

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

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

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 5

**CUSTOMARY SIGNS OR INDICATIONS
(ARTICLE 7(1)(D) EUTMR)**

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1 General remarks


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

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

Moreover, signs or indications that have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that sign are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not, therefore, fulfil the essential function of a trade mark (judgment of 16/03/2006, T-322/03, Weisse Seiten, EU:T:2006:87, § 52).

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

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

Sign	Reasoning	Case Neno
 <p data-bbox="240 1637 520 1693">EUTM No 9 894 528 covering goods in Class 9</p>	<p data-bbox="549 1373 1083 1704">'This device is identical to the international safety symbol known as "high voltage symbol" or "caution, risk of electric shock" ... It has been officially defined as such by the ISO 3864 as the standard high voltage symbol, whereby the device applied for is contained within the triangle which denotes that it is a hazard symbol ... Consequently, since it essentially coincides with the customary international sign to indicate a risk of high voltage, the Board deems it to be ineligible for registration as an EUTM in accordance with Article 7(1)(d) EUTMR' (paragraph 20)</p>	<p data-bbox="1145 1496 1310 1525">R 2124/2011-5</p>

2 Point in time of a term becoming customary

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

the sign in question had not become customary by the filing date (judgment of 05/03/2003, T-237/01, BSS, EU:T:2003:54, § 47; similarly, judgment of 21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264).

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

3 Assessment of customary terms

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

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

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

- The relevant public to be taken into account in determining the sign’s customary character comprises not only all consumers and end users but also, depending on the features of the market concerned, **all those in the trade who deal with that product commercially** (judgments of 29/04/2004, C-371/02, Bostongurka, EU:C:2004:275, § 26; 06/03/2014, C-409/12, Kornspitz, EU:C:2014:130, § 27).
- Where the trade mark targets both **professionals and non-professionals** (such as intermediaries and end users), it is sufficient for a sign to be refused or revoked if it is perceived to be a usual designation by any one sector of the relevant public, notwithstanding ~~the fact~~ that another sector may recognise the sign as a badge of origin (judgment of 06/03/2014, C-409/12, Kornspitz, EU:C:2014:130, § 23-26).
- The General Court has held that Article 7(1)(d) EUTMR is not applicable when the sign’s use in the market is **by one sole trader (other than the EUTM applicant)** (judgment of 07/06/2011, T-507/08, 16PF, EU:T:2011:253). In other words, a mark will not be regarded as customary purely for the simple reason that a competitor of the EUTM applicant also uses the sign in question. For customary character to be demonstrated, it is necessary for the examiner to provide evidence (which will generally come from the internet) that the relevant consumer

has been exposed to the mark in a non-trade mark context and that, as a result, they recognise its customary significance vis-à-vis the goods and services claimed for which the trade mark is protected.

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

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

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