ruled that the shape of a product which gives substantial value to that product cannot constitute a trade mark under Article 3(3) TMD (equivalent to Article 7(3) CTMR), even where, prior to the application for registration, it acquired attractiveness as a result of its recognition as a distinctive sign following advertising campaigns presenting the specific characteristics of the product in question.

Furthermore, the Court of Justice, in its preliminary ruling of 08/04/2003, joined cases C-53/01, C-54/04 and C-55/01, 'Linde', para. 44, stated that since Article 3(1)(e) TMD is a preliminary obstacle that may prevent a sign consisting exclusively of the shape of goods from being registered, it follows that if any one of the criteria listed in that provision is satisfied, the sign cannot be registered as a trade mark.

The Court also stated that if that preliminary obstacle is overcome, it is still necessary to ascertain whether a three-dimensional shape of the goods must be refused registration under one or more of the grounds for refusal set out in Article 3(1)(b) to (d) (joined cases C-53/01, C-54/04 and C-55/01, 'Linde', para. 45).

If the examination of a sign under Article 7(1)(e) CTMR leads to the conclusion that one of the criteria mentioned in that provision is met, it follows that it is no longer necessary to address the issue of whether the sign has acquired distinctiveness through use, since an objection under Article 7(1)(e) CTMR cannot be overcome by invoking Article 7(3) CTMR (judgment of 06/10/2011, T-508/08, 'Representation of a loudspeaker', para. 44). The above circumstance explains the **advantage of undertaking a prior examination of the sign under Article 7(1)(e) CTMR where several of the absolute grounds for refusal provided for in Article 7(1) CTMR may apply.**

Therefore, for the sake of sound and efficient administration of justice and economy of proceedings, examiners are requested to raise all objections to registration of the sign under Article 7(1) CTMR, including Article 7(1)(e) CTMR, as soon as they are found to be applicable.

Thus, when the sign applied for consists of a shape which is likely to be perceived by the relevant public both as merely functional and as a shape that does not depart significantly from the norms of the sector, the examiner should raise an objection under Article 7(1)(e) *and* 7(1)(b) CTMR, even if the evidence of lack of distinctiveness is stronger than that relating to functionality.

However, it may also happen that following an initial objection only under Article 7(1)(b) and/or (c) CTMR, the evidence submitted by the applicant shows that all the essential features of the shape in question serve a technical function or that the shape gives a substantial value to the goods. In such cases, a further objection under Article 7(1)(e)(ii) or (iii) should be raised, so that the applicant may make its submissions in that respect. In such a scenario, the applicant can try to overcome the objection only by arguments, since the evidence of acquired distinctiveness would not be taken into account in the context of an objection under Article 7(1)(e) CTMR.

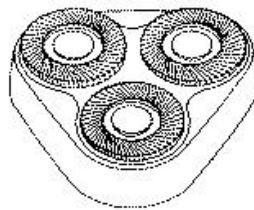
2.5.2 Shape which results from the nature of the goods

Under Article 7(1)(e)(i) CTMR, signs which consist exclusively of the shape which results from the nature of the goods themselves cannot be registered.

This ground of refusal will apply only when the trade mark applied for, whether a 2D or 3D mark, consists exclusively of the only natural shape possible for the goods (whether manufactured or existing in nature): for example, the realistic representation below of a banana for bananas:



It should be noted that whenever a given product may come in different shapes, it would not be appropriate to raise an objection under Article 7(1)(e)(i) CTMR, since there is not only one possible natural shape of the goods. For example, it would not be proper to apply this ground of refusal to the below shape of the head of an electric shaver where the specification was for 'electric shavers', since these do not necessarily have to be manufactured with this configuration:



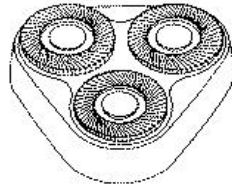
Nevertheless, other grounds of refusal may still apply, such as, in the present case, an objection under Article 7(1)(e)(ii) CTMR, as the shape in question is functional in its essential features (judgment of 18/06/2002, C-299/99, 'Philips').

In all those cases where the applied for CTM consists exclusively of the shape of the goods which follows from their nature, an objection may additionally be raised under Article 7(1)(c) CTMR, on the ground that the shape in question is descriptive of the nature of the goods.

2.5.3 Shape of goods necessary to obtain a technical result

Article 7(1)(e)(ii) CTMR excludes from registration signs which consist exclusively of the shape of goods which is necessary to obtain a technical result.

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 (preliminary ruling of 18/06/2002, C-299/99, 'Philips', and judgment of 14/09/2010, C-48/09 P, 'Red Lego brick'), interpreting, inter alia, Article 3(1) TMD, which is the equivalent of Article 7(1) CTMR.



Regarding the above sign, the Court of Justice held that when it comes to signs consisting exclusively of the shape of a product necessary to obtain a technical result, Article 3(1)(e)(ii) TMD is intended to preclude the registration of shapes whose **essential characteristics perform a technical function**, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function, or at least limit their freedom of choice with regard to the technical solution they wish to adopt in order to incorporate such a function in their product (preliminary ruling of 18/06/2002, C-299/99, 'Philips', para. 79).

It should be noted that Article 7(1)(e)(ii) CTMR, by referring to signs which consist 'exclusively' of the shape of goods which is 'necessary' to obtain a technical result, is aimed at ensuring that solely shapes of goods which only incorporate a technical solution, and whose registration as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered (judgment of 14/09/2010, C-48/09 P, 'Red Lego brick', para. 48).

A sign consists 'exclusively' of the shape of goods which 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, 'Red Lego Brick', para. 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, 'Red Lego brick', paras 53-58).

However, Article 7(1)(e)(ii) cannot apply if the shape of the goods incorporates a major non-functional element, such as a decorative or imaginative element which plays an important role in the shape (judgment of 14/09/2010, C-48/09 P, 'Red Lego brick', para. 52).

In contrast, the presence of one or more minor arbitrary elements in a three-dimensional sign, all of whose essential characteristics are dictated by the technical solution to which that sign gives effect, does not alter the conclusion that the sign consists exclusively of the shape of goods which is necessary to obtain a technical result (judgment of 14/09/2010, C-48/09 P, 'Red Lego brick', para. 52).

The correct application of Article 7(1)(e)(ii) requires that the essential characteristics of the three-dimensional sign at issue be properly identified. The expression 'essential characteristics' must be understood as referring to the most important elements of the sign (judgment of 14/09/2010, C-48/09 P, 'Red Lego brick', paras 68-69).

The identification of those essential characteristics must be carried out on a case-by-case basis. Moreover, the examiner may base their assessment directly on the overall impression produced by the sign or first examine in turn each of the components of the sign concerned (judgment of 14/09/2010, C-48/09 P, ‘Red Lego brick’, para. 70).

Unlike in the situation covered by Article 7(1)(b) CTMR, how the sign is presumed to be perceived by the average consumer is not a decisive element when applying the ground for refusal under Article 7(1)(e)(ii) CTMR, but, *at most*, may be a relevant assessment criterion of assessment for the examiner when the latter identifies the sign’s essential characteristics (judgment of 14/09/2010, C-48/09 P, ‘Red Lego brick’, para 76).

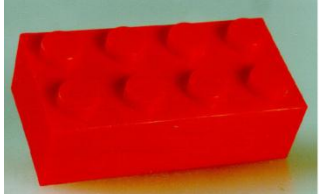
Once the sign’s essential characteristics have been identified, it will have to be established whether they all perform the technical function of the goods at issue (judgment of 14/09/2010, C-48/09 P, ‘Red Lego brick’, para 72).

In assessing a CTM application against Article 7(1)(e)(ii), consideration should be given to the meaning of the expression ‘technical result’. This expression should be interpreted broadly and includes shapes which, for example:

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

One of the leading cases concerning essentially functional shapes concerned the shape of a building block in a construction toy set.

In that case, following a cancellation action, two instances of the Office (firstly by the Cancellation Division and secondly by the Grand Board) declared CTM No 107 029 invalid for the three-dimensional sign below in relation to ‘construction toys’ in Class 28:

Sign	CTM No	Goods and services
	<p>CTM No 107 029</p>	<p>Class 28 (construction toys)</p>

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 856/2004-G, para. 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) CTMR (judgment of 12/11/2008, T-270/06, ‘Red Lego brick’).

Following an appeal, the Court of Justice, in its ruling of 14/09/2010, C-48/09 P, 'Red 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).

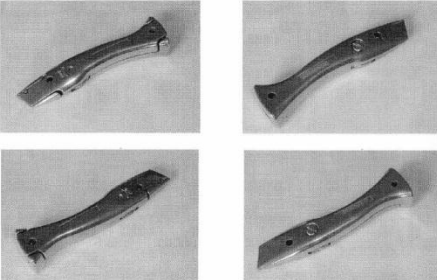
Importantly, the Court clarified that the essential characteristics of a shape must be determined as objectively as possible for the purposes of applying Article 7(1)(e)(ii) CTMR. The Court added that such an identification may, depending on the case, and in particular in view of its degree of difficulty, 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 criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned (para. 71).

Furthermore, the Court held that

... the technical functionality of the characteristics of a shape may be assessed, inter alia, by taking account of the documents relating to previous patents describing the functional elements of the shape concerned' (para. 85).

Therefore, 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 in Case R 42/2013-1).

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

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

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 which gives substantial value to the goods


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

Whereas the same shape can, in principle, be protected both as a design and as a trade mark, it should be noted that Article 7(1)(e)(iii) CTMR only refuses trade mark protection for shapes in certain specific cases, namely, when the sign consists exclusively of a shape which 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', i.e., the likelihood that the goods will be purchased *primarily because of* their particular shape. It should not, however, 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* 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 in Case R 2520/2011-5, para. 19).

As the Court has reiterated, the immediate purpose in barring registration of shapes which bestow substantial value on the goods is the same as that in the case of merely functional shapes, that is, to prevent the exclusive and permanent right conferred by a trade mark from serving to extend the life of other rights which the legislature has sought to make subject to 'limited periods' (judgment of 06/10/2011, T-508/08, 'Representation of a loudspeaker', para. 65).

To date, the 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
	<p>Decision of 10/09/2008, R 497/2005-1</p> <p>Judgment of 06/10/2011, T-508/08,</p> <p>'Representation of a loudspeaker'</p>	<p>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.</p>

The General Court, in its judgment of 06/10/2011, T-508/08, 'Representation of a loudspeaker', confirmed the Board of Appeal's finding that the sign at issue fell within the scope of Article 7(1)(e)(iii) CTMR. This judgment constitutes, until now, the only ruling by the judicature of the European Union to address the substance of the issue of ornamental shapes bestowing substantial value on goods.

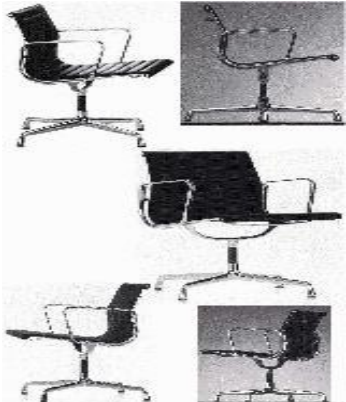
The Court held that for goods such as those listed above, the design was an element which would be very important in the consumer's choice even if the consumer took other characteristics of the goods at issue into account. After having stated that the shape for which registration was sought revealed a very specific design and that it was an essential element of the applicant's branding that increased the appeal of the product and, therefore, its value, the Court also noted that it was apparent from the evidence on record, namely extracts from the distributors' websites and on-line 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 (para. 75). The 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 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 itself is substantial.

In practice, **this ground of refusal will mostly apply to those goods where the shape of the object concerned is the main, although not necessarily exclusive, factor that determines the decision to buy it**. For example, this will be the case with objects of art and items such as jewellery, vases and other objects that are bought primarily because of the aesthetic value associated with their shape.

On the other hand, the fact that the shape may be pleasing or attractive is not sufficient to exclude it from registration. If that was the case, it would be virtually impossible to imagine any trade mark of a shape, 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 395/1999-3 – 'Gancino quadrato singolo', paras 1-2 and 22-36).

For example, the Board held that the below shape does not give substantial value to the goods.

Sign	Case
	<p style="text-align: center;">Decision of 14/12/2010, R 486/2010-2 'Shape of a chair'</p>

The Board held that, although the above shape was aesthetically pleasing and had some eye-appeal, it did not depart sufficiently from the norms of presentation of chairs on the filing date of the application. It further held that the chair was also bought to be sat on and used as a comfortable piece of office furniture in the home or workplace. It distinguished this case from the abovementioned 'Loudspeaker', noting that features such as the fact that its backrest is curved and thus provides lumbar support and that the armrests also add to its comfort as do the four rollers on the legs were visible from the shape, unlike the technical features of the loudspeaker in the 'Loudspeaker' decision.

The Board considered that the 'design icon' status invoked by the CTM proprietor in respect of the above chair did not automatically show that the value of the product lied primarily in the shape per se, being rather the result of the fact that the chair has a solid, comfortable and ergonomic design which has become famous due, in particular, to the considerable marketing efforts over the years.

The Board also noted that the CTM proprietor had not argued that the shape's value lied in its eye-appeal and that the invalidity applicant had not brought forward evidence proving that sellers advertised the chair in question mainly relying on its aesthetic appearance (paras 21-23).

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, due to information and documents provided by the applicant (or a third party) there is evidence that the aesthetic value of the shape can, in its own right, determine the commercial value of the product and the consumer's choice to a large extent. This has been, precisely, the case in the two cases referred to above: in the 'loudspeaker' case it was only after a careful assessment of the evidence filed by the applicant that the Board objected on this ground; and in the case described just above, the evidence had been provided by the invalidity applicant, but proved to be insufficient.

2.6 Acquired distinctiveness

2.6.1 Introduction

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

Article 7(3) CTMR constitutes an exception to the rule laid down in Articles 7(1)(b), (c) or (d) CTMR, whereby registration must be refused for trade marks which are per se devoid of any distinctive character, for descriptive marks, and for marks which consist exclusively of indications which 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 CTM 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) CTMR 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 that would have otherwise applied.

2.6.2 Request

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

2.6.3 The point in time

The evidence must prove that distinctiveness through use was acquired prior to the CTMA's filing date. In the case of an IR, the relevant date is the date of registration by the International Bureau. 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 (judgment of 11/06/2009, C-0542/07P, 'Pure Digital', paras 49 and 51; and judgment of 07/09/2006, C-0108/05, 'Europolis', para. 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', para. 49).

2.6.3.2 Cancellation Proceedings

In Cancellation Proceedings, a trade mark which was registered in breach of the provisions of Article 7(1)(b), (c) or (d) CTMR may nevertheless no longer be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character for the goods or services for which it is registered (Article 52(2) CTMR).

The precise purpose of this norm is to maintain the registration of those marks which, due to the use which has been made of them, have in the meantime – that is to say, after their registration – acquired distinctive character for the goods or services for which they were registered, in spite of the fact that, when it took place, such registration was contrary to Article 7 CTMR (judgment of 14/12/2011, T-237/10, ‘Louis Vuitton’, para. 86 and judgment of 15/10/2008, T-405/05, ‘Manpower’ para. 127).

2.6.4 Consumer

Distinctive character, including that acquired through use, of a sign 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 which have another origin (judgment of 29/09/2010, T-378/07, ‘RED/BLACK/GREY (Surface of a tractor)’, paras 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)’, paras 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 CTMA, 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 (judgment of 04/05/1999, C-0108/97 & C-0109/97, ‘Chiemsee’, para. 52; and judgment of 19/05/2009, T-0211/06, ‘Cybercrédit et al.’, para. 51).

2.6.6 Territorial Aspects

Pursuant to Article 1 CTMR, a Community trade mark has a unitary character and has equal effect throughout the European Union. Article 7(2) CTMR 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 thereto, acquired distinctiveness must be established throughout the territory in which the trade mark did not, *ab initio*, have such character (judgment of 22/06/2006, C-0025/05P, ‘Sweet wrapper’, paras 83, 86; and judgment of 29/09/2010, T-0378/07, ‘RED/BLACK/GREY (Surface of a tractor)’, para. 30).

This is because the unitary character of the Community 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’, para. 40). It would be paradoxical to accept, on the one hand, pursuant to Article 3(1)(b) TMD that a Member State has to refuse to register as a national mark a sign that is devoid of any distinctive character in its territory and, on the other, that that same Member State has to respect a Community 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, ‘Louis Vuitton’, para. 100).

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, a CTM applied for before the date of accession of a given Member State may only be rejected for reasons which 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 CTM application, and not those which 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. For the possibility of extrapolating the evidence, see paragraph 2.12.8.7 below.

2.6.6.3 Language area

Where the CTM applied for is rejected with respect to its meaning in a specific language, acquired distinctiveness through use must be shown at least 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 include:

- German

German is an official language in Germany and Austria as well as in Luxembourg and Belgium. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of German language wording must automatically be examined for all these countries.

- Greek

Greek is an official language not only in Greece but also in Cyprus. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of Greek language wording must automatically be examined for both these countries.

- English

English is an official language in the United Kingdom, in Ireland and in Malta. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of English language wording must automatically be examined for all these countries.

- French

French is an official language not only in France but also in Belgium and Luxembourg. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of French language wording must automatically be examined for all these countries.

- Dutch

Dutch is an official language not only in the Netherlands but also in Belgium. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of Dutch language wording must automatically be examined for both these countries.

- Swedish

Swedish is an official language not only in Sweden but also in Finland. Any claim that acquired distinctiveness through use enables the applied-for sign to overcome an absolute grounds objection based on the meaning of Swedish language wording must automatically be examined for both of these countries.

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

In addition to the Member States where the language of a sign's wording is an official EU language, it must also be considered whether a given official EU language is understood in other Member States where it is not official. This may be because, depending on the goods and services claimed in the CTMA, the relevant public in that Member State have 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, and not only the Member States where the language is official.

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', para. 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', para. 26), in technical fields (judgment of 09/03/2012, T-172/10, 'Base-seal', para. 54) and in financial matters (judgment of 26/09/2012, T-301/09, 'Citigate', para. 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, respectively.

2.6.7 What has to be Proved

The Court of Justice has provided guidance on the conditions which should result in a finding that a trade mark has acquired a distinctive character through use: 'If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.' (Judgment of 04/05/1999, C-0108/97 & C-0109/97, 'Chiemsee', para. 45 et seq.).

Accordingly, the evidence must demonstrate that a significant proportion of the relevant public for the claimed goods and services in the relevant territory see the trade mark as identifying the relevant goods or services of a specific undertaking, in other words, that the use made of the mark has created a link in the mind of the relevant public with a specific company's goods or services, regardless of the fact that the wording at issue would lack the distinctiveness to make this link had such use not taken place.

With regards to the extent of market penetration and relevant public recognition a trade mark must achieve to hold that it has acquired distinctiveness through use, in that it

has come to identify the goods and services of one undertaking as opposed to those of others for the relevant public, case-law does not prescribe fixed percentages of market recognition for the relevant public. Rather than using a fixed percentage of the relevant public in a given market, the evidence should rather show that a significant proportion of the public perceive the mark as identifying specific goods or services.

Finally, the evidence must relate to each of the goods and services claimed in the CTM application. After an initial absolute grounds objection under Article 7(1)(b), (c) or (d) CTMR, only the goods and services claimed in the application for which acquired distinctiveness through use has been proven will be registerable.

2.6.8 The evidence and its assessment

In establishing acquired distinctiveness, evidence of the following items may be taken into consideration: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant public who, because of the mark, identify goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (judgment of 04/05/1999, C-108/97 & C-0109/97, 'Chiemsee', para. 31; and judgment of 29/09/2010, T-378/07, 'RED/BLACK/GREY (Surface of a tractor)', para. 32).

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) unless the applicant has pleaded them (judgment of 12/12/2002, T-247/01, 'Ecopy', para. 47).

2.6.8.1 The kind of evidence that may be submitted

Examples of evidence which can serve to indicate some or all of the above factors which may show acquired distinctiveness include items such as 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 as to their intensity and reach, as well as customer and / or market surveys.

Applicants should take great care to make sure that the evidence shows not only 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. Undated evidence 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. Further, if evidence mixes materials concerning EU and non-EU territories, and does not permit the Office to identify the specific extent of EU-only use, it will be similarly devoid of probative value for the relevant EU public.

Article 78 CTMR contains a non-exhaustive list of means of giving or obtaining evidence in proceedings before the Office, which may serve as guidance to applicants.

2.6.8.2 Assessment of evidence as a whole

Since the Office must assess the evidence as a whole (R 0159/2005-4, 'Metavit/MEXAVIT C *et al*', para. 37). It is not necessary that any one item of evidence alone is

capable of proving the matter at issue. Such proof can result from an overall assessment of all items of evidence submitted (judgment of 07/06/2005, T-303/03, 'Salvita', para. 42; and decision of 08/03/2006, R 0358/2004-4, 'MediQi/MEDICE', para. 34). In order to assess the evidential value of a document, regard should be given to its credibility. It is also necessary to take into account the origin of the document, the circumstances in which it came into being, the person to whom it was addressed and whether the document appears sound and reliable (judgment of 07/06/2005, T-303/03, 'Salvita', para. 42; and judgment of 16/12/2008, T-86/07, 'DEITECH' [Fig. Mark], paras 46 et seq.).

2.6.8.3 Market share

The market share held by the trade mark may be relevant for assessing whether that mark has acquired distinctive character through use, to the extent that such market penetration might enable the Office to infer that the relevant public would recognise the mark as identifying the goods or services of a specific undertaking, and thus distinguishing those goods or services from those of other undertakings.

The amount of publicity on the relevant market for the goods or services claimed (as represented by advertising investment in promoting a mark) may also be relevant for assessing whether the mark has acquired distinctive character through use (judgment of 22/06/2006, C-0025/05P, 'Sweet wrapper', paras 76 et seq.). However, many attempts to prove distinctiveness acquired through use fail because the applicant's evidence is not sufficient to prove a link between the market share and advertising, on the one hand, and the consumer perception on the other.

2.6.8.4 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.

The GC has found that in principle it is not inconceivable 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', paras 38-39).

Accordingly, any opinion poll evidence must be assessed carefully. It is important that the questions asked are relevant and not leading. The criteria for the selection of the interviewed public must be assessed carefully. The sample must be indicative of the entire relevant public and, accordingly, must be selected randomly.

Evidence from independent trade associations, consumer organisations and competitors should also be given weight. Evidence from suppliers or distributors should, generally, be given less weight, since it is less likely that their evidence will be from a third-party 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').

2.6.8.5 Turnover and advertising

Information concerning turnover is one of the most readily available forms of evidence to companies. The same holds true with respect to advertising expenses.

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 the issue of 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 must be possible to identify with precision the turnover/advertising figures and evidence relating to the mark applied for, and also the relevant goods and services must be identifiable.

Goods and services are often marketed under several trade marks, which renders it difficult to see what the relevant customer perception is of the applied-for mark alone, and turnover/advertising 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. Consequently, 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.

Where figures for turnover or advertising are supplied, these should relate not only to the trade mark for which registration is sought, but also specifically to the goods or services covered by that mark. It is desirable that the turnover figures be segregated on an annual and market-by-market basis. The specific period(s) of use (including details as to when the use commenced) should be shown by the evidence, so that the Office is able to satisfy itself that the evidence proves that the trade mark acquired distinctiveness before the filing date.

2.6.8.6 Indirect evidence of use

The evidence may consist of or include 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 CTM application. These registrations may be taken into account, although they are not binding, when the examiner is able to assess the evidence which was submitted before the national IP office.

2.6.8.7 Extrapolation

Another important issue in the evaluation of evidence is 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 very unlikely that a party will 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 market is homogenous and if at least some evidence is submitted. The market conditions and the 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. For example, if the CTM is used in the entire relevant territory but the evidence only refers to a part of it, inference is possible if the circumstances are comparable. However, if the CTM is only used in part of the relevant territory (and the evidence refers to this), it will usually be difficult to extrapolate those facts to other parts of the territory.

2.12.8.8 Manner of use

The evidence should show examples of how the trade mark is used (brochures, packaging, samples of the goods, etc.). Use of a substantially different mark should not be given any weight.

It is sometimes the case that the use shown is of a sign which, while similar to the mark applied for, is in itself distinctive. In such cases the evidence should be disregarded. Acquired distinctiveness must be shown with respect to the sign applied for. However, in accordance with Article 15(1)(a) CTMR, minor amendments to the sign which do not change the distinctive character of the sign may be allowed (decision of 15/01/2010, R 0735/2009-2, 'PLAYNOW'; and decision of 09/02/2010, R 1291/2009-2, 'EUROFLORIST').

It is possible to prove acquired distinctiveness of a sign which has been used together with other trade marks (judgment of 28/10/2009, T-137/08, 'Green/Yellow', para. 27), provided that the relevant consumer attributes to the sign in question the identification function (judgment of 07/07/2005, C-353/03, 'Have a break'; judgment of 30/09/2009 T-75/08, '!' [Fig. Mark], para. 43; and judgment of 28/10/2009, T-137/08, 'Green/Yellow', para. 46).

2.6.8.9 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 the mark the more likely they are to have made the connection between the mark and a particular source in trade.

Considering, however, that the 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, which 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 which 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 events that they take place at regular intervals and are known to have extremely wide appeal. These major sport events are anticipated by millions, the knowledge that the event is due on a particular date preceding 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. It is therefore reasonable to suppose that the moment a particular tournament or games is announced as allocated to a particular city or country this is likely to instantly become known by practically all relevant consumers with an interest in the sport / sports concerned or to professionals in the sector. This may thereby give rise to the possibility of rapid or even instantaneous 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 possible instantaneous acquired distinctiveness will follow the general criteria as regards, e.g., the extent of use, the territory, the relevant date or the targeted public, where the general standards apply, as well as regards the onus of the applicant to provide evidence thereof. The only particularity refers to the 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 trademark in question as a distinctive sign.

2.6.8.10 Post-filing date evidence

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

However, evidence cannot be rejected merely because it postdates the filing date, since it may provide indications as to the situation before the filing date. Accordingly, such evidence must be assessed and due weight given to it.

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

2.6.9 Consequences of Acquired Distinctiveness

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

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