

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

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

***PART B***

***EXAMINATION***

***SECTION 4***

***ABSOLUTE GROUNDS FOR REFUSAL***

***CHAPTER 2***

***EUTM definition***

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

<b>1</b>	<b>General remarks .....</b>	<b>3</b>
<b>2</b>	<b>Examples of trade mark applications refused or accepted under Article 7(1)(a) EUTMR .....</b>	<b>5</b>
2.1	Smell/olfactory marks .....	5
2.2	Taste marks .....	6
2.3	Sound marks.....	6
2.4	Movement marks .....	8
2.5	Colour marks .....	10
2.6	Position mark.....	11
2.7	3D representation of a space.....	12
<b>3</b>	<b>Relationship with other EUTMR provisions .....</b>	<b>12</b>

## 1 General remarks

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

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

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

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

### a) Signs

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

However, in order not to deprive Article 4 EUTMR of any substance, this provision cannot be interpreted so broadly as to allow any non-specific subject matter to necessarily qualify as a sign. Thus, abstract concepts and ideas or general characteristics of goods are not specific enough to qualify as a sign, as they could apply to a variety of different manifestations (judgment of 21/04/2010, T-7/09, Spannfutter, EU:T:2010:153, § 25).

For this reason, the Court rejected, for example, an application for a 'transparent collecting bin forming part of the external surface of a vacuum cleaner', as the subject matter was not a particular type of bin, but rather, in a general and abstract manner, all conceivable shapes of a transparent bin with a multitude of different appearances (judgment of 25/01/2007, C-321/03, Transparent bin, EU:C:2007:51, § 35, and 37).

### b) Graphic representation

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

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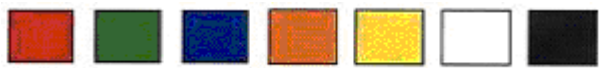
<sup>1</sup> The modifications introduced by Regulation No 2015/2424 in Article 4 EUTMR will enter into force on 01/10/2017. They are therefore **not** reflected in this version of the Guidelines.

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

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

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

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

Sign	Case number
 <p data-bbox="233 1160 849 1352"><u>Description:</u> ‘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’.</p>	<p data-bbox="916 1160 1315 1245" style="text-align: center;"><b>EUTM 8 316 184</b> 14/06/2012, T-293/10, Colour per se, EU:T:2012:302</p>
<p data-bbox="233 1397 1364 1554">The General Court considered that the mark’s description was too difficult to understand. A sign so defined is not a colour mark per se but a three-dimensional mark, or figurative mark, that corresponds to the external appearance of a particular object with a specific form — a cube covered in squares with a particular arrangement of colours. Even if the description had been clear and easily intelligible — which it was not — it would still have contained an inherent contradiction insofar as the true nature of the sign is concerned (paras 64 and 66).</p>	

c) Distinguishing character

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

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

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

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

### 2.1 Smell/olfactory marks

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

There is currently no means of graphically representing smells in a satisfactory way. There is no generally accepted international classification of smells that would make it possible, as with international colour codes or musical notation, to identify an olfactory sign objectively and precisely through the attribution of a name or a precise code specific to each smell (judgment of 27/10/2005, T-305/04, *Odeur de fraise mûre*, EU:T:2005:380, § 34).

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

- *Chemical formula*

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


- *Odour sample*

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

- *Graphic representation and description in word*

The requirements of graphical representation are not satisfied by:

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

Sign	Case No
 <p>Mark description: Smell of ripe strawberries</p>	<p>EUTM No 1 122 118</p>
<p><b>27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34</b>                      The Court considered that the smell of strawberries varies from one variety to another and the description</p>	

'smell of ripe strawberries' can refer to several varieties and therefore to several distinct smells. The description was found neither unequivocal nor precise and did not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed. Likewise, the image of a strawberry represents only the fruit that emits a smell supposedly identical to the olfactory sign at issue, and not the smell claimed, and therefore does not amount to a graphic representation of the olfactory sign.

## 2.2 Taste marks

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

## 2.3 Sound marks

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

The following **are not valid means** to graphically represent a sound:

- *Description of a sound in words*


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

- *Onomatopoeia*

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

- *Musical notes alone*

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

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

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

- *Musical notations (stave)*


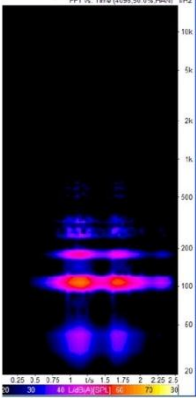
A stave divided into bars and showing, in particular, a clef (a treble, bass, alto or tenor clef), musical notes and rests whose form (for the notes: semibreve, minim, crotchet, quaver, semiquaver, etc.; for the rests: semibreve rest, minim rest, crotchet rest, quaver rest, etc.) indicates the relative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

- *MP3 files with another suitable graphic representation*

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

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

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

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

## 2.4 Movement marks

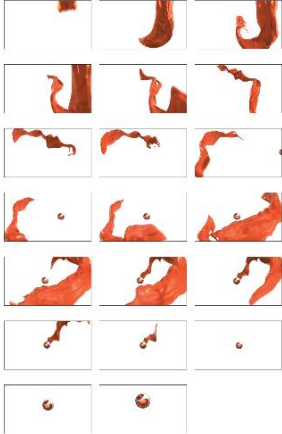
A movement mark **may only be refused** registration under Article 7(1)(a) EUTMR when a ‘reasonably observant person with normal levels of perception and intelligence would, upon consulting the EUTM register, [not be] able to understand precisely what the mark consists of, without expending a huge amount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


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

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




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

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

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

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

Sign	Case
 <p data-bbox="233 562 767 694"><u>Description:</u> The mark comprises a moving image consisting of a toothbrush moving towards a tomato, pressing onto the tomato without breaking the skin, and moving away from the tomato.</p>	<p data-bbox="979 450 1161 472">EUTM 9 742 974</p>
<p data-bbox="261 714 1334 768">The Office rejected the application as it was not possible to establish the precise movement from the description provided along with the graphic representation</p>	

## 2.5 Colour marks


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

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

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

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

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


Sign	Case number
 <p><b>Colours indicated:</b> Green, Pantone 368 C, anthracite, Pantone 425 C, orange, Pantone 021 C</p> <p><b>Description:</b> The trade mark consists of the colours green: Pantone 368 C; anthracite: Pantone 425 C; orange: Pantone 021 C, as shown in the illustration; the colours are applied to a basic component of the exterior of vehicle service stations (petrol stations) in the ratio green 60 %, anthracite 30 % and orange 10 %, creating the impression of a green and anthracite-coloured petrol station (green predominating) with small orange accents.</p>	<p>EUTM 8 298 499</p>

## 2.6 Position mark

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

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

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


Sign	Case Number
 <p><b>Initial description:</b> 'a copper ring between two metal layers, which is visible at the upper rim of the body of a cooking utensil like a pot or a pan'.</p> <p><b>Final Description:</b> <i>The trade mark is a positional trade mark whereby a narrow copper ring is positioned visibly between two metal layers on the upper rim of the body of a pot or pan.</i></p>	<p>EUTM 8 316 184</p>

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

The description was modified by the applicant during the examination proceedings (see above) and the objection under Article 7(1)(a) EUTMR was waived as a consequence of the new description.

## 2.7 3D representation of a space

Following the judgment of 10/07/2014, C-421/13, Apple, EU:C:2014:2070, it cannot be excluded that the requirements of graphic representation of the layout of a retail store are satisfied by a design alone, combining lines, curves and shapes, without any indication of the size or the proportions. The Court indicated that in such a case, the trade mark could be registered provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings and if no other grounds for refusal apply.

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

## 3 Relationship with other EUTMR provisions

Article 7(1)(a) EUTMR reflects the Office's obligation to refuse signs that do not conform to the requirements of Article 4 EUTMR. If the sign does not meet these requirements, there is no acceptable graphical representation and the application will be examined in the light of the other absolute grounds for refusal.

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