

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

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

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 2

EUTM Definition

(Article 7(1)(a) EUTMR)

1	General remarks	3
2	'Non-traditional' trade marks and Article 7(1)(a) EUTMR	5
2.1	Position mark.....	5
2.2	Colour marks	5
2.3	Sound marks.....	8
2.4	Motion marks	9
2.5	Other marks	12
2.5.1	Layout of a retail store	12
2.5.2	Smell/olfactory marks	13
2.5.3	Taste marks	14
3	Relationship with other EUTMR provisions	14

1 General remarks

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

As from 1 October 2017, according to Article 4 EUTMR, a European Union trade mark may consist of any **signs**, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of **distinguishing** the goods or services of one undertaking from those of other undertakings and being **represented on the Register** of European Union trade marks (the Register) in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

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

- (a) it must be a sign;
- (b) it must be capable of distinguishing the goods or services of one undertaking from those of others;
- (c) it must be capable of being represented on the Register in a way that allows the competent authorities and the public to determine the clear and precise subject matter of protection.

a) Signs

Article 4 EUTMR and Article 3(3) EUTMIR read in conjunction draw up a non-exhaustive list of signs that may constitute an EUTM: word marks, figurative marks, shape marks, position marks, pattern marks, single colour and combination of colour marks, sound marks, motion marks, multimedia marks, and hologram marks.

Where the mark does not fall within the definition of any of the specific types of marks listed in Article 3(3) EUTMIR, it can qualify as an 'other' mark provided for by Article 3(4) EUTMIR provided it complies with the requirement of representation set out in Article (3)1 EUTMIR.

Within this context, abstract concepts and ideas or general characteristics of goods are not specific enough to qualify as a sign, as they could apply to a variety of different manifestations (judgment of 21/04/2010, T-7/09, Spannfutter, EU:T:2010:153, § 25). For this reason, the Court rejected, for example, an application for a 'transparent collecting bin forming part of the external surface of a vacuum cleaner', as the subject matter was not a particular type of bin, but rather, in a general and abstract manner, all conceivable shapes of a transparent bin with a multitude of different appearances (judgment of 25/01/2007, C-321/03, Transparent bin, EU:C:2007:51, § 35, 37).

b) Distinguishing character

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

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

c) Representation on the Register

According to Article 4(b) EUTMR, the sign applied for needs to be capable of being represented on the Register, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

Regarding the representation of the sign, Article 3(3) EUTMIR lays down a non-exhaustive list of trade marks together with their definition and representation requirements. Article 3(4) EUTMIR deals with ‘other’ types of marks. For more information in this regard, see the Guidelines, Part B, Examination, Section 2, Formalities.

Article 3(1) EUTMIR states that the trade mark can be represented in any appropriate form using generally available technology, as long as it can be reproduced on the register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor.

The criteria listed by the EUTMIR are identical to those established in the Sieckmann case (judgement of 12/12/2002, C-273/00, Sieckmann, EU:C:2002:748) with respect to the requirement of a clear and precise acceptable ‘graphical’ representation under the previous wording of the EUTMR.

Article 3(9) EUTMIR clarifies that the filing of a sample or a specimen does not constitute a proper representation of a trade mark. The reason is that these cannot be clearly and precisely represented and are not generally available for inspection on the Register by means of commonly available technology. For example, a sample of a scent would not be a durable and stable representation of a trade mark, thereby not complying with the requirement of clarity and precision.

Article 3(2) EUTMIR makes clear that the subject matter of the registration is defined by the **representation of the mark**. In the limited number of cases where the representation is accompanied by a description (see below), the description must accord with the representation and must not extend its scope.

Whenever the representation of the sign does not enable the competent authorities (namely trade mark offices and courts) and the competitors to determine the clear and precise subject matter of the protection afforded to its proprietor, the mark has to be refused for not complying with Article 7(1)(a) EUTMR. This is an objective assessment to be carried out in application of the criteria listed in Article 3(1)IA for which no particular segment of the consumer has to be taken into account

Where the applicant has duly complied with the formalities requirements (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 10) — that is, the filing of a representation of the sign in accordance with the corresponding requirements of Article 3(1) and (3) EUTMIR) and a correct indication of the type of mark — the representation of the sign on the Register should enable the competent authorities and the public to determine the clear and precise subject matter of protection of the mark.

Nevertheless, issues in this respect are more likely to arise pursuant to Article 31(1)(d) EUTMR where the mark applied for does not qualify as one of the types of marks listed in Article 3(3) EUTMIR but as an ‘other’ type of mark (Article 3(4) EUTMIR) for which there are no specific explicit rules on representation other than that of complying with the standards set out in Article 3(1) EUTMIR.

2 ‘Non-traditional’ trade marks and Article 7(1)(a) EUTMR

The assessment of whether the representation of the sign enables the competent authorities and the public to determine the clear and precise subject matter of protection of the mark seems rather straightforward for traditional types of marks (word and figurative marks). To the extent that these marks have passed the formality examination, in general, they can directly be assessed under the other grounds of Article 7 EUTMR as there should not be any issues under Article 7(1)(a) EUTMR.

A closer examination of the requirements referred to in Article 7(1)(a) and Article 4 EUTMR might, however, be needed in the case of less ‘traditional’ signs.

Although the **graphical** representation requirement has been abolished, the existing case-law dealing with the graphical representation of signs is still relevant in some cases for the understanding of the requirement that signs have to be capable of being adequately represented on the Register.

2.1 Position mark

According to Article 3(3)(d) of the EUTMIR, a position mark is a trade mark consisting of the specific way in which the mark is placed or affixed on the product.

The abovementioned article stipulates the following mandatory and optional representation requirements for position marks.

- a) An appropriate identification of the **position** of the mark and its size or proportion **with respect** to the relevant goods (mandatory).
- b) A **visual disclaimer** of those elements which are not intended to form part of the subject-matter of the registration (mandatory). The EUTMIR gives preference to broken or dotted lines.
- c) A description explaining how the sign is affixed on the goods (optional). The representation should by itself clearly define the position of the mark as well as its size or proportion with respect to the goods, therefore the description may only serve explanatory purposes; it cannot serve to substitute visual disclaimers.

An objection under Article 7(1)(a) EUTMR may be raised for those goods on which the positioning of the mark may be unclear. For example, if a position mark is applied for in respect of *clothing, footwear and headgear*, but the representation identifies the position of the mark on *footwear* only, an objection should be raised for *clothing* and *headgear*.

2.2 Colour marks

According to Article 3(3)(f) EUTMIR, colour marks are either single colour marks without contours or a combination of colours without contours.


- (i) Trade marks consisting exclusively of a single colour (without contours) require:
- a reproduction of the colour (mandatory);
 - a reference to a generally recognised colour code (mandatory).
- (ii) Trade marks consisting exclusively of a combination of colours (without contours) require:
- a reproduction of the colour combination that shows the systematic arrangement of the colour combination in a uniform and predetermined manner (mandatory);
 - a reference to a generally recognised colour code (mandatory);
 - a description detailing the systematic arrangement of the colours (optional).
- For colour combinations, the new EUTMIR implements the case-law according to which the representation ‘must be systematically arranged by associating the colours concerned in a predetermined and uniform way’, where the Court of Justice stated that the mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours ‘in every conceivable form’, did not exhibit the qualities of precision and uniformity necessary to comply with the requirement of graphic representation contained at that time in Article 4 EUTMR (judgment of 24/06/2004, C-49/02, Blau/Gelb, EU:C:2004:384, § 33-34);

If a combination of colours without contours is not systematically arranged in a uniform and predetermined manner, too many different variations would be possible and this would not allow the competent authorities and economic operators to know the precise scope of the protection claimed by the mark.


The colours are arranged in a uniform and predetermined manner when at least the ratio and the relative position of the colours are provided in the application.

The addition (optional) of a description can only ‘detail’ the systematic arrangement of the colours and thus only serve explanatory purposes. As the trade mark’s scope of protection is exclusively determined by the representation itself, a description can neither add further information regarding the scope of protection nor extend the latter (Article 3(2) EUTMIR). In addition, a lack of accord between the representation and the description leads to a lack of clarity and precision of the mark (Article 3(2) EUTMIR).

Example of signs that are **acceptable**: (including or not the description):

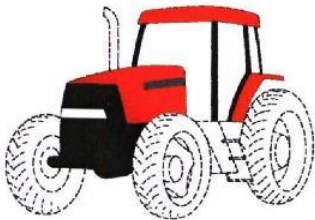
Sign	Case No
 <p>Colours indication: 'Pantone 368 C', 'Pantone 425 C', 'Pantone 021 C'</p> <p>Description: the colours are applied in the ratio of green 60 %, anthracite 30 % and orange 10 %</p>	<p>EUTM 8 298 499</p>

The sign can also indicate how the colours will be applied on the goods at issue where this is made by means of an iconic (as opposed to a naturalistic) representation, as show the following examples:

Sign	Case No
 <p>Description: RAL 9018;NCS S 5040G50Y + RAL 9018 1 : 4;NCS S 5040G50Y + RAL 9018 2 : 3;NCS S 5040G50Y + RAL 9018 3 : 2;NCS S 504050Y + RAL 9018 4 : 1: NCS S 5040G50Y.</p> <p>Class 7 – Wind energy converters, and parts therefor.</p>	<p>EUTMR: 2346542</p> <p>03/05/2017, T-36/16, BLENDED SHADE OF GREEN, EU:T:2017:295</p>

[T]he contested mark was registered as a colour mark (§ 36).

Consequently ... the upright trapezoidal shape is not part of the subject matter of the protection sought and that element does not set contours to the colours, but only serves to indicate how the colours will be applied on the goods at issue. The protection sought is thus for a specific combination of colours applied on the lower section of a shaft, irrespective of the shape of that shaft, which is not part of the subject matter of the protection sought. (§40)

 <p><u>Colours indicated:</u> Red, black and grey</p> <p><u>Description:</u> The mark consists of the combination of the colours red, black and grey as applied to the exterior surfaces of a tractor, namely red as applied to the bonnet, roof and wheel arches, light and dark grey as applied to the bonnet in a horizontal stripe and black as applied to the front bonnet grill, chassis and vertical trim — as depicted in the illustrative representation attached to the application.</p>	<p>EUTM 9 045 907</p>
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2.3 Sound marks

Article 3(3)(g) EUTMIR defines sound marks as trade marks consisting exclusively of a sound or combination of sounds.

EUTM applications for sound marks can **only** be an audio file reproducing the sound **or** an accurate representation of the sound in musical notation (for technical information and further details on **valid means** of representation of sound marks, see the Guidelines, Part B, Examination, Section 2, Formalities).

Other means of representation, such as onomatopoeia, musical notes on their own and sonograms will not be accepted as representations of sound marks for EUTM applications. In all cases, these representations would not sufficiently enable the competent authorities and the public to determine the clear and precise subject matter of protection.

- *Description of a sound in words*

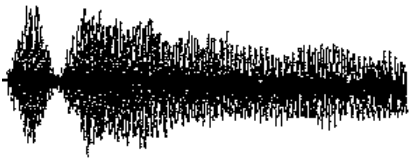
A description such as certain notes of a musical play, e.g. ‘the first 9 bars of *Für Elise*’, or a description of the sound in words, e.g. ‘the sound of a cockcrow’, is not sufficiently precise or clear and therefore does not make it possible to determine the scope of the protection sought (judgment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

- *Onomatopoeia*

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

- *Musical notes alone*

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

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

2.4 Motion marks

Article 3(3)(h) EUTMIR defines motion marks as ‘trade mark(s) consisting of, or extending to, a movement or a change in the position of the elements of the mark’.

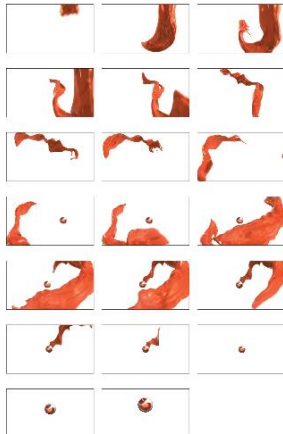
The definition does not restrict motion marks to those depicting movement. A sign may also qualify as a motion mark if it is capable of showing a change in the position of the elements (for instance a sequence of stills). Motion marks do not include sound (see the definition of a multi-media mark below).


Pursuant to Article 3(3)(h) EUTMIR, motion marks must be represented by submitting:

- a video file showing the movement or change of position, or
- a series of still sequential images showing the movement which may be numbered or accompanied by a description explaining the sequence.


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

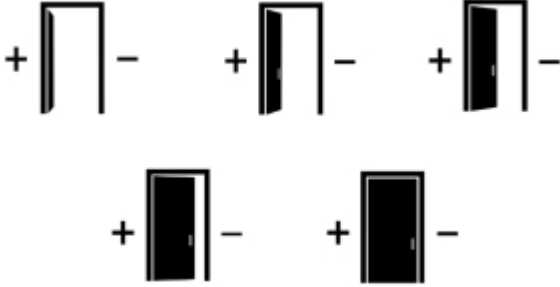
Examples of **acceptable** representations for motion marks:

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

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

Examples of **unacceptable** representations for motion marks:


Sign	Case No
 <p><u>Description:</u> The mark comprises a moving image consisting of a toothbrush moving towards a tomato, pressing onto the tomato without breaking the skin, and moving away from the tomato.</p>	<p>EUTM 9 742 974</p>
<p>The Office rejected the application as it was not possible to establish the precise movement from the description provided along with the representation.</p>	

Sign	Case No
 <p data-bbox="233 651 1027 871">Description: The mark consists of an animated sequence on a plain background, namely a door that can be opened in the following three stages: open/mid-open/closed or closed/mid-open/open, using the symbols '+' and '-'. The length of the animation between the stages is half a second. The door and its frame are rectangular and are in the style of a basic geometric drawing with a small rectangular handle, opening onto a plain background. The symbols '+' and '-' are placed by each of the long edges of the frame.</p>	<p data-bbox="1099 544 1299 571">EUTM 16 023 095</p>
<p data-bbox="233 891 1361 1055">The Office rejected the application as it was not possible to establish the precise movement from the description provided along with the graphic representation. A sign which consists of the opening and closing of a door by the pushes of buttons to the left or right to these is subject to personal interpretation of the consumer. The sign, therefore, cannot fulfil the requirements of clarity and precision under Article 4 EUTMR because each consumer would interpret it in a different way and would be subjected to a different sequence of the movement mark.</p>	

2.5 Other marks

2.5.1 Layout of a retail store

In its judgment of 10/07/2014, C-421/13, Apple, EU:C:2014:2070, paragraph 19, the Court of Justice found that a representation which depicts the layout of a retail store may constitute a trade mark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings. The layout was represented by means of a single design, combining lines, curves and shapes, without any indication of the size or the proportions.

Sign	Case No
	<p data-bbox="831 1738 1334 1765">10/07/2014, C-421/13, Apple, EU:C:2014:2070</p>

Following the abovementioned judgment, it cannot be excluded that the requirements of representation of the layout of a retail store are satisfied by a design alone, combining lines, curves and shapes, without any specific indication of the size or the proportions.

proportions in the description. The Court indicated that in such a case, the trade mark could be registered provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings and if no other grounds for refusal apply.

As a representation that depicts the layout of a retail store is not strictly covered by any of the types of marks listed in Article 3(3) EUTMIR, the representation must comply with the standards set out in Article 3(1) EUTMIR and may be accompanied by a description clearly specifying the subject matter for which protection is sought.

2.5.2. Smell/olfactory marks

This type of mark is not in the non-exhaustive list of types of marks provided by Article 3(3) EUTMIR. It could be applied for under the type of mark ‘other’.

However, it is currently not possible to represent smells in compliance with Article 4 EUTMR, as the subject matter of protection cannot be determined with clarity and precision **with any available technology**.

Article 3(9) EUTMIR specifically excludes the filing of samples.

The following are examples of non-satisfactory means of representation of a smell:


- *Chemical formula*

Only specialists in chemistry would recognise the odour in question from such a formula.

- *Representation and description in words*

The requirements of representation are not satisfied by:

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

Sign	Case No
<div style="text-align: center;">  </div> <p>Mark description: Smell of ripe strawberries</p>	<p style="text-align: center;">EUTM No 1 122 118</p>
<p>27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34</p> <p>The Court considered that the smell of strawberries varies from one variety to another and the description ‘smell of ripe strawberries’ can refer to several varieties and therefore to several distinct smells. The description was found neither unequivocal nor precise and did not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed.</p>	

In its Judgment of 12/12/2002, C-273/00, Methylcinnamat, EU:C:2002:748, § 69-73, the General Court dismissed the possibility of representing an olfactory mark by a

chemical formula, by a description in writing, by the deposit of an odour sample or by a combination of those elements.

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

Currently, there is no technology that could make possible the representation of a smell mark on the Register in a legally accepted manner. Therefore, an application for a smell mark would be rejected under Article 7(1)(a) EUTMR.

2.5.3. Taste marks

This type of mark is not in the non-exhaustive list of types of marks provided by Article 3(3) EUTMR. It could be applied for under the type of mark 'other'.

However, it is currently not possible to represent a taste in compliance with Article 4 EUTMR as Article 3(9) EUTMR specifically excludes the filing of samples and the subject matter of protection cannot be determined with clarity and precision **with any available technology**.

Therefore, an application for a taste mark would be rejected under Article 7(1)(a) EUTMR.

With current technology, there is no way to represent this type of mark in a proper manner. The arguments mentioned above under paragraph 2.1. are applicable in a similar way for taste marks (decision of 04/08/2003, R 120/2001-2, The taste of artificial strawberry flavour (gust.)).

3 Relationship with other EUTMR provisions

Article 7(1)(a) EUTMR reflects the Office's obligation to refuse signs that do not conform to the requirements of Article 4 EUTMR. If the sign does not meet these requirements and the representation is not clear and precise, the application will not be examined in the light of the other absolute grounds for refusal.

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