GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

PART B

EXAMINATION

SECTION 4

ABSOLUTE GROUNDS FOR REFUSAL

CHAPTER 8

DECEPTIVE TRADE MARKS

ARTICLE 7(1)(g) EUTMR
Table of Contents

1 Examination of the Deceptive Character ........................................... 3

2 Market Reality and Consumers’ Habits and Perceptions.................. 5

3 Trade Marks with Geographical Connotations Relating to the Location of the Applicant or the Place of Origin of the Goods/Services ................................................................. 6

4 Trade Marks Making Reference to ‘Official’ Approval, Status or Recognition................................................................................................................................. 7

5 Relation with Other EUTMR Provisions............................................. 8
   5.1 Article 7(1)(b) and (c) EUTMR...................................................... 8
1 Examination of the Deceptive Character

Article 7(1)(g) EUTMR provides that marks that are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services, will not be registered.

According to the case-law relating to Article 3(1)(g) of the First Trade Mark Directive (TMD), now Article 4(g) of Directive 2015/2436 of 16 December 2015, the wording of which remains identical to that of Article 7(1)(g) EUTMR, the circumstances for refusing registration referred to in Article 7(1)(g) EUTMR presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (judgment of 30/03/2006, C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 47, and the case-law cited therein).

Pursuant to the above, the Office, as a matter of practice, makes the twin assumptions that:

1. there is no reason to assume that a trade mark application has been filed with the intention of deceiving customers. No deceptiveness objection should be raised if a non-deceptive usage of the mark is possible vis-à-vis the goods and services specified — that is to say, an assumption is made that non-deceptive use of the sign will be made if possible;

2. the average consumer is reasonably attentive and should not be regarded as particularly vulnerable to deception. An objection will generally only be raised where the mark leads to a clear expectation that is patently contradictory to, for instance, the nature or quality or geographical origin of the goods.

An objection should, therefore, be raised when the list of goods/services is worded in such a way that non-deceptive use of the trade mark is impossible.

The following are three examples of marks that were found to be deceptive with regard to all or part of the claimed goods:

<table>
<thead>
<tr>
<th>Mark and goods</th>
<th>Reasoning</th>
<th>Case No</th>
</tr>
</thead>
<tbody>
<tr>
<td>LACTOFREE for lactose in Class 5</td>
<td>The nature of the sign would immediately lead the relevant consumer to believe that the product in question, i.e. 'lactose', does not contain any lactose. It is clear that if the product being marketed under the sign 'LACTOFREE' is actually lactose itself, then the mark would be clearly misleading.</td>
<td>R 892/2009-1</td>
</tr>
</tbody>
</table>

These examples address only the issue of whether a deceptiveness objection should be raised or not. This paragraph does not deal with possible objections under other absolute grounds for refusal. Therefore, the possibility that a given trade mark might appear to be prima facie objectionable under Article 7(1)(b) and/or (c) EUTMR (or other provisions for that matter) is not contemplated here.
**Mark and goods** | **Reasoning** | **Case No.**
---|---|---

| TITAN  
(German word for ‘titanium’)  
for portable and relocatable buildings; modular portable building units for use in the construction of prefabricated relocatable buildings; prefabricated relocatable buildings constructed of modular portable building units, none of the aforesaid goods being made from or including titanium in Classes 6 and 19. | During the appeal proceedings the applicant, in an attempt to overcome an objection of descriptiveness, offered to restrict the specifications in both classes by adding, at the end, the indication none of the aforesaid goods being made from or including titanium. The Board held that such a restriction, if accepted, would have had the effect of rendering the trade mark deceptive from the standpoint of the German-speaking public, as they would assume that the goods were made from titanium when in reality this is not the case. | R 789/2001-3 |
2 Market Reality and Consumers’ Habits and Perceptions

When assessing if a given trade mark is deceptive or not, account should be taken of the characteristics of the goods and services at issue, of market reality and of consumers’ habits and perceptions.

For example, in the (invented) trade mark ‘ELDORADO CAFÈ LATINO’ covering coffee, preparations for use as substitutes for coffee, artificial coffee, chicory, chicory flavourings; chocolate, preparations for use as substitutes for chocolate; tea, cocoa; sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice in Class 30, the examination should come to the following conclusions.

- An objection under Article 7(1)(g) EUTMR would be justified for preparations for use as substitutes for coffee, artificial coffee, chicory, chicory flavourings, because use of the mark on these goods would be necessarily deceptive. One would assume one was purchasing coffee, which would not in fact be the case.

- An objection under Article 7(1)(g) EUTMR would also be justified for products such as cocoa or tea. Like substitutes for coffee, they may be sold in packaging quite similar to that used for coffee, and are often bought rather hastily, it is likely that many consumers will not take time to analyse the wording on the packaging, but will choose these goods from the shelf in the (erroneous) belief that they are coffee.

- However, as far as coffee is concerned, there is no ‘clear contradiction’ between the claim for coffee and the wording ‘CAFÈ LATINO’, since the general category coffee may also include coffee originating from Latin America. Hence, no Article 7(1)(g) EUTMR objection arises for the category of coffee itself. The same logic applies for goods that could be flavoured with coffee (such as chocolate, ices and pastry and confectionery) — an assumption of non-deceptive use should be made, and there is not necessarily any contradiction between the said wording and the goods.

- Finally, for the remainder of the goods concerned, that is to say, honey, bread, vinegar, etc. the presence of the wording ‘CAFÈ LATINO’ will not give rise to any expectations at all. For such goods, this wording will be seen as clearly non-descriptive and hence there is no potential for actual deception. In the ‘real’
market, coffee is not displayed on the same shelves or in the same sections of a shop as bread, honey or vinegar. Furthermore, the goods in question have a different appearance and taste and are normally distributed in different packaging.

<table>
<thead>
<tr>
<th>Mark and services</th>
<th>Reasoning</th>
<th>Case No</th>
</tr>
</thead>
<tbody>
<tr>
<td>LEWIS ROAD For, inter alia, Class 29: Meat, fish, poultry and game; meat extracts; eggs; milk and milk products; dairy products including cheese; edible oils and fats including butter; flavoured milk beverages.</td>
<td>Meat in Class 29 also covers beef, which is depicted in the sign, meaning that non-deceptive use is possible. The sign does not, therefore, incur in an objection under Article 7(1)(g) EUTMR. For fish and poultry, amongst others, the sign is also not objectionable under Article 7(1)(g) EUTMR. They are sufficiently apart from beef to avoid deception. This will not only be noticed when the goods are purchased over the counter but also when they are offered on shelves in supermarkets where they are normally displayed in transparent packaging. Their appearance is very different (a fish or a chicken compared to beef) and they are generally not placed next to each other.</td>
<td>EUTM No 14 059 588</td>
</tr>
</tbody>
</table>

3 Trade Marks with Geographical Connotations Relating to the Location of the Applicant or the Place of Origin of the Goods/Services

When it comes to trade marks having certain ‘geographical’ connotations relating to the location of the applicant or the place of origin of the goods/services, the following should be noted.

As a general rule, the Office will not raise an objection on deceptiveness based upon the applicant’s geographical location (address). Indeed, such a geographical location bears, in principle, no relation to the geographical origin of the goods and services, that is to say, the actual place of production/offering of the goods and services covered by the mark.

For example, under Article 7(1)(g) EUTMR the Office will not object to a figurative mark containing the words MADE IN USA for clothing in Class 25 that is filed by a company with its seat in Sweden. In such cases, the Office assumes a non-deceptive use of the mark on the part of the proprietor.

Deceptiveness would nonetheless arise in the hypothetical event that a figurative mark containing the words MADE IN USA, filed by a company with its seat in the United States of America, were filed for a specifically limited list of goods — for example, clothing articles made in Vietnam — although, in practice, such cases seem unlikely to arise.
The sign could evoke in the consumers’ minds some impressions/expectations as to the geographical origin of the goods or of the designer thereof that may not correspond to reality. For example, trade marks such as ALESSANDRO PERETTI or GIUSEPPE LANARO (invented examples) covering clothing or fashion goods in general may suggest to the relevant public that these goods are designed and produced by an Italian stylist, which may not be the case.

However, such a circumstance is not sufficient per se to render those marks misleading, wherever the goods originate from. Indeed, ‘when the sign is merely evocative there is no clear contrast between the impression/expectation a sign may evoke and the characteristics/qualities of the goods and services it covers.

4 Trade Marks Making Reference to ‘Official’ Approval, Status or Recognition

It should be noted that, under the current practice of the Office, trade marks that could evoke official approval, status or recognition without giving the firm impression that the goods/services issue from, or are endorsed by, a public body or statutory organisation, are acceptable.

The following are two examples where the marks concerned, although allusive or suggestive, were not found to be deceptive.

<table>
<thead>
<tr>
<th>Mark and services</th>
<th>Reasoning</th>
<th>Case No</th>
</tr>
</thead>
<tbody>
<tr>
<td>THE E-COMMERCE AUTHORITY for business services, namely, providing rankings and other information regarding electronic commerce vendors, goods and services via the Internet in Class 35 and providing research and advisory services and information in the area of electronic commerce in Class 42.</td>
<td>The Board found that the trade mark was not deceptive, as it did not convey the firm impression that the services issue from a governmental or statutory organisation. (The Board, however, confirmed the refusal under Article 7(1)(b) EUTMR on the grounds that the mark lacked distinctive character, as it would be perceived by the English-speaking public merely as a simple statement of self-promotion that makes a claim about the level of competence of the service providers.)</td>
<td>R 803/2000-1</td>
</tr>
<tr>
<td>[Image: ecole_duski_francaise.png] for, inter alia, teaching of skiing in Class 41.</td>
<td>The Board held that French consumers would understand that the trade mark alludes to the fact that the services are supplied in France by a French teaching centre, and relate to learning how to ski ‘in the French way’. Furthermore, the French public had no reason to believe that, simply because of the presence of its tricolour logo (not a reproduction of the French flag), that the services are supplied by public authorities or even authorised by such authorities.</td>
<td>R 235/2009-1 confirmed by the General Court in T-41/10</td>
</tr>
</tbody>
</table>
5  Relation with Other EUTMR Provisions

The above explanations aim to define the scope of application of Article 7(1)(g) EUTMR. Although addressed in their respective sections of the Guidelines, in the context of absolute grounds examination and of possible deceptiveness scenarios, the following provisions may be of particular relevance.

5.1  Article 7(1)(b) and (c) EUTMR

Under the current Office practice, if, following a descriptiveness and/or lack of distinctiveness objection, the EUTM applicant proposes a limitation in an attempt to overcome it, and provided the proposed limitation meets the prescribed requirements (unconditional request and suitably worded), the original list of goods and/or services will be limited accordingly. However, if the limitation in question (albeit overcoming the initial objection) has the effect of rendering the trade mark applied for deceptive, then the examiner will have to raise a deceptiveness objection under Article 7(1)(g) EUTMR.

The following example illustrates such a scenario.

EUTM No 472 225, ‘ARCADIA’, was originally applied for in respect of wines, spirits (beverages) and liqueurs in Class 33.

Initially, an objection under Article 7(1)(g) EUTMR was not appropriate, since the broad category ‘wines’ also covers wines originating from Arcadia (and, since Arcadia — which identifies a wine-producing region in Greece — is not a protected geographical indication at European Union level, there is no obligation on the part of the applicant to restrict the specification only to wines originating from Arcadia).

The Office, however, objected under Article 7(1)(c) EUTMR because the trade mark was descriptive of the geographical origin of wines, to the extent that Arcadia is a Greek region known for its wine production.

The applicant subsequently offered to limit the specification of goods to exclude wines made in Greece or, if preferred, to include only wines produced in Italy. The Office held that the proposed limitation would render the trade mark deceptive under Article 7(1)(g) EUTMR, since it would convey false information as to the origin of the goods. On appeal, the Board confirmed the refusal (decision of 27/03/2000, R 246/1999-1, ARCADIA, § 14).