

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

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

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 9

***Trade marks in conflict with flags and other
symbols***

(ARTICLE 7(1)(h) and (i) EUTMR)

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1 Introduction

Article 7(1)(h) EUTMR incorporates Article 6*ter* of the Paris Convention for the Protection of Industrial Property (PC) into the European Union trade mark system. It therefore protects armorial bearings, flags and other state emblems of states that are party to the PC, as well as official signs and hallmarks indicating control and warranty adopted by them. This protection was extended to armorial bearings, flags, other emblems, abbreviations and names of intergovernmental organisations (IGOs) in 1958. Article 7(1)(h) EUTMR applies only if the sign applied for is identical to a protected ‘emblem’ or is a heraldic imitation of such an ‘emblem’.

Article 7(1)(i) EUTMR protects badges, emblems and escutcheons that are not protected under Article 6*ter* PC but are of public interest.

2 Article 7(1)(h) EUTMR

2.1 Objective of Article 7(1)(h) EUTMR

The objective of Article 6*ter* PC is to exclude the registration and use of trade marks that are identical or notably similar to state emblems, official signs and hallmarks indicating control and warranty adopted by the states or the emblems, abbreviations and names of IGOs. Such registration or use would adversely affect the right of the authority concerned to control the use of the symbols of its sovereignty and might, moreover, mislead the public as to the origin of the goods and services for which these marks are used.

Registration of these emblems and signs, as well as any imitation from a heraldic point of view, either as a trade mark or as an element thereof, must be refused if no authorisation has been granted by the competent authority.

Members of the World Trade Organization (WTO) enjoy the same protection pursuant to Article 2(1) TRIPS, according to which members of the WTO must comply with Articles 1 to 12 and 19 PC.

2.2 Relevant emblems and signs protected

State flags

A state flag is defined by the constitution of a state or by a specific law of that state. Normally, a state will have only one state flag.

For instance, the Spanish flag is defined in Article 4 of the Spanish Constitution; the French flag is defined in Article 2 of the French Constitution; and the German flag is defined in Article 22 of the German Constitution.

State flags enjoy protection per se without the need of any registration at WIPO pursuant to Article 6*ter*(3)(a) PC. There is no need to establish any link between the goods and services applied for and the country; state flags enjoy absolute protection.

Armorial bearings, flags, and other state emblems

Armorial bearings normally consist of a design or image depicted on a shield. An example of an armorial bearing is the coat of arms of Spain.



Protected under ES5.

Apart from the state flag (protected per se), a member state of the PC may also request protection for other flags, namely those of its first political division in a federal state. For instance, Germany has requested protection for the flags of each *Bundesland* ('federal state').



Protected under DE34
(flag of the federal
state of Berlin).

In contrast, Spain has not requested protection for the flag of the *Comunidades Autónomas* (Autonomous Communities), only for the state flag and the state flag with the coat of arms. France and the United Kingdom, for instance, have not requested protection for any flag.

The expression 'other state emblems' indicates any emblems constituting the symbol of the sovereignty of a state. This might be a representation of the national crown,



Protected under NL48.

or the official seal of a member state of the PC,



Protected under US1.

Like state flags, armorial bearings, flags, and other state emblems enjoy absolute protection, irrespective of the goods and services applied for.




Official signs and hallmarks indicating control and warranty

The purpose of official signs and hallmarks indicating control and warranty is to certify that a state or an organisation duly appointed by a state for that purpose has checked that certain goods meet specific standards or are of a given level of quality. There are official signs and hallmarks indicating control and warranty in several states for precious metals or products, such as butter, cheese, meat, electrical equipment, etc. Official signs and hallmarks may also apply to services, for instance, those relating to education, tourism, etc.

These symbols are normally registered for specific products such as:

	
<p>Protected under BR6 for tourism; national and international promotion and advertising; marketing studies; business management; business administration; and office functions.</p>	<p>Protected under JP1 for agricultural, forestry and fishery products and foodstuffs.</p>

More typical examples are signs of warranty for metals such as:



		
<p>Protected under CZ35 for platinum</p>	<p>Protected under IT13 for gold</p>	<p>Protected under HU10 for silver</p>

Official signs and hallmarks indicating control and warranty enjoy protection only for goods of the same or a similar kind pursuant to Article 6ter(2) PC (no absolute protection).

Armorial bearings, names, abbreviations and other emblems of intergovernmental organisations

Intergovernmental organisations of which more than one member state of the PC is a member enjoy protection for their armorial bearings, names, abbreviations and other emblems.

For instance, the following signs enjoy protection under the Paris Convention:

		
Protected under QO60.	Protected under QO1.	Protected under QO1248.
<p>AU</p> <hr/> Protected under QO884 for the AFRICAN UNION.		

The European Union has requested, for instance, protection for the following signs, abbreviations and names:

	EUIPO	European Union Intellectual Property Office
Published under QO1717	Published under QO1742 (QO1743 to QO46 in other languages)	Published under QO1718 (QO1719 to QO1741 in other languages)

Pursuant to Article 6ter(1)(c) PC, armorial bearings, names, abbreviations and other emblems of IGOs enjoy protection only for goods and services applied for that would suggest to the public that a connection exists between the organisation concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if the trade mark misleads the public about the existence of a connection between the user and the organisation.

Even though the European Union is not a state in terms of international law, but rather an international intergovernmental organisation, its area of activity is equated with that of a state (decision of 12/05/2011, R 1590/2010-1 – European Driveshaft Services EDS, § 54; judgment of 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 70). Consequently, the emblems of the European Union enjoy protection against all goods and services and there is no need to establish any specific link.

Pursuant to the last sentence of Article 6ter(1)(b) PC, Article 6ter PC is not applicable to any armorial bearings, flags, other emblems, abbreviations, and names that are already the subject of international agreements in force intended to ensure their protection (e.g. under the Geneva Convention).

Search for emblems

Relevant information about emblems protected under the Paris Convention is found in the WIPO Article 6ter database (<http://www.wipo.int/ipdl/en/6ter/>). The database can be

searched by ‘state’ (i.e. country), by ‘category’ (i.e. the type of ‘emblem’), as well as by ‘Vienna Classification’.

The Google image search (<https://images.google.com/>) might give some basic hints to identify an emblem before the Article 6ter database is checked.

Since state flags enjoy protection per se without the need of any registration at WIPO they are normally not found in the WIPO Article 6ter database PC (unless the flag is, at the same time, protected as another state emblem). Tools for finding flags such as <http://www.flagid.org> or <http://www.flag-finder.com> can be consulted.

2.3. Applicability of Article 7(1)(h) EUTMR

To fall foul of Article 7(1)(h) EUTMR, a trade mark:



- must **consist** solely of an identical reproduction or a ‘heraldic imitation’ of the abovementioned symbols; or
- must **contain** an identical reproduction or a ‘heraldic imitation’ of the abovementioned symbols.

Furthermore, the competent authority must not have given its **authorisation** (see paragraph 2.8.4 below).

In principle, the prohibition of the imitation of an emblem applies only to **imitations of it from a heraldic perspective**, that is to say, those that contain heraldic connotations that distinguish the emblem from other signs. Therefore, the protection against any imitation from a heraldic point of view refers not to the image itself, but to its heraldic expression. Therefore, it is necessary to consider the **heraldic description** of the emblem at issue to determine whether the trade mark contains an imitation from a heraldic point of view, (judgments of 16/07/2009, C-202/08 P and C-208/08 P, RW feuille d’érable, EU:C:2009:477, § 48; 5/05/2011, T-41/10, ESF École du ski français, EU:T:2011:200, § 25).

It follows from the above that in the course of trade mark examination, as a first step, both the protected ‘emblem’ and the sign applied for must be considered from a heraldic perspective.

Nonetheless, the Court ruled that as far as ‘imitation from a heraldic point of view’ is concerned, a difference detected by a specialist in heraldic art between the trade mark applied for and the state emblem will not necessarily be perceived by the average consumer and therefore, in spite of differences at the level of certain heraldic details, the contested trade mark may be an imitation of the emblem in question within the meaning of Article 6ter PC (judgments of 16/07/2009, C-202/08 P and C-208/08 P, RW feuille d’érable, EU:C:2009:477, § 50 et seq.; 25/05/2011, T-397/09, Suscipere et finire, EU:T:2011:246, § 24-25).

Spanish Flag	EU Flag
	
Spanish state flag.	Protected under QO0927.

Three horizontal stripes — red, yellow and red, each red stripe being half the width of the central yellow stripe.	On an azure field a circle of twelve golden mullets, their points not touching.
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To apply Article 7(1)(h) EUTMR, **it can therefore be sufficient that the average consumer, despite some differences in heraldic details, can see in the mark an imitation of the ‘emblem’**. This imitation may exist when the ‘emblem’ protected under Article 6ter PC for instance, displays the main element of the ‘emblem’ or shows part of it. That element need not necessarily be identical to the emblem in question. The fact that the emblem in question is **stylised** or that only **part of the emblem** is used does not necessarily mean that there is no imitation from a heraldic point of view (judgment of 21/04/2004, T-127/02, ECA, EU:T:2004:110, § 41).

The EUTM applied for contains a protected ‘emblem’

As a first step, it is important that the examiner identifies the various elements of the EUTM applied for and establishes the part that is considered to be the reproduction or the heraldic imitation of an ‘emblem’ protected under Article 6ter PC. The **size** of the protected emblem as contained in the EUTM is irrelevant, as long as it is **legible** and **perceivable**.

The fact that the EUTM applied for **also contains word elements** does not in itself preclude application of Article 6ter PC (judgment of 21/04/2004, T-127/02, ECA, EU:T:2004:110, § 41). On the contrary, such a word element may even strengthen the link between the EUTM application and an emblem (judgment of 13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120, § 66 et seq.; decision of 28/10/2014, R 1577/2014-4 – Swiss Concept, § 33).

Examples:



- Heraldic imitation found

Flag	Sign applied for
The flags of, Norway, France, Austria, Germany, Sweden, France, Czech Republic, Belgium, Denmark, Ireland, Italy and Finland (from the top in a clockwise circle).	 <p>EUTM application 10 502 714, R 1291/2012-2</p>
The colours are recognisable and follow the structure of the flags.	
 <p>Flag of the United Kingdom</p>	 <p>EUTM application: 13 169 313</p>

The trademark contains a faithful representation of the UK flag in terms of colour/configuration. The slight degree of stylisation does not take it outside the scope of heraldic imitation.

	
<p>French flag</p>	<p>R 1731/2013-1</p>

The French flag is incorporated into the trade mark. Although it is small, it is immediately recognisable.

	
<p>Emblem (Bavaria) protected under DE 26</p>	<p>EUTM: 12 031 531, R 1166/2014-1</p>







The escutcheon with the white and blue diamonds contained in the sign applied for reproduces the heraldic symbol of the lesser Bavarian state coat of arms.

 	
<p>Protected under GB 3 Protected under GB 0565</p>	<p>EUTM 5 627 245, R 1361/2008-1</p>

The Board of Appeal took into account the heraldic description of the protected emblems in order to consider whether there was an heraldic imitation (para. 24 and 27).

As regards the emblem protected under GB 3, it concluded that since central elements such as the quartered shield and the supporters are largely identical, this is in this respect an imitation in the heraldic sense. *The differences are not sufficient to give the CTM A new meaning from a heraldic point of view.* As regards *the* emblem protected under GB 0565, it concluded that the only difference between the supporters was the representation of the crowns, which would go unnoticed by the general public.



- Heraldic imitation not found

Flag	Sign applied for
	
French flag	EUTM 4 624 987, T-41/10
Although the colours are recognisable, the sign does not have the structure of the French flag.	
	
Peruvian flag	EUTM: 14 913 438
The mark is acceptable under Article 7(1)(h) EUTMR. The dimensions of the stripes and also the overall shape of the figurative element are different from that of the Peruvian flag.	
	
Flag of the United Kingdom	EUTM: 15 008 253
The trademark is not a faithful representation of the UK flag in terms of colour/configuration. The high degree of stylisation takes it outside the scope of heraldic imitation.	



The fact that the EUTM applied for **contains only part of the protected ‘emblem’** does not mean that there may not be an imitation from a heraldic point of view (judgment of 21/04/2004, T-127/02, ECA, EU:T:2004:110, § 41). As regards the flag of the European Union, its essential element is the circle of twelve golden mullets (stars) (decision of 14/07/2011, R 1903/2010-1 – A, § 17). However, to qualify as a heraldic imitation, it is not necessary for all the stars to be present in the EUTM applied for (judgment of 13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120). The exact direction of the stars is irrelevant (judgment of 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12). The same is true with respect to their colour (judgments of 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 43 for silver; 13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120, § 48 for red; decision of 14/07/2011, R 1903/2010-1 – A, § 17 for blue).

Earlier case-law of the Boards of Appeal, such as R 1991/2010-4, EASI, and R 0005/2011-4 –TEN, which did not follow the approach taken above, was overruled by the General Court, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120.



- Main characteristics/part of the emblem **incorporated** in the trade mark

Protected 'emblem'	Sign applied for
	
Protected under QO0927	EUTM application, R 1211/2011-1, T-430/12
The EUTM applied for consists of a circle of 12 stars, of which three are covered. It contains the most important element of the European flag. The adjective 'European' reinforces the link already established by the circle of stars.	
	
Protected under QO0927	EUTM 6 373 849, R 1903/2010-1
Since the EUTM contains an element that amounts to a heraldic imitation of the European emblem and the EUTM owner could not justify any authorisation, the registration must be declared invalid (para. 27).	
	
Protected under QO0927	
One element of the contested European Union trade mark contains an imitation of all the heraldic elements of the European emblem (para. 48).	
	
Emblem (Bavaria) protected under DE 24	EUTM: 12 031 531, R 1166/2014-1
The escutcheon with the white and blue diamonds contained in the sign applied for reproduces the heart shield in the greater Bavarian state coat of arms.	

- Main characteristics/part of the protected emblem **not incorporated** in the trade mark

Protected 'emblem'	Sign applied for
	
Protected under IE11	EUTM application 11 945 797, R 0139/2014-5









It must also be taken into consideration that the graphic element of the sign applied for has a colour configuration that is clearly different from the Irish national symbols. These elements are so strong that the mere fact that the sign applied for also contains a clover leaf does not mean that the sign is similar to one of the national emblems of Ireland (paras. 18-19).

	
Protected under SE20	EUTM application 13 580 981
The mark is not a heraldic imitation of the Swedish armorial bearing; it contains only one of the three crowns that are the main characteristic of the Swedish armorial bearing.	



Black and white representations of the protected emblem

Flags are often reproduced in black and white; therefore, a black and white depiction of a protected emblem (or vice versa) may still be considered a heraldic imitation (judgments of 21/04/2004, T-127/02, ECA, EU:T:2004:110, § 45 and 28/02/2008, T-215/06, RW feuille d’érable, EU:T:2008:55, § 68).

Examples:



Flag	Sign applied for
 Protected under QO0927	 T-127/02
 Protected under CA1	 EUTM application 2 793 495
 Protected under CA2	 C-202/08 P and C-208/08 P
 Flag of the United Kingdom	 Invented example

However, if the black and white depiction does not allow recognition of a specific flag, there is no heraldic imitation.

Flag	Sign applied for
	
Various state flags	Invented example
It is not possible to recognise a specific flag, as the sign could be a black and white reproduction of any of the four flags reproduced above.	

Changes in colour

The use of silver v gold is important in heraldry. However, average consumers will not necessarily recognise this difference in colour; indeed, they will not even give it any importance (judgment of 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 43). Slight differences in the actual colour are irrelevant (light blue v dark blue). Heraldry does not normally distinguish between different tones of the same colour (judgment of 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 42). Furthermore, gold is often reproduced as yellow (decision of 20/05/2009, R 1041/2008-1, Kultur in Deutschland + Europa (fig.), § 33); consequently, this difference has no impact on the assessment.

Protected Emblem	Sign applied for
	
Protected under QO0927	EUTM 2 180 800, T-413/11
The Court maintained that even as regards professionals the possibility of making a connection between the sign represented above and the Organization is not excluded (para. 66).	

3 Article 7(1)(i) EUTMR — emblems not protected under Article 6ter PC

3.1 Objective of Article 7(1)(i) EUTMR

Article 7(1)(i) EUTMR applies to all other badges, emblems or escutcheons that

- i) have not been communicated in accordance with Article 6ter(3)(a) PC regardless of whether they are the emblems of a state or international intergovernmental organisation within the meaning of Article 6ter(1)(a) or (b) PC, or of public bodies or administrations other than those covered by Article 6ter PC, such as provinces or municipalities

and

- ii) are of particular public interest,

unless the competent authority has consented to their registration.

Article 7(1)(i) does not define symbols of ‘particular public interest’. The nature of these symbols could vary and could include, for example, symbols of public bodies or administrations, such as provinces or municipalities. In any case, the ‘particular public interest’ involved must be reflected in a public document, for example a national or international legal instrument, regulation or other normative act.

The General Court stated that a **‘particular public interest’ existed when the emblem had a particular link with one of the activities carried out by an international intergovernmental organisation** (judgment of 10/07/2013, T-3/12, Member of €e euro experts, EU:T:2013:364, § 44). In particular, the Court specified that Article 7(1)(i) EUTMR also applied when the emblem merely related to one of the areas of activity of the European Union, even if that activity concerned only certain EU Member States (judgment of 10/07/2013, T-3/12, Member of €e euro experts, EU:T:2013:364, § 45-46). This confirms that the protection afforded by Article 7(1)(i) EUTMR also applies to symbols that are of particular public interest in only a single Member State or part thereof (Article 7(2) EUTMR).

According to the case-law, Article 7(1)(i) and (h) EUTMR both have a similar scope of application and grant equivalent levels of protection. Therefore, Article 7(1)(i) EUTMR covers identical reproduction (full or partial) in a trade mark of the abovementioned symbols, as well as their heraldic imitation.

Following the same line of reasoning, Article 7(1)(i) EUTMR applies where the mark is liable to **mislead the public** as to the existence of a connection between the owner of the trade mark and the body to which the abovementioned symbols refer. In other words, **the protection afforded by Article 7(1)(i) EUTMR is conditional on a link between the mark and the symbol (no absolute protection)**. Otherwise, trade marks to which Article 7(1)(i) EUTMR applies would obtain broader protection than under Article 7(1)(h) EUTMR (judgment of 10/07/2013, T-3/12, Member of €e euro experts, EU:T:2013:364).

3.2 Protected symbols

The following signs (not being covered by Article 6ter PC) enjoy special protection under Article 7(1)(i) EUTMR:

- the euro sign (€, as defined by the European Commission, http://ec.europa.eu/economy_finance/euro/cash/symbol/index_en.htm);



- the symbols protected under the Geneva Conventions and their additional protocols, that is to say, the red cross, the red crescent and the red crystal emblems and their names (<https://www.icrc.org/en/war-and-law/emblem>);




However, a number of well-known red crosses have traditionally been used and are still in use, the incorporation of which in a mark would not be considered a reproduction/heraldic imitation of the ‘Red Cross’.

Examples of these crosses include the following:

‘Templar cross’	
‘Maltese cross’	

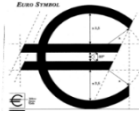



- the Olympic Symbol protected under the Nairobi Treaty on the Protection of the Olympic Symbol (http://www.wipo.int/treaties/en/text.jsp?file_id=287432)



<p>The five interlaced rings in blue, yellow, black, green and red, arranged in that order from left to right. The symbol consists of the Olympic rings alone, whether in a single colour or in different colours, as set out in the Nairobi Treaty on the Protection of the Olympic Symbol (</p>	
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The same rules as set out above concerning the heraldic imitation and authorisations also apply with respect to Article 7(1)(i) EUTMR.



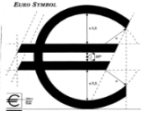

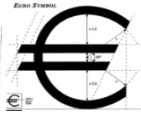

Examples

- Reproduction/heraldic imitation found

Symbol	Sign applied for
	
EUTM application No 6 110 423, T-3/12	
The EUTM contains an imitation of the euro symbol in a central position. A link will be established with the European Union. The other elements reinforce the link between the EUTM and the euro sign. (para. 109 et seq.).	
	
EUTM application 2 966 265, applied for goods and services in Classes 9, 38, 42 and 44.	
Trade mark cancelled. See decision of 23/07/2007, 2 192 C. The EUTM clearly contains the emblem of the Red Cross on a white background, as defined by and protected by the Geneva Convention, as a discernible, individual portion of the mark (para. 23).	

	
	EUTM application 5 988 985, applied for goods and services in Classes 28 and 30.
The trade mark contains the representation of the Red Cross, protected by the Geneva Convention.	

- Reproduction/heraldic imitation not found

Symbol	Sign applied for
	
	R 0315/2006-1, applied for goods and services in Classes 8, 11 and 12.
<p>20. In the present case, the Red Cross cannot be said to be included in the contested EUTM because of the difference in colour. The Red Cross, as its denomination indicates, is red and the colour constitutes a very essential element of its protection. The cancellation applicant's argument that the colour orange may be very similar to some shades of red cannot be accepted.</p> <p>21. Additionally, the cross of the contested EUTM contains the wording 'REPAIR' which, coupled with the goods concerned (tools, car spare parts and accessories in Classes 8, 11 and 12), is likely to be associated with car and motorcycle repairs. This association makes the orange cross of the contested EUTM even more distinct from the Red Cross emblem protected by the Geneva Convention.</p>	
	
	EUTM application 10 868 985, applied for goods and services in Classes 12, 35, 38, 39 and 42 (car rental related).
A link with the European Union will not be established, it rather refers to the 'good price' of the goods and services concerned.	
	
	EUTM application 11 076 866, applied for goods and services in Classes 9, 35, 36, 37 and 42 (e.g. electricity measuring devices, services related to building and construction).
A link with the European Union will not be established, it will be perceived as a stylised letter 'E'.	

4 Exceptions

The EUTM applied for can be registered despite Article 7(1)(h) and (i) EUTMR if the applicant provides the Office with the authorisation to include the protected emblem or parts of it in its trade mark. The authorisation must cover the registration as a trade mark or as a part of it. The authorisation to use the protected emblem is not sufficient.

It is up to the applicant to submit the authorisation. The Office cannot enquire as to whether an authorisation exists, either on an individual or general level.

Even in cases where **general** announcements or authorisations are rendered by competent authorities under national law to use a protected emblem in trade and are provided by the applicant, it should be carefully examined on a case by case basis whether such authorisations **specifically** authorise the use of an emblem in a trade mark (decision of 26/02/2015, R 1166/2014-1 – Alpenbauer Bayerische Bonbonlutschkultur, § 23-29).

It is also important to mention that the provisions of Article 7(1)(h) and (i) EUTMR are not applicable to trade marks that were registered either before the receipt of the notification from WIPO or less than 2 months after receipt of the said notification.

State flags that are not submitted to WIPO enjoy protection only against trade marks that were registered after 6/11/1925.

If an EUTM applied for contains or consists of the heraldic imitation of emblems of two or more states, which are similar, it is sufficient to present authorisation from one of them (Article 6*ter*(8) PC).

