

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

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

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 3

***NON-DISTINCTIVE TRADE MARKS
(Article 7(1)(b) EUTMR)***

Table of Contents

1	General Remarks	3
2	Word Elements	3
3	Titles of Books	5
4	Colours	5
	4.1 Single colours.....	6
	4.2 Colour combinations.....	6
5	Single Letters	8
	5.1 General considerations.....	8
	5.2 Examples	9
6	Slogans: Assessing Distinctive Character	9
7	Simple Figurative Elements.....	13
8	Commonplace Figurative Elements.....	14
9	Typographical Symbols	15
10	Pictograms	16
11	Common/Non-Distinctive Labels	17
12	Three-Dimensional Trade Marks	18
	12.1 Preliminary remarks	18
	12.2 Shapes unrelated to the goods or services themselves.....	19
	12.3 Shape of the goods themselves or shapes related to the goods or services.....	19
	12.4 Shape of the packaging	24
13	Pattern Marks.....	25
14	Position Marks	29
15	Sound Marks	30

1 General Remarks

According to settled case law, distinctiveness of a trade mark within the meaning of Article 7(1)(b) EUTMR means that the sign serves to identify the product and/or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (judgments of 29/04/2004, joined cases C-468/01 P to C-472/01 P, Tabs (3D), EU:C:2004:259, § 32; 21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 42; and 08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 66; and 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 33). According to settled case law, such distinctiveness can be assessed only by reference first to the goods or services in respect of which registration is sought and, second, to the relevant public's perception of that sign (judgment of 12/07/2012, C-311/11 P, Wir machen das Besondere einfach EU:C:2012:460, § 24 and case law cited).

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

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

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

2 Word Elements

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

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

- **ECO** as denoting ‘ecological’ (judgments of 24/04/2012, T-328/11, EcoPerfect, EU:T:2012:197, § 25 and of 15/01/2013, T-625/11, EcoDoor, EU:T:2013:14, § 21);
- **FLEX** and **FLEXI** as referring to “flexible” (T-352/12 FLEXI, ECLI:EU:T:2014:519 §20-21)
- **GREEN** as being environmentally friendly (T-106/14, Grenworld, ECLI:EU:T:2015:123, § 24);
- **MEDI** as referring to ‘medical’ (judgment of 12/07/2012, T-470/09, Medi, EU:T:2012:369);
- **MULTI** as referring to ‘much, many, more than one’ (decision of 2 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)
- **MEGA** as denoting “big” (T-137/13 Megarail, ECLI:EU:T:2015:232 § 38);
- **Premium/PREMIUM** as referring to ‘best quality’ (judgments of 22/05/2012, T-60/11, Suisse Premium, EU:T:2014:25, § 46-49, 56, 58; and of 17/01/2013, joined cases T-582/11 and T-583/11, Premium XL / Premium L, EU:T:2013:24, § 26);
- **PLUS** as denoting ‘additional, extra, of superior quality, excellent of its kind’. (decision of 15/12/1999, R 329/1999-1, PLATINUM PLUS);
- **SUPER** for highlighting the positive qualities of the goods or services (T-464/08 superleggera, ECLI:EU:T:2010:212 §23-30 and T-86/01 Kit Super Pro, ECLI:EU:T:2002:279 § 26)
- **ULTRA**¹ as denoting ‘extremely’ (decision of 09/12/2002, R 333/2002-1, ULTRAFLEX);
- **UNIVERSAL** as referring to goods that fit for general or universal use (judgment of 02/05/2012, T-435/11, UniversalPHOLED, EU:T:2012:210, § 22, 28).

Top level domain endings, such as ‘.com’, only indicate the place where information can be found 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 was confirmed by the General Court in its judgment of 21/11/2012, T-338/11, Photos/com, EU:T:2012:614, § 22, where it was stated that the element ‘.com’ is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site. Furthermore, it may also indicate that the goods and services covered by the trade mark application can be obtained or viewed online, or are internet related. Accordingly,

¹ Amended on 23/06/2010.

the element in question must also be considered to be devoid of distinctive character in respect of the goods or services concerned.

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

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

3 Titles of Books

Trade marks consisting solely of a famous story or book title may be non-distinctive under Article 7(1)(b) EUTMR in relation to goods and services that could have that story as their subject matter. The reason for this is that certain stories (or their titles) have been established for so long and become so 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’, ‘Cinderella’ and ‘The Iliad’ are perfectly capable of being distinctive trade marks for paint, clothing or pencils. However, they are incapable of performing a distinctive role in relation to books or films, for example, because consumers will simply think that these goods refer to the story of Peter Pan or Cinderella, this being the only meaning of the terms concerned.

Objections should only be raised in such cases where the title in question is famous enough to be truly well known to the relevant consumer and where the mark can be perceived in the context of the goods/services as primarily signifying a famous story or book title. A finding of non-distinctiveness in this regard will be more likely where it can be shown that a large number of published versions of the story have appeared and/or where there have been numerous television, theatre and film adaptations reaching a wide audience, in particular when a work has passed into the public domain once copyright protection has expired. In cases where copyright is still running, the Office will presume good faith and register the mark (which can later be the subject of a cancellation action if the applicant was not entitled to file the EUTM application).

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

4 Colours

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

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

assumption that the colour combination in the way it is filed appears on the goods or their packaging, or in advertisements or promotional material for the services.

4.1 Single colours

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

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

Such very special circumstances require the applicant to demonstrate that the mark is absolutely unusual or striking in relation to these specific goods. These cases will be extremely rare, for example in the case of the colour black for milk. It is not necessary for a refusal that one of the factors listed in paragraph 4.2 below is present, but if this is the case, it should be used as a further argument in support of the refusal. Where the single colour is found to be commonly used in the relevant sector(s) and/or to serve a decorative or functional purpose, the colour must be refused. The public interest is, according to the Court, an obstacle to the monopolisation of a single colour irrespective of whether the relevant field of interest belongs to a very specific market segment (judgment of 13/09/2010, T-97/08, *Colour (shade of orange) II*, EU:T:2010:396, § 44-47).

4.2 Colour combinations

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

For example, a mark comprising a small yellow stripe on top of red is different from red and yellow presented in even proportions, with red on the left side. An abstract claim, in particular to two colours 'in any possible combination' or 'in any proportion', is not allowable and leads to an objection under Article 7(1)(a) EUTMR (decision of 27/07/2004, R 730/2001-4, *GELB/BLAU/ROT*, § 34). This must be distinguished from the indication of how the colour combination would appear on the product, which is not

required because what matters in connection with the assessment of inherent distinctiveness is the subject matter of the registration, not the way it is or can be used on the product.

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

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

- In many instances, a colour would merely be a decorative element of the goods or comply with the consumer's request (e.g. colours of cars or T-shirts), irrespective of the number of colours concerned.
- A colour can be the nature of the goods (e.g. for tints).
- A colour can be technically functional (e.g. colour red for fire extinguishers, various colours used for electric cables).
- A colour may also be usual (e.g. again, red for fire extinguishers, yellow for postal services in many countries).
- A colour may indicate a particular characteristic of the goods such as a flavour (yellow for lemon flavour, pink for strawberry flavour).
- 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 different competitors (e.g. the Office proved that the colour combination red and yellow is used by various enterprises on beer and soft drink cans).

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

The criteria to assess the distinctiveness of colour marks designating services should not be different from those applicable to colour marks designating goods (as recalled by the General Court in its judgment of 12/11/2010, T-404/09, *Grau/Rot*, EU:T:2010:466). In this case, the colour combination applied for was considered not to differ for the relevant consumer in a perceptible manner from the colours generally 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 of colours is, the less distinctiveness is likely, because of the difficulty of memorising a high number of different colours and their sequence.

For the names of colours see Guidelines, Part B Examination, Section 4 Absolute Grounds for refusal, Chapter 4: Descriptive trade marks.

5 Single Letters²

5.1 General considerations

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

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

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

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

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

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

² This part deals with single letters under Article 7(1)(b) EUTMR. For single letters under Article 7(1)(c) EUTMR, see Guidelines, Part B Examination, Section 4 Absolute Grounds for refusal, Chapter 4: Descriptive trade marks.

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

5.2 Examples

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

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

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

Another example of lack of distinctiveness would be a single-letter trade mark applied for in respect of toy cubes (of the sort often used to teach children how to construct words by combining letters appearing on the cubes themselves) that does not describe the product as such.

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

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



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

For further examples see Guidelines, Part B Examination, Section 4 Absolute Grounds for refusal, Chapter 4: Descriptive trade marks.

6 Slogans: Assessing Distinctive Character

The Court of Justice has ruled that it is inappropriate to apply to slogans stricter criteria than those applicable to other types of signs when assessing their distinctive character (judgment of 12/07/12, C-311/11 P, *Wir machen das Besondere einfach*, EU:C:2012:460 and case law cited).

Advertising slogans are objectionable under Article 7(1)(b) EUTMR when the relevant public perceives them as a mere promotional formula. However, they are deemed to be distinctive if, apart from their promotional function, the public perceives them as an indication of the commercial origin of the goods or services in question.

The Court of Justice has provided the **following criteria** that should be used when assessing the distinctive character of a slogan (judgments of 21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, § 47; 13/04/2011, T-523/09, *Wir machen das Besondere einfach*, EU:T:2011:175, § 37).

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

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

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

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

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

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

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

Moreover, according to well-established case law from the General Court, the level of attention of the relevant public may be **relatively low** when it comes to promotional indications, whether what is involved are average end consumers or a more attentive public made up of specialists or circumspect consumers. This finding is applicable even for goods and/or services where the level of attention of the relevant public is generally

high, such as financial and monetary services (judgments of 29/01/2015, T-609/13, SO WHAT DO I DO WITH MY MONEY, EU:T:2015:688, § 27; T-59/14, INVESTING FOR A NEW WORLD, EU:T:2015:56, § 27 and cited case law).

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

EUTM	Main function	Case No
EUTM No 5 904 438 MORE THAN JUST A CARD for Class 36 <i>(bank, credit and debit card services)</i>	Customer service statement	R 1608/2007-4
Objected to under Article 7(1)(b) EUTMR The slogan merely conveys information about the goods and services for which protection is sought. It is the kind of language an English speaker would use to describe a bank card that is a little out of the ordinary. It conveys the notion that the card has welcome features that are not obvious at first sight. The fact that the slogan leaves open what these features are, that is to say, that the mark does not describe a specific service or characteristic of the 'card', does not make the mark distinctive.		
EUTM	Main function	Case No
EUTM No 7 394 414 WE PUT YOU FIRST. AND KEEP YOU AHEAD for Class 40	Customer service statement	(Examiner's decision without BoA case)
Objected to under Article 7(1)(b) EUTMR The mark is a promotional laudatory message, highlighting the positive aspects of the services, namely that they help to procure the best position in the business and maintain this position in the future.		
EUTM	Main function	Case No
EUTM No 6 173 249 SAVE OUR EARTH NOW for Classes 3, 17, 18, 20, 22, 24, 25 and 28	Value statement or political motto	R 1198/2008-4
Objected to under Article 7(1)(b) EUTMR The sign is a simple and straightforward appeal to take action and contribute to the Earth's well-being by favouring the purchase of environment-friendly products. Contrary to the appellant's contentions that the word 'now' constitutes an original element since nobody will believe that by purchasing the goods in question they will literally save the Earth now, the word 'NOW' is an emotional word commonly used in marketing to urge consumers to consume, to get what they want without waiting; it is a call to action. The relevant consumer will immediately recognise and perceive the sign as a promotional laudatory expression indicating that the goods represent an environment-friendly alternative to other goods of the same sort, and not as an indication of commercial origin.		
EUTM	Main function	Case No
EUTM No 4 885 323 DRINK WATER, NOT SUGAR for Classes 32 and 33	Inspirational or motivational statement	R 718/2007-2
Objected to under Article 7(1)(b) EUTMR The mark is a banal slogan that merely conveys the idea that the consumer will be drinking real water rather than a sugary drink. The mark lacks any secondary or covert meaning, has no fanciful elements, and its message to the consumer is plain, direct and unambiguous. For these reasons, it is unlikely to be perceived as a sign of trade origin. It is easily seen that the mark consists merely of good counsel, namely that it is better from a health point of view to drink water that has not been sugared. What better way to promote such goods than by an expression such as DRINK WATER, NOT SUGAR? Consumers will read this with approval, but will look elsewhere on the product for the trade mark.		

EUTM	Main function	Case No
DREAM IT, DO IT! Classes 35, 36, 41 and 45	Inspirational or motivational statement	T-186/07
<p>The relevant English-speaking public will see this as an invitation or encouragement to achieve their dreams and will understand the message that the services covered by that trade mark will allow them to do so.</p>		
EUTM	Main function	Case No
VALORES DE FUTURO for Class 41	Value statement	Judgment of 06/12/2013, T-428/12
<p>Objected to under Article 7(1)(b) EUTMR</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 of the services involved.</p>		
EUTM	Main function	Case No
INVESTING FOR A NEW WORLD Classes 35 and 36	Value statement	Judgment of 29/01/2015, T-59/14
<p>Objected to under Article 7(1)(b) EUTMR</p> <p>The sign INVESTING FOR A NEW WORLD, considered as a whole, may be easily understood by the relevant public, in view of the common English words of which it consists, as meaning that the services offered are intended for a new world's needs. Given that the services covered by the mark applied for are all related to activities connected with finance and have a close link with the word 'investing', the Board of Appeal was right to find that the message conveyed by the expression 'investing for a new world' was that, when purchasing the services in question, the money or capital invested created an opportunity in a new world, which carried a positive connotation. The Court also found that the fact that the expression at issue could be interpreted in a number of ways did not alter its laudatory nature.</p>		
EUTM	Main function	Case No
SO WHAT DO I DO WITH MY MONEY Classes 35 and 36	Value statement	Judgment of 29/01/2015, T-609/13
<p>Objected to under Article 7(1)(b) EUTMR</p> <p>The expression 'so what do I do with my money' prompts consumers to ask themselves what they should do with their financial resources and assets. In the present case, the average reasonably well-informed and reasonably observant and circumspect consumer of the services covered by the application for registration will, on reading or hearing that expression, wonder whether he or she is using his or her money effectively.</p>		
EUTM	Main function	Case No
PIONEERING FOR YOU Classes 7, 9, 11, 37 and 42	Value statement	Judgment of 12/12/2014, T-601/13
<p>Objected to under Article 7(1)(b) EUTMR</p> <p>The sign would be understood as 'innovative for you'. The meaning of the sign is clear and does not leave any doubts. The structure of the sign is grammatically correct and does not trigger any mental process in order to arrive at its meaning. It is, as a whole, a simple message that could be attributed to any producer or service provider with the natural consequence that it does not indicate the origin of the goods or services</p>		

Some examples of **accepted** slogans:

EUTM	Classes	Case No
SITEINSIGHTS	Classes 9 and 42	R 879/2011-2, EUTM No 9 284 597
The mark 'SITEINSIGHTS' shows some degree of originality and expressiveness, which makes it easy to remember. It contains a play on words as the word 'SITE' and the 'SIGHT' element of 'INSIGHTS' are pronounced identically.		
EUTM	Classes	Case No
WET DUST CAN'T FLY	Classes 3, 7 and 37	T-133/13
The concept of 'wet dust' is literally inaccurate, since dust is no longer dust when it is wet. Consequently, the juxtaposition of those two words gives that concept a fanciful and distinctive character.		

A slogan is objectionable under Article 7(1)(c) EUTMR if it immediately conveys information about the kind, quality, intended purpose or other characteristics of the goods or services (see Guidelines, Part B Examination, Section 4 Absolute Grounds for refusal, Chapter 4: Descriptive trade marks).

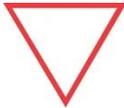
7 Simple Figurative Elements

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

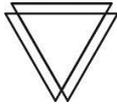
As set out by the Court, an extremely simple sign, composed of a basic geometric figure such as a circle, a line, a rectangle or a pentagon is not capable, as such, of conveying a message that consumers can remember, with the result that they will not consider it as a trade mark (judgment of 12/09/2007, T-304/05, Pentagon, EU:T:2012:271, § 22).

Examples of refused trade marks

Sign	G&S	Reasoning	Case
	Class 33	The sign consists merely of a normal pentagon, a simple geometric figure. The geometric form, if it happened to be the form of the label, would be perceived as having a functional or aesthetic purpose rather than an origin function.	Judgment of 12/09/2007, T-304/05, Pentagon, EU:T:2007:271
	Classes 9, 14, 16, 18, 21, 24, 25, 28, 35-39, 41-45	The sign will be perceived as an excessively simple geometric shape, essentially as a parallelogram. To fulfil the identification function of a trade mark, a parallelogram should contain elements which singularise it in relation to other parallelograms' representations. The two characteristics of the sign are the fact that it is slightly inclined towards the right and that the base is slightly rounded and stretched out towards the left. Such nuances would not be perceived by the general consumer.	Judgment of 13/04/2011, T-159/10, Parallélogramme, EU:T:2011:176

Sign	G&S	Reasoning	Case
	Classes 14, 18, 25	The sign does not contain any elements that may be easily and instantly memorised by an attentive relevant public. It will be perceived only as a decorative element, regardless of whether it relates to goods in Class 14 or to those in Classes 18 and 25.	Judgment of 29/09/2009, T-139/08, Smiley, EU:T:2009:364
	Class 9	The sign consists of a basic equilateral triangle. The inverted configuration and red outline of the triangle do not serve to endow the sign with distinctive character. The sign's overall impact remains that of a simple geometric shape that is not capable of transmitting a trade mark message prima facie.	International registration No 1 091 415
	Classes 3, 18, 24, 43, 44	The sign consists of merely a simple geometric figure in green. The specific colour is commonly and widely used in advertising and in the marketing of goods and services for the power to attract without giving any precise message.	Judgment of 09/12/2010, T-282/09, Carré convexe vert, EU:T:2010:508

Example of an accepted trade mark

Sign	G&S	Reasoning	Case
	Classes 35, 41	The sign creates the illusion of two overlapping triangles, but it is actually a single line which describes a path that does not create any actual triangles at all. It is not a simple juxtaposition of two basic shapes, but rather a creative arrangement of lines giving a distinctive overall impression..	EUTM No 10 948 222

Further examples of simple figurative elements (combined with non-distinctive/descriptive terms) can be found in Guidelines, Part B Examination, Section 4 Absolute Grounds for refusal, Chapter 4: Descriptive trade marks.

8 Commonplace Figurative Elements

In some cases, the figurative element consists of a representation of the goods and services for which the trade mark is protected. In principle, said representation is considered to be descriptive and/or devoid of distinctive character whenever it is a true-to-life portrayal of the goods and services or when it consists of a symbolic/stylised portrayal of the goods and services that does not depart significantly from the common representation of said goods and services.

In other cases, the figurative element might not represent the goods and services but might still have a direct link with the characteristics of the goods and/or services. In such cases, the sign will be considered non-distinctive, unless it is sufficiently stylised.

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



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



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

The above sign was refused, as representations of cows are commonly used in relation to milk and milk products. The fact that the subject mark consists of an ‘aerial’ picture of a cow is not sufficient to confer distinctive character on 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’.

Further examples of common figurative elements (combined with non-distinctive/descriptive terms) can be found in Guidelines, Part B Examination, Section 4 Absolute Grounds for refusal, Chapter 4: Descriptive trade marks.

9 Typographical Symbols

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

The following marks were objected to.

Sign	G&S	Reasoning	Case
	Classes 14, 18 and 25	The GC confirmed the finding of the BoA that the trade mark applied for is devoid of the necessary degree of distinctive character. It consists merely of a punctuation mark with no special additional features immediately apparent to customers, and is a commonplace sign that is frequently used in business or in advertising. In view of its frequent use, the relevant consumer will see the exclamation mark as being merely laudatory advertising or something to catch the eye (judgment of 30/09/2009, T-75/08, I, EU:T:2009:374).	EUTM No 5 332 184

Sign	G&S	Reasoning	Case
	<p>Classes 29, 30, 31 and 32</p>	<p>The sign applied for was refused because, in the case of the goods for which the trade mark is protected (foodstuffs and beverages), percentages are particularly important in relation to the price. For example, the percentage sign indicates clearly that there is a favourable cost/benefit ratio because the price has been reduced by a particular percentage in comparison with the normal price. Such a per cent sign in a red circle is also frequently used in connection with clearance sales, special offers, stock clearances or cheap no-name products, etc. The consumer will regard the sign merely as a pictogram conveying the information that the goods for which the trade mark is protected are sold at a reduced price (see decision of 16/10/2008, R 998/2008-1, Other mathematical symbols % (fig.)).</p>	<p>EUTM No 5 649 256</p>

10 Pictograms

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

Commonly used pictograms, for example, a white ‘P’ on a blue background to designate a parking place (this sign could also be objectionable under Article 7(1)(d) EUTMR) 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.

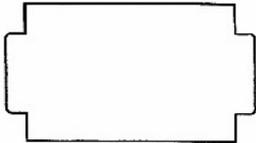
Sign	Reasoning	Case
	<p>Taking into account the kind of goods and services for which protection is sought in Classes 9, 35, 36, 38 and 42 (for example, cash dispensers, banking services), the public will see the sign as a practical indication or as directional arrows showing where the magnetic card has to be inserted into the distributor. The association of the triangles with 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).</p>	<p>Judgment of 02/07/2009, T-414/07, Main tenant une carte, EU:T:2009:242</p>

Sign	Reasoning	Case
 <p>EUTM No 9 894 528 for goods in Class 9</p>	<p>The above sign was refused as it is identical to the core of the international safety symbol for 'high voltage' or 'caution, risk of electric shock'. The device applied for, within the triangle denoting a hazard symbol, has been officially defined by ISO 3864 as the standard high voltage symbol. Because this sign essentially coincides with the customary international sign to indicate a risk of high voltage, it was refused under Article 7(1)(b) EUTMR.</p>	<p>Decision of 21/09/2012, R 2124/2011-5, DEVICE OF LIGHTNING BOLT (fig.)</p>
	<p>Refused for Class 9 goods. The public will encounter this used as a pictogram on a mobile phone, computer, tablet or similar to indicate access to a program or application that allows the user to make notes or write text. Some of these applications convert handwriting into typewritten text.</p>	<p>EUTM No 12 717 914</p>
	<p>Refused for Class 9 goods. The public will encounter this bar chart used as a pictogram on a mobile phone, computer, tablet or similar to indicate access to a program, tool or application that allows the user to produce statistical material.</p>	<p>EUTM No 12 717 823</p>
	<p>Refused for Class 9 goods. The public will encounter this schematic table or lectern used as a pictogram on a mobile phone, computer, tablet or similar to indicate access to a program or application that allows the user to prepare and store presentations, speeches or lectures.</p>	<p>EUTM No 12 717 682</p>

11 Common/Non-Distinctive Labels

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

See the following examples:

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

Sign	Reasoning	Case
 <p data-bbox="231 499 531 584">EUTM No 9 715 319 for goods in Classes 6, 7, 8, 9 and 20</p>	<p data-bbox="547 241 1086 734">The mark was refused, as its basic shape combined only with a bright yellow colour could not, in the minds of the relevant professional and general public, serve to distinguish the goods for which protection was sought as originating from a particular undertaking. Here, the colour yellow may be perceived as a decoration for the goods, as well as for the purpose of attracting attention to the goods without giving any specific information or precise message as to the commercial origin of the goods. In addition, as is generally known, bright 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 as an alert or decoration.</p>	<p data-bbox="1099 421 1350 555">Decision of 15/01/2013, R 0444/2012-2, Device of a label in yellow colour</p>

In the same way, the following marks were rejected.



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



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



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

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

12 Three-Dimensional Trade Marks

12.1 Preliminary remarks

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

For signs consisting of the shape of the goods themselves, no stricter criteria 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 (judgment of 08/04/2002, C-136/02 P, Torches, EU:C:2004:592, § 30).

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

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

12.2 Shapes unrelated to the goods or services themselves

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

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

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

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

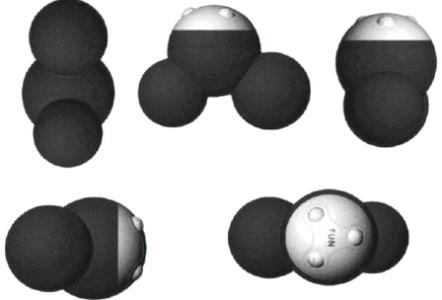
Step 1: Article 7(1)(e) EUTMR analysis

The examiner should first examine whether one of the grounds for refusal under Article 7(1)(e) EUTMR applies, as those cannot be overcome through acquired distinctiveness. With regard to this first step, see Guidelines, Part B Examination, Section 4 Absolute Grounds for refusal, Chapter 14: Acquired distinctiveness through use.

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

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

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

Sign	Case
	<p>R 1511/2013-2 (26/11/2015, T-390/14, JK KANGOO JUMPS XR, EU:T:2015:897)</p>
<p>BoA confirmed that the figurative element 'KANGOO JUMPS' (in both the upper and lower spring layers) and the letters 'KJ' and 'XR' (at the ends of the intermediate elastic plastic straps) could only be seen with great difficulty or not at all. Parts such as these, which can only be noticed on close inspection, are, in general, not to be perceived as an indication of origin (para. 29). The GC confirmed the BoA decision, stating that '...the word and figurative elements of the mark ... are extremely minor ... and, therefore ... of such a superficial nature that they do not bring any distinctive character to the mark applied for as a whole.' (para. 27)</p>	
Sign	Case
	<p>12/07/2012, T-323/11, Botella, EU:T:2012:376</p>
<p>An image depicting certain stones is embossed on the central part of the bottle.</p> <p>The Court confirmed the BoA decision when it considered that the applicant had failed to prove that European consumers have sufficient information and knowledge to recognise that the embossing on the central part of the bottle at issue depicts the twelve-angle stones used in Inca constructions. Without that proof, European consumers will merely perceive the embossing as such without being aware of its significance, from which it follows that they will simply perceive it as a mere decoration without any distinctive character, because it is not particularly original or striking; therefore, it will not serve to differentiate the bottle in question from other bottles widely used in the packaging of beers (para. 25 et seq.).</p>	
Sign	Case
	<p>18/01/2013, T-137/12, Vibrator, EU:T:2013:26</p>
<p>The Court considered that the descriptive element 'fun' could not confer distinctiveness on the 3D sign. Moreover, the BoA was right not to take into account the element 'factory' written above the word 'fun', as it was illegible in the application (para. 34 et seq.).</p>	

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 or she has had positive experiences with the goods. Frozen vegetables in the form of a crocodile are a good example of this.

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

- A shape is non-distinctive if it is a basic shape (judgment of 19/09/2001, T-30/00, *Henkel v OHMI* (Image d'un produit détergent), EU:T:2001:223) or a combination of basic shapes (decision of 13/04/2000, R 263/1999-3).
- To be distinctive, the shape must depart significantly from the shape that is expected by the consumer, and it must depart significantly from the norm or customs of the sector. The more closely the shape resembles the shape that is most likely to be taken by the product in question, the greater the likelihood that it is not distinctive (judgment of 07/10/2004, C-136/02 P, *Torches*, EU:C:2004:592, § 31).
- It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs (judgments of 07/10/2004, C-136/02 P, *Torches*, EU:C:2004:592, § 32 and 07/02/2002, T-88/00, *Torches*, EU:T:2002:28, § 37).
- Functional shapes or features of a three-dimensional mark will be perceived by the consumer as such. For example, for washing tablets, bevelled edges avoid damage to 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, *Henkel v OHMI* (Image d'un produit détergent), EU:T:2001:223, § 49).

Specific case: 3D toys, dolls and play figures

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

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

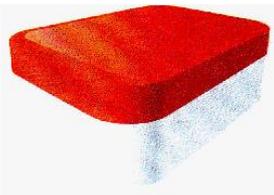
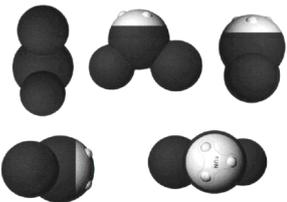
This may be complicated by the sheer volume and proliferation of toy animals, figures, dolls and assorted characters in this market sector. Simply adding a **basic** set of **clothing or basic human characteristics** such as eyes or a mouth to a common

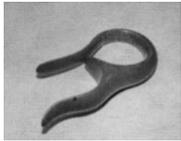
plush toy such as a rabbit or a cat will generally not suffice. It is commonplace to present toy dolls and animals in clothing and to provide a separate range of clothing options, so that the user of such goods can change the appearance of the toy. It is also common to humanise the toys to make them more attractive. Within such a high-volume marketplace, the presentation of these goods in such a way will invariably leave the relevant consumer struggling, without prior exposure, to perceive a badge of origin in such marks.

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

Examples:

The following is a list of examples of shapes of goods for which protection has been sought and an 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, <i>Henkel v OHMI</i> (Image d'un produit détergent, EU:T:2001:223, § 44, 53). The same approach has been confirmed by several judgments, including that of 04/10/2007, C-144/06 P, <i>Tabs</i> (3D), EU:C:2001:577.</p>	<p>Judgment of 19/09/2001, T-30/00, <i>Henkel v OHMI</i> (Image d'un produit détergent EU:T:2001:223</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 07/10/2004, C-136/02 P, <i>Torches</i>, EU:C:2004:592</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 that are spherical or round (para. 29). The addition of the small descriptive word element 'fun factory' does not remove the overall shape from the scope of non-distinctiveness (para. 36).</p>	<p>Judgment of 18/01/2013, T-137/12, <i>Vibrator</i>, EU:T:2013:26.</p>

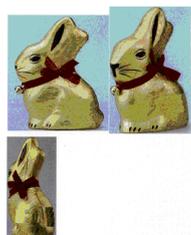
Sign	Reasoning	Case
 <p>Three images showing a rectangular chocolate bar with a textured, slightly irregular surface, representing a three-dimensional sign.</p>	<p>The Court of Justice confirmed the refusal of this three-dimensional sign as not being sufficiently different from the shapes and colours of those commonly used in the sweet 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, Milchmäuse, EU:C:2012:537</p>
 <p>A black and white image of a hand-operated agricultural implement, specifically a pair of shears or clippers, shown from a side perspective.</p>	<p>This three-dimensional mark consisting of a handle, applied to goods in Class 8 (<i>hand-operated implements used in agriculture, horticulture and forestry, including secateurs, pruning shears, hedge clippers, shearers (hand instruments)</i>), was refused.</p>	<p>Judgment of 16/09/2009, T-391/07, Teil des Handgriffes, EU:T:2009:336</p>
 <p>A white, oval-shaped computer mouse with a complex hollow design on its surface, representing a three-dimensional trade mark.</p>	<p>The Court confirmed the case law on non-distinctiveness of three-dimensional trade marks in the form of a product or its packaging. Even if the oval shape in the EUTM application has a complex hollow on its surface, this cannot be considered as significantly different from the shapes of confectionery available on the market.</p>	<p>Judgment of 12/12/2013, T-156/12, Oval, EU:T:2013:642</p>
 <p>Five small, green parrot-shaped toys standing on their hind legs, arranged in a horizontal line.</p>	<p>The parrot figure applied for, on its own, does not depart sufficiently from the usual form of parrot toys to be seen as a trade mark. Its coat colour resembles the green quite common among parrots. Its head is bigger than normal and it is standing on its hind legs but, in the Board's opinion, the majority of consumers would perceive the parrot shape as an ordinary parrot-shaped toy design, and a rather banal toy, but not as an indication of origin (para. 16).</p>	<p>R 2131/2013-5</p>
 <p>A black and white line drawing of a bulldog, shown in profile, facing right.</p>	<p>Accepted</p>	<p>EUTM No 015240534</p>

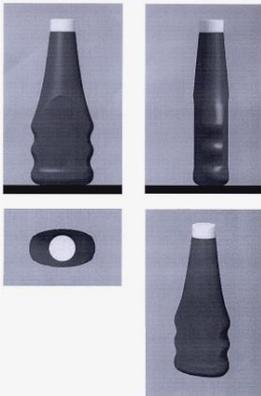
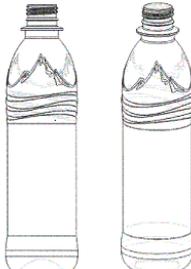
Analogous criteria, *mutatis mutandis*, apply to shapes related to services, for example the device of a washing machine for laundry services.

	<p>Class 35 — Retail Services for various goods and services.</p> <p>The case law on 3D marks consisting of the shape of the goods applies also with respect to services. The ‘get-up’ or appearance of services consists, in particular, of the environment in which they are offered and/or the means used in order to provide the services to the relevant consumer. Such ‘get-up’ is only distinctive where it significantly departs from the norms of the relevant sector. The salesroom depicted in the application will be perceived as having the merely functional purpose of enabling consumers to purchase conveniently the goods and services offered for inspection and sale.</p>	<p>R 2224/2015-1</p>
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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. In the area of containers, regard must also be had to any functional character of a given element. As in the field of containers and bottles, 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, a search must be carried out in relation to containers for beverages in general; see, in that regard, the Opinion of the Advocate General of 14/07/2005, C-173/04 P, *Deutsche SiSi-Werke v OHIM*, EU:C:2005:474).

Sign	Reasoning	Case
	<p>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 industry concerned. 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).</p>	<p>Judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307</p>

Sign	Reasoning	Case
	<p>The mark, the representation of a twisted wrapper serving as packaging for sweets (and thus not the product itself), was refused registration as it is a 'normal and traditional shape for a sweet wrapper and ... a large number of sweets so wrapped could be found on the market' (para. 56). The same applies in respect of the colour of the wrapper in question, namely 'light brown (caramel)'. This colour is not unusual in itself, and neither is it rare to see it used for sweet wrappers (para. 56). Therefore, the average consumer will not perceive this packaging in and of itself as an indicator of origin, but merely as a sweet wrapper.</p>	<p>Judgment of 10/11/2004, T-402/02, Bonbonverpackung, EU:T:2004:330</p>
	<p>The refusal of the shape applied for was confirmed by the General Court. The elongated neck and the flattened body do not depart from the usual shape of a bottle containing the goods for which protection was sought, 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, these alone are insufficient to influence the overall impression given by the shape applied for to such an extent that it departs significantly from the norm or customs of the sector (para. 53).</p>	<p>Judgment of 15/03/2006, T-129/04, Plastikflaschenform, EU:T:2006:84</p>
	<p>It is a well-known fact that bottles usually contain lines and creases on them. The relief at the top is not sufficiently striking but will be perceived as a mere decorative element. As a whole, the 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 19/04/2013, T- 347/10, Getränkeflasche, EU:T:2013:201</p>

13 Pattern Marks

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

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

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

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

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

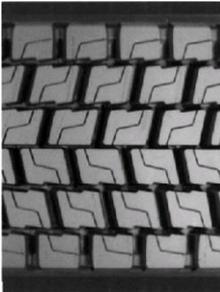
In principle, if a pattern is commonplace, traditional and/or typical, it is devoid of distinctive character. In addition, patterns that consist of basic/simple designs usually lack distinctiveness. The reason for the refusal lies in the fact that such patterns do not convey any 'message' that could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

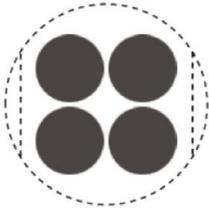
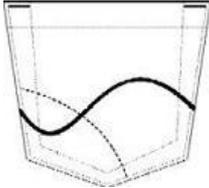
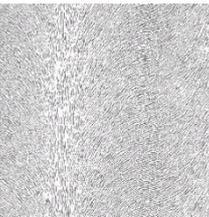
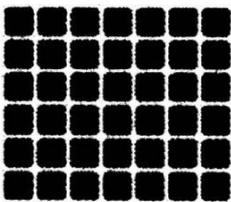
In this regard, it must be taken into account that the average consumer tends not to look at things analytically. A trade mark must therefore enable average consumers of the goods/services in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the product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

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

As seen above, the distinctive character of pattern marks must usually be assessed with regard to goods. Nevertheless, a pattern mark that has been considered devoid of distinctive character for the goods it covers must also be regarded as lacking distinctiveness for services that are closely connected to those goods. For example, a stitching pattern that is devoid of distinctive character for clothing articles and leather goods must be regarded as lacking distinctiveness also for retail services concerning those goods (see by analogy decision of 29/07/2010, R 868/2009-4, *A device of a pocket* (fig.)). 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="244 622 523 703">EUTM No 8 423 841, filed as a figurative mark in Classes 18, 24 and 25</p>	<p data-bbox="549 331 1085 680">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 goods itself, as the mark was applied for in Classes 18, 24 and 25.</p>	<p data-bbox="1101 456 1358 560">Judgment of 19/09/2012, T-326/10, Stoffmuster, EU:T:2012:436, § 47-48</p>
 <p data-bbox="244 1034 523 1115">EUTM No 8 423 501, filed as a figurative mark in Classes 18, 24 and 25</p>	<p data-bbox="549 891 1085 949">In this case, similarly to the previous case, the General Court confirmed the refusal of the mark.</p>	<p data-bbox="1101 869 1348 972">Judgment of 19/09/2012, T-329/10, Stoffmuster, EU:T:2012:436</p>
 <p data-bbox="244 1460 523 1541">EUTM No 5 066 535 filed as a figurative mark in Class 12 (tyres)</p>	<p data-bbox="549 1205 1085 1473">Where the mark consists of a stylised representation of the goods or services, the relevant consumer will see prima facie the mere representation of the entire product or a specific part thereof. In this case of an application for tyres, the relevant consumer would perceive the mark as merely a representation of the grooves of a tyre, and not an indication of source of origin. The pattern is banal and the mark cannot fulfil its function as indicator of origin.</p>	<p data-bbox="1117 1317 1340 1375">Examiner's decision without BOA case</p>
 <p data-bbox="236 1845 533 1980">EUTM No 9 526 261, filed as a figurative mark (Series of stylised V letters), claiming goods in Classes 16, 18 and 25</p>	<p data-bbox="549 1657 1085 1899">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 data-bbox="1117 1756 1340 1814">Examiner's decision without BOA case</p>

Sign	Reasoning	Case
 <p>EUTM No 9 589 219, filed as a figurative mark for goods in Class 9</p>	<p>The sign, applied for in respect of ‘multi-well plates that can be used in chemical or biological analysis using electrochemiluminescence for scientific, laboratory or medical research use’, was refused as it does not serve the purpose of indicating origin. The application described the mark as corresponding to a pattern contained on the bottom of the goods, and the examiner was found to be correct in stating that due to the lack of any eye-catching features, the consumer would be unable to perceive it as anything other than a mere decoration of the goods.</p>	<p>Decision of 09/10/2012, R 412/2012-2, Device of four identically sized circles (fig.)</p>
 <p>EUTM No 6 900 898, for 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 such as 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, DESIGN OF TWO CURVES CROSSED AT ONE POINT INSERTED ON A POCKET (fig.) EU:T:2010:410, § 19-27</p>
 <p>EUTM No 3 183 068, filed as a figurative mark, for 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) EUTMR. It was reasoned that the relevant consumer is not used to perceiving designs applied to glass surfaces as an indication of origin and that the design is recognisable as a functional component to make the glass opaque. Furthermore, the complexity and fancifulness of the pattern are insufficient to establish distinctiveness, attributable to the ornamental and decorative nature of the design’s finish, and do not allow the design’s individual details to be committed to memory or to be apprehended without the product’s inherent qualities being perceived simultaneously.</p>	<p>Judgment of 09/10/2002, T-36/01, Glass pattern, EU:T:2002:245, § 26-28</p>
 <p>EUTM No 10 144 848, filed as a figurative mark for goods in Classes 3, 5, 6, 10, 11, 12, 16, 18, 20 and 21</p>	<p>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 that does not display any element or noticeable variation, in particular in terms of fancifulness or as regards the way in which its components are combined, that would distinguish it from the usual representation of another regular pattern consisting of a different number of squares. Neither the shape of each individual square nor the way they are combined are immediately noticeable features that could catch the average consumer’s attention and cause the consumer to perceive the sign as a distinctive one.</p>	<p>Decision of 14/11/2012, R 2600/2011-1, Device of a black and white pattern</p>

Sign	Reasoning	Case
 <p data-bbox="284 555 485 607">EUTM No 370 445 Class 18</p>	<p data-bbox="549 241 1085 680">The chequerboard pattern is a basic and commonplace figurative pattern, since it is composed of a regular succession of squares of the same size that are differentiated by alternating different colours, in this case brown and beige. The pattern thus does not contain any notable variation from the conventional representation of chequerboards and is the same as the traditional form of such a pattern. Even applied to goods such as those falling within Class 18, the pattern in question does not differ from the norm or customs of the sector inasmuch as such goods are generally covered with fabrics of different kinds, and the chequerboard pattern, due to its great simplicity, might constitute precisely one of those patterns (para. 37).</p>	<p data-bbox="1109 324 1350 600">T-359/12, Device of a chequered pattern (maroon & beige), EU:T:2015:215 and T-360/12, Device of a chequered pattern (grey), EU:T:2015:214 (Both judgments have been appealed before the CJ.)</p>

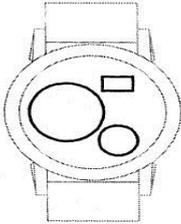
14 Position Marks

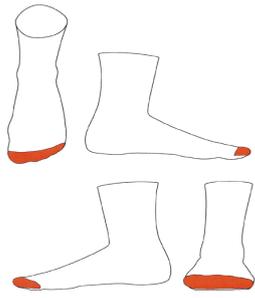
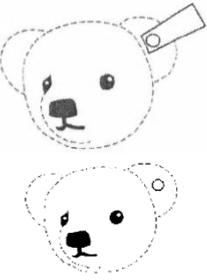
Applications for position marks effectively seek to extend protection to the specific way in which elements (figurative, colour, etc.) are placed or affixed on the product. The representation of the mark applied for must be accompanied by a description indicating the exact nature of the right concerned.

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

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

The following are examples of the assessment of position marks.

Sign	AG NOT OK	Case
	<p data-bbox="549 1594 1085 1868">In this case, the General Court upheld an objection under Article 7(1)(b) EUTMR. The mark description specified that 'The mark consists of the position of the circular and rectangular fields on a watch face'. The Court considered that the mark was not independent or distinguishable from the form or design of the product itself and that the positioned elements were considered not substantially different from other designs on the market.</p>	<p data-bbox="1109 1691 1350 1771">Judgment of 14/09/2009, T-152/07, Uhr, EU:T:2009:324</p>

Sign	AG NOT OK	Case
	<p>In this case involving hosiery consisting of an orange stripe covering the toe area, the General Court considered that there was no evidence to suggest that the colouring of this part of the product would normally be perceived as having trade mark character. On the contrary, it was considered that this feature would be likely to be perceived as a decorative feature falling within the norms and customs of the market sector. The Article 7(1)(b) EUTMR objection was therefore maintained.</p>	<p>Judgment of 15/06/2010, T-547/08, Strumpf, EU:T:2010:235</p>
Sign	AG NOT OK	Case
	<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, Knopff im Stofftierohr, EU:T:2014:8 and T-434/12, Fähnchen im Stofftierohr, EU:T:2014:6</p>

15 Sound Marks

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

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

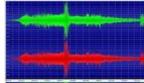
The perception of the relevant public is not necessarily the same in the case of a sign consisting of a sound per se as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods it denotes. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign is merely a sound (by analogy, judgment of 04/10/2007, C-144/06 P, Tabs (3D), EU:C:2007:577, § 36). By the same token, **only a sound that departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin** is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (by analogy, judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 42).

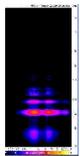
The kinds of sound marks that are **unlikely** to be accepted without evidence of factual distinctiveness include:

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

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

Examples

Sign	Description	G&S	Result	Reasoning	Case
	sequence of four different tones initially falling by a fourth and then rising and ending on the mediant.	16, 35, 42	Distinctive	jingle-like sound sequences are capable of identifying goods and services.	R 2056/2013-4
	The first two shorter A notes sound less powerful than the following long and higher C note. The higher and longer C note is thus accentuated on account of its pitch, length and strength.	9, 16, 35, 36, 41, 42	Distinctive	According to general life experience, jingle-like sound sequences, enable distinction between goods and services.	R 0087/2014-5
	Piece of music, three seconds long, combining different tones	9, 14, 16, 21, 25, 28, 35, 38, 41, 43	Distinctive		EUTM 11 074 705
	Computer-generated sound of ten seconds	9, 28, 41	Distinctive		EUTM 11 654 209
	Computer-generated sound of nearly 30 seconds including the sounds of animals followed by the sound of a motor	9, 12	Distinctive		EUTM 10 654 374
	Two musical notes, F and C	35, 36, 38, 39, 41, 42	Not distinctive	A two note 'tune' has no impact on the consumer and will only be perceived by the consumer as a very banal sound, such as the 'ding-dong' of a doorbell.	EUTM 4 010 336
	Two extremely short blips	9, 38	Not distinctive	Machine-generated blip that is commonly emitted by computers and other electronic devices	EUTM 9 199 167
	'Ping' sound, resembling a warning signal	9, 16, 28	Not distinctive	Sound constitutes a warning signal and a direct characteristic of	R 2444/2013-1

Sign	Description	G&S	Result	Reasoning	Case
				the goods applied for	
	Machine-generated synthesised sound	9, 12, 35	Not distinctive	Sound typically linked to the goods and services applied for	R 1338/2014-4
	The first 13 notes of 'La Marseillaise'	Any	Not distinctive	A national anthem is in the public domain	Invented example