

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

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

***Part B***

***Examination***

***Section 4***

***Absolute grounds for refusal***

## Table of Contents

<b>Chapter 1 General principles.....</b>	<b>291</b>
<b>Chapter 2 EUTM definition (Article 7(1)(a) EUTMR).....</b>	<b>300</b>
<b>Chapter 3 Non-distinctive trade marks (Article 7(1)(b) EUTMR).....</b>	<b>316</b>
<b>Chapter 4 Descriptive trade marks (Article 7(1)(c) EUTMR).....</b>	<b>369</b>
<b>Chapter 5 Customary signs or indications (Article 7(1)(d) EUTMR).....</b>	<b>420</b>
<b>Chapter 6 Shapes or other characteristics with an essentially technical function, substantial value or resulting from the nature of the goods (Article 7(1)(e) EUTMR).....</b>	<b>425</b>
<b>Chapter 7 Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR).....</b>	<b>436</b>
<b>Chapter 8 Deceptive trade marks (Article 7(1)(g) EUTMR).....</b>	<b>452</b>
<b>Chapter 9 Trade Marks in conflict with flags and other symbols (Article 7(1)(h) and (i) EUTMR).....</b>	<b>462</b>
<b>Chapter 10 Trade Marks in Conflict with Designations of Origin and Geographical indications (Article 7(1)(j) EUTMR).....</b>	<b>482</b>
<b>Chapter 11 Trade marks in conflict with traditional terms for wines (Article 7(1)(k) EUTMR).....</b>	<b>533</b>
<b>Chapter 12 Trade marks in conflict with traditional specialities guaranteed (Article 7(1)(l) EUTMR).....</b>	<b>545</b>
<b>Chapter 13 Trade marks in conflict with earlier plant variety denominations (Article 7(1)(m) EUTMR).....</b>	<b>553</b>
<b>Chapter 14 Acquired distinctiveness through use (Article 7(3) EUTMR). </b>	<b>564</b>
<b>Chapter 15 European Union collective marks.....</b>	<b>582</b>
<b>Chapter 16 European Union certification marks.....</b>	<b>590</b>

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***Chapter 1***

***General principles***

## Table of Contents

<b>1 Reasoned Objection.....</b>	<b>293</b>
<b>2 Dialogue with the Applicant.....</b>	<b>293</b>
<b>3 Decision.....</b>	<b>295</b>
<b>4 European Criteria.....</b>	<b>295</b>
<b>5 Irrelevant Criteria.....</b>	<b>296</b>
5.1 Term not used.....	296
5.2 Need to keep free.....	296
5.3 Factual monopoly.....	297
5.4 Double meaning.....	297
<b>6 Scope of Objections to the Goods and Services.....</b>	<b>297</b>
<b>7 Timing of Objections.....</b>	<b>299</b>
<b>8 Disclaimers.....</b>	<b>299</b>

## 1 Reasoned Objection

Any one of the grounds listed in Article 7(1) EUTMR is sufficient for the refusal of a European Union trade mark.

For the sake of sound administration and economy of proceedings, the Office will raise any objections to registration of the sign under Article 7(1) EUTMR **as soon as possible and preferably all at once**. This is particularly important in those cases where the applicant cannot overcome the objection by demonstrating that the sign has acquired distinctive character through use (for instance, when Article 7(1)(e) EUTMR is invoked).

Each of the grounds for refusal listed in Article 7(1) EUTMR is **independent** and must be examined separately. Therefore, when various absolute grounds for refusal are invoked, a reasoned objection will be issued, specifying the individual grounds for refusal and providing clear and distinct reasoning **for each ground**. Even when some grounds for refusal overlap, each ground for refusal must be reasoned in the light of the general interest underlying each of them.

For example, where a word mark is found to have a semantic meaning that gives rise to an objection under both Article 7(1)(b) and (c) EUTMR, the notification of grounds for refusal should deal with each of those grounds in separate paragraphs. In such a case, it will be clearly indicated whether the lack of distinctiveness arises out of the same, or different, considerations from those that lead to the mark being deemed descriptive.

Occasionally, **arguments put forward by the applicant**, or a restriction (partial withdrawal) of the list of goods and services, will lead to the application of other grounds for refusal. In these cases, the party will always be given the opportunity to comment thereon.

## 2 Dialogue with the Applicant

During examination proceedings, the Office will seek a dialogue with the applicant.

At all stages of the proceedings, the observations submitted by the applicant will be considered carefully.

The Office will likewise consider, of its own motion, new facts or arguments that plead in favour of acceptance of the mark. The application can only be refused if the Office is convinced that the objection is well founded at the point in time when the decision is taken.

If several grounds for refusal are raised, the applicant must overcome all of them, since a refusal can be based on a single ground for refusal (19/09/2002, C-104/00 P, *Companyline*, EU:C:2002:506, § 28).

- No observations submitted by the applicant  
Where the applicant has not submitted any observations, if the application is to be refused, the notification to the applicant will include the original objection letter(s),

state that the application is ‘hereby refused’, and contain a notice on the availability of an appeal.

- Observations submitted by the applicant

If the applicant contests the reasons given in the original notification, the refusal will first provide the original reasoning given, and then address the applicant’s arguments.

Where the Office needs to provide new facts or arguments to sustain a refusal, the applicant must be given the opportunity of commenting on these before a final decision is taken.

- Restriction of goods and services

Where the applicant tries to overcome the objection by restricting the list of goods and services, it is possible that the restriction may give rise to a new ground for refusal, for example, deceptiveness in addition to descriptiveness. In this case another objection letter will be issued, so as to give the applicant the opportunity to comment on all grounds for refusal found pertinent.

A specification of goods or services that is restricted by a condition that the goods or services do not possess a particular characteristic should not be accepted (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 114). For example, in respect of the trade mark ‘Theatre’, a specification claiming ‘*books, except for books about theatre*’ should not be accepted. By contrast, restrictions that are worded in a positive way are usually acceptable, such as ‘*books about Chemistry*’.

- Proof of acquired distinctiveness

The applicant has the right to claim that its mark has acquired distinctiveness through use (Article 7(3) EUTMR) and to submit relevant proof thereof.

The applicant must make its claim under Article 7(3) EUTMR either together with the application or, **at the latest, in reply to the Office’s first objection** (Article 2(2) EUTMR). The claim can no longer be made for the first time at the appeal stage (Article 27(3)(a) EUTMDR).

The claim of acquired distinctiveness through use can be made either as a **principal** claim or as a **subsidiary** one (Article 2(2) EUTMR). The applicant must, however, clearly and precisely specify the type of claim, either together with the application or, at the latest, in reply to the Office’s first objection.

Where the applicant has made a **principal** claim, the Office will take **one** (single) decision both on the mark’s inherent distinctiveness and, where there is no inherent distinctiveness, on the submission of acquired distinctiveness through use.

Where the applicant has made a **subsidiary** claim, the Office will take a **first** decision on the mark’s inherent distinctiveness and then, once that decision (finding lack of inherent distinctiveness) has become final, the applicant will be invited to submit its evidence on acquired distinctiveness through use.

For further information on acquired distinctiveness through use, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 14, Acquired Distinctiveness Through Use (Article 7(3) EUTMR).

### 3 Decision

After the dialogue with the applicant has taken place, the Office will take a decision if it considers that the objection is well founded despite the facts and arguments submitted by the applicant.

The decision will include the original objection, summarise the applicant's arguments, address the applicant's arguments and submissions, and give reasons and a detailed explanation as to why they are not convincing.

The objection can be waived in part if the Office considers that (i) **some** of the grounds have been overcome or (ii) **all** grounds have been overcome for some of the goods and services.

The decision will state that the application has been refused, either partly or in its entirety, indicating the goods and services rejected, and contain a notice on the availability of an appeal.

If a subsidiary claim of acquired distinctiveness through use has been made, the first decision will declare the inherent distinctiveness of the mark. It will only be after examining this evidence that the Office will decide whether to refuse the application.

The above, obviously, applies only to those cases where a claim under Article 7(3) EUTMR can be made. When an application is refused on the basis of a ground for refusal that cannot be overcome by means of Article 7(3) EUTMR (e.g. a refusal under Article 7(1)(e)(i) to (iii)), a subsidiary claim of acquired distinctiveness will fail.

### 4 European Criteria

Article 7(1) EUTMR is a European provision and has to be interpreted on the basis of a common European standard. It would be incorrect to apply different standards of distinctiveness, based on different national traditions, or to apply different (i.e. more lenient or stricter) standards on the breach of public order or morality, depending on the country concerned.

However, Article 7(2) EUTMR excludes an application from registration if a ground for refusal pertains to only part of the European Union (EU).

For example, it suffices for a refusal if the trade mark is descriptive, or lacks distinctive character, in any one of the official languages of the EU (03/07/2013, T-236/12, Neo, EU:T:2013:343, § 57).

As regards other languages, a trade mark will be refused if it gives rise to an objection under Article 7(1) EUTMR in a language understood by a significant section of the relevant public in at least part of the European Union (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR), paragraph 1.2, and 13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 35-36).

Where the objection is not based on a semantic meaning of a word, the ground for refusal will normally pertain to the European Union as a whole. However, the perception of the sign by the relevant public, the practice in trade, or the use of the goods and services claimed may be different in some parts of the European Union.

## **5 Irrelevant Criteria**

Applicants often advance arguments that have already been declared irrelevant by the courts. These arguments should be rejected and the corresponding passages of the applicable judgments cited.

### **5.1 Term not used**

The fact that a descriptive use of the term applied for cannot be ascertained is irrelevant. Examination of Article 7(1)(c) EUTMR has to be made by means of prognostics (assuming that the mark will be used with respect to the goods or services claimed). It follows clearly from the text of Article 7(1)(c) EUTMR that it suffices if the mark ‘may serve’ to designate characteristics of the goods and services (23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 33).

### **5.2 Need to keep free**

It is frequently claimed that other traders do not need the term applied for, can use more direct and straightforward indications or have synonyms at their disposal to describe the respective characteristics of the goods. All these arguments must be refused as irrelevant.

Although there is a public interest underlying Article 7(1)(c) EUTMR that descriptive terms should not be registered as trade marks so as to remain freely available to all competitors, it is not necessary for the Office to show that there is, on the part of third parties, a present or future need to use, or concrete interest in using, the descriptive term applied for (no *konkretes Freihaltebedürfnis*) (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 35; 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 61).

Whether there are synonyms or other, even more usual, ways of expressing the descriptive meaning is thus irrelevant (12/02/2004, C-265/00, Biomild, EU:C:2004:87, § 42).



### 5.3 Factual monopoly

The fact that the applicant is the only person offering the goods and services for which the mark is descriptive is not relevant for Article 7(1)(c) EUTMR. However, in this case the applicant will be more likely to succeed on acquired distinctiveness.

### 5.4 Double meaning

The argument frequently put forward by applicants that the terms applied for have more than one meaning, one of them not being descriptive for the goods/services, should be rejected. It suffices for a refusal under Article 7(1)(c) EUTMR if at least one of the possible meanings of the term is descriptive in relation to the relevant goods and services (23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 32; confirmed by 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 97).

Given that the examination must focus on the goods/services covered by the application, arguments concerning other possible meanings of the word(s) making up the trade mark applied for (that are unrelated to the goods/services concerned) are irrelevant. Equally, when the trade mark applied for is a composite word mark, what matters for examination purposes is the meaning, if any, associated with the sign considered **as a whole**, and not the possible meanings of its individual elements considered separately (08/06/2005, T-315/03, Rockbass, EU:T:2005:211, § 56).

## 6 Scope of Objections to the Goods and Services

Almost all absolute grounds for refusal, and in particular the most frequent ones of lack of distinctiveness, descriptiveness, genericness and deceptiveness, have to be assessed with respect to the goods and/or services actually claimed.

If an objection is raised, the Office must state specifically which ground (or grounds) for refusal apply to the mark in question, for each product or service claimed.

It is sufficient that a ground for refusal applies to a **single homogenous category** of goods and/or services. A homogenous category is considered a group of goods and/or services that have a sufficiently direct and specific link to each other (02/04/2009, T-118/06, Ultimate fighting championship, EU:T:2009:100, § 28). Where the same ground or grounds for refusal is/are given for a category or group of goods or services, only **general reasoning** for all of the goods or services concerned may be used (15/02/2007, C-239/05, The Kitchen Company, EU:C:2007:99, § 38).

Sign	Case number
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BigXtra	C-253/14 P EU:C:2014:2445
The Court confirmed the refusal in respect of goods and services in Classes 16, 35, and 41 to 43 by means of general reasoning because of a sufficiently concrete and direct link for all these goods and services. For all of them, 'BigXtra' will be perceived as indicating price reductions or other advantages (para. 48).	
<b>Sign</b>	<b>Case number</b>
PIONEERING FOR YOU	T-601/13 EU:T:2014:1067
The General Court allowed general reasoning in respect of goods and services in Classes 7, 9, 11, 37 and 42 because the promotional meaning of the sign applied for would be perceived identically for each of them (paras 36-37).	

As regards descriptiveness, an objection applies not only to those goods/services for which the term(s) making up the trade mark applied for is/are directly descriptive, but also to the **broad category** that (at least potentially) contains an identifiable subcategory or specific goods/services for which the mark applied for is directly descriptive. In the absence of a suitable restriction by the applicant, the descriptiveness objection necessarily affects the broad category as such. For example, 'EUROHEALTH' is to be refused for 'insurance' as a whole and not only for health insurance (07/06/2001, T-359/99, EuroHealth, EU:T:2001:151, § 33).

An objection also applies for those goods and services that **are directly linked** to those for which the descriptive meaning pertains. Furthermore, if the descriptive meaning applies to an activity involving the use of several goods or services mentioned separately in the specification, then the objection applies for all of them (see judgment of 20/03/2002, T-355/00, Tele Aid, EU:T:2002:79, for a number of goods and services offered in conjunction with, or applied in, remote assistance to car drivers).

It is possible to claim goods and services as what can be referred to as **auxiliary goods or services** in the sense that they are meant to be used with, or support the use of, the main goods or services. Typically, this covers paper and instruction manuals for the goods to which they belong or which are packed with them, advertisement and repair. In these cases, the auxiliary goods are by definition intended to be used and sold together with the main product (e.g. vehicles and instruction manuals). It follows that if the EUTM is found to be descriptive of the main goods, logically it is also descriptive of the auxiliary goods, which are so closely related.

## 7 Timing of Objections

Objections should be raised **as early as possible**. In the majority of cases, the Office raises its objection *ex officio* before the publication of the EUTM application.

The Office can reopen the examination of absolute grounds on its **own initiative** at any time before registration (Article 45(3) EUTMR), and in particular, upon receiving observations from **third parties** relating to the existence of an absolute ground for refusal or following an interim decision from the **Boards of Appeal** proposing to re-examine the contested EUTM application on absolute grounds.

Observations from third parties must be submitted before the end of the opposition period or before the final decision on an opposition is taken when an opposition has been filed (Article 45(2) EUTMR). The Office can then decide to reopen the examination procedure as a result of these observations. See the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 3.1.

In the case of **international registrations** designating the EU, the Office can raise an objection as long as the opposition period (one month after republication) has not started (Article 193(7) EUTMR) and any interim status declaration previously sent would be revoked.

## 8 Disclaimers

Pursuant to Regulation No 2015/2424 amending Regulation No 207/2009 on the Community trade mark, it is no longer possible to file a disclaimer to indicate that protection is not requested for a specific element of a mark.

The Office will assess disclaimers filed **before** the date of entry into force of the abovementioned regulation (23/03/2016) according to the former practice applicable.

- As a general rule, a disclaimer will not help to overcome an absolute grounds objection.
- Where a trade mark consists of a combination of elements, each of which in itself is clearly not distinctive, there is no need for a disclaimer of the separate elements. For example, if a periodical had as its trade mark 'Alicante Local and International News' with a figurative distinctive element, the individual word elements within it would not need to be disclaimed.
- If the applicant's disclaimer does not overcome the ground for refusing registration, the application must be refused to the extent that is required.
- Where the applicant has made a disclaimer of a non-distinctive element in its application, the disclaimer will stay even if the Office does not consider it necessary. **Disclaimers of distinctive elements will be refused by the Office** since they would result in a trade mark with an unclear scope of protection.

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### ***Part B***

### ***Examination***

### ***Section 4***

### ***Absolute grounds for refusal***

### ***Chapter 2***

### ***EUTM definition (Article 7(1)(a) EUTMR)***

## Table of Contents

<b>1 General Remarks.....</b>	<b>302</b>
1.1 Signs.....	302
1.2 Distinguishing character.....	303
1.3 Representation on the Register.....	303
<b>2 ‘Non-traditional’ Trade Marks and Article 7(1)(a) EUTMR.....</b>	<b>304</b>
2.1 Shape marks.....	305
2.2 Position marks.....	305
2.3 Pattern marks.....	305
2.4 Colour marks.....	306
2.5 Sound marks.....	308
2.6 Motion marks.....	309
2.7 Multimedia marks.....	312
2.8 Hologram marks.....	312
2.9 Other marks.....	313
2.9.1 Layout of a retail store.....	313
2.9.2 Smell/olfactory marks.....	313
2.9.3 Taste marks.....	314
2.9.4 Tactile marks.....	315
<b>3 Relationship with Other EUTMR Provisions.....</b>	<b>315</b>

## 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 01/10/2017, 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 that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

According to Article 39(2)(a) EUTMR, 'Title II [application procedure] shall not apply to applications for an EU trade mark entered before 01/10/2017, as well as to international registrations for which the designation of the Union was made before that date'.

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:

1. it must be a sign;
2. it must be capable of distinguishing the goods or services of one undertaking from those of others;
3. 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.

### 1.1 Signs

Article 4 EUTMR and Article 3(3) EUTMR, 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) EUTMR, it can qualify as an 'other' mark provided for by Article 3(4) EUTMR, provided it complies with the representation requirements set out in Article (3)1 EUTMR.

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 (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 (25/01/2007, C-321/03, Transparent bin, EU:C:2007:51, § 35, 37).

## **1.2 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’.

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

Article 3(1) EUTMR 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 EUTMR are identical to those established in the Sieckmann case (12/12/2002, C-273/00, Sieckmann, EU:C:2002:748) with respect to the requirement for a clear and precise acceptable ‘graphical’ representation under the previous wording of the EUTMR.

Article 3(9) EUTMR 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 clarity and precision requirements.

Article 3(2) EUTMR 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 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 by applying the criteria listed in Article 3(1) EUTMR, for which no particular consumer segment 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 9) — that is, the filing of a representation of the sign in accordance with the corresponding requirements of Article 3(1) and (3) EUTMR and 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) EUTMR but as an ‘other’ type of mark (Article 3(4) EUTMR), for which there are no specific explicit rules on representation other than that of complying with the standards set out in Article 3(1) EUTMR.

## 2 ‘Non-traditional’ Trade Marks and Article 7(1)(a) EUTMR

Assessing 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 Office’s formalities examination, they can, in general, be assessed directly 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 under Article 7(1)(a) and Article 4 EUTMR might, however, be needed in the case of less ‘traditional’ signs.

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



## 2.1 Shape marks

According to Article 3(3)(c) EUTMIR, a shape mark is a trade mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or its appearance.

The term 'extending to' means that these marks cover not only the shapes per se, but also shapes that contain word or figurative elements, labels, etc.

The representation of shape marks requires the one of the following to be submitted:

- a graphic reproduction of the shape, including computer-generated imaging;
- a photographic reproduction.

The graphic or photographic reproduction may contain different views. Where the representation is not provided electronically, it may contain up to six different views.

## 2.2 Position marks

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

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

An appropriate identification of the **position** of the mark and its size or proportion **with respect** to the relevant goods (mandatory).

A visual disclaimer of those elements that are not intended to form part of the subject-matter of the registration (mandatory). The EUTMIR gives preference to broken or dotted lines.

A description explaining how the sign is affixed to 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, according to Article 3(2) EUTMIR, 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 is 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*.

## 2.3 Pattern marks

Article 3(3)(e) EUTMIR defines pattern marks as those trade marks consisting exclusively of a set of elements that are repeated regularly.

The article requires that pattern marks ‘be represented by submitting a reproduction showing the pattern of repetition.’ Descriptions detailing how its elements are repeated in a regular pattern are allowed for this type of mark. For other cases where the EUTMR allows for the possibility of adding descriptions, the description must accord with the representation and must not extend its scope.

## 2.4 Colour marks

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


1. 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).
2. 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 EUTMR has applied the case-law according to which the representation ‘must be systematically arranged by associating the colours concerned in a predetermined and uniform way’, as 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 meet the requisite standards of precision and uniformity (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 registrations.

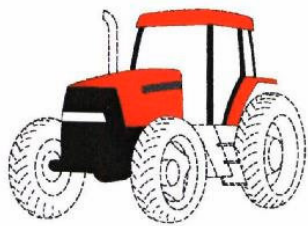
As the trade mark’s subject matter of protection is exclusively determined by the representation itself, any voluntary description detailing the systematic arrangement must accord with the representation (i.e. it cannot be inconsistent with the image shown) and must not extend beyond its subject matter (Article 3(2) EUTMR). 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) EUTMR).

Example of signs that are **acceptable** (with or without a description):

Sign	Case No
	<p>EUTM 11 055 811</p> <p><u>Description:</u> The mark consists of five stripes of colour arranged horizontally and directly adjoining each other, their length being several times larger than their height. The colour distribution from the top to the bottom is: very light green, light green, medium green, dark green and very dark green. Proportion of the five colours: 20 % each.</p>

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

Sign	Case No
 <p><u>Colour indication:</u> 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 5040G50Y + RAL 9018 4 : 1: NCS S 5040G50Y.</p> <p><u>Description:</u> none</p> <p>Class 7 — <i>Wind energy converters, and parts therefor.</i></p>	<p>EUTM: 2 346 542</p> <p>03/05/2017, T-36/16, BLENDED SHADE OF GREEN, EU:T:2017:295</p>
<p>[T]he contested mark was registered as a colour mark (§ 36).</p> <p>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>	

Sign	Case No
 <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> <p>(This mark was applied for as ‘other’ under the previous regime, indicating that it was a position mark. The example is given here to show that it can also be filed as a colour mark (combination of colours), showing how the combination appears on the products.)</p>

## 2.5 Sound marks

Article 3(3)(g) EUTMR 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).

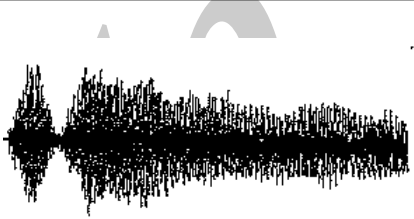
Other means of representation, such as onomatopoeia, musical notes alone and sonograms will not be accepted as representations of sound marks for EUTM applications. In all cases, these representations would not sufficiently enable the competent authorities and the public to determine the clear and precise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

- Description of a sound in words  
A description such as certain notes of a piece of music, 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 (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 (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 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 (27/11/2003, C-283/01, Musical notation, EU:C:2003:641, § 61).

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

## 2.6 Motion marks

Article 3(3)(h) EUTMR 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 multimedia mark below).


Pursuant to Article 3(3)(h) EUTMR, motion marks must be represented by submitting one of the following.

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

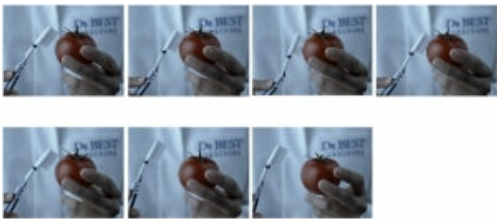
A motion mark **may only be refused** registration under Article 7(1)(a) EUTMR when a reasonably observant person with normal levels of perception and intelligence would, upon consulting the EUTM register, not be able to understand precisely what the mark consists of, without expending a huge amount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

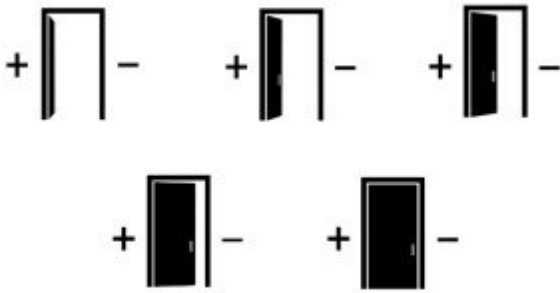
Examples of **acceptable** representations **for motion marks**:

Sign	Case No
 <p><b>Description:</b> 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 9 77</p> <p>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 1 and 2 seconds.</p>	<p>EUTM 5 338 6 29</p>
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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 9 74</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="236 705 1185 981">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="1201 600 1353 667">EUTM 16 023 095</p>
<p data-bbox="236 1010 1358 1245">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 that consists of the opening and closing of a door by pushing buttons on the left or right of the latter is subject to the consumer's personal interpretation. The sign therefore cannot fulfil the clarity and precision requirements 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>	

## 2.7 Multimedia marks

According to Article 3(3)(i) EUTMR, a multimedia mark is a trade mark consisting of, or extending to, the combination of image and sound.

The article requires that multimedia marks 'be represented by submitting an audiovisual file containing the combination of the image and the sound'.

## 2.8 Hologram marks

Article 3(3)(j) EUTMR defines a hologram mark as a trade mark consisting of elements with holographic characteristics, and adds that it 'shall be represented by submitting a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety.'




## 2.9 Other marks

The following types of marks are not explicitly included in the non-exhaustive list of types of marks provided by Article 3(3) EUTMR. They fall under the category of the mark type 'other'.

### 2.9.1 Layout of a retail store

In its judgment of 10/07/2014, C-421/13, Apple Store, EU:C:2014:2070, § 19, the Court of Justice found that a representation that 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 proportions.

Sign	Case No
	10/07/2014, C-421/13, Apple Store, EU:C:2014:2070

Following the abovementioned judgment, it cannot be excluded that the requirements for the representation of the layout of a retail store could be satisfied by a design alone, combining lines, curves and shapes, without any specific indication of the size or 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) EUTMR, the representation must comply with the standards set out in Article 3(1) EUTMR and may be accompanied by a description clearly specifying the subject matter for which protection is sought.

### 2.9.2 Smell/olfactory marks

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 generally available technology**.

Article 3(9) EUTMR 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 representation requirements 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
 <p>Mark description: Smell of ripe strawberries</p>	EUTM No 1 122 118
<p><b>27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34</b></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, Sieckmann, EU:C:2002:748, § 69-73, the 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 by attributing a name or precise code specific to each smell (27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34).

### 2.9.3 Taste marks

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 generally available technology**.

The arguments mentioned above under paragraph 2.9.2 similarly apply to taste marks (04/08/2003, R 120/2001-2, THE TASTE OF ARTIFICIAL STRAWBERRY FLAVOUR (GUSTATORY MARK)).

#### 2.9.4 Tactile marks

It is currently not possible to represent the tactile effect of a certain material or texture 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 generally available technology.

The arguments mentioned above under paragraph 2.9.2 similarly apply to tactile marks (27/05/2015, R 2588/2014-2, EMBOSSED PATTERN ON A SMOOTH BOTTLE SURFACE (TACTILE MARK)).

### 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 on the basis 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 use of the mark.

# ***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

<b>1 General Remarks.....</b>	<b>318</b>
<b>2 Word Elements.....</b>	<b>319</b>
<b>3 Single Letters .....</b>	<b>320</b>
3.1 General considerations.....	320
3.2 Examples.....	321
<b>4 Slogans: Assessing Distinctive Character.....</b>	<b>322</b>
<b>5 Simple Figurative Elements.....</b>	<b>327</b>
<b>6 Commonplace Figurative Elements.....</b>	<b>330</b>
<b>7 Typographical Symbols.....</b>	<b>331</b>
<b>8 Pictograms.....</b>	<b>333</b>
<b>9 Common/Non-Distinctive Labels.....</b>	<b>338</b>
<b>10 Shape Marks.....</b>	<b>340</b>
10.1 Preliminary remarks.....	340
10.2 Shapes unrelated to the goods or services themselves.....	340
10.3 Shape of the goods themselves or shapes related to the goods or services.....	341
10.4 Shape of the packaging.....	349
<b>11 Position Marks.....</b>	<b>353</b>
<b>12 Pattern Marks.....</b>	<b>355</b>
<b>13 Colour Marks.....</b>	<b>361</b>
13.1 Single Colours.....	361
13.2 Colour combinations.....	362
<b>14 Sound Marks.....</b>	<b>363</b>
<b>15 Motion, Multimedia and Hologram Marks.....</b>	<b>366</b>

## 1 General Remarks

The subject matter of a trade mark is defined by the representation of the trade mark (Article 3(2) EUTMR). Specific types of trade mark — namely ‘word mark’, ‘figurative mark’, ‘shape mark’, ‘position mark’, ‘pattern mark’, ‘colour mark’, ‘sound mark’, ‘motion mark’, ‘multimedia mark’, and ‘hologram mark’ — are now defined by law (Article 3(3) (a) to (j) EUTMR). Marks not covered by those specific types may, however, also be filed as EUTM applications (Article 3(4) EUTMR). Regarding the formalities for the different types of trade mark, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 10.

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 (29/04/2004, C-468/01 P – 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; 08/05/2008, C-304/06 P, *Eurohypo*, EU:C:2008:261, § 66; 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 (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 (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, the term 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 (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 (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' (24/04/2012, T-328/11, EcoPerfect, EU:T:2012:197, § 25; 15/01/2013, T-625/11, EcoDoor, EU:T:2013:14, § 21);
- **FLEX** and **FLEXI** as referring to 'flexible' (13/06/2014, [T-352/12](#), Flexi, EU:T:2014:519, § 20-21);
- **GREEN** as being 'environmentally friendly' (27/02/2015, T-106/14, Greenworld, EU:T:2015:123, § 24);
- **MEDI** as referring to 'medical' (12/07/2012, T-470/09, Medi, EU:T:2012:369);
- **MULTI** as referring to 'much, many, more than one' (17/11/2005, R 904/2004-2, MULTI);
- **MINI** as denoting 'very small' or 'tiny' (17/12/1999, R 62/1999-2, MINIRISC);
- **MEGA** as denoting 'big' (28/04/2015, T-137/13, MEGARAIL, EU:T:2015:232, § 38);
- **Premium/PREMIUM** as referring to 'best quality' (22/05/2012, T-60/11, Suisse Premium, EU:T:2012:252, § 46-49, 56, 58; 17/01/2013, T-582/11 & T-583/11, Premium XL / Premium L, EU:T:2013:24, § 26);
- **PRO** as an indication that the designated goods are intended for 'professionals' or are 'supporting' something (25/04/2013, T-145/12, Eco Pro, EU:T:2013:220, § 29-32).
- **PLUS** as denoting 'additional, extra, of superior quality, excellent of its kind'. (15/12/1999, R 329/1999-1, PLATINUM PLUS);
- **SUPER** for highlighting the 'positive qualities of the goods or services' (judgments of 19/05/2010, T-464/08, Superleggera, EU:T:2010:212, § 23-30; 20/11/2002, T-79/01 & T-86/01, Kit Pro / Kit Super Pro, EU:T:2002:279, § 26);
- **ULTRA**<sup>5</sup> as denoting 'extremely' (09/12/2002, R 333/2002-1, ULTRAFLEX);
- **UNIVERSAL** as referring to goods that are 'fit for general or universal use' (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.

<sup>5</sup> Amended on 23/06/2010.

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, 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 (16/09/2004, C-404/02, Nichols, EU:C:2004:538, § 26, 30), and the names of prominent persons (including heads of state). 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).

For objection based on titles of books, please see the Guidelines, Part B, Examination, Section 4, Chapter 4, Descriptive Trade Marks, Paragraph 2.7.2, Titles of books.

### 3 Single Letters <sup>6</sup>

#### 3.1 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).

<sup>6</sup> This part deals with single letters under Article 7(1)(b) EUTMR. For single letters under Article 7(1)(c) EUTMR, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR), paragraph 2.8).



As to the burden of proof, the Court stated that, when examining absolute grounds for refusal, the Office is required under Article 95(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.

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.

### 3.2 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 the sort of toy cubes used to teach children how to construct words. The individual letters in this example are not being used as a sign to distinguish the commercial origin of the goods in question.

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 (30/09/2010, R 1008/2010-2, W (fig.), § 12-21).

For further examples see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR).

## 4 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 (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 only 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 (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 (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' (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 that public consists of average end consumers or of 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 (29/01/2015, T-609/13, SO WHAT DO I DO WITH MY MONEY, EU:T:2015:688, § 27; 29/01/2015, 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 <a href="#">MORE THAN JUST A CARD</a> for Class 36 <i>(bank, credit and debit card services)</i>	Customer service statement	R 1608/2007-4

<p>Objected to under Article 7(1)(b) EUTMR</p> <p>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.</p>		
EUTM	Main function	Case No
<p>EUTM No 7 394 414</p> <p>WE PUT YOU FIRST. AND KEEP YOU AHEAD</p> <p>for Class 40</p>	Customer service statement	(Examiner's decision without BoA case)
<p>Objected to under Article 7(1)(b) EUTMR</p> <p>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.</p>		
EUTM	Main function	Case No
<p>EUTM No 6 173 249</p> <p>SAVE OUR EARTH NOW</p> <p>for Classes 3, 17, 18, 20, 22, 24, 25 and 28</p>	Value statement or political motto	R 1198/2008-4
<p>Objected to under Article 7(1)(b) EUTMR</p> <p>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.</p>		
EUTM	Main function	Case No
<p>EUTM No 4 885 323</p> <p>DRINK WATER, NOT SUGAR</p> <p>for Classes 32 and 33</p>	Inspirational or motivational statement	R 718/2007-2

<p>Objected to under Article 7(1)(b) EUTMR</p> <p>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.</p>		
EUTM	Main function	Case No
<p>DREAM IT, DO IT!</p> <p>Classes 35, 36, 41 and 45</p>	Inspirational or motivational statement	02/07/2008, T-186/07, EU:T:2008:244
<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
<p>VALORES DE FUTURO</p> <p>for Class 41</p>	Value statement	06/12/2013, T-428/12, EU:T:2013:629
<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
<p>INVESTING FOR A NEW WORLD</p> <p>Classes 35 and 36</p>	Value statement	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	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>		
<b>EUTM</b>	<b>Main function</b>	<b>Case No</b>
PIONEERING FOR YOU Classes 7, 9, 11, 37 and 42	Value statement	12/12/2014, T-601/13, EU:T:2014:1067
<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

<b>EUTM</b>	<b>Classes</b>	<b>Case No</b>
SITEINSIGHTS	Classes 9 and 42	R 879/2011-2, EUTM No 9 284 597
<p>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.</p>		
<b>EUTM</b>	<b>Classes</b>	<b>Case No</b>
WET DUST CAN’T FLY	Classes 3, 7 and 37	22/01/2015, T-133/13, EU:T:2015:46
<p>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.</p>		

EUTM	Classes	Case No
LOVE TO LOUNGE	Class 25	15/09/2017, T-305/16, EU:T:2017:607
When the mark is used in relation to the goods in question, namely clothing, footwear and items of headgear, the relevant public will have to place that mark in a certain context, which requires an intellectual effort. The contested mark will enable consumers to identify the commercial origin of the goods at issue. Consequently, that mark has inherent 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 the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR)).



## 5 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.

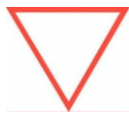

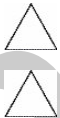
As set out by the Court, an extremely simple sign, composed of a basic geometric figure such as a circle, a line, a rectangle or a pentagon is not capable, as such, of conveying a message that consumers can remember, with the result that they will not consider it as a trade mark (12/09/2007, T-304/05,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

### Examples of refused trade marks

Sign	Goods and services	Reasoning	Case No
	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-indicating function.	12/09/2007, <a href="#">T-304/05</a> , Pentagon

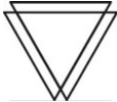
Sign	Goods and services	Reasoning	Case No
	Classes 9, 14, 16, 18, 21, 24, 25, 28, 35-39, 41-45	The sign will be perceived as an excessively simple geometric shape, essentially as a parallelogram. To fulfil the identification function of a trade mark, a parallelogram should contain elements that singularise 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 elongated towards the left. Such nuances would not be perceived by the general consumer.	13/04/2011, T-159/10, Parallélogramme, EU:T:2011:176
	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.	29/09/2009, T-139/08, Smiley, EU:T:2009:364



Sign	Goods and services	Reasoning	Case No
	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.	09/12/2010, T-282/09, Carré convexe vert, EU:T:2010:508
	Classes 35, 41	It is a simple repetition of two basic triangles without any creative arrangement.	Invented example

#### Example of an accepted trade mark

Sign	Goods and services	Reasoning	EUTM No
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	Classes 35, 41	The sign gives the impression of overlapping triangles, but this is actually just an illusion formed by one single line. It is not a simple juxtaposition of basic shapes, but rather a creative arrangement of lines giving a distinctive overall impression.	EUTM No 10 948 222
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Further examples of simple figurative elements (combined with non-distinctive/descriptive terms) can be found in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR).

## 6 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, the 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 the 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 the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR).

## 7 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.

Examples of refused trade marks

Sign	Goods and services	Reasoning	EUTM No
	Classes 14, 18 and 25	<p>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 (30/09/2009, <a href="#">T-75/08</a>, EU:T:2009:374).</p>	<a href="#">EUTM No 5 332 184</a>

Sign	Goods and services	Reasoning	EUTM No
	Classes 29, 30, 31 and 32	<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 percent 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 (16/10/2008, R 998/2008-1, Percent sign (fig.)).</p>	<a href="#">EUTM No 5 649 256</a>


## 8 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. Moreover, if the pictogram immediately conveys information about the kind, quality, intended purpose or other characteristics of the goods or services, it will also be objectionable under Article 7(1)(c) EUTMR (20/07/2016, R 2345/2015-4, PICTOGRAM OF A DROP OF LIQUID AND OF THREE DIRECTIONAL ARROWS (fig.)).



#### Examples of refused trade marks

Sign	Reasoning	Case No
	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).	02/07/2009, T-414/07, Main tenant une carte, EU:T:2009:242


Sign	Reasoning	Case No
 <p>EUTM No 9 894 528 for goods in Class 9</p>	<p>This 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, inter alia, under Article 7(1)(b) and (d) EUTMR.</p>	<p>21/09/2012, R 2124/2011-5, DEVICE OF LIGHTNING BOLT(fig.)</p>

Sign	Reasoning	Case No
 <p>Class 9</p>	<p>Refused for goods in Class 9.</p> <p>It is a well-known fact that a great variety of software applications are available for mobile phones, tablet computers, standard computers or other digital electronic devices, and that such applications, once they are installed, are often represented by a symbol (icon) that makes the application easily accessible for its user. Such symbols can be designed in various ways, ranging from a simple image of a clock, camera or a book, which will represent the nature of the underlying software application, to an arbitrary symbol and/or a trade mark that in itself does not reveal anything about the software it is used for (para. 18).</p> <p>The inclusion of a person's silhouette on a square shaped background is a natural way of designing icons that, when used in mobile phones, tablet computers, standard computers or other digital electronic devices, will be seen as representing an application for managing contact information, such as telephone numbers and/or addresses (para. 19 et seq.).</p>	<p>25/01/2016, R 1616/2015-5, A B C D (fig.)</p>



Sign	Reasoning	Case No
 <p>Classes 9 and 38</p>	<p>Refused for goods in Class 9 and services in Class 38.</p> <p>An email system running on a computer or handheld device (e.g. tablet or mobile phone) must use 'icons' to represent the current status of an application or operation. There is no more apt 'icon' — which is nothing more than a small graphic representation of a program or file — to represent an electronic message than an envelope. The 'tick' indicates that something has been done correctly or that something has been checked (paras 16 and 17). It is well known what these kind of icons look like (para. 19).</p>	<p>05/04/2016, R 2256/2015-2, DEVICE OF AN OPEN ENVELOPE WITH A CHECK SIGN (fig.)</p>
	<p>Refused for goods in Class 9.</p> <p>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>

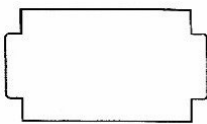
#### Example of accepted trade marks


Sign	Reasoning	EUTM No
	Accepted for goods and services in Classes 9 and 43.  The representation does not have any direct discernible meaning in relation to the goods and services at issue.	EUTM No 16 314 494

## 9 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 No
  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> )	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).	22/05/2006, R 1146/2005-2, LABEL SHAPE (3D)

Sign	Reasoning	Case No
 EUTM No 9 715 319 for goods in Classes 6, 7, 8, 9 and 20	<p>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, that is, 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>	15/01/2013, R 444/2012-2, DEVICE OF A LABEL IN COLOUR YELLOW (fig.)

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
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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*.

## 10 Shape Marks

### 10.1 Preliminary remarks

The principles set out in this section should be read in line with the principles established in [CP9 Common Practice – Distinctiveness of three-dimensional marks \(shape marks\) containing verbal and/or figurative elements when the shape is not distinctive in itself](#), adopted by the Office on 01/04/2020 and applied as of that date, including with regards to ongoing procedures.

Article 3(3)(c) EUTMR defines shape marks as trade marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The term ‘extending to’ means that these marks cover not only shapes per se but also shapes that contain word or figurative elements such as logos or labels.

Article 7(1)(b) EUTMR does not distinguish between different categories of trade marks in determining whether a trade mark is capable of distinguishing the goods or services of one undertaking from those of other undertakings (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 depending on 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 (07/10/2004, C-136/02 P, *Torches*, EU:C:2004:592, § 30).



Shape 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.

### 10.2 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.

*Accepted trade marks*

Sign	Reasoning	EUTM No
	<p>Registered for goods in Classes 16 and 21</p> <p>The sign is clearly different to what is commonly expected for the corresponding goods (paper, rolls of paper for household use, kitchen utensils and containers, etc.).</p>	<b>EUTM No 1 705 367</b>
	<p>Registered for goods in Classes 36, 39 and 42, (insurance and financial services, rental and leasing of vehicles, and leasing of commercial and industrial equipment).</p> <p>The shape is unrelated to the goods and services and therefore perfectly capable of distinguishing them.</p>	<b>EUTM No 715 524</b>

### 10.3 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 (14/09/2009, T-152/07, Uhr, EU:T:2009:324; 04/05/2017, C-417/16 P, DEVICE OF A SQUARE-SHAPED PACKAGING (fig.), EU:C:2017:340).

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

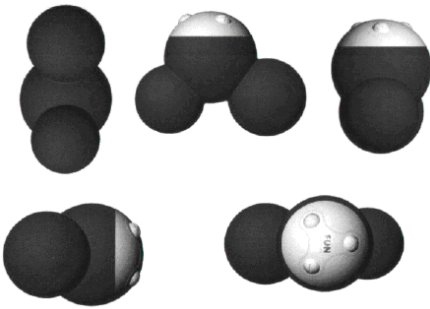
The examiner should first examine whether one of the grounds for refusal under Article 7(1)(e) EUTMR applies, as those cannot be overcome through acquired distinctiveness. With regard to this first step, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 6: Shapes or Other Characteristics with an Essentially Technical Function, Substantial Value or Resulting from the Nature of the Goods (Article 7(1)(e) EUTMR).

#### Step 2: identifying the elements of the shape mark

In the second step, the examiner should assess whether the representation of the shape mark extends to **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 shape 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 shape 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 (18/01/2013, T-137/12, Vibrator, EU:T:2013:26, § 34-36).

Sign	Case No
	<p>R 1511/2013-2</p> <p>(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).</p> <p>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 No
	<p>12/07/2012, T-323/11, Botella, EU:T:2012:376</p>

Sign	Case No
<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 No
	<p>18/01/2013, T-137/12, Vibrator</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 shape trade marks consisting exclusively of the shape of the goods themselves.

- A shape is non-distinctive if it is a basic shape (19/09/2001, T-30/00, red-white squared washing tablet (fig.), EU:T:2001:223) or a combination of basic shapes (13/04/2000, R 263/1999-3, Tönnchen (3D)).
- 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 (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 (07/10/2004, C-136/02 P, *Torches*, EU:C:2004:592, § 32; 07/02/2002, T-88/00, *Torches*, EU:T:2002:28, § 37).
- Functional shapes or features of a shape 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 shape 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 shape mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product (19/09/2001, T-30/00, red-white squared washing tablet (fig.), EU:T:2001:223, § 49).

#### Specific case: toys, dolls and play figures

Applications for shape 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 shape 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**.

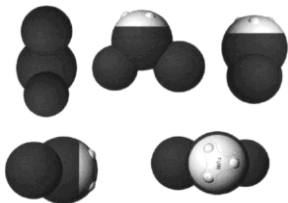

#### Examples

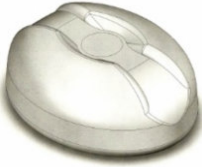

The following is a list of examples of shapes of goods for which protection has been sought and an analysis of them.

#### *Rejected product shapes*



Sign	Reasoning	Case No
	<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 <i>washing or dishwashing preparations in tablet form</i> 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 (19/09/2001, T-30/00, red-white squared washing tablet (fig.), 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, Tabs (3D), EU:C:2007:577.</p>	<p>19/09/2001, T-30/00, red-white squared washing tablet (fig.)</p>
	<p>This shape was refused as it is merely a variant of a common shape of this type of product, i.e. <i>flashlights</i> (para. 31).</p>	<p>07/10/2004, C-136/02 P, Torches</p>


Sign	Reasoning	Case No
	<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>	18/01/2013, T-137/12, Vibrator
	<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>	06/09/2012, C-96/11 P, Milchmäuse, EU:C:2012:537
	<p>This shape 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>	16/09/2009, T-391/07, Teil des Handgriffes, EU:T:2009:336

Sign	Reasoning	Case No
	<p>The Court confirmed the case-law on non-distinctiveness of shape 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>12/12/2013, T-156/12, Oval, EU:T:2013:642</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>

*Accepted product shapes*

Sign	Reasoning	EUTM No
	Accepted for <i>toys</i>	EUTM No 15 240 534
	Accepted for <i>ice creams</i>	EUTM No 10 350 593
	Accepted for <i>pumps, compressors</i>	EUTM No 5 242 433
	Accepted in Class 9, <i>protective covers for mobile phones</i>	EUTM No 12 269 511

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

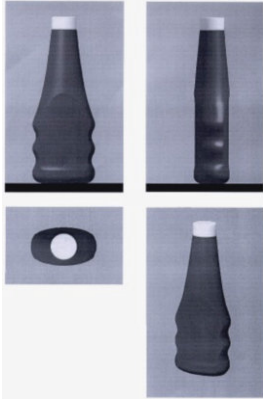
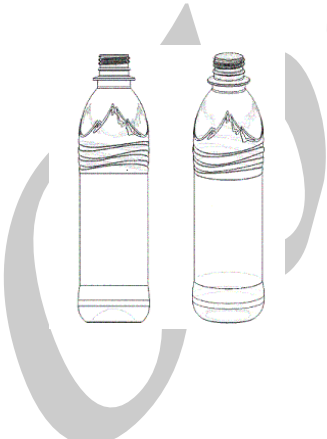
Sign	Reasoning	Case No
	<p>Class 35 — Retail Services for various goods and services.</p> <p>The case-law on marks consisting of the shape of the goods applies also with respect to services. The ‘get-up’ or appearance of services consists, in particular, of the environment in which they are offered and/or 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>The first instance decision regarding the mark’s lack of distinctive character was confirmed by the Board.</p>	R 2224/2015-1


## 10.4 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, Standbeutel, EU:C:2005:474).

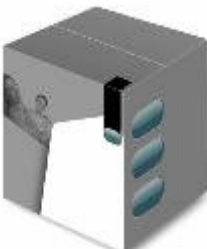


Examples of marks for which protection was sought for the shape of the packaging*Rejected trade marks*

Sign	Reasoning	Case No
	<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>24/05/2012, C-98/11 P, Hase</p>
	<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>10/11/2004, T-402/02, Bonbonverpackung, EU:T:2004:330</p>

Sign	Reasoning	Case No
	<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 affect 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>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>19/04/2013, T-347/10, Getränkeflasche, EU:T:2013:201</p>

Sign	Reasoning	Case No
	The shape does not depart significantly from the norms and customs of the sector, 'where what is involved is the packaging of a liquid product and the sign consists of the appearance of the product itself'.	07/05/2015, C-445/13 P, Bottle, EU:C:2015:303, confirming 28/05/2013, T-178/11, Bottle, EU:T:2013:272

### Accepted trade marks

Sign	Reasoning	Case No
	Accepted for goods in Classes 4 and 11	EUTM No 12 491 858
	Accepted for goods in Classes 29, 30, 32	EUTM No 12 485 702
	The Board of Appeal annulled the decision refusing the registration of the shape mark for <i>chewing gums and other confectionery</i> . The Board of Appeal considered that the shape is not common in the market sector in question.	R 832/2012-2



## 11 Position Marks

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

Applications for position marks effectively seek to extend protection to the specific way in which elements (figurative, colour, etc.) are placed on or affixed to the product.

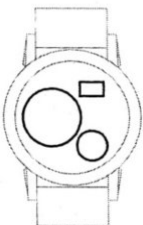
The factors to be taken into account when examining shape marks are also relevant for position marks. In particular, the examiner must consider whether the relevant consumer will be able to identify a sign that is different from the normal appearance of the products themselves. A further relevant consideration 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.


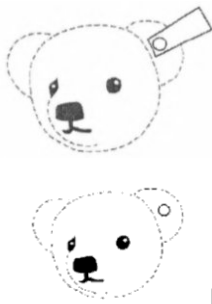
Note that even where it is accepted that the relevant public may be attentive to the different aesthetic details of a product, this does not automatically imply that they will perceive it as a trade mark. In certain contexts, and given the norms and customs of particular trades, a position mark may appeal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

### Examples


The following are examples of the assessment of position marks.

#### *Rejected position marks*

Sign	Reasoning	Case No
	<p>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 not substantially different from other designs on the market.</p>	<p>14/09/2009, T-152/07, Uhr</p>

Sign	Reasoning	Case No
	<p>In this case involving hosiery consisting of an orange strip 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>15/06/2010, T-547/08, Strumpf, EU:T:2010:235</p>
	<p>Buttons are common decorative elements of soft toys. A button is a simple geometrical form that does not depart from the norm or customs of the sector. It is not uncommon to attach badges, rings, ribbons, loops and embroidery 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>16/01/2014, T-433/12, Knopf im Stofftierohr, EU:T:2014:8 &amp; 16/01/2014, T-434/12, Fähnchen im Stofftierohr, EU:T:2014:6</p>

*Accepted position mark*

Sign	Description	EUTM No
	<p>Class 25</p> <p>Description: the trade mark is a position mark. It consists of a figurative element placed on the outer surface of the upper part of a shoe, extending lengthwise from the centre of the cuff of the shoe down to the sole. The dotted line shows the position of the trade mark on the shoe, and does not form part of the trade mark.</p>	EUTM No 13 755 244

## 12 Pattern Marks

Article 3(3)(e) EUTMR defines pattern marks as trade marks consisting 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 shape marks that consist of the appearance of the product itself (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 websites, 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 (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 (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).

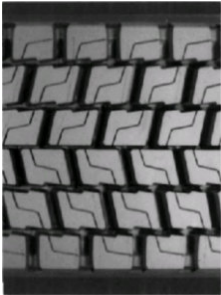

The fact that the pattern may also have other functions and/or effects is an additional argument for concluding that it lacks distinctive character. By contrast, if a pattern is fanciful, unusual and/or arbitrary, departs from the norm or customs of the sector or is, more generally, capable of being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

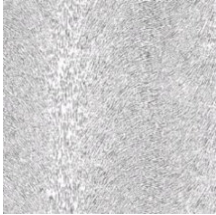
As seen above, the distinctive character of pattern marks must usually be assessed with regard to goods. Nevertheless, a pattern mark that has been considered devoid of distinctive character for the goods it covers must also be regarded as lacking distinctiveness for services that are closely connected 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, DEVICE OF A POCKET (fig.)). The same considerations would apply to a fabric pattern with regard to services such as *manufacture of fabrics*.

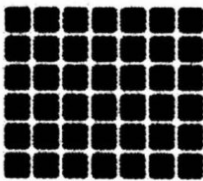
#### Examples of pattern marks

##### *Rejected pattern marks*


Sign	Reasoning	Case No
 <p>EUTM No 8 423 841, filed as a figurative mark in Classes 18, 24 and 25</p>	<p>The criteria for shape 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>19/09/2012, T-326/10, Stoffmuster, EU:T:2012:436, § 47-48</p>
 <p>EUTM No 8 423 501, filed as a figurative mark in Classes 18, 24 and 25</p>	<p>In this case, similarly to the previous case, the General Court confirmed the refusal of the mark.</p>	<p>19/09/2012, T-329/10, Stoffmuster</p>

Sign	Reasoning	Case No
 <p>EUTM No 5 066 535 filed as a figurative mark in Class 12 (<i>tyres</i>)</p>	<p>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 <i>tyres</i>, 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 an indicator of origin.</p>	<p>Examiner's decision without BoA case</p>
 <p>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>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>Examiner's decision without BoA case</p>


Sign	Reasoning	Case No
 <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>09/10/2002, T-36/01, Glass Pattern, § 26-28</p>

Sign	Reasoning	Case No
 <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 is an immediately noticeable feature that could catch the average consumer's attention and cause the consumer to perceive the sign as a distinctive one.</p>	<p>14/11/2012, R 2600/2011-1, DEVICE OF A BLACK AND WHITE PATTERN (fig.)</p>

*Accepted pattern marks*

Sign	Reasoning	EUTM No
	<p>Classes 16, 18, 25</p>	<p>EUTM No 15 602</p>



Sign	Reasoning	EUTM No
	Classes 18, 20, 21, 24, 25, 27	EUTM No 3 191 301

## 13 Colour Marks

This paragraph is concerned with single colours or combinations of colours as such ('colour marks' within the meaning of Article 3(3)(f) EUTMR).

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 appears on the goods or their packaging, in a way that accords with the representation, or in advertisements or promotional material for the services.

### 13.1 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 (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 (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 exceptional circumstances.

Such exceptional circumstances require the applicant to demonstrate that the mark is unusual or striking in relation to these specific goods or services. These cases will be very 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 14.2 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 (13/09/2010, T-97/08, Colour (shade of orange) II, EU:T:2010:396, § 44-47).

## 13.2 Colour combinations

In the case of a colour combination, a refusal can only be based on specific facts or arguments, and where such specific arguments for refusal 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). See judgment of 03/05/2017, T-36/16, GREEN STRIPES ON A PIN (col.), EU:T:2017:295, paras 43 to 47, in which the Court stated that the colour green, perceived as the colour of nature, would lead the relevant public to understand it as referring to the ecological nature of the goods at issue (*wind energy converters*).
- 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 reiterated 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 the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR).

## 14 Sound Marks

The definition of sound marks is restricted to only those that consist exclusively of a sound or a combination of sounds (Article 3(3)(g) EUTMR). Trade marks combining sounds with other elements, namely movement, do not qualify as sound marks, but are considered multimedia 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 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 (see, 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 (see, by analogy, judgment of 24/05/2012, C-98/11 P, *Hase*, EU:C:2012:307, § 42).



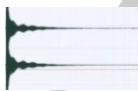
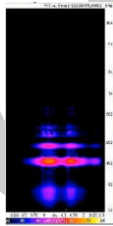
The kinds of sound marks that are **unlikely** to be accepted without evidence of factual distinctiveness include:



1. very simple pieces of music consisting of only one or two notes (see examples below);
2. sounds that are in the common domain (e.g. La Marseillaise, Für Elise);
3. sounds that are too long to be considered as an indication of origin;
4. 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

#### Refused trade marks

Sign	Goods and services	Reasoning	Case No
 [Two musical notes, F and C]	35, 36, 38, 39, 41, 42	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 No 4 010 336
 [Two extremely short blips]	9, 38	Machine-generated blip that is commonly emitted by computers and other electronic devices.	EUTM No 9 199 167
 [Ping sound, resembling a warning signal]	9, 16, 28	Sound constitutes a warning signal and a direct characteristic of the goods applied for.	R 2444/2013-1
 [Machine-generated synthesised sound]	9, 12, 35	Sound typically linked to the goods and services applied for.	R 1338/2014-4

Sign	Goods and services	Reasoning	Case No
 [The first 13 notes of 'La Marseillaise']	Any	A national anthem is in the public domain. This necessarily implies that it is a non-distinctive sign as it will not be perceived as an indicator of commercial origin.	Invented example
	9, 38 and 41	<p>Although — as regards certain goods or services — a sound may be commonly used to identify a product or service as coming from a particular undertaking, such sound has to be perceived neither (i) as a functional element nor (ii) as an indicator without any inherent characteristics. In particular, a sound sign characterised by excessive simplicity will not be perceived as a trade mark.</p> <p>In the present case, the mark applied for is a very simple sound motif, that is to say, in essence, a banal and commonplace ringing sound that would generally go unnoticed and would not be remembered by the target consumer.</p>	13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM PLIM (sound mark), EU:T:2016:468

*Accepted trade marks*

Sign	Goods and services	Reasoning	Case No
N/A (electronic file) [Short sequence of easily identifiable tones]	9, 35, 36, 37, 38, 39, 42, 43, 44, 45	The sign is short but it is not too simple and is capable of being memorised by the relevant consumer.	EUTM No <a href="#">17 396 102</a>
N/A (electronic file) [Human voice]	3, 9, 16, 25, 28, 35, 41, 43	Clearly pronounced distinctive word (barça)	EUTM No <a href="#">17 700 361</a>
 [sequence of four different tones, initially falling by a fourth and then rising and ending on the median]	16, 35, 42	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	According to general life experience, jingle-like sound sequences enable goods and services to be distinguished.	R 87/2014-5

## 15 Motion, Multimedia and Hologram Marks

Article 3(3)(h) EUTMR describes a **motion mark** as a trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark. The term 'extending to' means that these marks cover not only the motion per se but also movements that contain word or figurative elements such as logos or labels.

The proposed 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 (e.g. a sequence of stills). Motion marks do not include sound (see multimedia marks below).




According to Article 3(3)(i) EUTMR, a **multimedia mark** is a trade mark consisting of, or extending to, the combination of image and sound. The term 'extending to' means



that these marks cover not only the combination of sound and image per se but also combinations that include word or figurative elements.

Article 3(3)(j) EUTMR defines a **hologram mark** as a trade mark consisting of elements with holographic characteristics.

In the absence of relevant case-law, the general criteria for the assessment of distinctiveness will apply to these marks. The mark will be distinctive within the meaning of Article 7(1)(b) EUTMR if the sign can serve to identify the product and/or services for which registration is applied for as originating from a particular undertaking, and thus to distinguish that product/service from those of other undertakings. This distinctiveness will be assessed by reference, first, to the goods or services for which registration is sought and, second, to the relevant public's perception of that sign. These marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark.

#### *Examples of accepted trade marks*

Mark type (with verbal outline of the content)	Partial representation of sign (for reference purposes)	EUTM No
Motion  Outline of a red apostrophe on a white background, over which appears the slogan 'The future is exciting', which is then replaced with the word 'Ready?'		EUTM No <a href="#">17 894 840</a>  Registered for goods in Classes 9, 35, 38 and 41.
Motion  The word 'TIMEQUBE' on a white background, accompanied by a cube, which changes colour, from white to green to yellow to brown to red, and all shades in between.		EUTM No <a href="#">17 911 214</a>  Registered for goods in Class 14.
Multimedia  A one-eyed ball-like figure, which moves on a spotlight black background, with musical accompaniment and a voice shouting 'Bingo'.		EUTM No <a href="#">17 931 160</a>  Registered for goods in Classes 9, 28 and 41.

<p>Multimedia</p> <p>The sole of a shoe, which changes colour as it appears to tread, accompanied by beats in time with the impact of the sole; these impacts are marked by shock waves alongside the sole. The verbal element 'Callaghan' is visible on the sole at some point.</p>		<p>EUTM No <a href="#">17 941 596</a></p> <p>Registered for goods in Class 25.</p>
<p>Multimedia</p> <p>A beating heart made from various mechanical elements, including a moving handle and key, accompanied by beating sounds. At the sounds of a swoosh, the heart moves to the left, and the word expression 'IFORI INTELLECTUAL PROPERTY &amp; ICT LAW' appears.</p>		<p>EUTM No <a href="#">17 279 704</a></p> <p>Registered for services in Class 45.</p>



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

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

### ***Part B***

### ***Examination***

### ***Section 4***

### ***Absolute grounds for refusal***

### ***Chapter 4***

### ***Descriptive trade marks (Article 7(1)(c) EUTMR)***

## Table of Contents

<b>1 General Remarks.....</b>	<b>371</b>
1.1 The notion of descriptiveness.....	371
1.2 The reference base.....	371
1.3 Characteristics mentioned under Article 7(1)(c) EUTMR.....	373
<b>2 Word Marks.....</b>	<b>375</b>
2.1 One word.....	375
2.2 Combinations of words.....	376
2.3 Misspellings and omissions.....	378
2.4 Abbreviations and acronyms.....	380
2.5 Slogans.....	381
2.6 Geographical terms.....	382
2.6.1 Preliminary remarks.....	382
2.6.2 Assessment of geographical terms.....	383
2.7 Terms describing subject matter in goods or services.....	390
2.7.1 General considerations.....	390
2.7.2 Titles of books.....	393
2.8 Single letters and numerals.....	394
2.9 Names of colours.....	396
2.10 Names of banks, newspapers/magazines and airports.....	398
2.11 Names of hotels.....	400
2.12 Combinations of names of countries/cities with a number indicating a year.....	401
2.13 INN codes.....	402
<b>3 Figurative Marks.....</b>	<b>403</b>
<b>4 Figurative Threshold.....</b>	<b>405</b>
4.1 Preliminary remarks.....	405
4.2 Assessment of the figurative threshold.....	406
4.2.1 Word elements in a mark.....	407
4.2.2 Figurative elements (word element(s) and additional figurative element(s)).....	411
4.2.3 Word and figurative elements (stylised word elements and additional figurative element(s)).....	418

## 1 General Remarks

### 1.1 The notion of descriptiveness

A sign must be refused as descriptive if it has a meaning that is immediately perceived by the relevant public as providing information about the goods and services applied for. This is the case where the sign provides information about, *inter alia*, the quantity, quality, characteristics, purpose, kind and/or size of the goods or services. The relationship between the term and the goods and services must be sufficiently direct and specific (20/07/2004, T-311/02, *Limo*, EU:T:2004:245, § 30; 30/11/2004, T-173/03, *Nurseryroom*, EU:T:2004:347, § 20), as well as concrete, direct and understood without further reflection (26/10/2000, T-345/99, *Trustedlink*, EU:T:2000:246, § 35). If a mark is descriptive, it is also non-distinctive.

Article 7(1)(c) EUTMR does not apply to those terms that are only suggestive or allusive as regards certain characteristics of the goods and/or services. Sometimes this is also referred to as vague or indirect references to the goods and/or services (31/01/2001, T-135/99, *Cine Action*, EU:T:2001:30, § 29).

The public interest underlying Article 7(1)(c) EUTMR is that exclusive rights should not exist for purely descriptive terms that other traders might wish to use as well. However, it is not necessary for the Office to show that there is already a descriptive use by the applicant or its competitors. Consequently, the number of competitors that could be affected is totally irrelevant. Therefore, if a word is descriptive in its ordinary and plain meaning, this ground for refusal cannot be overcome by showing that the applicant is the only person who produces, or is capable of producing, the goods in question.

### 1.2 The reference base

The **reference base** is the ordinary understanding of the relevant public of the word in question. That can be corroborated by **dictionary entries**, examples of the use of the term in a descriptive manner found on internet **websites**, or it may clearly follow from the **ordinary understanding** of the term.

It is not necessary for the Office to prove that the word is the subject of a dictionary entry in order to refuse a sign. In particular for composite terms, dictionaries do not mention all possible combinations. What matters is the ordinary and plain meaning. In addition, terms used as specialised terminology to designate the respective relevant characteristics of the goods and services are to be considered descriptive. In these cases it is not required to demonstrate that the meaning of the term is immediately apparent to the relevant consumers to which the goods and services are addressed. It suffices that the term is meant to be used, or could be understood by part of the relevant public, as a description of the goods or services for which protection is sought,

or a characteristic of the goods and services (17/09/2008, T-226/07, Pranahaus, EU:T:2008:381, § 36; 18/11/2015, T-558/14, TRILOBULAR, EU:T:2015:858, § 50).

Article 7(1)(c) EUTMR also applies to **transliterations**. In particular, transliterations of Greek words into Latin characters must be treated in the same way for the purpose of examining absolute grounds for refusal as words written in Greek characters and vice versa (16/12/2010, T-281/09, Chroma, EU:T:2010:537, § 34). This is because the Latin alphabet is known to Greek-speaking consumers. The same applies to the Cyrillic alphabet, which is used in the EU by Bulgarians, who are also familiar with Latin characters.

The following **principles** in respect of both language and dictionary use apply, with regard to the reference base:

#### Languages

1. The sign must be refused if it is descriptive in any of the **official languages of the European Union**, regardless of the size or population of the respective country. Systematic language checks are only performed in the official languages of the European Union.
2. Should there be convincing evidence that a given term has a meaning in a **language other than the official languages of the Union** and is understood by a significant section of the relevant public in at least a part of the European Union, this term must also be refused pursuant to Article 7(2) EUTMR (13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 35-36). For example, the term 'Hellim' is the Turkish translation of the word 'Halloumi', a type of cheese. Since Turkish is an official language in Cyprus, it is a language that is understood and spoken by part of the population of Cyprus, and therefore the average consumer in Cyprus may understand that 'Hellim' is a descriptive term for cheese (13/06/2012, T-534/10, Hellim, EU:T:2012:292).

Under point 1 above, consideration must, under certain circumstances, be given to the understanding by the relevant public of foreign terms in the sense that they originate from another EU language. This may be because, depending on the goods and services claimed in the EUTM application, the relevant public:

- has an **elementary understanding** of the language in question and the sign consists of an elementary word of that language. This is supported by the fact that the GC has held that a very large proportion of European consumers and professionals have an elementary knowledge of English (26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 41);
- consists of **specialists** for whom certain technical terms in another EU Member State's official language are understood:

The GC has held that certain English terms in the medical field (29/03/2012, T-242/11, 3D eXam, EU:T:2012:179, § 26), in technical fields (09/03/2012, T-172/10, Base-seal, EU:T:2012:119, § 54) and in financial matters (26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 41) will be understood by the relevant professionals throughout the European Union, as English is the commonly used professional language in these areas;

- understands the meaning in cases where a term in one language (e.g. English) has **entered into the dictionary or parlance** of another language (e.g. German) and acquired a descriptive character that may or may not exist in the original language (e.g. the sign ‘Old Timer’ applied for cars would be objectionable with regard to the German-speaking public as a reference to ‘classic/veteran car’ and not necessarily for the English-speaking consumers).

This is supported by the fact that the understanding of languages is not strictly limited by geographical borders, it may well be that, **for historical, cultural or cross-border market reasons**, certain (usually elementary) vocabulary of a given language may spread and could be widely understood by the general public in other Member States, particularly those with contiguous land borders, e.g. ‘bon appétit’, ‘ciao’, ‘siesta’, ‘fiesta’, ‘merci’, ‘voilà’.

#### Evidence

The **evidence** can come by individual knowledge of the particular examiner, or is produced via third-party observations or by way of documentation included in cancellation requests.

- An internet search is also a valid means of evidence for the descriptive meaning, in particular for new terms, technical jargon or slang words, but the evidence should be carefully assessed in order to find out whether the word is actually used in a descriptive manner, as often the difference between descriptive and trade mark use on the internet is vague and the internet contains a vast amount of unstructured, unverified information or statements.
- The objection should clearly state which language or languages are concerned, which makes the ground for refusal applicable at least for the Member State in which this language is the official language or one of the official languages, and excludes conversion for that Member State (see Article 140(4) EUTMR).

### **1.3 Characteristics mentioned under Article 7(1)(c) EUTMR**

#### Kind of goods and services

This includes the goods or services themselves, that is, their type or nature. For example, ‘bank’ for financial services, ‘Perle’ for wines and sparkling wines (01/02/2013, T-104/11, ‘Perle’, EU:T:2013:51,) or ‘Universaltelefonbuch’ for a universal telephone directory (14/06/2001, T-357/99 & T-358/99, Universaltelefonbuch, EU:T:2001:162) or constituent parts or components of the goods (15/01/2013, T-625/11, EcoDoor, EU:T:2013:14, § 26).

#### Quality

This includes both laudatory terms, referring to a superior quality of the respective goods or services, as well as the inherent quality of the goods or services. It covers terms such as ‘light’, ‘extra’, ‘fresh’, ‘hyper light’ for goods that can be extremely light (27/06/2001, R 1215/2000-3, Hyperlite). In addition, figures may refer to the quality of a

product or a service, such as 24/7 for service availability; '2000', which refers to the size of the motor or '75', which refers to the horse power (kW) of the motor.

#### Quantity

This covers indications of the quantity in which the goods could be sold, such as 'six pack' for beer, 'one litre' for drinks, '100' (grams) for chocolate bars. Only quantity measurements relevant in trade, not those that are hypothetically possible, count. For example, 99.999 for bananas would be acceptable.

#### Intended purpose

The intended purpose is the function of a product or service, the result that is expected from its use or, more generally, the use for which the good or service is intended. An example is 'Trustedlink' for goods and services in the IT sector aimed at securing a safe (trusted) link (26/10/2000, T-345/99, Trustedlink, EU:T:2000:246). Marks that have been refused registration on this basis include 'Therapy' for massage tools (08/09/1999, R 144/1999-3, THERAPY) and 'Slim belly' for fitness training apparatus, sport activities, medical and beauty care services (30/04/2013, T-61/12, Slim belly, EU:T:2013:226). This objection also applies as regards accessories: a term that described the type of goods also describes the intended purpose for accessories to those goods. Therefore, 'Rockbass' is liable to objection for accessories for rock guitars (08/06/2005, T-315/03, Rockbass, EU:T:2005:211 (appeal C-301/05 P settled)).

#### Value

This covers both the (high or low) price to be paid, as well as the value in quality. It therefore does not only refer to expressions such as 'extra' or 'top', but also expressions such as 'cheap' or 'more for your money'. It also includes expressions indicating, in common parlance, goods or services that are superior in quality.

#### Geographical origin

See paragraph 2.6 below.

#### Time of production of the goods or of rendering of the service

This covers expressions concerning the time at which services are rendered, either expressly ('evening news', '24 hours') or in a usual manner (24/7). It also covers the time at which goods are produced if that is relevant for the goods (late vintage for wine). For wine, the numeral '1998' indicating the vintage year would be relevant, but not for chocolate.

#### Other characteristics

This covers other characteristics of the goods or services and shows that the preceding list of items in Article 7(1)(c) is not exhaustive. In principle, any characteristic of the goods and services must lead to a refusal under Article 7(1)(c) EUTMR. It does not matter whether the characteristics of the goods or services are commercially essential or merely ancillary or whether there are synonyms of those characteristics (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 102; 24/04/2012, T-328/11, EcoPerfect, EU:T:2012:197, § 41).

#### *Examples of 'other characteristics'*

- the subject matter contained within the goods or services for which protection is sought: (see paragraph 2.7 below);
- the identification of the targeted consumer: ‘children’ for *bread* (18/03/2016, T-33/15, BIMBO, EU:T:2016:159) or ‘ellos’ (27/02/2002, T-219/00, Ellos, EU:T:2002:44) for *clothing*.

## 2 Word Marks

### 2.1 One word

Descriptive terms are those that merely consist of information about the characteristics of the goods and services. This means that descriptive terms cannot fulfil the function of a trade mark. Consequently, the ground for refusal applies irrespective of whether a term is already used by other competitors in a descriptive manner for the goods and services at issue.

In particular, a word is descriptive if either for the general public (if the goods or services target them) or for a specialised public (irrespective of whether the goods or services also target the general public) the trade mark has a descriptive meaning.

- The term ‘RESTORE’, is descriptive for surgical and medical instruments and apparatus; stents; catheters; and guide wires (17/01/2013, C-21/12 P, Restore, EU:C:2013:23).
- ‘CONTINENTAL’ is descriptive for ‘live animals, that is to say, dogs’ and ‘the keeping and breeding of dogs, that is to say, puppies and animals for breeding’. Indeed, the word ‘Continental’ indicates a breed of bulldogs (17/04/2013, T-383/10, Continental, EU:T:2013:193).
- ‘TRILOBULAR’ is descriptive for screws. It would be immediately perceived by professionals as describing the fact that the screw is made up of three lobes, and thus describes a quality or characteristic, which is, moreover fundamental, of those goods (18/11/2015, T-558/14, TRILOBULAR, EU:T:2015:858, § 32).

Furthermore, as seen above, objections should also be raised against terms that describe desirable characteristics of the goods and services.

However, it is important to distinguish laudatory terms that describe — although in general terms — desirable characteristics of goods and services as being cheap, convenient, of high quality, etc. and that are excluded from registration, from those terms that are laudatory in a broader sense, that is to say, they refer to vague positive connotations or to the person of the purchaser or producer of the goods without specifically referring to the goods and services themselves.

Not descriptive:

- ‘BRAVO’, as it is unclear who says ‘BRAVO’ to whom, and what is being praised (04/10/2001, C-517/99, Bravo, EU:C:2001:510).

## 2.2 Combinations of words

As a general rule, a **mere combination of elements**, each of which is descriptive of characteristics of the goods or services themselves, remains descriptive of those characteristics. Merely bringing those elements together without introducing unusual variations, in particular as to syntax or meaning, cannot result in anything other than a descriptive sign.

However, if due to the **unusual nature of the combination** in relation to the goods or services, a combination creates an **impression that is sufficiently far removed** from that produced by the mere combination of meanings lent by the elements of which it is composed, that combination will be considered **more than the sum of its parts** (12/02/2004, C-265/00, Biomild, EU:C:2004:87, § 39, 43). These notions, 'unusual nature of the combination', 'impression sufficiently far removed' and 'more than the sum of its parts' have to be interpreted as meaning that Article 7(1)(c) EUTMR does not apply when the way in which the two descriptive elements are combined is in itself fanciful.

The following examples have been **refused** registration:

- 'Biomild' for yoghurt being mild and organic (12/02/2004, C-265/00, Biomild, EU:C:2004:87);
- 'Companyline' for insurance and financial affairs (19/09/2002, C-104/00 P, Companyline, EU:C:2002:506);
- 'Trustedlink' for software for e-commerce, business consulting services, software integration services and education services for e-commerce technologies and services (26/10/2000, T-345/99, Trustedlink, EU:T:2000:246);
- 'Cine Comedy' for the broadcast of radio and television programmes, production, showing and rental of films, and allocation, transfer, rental and other exploitation of rights to films (31/01/2001, T-136/99, Cine Comedy, EU:T:2001:31);
- 'Teleaid' for electronic devices for transferring speech and data, repair services for automobiles and vehicle repair, operation of a communications network, towing and rescue services and computing services for determining vehicle location (20/03/2002, T-355/00, Tele Aid, EU:T:2002:79);
- 'Quick-gripp' for hand tools, clamps and parts for tools and clamps (27/05/2004, T-61/03, Quick-Grip, EU:T:2004:161);
- 'Twist and Pour' for handheld plastic containers sold as an integral part of a liquid paint containing, storage and pouring device (12/06/2007, T-190/05, Twist & Pour, EU:T:2007:171);
- 'CLEARWIFI' for telecommunications services, namely high-speed access to computer and communication networks (19/11/2009, T-399/08, Clearwifi, EU:T:2009:458);
- 'STEAM GLIDE' for electric irons, electric flat irons, electric irons for ironing clothes, parts and fittings for the aforementioned goods (16/01/2013, T-544/11, Steam Glide, EU:T:2013:20);



- ‘GREENWORLD’ for, inter alia, gas fuels, fuels, electric power, gas for lighting, retail services in the areas of fuels, transmission and transport of electrical energy, heat, gas or water (27/02/2015, T-106/14, Greenworld, EU:T:2015:123);
- ‘Greenline’ for goods in Classes 1, 5, 6, 8, 20 and 21 that can conform to a philosophy of care for the environment (30/03/2007, R 125/2007-2, GREENLINE, § 15-22);
- ‘ecoDOOR’ for products on which doors have a significant impact, such as dishwashers, washing machines, vending machines, apparatus for cooking (10/07/2014, C-126/13 P, EcoDoor, EU:C:2014:2065).

In the same way, combinations of the **prefix ‘EURO’** with purely descriptive terms must be refused where the ‘EURO’ element reinforces the descriptiveness of the sign as a whole or where there is a reasonable connection between that term and the goods or services concerned. This is in line with the judgment of 07/06/2001, T-359/99, EuroHealth, EU:T:2001:151.

The following examples have been **accepted for** registration:

- GREENSEA for goods and services in Classes 1, 3, 5 and 42;
- MADRIDEXPORTA for Classes 16, 35, 36, 38, 39, 41 and 42 (16/09/2009, T-180/07, Madridexporta, EU:T:2009:334);
- DELI FRIENDS for Classes 29, 30 and 35.

#### Combinations not following grammatical rules

A combination of words can be considered a descriptive indication even though it does not follow the usual grammatical rules. If, however, the combination does amount to more than the mere sum of its parts, it may be acceptable (17/10/2007, T-105/06, WinDVD Creator, EU:T:2007:309, § 34).

- ‘HIPERDRIVE’ is considered descriptive of the intended purpose of setting devices for tools, despite the misspelling of the adjective ‘hyper’ as ‘hiper’ (22/05/2014, T-95/13, Hiperdrive, EU:T:2014:270, § 33-42).
- ‘CARBON GREEN’ is descriptive for reclaimed rubber, namely, recycled carbonaceous materials, namely plastic, elastomeric, or rubber filled materials obtained from pyrolysed tire char and plastic, elastomeric, or rubber compounds formulated using such filler material, even though adjectives precede nouns in English (11/04/2013, T-294/10, Carbon green, EU:T:2013:165).

Furthermore, in the world of advertising, definite articles and pronouns (the, it, etc.), conjunctions (or, and, etc.) or prepositions (of, for, etc.) are frequently omitted. This means that a lack of these grammatical elements will sometimes not be sufficient to make the mark distinctive.

#### Combinations of adjectives + nouns or verbs

For combinations consisting of **nouns and adjectives**, it should be assessed whether the meaning of the combination changes if its elements are inverted. For example, ‘Vacations direct’ (not registrable, 23/01/2001, R 33/2000-3) is tantamount to ‘direct vacations’, whereas ‘BestPartner’, is not the same thing as ‘PartnerBest’.

The same reasoning applies to words consisting of the **combination of an adjective and a verb**. Therefore, the word 'ULTRAPROTECT' must be considered descriptive for sterilising and sanitary preparations, even though it consists of the combination (grammatically incorrect) of an adjective (ULTRA) with a verb (PROTECT), since its meaning remains clearly understandable (03/06/2013, R 1595/2012-1, ULTRAPROTECT; 06/03/2012, T-565/10, Highprotect, EU:T:2012:107).

#### Combinations of words in different languages

Combinations made up of words from different languages may still be liable to objection if the relevant consumers will understand the descriptive meaning of all the elements without further effort. This may be the case, in particular, when the sign contains basic terms in a language that will be understood easily by the speakers of another language, or if the terms are similar in both languages. For instance, if a mark is composed of one basic descriptive term belonging to language 'A' and another descriptive word in language 'B', the sign as a whole will remain descriptive when it is assumed that the speakers of language 'B' will be able to grasp the meaning of the first term.

Applications that consist of descriptive words or expressions repeated in various languages are a special case in the sense that they are mere translations of each other. These trade marks should be considered descriptive if the relevant consumer will grasp that each of the words or expressions is in fact merely the translation of a descriptive meaning, for example, because the proximity of the terms contained in the mark to each other will lead the consumer to understand that they all have the same descriptive meaning in different languages. For instance:

- EUTM No 3 141 017 'Le salon virtuel de l'industrie — Industry virtual exhibition — Die virtuelle Industriemesse — Il salon virtuale dell'industria — El salon virtual de la industria' for services in Classes 35, 38 and 42.

The following examples have been **refused** registration:

- EUTM No 12 596 169 'BABYPATAUGEOIRE' for Classes 20 and 42 related to chairs and design of chairs for babies. The sign is composed of an EN and a FR term that will be immediately understood by the French-speaking part of the public (the term 'baby' will be understood by the French-speaking part of the public);
- 'EURO AUTOMATIC PAIEMENT', for Classes 9 and 36 (05/09/2012, T-497/11, Euro automatic paiement, EU:T:2012:402, combination of English and French terms).

## 2.3 Misspellings and omissions

A misspelling does not necessarily change the descriptive character of a sign. First of all, words may be misspelt due to influences from another language or the spelling of a word in non-EU areas, such as American English, in slang or to make the word more fashionable. Examples of signs that have been refused:

- 'Xtra' (27/05/1998, R 20/1997-1);
- 'Xpert' (27/07/1999, R 230/1998-3);

- 'Easi-Cash' (20/11/1998, R 96/1998-1);
- 'Lite' (27/02/2002, T-79/00, Lite, EU:T:2002:42);
- 'Rely-able' (30/04/2013, T-640/11, Rely-able, EU:T:2013:225);
- 'FRESHHH' (26/11/2008, T-147/06, Freshhh, EU:T:2008:528).

Furthermore, consumers will, without further mental steps, understand the '@' as the letter 'a' or the word 'at' and the '€' as the letter 'e'. Consumers will replace specific numerals by words, for example, '2' as 'to' or '4' as 'for'.

However, if the misspelling is fanciful and/or striking or changes the meaning of the word (accepted: 'D'LICIOUS', EUTM No 13 729 348 (instead of 'delicious'), 'FANTASTICK', EUTM No 13 820 378 (instead of 'fantastic')), the sign is acceptable.

As a rule, misspellings endow the sign with a sufficient degree of distinctive character when:

- they are striking, surprising, unusual, arbitrary and/or;
- they are capable of changing the meaning of the word element or require some mental effort from the consumer in order to make an immediate and direct link with the term that they supposedly refer to.

The following marks were refused.

Sign	Reasoning	Case No
<b>ACTIVMOTION SENSOR</b>  EUTM No 10 282 614 for goods in Class 7 (swimming pool and spa cleaning equipment, namely, sweepers, vacuums, and parts therefor)	The mark merely consists of 'ACTIV' (an obvious misspelling of the word 'ACTIVE'), 'MOTION' and 'SENSOR'. Combined, the words form a perfectly comprehensible and plainly descriptive combination, and the mark was thus refused.	06/08/2012, R 716/2012-4, ACTIVMOTION SENSOR, § 11
<b>XTRAORDINARIO</b>  International registration designating the EU No 930 778, for goods in Class 33 ( <i>tequila</i> )	The above term is a non-existent word but closely resembles the Spanish adjective 'extraordinario'. Spanish and Portuguese consumers will perceive the sign as a misspelling of a word meaning 'remarkable', 'special', 'outstanding', 'superb' or 'wonderful', and as such, attribute a descriptive meaning to the sign.	04/07/2008, R 169/2008-1, Xtraordinario, § 11-12

However, the following marks were **accepted**.

Sign	Reasoning	Case No
<b>LINQ</b> EUTM No 1 419 415 covering goods and services in Classes 9 and 38	This word is an invented word, not existing in any known dictionary, and it was not shown that this word is a common misspelling used in the trade circles of interest to the appellant. Additionally, because the word is short, the ending letter 'Q' will be noticed as a peculiar element, and thus the fanciful spelling is obvious	04/02/2002, R 9/2001-1, LINQ, § 13
<b>LIQID</b> EUTM No 5 330 832 initially covering goods in Classes 3, 5 and 32	In this word mark, the combination 'QI' is highly uncommon in the English language, as the letter 'Q' is normally followed by a 'U'. The striking misspelling of the word 'liquid' would allow even a consumer in a hurry to notice the peculiarity of the word 'LIQID'. Furthermore, the spelling would not only have an effect on the visual impression produced by the sign, but also the aural impression, as the sign applied for will be pronounced differently from the word 'liquid'.	22/02/2008, R 1769/2007-2, LIQID, § 25

## 2.4 Abbreviations and acronyms

Abbreviations of descriptive terms are in themselves descriptive if they are used in that way, and the relevant public, whether general or specialised, recognises them as being identical to the full descriptive meaning. The mere fact that an abbreviation is derived from a descriptive term is not sufficient (13/06/2014, T-352/12, Flexi, EU:T:2014:519).

The following signs were refused because the descriptive meaning for the relevant public could clearly be shown:

- SnTEM (12/01/2005, T-367/02 – T-369/02, SnTEM, SnPUR & SnMIX, EU:T:2005:3);
- TDI 03/12/2003, T-16/02, TDI, EU:T:2003:327 (appeal C-82/04 P was settled);
- LIMO (20/07/2004, T-311/02, Limo, EU:T:2004:245);

- BioID (05/12/2002, T-91/01, BioID, EU:T:2002:300 (appeal C-37/03 P set aside the Court's judgment and dismissed the decision of the second BoA)).

Note that use of internet databases such as 'AcronymFinder.com' as a reference base should be made with due consideration. Use of technical reference books or scientific literature is preferable, for example, in the field of computing. Alternatively, use of the abbreviation by a number of traders in the appropriate field on the internet is sufficient to substantiate actual use of the abbreviation.

Signs consisting of an independently non-descriptive acronym that precedes or follows a descriptive word combination should be objected to as descriptive if it is perceived by the relevant public as merely a word combined with an abbreviation of that word combination, for example 'Multi Markets Fund MMF'. This is because the acronym and word combination together are intended to clarify each other and to draw attention to the fact that they are linked (15/03/2012, C-90/11 & C-91/11, Natur-Aktien-Index / Multi Markets Fund, EU:C:2012:147, § 32, 34, 40). This will be the case even where the acronym does not account for the mere 'accessories' in the word combination, such as articles, prepositions or punctuation marks, such as in the following example: 'The Statistical Analysis Corporation — SAC'.

While the above rule will cover most cases, not all instances of descriptive word combinations juxtaposed with an abbreviation of that word will be considered descriptive as a whole. This will be the case where the relevant public will not immediately perceive the acronym as an abbreviation of the descriptive word combination, but rather as a distinctive element that will make the sign as a whole more than the sum of its individual parts, as demonstrated in the following example:

- 'The Organic Red Tomato Soup Company — ORTS'.

## 2.5 Slogans

A slogan gives rise to an objection under Article 7(1)(c) EUTMR when it immediately conveys the kind, quality, intended purpose or other characteristics of the goods or services.

The criteria established by case-law for the purpose of determining whether a slogan is descriptive or not are identical to those applied in the case of a word mark containing only a single element (06/11/2007, T-28/06, Vom Ursprung her vollkommen, EU:T:2007:330, § 21). It is inappropriate to apply criteria to slogans that are stricter than those applicable to other types of signs, especially considering that the term 'slogan' does not refer to a special subcategory of signs (12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 26, 40).

### Example of a descriptive slogan

- An application in Class 9 (*satellite navigation systems*, etc.) for 'FIND YOUR WAY', (18/07/2007, R 1184/2006-4) was objected to under Article 7(1)(b) and (c) EUTMR. The expression 'FIND YOUR WAY' in relation to the goods applied for in Class 9 is clearly intended to inform the relevant consumer that the appellant's goods help

consumers to identify geographical locations in order to find their way. The message conveyed by the sign applied for directly refers to the fact that consumers will discover the route for travelling from one place to another when using the specified goods.

- ‘BUILT TO RESIST’ could have only one possible meaning in relation to paper, paper goods and office requisites in Class 16, leather, imitations of leather, travel articles not included in other classes and saddlery in Class 18 and clothing, footwear and headgear in Class 25, namely that the goods are manufactured to last and are, therefore, tough and resistant to wear and tear (16/09/2009, T-80/07, Built to resist, EU:T:2009:332, § 27-28).

#### Example of a non-descriptive slogan

- ‘WET DUST CAN’T FLY’ does not describe the way in which the cleaning preparations, appliances and services in Classes 3, 7 and 37 operate. Cleaning preparations are not designed to moisten dust in order to prevent it from dispersing, but to make the dirt disintegrate and disappear. Cleaning appliances filter the dust through liquids but are not designed to dampen the dust in order to prevent it from flying (22/01/2015, T-133/13, WET DUST CAN’T FLY, EU:T:2015:46, § 23-24, 27).

## 2.6 Geographical terms

### 2.6.1 Preliminary remarks

A geographical term is every existing name of a place, for example a country, region, city, lake or river. This list is not exhaustive. Adjectival forms are not sufficiently different from the original geographical term to cause the relevant public to think of something other than that geographical term (15/10/2003, T-295/01, Oldenburger, EU:T:2003:267, § 39). For example, ‘German’ will still be perceived as referring to Germany, and ‘French’ will still be perceived as referring to France. Furthermore, outdated terms such as ‘Ceylon’, ‘Bombay’ and ‘Burma’ fall within this scope if they are still commonly used or generally understood by consumers as a designation of origin.

It is in the **public interest** that signs that may serve to designate the geographical origin of goods or services remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer preferences by, for instance, associating the goods or services with a place that may elicit a favourable response (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 47; 25/10/2005, T-379/03, Cloppenburg, EU:T:2005:373, § 33).

This paragraph (2.6) uses the words ‘geographical term’ to refer to **any** geographical indication in an EUTM application, whereas the terms ‘protected geographical indication’ and ‘protected designation or appellation of origin’ are used **only** in the context of specific legislation protecting them. Designations of origin and geographical indications protected under specific EU regulations are dealt with under the section on Article 7(1)(j) EUTMR.

## 2.6.2 Assessment of geographical terms

The registration of geographical names as trade marks is not possible where such a geographical name is either **already famous**, or is **known for the category of goods concerned**, and is therefore **associated** with those goods or services in the mind of the relevant class of persons, or it is **reasonable to assume** that the term may, in view of the relevant public, designate the geographical origin of the category of goods and/or services concerned (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 48; 25/10/2005, T-379/03, Cloppenburg, EU:T:2005:373, § 34).

As with all other descriptive terms, the test is whether the geographical term **describes objective characteristics of the goods and services**. The assessment must be made with reference to the goods and services for which protection is sought **and** with reference to the perception by the relevant public.

Under this part of the Guidelines, the descriptive character of the geographical term may relate to:

- the place of production of the goods;
- the place where the goods were conceived and designed (06/09/2018, C-488/16 P, NEUSCHWANSTEIN, EU:C:2018:673, § 48);
- the place where the services are rendered;
- the place that influences consumer preferences (e.g. lifestyle) by eliciting a favourable response (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 47; 25/10/2005, T-379/03, Cloppenburg, EU:T:2005:373, § 33).

The use of geographical names as trade marks is also dealt with in other parts of the Guidelines. For example, where such a sign indicates the subject matter of the goods and/or services, the relevant part of the Guidelines applies (i.e. paragraph 2.7 below on subject matter).

The following two-step assessment must be carried out when assessing geographical names as trade marks.

**First step:** term is understood by the relevant public as a geographical name.

The **first step** in assessing a geographical term is to determine whether it is understood as such by the relevant public. Article 7(1)(c) EUTMR does not in principle preclude the registration of geographical names that are unknown to the relevant public — or at least unknown as the designation of a geographical location (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 49; T-379/03, Cloppenburg, EU:T:2005:373, § 36). Whether or not this is the case will be determined by taking as a basis a reasonably well-informed consumer who has sufficient common knowledge but is not a specialist in geography. For an objection to be raised, the Office must prove that the geographical term is known by the relevant public as designating a place (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 51).

**Second step:** term either (a) designates a place associated with the goods and services or (b) may be reasonably assumed to designate the geographical origin of the goods and services.

The second step is to determine whether the geographical term applied for designates a place that **is currently** associated with the claimed goods or services in the mind of the relevant public or whether **it is reasonable to assume** that it will be associated with those goods or services in the future (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 31), or whether such a name may, in the mind of the relevant public, designate the geographical origin of that category of goods or services (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 48; T-379/03, Cloppenburg, EU:T:2005:373, § 34).

In establishing whether such an association exists, the Court has clarified that the following factors should be taken into account (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 32, 37; T-379/03, Cloppenburg, EU:T:2005:373, § 38), namely the degree of familiarity with:

- the geographical term;
- the characteristics of the place designated by the term; and
- the category of goods or services.

1. Places **currently associated** with the claimed goods or services

Geographical names that designate specified geographical locations that are already famous or are known for the category of goods or services concerned, and that are therefore associated with that category in the mind of the relevant class of persons, may not be registered as trade marks (15/10/2003, T-295/01, Oldenburger, EU:T:2003:267, § 31).

For example, 'Milano' should be refused for clothing, 'Frankfurt' for financial services, 'Islas Canarias' for sightseeing, tour guide and excursion services and 'Switzerland' for banking services, cosmetic products, chocolate and watches.

Sign	Reasoning	Case No
ST ANDREWS Classes 25, 28, 35 and 41	The Court considered that the services in Class 41 could all directly relate to golf sports, and in particular to the organisation and planning of golf events, competitions, conferences, congresses, seminars, exhibitions and training, including club services and publications related to the aforesaid, that is to the particular field for which the town of St Andrews was well known. (para. 35).	20/11/2018, T—790/17, ST ANDREWS, EU:T:2018:811



<p>KARELIA</p> <p>Classes 4 and 10</p>	<p>Karelia is a region situated in Finland with historic ties to Sweden.</p> <p>In order to come to the finding that the mark applied for will be perceived by the relevant public as describing the geographical origin of the relevant goods, the Board of Appeal took into account the considerable reputation of the Karelia region for the production of biomass and biofuels and the awareness that the public has of the importance of that industry and of bioenergy production in Finland and, more specifically, in the Karelia region. Consequently, the Board of Appeal was entitled, taking into account the characteristics of that region and the awareness that the relevant public has of it, to find that the word 'karelia' referred to a place that currently has a connection with the relevant goods in the mind of the relevant public, at the very least as regards the Finnish public (para. 31).</p>	<p>06/10/2017,</p> <p>T-878/16, KARELIA,</p> <p>ECLI:EU:T:2017:702</p>
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2. **A reasonable assumption can be made** that a place will be associated with those goods or services in the future or that a name may, in the mind of the relevant public, designate the geographical origin of that category of goods or services. In establishing whether the abovementioned assumption can reasonably be made, the following circumstances should be considered:

- There are some geographical terms, such as the names of regions or countries, that enjoy widespread recognition and fame for the high quality of their goods and/or services. **When a sign consists of such geographical terms**, there is no need for a detailed assessment of the association between **the place and each** (category) of the goods and/or services. Such signs may be refused on the basis of being perceived as a reference to the quality of the goods and/or services, namely that linked with the geographical term (15/12/2011, T-377/09, *Passionately Swiss*, EU:T:2011:753, § 43-45).
- Nature and size of the geographical location in question. There is generally a correlation between geographical size, variety of goods and/or services made available in the place concerned and corresponding knowledge or expectations on the part of consumers. In that regard, it is assumed that the name of a country will, in principle, be associated with the relevant goods and/or services and that the public will accordingly perceive a country name as an indication of the geographical origin of the goods and/or services. This assumption, however, does not automatically rule out the need for an assessment of whether or not the public actually establishes such a descriptive link between the sign and the goods and/or services. Moreover, in line with the nature of the location, its

characteristics should be taken into account. Characteristics such as natural conditions, industries typical to the geographical location or a tradition of manufacturing the goods in question are important factors to be taken into account. The mere fact that some production of the relevant goods or provision of the relevant services is located in the geographical place in question is not per se sufficient to support the abovementioned assumption.

- Market sectors. It must be borne in mind that, in certain market sectors, such as the car or furniture industries, it is common to use place names without a real geographical connotation, for example to designate models or range of products.

It is **not necessary** to establish that the name actually designates the **true** geographical origin of the goods. It is enough to demonstrate that the connection between the name of the place and the goods may enable the relevant public to perceive the contested sign as an indication of the origin of those goods (15/10/2003, T-295/01, Oldenburger, EU:T:2003:267, § 43).

A refusal on the grounds of Article 7(1)(c) EUTMR cannot be based solely on the argument that the goods and/or services can **theoretically** be produced or rendered in the place designated by the geographical term (08/07/2009, T-226/08, Alaska, EU:T:2009:257).

Consequently, if it can be concluded that there is a particular relationship between the geographical place designated by the sign and the goods and/or services for which the protection is sought, the Office will raise an objection.

Sign	Reasoning	Case No
<p>MIAMI</p> <p>Class 25: <i>Track pants, tracksuits</i></p>	<p>Miami is a large city attracting a large number of tourists (para 24).</p> <p>Unlike indications of a country of production, it is unusual to refer to a city as a place of production for clothing. The consumer knows that clothing can be produced in any number of places, including under the same mark, and indeed not necessarily at the place where the trade mark proprietor is based, but mostly in low-wage countries. Where production takes place within the EU, it is the country concerned that is normally indicated and not a particular city. As the contested decision correctly points out, this would only be different in the case of cities that the consumer currently associates with fashion, or at least as locations for fashion design, such as Paris. This too would have to be proven, because fashion design is also generally possible anywhere in the world (para 27).</p> <p>Furthermore, there are no apparent reasons as to why consumers in the EU would associate the city of Miami, of all places, with tracksuits. There is no particular relationship between the geographical or climatic characteristics of the city of Miami or of the US State of Florida (including its beaches) and the nature of tracksuits.</p>	<p>08/06/2018, R 2528/2017-4, MIAMI</p>

The mere fact that a geographical term is used by only one producer is not sufficient to overcome an objection, although it is an important argument to be taken into account in assessing acquired distinctiveness.

The following marks were refused:

Sign	Reasoning	Case No
<p>BRASIL</p> <p>Class 32: <i>Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages.</i></p> <p>Class 33: <i>Whisky; whisky-based beverages.</i></p>	<p>The Board recognised that the mere existence of whisky production in Brazil was not sufficient in itself to presume that the relevant consumer of whisky will associate the sign with the goods. However, it had to be assessed whether it was reasonable to assume that such an association might be established in the future. The BoA assessed a number of factors, including the fact that it is current practice in trade to indicate the geographical origin of whiskies and whisky-based beverages. It concluded that the designation 'Brasil' would be understood as an informative indication for whisky and whisky-based beverages (para. 29).</p>	<p>06/02/2014, R 434/2013-1, Brasil</p>
<p>SUEDTIROL</p> <p>Class 35: <i>Business management; business administration; office functions.</i></p> <p>Class 39: <i>Packaging and storage of goods.</i></p> <p>Class 42: <i>Scientific and technological services and research and design relating thereto; industrial analysis and research; design and development of computer hardware and software; legal services.</i></p>	<p>The Court considered that the Grand Board of Appeal was correct to find that services such as those designated by the contested mark are in principle offered in every region of a certain level of economic importance (para. 41).</p> <p>In addition, it is true that the relevant public might take the contested mark as a reference to a specific quality of the services in question, for example, to the fact that the services are tailored to the particular requirements of businesses operating in that region, characterised by a particular political, administrative and linguistic context. Thus, the use of a geographical indication of origin is likely to convey to those concerned a positive idea or image of a particular quality of those services, within the meaning of the case-law (para. 42).</p>	<p>20/07/2016, T-11/15, SUEDTIROL, EU:T:2016:422</p>
<p>VIRO</p> <p>Classes 9 and 11</p>	<p>The sign 'VIRO' is perceived by the relevant Finnish-speaking consumers as the name of Estonia. It therefore designates, in the perception of the relevant public, a geographical place, which was already known to this public due to its size, economic significance and cultural tradition long before the filing of the mark (para. 24).</p>	<p>28/03/2017, R 2312/2016-1, Viro</p>

Sign	Reasoning	Case No
<p>AUSTRALIA</p> <p>Classes 12, 25, 28, 35 and 37</p>	<p>It is a well-known fact that Australia is a strong economic nation with a thriving economy, which has grown steadily for more than a quarter of a century. Due to its size, its political and economic importance and its popularity as a holiday destination, Australia has a strong reputation in the EU and its Member States (para. 21).</p> <p>First, with regard to all the goods and services for which protection is sought, the contested trade mark is understood as a reference to a positive image, namely a particular attitude towards life. Australia is widely associated with a sense of freedom, wide open spaces and a connection with nature, of which the Australian Outback is representative. Consequently, it is likely that the geographical name 'AUSTRALIA' will influence consumers in the choice of their goods and services, as they associate the goods and services thus marked with this particular attitude to life, which triggers a positive reaction (06/02/2013, R 434/2013-1, BRASIL, § 32). The sign applied for is descriptive, as it indicates that the use or take-up of the goods and services in question contributes to creating a particular attitude to life linked to Australia (para. 26).</p>	<p>06/04/2018, R 2207/2017-2, AUSTRALIA</p>
<p>MONACO</p>	<p>The Court found that the word 'monaco' corresponded to the name of a principality known throughout the world, not least because of the renown of its royal family and its organisation of a Formula 1 Grand Prix and a circus festival. The Court considered that the trade mark MONACO had to be refused for goods and services in Classes 9, 16, 39, 41 and 43 as the word 'monaco' could be used, in trade, to designate origin, geographical destination or the place of supply of services. The trade mark was thus descriptive for the goods and services concerned.</p>	<p>15/01/2015, T-197/13, MONACO, EU:T:2015:16</p>

Sign	Reasoning	Case No
Passionately Swiss	The Court held that BoA did not need to go into a detailed assessment of the association between the sign and each of the goods and services. It based its finding on Switzerland's reputation for quality, exclusiveness and comfort, which can be associated with the services in Classes 35, 41, 43 and 44 and the goods in Class 16 (para. 45).	15/12/2011, T-377/09, Passionately Swiss, EU:T:2011:753
PARIS	BoA established that 'PARIS' is likely to be associated with a certain idea of quality, design, stylishness and even of being avant-garde. This results in a positive feeling, an expectation with regard to the quality of the goods sold and the services provided, when 'PARIS' is put forward as an indication of geographical origin or destination.	26/10/2015, R 3265/2014-4, Paris

The following marks were registered:

- HOLLYWOOD for goods in Class 30 (EUTM No 31 450)
- GREENLAND for fresh fruits and vegetables (30/09/2002, R 691/2000-1, Greenland)
- DENVER for lighting equipment (03/04/2013, R 2607/2011-2, DENVER)
- PORT LOUIS in Classes 18, 24 and 25 (15/10/2008, T-230/06, Port Louis, EU:T:2008:443).

## 2.7 Terms describing subject matter in goods or services

### 2.7.1 General considerations

Where a sign consists exclusively of a word that describes what may be the subject matter or content of the goods or services in question, it should be objected to under Article 7(1)(c) EUTMR. Commonly known terms likely to be linked to a particular thing, product or activity by the relevant public are capable of describing subject matter and should therefore be kept free for other traders (12/06/2007, T-339/05, Lokthread, EU:T:2007:172, § 27).

The essential question is whether the sign applied for **may be used in trade in relation to the goods or services applied for** in a manner that will be undoubtedly perceived by the relevant public as descriptive of the subject matter of those goods or services for which protection is sought, and should therefore be kept free for other traders.

For example, a widely known name such as 'Vivaldi' will immediately create a link to the famous composer, just as the term 'skis' will immediately create a link to the sport

of skiing. While Class 16 (books) is a prime example of a category of goods that contains subject matter or content, an objection made under this section may occur also with respect to other goods and services, such as recorded DVDs or editorial services. With regard to this section, the terms ‘subject matter’ and ‘content’ are used interchangeably.

Names of famous persons (in particular musicians or composers) can indicate the category of goods, if due to widespread use, time lapse, date of death, popularisation, recognition, multiple performers or musical training, the public can understand them as generic. This would be the case, for example, with respect to ‘Vivaldi’, whose music is played by orchestras all over the world and the sign ‘Vivaldi’ will not be understood as an indicator of origin for music.

With regard specifically to famous titles of books, see below 2.7.2 titles of books.

In the event of services, where a sign consists of a term indicating a certain industry, such as ‘CLOTHING’ or ‘CARS’, and it can be reasonably assumed that a services provider (e.g. in the field of advertising or retail services) could specialise to meet the characteristics of that particular industry, an objection to subject matter should be raised.

Objections based on the above:

- will apply only to goods (e.g. *books*) or services (e.g. *education*) that contain subject matter regarding other things, products and/or activities (e.g. a book about history, or an educational course on history);
- when the sign consists exclusively of the word identifying that subject matter (e.g. ‘VEHICLES’ or ‘HISTORY’); and
- will be made on a case-by-case basis by assessing multiple factors, such as the relevant public, the degree of attention or the descriptive character of the term in question, or the market reality (see below).

#### Goods and services that may contain subject matter

For most cases, the goods or services that may consist of or contain subject matter that give rise to an objection are the following.

- Class 9: *software, electronic publications (downloadable)*.
  - Give rise to an objection
- STATISTICAL ANALYSIS for software
- ROCK MUSIC for pre-recorded CDs.
- Class 16: *Printed matter, photographs and teaching materials as long as these include printed matter*.
  - Give rise to an objection
- HISTORY for books
- PARIS for travel guides
- CAR for magazines
- ANIMALS for photographs

— TRANSCENDENTAL MEDITATION for *instructional and teaching material*.

- Class 28: *Board games*

- Give rise to an objection

— ‘Memory’ (14/03/2011, C-369/10 P, Memory, EU:C:2011:148).

- Class 35: *Trade fairs, advertising, retail services, import-export services*.

- Give rise to an objection

— ELECTRONICA for trade fairs related to electronic goods (05/12/2000, T-32/00, Electronica, EU:T:2000:283, § 42-44)

— LIVE CONCERT for advertising services

— CLOTHING for retail services

— PHARMACEUTICALS for import-export services.

- Class 41: *Education, training, entertainment, electronic publications (non-downloadable)*.

- Give rise to an objection

— GERMAN for language courses

— HISTORY for education

— COMEDY for television programmes

— TRANSCENDENTAL MEDITATION for *education services*.

**The above list of Nice classes is not exhaustive, although it will apply to the vast majority of cases.** Consequently, objections based on descriptive subject matter should be raised primarily in the context of the goods and services listed above.

Where the sign applied for is a descriptive term for a particular characteristic of goods or services, a designation of goods or services that excludes that particular characteristic described by the sign applied for will not avoid an objection based on subject matter. This is because it is unacceptable for an applicant to make a claim of goods or services subject to the condition that they do not possess a particular characteristic (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 114-116). The following invented examples illustrate designations of goods or services that will not avoid an objection:

- COMEDY for television broadcasting, except for comedy *programming*
- PENGUINS (in plural!) for books, except for books about *penguins*
- TECHNOLOGY for classes, except for classes about computers and *technology*.

Distinguishable from the examples above are positive claims of goods or services, under which it is impossible for the sign applied for to describe any subject matter or content. For example, the following invented examples would not be liable to objection, at least with regard to signs being descriptive of subject matter:

- COMEDY for television broadcasting of economic news, politics and *technology*
- PENGUIN for comic books with country western, medieval and ancient Roman *themes*
- TECHNOLOGY for classes about creative fiction *writing*.



### 2.7.2 Titles of books

The fact that a sign applied for is the title of a book is not per se an obstacle for registration as a trade mark. However, the Office will refuse the mark when it can be perceived as describing the subject matter of the goods and services and thus has not the capacity to identify the commercial origin of the goods or services.

Trade marks consisting solely of a book title may be descriptive under Article 7(1)(c) EUTMR in relation to goods and services that could be perceived as containing or dealing with the well-known story, a new version of it or a theme linked to the story. 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’. They are no longer linked exclusively with the original book, but have rather become well known, universal and autonomous commonplace expressions to denote a certain type of story or an entire genre.

For example, ‘The Jungle Book’ or ‘Robinson Crusoe’ are book titles originally attributable to a particular literary work and a particular author (Rudyard Kipling; Daniel Defoe). Due to the enormous popularity of the books, and facilitated by the passing of time, their titles have, in the public’s perception, gradually gained a thematic significance, which extends beyond the actual content of the books concerned. They have entered into everyday language as synonyms for a particular type of story or genre (e.g. young humans succeeding on their own in the wilderness; struggle against nature, hardship, privation, loneliness).

While such famous book titles might remain perfectly capable of being distinctive for paint, clothing or pencils, they will become incapable of performing a distinctive role in relation to goods and services that could merely have the general story or genre as their content (e.g. publications, data carriers or cultural events).

The assessment of whether a book title has reached a sufficient degree of recognition depends on a thorough case-by-case analysis, taking account of the particularities of the individual case.

The following, non-exhaustive considerations might assist in evaluating whether the title of a book would be perceived as descriptive of the subject matter of the goods and services and thus not capable of denoting the commercial origin of subject-related goods and services.

- **Adaptations**

A finding of non-distinctiveness 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.

- **Cultural Heritage**

The fact that a book or its story is included in a high-profile encyclopaedia, that it frequently forms part of school/university curricula and that it is subject to ample scientific research and abstract analysis of its main themes might be an indicator that it is considered a ‘Classic’, that is to say, a book that has reached a universal importance

that stretches beyond its actual content and that actively forms part of the cultural DNA of the general public (e.g. ‘The Odyssey’, ‘Cinderella’, ‘Romeo and Juliet’, ‘Don Quixote’).

- **Time**

The more time has passed by since the publication of the original work, the more likely it becomes that a book’s plot, its characters and its title are no longer strictly connected to a particular author or the exact story, but have rather reached a status of autonomy.

Depending on 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).

Examples for book titles considered to be descriptive of the subject matter:

‘**Pinocchio**’ (R 1856/2013-2): partly declared invalid for Classes 9, 16, 28, 41;

‘**The Jungle Book**’ (R 118/2014-1): partly rejected for Classes 9, 16, 41;

‘**Winnetou**’ (R 1297/2016-2): partly declared invalid for Classes 9, 16, 28, 41.

Examples for book titles considered to be sufficiently distinctive:

‘**Die Wanderhure**’ (EUTM No 12 917 621): in Classes 9, 16, 35, 38 and 41;

‘**Partners in crime**’ (EUTM No 13 011 887): in Classes 9, 16 and 41.

## 2.8 Single letters and numerals

### Single letters <sup>(7)</sup>

#### *General considerations*

In its judgment of 09/09/2010, C-265/09 P, α, EU:C:2010:508, the Court stated that when examining absolute grounds for refusal, the Office is required, under Article 95(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 motivated reasoning, why a trade mark consisting of a single letter represented in standard characters is descriptive.

Consequently, when examining single letter trade marks, generic, unsubstantiated arguments such as those relating to the availability of signs, given the limited number of letters, should be avoided. Similarly, it would not be appropriate to base an objection on speculative reasoning as to the different meanings that a sign could possibly have. The Office is obliged to establish, **on the basis of a factual assessment**, why the trade mark applied for would be liable to objection.

It is therefore clear that the examination of single letter trade marks should be thorough and stringent, and that each case calls for a careful examination.

#### *Examples*

<sup>7</sup> This part deals with single letters under Article 7(1)(c) EUTMR. For single letters under Article 7(1)(b) EUTMR, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 3, Non-Distinctive Trade Marks (Article 7(1)(b) EUTMR), paragraph 5.

For instance, in **technical domains** such as those involving computers, machines, motors and tools, it may be that particular letters have a descriptive connotation if they convey sufficiently precise information about the goods and/or services concerned.

The **letter ‘E’** was also considered to be descriptive in respect of *wind power plants and parts thereof, generators, rotor blades for wind power plants, rotors for wind power plants* in Class 7, *control switches for wind power plants, frequency converters, measuring, signalling and checking (supervision) instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity* in Class 9 and *towers for wind power plants* in Class 19, since it may be seen as a reference to energy or electricity (21/05/2008, T-329/06, E, EU:T:2008:161, § 24-31; 08/09/2006, R 394/2006-1, E, § 22-26; 09/02/2015, R 1636/2014-2, E (fig.)).

An objection might also be justified in respect of goods and/or services meant for a wider public. For example, **the letters ‘S’, ‘M’ or ‘L’** for clothing would give rise to an objection as these letters are used to describe a particular size of clothing, namely as abbreviations for ‘Small’, ‘Medium’ or ‘Large’.

However, if it cannot be established that a given single letter is descriptive for the goods and/or services concerned, and provided that the trade mark applied for is not open to objection under another provision of Article 7(1) EUTMR, then the application should be **accepted**.

See the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 3, Non-Distinctive Trade Marks (Article 7(1)(b) EUTMR), paragraph 5.2 for further examples of where an objection under Article 7(1)(b) EUTMR may be raised.

### Numerals

In its judgment of 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, the Court of Justice ruled that signs composed exclusively of numerals with no graphic modifications may be registered as trade marks (paras 29-30).

The Court referred by analogy to its previous judgment of 09/09/2010, C-265/09 P, α, EU:C:2010:508, in respect of single letters (para. 31) and emphasised that trade marks consisting of numerals must be examined with specific reference to the goods and/or services concerned (para. 32).

Therefore, a numeral may be registered as a European Union trade mark only if it is distinctive for the goods and services covered by the application for registration (para. 32) and is not merely descriptive or otherwise non-distinctive for those goods and services.

For example, the Boards of Appeal confirmed the refusal of the trade marks ‘15’ (12/05/2009, R 72/2009-2, 15) and ‘60’ (23/09/2015, R 553/2015-4, 60) applied for in respect of *‘clothing, footwear, headgear’* in Class 25. The board considered in the first case that that the numeral ‘15’ is linked directly and specifically to these goods, as it contains obvious and direct information regarding their size (paras 15-22). In the second decision, it held that the indication of size 60, whether it exists or might exist,

would naturally be understood and connected to measurement (size) by the relevant public (para. 19).

The Board also confirmed the refusal of the sign '15' for 'beers' in Class 32, as practical experience of the marketing of the relevant goods — relied upon by the Office — showed that a number of very strong beers with an alcohol content of 15 % volume exist on the EU market (12/05/2009, R 72/2009-2, 15, § 15-22).

It is well known that numerals are often used to convey relevant information as to the goods and/or services concerned. For example, in the following scenarios an objection would apply on the ground that the sign applied for is descriptive since it refers to:

- the **date** of production of goods/provision of services, when this factor is relevant in respect of the goods/services concerned. For instance, 1996 or 2000 for *wines* would give rise to an objection, since the age of the wine is a very relevant factor when it comes to the purchasing choice; 2020 would give rise to an objection also for *events* as it could be considered the year of an event;
- **size**: in addition to the previous examples 15 and 60 for clothing, 1 600 for cars, 185/65 for tyres, 10 for women's clothing in the UK, 32 for women's clothing in France;
- **quantity**: 200 for cigarettes;
- **telephone codes**: 0800 or 0500 in the UK, 800 in Italy, 902 in Spain, etc.;
- the **time** of provision of services: 24/7;
- the **power** of goods: 115 for engines or cars;
- **alcoholic content**: 4.5 for lager, 13 for wines;
- the **number of pieces**: 1 000 for puzzles.

However, where the numeral does not appear to have any possible meaning for the goods and services, it is acceptable, that is to say, '77' for *financial services* or '333' for *clothing*.

## 2.9 Names of colours

Name of colours can be **single colour** names (e.g. red, green), **compound colour** names (e.g. navy blue, blood red) or more **unusual** colour names. Among unusual colour names, there are names of objects, gemstones, flowers or similar elements (e.g. magnolia, emerald, amethyst, alabaster) and combination of colour associated with another noun (e.g. flamenco red, crystal pink, vintage rose, Bermuda blue).

A sign consisting exclusively of the name of a colour must be objected to under Article 7(1)(c) EUTMR when the application claims any **goods and services for which the colour can reasonably be perceived by the public as a description of one of its characteristics**.

For example, the name of the colour BLUE in relation to cheese describes a specific kind of cheese; the colour GREEN describes a specific kind of tea or environmentally friendly services. The name of the colour BROWN in relation to sugar describes the colour and kind of the sugar. This rule applies mainly to common colours, for example, primary colours or SILVER and GOLD.

The following guidelines should generally be applied:

- **Where colour is a typical feature of the goods and relevant for consumer choice**, such as clothing and motor cars, colour names such as CYAN, EMERALD or APRICOT, which, despite having alternative meanings, are recognised as having a strong connotation with definite colours, **should be objected to**.
- Where the name of a colour is **combined with a reference to a possible texture, sheen or finish**: SMOKY GRAY, SANDY BROWN, METALLIC BLUE, MATT GOLD, BRILLIANT BRONZE, etc., and the combination represents a typical feature of the goods and is relevant for the consumer's choice, the sign will be objected to inasmuch as it describes the colour and finish/sheen/texture of the respective goods.
- When the goods for which protection is sought **concern colourants such as paint, ink, dyes or cosmetics** (e.g. lipsticks or make-up), the name of a colour may describe the actual colour of the goods, and signs consisting exclusively of a colour should be objected to under Article 7(1)(c) EUTMR. In these cases, names of colours would not be seen as trade marks but merely as indications of the principal characteristic of the goods.
- **Where the colour does not have a sufficiently strong colour connotation to overwhelm the other non-colour, the meaning should generally not be objected to** if it is unlikely to be perceived as having a colour meaning with respect to the goods or services for which protection is sought (12/12/2013, 7 950 C, Lapislazuli). For instance, words such as FLAMINGO.

Colours in combination with other words may be registrable if the sign as a whole is distinctive: ICE COFFEE, VANILLA ICE and MISTY BLUE.

Dictionary words that are descriptive of colours but are obscure and unlikely to be used by others can be accepted: LUNA (alchemists' name for silver) and CARNELIAN (an alternative name for CORNELIAN, a red gemstone that is less well known).

#### Examples

##### *Rejected trade marks*

Sign	Reasoning	Case No
CYAN	'CYAN' has the sort of direct and concrete link with the goods in question by which the relevant public can immediately and without further reflection perceive the mark as a description of a characteristic of the goods (Classes 12, 14, 16, 18 and 25)	26/05/2016, R 2588/2015-5
CERAMIC WHITE	Class 9 products (smartphones, PDAs, TV receivers, etc.)	EUTM No 14 497 986

*Accepted trade marks*

Sign	Reasoning	Case No
OPAL BLUE	for software in Class 9. There is no link between an opal-blue colour and the computer application software applied for. Computer software is a programme used to operate computers, which by its very nature is colourless. There is also no indication that colours are used to indicate specific types or versions or any other features of computer software and nothing was brought forward by the examiner in this respect.	31/08/2016, R 664/2016-4

## 2.10 Names of banks, newspapers/magazines and airports

In some fields, such as banks, newspapers, magazines and airports, consumers are accustomed to recognising descriptive combinations of terms as badges of origin.

This is due to the market reality whereby a sign composed of different elements has the capacity to **identify a specific entity**. It is the case, for example, of a sign that describes an entity that is the only one to offer the respective goods and/or services.

The following marks were **accepted**.

Sign	EUTM No
BANK OF ENGLAND Classes 6,8,9,14,16,18,21,28,30,35,36,41,42,45	11 157 641

Sign	EUTM No
DIARIO DE LAS PROVINCIAS DE VALENCIA Classes 16, 35	54 619

Sign	EUTM No
AEROPORT TOULOUSE-BLAGNAC Classes 16,35,36,37,38,39,41,42,43,45	13 952 346

Nevertheless, descriptive combinations give rise to an objection when they do not create, at least prima facie, the impression of a clearly identifiable entity. It is the case when the sign refers to a general category and not a specific unique entity.

The following marks were refused.

Sign	Reasoning	EUTM No
CHARITY BANK Classes 9, 35 and 36	The sign as a whole merely indicates that the goods and services are provided by a bank that focuses on charity more than other banks that may also support charity activities.	4 454 872
European PrivateTrust BANK Class 36	The expression taken as a whole immediately informs consumers without further reflection that the services applied for are insurances, financial and monetary services, etc., that are rendered by a European non-public trust bank that is organised to perform the fiduciary of trusts and agencies.	11 585 908

Sign	Reasoning	EUTM No
JOURNAL OF OPTOMETRY Classes 16 and 41	The relevant consumer will not see the sign as something unusual but rather as a meaningful expression: a publication related to the world of optometry with its technological projection and the knowledge of the mentioned science.	6 646 996

Sign	Reasoning	EUTM No
HEALTH JOURNAL Classes 16 and 38	The consumers will see the sign as an indication of the good itself.	1 524 396

Sign	Reasoning	EUTM No
<b>ALICANTE-AIRPORT</b> Class 35	The expression is not the official denomination of the main airport next to the city of Alicante. The expression 'alicante-airport' immediately informs consumers without further reflection that the services applied for are from an airport in the city or province of Alicante. Therefore, the mark conveys obvious and direct information regarding the geographical origin of rendering of the services in question.	15 140 676

## 2.11 Names of hotels

In the hotel sector, hotel names are often the combination of the word 'HOTEL' together with a geographical term (i.e. the name of an island, a city, a country etc.). They usually indicate specific establishments that **do not have any link with the geographical term they refer to**, since they are not situated in that specific location. Consequently, due to these trade habits, consumers would not perceive expressions such as 'HOTEL BALI', 'HOTEL BENIDORM' or 'HOTEL INGLATERRA' as descriptive indications (describing that the services are provided by a hotel that is situated in that specific location) but rather as badges of origin.

Indeed, such expressions are not equivalent to the grammatically correct ones 'HOTEL IN BALI', 'HOTEL DE BENIDORM' or 'HOTEL EN INGLATERRA', which clearly give rise to an objection. This is even truer in cases where the hotel name consists of the names of two different cities, (or of two geographical terms in general), for example 'HOTEL LONDRES SAN SEBASTIAN'. Indeed, in this case the presence of the wording SAN SEBASTIAN (a city in the north of Spain) clearly indicates that 'HOTEL LONDRES' must be regarded as a fanciful expression. Therefore, no objection should be raised.



Nevertheless, in those **cases where the geographical term precedes the word ‘HOTEL’**, the situation may change according to the different languages. For example, in English the wording ‘BALI HOTEL’, would be perceived as an expression merely indicating any hotel located in the island of Bali, which clearly gives rise to an objection. Consequently, each case should be assessed on its own merits. Finally, descriptive combinations such as ‘LEADING HOTELS’ give rise to an objection since they do not create, at least *prima facie*, the impression of a clearly identifiable entity.

## 2.12 Combinations of names of countries/cities with a number indicating a year

Marks consisting of the combination of the name of a country/city with a number indicating a year must be refused under Article 7(1)(b) and (c) EUTMR in the following cases.

Firstly, where the combination is perceived by the relevant consumers as **describing an event** happening that specific year in the designated geographic location, it must be **refused for all the goods and services** for which protection is sought, since it is considered that the descriptive link applies to any good or service.

As an **example**, the mark ‘GERMANY 2006’ was found to be immediately perceived as a reference to an event that would take place in 2006. It has been considered as a descriptive indication for a wide list of goods and services, ranging from *unexposed films* in Class 1 to *vehicle maintenance* in Class 37. In particular, the decision of 30/06/2008 in case R 1467/2005-1 stated that this mark:

- is descriptive of the kind and content of those services ‘of actually preparing, organising and promoting an event in Germany in 2006’ (para. 29, referring to the organisation of sporting events related to or associated with football championships, etc.);
- is descriptive of ‘the purpose and thereby in part the level of quality of goods or services, during such competitions in Germany in the year 2006, as being suitable for competitions of the highest standard or that it has been successfully used in the context of such competitions’ (para. 30, referring to medical instruments, soccer balls, etc.);
- qualifies the goods as souvenir articles (para. 31, referring to goods such as stickers, confetti, pyjamas, etc.).

With regard to **souvenir articles**, the Board underlined that ‘merchandising and co-branding is not limited to ‘classic’ souvenir products. It is public knowledge that there is a tendency to try to find new markets by combining various goods with the brand of some other unrelated popular event or names’ (30/06/2008, R 1467/2005-1, GERMANY 2006, § 34, referring to goods such as eyeglasses, televisions, toilet paper, etc., all related to or associated with football championships). In line with the above, the Boards confirmed the refusal of the trade mark ‘TARRAGONA 2017’ for various commemorative articles, such as goods in Class 6 (*bronzes (works of art), busts of common metal, crates of metal, bells, placards of metal*, etc.) or goods in Class 14

(*jewellery ornaments, decorative pins of precious metal, amulets (jewellery), rings (jewellery), bracelets and wrist bands, etc.*) (28/10/2016, R 2318/2015-5, TARRAGONA 2017, § 32).

Secondly, where the combination is not, or not any more, perceived by the relevant consumers as describing an event that happens, or took place, in that specific year in the designated geographic location, a sign combining the name of a country or city with a number indicating a year might still be perceived by the relevant public as an indication of another characteristic, such as the place and time of production or destination. The assessment has to be made in accordance with the criteria explained under paragraph 2.6 above.

## 2.13 INN codes

**International non-proprietary names (INNs)** are assigned to pharmaceutical substances by the World Health Organisation (WHO), so that each substance can be recognised by a unique name. These names are needed for the clear identification, safe prescription and dispensing of medicines, and for communication and exchange of information among health professionals. INNs can be used freely because they are in the public domain. Examples of INNs are alfacalcido, calcifediol, calcipotriol.

**Stems** define the pharmacologically related group to which the INN belongs. INN stems serve to indicate the mode of action of groups of drugs. These stems and their definitions have been selected by WHO experts and are used when selecting new international non-proprietary names. An example of a stem is 'calci'.

The criteria for assessing the descriptiveness of a trade mark for pharmaceuticals are no different from those applicable to other categories of trade marks. The provisions of trade mark law apply to pharmaceuticals in the same way as to other categories of goods. The European Medicines Agency (EMA) assesses the single name under which a medicinal product will be marketed as part of its marketing authorisation for the European Union. The EMA's assessment is based on public health concerns and takes into account the WHO World Health Assembly resolution (WHA46.19) on protection of INNs/INN stems to prevent any potential risk of confusion. The Office's assessment of the registrability of pharmaceutical trade marks, however, has no specific legal basis for taking such health-related concerns into consideration (by analogy, 05/04/2006, T-202/04, Echinaid, EU:T:2006:106, § 31-32).

Considering the descriptive nature of INN codes and stems, an objection should be raised for Class 5 in the following scenarios:

- where the EUTM is an INN (the general rules on misspellings also apply, see paragraph 2.3 above); or
- where an INN appears within an EUTM and the other elements of the EUTM are descriptive/non-distinctive too (for instance BIO, PHARMA, CARDIO, MED, DERMA); or
- where the EUTM consists **only** of a stem.

A list of INN codes can be accessed after online registration on MedNet (<https://mednet-communities.net>). A list of common stems is available at the following link: [http://www.who.int/medicines/services/inn/StemBook\\_2011\\_Final.pdf](http://www.who.int/medicines/services/inn/StemBook_2011_Final.pdf).



Office practice is to accept figurative trade marks containing INN codes or stems, applying the same criteria as to any other figurative trade mark containing descriptive word elements (i.e. whether the stylisation and/or the graphical features of a sign are sufficient for it to act as a trade mark).

An objection may also be based on Article 7(1)(g) EUTMR in the unlikely scenario that the list of goods in Class 5 refers to a different kind of drug from that covered by the INN. Where the list in Class 5 includes *pharmaceuticals*, the Office assumes good faith and no objection under Article 7(1)(g) EUTMR will be raised.

### 3 Figurative Marks

By definition (Article 3(3)(b) EUTMR), marks where **non-standard characters, stylisation or layout**, or a graphic feature or a colour is used are figurative marks. Signs represented in alphabets other than Latin, Greek or Cyrillic are to be considered figurative trade marks. However, this does not mean that the semantic content of these signs will not be taken into consideration for the purpose of the application of Article 7(1)(c) EUTMR.

Where a figurative mark consists exclusively of a basic natural form that is not significantly different from a true-to-life portrayal that serves to indicate the kind, intended purpose or other characteristic of the goods or services, it should be objected to under Article 7(1)(c) EUTMR as descriptive of a characteristic of the goods or services in question.

Sign	Case No
	08/07/2010, T-385/08, Hund, EU:T:2010:295
	08/07/2010, T-386/08, Pferd, EU:T:2010:296


In these cases the Court held that for goods in Classes 18 and 31, the depiction of a dog or horse, respectively, serves to indicate the type of animal for which the goods are intended.

In the first case, the Court noted that the goods in Class 18 were specially produced for dogs, such as dog leads, dog collars and other dog accessories including bags. In the

field of animal accessories, it is common practice for true-to-life or stylised but realistic portrayals of animals to be used for indicating the type of animal concerned. Therefore, for the goods in Class 18, the relevant public will immediately perceive the image's message that those goods are for dogs, without any further mental steps. The portrayal of a dog, therefore, indicates an essential characteristic of the goods concerned. The sign applied for is, therefore, descriptive (paras 25-28).

The same applies to goods in Class 31. As foodstuffs for domestic animals include dog food, the mark applied for is a descriptive indication for the goods at issue that will be immediately understood by the relevant public (para. 29).

In the second case, the Court held that for *clothing, headgear and belts* in Class 25, the portrayal of a horse was descriptive of the kind or intended purpose of the goods, namely that they are particularly developed or suitable for horse riding. As the relevant public would make a direct link between a horse and horse riding, the Court maintained that there was an immediate and concrete link between the portrayal of a horse and the goods concerned (paras 35-38).

Sign	Case No
 <p>Classes 5, 25 and 35</p>	<p>29/09/2016, T-335/15,          DEVICE OF A BODY BUILDER (fig.),          EU:T:2016:579</p>

The Court noted that the image in question represents in a fairly realistic way the silhouette of a bodybuilder in a typical pose that highlights the body's muscles and, in particular, those of the arms. No detail or characteristic of that image goes beyond the standard representation of a bodybuilder. The mark applied for shows a sufficiently direct and specific relationship to the goods and services covered by the application for registration, enabling the relevant public to perceive immediately the nature and intended purpose of those goods and services.

By way of example, the sign below was held to be sufficiently highly stylised to significantly differ from a true-to-life portrayal serving to indicate the kind or intended purpose of the goods or services, and, thus, was registered.

Sign	EUTM No	Goods and services
------	---------	--------------------

	844	Classes 1, 3, 5, 6, 7, 8, 9, 11, 16, 17, 18, 19, 20, 21, 22, 26, 28, 31, 41, 42
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## 4 Figurative Threshold

### 4.1 Preliminary remarks

Terms or signs that are non-distinctive, descriptive or generic may be brought out of the scope of a refusal based on Article 7(1)(b), (c) or (d) EUTMR if combined with other elements that make the sign as a whole distinctive. In other words, refusals based on Article 7(1)(b), (c) and/or (d) EUTMR may not apply to signs consisting of a non-distinctive, descriptive or generic element combined with other elements that take the sign as a whole beyond a minimum level of distinctiveness.

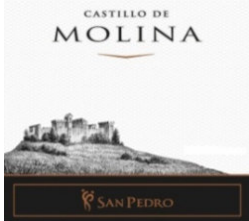
In practice this means that one of the main questions that the Office must answer is whether the mark is figurative enough to reach the minimum degree of distinctive character that is required for registration.

Finally, the fact that a sign contains figurative elements does not prevent it from still being misleading or contrary to public order or accepted principles of morality or from falling under other grounds of refusal, such as those set forth by Article 7(1)(h), (i), (j) (k), (l) and (m) EUTMR.

Sign	EUTM No	Goods and services
	8 384 653	Classes 33, 35 and 39

(09/03/2012, T-417/10, ¡Que buenu ye! Hijoputa, EU:T:2012:120)

The application was rejected since 'Hijoputa' is an offensive and vulgar word in Spanish. The application was considered to be against accepted principles of morality (irrespective of the figurative elements of the sign) protected under Article 7(1)(f) EUTMR.

Sign	EUTM No	Goods and services
	11 402 781	Class 33
<p>The application was refused on the basis of Article 7(1)(j) EUTMR, because it contains the protected geographical indication for wines 'MOLINA' (protected under the Agreement establishing an association between the European Union and its Member States, of the one part, and the Republic of Chile, of the other part). The distinctive figurative elements of the sign are irrelevant.</p>		

## 4.2 Assessment of the figurative threshold

The presence of figurative elements may give distinctive character to a sign consisting of a descriptive and/or non-distinctive word element so as to render it eligible for registration as an EUTM. Therefore, the question to be considered is whether the stylisation and/or the graphical features of a sign are sufficiently distinctive for the sign to act as a badge of origin.

In the framework of the European Union Intellectual Property Network (EUIPN), the Office and a number of trade mark offices in the European Union have agreed on a Common Practice in relation to when a figurative mark, containing purely descriptive/non-distinctive words, should pass the absolute grounds examination because the figurative element renders sufficient distinctive character (also referred to as Convergence Project 3 or CP3 Practice) <sup>(8)</sup>.

The Common Practice establishes criteria to determine if the threshold of distinctiveness is met due to the figurative features in the mark. They consider:

- **word elements** such as typeface and font, combination with colour, punctuation marks and/or other symbols, or how the words are placed (sideways, upside-down, etc.);

<sup>8</sup> See Common Communication on the Common Practice of Distinctiveness — Figurative Marks containing descriptive/non-distinctive words, available at: <https://www.tmdn.org/network/documents/10181/278891cf-6e4a-41ad-b8d8-1e0795c47cb1>

- **figurative elements** such as the use of simple geometric shapes, the position and proportion (size) of the figurative element(s) in relation to the word elements, or whether the figurative element is a representation of, or has direct link with, the goods and/or services, and whether the figurative element is commonly used in trade for the goods and/or services applied for;
- **both word and figurative elements** and how combinations of the criteria affect distinctiveness.

These criteria are explained in the following paragraphs.

Moreover, the Common Practice includes a number of examples. Some of them are included in the paragraphs below (marked as ‘CP3 example(s)’). The signs containing ‘Flavour and aroma’ seek protection for *coffee* in Class 30, the signs containing ‘Fresh sardine’ and ‘Sardines’ seek protection for *sardines* in Class 29, the sign containing ‘DIY’ seeks protection for *kits of parts for assembly into furniture* in Class 20, the signs containing ‘Pest control services’ seek protection for *pest control services* in Class 37, and the sign containing ‘Legal advice services’ seeks protection for *legal services* in Class 45.

In addition to the CP3 examples agreed by the Office and a number of trade mark offices in the European Union, the following paragraphs also include examples of EUTMs examined by the Office.

#### 4.2.1 Word elements in a mark

##### Typeface and font

In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces — with or without font effects (bold, italics) — are not registrable.

##### *Non-distinctive examples*

Sign	Example
<b>Fresh Sardine</b>	CP3 example
<i>Fresh Sardine</i>	CP3 example
FrEsh SaRdine	CP3 example
<i>Flavour and aroma</i>	CP3 example
Flavour and aroma	CP3 example
<i>Flavour and aroma</i>	CP3 example

Sign	Case No	Goods and services
Foamplus	07/05/2008 R 655/2007-1	Classes 1,3,7,17,22,37
<i>Superleggera</i>	T-464/08 EU:T:2010:212	Classes 12,18,25
<i>Crema di Bismacco</i>	EUTM No 5 225 156	Classes 29, 30

Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

#### *Distinctive examples*

Sign	Example
	CP3 example
	CP3 example
	CP3 example

Sign	Case No	Goods and services
	EUTM No 13 448 097	Classes 5,9,11,37,42,45

#### Combination with colour

The mere 'addition' of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, will not be sufficient to give the mark distinctive character.

Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours that is unusual






and can be easily remembered by the relevant consumer could render a mark distinctive.

#### *Non-distinctive examples*

CP3 examples





Sign	Case No	Goods and services
	EUTM No 7 147 689	Classes 9, 38
	04/12/2014, T-494/13, Watt, EU:T:2014:1022	Classes 35,39,42
	20/11/2015, T-202/15, WORLD OF BINGO, EU:T:2015:914	Classes 9, 28, 41



#### Combination with punctuation marks and other symbols

In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements.

#### *Non-distinctive examples*

CP3 examples

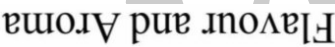
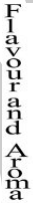





Sign	Case No	Goods and services
	05/12/2002, T-91/01, BioID, EU:T:2002:300	Classes 9,38,42
	01/02/2016, R 1451/2015-4	Classes 3,4,14,16,18,20,21,25,30 ,32,33

#### Position of the word elements (sideways, upside-down, etc.)

In general, the fact that the word elements are arranged vertically, upside-down or in one or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.

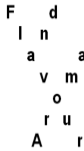

#### *Non-distinctive examples*


CP3 examples	
	
	
	

Sign	Case No	Goods and services
	12/11/2014, T-504/12, Notfall Creme, EU:T:2014:941	Classes 3, 5
	11/07/2012, T-559/10, Natural beauty, EU:T:2012:362	Class 3

However, the way in which the word elements are positioned can add distinctive character to a sign when the arrangement is of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message.

#### *Distinctive examples*

CP3 examples	
	
	

Sign	EUTM No	Goods and services
	15 971 153	Classes 9, 16 and 35

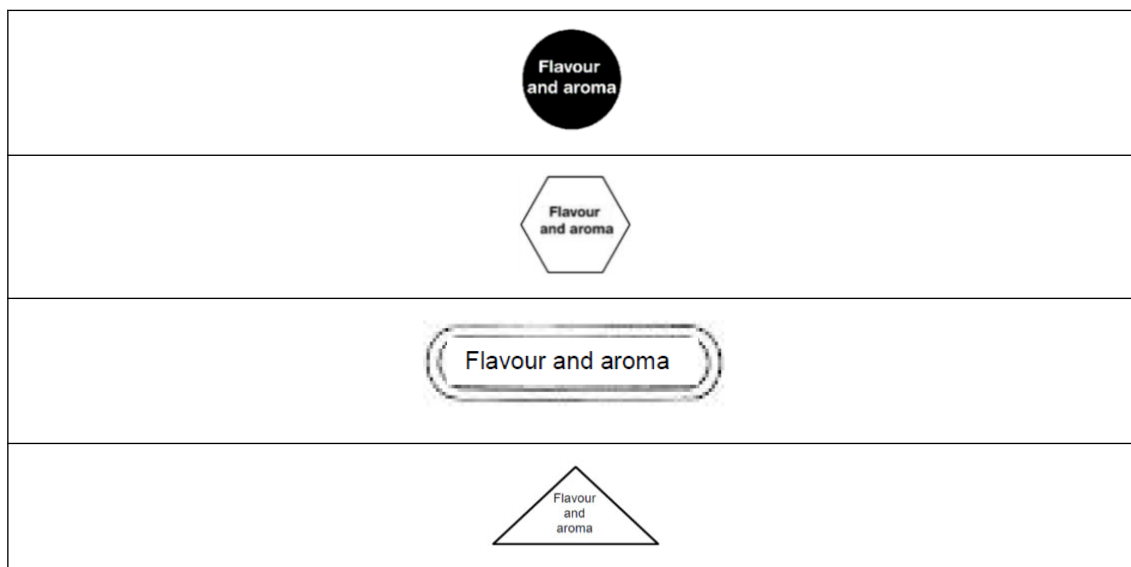
#### 4.2.2 Figurative elements (word element(s) and additional figurative element(s))




##### Use of simple geometric shapes

Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, in particular when the abovementioned shapes are used as a frame or border.

#### *Non-distinctive examples*

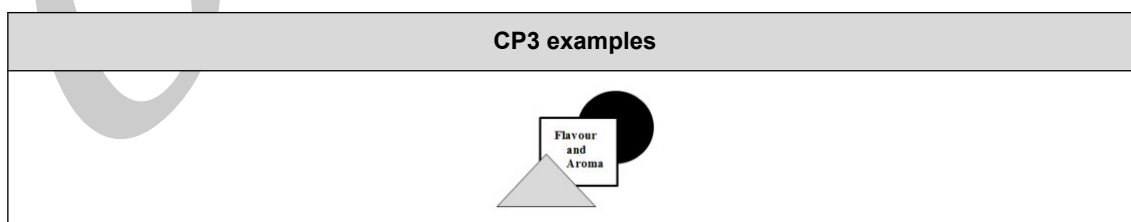
CP3 examples
--------------







Sign	Case No	Goods and services
	09/07/2014, T-520/12, Gifflar, EU:T:2014:620	Class 30
	EUTM No 6 039 119	Class 24
	EUTM No 11 387 941	Classes 9,35,41

However, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression that is sufficiently distinctive.

*Distinctive examples*



CP3 examples




Sign	EUTM No	Goods and services
	13 899 455	Class 35

#### Position and proportion (size) of the figurative element in relation to the word element



In general, when a figurative element that is distinctive on its own is added to a descriptive and/or non-distinctive word element, then the mark is registrable, provided that said figurative element is, due to its size and position, clearly recognisable in the sign.

#### *Non-distinctive examples*


CP3 examples






Sign	Case No	Goods and services
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	EUTM No 11 418 605	Classes 21, 24, 35
	21/05/2015, T-203/14, Splendid, EU:T:2015:301	Classes 18, 25

*Distinctive examples*

<b>CP3 example</b>
 <b>Flavour and aroma</b>

Sign	EUTM No	Goods and services
	13 244 942	Classes 11, 37
 PLANMY.WEDDING	15 184 799	Classes 35, 41, 45
	13 906 458	Classes 12, 39

The figurative element is a representation of, or has a direct link with, the goods and/or services




A figurative element is considered to be descriptive and/or devoid of distinctive character whenever:

it is a true-to-life portrayal of the goods and services;



it is a symbolic/stylised — portrayal of the goods and services that does not depart significantly from the common representation of said goods and services.

*Non-distinctive examples*

<b>CP3 examples</b>
---------------------

 <b>Fresh Sardine</b>
 <b>Sardines</b>
 <b>From the sea to your plate</b>



### *Distinctive examples*



Sign	Example
 <b>resh Sardine</b>	CP3 example
 <b>Fresh Sardine</b>	CP3 example

A figurative element that does not represent the goods and services but has a direct link with the characteristics of the goods and services will not render the sign distinctive, unless it is sufficiently stylised.

### *Non-distinctive examples*




<b>CP3 example</b>
 <b>PEST CONTROL SERVICES</b>

Sign	EUTM No	Goods and services
 <b>Hunde sport</b>	10 909 307	Classes 18, 21, 28, 31
 <b>1click donation</b>	1 131 046	Classes 36, 42, 45


	874 778	Classes 9, 11
	14 512 784	Classes 11, 28, 37, 42
	14 584 262	Classes 9, 42

### Distinctive examples

<b>CP3 example</b>


Sign	Case No	Goods and services
	EUTM No 13 847 827	Classes 5, 31
	EUTM No 13 433 784	Classes 37,41,42
	11/02/2015, R 1983/2014-2	Class 11





	EUTM No 13 893 871	Classes 29, 31
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The figurative element is commonly used in trade in relation to the goods and/or services applied for

In general, figurative elements that are commonly used or customary in trade in relation to the goods and/or services claimed do not add distinctive character to the mark as a whole.

*Non-distinctive examples*

<b>CP3 examples</b>	
	
	

Sign	Case No	Goods and services
	EUTM No 116 434	Class 32
	03/07/2003, T-122/01, Best Buy, EU:T:2003:183	Classes 35, 37, 42






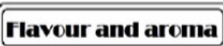




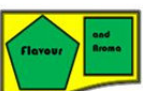








	IR No W 01 116 291	Classes 29, 30, 43
	11/12/2015, R 1191/2015-5	Classes 16, 29, 30, 35

#### 4.2.3 Word and figurative elements (stylised word elements and additional figurative element(s))



In general, a combination of figurative and word elements, which if considered individually are devoid of distinctive character, does not give rise to a distinctive mark.

Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case when the combination results in an overall impression that is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.



**Examples.** In order for a sign to be registrable, it must have a minimum level of distinctiveness. The purpose of the scale is to illustrate where that threshold is. The examples below from left to right contain elements with an increasing impact on the distinctiveness of the marks, resulting in marks that are either non-distinctive in their totality (red column) or distinctive in their totality (green column).

 <b>1.</b> <i>Flavour and aroma</i>  <i>Flavour and aroma</i>  <i>Flavour and</i>  <i>aroma</i>	
<b>2.</b>    	  
<b>3.</b>    	  

### Non-distinctive examples

Sign	Case No	Goods and services
	03/12/2015, T-647/14, DUALSAW, EU:T:2015:932	Classes 7, 8, 35
	24/06/2015, T-552/14, Extra, EU:T:2015:462	Classes 3, 21, 30

### Distinctive examples

Sign	EUTM No	Goods and services
	13 815 121	Classes 16, 21, 30
	14 585 939	Classes 29, 30, 32

# ***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)***

**Table of Contents**

**1 General Remarks..... 422**

**2 Point in Time of a Term Becoming Customary..... 423**

**3 Assessment of Customary Terms..... 424**

Obsolete

## 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 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 (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 (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 which registration is sought, 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 No
 <p>EUTM No 9 894 528 covering goods in Class 9</p>	<p>'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' (para. 20)</p>	<p>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** (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 (05/03/2003, T-237/01, BSS, EU:T:2003:54, § 47; similarly, 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 59(1)(a) EUTMR, but can lead to a **revocation** with effect *ex nunc* under Article 58(1)(b) EUTMR. For example, the EUTM registration 'STIMULATION' was cancelled on the grounds that it had become a term customarily used for 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 for which registration is sought, and, secondly, on the basis of the target public's perception of the mark (07/06/2011, T-507/08, 16PF, EU:T:2011:253, § 53).

As regards the **link with the goods and services** for which registration is sought, Article 7(1)(d) EUTMR will not apply where the mark is a more general laudatory term that has no particular customary link with the goods and services concerned (04/10/2001, C-517/99, Bravo, EU:C:2001:510, § 27, 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 (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** (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 that another sector may recognise the sign as a badge of origin (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)** (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 for which the trade mark is filed.



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

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

### ***Part B***

#### ***Examination***

##### ***Section 4***

###### ***Absolute grounds for refusal***

###### ***Chapter 6***

###### ***Shapes or other characteristics with an essentially technical function, substantial value or resulting from the nature of the goods (Article 7(1)(e) EUTMR)***

## Table of Contents

<b>1 General Remarks.....</b>	<b>427</b>
<b>2 Shape or Other Characteristics Resulting from the Nature of the Goods..</b>	<b>429</b>
<b>3 Shape or Other Characteristics of Goods Necessary to Obtain a Technical Result.....</b>	<b>430</b>
<b>4 Shape or Other Characteristics Giving Substantial Value to the Goods....</b>	<b>432</b>

## 1 General Remarks

Article 7(1)(e) EUTMR excludes from registration signs that consist exclusively of (i) the shape or another characteristic that results from the nature of the goods themselves; (ii) the shape or another characteristic of goods that is necessary to obtain a technical result; or (iii) the shape or another characteristic of the goods that gives substantial value to the goods.

The wording of this provision implies, in principle, that it does not apply to signs for which registration is sought in respect of services.

In relation to shapes, the **objective** pursued by Article 7(1)(e) EUTMR is the same for all of its three grounds, namely to prevent the exclusive and permanent rights that a trade mark confers from serving to extend the life of other IP rights indefinitely, such as patents or designs, which the EU legislature has sought to make subject to limited periods (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 19-20; 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 43; 06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 65).

Regulation (EU) 2015/2424 of the European Parliament and of the Council amending the Community Trade Mark Regulation introduced the reference to ‘another characteristic’ of goods. To the Office’s understanding, most of the trade marks that fall foul of the new wording of this provision are currently objectionable under Article 7(1) (b) and/or (c) EUTMR, as they are descriptive or otherwise non-distinctive. However, an important practical difference lies in the fact that an objection under Article 7(1)(e) EUTMR cannot be overcome by invoking Article 7(3) EUTMR.

Importantly, unlike the situation covered by Article 7(1)(b) EUTMR, the **average consumer’s perception is not a decisive element** when applying the ground for refusal under Article 7(1)(e) EUTMR, but, **at most**, may be a relevant criterion for the Office when identifying the sign’s essential characteristics (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 34).

For these reasons, **an objection under Article 7(1)(e) EUTMR** to marks consisting of shapes or other characteristics that follow from the nature of the goods; shapes or other characteristics that are necessary to obtain a technical result; or shapes or other characteristics giving substantial value to the goods **cannot be overcome** by demonstrating that they have **acquired distinctive character**. In other words, Article 7(3) EUTMR is not applicable to such shapes or other characteristics, regardless of whether that particular shape or another characteristic might actually be distinctive in the marketplace.

It is therefore essential to **undertake a prior examination of the sign under Article 7(1)(e) EUTMR where several of the absolute grounds for refusal provided for in Article 7(1) EUTMR may apply** (06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 44).

For the sake of sound administration and economy of proceedings, the Office will raise any objections to registration of the sign under Article 7(1) EUTMR simultaneously in

one communication. The reasoning of the objection will address first Article 7(1)(e) EUTMR, even if this ground for refusal may be less evident than, for instance, an objection for a lack of distinctiveness under Article 7(1)(b) EUTMR. This is justified by the fact that registration of a sign that falls foul of Article 7(1)(e) EUTMR is clearly impossible even if acquired distinctiveness through use has been proven.

It may also be the case that, following an initial objection under Article 7(1)(b) and/or (c) EUTMR, the evidence submitted by the applicant shows that the sign consists exclusively of a shape or another characteristic as listed in Article 7(1)(e) EUTMR. In these cases, an objection under Article 7(1)(e) EUTMR should be raised as well.

Article 7(1)(e) EUTMR does not define the category of mark that must be considered as a shape within the meaning of that provision. **It makes no distinction between 2D or 3D shapes, or 2D representations of 3D shapes.** Therefore, the applicability of Article 7(1)(e) EUTMR is not confined to 3D shapes but also applies to other categories of marks, such as figurative signs representing shapes (06/03/2014, C-337/12 P – C-340/12 P, Surface covered with circles, EU:C:2014:129, § 55).

A sign consists ‘**exclusively**’ of the shape of goods or other characteristics when all its **essential characteristics** — that is to say, its most important elements — result from the nature of the goods (Article 7(1)(e)(i) EUTMR), perform a technical function (Article 7(1)(e)(ii) EUTMR) or give substantial value to the goods (Article 7(1)(e)(iii) EUTMR). The presence of one or more minor arbitrary elements, therefore, will not alter the conclusion (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 21-22; 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 51-52). However, an objection under Article 7(1)(e) EUTMR would not be justified if the sign applied for were a shape or other characteristic(s) combined with additional, distinctive matter such as word or figurative elements (that qualify as essential characteristics of the sign), as the sign in its entirety would then not consist exclusively of a shape or other characteristic(s) (see Step 3 in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 3, Non-Distinctive Trade Marks (Article 7(1)(b) EUTMR), paragraph 11.3).

The correct application of Article 7(1)(e) EUTMR requires that **the essential characteristics of the sign at issue be properly identified**. There is no hierarchy that applies systematically between the various types of elements of which a sign may consist. Moreover, in determining the essential characteristics of a sign, the Office may either base its assessment directly on the overall impression produced by the sign, or first examine in turn each of the components of the sign concerned (14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 70; 19/09/2012, T-164/11, Knife handles, EU:T:2012:443, § 37).

This identification may, depending on the case and in particular its degree of difficulty, ‘be carried out by means of a simple visual analysis of the sign or, alternatively, be based on a detailed examination in which relevant assessment criteria may be taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously for the goods concerned’, such as patents (14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 71, 85).

Once the sign's essential characteristics have been identified, it will have to be established **whether they all fall under the respective ground set out in Article 7(1)(e) EUTMR** (14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 72). In this respect, each of the three grounds must be applied independently of the others. In addition, where none of those grounds is fully applicable for the entire shape or another characteristic, they do not preclude registration of the sign (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 39, 42). Therefore, if parts of the shape or other characteristics are necessary to obtain a technical result within the meaning of Article 7(1)(e)(ii) EUTMR, for instance, and the remaining parts merely give substantial value to the goods under Article 7(1)(iii) EUTMR, neither of these two provisions bars the registration of the shape or other characteristics as a sign.

## 2 Shape or Other Characteristics Resulting from the Nature of the Goods

Under Article 7(1)(e)(i) EUTMR, signs that consist exclusively of the shape or another characteristic that results from the nature of the goods themselves cannot be registered.

This ground for refusal will apply when the sign, whether 2D or 3D, consists exclusively of the only natural shape of the good, that is, **'natural' products that have no substitute**: for example, the realistic representation below of a banana for bananas.



The same would apply to **'regulated' products** (the shape or another characteristic of which is prescribed by legal standards), such as a rugby ball.

Apart from 'natural' and 'regulated' products, all shapes that are **inherent to the generic function or functions** of such goods must, in principle, also be denied registration (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 23-25). The Court of Justice has not given any further guidance about exactly when a shape is inherent to the generic function(s) of goods. In the absence of any case-law in this respect, the examples given by the Advocate General may be referred to: legs with a horizontal level for a table; an orthopaedic-shaped sole with a V-shaped strap for flip-flops (14/05/2014, C-205/13, EU:C:2014:322, § 59). Even though the opinion of the Advocate General is not binding, it can give useful guidance.

There is no practice yet on cases where a trade mark consists of **'other characteristics'** that result from the nature of the goods. As an invented example, a sound mark representing the sound of a motorbike for *motorbikes* could be captured by Article 7(1)(e)(i) EUTMR if the sound results from the nature of the goods (in the sense of its technical performance). Another hypothetical example of a sign that consists

exclusively of ‘other characteristics’ resulting from the nature of the goods could be an olfactory mark of a scent for a *perfume*.

### 3 Shape or Other Characteristics of Goods Necessary to Obtain a Technical Result

Article 7(1)(e)(ii) EUTMR excludes from registration signs that consist exclusively of the shape or another characteristic of goods that is necessary to obtain a technical result.

The Courts have not yet ruled on the interpretation of ‘another characteristic’ of the goods. However, the Court of Justice has rendered two leading judgments concerning the subject of essentially functional shapes, which provide guidance concerning the examination of trade marks consisting exclusively of functional shapes (18/06/2002, C-299/99, Remington, EU:C:2002:377; 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516), interpreting, inter alia, Article 3(1) of the Trade Mark Directive, which is the equivalent of Article 7(1) EUTMR.

A sign consists ‘exclusively’ of the shape of goods that is necessary to obtain a technical result when all the essential characteristics of a shape perform a technical function, the presence of non-essential characteristics with no technical function being irrelevant in that context (14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 51). The fact that there may be alternative shapes, with other dimensions or another design, capable of achieving the same technical result does not in itself preclude the application of this provision (14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 53-58). Likewise, the combination of different elements that are all functional in themselves does not render the sign registrable.

The Court further pointed out that the essential characteristics of the shape necessary to obtain a technical result **must be assessed in the light of the technical function of the actual goods represented**. The analysis cannot be made without taking into consideration, where appropriate, the **additional elements relating to the function of the actual goods**. In the ‘Rubik’s Cube-type puzzle’ the functionality of the grid structure in the light of the rotating capability of individual elements of the puzzle should have been examined (10/11/2016, C-30/15 P, CUBES (3D), EU:C:2016:849, § 47-51).

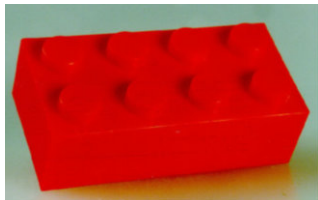
In assessing an EUTM application against Article 7(1)(e)(ii) EUTMR, consideration should be given to the meaning of the **expression ‘technical result’**. This expression should be interpreted broadly and includes shapes or other characteristics that, for example:

- fit with another article;
- give the most strength;
- use the least material;
- facilitate convenient storage or transportation.

Other characteristics of the goods that are necessary to obtain a technical result may include particular sounds. For instance, as an invented example, a sound mark for

insect repellents may be objected to under Article 7(1)(e)(ii) EUTMR if the sound in fact repels insects.

In the ‘Red Lego Brick’ case, following a cancellation action, two instances of the Office declared the 3D shape of a building block in a construction toy set as invalid:

Sign	Case No	Goods and services
	EUTM No 107 029 10/07/2006, R 856/2004 G 12/11/2008, T-270/06 14/09/2010, C-48/09 P	Class 28 ( <i>construction toys</i> )

In particular, the Grand Board held that the various features of the ‘Red Lego brick’ all performed particular technical functions, namely (i) *the bosses [studs]*: height and diameter for clutch power; number for fixing versatility; layout for fixing arrangement; (ii) *the secondary projections*: clutch-power; the number for best clutch-power in all positions; the thickness of the wall to act as a spring; (iii) *the sides*: connected with sides of other bricks to produce a wall; (iv) *the hollow skirt*: to mesh with the bosses and to enable fixing for clutch power and (v) *the overall shape*: brick shape for building; size for children to hold (10/07/2006, R 856/2004-G, 3D SHAPE OF LEGO BRICK, § 54).

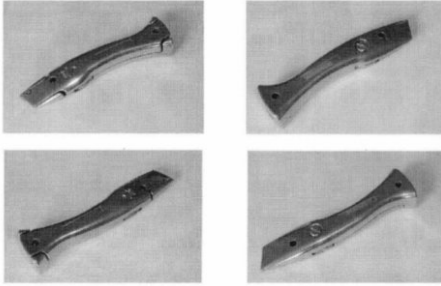
The General Court dismissed the appeal against the above decision and confirmed the findings of the Grand Board, holding that the latter had correctly applied Article 7(1)(e) (ii) EUTMR (12/11/2008, T-270/06, Lego brick, EU:T:2008:483).

Following an appeal, the Court of Justice, in its ruling of 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, confirmed the judgment of the General Court, holding that:

... the solution incorporated in the shape of goods examined is the technically preferable solution for the category of goods concerned. If the three-dimensional sign consisting of such a shape were registered as a trade mark, it would be difficult for the competitors of the proprietor of that mark to place on the market shapes of goods constituting a real alternative, that is to say, shapes which are not similar and which are nevertheless attractive to the consumer from a functional perspective (para. 60).

The fact that the shape concerned is, or has been, the subject of a claim in a **registered patent or patent application** constitutes *prima facie* evidence that those aspects of the shape identified as being functional in the patent claim are necessary to achieve a technical result (this approach has been followed by the Boards of Appeal, for example, in their decision of 17/10/2013, R 42/2013-1, SHAPE OF A STOPPER (3D)).

A case regarding the following shape for ‘knives and knife handles’ provides an example of **how to identify the essential characteristics** of a shape and how to assess if all of those characteristics perform a technical function:

Sign	Case No
	<p>19/09/2012, T-164/11, Knife handles</p>
<p>In this case, the shape applied for was described as</p> <p>... a slightly curved knife handle characterised by a small angle of 5 to 10 degrees between the knife blade and the longitudinal axis of the shell grip, which has a middle section with a somewhat rounded outer cross section, which broadens towards a tapered rear end. The handle also incorporates a knurled screw in the shell of the knife (para. 28).</p> <p>The Court stated that</p> <p>As is apparent from that patent [relied upon by the invalidity applicant], the technical effect of the angle between the knife blade and the longitudinal axis of the mother-of-pearl handle is to facilitate cutting. The intermediate section is of particular importance for long cuts. It makes the cut more precise while allowing greater pressure to be exerted. Finally, the knurled screw allows the shell to be opened and the blades of the knife to be changed without using other tools and without hindering manipulation of the knife during use (para. 30).</p> <p>and concluded that the most important elements of the sign, constituting its essential characteristics, are all exclusively functional (para. 33). The applicant, in this regard, accused the Boards of Appeal of limiting itself to an assessment, in an isolated manner, of all the elements constituting the contested sign without taking into account the <b>overall impression</b> produced by the sign. However, as the Court noted:</p> <p>In this case, contrary to what the applicant claims, the Boards of Appeal did state ... that the shape of the knife constituting the disputed trade mark could be perceived as being a fish or a dolphin. However, that resemblance with a fish is conditioned by elements having a technical function, namely the invention covered by the expired American patent with a slightly less curved handle and a slight prolongation of the points at the rear end (para. 39).</p>	

## 4 Shape or Other Characteristics Giving Substantial Value to the Goods

Under Article 7(1)(e)(iii) EUTMR, signs that consist exclusively of the shape or another characteristic that gives substantial value to the goods cannot be registered or, if registered, they are liable to be declared invalid.

Whereas the same shape or another characteristic can, in principle, be protected both as a design and as a trade mark, Article 7(1)(e)(iii) EUTMR only refuses trade mark



protection for shapes or other characteristics in certain specific cases, namely, when the sign consists exclusively of a shape or another characteristic that gives substantial value to the product.

The **concept of ‘value’** should be interpreted not only in commercial (economic) terms, but also in terms of ‘attractiveness’, that is to say, the likelihood that the goods will be purchased **primarily because of** their particular shape or another particular characteristic. When other characteristics may give the product significant value in addition to this aesthetic value, such as functional value (for instance safety, comfort and reliability), Article 7(1)(e)(iii) EUTMR cannot be ruled out automatically. Indeed, the concept of ‘value’ cannot be limited purely to the shape or another characteristic of goods having only artistic or ornamental value (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 29-32).

**The concept of ‘value’ should not be interpreted as meaning ‘reputation’**, since application of this absolute ground for refusal is justified exclusively by the effect on the value added to the goods **by the shape or other characteristic** and not by other factors, such as the reputation of the word mark that is also used to identify the goods in question (16/01/2013, R 2520/2011-5, SHAPE OF GUITAR BODY (3D), § 19).

Furthermore, that the shape or other characteristic may be **pleasing or attractive** is not sufficient to exclude it from registration. If that were the case, it would be virtually impossible to imagine any trade mark of a shape or another characteristic, given that in modern business there is no product of industrial utility that has not been the subject of study, research and industrial design before its eventual launch on the market (03/05/2000, R 395/1999-3, SINGLE SQUARE CLASP, § 1-2, 22-36).

In assessing the value of the goods, account may be taken of **criteria** such as the nature of the category of goods concerned, the artistic value of the shape or other characteristic in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference compared with similar goods, and the development of a promotion strategy that focuses on accentuating the aesthetic characteristics of the product in question (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 35).


The fact that the shape also performs other functions in addition to its aesthetic function (e.g. functional functions) does not exclude the application of Article 7(1)(e)(iii) EUTMR (18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 31).

An example of a sign that consists exclusively of ‘other characteristics’ that give substantial value to the goods could be a sound mark, representing a specific sound of a *motorbike* that may be appealing to a significant part of the relevant public to the extent that it may indeed affect the consumer’s choice of purchase.

For the examination of these trade marks, a **case-by-case approach is necessary**. In most of these cases a proper examination will only be possible where there is evidence that the aesthetic value of the shape or other characteristic can, in its own right, determine the commercial value of the product and the consumer’s choice to a large extent.

If a shape or other characteristic derives its appeal from the fame of its designers and/or marketing efforts rather than from the aesthetic value of the shape or other characteristic itself, Article 7(1)(e)(iii) EUTMR will not apply (14/12/2010, R 486/2010-2, SHAPE OF A CHAIR (3D), § 20-21).

A leading case when it comes to shapes bestowing substantial value on the goods concerns the three-dimensional representation below of a loudspeaker.


Sign	Case No	Goods
	10/09/2008, R 497/2005-1, LOUDSPEAKER (3D)  06/10/2011, T-508/08, Loudspeaker	Apart from loudspeakers, other apparatus for the reception, processing, reproduction, regulation or distribution of sound signals in Class 9 as well as music furniture in Class 20.

The General Court confirmed the Board of Appeal's finding that the sign at issue fell within the scope of Article 7(1)(e)(iii) EUTMR (06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575).

The General Court held that for goods such as those listed above, the design was an element that would be very important in the consumer's choice even if the consumer took other characteristics of the goods at issue into account. After having stated that the shape for which registration was sought revealed a very specific design and that it was an essential element of the applicant's branding, which increased the appeal of the product and, therefore, its value, the General Court also noted that it was apparent from the evidence on record, namely extracts from the distributors' websites and online auction or second-hand websites, that the aesthetic characteristics of that shape were emphasised first and that the shape was perceived as a kind of pure, slender, timeless sculpture for music reproduction, which made it an important selling point (06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 75). The General Court thus concluded that, independently of the other characteristics of the goods at issue, the shape for which registration was sought bestowed substantial value on the goods concerned.

It follows from the above judgment that it is important to determine whether **the aesthetic value of a shape (or, by analogy, other characteristic) can, in its own right, determine the commercial value of the product and the consumer's choice to a large extent**. It is immaterial whether the overall value of the product is also affected by other factors, if the value contributed by the shape **or other characteristic** itself is substantial.

See another example of such an application below:

EUTM	Case No
	18/03/2015, R 664/2011-5, DEVICE OF A CHAIR (3D)
<p>The BoA cancelled the EUTM in view of the fact that the chair shape as registered had substantial value. The BoA examined the evidence put forward in detail and concluded, among others, that the promotional strategy of the EUTM proprietor had been dominated by references to the aesthetic value of the chair shape over many years, including well before the registration date.</p>	

***GUIDELINES FOR EXAMINATION***

***EUROPEAN UNION***

***INTELLECTUAL PROPERTY OFFICE***

***(EUIPO)***

***Part B***

***Examination***

***Section 4***

***Absolute grounds for refusal***

***Chapter 7***

***Trade marks contrary to public policy or acceptable principles of morality (Article 7(1)(f) EUTMR)***

## Table of Contents

<b>1 General Remarks.....</b>	<b>438</b>
<b>2 ‘Public Policy’.....</b>	<b>439</b>
2.1 Concept and categories.....	439
<b>3 Accepted Principles of Morality.....</b>	<b>440</b>
<b>4 Examples.....</b>	<b>442</b>
4.1 Examples of rejected EUTM applications.....	442
4.2 Examples of accepted EUTM applications.....	448

## 1 General Remarks

Article 7(1)(f) EUTMR excludes from registration trade marks that are contrary to public policy or to accepted principles of morality. Article 7(1)(f) EUTMR mirrors that of Article 6<sup>quinquies</sup>(B)(3) of the Paris Convention <sup>(9)</sup>, which provides for the refusal of trade mark applications and for the invalidation of registrations where trade marks are ‘contrary to morality or public order’.

The wording of Article 7(1)(f) EUTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to encounter disturbing, abusive, insulting and even threatening trade marks (06/07/2006, R 495/2005-G, SCREW YOU, § 14).

The rationale of Article 7(1)(f) EUTMR is not to identify and filter out signs whose use in commerce must at all costs be prevented, but to preclude trade marks from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society. In other words, the Office should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society (06/07/2006, R 495/2005-G, SCREW YOU, § 13).

The application of Article 7(1)(f) EUTMR is not limited by the principle of freedom of expression (Article 10, Freedom of expression, European Convention on Human Rights) since the refusal to register only means that the sign is not granted protection under trade mark law and does not stop the sign from being used — even in business (09/03/2012, T-417/10, ¡Que bueno ye! HIJOPUTA (fig.), EU:T:2012:120, § 26).

‘Public policy’ and ‘accepted principles of morality’ are two different concepts that often overlap.

The question whether the goods or services for which protection is sought can or cannot be legally offered in a particular Member State’s market is irrelevant for the question as to whether the sign itself falls foul of Article 7(1)(f) EUTMR (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 33). Whether or not a mark is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the mark applied for, and not by the circumstances relating to the conduct of the person applying for the trade mark (13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 28). In its judgment of 20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, the General Court held that the concepts of ‘public policy’ and ‘acceptable principles of morality’ must be interpreted not only with reference to the circumstances common to all Member States but by taking into account ‘the particular circumstances of **individual Member States** which are likely to influence the perception of the relevant public within those States’ (para. 34).

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<sup>9</sup> Paris Convention for the Protection of Industrial Property of 20 March 1883 (as amended on 28 September 1979).

The legislation and administrative practice of certain Member States can also be taken into account in this context (i.e. for assessing subjective values), not because of their normative value, but as evidence of facts that make it possible to assess the perception of the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 57). In such a case, the illegality of the EUTM applied for is not the determining factor for the application of Article 7(1)(f) EUTMR, but rather is of evidential value with regard to the perception of the relevant public in the Member State(s) in question.

Considering that the specific circumstances of **individual** Member States may not be widely known in EU territory, the objection letter should explain these circumstances clearly in order to make sure that the applicant is able to fully understand the reasoning behind the objection and is able to respond accordingly.

## 2 ‘Public Policy’

### 2.1 Concept and categories

This objection derives from an assessment based on **objective criteria**. ‘Public policy’ is the body of all legal rules that are necessary for the functioning of a democratic society and the state of law. In the context of Article 7(1)(f) EUTMR, ‘public policy’ refers to the **body of EU law applicable in a certain area**, as well as to the legal order and the state of law as defined by the Treaties and secondary EU legislation, which reflect a common understanding of certain basic principles and values, such as human rights.

The following is a non-exhaustive **list of examples** of when signs will be caught by this prohibition.

- Trade marks that contradict the basic principles and fundamental values of the European Union political and social order and, in particular, the universal values on which the European Union is founded, such as human dignity, freedom, equality and solidarity and the principles of democracy and the rule of law, as proclaimed in the Charter of Fundamental Rights of the European Union (OJ C 83, 30/03/2010, p. 389).
- On 27/12/2001, the Council of the European Union adopted Common Position 2001/931/CFSP on the application of specific measures to combat terrorism (OJ L 344, 28/12/2001, p. 93), later updated by Council Decision (CFSP) 2017/1426 of 04/08/2017, updating the list of persons, groups and entities subject to Articles 2, 3 and 4 of Common Position 2001/931/CFSP on the application of specific measures to combat terrorism and repealing Decision (CFSP) 2017/154 (OJ L 204, 05/08/2017, p. 95, consolidated version available at <http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017D1426&from=EN>), which contains a list of individuals and groups facilitating, attempting to commit or committing terrorist acts

in EU territory. Any EUTM applied for that can be deemed to support or benefit an individual or a group on the list will be rejected as being against public policy.

### 3 Accepted Principles of Morality

This objection concerns **subjective values**, but these must be applied as objectively as possible by the examiner. The provision excludes registration as European Union trade marks of blasphemous, racist, discriminatory or insulting words or phrases, but only if that meaning is clearly conveyed by the mark applied for in an unambiguous manner; the standard to be applied is that of the reasonable consumer with average sensitivity and tolerance thresholds (09/03/2012, T-417/10, ¡Que bueno ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

The concept of morality in Article 7(1)(f) EUTMR is not concerned with bad taste or the protection of individuals' feelings. In order to fall foul of Article 7(1)(f) EUTMR, a trade mark must be perceived by the relevant public, or at least a significant part of it, as going directly against the basic moral norms of society. It is not sufficient if the trade mark is only likely to offend a small minority of exceptionally puritanical citizens. Conversely, a trade mark should not be allowed to be registered simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. The trade mark must be assessed by reference to the standards and values of ordinary citizens who fall between those two extremes (06/07/2006, R 495/2005-G, SCREW YOU, § 21).

As stated under 'General remarks' above, national legislation and practice of Member States are indicators to be taken into account in order to assess how certain categories of signs are perceived by the relevant public in those Member States (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498, § 58). However, the Office must not object to trade marks because of the mere fact that they are in conflict with national legislation and practice. National legislation and practice are considered to be **factual evidence** that enables an assessment of the perception of the relevant public within the relevant territory.

Examples of national legislation taken into account as evidence of a trade mark being contrary to accepted principles of morality:

- use of symbols and names of unconstitutional parties or organisations is prohibited in Germany (§ 86a dt. StGB (German Criminal Code), BGBl. No I 75/1998) and in Austria (§ 1 öst. Abzeichengesetz (Austrian Law on Insignias), BGBl. No 84/1960 in conjunction with § 1 öst. Verbotsgesetz (Austrian Prohibition Law), BGBl. No 25/1947);
- 'use of symbols of totalitarianism' (e.g. the sickle and hammer and the five-pointed red star), specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity is prohibited in Hungary (Section 335 of Act C of 2012 on the Criminal Code) (20/09/2011, T-232/10, Coat of Arms of the Soviet Union, EU:T:2011:498).



Signs that can be perceived as promoting the use of illegal drugs also fall under this provision. Taking into account, as factual evidence, that certain drugs are illegal in some Member States as well as the fact that the EU has undertaken drug policy initiatives to fight against illegal drugs, an objection should be raised. It is an objective indication that such signs would be perceived as going directly against the basic moral norms of society.

The assessment made will take into account the term used in the mark applied for or the presence of other elements that could be perceived as promoting the use of illegal drugs. However, an objection will not be raised if the sign contains a reference to a drug that is for medical use, as the mark would not fall, in principle, within the prohibition of Article 7(1)(f) EUTMR.

The examination of Article 7(1)(f) EUTMR should consider the **context** in which the mark is likely to be encountered, assuming normal use of the mark **in connection with the goods and services** covered by the application (06/07/2006, R 495/2005-G, SCREW YOU, § 21). Taking account of the goods and services for which registration of the mark is sought is normally necessary, since the relevant public may be different for different goods and services and, therefore, may have different thresholds with regard to what is clearly unacceptably offensive. For example, 'a person who is sufficiently interested in [sex toys] to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations' (06/07/2006, R 495/2005-G, SCREW YOU, § 29).

Nevertheless, although the Court has held that the goods and services for which protection is sought are important for identifying the relevant public whose perception needs to be examined, it has also made it clear that the **relevant public is not necessarily only that which buys the goods and services covered by the mark**, since a broader public than just the consumers targeted may encounter the mark (05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 17-18). Accordingly, the commercial context of a mark, in the sense of the public targeted by the goods and services, is not always the determining factor in whether that mark would breach accepted principles of morality (09/03/2012, T-417/10, ¡Que bueno ye! HIJOPUTA (fig.), EU:T:2012:120, § 24; 26/09/2014, T-266/13, Curve, EU:T:2014:836, § 18-19).

**Illegality is not a necessary condition** for giving rise to a conflict with accepted principles of morality: there are words or signs that would not lead to proceedings before the relevant authorities and courts, but that are sufficiently offensive to the general public to not be registered as trade marks (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPIITZ (fig.), § 16). Furthermore, there is an interest in ensuring that children and young people, even if they are not the relevant public of the goods and services in question, do not encounter offensive words in shops that are accessible to the general public. Dictionary definitions will in principle provide a preliminary indication as to whether the word in question has an offensive meaning in the relevant language (01/09/2011, R 168/2011-1, fucking freezing! by TÜRPIITZ (fig.), § 25), but the key factor must be the perception of the relevant public in the specific context of how and where the goods or services will be encountered.

However, the Boards of Appeal took the view that the word ‘kuro’ did not convey to the Hungarian public the offensive meaning of the word ‘kúró’ (meaning ‘fucker’ in English), since the vowels ‘ó’ and ‘ú’ are separate letters that are distinct from ‘o’ and ‘u’, which are pronounced differently and convey different meanings (22/12/2012, R 482/2012-1, kuro, § 12 et seq.).

There is a clear risk that the wording of Article 7(1)(f) EUTMR could be applied subjectively so as to exclude trade marks that are not to the examiner’s personal taste. However, for the word(s) to be objectionable, it (they) must have a clearly offensive impact on people of normal sensitivity (09/03/2012, T-417/10, ¡Que bueno ye! HIJOPUTA (fig.), EU:T:2012:120, § 21).

There is no need to establish that the applicant **wants** to shock or insult the relevant public; the fact that the EUTM applied for **might** be seen, as such, to shock or insult is sufficient (23/10/2009, R 1805/2007-1, PAKI, EU:T:2011:564, § 27, confirmed 05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 20 et seq.).




Finally, it is not only signs with a ‘negative’ connotation that can be offensive. The banal use of some signs with a **highly positive connotation** can also be offensive (e.g. terms with a religious meaning or national symbols with a spiritual and political value, like ‘ATATURK’ for the EU general public of Turkish origin (17/09/2012, R 2613/2011-2, ATATURK, § 31)).

Raising an objection when a trade mark is contrary to accepted principles of morality does not, however, prevent the sign from being also contrary to public policy (e.g. the trade mark may be perceived by the relevant public as directly contrary to the basic moral norms of society and, **at the same time**, may contradict the basic principles and fundamental values of the EU political and social order).

## 4 Examples

### 4.1 Examples of rejected EUTM applications

Sign	Relevant Consumer	Public policy/morality	Case No
BIN LADIN	General consumer	Morality and public policy — the mark applied for will be understood by the general public as the name of the leader of the notorious terrorist organisation Al Qaeda; terrorist crimes are in breach of public order and moral principles (para. 17).	29/09/2004 R 176/2004-2


Sign	Relevant Consumer	Public policy/morality	Case No
CURVE	General consumer	Morality — 'Curve' is an offensive and vulgar word in Romanian (it means 'whores'). The relevant public is not limited only to the public to which the goods and services covered by the mark are <b>directly</b> addressed. 'Curve' equally offends other persons, who are confronted with the sign <b>accidentally</b> without being interested in these goods and services (para. 19).  With regard to the word 'Curve'+ additions ['AIRCURVE'], see example below in this paragraph (R 203/2014-2).	T-266/13
	General consumer	Morality — 'fucking' is an offensive and vulgar word in English.	R 168/2011-1
	General consumer	Morality — 'HIJOPUTA' is an offensive and vulgar word in Spanish.	T-417/10
	General consumer	Morality — the Hungarian Criminal Code bans certain 'symbols of despotism', including the hammer and sickle as well as the five-pointed red star symbolising the former USSR. This law is not applicable by reason of its normative value but rather as evidence of the perception of the relevant public (paras 59-63) <sup>(10)</sup> .	T-232/10
PAKI	General consumer	Morality — 'PAKI' is a racist insult in English.	T-526/09
SCREW YOU	General consumer (for goods other than sex products)	Morality — a substantial proportion of ordinary citizens in Britain and Ireland would find the words 'SCREW YOU' offensive and objectionable (para. 26).	R 495/2005-G


<sup>10</sup> The Hungarian Criminal Code, in force at the time of the judgment (20/09/2011), has been amended by Act C of 2012 to now encompass 'Use of Symbols of Totalitarianism', used 'specifically in a way to offend the dignity of victims of totalitarian regimes and their right to sanctity' (formerly Section 269/B, now Section 335 of the Hungarian Criminal Code).

Sign	Relevant Consumer	Public policy/morality	Case No
FICKEN	General consumer	Morality — 'FICKEN' is an offensive and vulgar word in German (it means 'fuck').	14/11/2013, T-52/13, EU:T:2013:596
ATATURK	Average consumer in the EU general public of Turkish origin	Morality — banal use of signs with a highly positive connotation can be offensive under Article 7(1)(f) EUTMR. 'ATATURK' is a national symbol of spiritual and political value for the European general public of Turkish origin.	R 2613/2011-2
FUCK CANCER	General consumer	Morality — the word 'FUCK' is not only a 'slightly rude word' in combination with the word 'CANCER', but offensive and indecent, at least for the English-speaking part of the trade circles (para. 19).	23/02/2015, R 793/2014-2
MECHANICAL APARTHEID	General consumer	Public policy — 'APARTHEID' refers to an offensive former political regime in South Africa that included state terror, torture and the denial of human dignity. The message conveyed by the sign for computer games, related publications and entertainment is contrary to the European Union's public policy, since it contradicts the indivisible, universal values on which the EU is founded, i.e. human dignity, freedom, physical integrity, equality and solidarity, and the principles of democracy and the rule of law (para. 30).	06/02/2015, R 2804/2014-5
MH17 MH370	General consumer	Morality — acronyms of the flights. The intent to seek financial gain from what is universally accepted to be a tragic event that has resulted in the loss of many hundreds of lives, is unacceptable and contrary to accepted principles of morality.	EUTM 13 09 2 937 EUTM 12 83 9 486

Sign	Relevant Consumer	Public policy/morality	Case No
Fack Ju Göhte	General consumer	<p>Morality — the term ‘fack ju’ is slang for the offensive and vulgar expression ‘fuck you’ in English.</p> <p>18_(...) in its first sense, the English term ‘Fuck you’ has a sexual connotation and is characterised by coarseness; it is used also in quite a different context, to that foreseen by the Board of Appeal, to convey anger, defiance or a dislike of someone. However, even in such a case, the innate coarseness of this expression persists and the addition of the element ‘göhte’ at the end of the sign in question, whether it enables those to whom the terms at the start of the sign are ‘addressed’ to be identified, does little to mitigate its coarseness.</p> <p>32_(...) the Board of Appeal has deemed that, even though the relevant public might not attribute such a connotation to the expression ‘Fuck you’, nevertheless it is not only an expression in bad taste but one that is shocking and coarse. In these circumstances, the applicant’s argument that this Board of Appeal was wrong in deeming this sign to have a sexual connotation is irrelevant, and can only be rejected.</p>	<p>24/01/2018</p> <p><a href="#">T-69/17</a> pending appeal before CJEU</p> <p><a href="#">C-240/18 P</a></p>

Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	<p>Public policy and morality — mafia-type organised crime is a clear and present threat to the whole of the EU.</p> <p>'la Mafia' is understood world-wide as referring to a criminal organisation originating in Italy, whose activities extend to States other than the Italian Republic, inter alia, within the European Union. The referred criminal organisation resorts to intimidation, physical violence and murder in carrying out its activities, which include, inter alia, drug trafficking, arms trafficking, money laundering and corruption (para. 35).</p> <p>Such criminal activities breach the very values on which the European Union is founded, in particular the values of respect for human dignity and freedom as laid down in Article 2, Treaty of the European Union and Articles 2, 3 and 6 of the Charter of Fundamental Rights of the European Union (para. 36).</p> <p>The association in the mark of the word element 'la mafia' with the other elements of the contested mark is such to convey a globally positive image of the Mafia's activities and, so doing, to trivialise the perception of the criminal activities of that organisation (para. 46). (...) The contested mark is, therefore, likely to shock or offend not only the victims of that criminal organisation and their families, but also any person who, on EU territory, encounters that mark and has average sensitivity and tolerance thresholds (para. 47).</p>	15/03/2018, T-1/17, EU:T:2018:146

Sign	Relevant Consumer	Public policy/morality	Case No
ETA	General consumer	<p>Public policy and morality — 'ETA' will be immediately understood in Europe, in particular in Spain, as designating the terrorist group ETA (para. 2).</p> <p>ETA is included on the list of individuals and groups facilitating, attempting to commit or committing terrorist acts in EU territory (Council Common Position 2001/931/CFSP of 27/12/2001 on the application of specific measures to combat terrorism updated by Council Common Position 2009/64/CFSP) (para. 14).</p> <p>In a commercial context, the term 'ETA' has the inherent tendency to shock any normal person who hears or reads it and, in particular, members of the Spanish public who particularly keep that name in mind. The fact that ETA is not currently considered to be the biggest threat facing Spain according to an extract from a survey conducted in June 2015 provided by the applicant, does not mean that the term will not continue to be associated with the terrorist group in question in the mind of the public (para. 15).</p>	27/06/2016, R 563/2016-2
	General consumer	<p>Public policy and morality — the words 'KRITIKAL BILBO' identify a variety of plant of the 'cannabis' genus — also called 'marihuana' — which, due to its high content of tetrahydrocannabinol (THC), namely 21.47 %, is used to make marihuana (para 19).</p> <p>Cannabis with a high THC content is considered to be a narcotic that is prohibited in a large number of Member States (19/11/2009, T-234/06, Cannabis, EU:T:2009:448). Non-psychoactive substances are legal and the authorities can issue licences for their cultivation for those purposes. However, due to its high THC content, in this case the product concerned is not non-psychoactive, but is a substance for smoking that is strictly controlled in almost all European Union countries (para. 22).</p>	27/10/2016, R 1881/2015-1


Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	Morality — the sign, containing the term 'weed' and applied for in Class 32, will be understood by the relevant consumer as glorifying the use of a drug (cannabis/marijuana) that is prohibited by law in many European countries.	EUTM 16 96 1 732



## 4.2 Examples of accepted EUTM applications

Sign	Relevant Consumer	Comment	Case No
KURO	General consumer	That a foreign term, name or abbreviation displays certain similarities with an offensive word (like 'kúró') is not in itself sufficient reason to refuse an EUTM application (para. 20). The Hungarian vowels 'ò' and 'ù' are clearly different from the unaccented vowels 'o' and 'u'. Furthermore, Hungarian words never end with an unaccented 'o' (paras 15-18).	R 482/2012-1
SCREW YOU	General consumer (for sex products)	A person entering a sex shop is unlikely to be offended by a trade mark containing crude, sexually charged language (para. 29).	R 495/2005-G



DE PUTA MADRE	General consumer	Although 'puta' means 'whore' in Spanish, the expression 'DE PUTA MADRE' means 'very good' in Spanish (slang).	EUTM 3 798 469 EUTM 4 781 662 EUTM 5 028 477
AIRCURVE	Specialised public (medical personnel; patients with breathing disorders)	<p>The objectionable word 'Curve' ['whore', 'slut' in Romanian] is seamlessly attached to the English word 'AIR' to form 'AIRCURVE', which, as a whole, is entirely fanciful in Romanian. Even if the relevant public understood the English word 'AIR', and analysed the mark by separating it into two elements, the meaning of 'AIRCURVE' would be 'air whores', which, as a concept, and for respiratory apparatus, is sufficiently nonsensical or puzzling to the extent that it would eclipse any notion of being offensive (para. 13 et seq.).</p> <p>With regard to the word 'Curve' on its own, see the abovementioned example in this paragraph (T-266/13).</p>	04/06/2014, R 203/2014-2

	General consumer	For the goods at issue — <i>rum</i> (Class 33) — the relevant public will perceive the sign as provocative, transgressive, rebellious, but not as an indicator of criminal origin of the goods (para. 23).	07/05/2015, R 2822/2014-5
ILLICIT	General consumer	The mark is considered acceptable under Article 7(1)(f) EUTMR, as 'illicit' is different from something like 'counterfeit'. The mark would be seen as fanciful on the goods ( <i>cosmetics, and perfumes</i> ) and it could be accepted.	EUTM 13 469 523

	General consumer	<p>The mark evokes a concept that falls within the domain of vulgarity and profanity. However, the effect is attenuated by the fact that the implicit word does not appear in the mark as such. The presence of the initial figurative element 'W', combined with the euphemistic presentation of 'F____', also suppresses the offensive potential of the sign. Consumers with a normal level of sensitivity and tolerance would not be offended or upset by regular commercial exposure to the term in connection with the relevant goods and services in Classes 16, 18, 25, 35, 41, 43 and 44 (para. 31).</p>	<p>29/11/2018 R 1516/2018-5</p>
	General consumer	<p>The sign, containing the terms 'hemptouch' and 'cannabis', is applied for in Classes 3 and 5. It will be perceived by the relevant consumer as a reference to the medicinal use of the substance. Hemp is a variety of <i>Cannabis sativa</i>, which contains a very low concentration of THC, and cannabis can be used for medicinal purposes.</p>	EUTM 18 000 042

# ***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

<b>1 Examination of the Deceptive Character.....</b>	<b>454</b>
<b>2 Market Reality and Consumers' Habits and Perceptions.....</b>	<b>456</b>
<b>3 Trade Marks with Geographical Connotations Relating to the Location of the Applicant or the Place of Origin of the Goods/Services.....</b>	<b>458</b>
<b>4 Trade Marks Making Reference to 'Official' Approval, Status or Recognition.....</b>	<b>459</b>
<b>5 Relation with Other EUTMR Provisions.....</b>	<b>460</b>
5.1 Article 7(1)(b) and (c) EUTMR.....	461

## 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 First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [now Article 4(g) of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015] (TMD), 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** (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 objection based on deception should be raised if a non-deceptive use 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 so that there is a sufficiently serious risk that the consumer will be deceived.

An objection should, therefore, be raised **when the list of goods/services is worded in such a way that a non-deceptive use of the trade mark is not guaranteed and there is a sufficiently serious risk that the consumer will be deceived**.

The following are three examples of marks that were found to be deceptive with regard to all or part of the claimed goods <sup>11</sup>

<sup>11</sup> These examples only address the issue of whether an objection based on deception 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 any other provisions) is not contemplated here.

Sign and goods	Reasoning	Case No
LACTOFREE for <i>lactose</i> in Class 5	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' were actually <i>lactose</i> itself, then the mark would be clearly misleading.	19/11/2009, R 892/2009-1
TITAN (German word for 'titanium') for <i>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</i> in Classes 6 and 19.	During the appeal proceedings the applicant, in an attempt to overcome an objection based on deception, offered to restrict the specifications in both classes by adding, at the end, the indication <i>none of the aforesaid goods being made from or including titanium</i> . 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.	23/01/2002, R 789/2001-3
 (Italian word for coffee) for <i>tea, cocoa, artificial coffee</i> in Class 30.	The Board confirmed the refusal. It considered that the consumer would falsely believe that the <i>tea, cocoa, artificial coffee</i> offered by the applicant contained coffee. The mark would give the consumer false information about the ingredients of the goods and for that reason was deceptive.	03/12/2014 R 1692/2014-1

In the judgments of 27/10/2016, T-29/16, CAFFÈ NERO, EU:T:2016:635, § 48 and 27/10/2016, T-37/16, CAFFÈ NERO (fig.), EU:T:2016:634, § 53, the General Court found that a possible perception of the mark by the relevant consumer in a non-


deceptive manner is irrelevant, once — and thus provided that — the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived has been established.

**An objection should be raised when** the list of goods/services, worded in a detailed manner, contains goods/services for which a non-deceptive use is not guaranteed, and **there is a sufficiently serious risk that the consumer will be deceived.**

In the (invented) case of trade mark 'KODAK VODKA' for *vodka, rum, gin, whisky*, an objection should be raised for the specific goods for which non-deceptive use of the trade mark is not possible, that is to say, *rum, gin, whisky*. Such cases are substantially different from those (see below) where broad wording/categories are used and where non-deceptive use of the sign is possible.

**No objection should be raised when the list of goods/services is worded in such a broad way that non-deceptive use is possible.**

When **broad categories** in the list of goods/services are used, the question arises whether an objection should be raised in relation to an entire category where the mark is deceptive for only some goods/services falling within that category. The policy of the Office is **not to object** in these circumstances. The examiner should assume that the mark will be used in a non-deceptive manner. In other words, they will **not** object on the basis of deception wherever they can pinpoint non-deceptive use (within a category). For example, no objection would be raised for 'KODAK VODKA' for *alcoholic beverages*, since this broad category includes vodka, for which the trade mark is not deceptive.

Sign and goods	Reasoning	Case No
 for, inter alia, <i>poultry</i> in Class 29.	<p>'Gallina' means 'chicken' in Spanish.</p> <p>The specification is sufficiently broad to include chicken. There is no specific reference in the sign, which indeed would qualify for an objection under Article 7(1)(g) EUTMR.</p>	EUTM No 419 507

## 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 CAFÉ ESPAÑOL' 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 necessarily be 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 ‘ELDORADO CAFÉ ESPAÑOL’, since the general category *coffee* may also include coffee originating from Spain. 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 ‘ELDORADO CAFÉ ESPAÑOL’ 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.

Sign and services	Reasoning	Case No
 <p>for, inter alia, Class 29: <i>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.</i></p>	<p><i>Meat</i> in Class 29 also covers beef, which is depicted in the sign, meaning that non-deceptive use is possible. The sign does not, therefore, give rise to an objection under Article 7(1)(g) EUTMR.</p> <p>For <i>fish</i> and <i>poultry</i>, inter alia, the sign is also not objectionable under Article 7(1)(g) EUTMR. They are sufficiently different from <i>beef</i> 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.</p>	EUTM No 14 059 588

### 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 the grounds of deception 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.

Deception would nonetheless arise in the hypothetical case of a figurative mark containing the words **MADE IN USA**, filed by a company with its seat in the United States of America, being 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 their designer 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.

Sign and services	Reasoning	Case No
<p><b>THE E-COMMERCE AUTHORITY</b></p> <p>for <i>business services, namely, providing rankings of and other information regarding electronic commerce vendors, goods and services via the Internet</i> in Class 35 and <i>providing research and advisory services and information in the area of electronic commerce</i> in Class 42.</p>	<p>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.)</p>	<p>11/07/2001, R 803/2000-1</p>
 <p>for, inter alia, <i>teaching of skiing</i> in Class 41.</p>	<p>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.</p>	<p>11/07/2001, R 235/2009-1; confirmed 05/05/2011, T-41/10, EU:T:2011:200</p>

## 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 scenarios of deceit, the following provisions may be of particular relevance.

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

Under the current Office practice, if, following an objection based on descriptiveness and/or lack of distinctiveness, the EUTM applicant proposes a limitation in an attempt to overcome it, and provided the proposed limitation meets the prescribed requirements (a suitably worded unconditional request), 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 an objection based on deception 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 (27/03/2000, R 246/1999-1, ARCADIA, § 14).

# ***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)***

## Table of Contents

<b>1 Introduction.....</b>	<b>464</b>
<b>2 Article 7(1)(h) EUTMR.....</b>	<b>464</b>
2.1 Objective of Article 7(1)(h) EUTMR.....	464
2.2 Relevant emblems and signs protected.....	464
2.3 Applicability of Article 7(1)(h) EUTMR.....	468
<b>3 Article 7(1)(i) EUTMR — Emblems not Protected under Article 6ter PC.....</b>	<b>477</b>
3.1 Objective of Article 7(1)(i) EUTMR.....	477
3.2 Protected symbols.....	478
<b>4 Exceptions.....</b>	<b>481</b>

## **1 Introduction**

Article 7(1)(h) EUTMR incorporates Article 6<sup>ter</sup> 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<sup>ter</sup> 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<sup>ter</sup> 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 any need for registration at WIPO pursuant to Article 6ter(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.

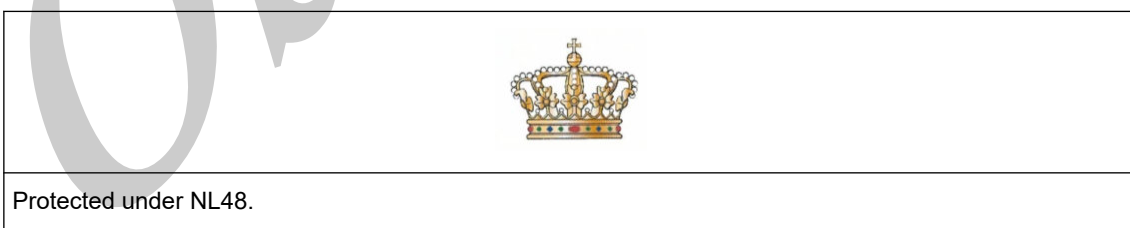


Apart from the state flag (protected per se), a member state of the PC may also request protection for other flags, namely those of its first political division in a federal state. For instance, Germany has requested protection for the flags of each *Bundesland* ('federal state').




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 are examples of states that 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,



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 at WIPO for specific products and services, such as:

	
Protected under BR6 for tourism; national and international promotion and advertising; marketing studies; business management; business administration; and office functions.	Protected under JP3 for agricultural, forestry and fishery products and foodstuffs.

Other typical examples are signs of warranty for metals, such as:




		
Protected under CZ35 for platinum	Protected under IT13 for gold	Protected under HU10 for silver

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 one or more member states 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.

AU
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 QO1746 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 (12/05/2011, R 1590/2010-1, EUROPEAN DRIVESHAFT SERVICES EDS (fig.), § 54; 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 70).

Consequently, the emblems of the European Union enjoy protection for all goods and services and there is no need to establish any specific link.

Pursuant to the 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') and by 'Vienna Classification'.

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

Since state flags enjoy protection per se without any need for registration at WIPO they are normally not found in the WIPO Article 6ter database (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 4 below).

In principle, 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, 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, (16/07/2009, C-202/08 P & C-208/08 P, RW feuille d'érable, EU:C:2009:477, § 48; 05/05/2011, T-41/10, esf école du ski français (fig.), 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 (16/07/2009, C-202/08 P & 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).

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'**. There may, for example, be imitation when the mark contains the main element of, or part of, the 'emblem' protected under Article 6ter PC. 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 (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 heraldic imitation of an 'emblem' protected under Article 6ter PC. The **size** of the protected emblem 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 (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 (13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120, § 66 et seq.; 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).	
	EUTM application No 10 502 714; 17/06/2013, R 1291/2012-2, WHO WANTS TO BE A FOOTBALL MILLIONAIRE (fig.)
The colours are recognisable and follow the structure of the flags.	







	
Flag of the United Kingdom	EUTM application No 13 169 313
The trade mark 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.	
	
French flag	18/03/2015, R 1731/2013-1, LAPIN NA LA NOUVELLE AGRICULTURE (fig.)
The French flag is incorporated into the trade mark. Although it is small, it is immediately recognisable.	
	
Emblem (Bavaria) protected under DE26	EUTM No 12 031 531; 26/02/2015, R 1166/2014-1, ALPENBAUER BAYRISCHE BONBONLUTSCHKULTUR (fig.)
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 GB3</p> <p>Protected under GB4</p>	<p>EUTM No 5 627 245; 23/07/2009, R 1361/2008-1, SUSCIPERE ET FINIRE (fig.)</p>
<p>The Board of Appeal took into account the heraldic description of the protected emblems in order to consider whether there was a heraldic imitation (paras 24 and 27).</p> <p>As regards the emblem protected under GB3, it concluded that since central elements such as the quartered shield and the supporters were largely identical, this was in this respect an imitation in the heraldic sense. The differences were not sufficient to give the EUTM application new meaning from a heraldic point of view. As regards the emblem protected under GB4, it concluded that the only difference between the supporters was the representation of the crowns, which would go unnoticed by the general public.</p>	
	
<p>Swiss flag</p>	<p>EUTM No 9 273 137</p>
<p>In spite of a slight stylisation, the Swiss flag is immediately recognisable in the sign with the same structure and colours as the protected flag.</p>	

- Heraldic imitation not found

Flag	Sign applied for
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French flag	EUTM No 4 624 987, 05/05/2011, T-41/10, esf école du ski français (fig.)
Although the colours are recognisable, the sign does not have the structure of the French flag.	
	
Peruvian flag	EUTM No 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 No 15 008 253
The trade mark 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 (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) (14/07/2011, R 1903/2010-1, A (fig.), § 17). However, to qualify as a heraldic imitation, it is not necessary for all the stars to be present in the EUTM applied for (13/03/2014, T-430/12, European Network Rapid Manufacturing, EU:T:2014:120). The exact orientation of the stars is irrelevant (15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12). The same is true with respect to their colour (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; 14/07/2011, R 1903/2010-1 A (fig.), § 17 for blue).

Earlier case-law of the Boards of Appeal, such as decisions of 11/10/2011, R 1991/2010-4, EASI EUROPEAN ALLIANCE SOLUTIONS INNOVATIONS and R 5/2011-4, TEN, which did not follow the approach taken above, was overruled by the General Court (13/03/2014, 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 QO188	EUTM application No 6 697 916; 01/03/2012, R 1211/2011-1, DIRO.net Lawyers for Europe (fig.); 13/03/2014, T-430/12, European Network Rapid Manufacturing
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 QO188	EUTM No 6 373 849; 14/07/2011, R 1903/2010-1, A (fig.)
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 QO188	EUTM No 4 819 686; 21/03/2012, R 2285/2010-2, EUROPEAN MOO DUK KWAN TANG SOO DO FEDERATION
One element of the contested EUTM contains an imitation of all the heraldic elements of the European emblem (para. 48).	
	

Emblem (Bavaria) protected under DE24	EUTM No 12 031 531; 26/02/2015, R 1166/2014-1, ALPENBAUER BAYRISCHE BONBONLUTSCHKULTUR (fig.)
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




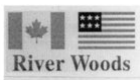




Protected 'emblem'	Sign applied for
	
Protected under IE11	EUTM application No 11 945 797; 01/04/2014, R 139/2014-5, REPRESENTATION OF A CLOVERLEAF (fig.)
It must also be taken into consideration that the graphic element of the sign applied for has a colour configuration that is clearly different from the Irish national symbols. These elements are so strong that the mere fact that the sign applied for also contains a cloverleaf does not mean that the sign is similar to one of the national emblems of Ireland (paras 18-19).	
	
Protected under SE20	EUTM application No 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.	
	



Protected under CA2	EUTM application No 15 951 262
The mark is not a heraldic imitation of the Canadian state emblem.	
	
Protected under QO188	EUTM application No 15 889 157
The mark is not a heraldic imitation of the European emblem.	

#### 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 (21/04/2004, T-127/02, ECA, EU:T:2004:110, § 45; 28/02/2008, T-215/06, RW feuille d'érable, EU:T:2008:55, § 68).

Examples:

Flag	Sign applied for
	
Protected under QO188	21/04/2004, T-127/02, ECA
	
Protected under CA1	EUTM application No 2 793 495
	
Protected under CA2	C-202/08 P & C-208/08 P
	
Flag of the United Kingdom	Invented example



	
Protected under CH27	28/10/2014, R 1577/2014-4

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 (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 (15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 42). Furthermore, gold is often reproduced as yellow (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 QO188	EUTM No 2 180 800; 15/01/2013, T-413/11, European Driveshaft Services
The Court maintained that even as regards professionals the possibility of making a connection between the sign represented above and the organisation concerned 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

1. 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
  2. are of particular public interest,
- unless the competent authority has consented to their registration.

Article 7(1)(i) EUTMR 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** (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 (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 (10/07/2013, T-3/12, Member of €e euro experts, EU:T:2013:364).

### 3.2 Protected symbols

The following signs (not 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](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](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
	
	<p>EUTM application No 6 110 423, 10/07/2013, T-3/12.</p>
<p>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).</p>	
	
	<p>EUTM application No 2 966 265, applied for in respect of goods and services in Classes 9, 38, 42 and 44.</p>
<p>Trade mark cancelled by decision of 13/05/2008, 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).</p>	
	
	<p>EUTM application No 5 988 985, applied for in respect of goods and services in Classes 28 and 30.</p>
<p>The trade mark contains the representation of the Red Cross, protected by the Geneva Convention.</p>	

- Reproduction/heraldic imitation not found

Symbol	Sign applied for
	
	28/06/2007, R 315/2006-1, D&W REPAIR (fig.), applied for in respect of goods and services in Classes 8, 11 and 12.
<p>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 (para. 20).</p> <p>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 (para. 21).</p>	
	
	EUTM application No 10 868 985, applied for in respect of goods and services in Classes 12, 35, 38, 39 and 42 (car rental related).
No link will be made with the European Union; the symbol rather refers to the 'good price' of the goods and services concerned.	
	
	EUTM application No 11 076 866, applied for in respect of goods and services in Classes 9, 35, 36, 37 and 42 (e.g. <i>electricity measuring devices, services related to building and construction</i> ).
No link will be made with the European Union; the symbol 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 registration as a trade mark or as a part thereof. 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 these are submitted 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 (26/02/2015, R 1166/2014-1, ALPENBAUER BAYERISCHE BONBONLUTSCHKULTUR (fig.), § 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 receipt of the notification from WIPO or less than 2 months after receipt of said notification.

State flags that are not submitted to WIPO enjoy protection only against trade marks that were registered after 06/11/1925.

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 6ter(8) PC).

	
State flag of the Netherlands	State flag of Luxembourg

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

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

### ***Part B***

#### ***Examination***

#### ***Section 4***

#### ***Absolute grounds for refusal***

#### ***Chapter 10 Trade Marks in Conflict with Designations of Origin and Geographical indications (Article 7(1)(j) EUTMR)***

## Table of Contents

<b>1 Article 7(1)(j) EUTMR.....</b>	<b>484</b>
<b>2 Definition of Geographical Indications under EU Regulations.....</b>	<b>485</b>
<b>3 Relevant GIs under EU Regulations.....</b>	<b>487</b>
3.1 Relevant point in time.....	488
<b>4 Situations Covered by the EU Regulations and Absolute Grounds</b>	
<b>Examination.....</b>	<b>489</b>
4.1 Use of a GI (direct or indirect use).....	490
4.1.1 Exploitation of the reputation of GIs.....	493
4.2 Misuse, imitation or evocation of a GI.....	494
4.2.1 Misuse.....	494
4.2.2 Imitation/evocation.....	494
4.3 Other misleading indications and practices.....	500
4.4 Additional considerations.....	501
4.4.1 Translations.....	501
4.4.2 Use of delocalisers.....	502
4.4.3 Location of the applicant's legal seat.....	503
4.4.4 GIs not known to the public.....	503
4.5 Limits to the scope of protection.....	504
4.5.1 Elements that will not be afforded protection.....	504
4.5.2 Terms commonly used in trade.....	505
4.5.3 Logical and conceptual unit.....	507
4.5.4 Names of countries, regions.....	510
4.6 Trade marks in conflict with two or more GIs.....	513
<b>5 Relevant Goods under EU Regulations.....</b>	<b>517</b>
5.1 Identical products.....	517
5.2 Comparable products.....	518
5.3 Restriction of the list of goods.....	521
<b>6 GIs not Protected under EU Regulations.....</b>	<b>527</b>
6.1 GIs protected at national level in an EU Member State.....	527
6.2 GIs from non-EU countries.....	529
6.3 Relationship with other EUTMR provisions.....	532

## 1 Article 7(j) EUTMR

Article 7(1)(j) EUTMR provides for the refusal of EUTMs that are excluded from registration pursuant to national or EU legislation or to international agreements to which the EU or the Member State concerned is party and that protect designations of origin and geographical indications. When defining the protection given to these specific designations, the relevant regulations refer simply to the protected/registered names, regardless of whether those names refer to a protected designation of origin (PDO) or a protected geographical indication (PGI). Moreover, the scope of protection does not rely on any distinction between PDOs and PGIs, as all the protected names are given the same scope of protection. Therefore, this Chapter will refer to these protected names as Geographical Indications (GIs) without making any distinction between them.

As regards **EU legislation** protecting GIs, the following EU regulations are currently in place:

- Regulation (EU) No 1308/2013 <sup>(12)</sup> in respect of *wines*;
- Regulation (EU) No 251/2014 <sup>(13)</sup> in respect of *aromatised wines*;
- Regulation (EU) 2019/787 <sup>(14)</sup> in respect of *spirit drinks*;
- Regulation (EU) No 1151/2012 <sup>(15)</sup> in respect of *agricultural products and foodstuffs*.

As a consequence, Article 7(1)(j) EUTMR applies where GIs have been registered under the procedure laid down by these EU regulations. Importantly, GIs registered at EU level can originate from both EU Member States and non-EU countries.

Article 7(1)(j) EUTMR also applies to EUTMs that are in conflict with non-EU GIs that enjoy protection in the EU through **international agreements to which the EU is a party** (see paragraph 5.2 below).

The Office interprets the ‘national legislation’ referred to in Article 7(1)(j) EUTMR as relating exclusively to national legislation providing for the protection of GIs in those areas where there is not a uniform and exclusive system of EU protection, namely those areas not covered by the abovementioned EU regulations. For the purposes of these Guidelines, they will be referred to as ‘**non-agricultural GIs**’ (e.g. *handicrafts*).

As regards **international agreements concluded by Member States only**, and by analogy with the Office’s interpretation of Article 7(1)(j) EUTMR as far as national law is concerned, the Office considers that reference to an ‘international agreement to which the Member State concerned is party’ should be interpreted as referring to international

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<sup>12</sup> () Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007.

<sup>13</sup> () Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91.

<sup>14</sup> () Regulation (EU) 2019/787 of the European Parliament and of the Council of 17 April 2019 on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages, and repealing Regulation (EC) No 110/2008.

<sup>15</sup> () Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs. It replaced and repealed Regulation (EC) No 510/2006.

agreements (including the Lisbon Agreement) in areas for which there is no uniform EU protection in place, namely *non-agricultural products* (see paragraph 5.2 below).

## 2 Definition of Geographical Indications under EU Regulations

As regards **wines**, according to Article 93 of Regulation (EU) No 1308/2013:

‘designation of origin’ means the name of a region, a specific place or, in exceptional cases, a country used to describe a *wine* that complies with the following requirements:

1. its quality and characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors;
2. the grapes from which it is produced come exclusively from that geographical area;
3. its production takes place in that geographical area; and
4. it is obtained from vine varieties belonging to *Vitis vinifera*.

‘geographical indication’ means an indication referring to a region, a specific place or, in exceptional cases, a country, used to describe a *wine* that complies with the following requirements:

1. it possesses a specific quality, reputation or other characteristics attributable to that geographical origin;
2. at least 85 % of the grapes used for its production come exclusively from that geographical area;
3. its production takes place in that geographical area; and
4. it is obtained from vine varieties belonging to *Vitis vinifera* or a cross between the *Vitis vinifera* species and other species of the genus *Vitis*.

As regards **aromatised wines**, according to Article 2 of Regulation (EU) No 251/2014, a ‘geographical indication’ means an indication that identifies an *aromatised wine* product as originating in a region, a specific place, or a country, where a given quality, reputation or other characteristics of that product is essentially attributable to its geographical origin.

As regards **spirit drinks**, according to Article 3(4) of Regulation (EU) 2019/787, a ‘geographical indication’ is an indication that identifies a spirit drink as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of that spirit drink is essentially attributable to its geographical origin.

Finally, as regards **agricultural products and foodstuffs**, pursuant to Article 5 of Regulation (EU) No 1151/2012, a ‘designation of origin’ is a name that identifies a product:

1. originating in a specific place, region or, in exceptional cases, a country;
2. whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; and
3. the production steps of which all take place in the defined geographical area.

A ‘geographical indication’ is a name that identifies a product:

1. originating in a specific place, region or country;
2. whose given quality, reputation or other characteristic is essentially attributable to its geographical origin; and
3. of which at least one of the production steps takes place in the defined geographical area.

The difference, where there is one, between PDOs and PGIs is that the former have a **closer link** with the area. In the foodstuffs sector, PDO is the term used to describe foodstuffs that are produced, processed and prepared in a given geographical area using recognised know-how. A PGI indicates a link with the area in at least one of the stages of production, processing or preparation. PDOs therefore have a stronger link with the area.

As already mentioned, this distinction does not affect the scope of protection, which is the same for PDOs and PGIs. In other words, Article 7(1)(j) EUTMR applies equally to all designations covered by Regulation (EU) No 1308/2013 on *wines* and Regulation (EU) No 1151/2012 on *agricultural products and foodstuffs*, regardless of whether they are registered as PDOs or as PGIs. Regulation (EU) 2019/787 on *spirits* and Regulation (EU) No 251/2014 on *aromatised wines*, however, cover only geographical indications (equivalent to PGIs), not PDOs.

In this respect, it must also be underlined that the concept of the GI differs from a ‘**simple indication of geographical provenance**’. For the latter, there is no direct link between a specific quality, reputation or other characteristic of the product and its specific geographical origin, with the result that it does not come within the scope of Article 93 of Regulation (EU) No 1308/2013, Article 2 of Regulation (EU) No 251/2014, Article 3(4) of Regulation (EU) 2019/787 or Article 5(2) of Regulation (EU) No 1151/2012 (07/11/2000, C-312/98, Haus Cramer, EU:C:2000:599, § 43-44; 08/05/2014, C-35/13, Assica and Krafts Foods Italia, EU:C:2014:306, § 30).

For example, ‘Rioja’ is a PDO for *wines* since it designates a *wine* with particular characteristics that comply with the definition of a PDO. However, *wine* produced in ‘Tabarca’ (a ‘simple geographical indication’ designating a small island close to Alicante) cannot qualify for a GI unless it meets specific requirements. Similarly, ‘Queso Manchego’ is a PDO for *cheese* since it designates a product with particular characteristics that comply with the definition of a PDO. However, ‘Queso de Alicante’ (a ‘simple geographical indication’) cannot qualify for a GI since it does not enjoy such characteristics and requirements. Simple geographical indications (such as MONACO or PARIS) can, nonetheless, trigger objections based on Article 7(1)(c) EUTMR — see the Guidelines, Part B, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR).

Protection is granted to GIs in order, inter alia, to protect the **legitimate interests of consumers and producers**. In particular, the specific objectives of protecting designations of origin and geographical indications are to secure a fair return for farmers and producers for the qualities and characteristics of a given product, or of its mode of production, and to provide clear information on products with specific

characteristics linked to geographical origin, thereby enabling consumers to make more informed purchasing choices (see recital 18 of Regulation (EU) No 1151/2012). Moreover, their protection aims to ensure that they are used fairly and to prevent practices liable to mislead consumers (see recital 29 of Regulation (EU) No 1151/2012 and recital 97 of Regulation (EU) No 1308/2013).

### 3 Relevant GIs under EU Regulations

Article 7(1)(j) EUTMR in combination with the EU regulations applies where GIs (either from an EU Member State or from a non-EU country) have been **registered** under the procedure laid down by Regulations No 1308/2013, No 251/2014, 2019/787 and No 1151/2012.

- Relevant information about registered GIs for *wines* can be found in the eAmbrosia database maintained by the Commission, which can be accessed through the internet at <https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/geographical-indications-register/#>. This database also contains information on new wine applications and amendments to registered ones.
- Currently, there are only five GIs for *aromatised wines*: Nürnberger Glühwein, Samoborski bermet, Thüringer Glühwein, Vermouth de Chambéry, Vermouth di Torino <sup>(16)</sup>.
- GIs for *spirit drinks* are listed in Annex III of Regulation (EC) No 110/2008 (Article 15(2) of Regulation (EC) No 110/2008), as amended <sup>(17)</sup>, which can be accessed at [https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:52019XC0327\(02\)&from=EN](https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:52019XC0327(02)&from=EN). Although this regulation was repealed by Regulation (EU) 2019/787, Annex III remains in force until the new register has been established <sup>(18)</sup>. Moreover, the eAmbrosia database also contains information on registered GIs and their applications.
- Relevant information about GIs for *agricultural products and foodstuffs* registered or applied for under Regulation (EU) No 1151/2012 can be found in the DOOR database maintained by the Commission, which can be accessed at <http://ec.europa.eu/agriculture/quality/door/list.html>.

Protection is granted solely to the name of a GI as registered (for example, Article 13(1) of Regulation (EU) No 1151/2012) **and does not extend *ipso iure* to the names of subregions, subdenominations, local administrative areas or localities** in the area covered by that GI. The Office, therefore, does not object under Article 7(1)(j) EUTMR to trade marks consisting, containing, imitating or evoking such geographical names. They may, nonetheless, be protected **outside of the EU** based on an international agreement between the EU and a non-EU country. In this respect,

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<sup>16</sup> () See [http://ec.europa.eu/agriculture/quality/documents-links/pdf/rgi-aromatised-wine-products\\_en.pdf](http://ec.europa.eu/agriculture/quality/documents-links/pdf/rgi-aromatised-wine-products_en.pdf).

<sup>17</sup> () Commission Regulation (EU) 2016/1067 of 1 July 2016 amending Annex III to Regulation (EC) No 110/2008 removed from Annex III those PGIs for which Member States did not submit technical files by the deadline of 20 February 2015, as required under Article 20(1) of Regulation (EC) No 110/2008. A total of 87 PGIs were removed (e.g. Marc de Lorraine, Anis português, anís español, cazalla, Dansk akvavit/Dansk Aquavit, Brandy of Attica).

<sup>18</sup> () See Article 49 of Regulation (EU) 2019/787.

and in particular as regards *wines*, a distinction must be made between the doctrine of the General Court in its judgment of 11/05/2010, T-237/08, Cuvée Palomar, EU:T:2010:185, and the current legal framework. That judgment refers to a system of Member State competencies on the designation of geographical indications for *wines* that existed under previous Regulation (EC) No 1493/1999 but is no longer in force. According to Article 67 of Commission Regulation (EC) No 607/2009 (see also Article 120(1)(g) of Regulation (EU) No 1308/2013), the names of those small geographical areas are now considered merely optional particulars on labels.

### 3.1 Relevant point in time

Article 7(1)(j) EUTMR applies only to GIs that were **applied for** before the EUTM application **and** are **registered** at the time the EUTM application is examined. The relevant dates for establishing the priority of a trade mark and a GI are the date of application of the EUTM application (or what is known as the Paris Convention priority, if claimed) and the date of application for protection of a GI to the Commission respectively.

Notwithstanding the above, and in view of the fact that the vast majority of applications for a GI usually mature into a registration, **an objection will be raised** when the GI was applied for **before** the filing date (or the priority date, if applicable) of the EUTM application **but** had not yet been registered at the time of examining the EUTM application. However, if the EUTM applicant indicates that the GI in question has not yet been registered, the proceedings will be suspended, after consulting the applicant, pending the outcome of the registration procedure of the GI.

Therefore, **no objection will be raised** under Article 7(1)(j) EUTMR when the GI was applied for **after** the filing date (or priority date, if applicable) of the EUTM application. The relevant dates for establishing priority of the GI are the following.

- For *wines*, all relevant information can be found in eAmbrosia, including the registration date and access to the Single Document and the Product Specification for GIs already in existence on 01/08/2009, the date on which the first register was set up. For any GIs for *wines* applied for subsequently, eAmbrosia also includes the application and publication date as well as a reference to publication in the Official Journal.
- For *aromatised wines*, the initial publication of Annex II of Regulation (EEC) No 1601/91 contained all GIs for *aromatised wines* that existed on 17/06/1991, the date of entry into force of that regulation. For any GIs for *aromatised wines* added subsequently, the corresponding amendment of the regulation contains the relevant information.
- Similarly, for *spirit drinks*, the initial publication of Annex III of Regulation (EC) No 110/2008 contained all GIs for *spirit drinks* that existed on 20/02/2008, the date of entry into force of the protection of the GI concerned in the country of origin. For any GIs for *spirit drinks* added subsequently, the corresponding amendment of the regulation contains the relevant information. Although Regulation (EC) No 110/2008



was repealed by Regulation (EU) 2019/787, Annex III remains in force until the new register has been established <sup>(19)</sup>.

- Details of the date of application and registration for GIs for *agricultural products and foodstuffs* are available in the DOOR database.

## 4 Situations Covered by the EU Regulations and Absolute Grounds Examination

The EU regulations refer, *mutatis mutandis*, to different situations of ‘use’ against which GIs are protected:

1. any use of a GI (direct or indirect):
  - a. in respect of products not complying with the product specification of a GI; or
  - b. insofar as such use exploits the reputation of a GI;
2. any misuse, imitation or evocation;
3. any other false or misleading indications or practices.

However, when applying Article 7(1)(j) EUTMR, and for the purposes of the absolute grounds examination, the situations listed above are further restricted in accordance with the **relevant provisions governing conflicts with trade marks** as shown in the following paragraphs.

As regards *wines*, according to Article 102(1) of Regulation (EU) No 1308/2013, the registration of a trade mark that contains or consists of a GI that does not comply with the product specification concerned or the use of which falls under Article 103(2) of that Regulation, and that relates to **a product falling under one of the categories listed in Part II of Annex VII** must be refused if the application for registration of the trade mark is submitted after the date of submission of the application for protection of the designation of origin or geographical indication to the Commission and the designation of origin or geographical indication is subsequently protected.

As regards *aromatised wines*, according to Article 19(1) of Regulation (EU) No 251/2014, the registration of a trade mark, the use of which falls under Article 20(2) of that Regulation and relates to **an aromatised wine product** must be refused if the application for registration of the trade mark is submitted after the date of submission of the application for protection of the geographical indication to the Commission and the geographical indication is subsequently protected.

As regards *spirit drinks*, according to Article 36(1) of Regulation (EU) 2019/787, ‘the registration of a trade mark the use of which corresponds or would correspond to one or more of the situations referred to in Article 21(2) shall be refused or invalidated’.

Finally, as regards *agricultural products and foodstuffs*, according to Article 14(1) of Regulation (EU) No 1151/2012, ‘[w]here a designation of origin or a geographical indication is registered under this Regulation, the registration of a trade mark the use of which would contravene Article 13(1) and which relates to **a product of the same type** shall be refused if the application for registration of the trade mark is submitted after the

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<sup>19</sup> () See Article 49 of Regulation (EU) 2019/787.

date of submission of the registration application in respect of the designation of origin or the geographical indication to the Commission’.

For further information on the relevant point in time see paragraph 3.1 above.

In light of the above provisions, **three cumulative conditions** must be met for Article 7(1)(j) EUTMR in combination with the EU regulations to apply.

1. The GI in question must be registered at EU level (see paragraph 3 above).
2. Use of the EUTM must constitute one of the situations provided for in Article 103(2) of Regulation (EU) No 1308/2013, Article 20(2) of Regulation (EU) No 251/2014, Article 21(2) of Regulation (EU) 2019/787 or Article 13(1) of Regulation (EU) No 1151/2012 (see paragraphs 4.1 to 4.3 below).
3. The EUTM application must include relevant goods, as provided above. (For objectionable goods see paragraph 5 below).

#### 4.1 Use of a GI (direct or indirect use)

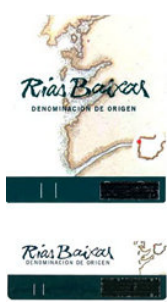

As a preliminary remark, ‘direct and indirect use’ need to be defined/interpreted. According to the Court (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 32), direct and indirect use merely refer to the physical manner in which the use of a GI appears on the market: ‘direct use’ implies that the GI is affixed directly to the product or its packaging, while ‘indirect use’ requires the GI to feature in supplementary marketing or information sources, such as an advertisement for the product or documents relating to it. This distinction plays no role for the absolute grounds assessment, as the Office is not concerned with the subsequent placing on the market of the mark proposed for registration.

For the purpose of finding whether or not there is use of a GI, the Office will assess whether an EUTM **contains** a GI as a whole or a term that could be considered **phonetically and/or visually highly similar thereto**. According to the Court, ‘the word “use” ... requires, by definition, that the sign at issue make use of the protected geographical indication itself, in the form in which that indication was registered or, at least, in a form with such close links to it, in visual and/or phonetic terms, that the sign at issue clearly cannot be dissociated from it.’ (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 29).

The following EUTMs are considered to fall under Article 7(1)(j) EUTMR since they make use of a GI.

GI	EUTM	
<b>CHAMPAGNE</b> (PDO-FR-A1359)	<b>CHAMPAGNE VEUVE DEVANLAY</b> (EUTM No 11 593 381)	

GI	EUTM
<p><b>BEAUJOLAIS</b> (PDO-FR-A0934)</p>	 <p>(EUTM No 1 561 646)</p>
<p><b>DRESDNER CHRISTSTOLLEN</b> (DE/PGI/005/0704)</p>	 <p>(EUTM No 5 966 668)</p>
<p><b>LISBOA</b> (PGI-PT-A1535)</p>	 <p>(EUTM No 17 945 350)</p>
<p><b>POMEROL</b> (PDO-FR-10273)</p>	 <p>(EUTM No 17 889 185)</p>

GI	EUTM
<b>RIAS BAIXAS</b> (PDO-ES-A1119)	 (EUTM No 17 067 141)
<b>OPORTO</b> (PDO-PT-A1540)	 (EUTMs No 11 907 334 and No 2 281 970)
<b>JAGNIĘCINA PODHALAŃSKA</b> (PL/PGI/0005/00837)	<b>JAGNIĘCINA Z PODHALA</b> (invented example) Adjective in the PGI → Noun in the EUTM
<b>IBIZA</b> (PGI-ES-A0110)	<b>IBICENCO</b> (invented example) Noun in the PGI → Adjective in the EUTM

Under Article 7(1)(j) EUTMR, it is irrelevant whether or not the other word or figurative elements may give the trade mark distinctive character. The sign can be acceptable as a whole under Article 7(1)(b) and (c) EUTMR and can still be objected to (as in the cases above) under Article 7(1)(j) EUTMR.

If the mark consists solely of the GI, the EUTM also falls under **Article 7(1)(c) EUTMR**, since it is considered descriptive both of the geographical origin of the goods and of their quality. This means that the Office's objection will **simultaneously** raise absolute grounds for refusal under both Article 7(1)(c) and (j) EUTMR.

While **restricting the relevant goods** (to comply with the specifications of the GI) is usually a means of waiving the objection under Article 7(1)(j) EUTMR (see paragraph 5 below), it is irrelevant for Article 7(1)(c) EUTMR.

For example, an application for the word mark 'Bergerac' for *wines* will simultaneously be objected to under both Article 7(1)(c) and (j) EUTMR: it consists solely of the PDO 'Bergerac' and is therefore descriptive. If the goods are subsequently limited to *wines* complying with the specifications of the PDO 'Bergerac', the objection under Article 7(1)(j) EUTMR will be waived but the trade mark will still be descriptive and can be objected to under Article 7(1)(c) EUTMR.

There must be a **logical separation of the GI from the rest of the term** for it to be identifiable and liable to objection. A trade mark will not be liable to objection when it contains the GI as part of a word element that does not bring to the consumer's mind the product whose designation is protected. This is normally the case when the term has its own meaning.

Examples where an objection should not be raised: TORONTO (it does not evoke the PDO 'Toro'), EXCAVADORA (it does not evoke the PDO 'Cava'), IMPORT (it does not evoke the PDO 'Port').

Examples where an objection was raised: 18/11/2014, R 2462/2013-2, TOROLOCO (fig.) and 20/01/2014, R 1900/2013-5, PARMATUTTO. See also IR No 1 384 844 MEZCALOSFERA DE MEZCALOTECA (fig.), received on 18/01/2018, against which an objection was raised.

On the limits to the scope of protection see paragraph 4.4 below.

#### 4.1.1 Exploitation of the reputation of GIs

According to Article 103(2)(a) of Regulation (EU) No 1308/2013, Article 20(2)(a) of Regulation (EU) No 251/2014, Article 21(2)(a) of Regulation (EU) 2019/787 and Article 13(1)(a) of Regulation (EU) No 1151/2012, registered names are protected against use that exploits the reputation of the protected name. This protection extends even to different products (12/06/2007, T-53/04 – T-56/04, T-58/04 & T-59/04, Budweiser, EU:T:2007:167, § 175) and to services.

However, as regards *wines*, the scope of such protection must be read in line with the mandate contained in Article 102 of Regulation (EU) No 1308/2013, which limits the **refusal of trade marks** to the grapevine products listed in its Annex VII, Part II. As regards *aromatised wines*, Article 19 of Regulation (EU) No 251/2014 limits the refusal to trade marks relating to an *aromatised wine product*. For *agricultural products and foodstuffs*, Article 14 of Regulation (EU) No 1151/2012 limits the refusal of trade marks to products 'of the same type'. For *spirit drinks*, Regulation (EU) 2019/787 does not contain any specific provision in this respect, but the Office interprets this Regulation following the same systematic approach.

In light of the foregoing, the Office considers that, **in the context of examining absolute grounds for refusal**, the protection of GIs under all EU regulations cannot extend to all possible products. The protection is limited to:

- goods identical to the product covered by the GI, including when such goods constitute the *specific object* of services such as *retail, wholesale, import/export, transportation and provision of drink and food, production of [the product covered by the GI] for others*;
- goods comparable to the product covered by the GI;
- goods in which the GI is a relevant ingredient.

For further information on objectionable goods see paragraph 5 below.

However, the extended scope of protection of a GI can be invoked in the context of Article 8(6) EUTMR (see the Guidelines, Part C, Opposition, Section 4, Other Earlier Rights, Chapter 2, Geographical Indications (Rights under Article 8(6) EUTMR)).

## 4.2 Misuse, imitation or evocation of a GI

Neither the EUTMR nor the EU regulations define the meaning of ‘misuse’, ‘imitation’ or ‘evocation’.

### 4.2.1 Misuse

In the absence of any guidance from the Court, the Office considers that an EUTM ‘misuses’ a GI when it provides false indications as to the geographical source of the goods, with the result that it benefits from the perceived quality of the GI.

The Office understands the concept of ‘misuse’ as covering both misuse by the mere fact that an application is being filed and misuse due to use of the trade mark in trade.

‘Misuse’ due to use in trade is more difficult to establish in an absolute grounds for refusal examination. The Office’s examination is an *ex parte* assessment, which normally takes place before the applicant has actually used the trade mark. Therefore, in most cases, it would be difficult for the Office to establish that the trade mark actually ‘misuses’ the GI.

### 4.2.2 Imitation/evocation

The mark ‘imitates’ (mimics, reproduces elements of, etc.), with the result that the product designated by the GI is ‘evoked’ (called to mind). The term ‘evocation’ requires less than ‘imitation’ or ‘misuse’ (17/12/1998, C-87/97, Cambozola, EU:C:1998:614, § 33). Nevertheless, the Office considers the terms ‘imitation’ and ‘evocation’ as two corollaries of essentially the same concept.

Moreover, there is ‘imitation’, in the common meaning of the term, where the trade mark is ‘intended to simulate or copy something else’, here the earlier GI (see decision of 30/11/2018, R 0251/2016-1, § 135). By contrast, ‘evocation’ is objective. There is no need to show that the owner of the mark intended to evoke the earlier GI.

According to the Court, the decisive criterion for finding ‘evocation’ is whether, **‘when the consumer is confronted with a disputed designation, the image triggered directly in his mind is that of the product whose geographical indication is protected’** (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 51; 04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 25; 26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117, § 44; 21/01/2016, C-75/15, Viiniverla, EU:C:2016:35, § 21). Consumers must **establish a sufficiently clear and direct link** between the term used to designate the product and the product whose name is protected (21/01/2016, C-75/15, Viiniverla, EU:C:2016:35, § 22; 07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 53). At the same time, it is necessary to take

account of **the presumed expectation of the average consumer**, who is reasonably well informed and reasonably observant and circumspect. In particular, it is not enough if the term incorporated in the trade mark application evokes in the relevant public **some kind of association** with the protected geographical indication or the area relating thereto, because such association does not necessarily establish a sufficiently clear and direct link between that element and the indication concerned (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 53). It is important to emphasise that the finding of evocation is never automatic. There may be no evocation even if the EUTM incorporates part of the GI or if a visual and aural similarity and conceptual proximity is established. What has to be found is that the relevant public establishes a **sufficiently clear and strong link** between the element of the EUTM and the GI, with the result that, upon encountering the EUTM, the image triggered directly in the public's mind is that of the product whose geographical indication is protected.

According to the Advocate General (17/12/1998, C-87/97, Cambozola, EU:C:1998:614, § 33), 'the term "evocation" is **objective**, so that it is not necessary to show that the owner of the mark intended to evoke the protected name'.

Importantly, the EU regulations protect geographical indications and denominations of origin throughout the territory of the European Union. As a result, the Court has ruled that, in order to guarantee effective and uniform protection of GIs in that territory, **the concept of the consumer must be considered to cover European consumers** and not merely consumers of the Member State in which the product giving rise to a possible evocation of the GI is manufactured (21/01/2016, C-75/15, Viiniverla, EU:C:2016:35, § 27; 07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 59). Taking the Viiniverla case as an example, the possible evocation of the GI 'Calvados' by a Finnish manufacturer of a cider spirit named Verlados has to be assessed on the basis of a number of criteria (see below) with respect to European consumers, not only Finnish consumers. Likewise, in the 'Scotch Whisky' case, the Court of Justice held that the fact that the disputed designation referred to a place of manufacture that was known to consumers in the Member State where the product was manufactured was irrelevant for the purpose of assessing evocation, since GIs are protected throughout the territory of European Union and all European consumers must be included in that exercise (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 59).

Furthermore, in the 'Scotch Whisky' case, the Court of Justice held that phonetic and visual similarity between the disputed designation and the GI is not an essential condition for establishing that there is an evocation; it is only one of the factors to be taken into account. Therefore, in the absence of any phonetic or visual similarity or partial incorporation of the GI in the trade mark applied for, the examination of evocation must take into account also any **conceptual proximity** between the GI and the disputed designation in the trade mark applied for.

There may be evocation where the EUTM contains an element that is **visually, aurally or conceptually similar** to the protected GI. This extends to the figurative elements of a sign, as confirmed by the Court of Justice, should those elements trigger directly in the consumer's mind the products whose names are registered (02/05/2019, C-614/17, Queso Manchego, ECLI:EU:C:2019:344, § 22 and 32). In both instances, that of

conceptual proximity or evocation through figurative elements, the finding of evocation will be extremely rare on the Office's part because, as a matter of principle, evocation of the earlier GI is unlikely if there is no visual or aural similarity whatsoever between the earlier GI and the disputed element.

As indicated above, according to the Court (04/03/1999, C-87/97, *Cambozola*, EU:C:1999:115; 26/02/2008, C-132/05, *Commission v Germany*, EU:C:2008:117; 21/01/2016, C-75/15, *Viiniverla*, EU:C:2016:35, § 21, cited above), the EUTM must trigger in the consumer's mind the image of the product whose designation is protected, in the sense that a link is established.

Importantly, evocation is **not assessed in the same way as likelihood of confusion**. Therefore, it is irrelevant whether a likelihood of confusion can be established or not in order to find that there is evocation of the GI. As the Court has held, there can be 'evocation' even in the absence of any likelihood of confusion. What matters, in particular, is that an association of ideas regarding the origin of the products is not created in the mind of the public, and that a trader does not take undue advantage of the reputation of the protected geographical indication (21/01/2016, C-75/15, *Viiniverla*, EU:C:2016:35, § 45). For evocation, **a link must be made with the product whose designation is protected**. Therefore, whether or not there is evocation will not be analysed according to the principles laid down by the Court in its judgment of 11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528.

In assessing whether such a link is established, the Court has considered the following factors:

- whether there is a **visual, phonetic or conceptual relationship** between the terms:
  - e.g. if the terms share a characteristic beginning, such as *Parmesan/Parmigiano Reggiano* (26/02/2008, C-132/05, *Commission v Germany*, EU:C:2008:117);
  - e.g. if the terms share characteristic roots or endings that have no particular meaning, such as in *Gorgonzola/Cambozola* (04/03/1999, C-87/97, *Cambozola*, EU:C:1999:115) and *Verlados/Calvados* (21/01/2016, C-75/15, *Viiniverla*, EU:C:2016:35);
  - e.g. if the terms share the same number of letters or syllables, such as *Gorgonzola/Cambozola* (04/03/1999, C-87/97, *Cambozola*, EU:C:1999:115);
  - e.g. where there is conceptual proximity, such as between *Parmesan* and *Parmigiano Reggiano* (26/02/2008, C-132/05, *Commission v Germany*, EU:C:2008:117, § 47); this includes situations where there is conceptual proximity but no visual or phonetic similarity (07/06/2018, C-44/17, *SCOTCH WHISKY*, EU:C:2018:415, § 56).
- **the degree of proximity of the goods concerned**, including the actual physical appearance or the ingredients and taste of the products covered by the EUTM and the GI (04/03/1999, C-87/97, *Cambozola*, EU:C:1999:115, § 27). The fact that the goods are comparable does not, as such, lead automatically to the evocation of the GI. However, if the goods concerned are identical, this is an element in support of evocation (see paragraph 4.2 above).
  - For instance, the expression 'POLISH TASTE' for *vodka* evokes the GI 'Polish vodka'. However, the Office considers that the expression 'POLISH TASTE' for






*whisky* does not evoke the PGI *Polish vodka*, considering the differences between whisky and vodka. In other words, given the differences between whisky and vodka (e.g. different characteristics, ingredients and taste) and the fact that the PGI ‘Polish vodka’ is not fully reproduced in the trade mark, the relevant consumers will not establish a link between a bottle of whisky marketed under the trade mark ‘POLISH TASTE’ and vodka protected by the designation ‘Polish vodka’.

- Similarly, the expression ‘M. MÜLLER — ECHTE BAYERISCHE QUALITÄT VON BODENSEE’ [M. Müller — Real Bavarian Quality from Lake Constance] for *beef* evokes the GI ‘Bayerisches Rindfleisch’ (beef from Bavaria). However, the Office considers that the same expression for *poultry* will not evoke the GI ‘Bayerisches Rindfleisch’. The Office considers that even if these are all ‘meat products’, when account is taken of the differences between beef and poultry and the fact that the GI ‘Bayerisches Rindfleisch’ is not fully reproduced in the trade mark, the relevant consumers will not establish a link between poultry meat marketed under the trade mark ‘M. MÜLLER — ECHTE BAYERISCHE QUALITÄT VON BODENSEE’ and beef protected by the designation ‘Bayerisches Rindfleisch’.
- the fact that the **context surrounding the element under assessment is not to be taken into account** (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 60). In particular, the fact that the EUTM contains indications of the true origin of the product or what are known as ‘delocalisers’ are not factors that will weigh against a finding of evocation (see 4.4 et seq.).



The Office does not consider that a claim to the widespread reputation of a specific GI (or evidence thereof) is one of the factors to be taken into account in establishing evocation. The assessment of whether the public will establish a sufficiently clear and direct link between the element in the sign and the GI concerned should be based on equal knowledge by the public of all protected GIs. As indicated above under paragraph 4.1.1, the Office will assess any claim relating to exploitation of a GI’s reputation by the use of the trade mark in the context of Article 8(6) EUTMR.

#### *Examples of where evocation was found*

GI	EUTM	Explanation
SCOTCH WHISKY	 <p>(EUTM No 15 420 607)</p>	The country name Scotland is a noun that evokes the adjective ‘Scotch’, which forms part of the PGI ‘Scotch Whisky’.

<p><b>LYGOURIO ASKLIPIOU</b> (EL/PDO/0017/0050)</p>	 (EUTM No 15 510 721)	<p>The term 'ASKLIPIOU', which forms part of the PDO 'Lygourgio Asklipiou', is the genitive case of the noun 'ASKLEPIOS' (or 'ASKLIPIOS'), which appears in the nominative case in the contested EUTM. The genitive case denotes, inter alia, origin and possession and in this case evokes the PDO. The figurative element is a visual repetition of the term as it consists of a typical representation of the ancient Greek god Asclepios.</p>
<p><b>PORC DE NORMANDIE</b> (FR/PGI/0017/0192) <b>VOLAILLES DE NORMANDIE</b> (FR/PGI/0017/0154) <b>CAMEMBERT DE NORMANDIE</b> (FR/PDO/0017/0112)</p>	 (EUTM No 17 772 401)	<p>The term Normandy will be linked with the French term 'Normandie'.</p>
<p><b>CHAMPAGNE</b> (PDO-FR-A1359)</p>	 (EUTM No 17 962 122)	<p>The word element in the later trade mark can be seen as phonetically and visually similar to the term Champagne and will have to be assessed for evocation.</p>
<p><b>IRISH POTEEN</b> <b>IRISH WHISKEY</b> <b>IRISH CREAM</b></p>	<p><b>Irish Monk</b> (EUTM No 017 496 308)</p>	<p>Reference to 'Irish' as seen in this later trade mark will have to be assessed for evocation against the registered GIs containing the same term.</p>
<p><b>TIERRA DEL VINO DE ZAMORA</b> (PDO-ES-A0634)</p>	 (EUTM No 17 009 127)	<p>The term Zamora is clearly visible in both the GI and the later trade mark, and an assessment for evocation will have to be carried out.</p>

*Examples of where evocation was not found*

GI	EUTM	Explanation
<b>VINHO VERDE</b> (PDO PDO-PT-A1545)	<b>VERDI</b> EUTM No 15 080 278	<p>Due to the clear conceptual meaning of the designation 'VERDI', the relevant public will not be led to believe that the aforementioned designation depicts the PDO in question.</p> <p>The presence of a partial correlation in the present case between the terms 'VERDI' on the one hand, and 'VERDE' on the other, is not sufficient to offset the fact that the consumer of the goods in question will perceive the sign 'VERDI' as a clear reference to the Italian opera composer.</p> <p>(06/04/2017, R 1972/2016-5, VERDI, § 12 and 14)</p>
<b>CAPE GIRARDEAU COUNTY</b> (Non-EU-country PGI (United States of America))	 EUTM No 16 081 614	<p>The mark contains the term 'craft beer'. Therefore, it is unlikely that it will be perceived as evoking a PGI relating to wine.</p> <p>Moreover, 'Cape' by itself is not, on its own, the significant part of the PGI. Therefore, in order to evoke the PGI, reference to the other geographically significant part of the PGI (e.g. 'Girardeau') is necessary.</p>
<b>ROSEÉ DES PYRENEES CATALANES</b> (MULTI/PGI/0005/01343)	 EUTM No 17 371 063	<p>The fact that the trade mark contains the generic term Rosée, does not in itself lead to an evocation of the PGI referred to.</p>

<p><b>LAVILLEDIEU</b> (PGI-FR-A1136)</p>	<p>Laville Pavillon EUTM No 10 961 785</p>	<p>The mere reference to Laville is not sufficient to trigger in the public's mind a link with the GI Lavilledieu. As many municipalities start with the term 'Laville', this term is commonly used and no direct link can be established with any particular GI product.</p>
<p><b>ISOLA DEI NURAGHI</b> (PGI-IT-A1140) <b>S. ANNA DI ISOLA CAPO RIZZUTO</b> (PDO-IT-A0629)</p>	 EUTM No 17 626 664	<p>'ISOLA BIANCA' means 'WHITE ISLAND'. Although 'ISOLA' appears in the GIs 'Isola dei Nuraghi' and 'S. Anna di Isola Capo Rizzuto', the term 'ISOLA' cannot by itself evoke those GIs as the term 'ISOLA' itself is a common term referring merely to an island as such.</p>
<p><b>PORTOFINO</b> (PDO-IT-A0355)</p>	 EUTM No 17 960 157	<p>The mark contains the term 'gin'. Therefore, it is unlikely that it will be perceived as evoking a PDO relating to wine.</p> <p>The EUTM is acceptable since the logical and conceptual unit translates as gin from Portofino, which precludes the evocation of the PDO, as a new distinct conceptual unit emerges for the European public.</p>

### 4.3 Other misleading indications and practices

Article 103(2)(c) and (d) of Regulation (EU) No 1308/2013, Article 20(2)(c) and (d) of Regulation (EU) No 251/2014, Article 21(2)(c) and (d) of Regulation (EU) 2019/787 and Article 13(1)(c) and (d) of Regulation (EU) No 1151/2012 protect PDOs/PGIs against a number of false or misleading indications about the origin, nature or essential qualities of products.

In the 'Scotch Whisky' judgment, the Court (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 61-71) addressed the issue of misleading indications. There are two points to be considered:

- an indication may be considered misleading if it includes information, inter alia in the form of words or an image, that is **capable of providing information** on the provenance, origin, nature or essential qualities of that product (§ 66);
- **the context** in which the possible misleading indication is used is not to be taken into account (§ 63).

The Office would, therefore, have to establish whether or not an indication (an element in the trade mark) is 'liable to convey a false impression as to [the product's] origin' (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 66-67) or to the nature or essential qualities of the product (20/12/2017, C-393/16, CHAMPAGNE, EU:C:2017:991, § 64).

Given the inherent difficulty in identifying and assessing such possible indications, the Office will rely principally on observations by third parties.

Nevertheless, it should be borne in mind that this situation of 'misleading indications and practices' will mainly refer to cases where the term/'indication' is already assessed under the ground of either use, misuse, imitation or evocation as part of the absolute grounds examination. As the Court found in the 'CHAMPAGNE' case, use of a PDO 'Champagne' might simultaneously fall under 'use' and be considered 'a misleading indication' (20/12/2017, C-393/16, CHAMPAGNE, EU:C:2017:991, § 53, 63).

## 4.4 Additional considerations

When applying Article 7(1)(j) EUTMR, the mere fact that the GI is used in translation or that there is a 'delocaliser' in the EUTM will be considered irrelevant. EU regulations with respect to GIs clearly and explicitly refer to such 'uses' as prohibited. Where the applicant has its legal seat is likewise irrelevant for the purposes of applying Article 7(1)(j) EUTMR. Additionally, the argument that a GI is not known to the relevant public cannot succeed against an objection under Article 7(1)(j) EUTMR.

### 4.4.1 Translations

The protection conferred on a GI applies 'even if' the protected indication is used in a translated form. It is therefore irrelevant whether or not the disputed name constitutes an exact translation of the protected GI (26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117, § 47).

On the one hand, it follows that the fact that a disputed name contained in an EUTM is a translation of a protected GI cannot be raised as a valid defence by the applicant or proprietor. On the other hand, this implies that the Office will object to translations of GIs **only to the extent** that the translation amounts to use, misuse or evocation of a GI. Accordingly, no objection will be raised if the translation at issue does not trigger a sufficiently clear and direct link in the consumer's mind with a product whose designation is protected.

For instance, the Office will not object under Article 7(1)(j) EUTMR to the term 'BULL' just because it is, strictly speaking, the English equivalent to the Spanish word 'TORO'

—‘TORO’ is a Spanish PDO for wines from the region of Toro. Once translated, the geographical reference and hence the link with the particular product is immediately lost as, in this particular case, the term ‘bull’ would not convey any link with the PDO ‘Toro’.

GI	EUTM	Explanation
<b>BOURGOGNE</b>	 EUTM No 2417269	‘Borgoña’ is the Spanish translation of the French PDO ‘Bourgogne’.
<b>PÂTES D'ALSACE</b> (FR/PGI/0005/0324)	<b>ALSATIAN PASTA</b> (invented example)	An EUTM that contains the expression ‘Alsatian Pasta’ will be considered as ‘using’ the PGI ‘Pâtes d’Alsace’.

Trade marks consisting of these translated terms must be refused under both Article 7(1)(c) and (j) EUTMR rather than solely under Article 7(1)(c) EUTMR.

#### 4.4.2 Use of delocalisers

According to Article 103(2)(b) of Regulation (EU) No 1308/2013, Article 20(2)(b) of Regulation (EU) No 251/2014, Article 21(2)(b) of Regulation (EU) 2019/787 and Article 13(1)(b) of Regulation (EU) No 1151/2012, GIs are protected ‘even if ... the protected name is ... accompanied by an expression such as “style”, “type”, “method”, “as produced in”, “imitation” ... or similar’.

Therefore, the fact that the GI reproduced or evoked in the EUTM is accompanied by these expressions does not rule out application of Article 7(1)(j) EUTMR.

In other words, **even if the public is thereby informed about the actual origin of the product, an objection will still be raised** under Article 7(1)(j) EUTMR. Notwithstanding this, the trade mark will be **misleading** under Article 7(1)(g) EUTMR since there is a contradiction between the goods (restricted to the specific GI) and the message conveyed by the mark (that the goods are not ‘genuine’ GI products), which will thus necessarily lead to a further objection under that Article.

PDO/PGI	EUTM (invented examples)	Explanation

<b>RIOJA</b> (PDO-ES-A0117)	<b>RIOJA STYLE RED WINE</b>	An EUTM that contains an expression such as 'Rioja Style Red Wine' will be considered unacceptable even if it conveys the idea that the product in question is not a 'genuine' PDO Rioja wine.
<b>FETA</b> (EL/PDO/0017/0427)	<b>GREEK STYLE PLAIN FETA</b> <b>ARABIAN FETA</b>	An EUTM that contains expressions such as 'Greek Style Plain Feta' or 'Arabian Feta' will be considered unacceptable even if it conveys the idea that the product in question is not a 'genuine' PDO Feta <i>cheese</i> .

#### 4.4.3 Location of the applicant's legal seat

Where the applicant has its legal seat is irrelevant for assessing Article 7(1)(j) EUTMR. Article 103(1) of Regulation (EU) No 1308/2013, Article 20(1) of Regulation (EU) No 251/2014 and Article 12(1) of Regulation (EU) No 1151/2012 set out that GIs may be used by any operator marketing a product that conforms to the corresponding specification. Hence, provided that the goods comply with the specification of the GI in question (which is guaranteed by restricting the goods appropriately), **the location of the applicant's legal seat as indicated in the EUTM application is irrelevant**. For example, a company with legal domicile in Poland can own a vineyard located in Spain that produces *wine* complying with the product specification of the PDO 'Ribera del Duero'. Similarly, a company with legal domicile in Lithuania can own a factory located in Spain that prepares products complying with the PGI 'Chorizo de Cantimpalos'.

#### 4.4.4 GIs not known to the public

Any contention that the protected GI reproduced in or evoked by the EUTM is unknown to the relevant public or has no reputation must be dismissed as irrelevant. This is in particular because the reputation of a GI is not a condition for its protection (02/02/2017, T-510/15, TOSCORO, EU:T:2017:54, § 48). It has to be understood as absolute protection given to any registered GI name. The starting premise of the assessment under Article 7(1)(j) EUTMR is that every registered GI is, as a fact, known to the relevant public as a GI.

This also stems, more fundamentally, from the essential function of a GI, which is to guarantee to consumers the geographical origin of the goods and the specific qualities inherent in them (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 147). For more on inherent reputation of a GI in terms of quality, see Guidelines, Part C, Opposition,

Section 4, Other Earlier Rights, Chapter 2, Geographical Indications (Rights under Article 8(6) EUTMR). The Court has already confirmed that the system of registration for GIs ‘seeks to contribute [...] not only to the prevention of deceptive practices and the attainment of market transparency and fair competition, but also to the attainment of a high level of consumer protection’. Therefore, what the Office will take into account is the presumed reaction/expectation of the average consumer, who is reasonably well informed and reasonably observant and circumspect (21/01/2016, C-75/15, Verlados, EU:C:2016:35, § 24-25).

## 4.5 Limits to the scope of protection

### 4.5.1 Elements that will not be afforded protection

If a GI contains more than one element within its name (i.e. the indication of a type of a product and the geographical reference, or a grape variety and the geographical reference), some of which would be considered **descriptive or generic**, protection does not extend to the descriptive/generic element (see Article 13(1) of Regulation (EU) No 1151/2012 *in fine* and judgment of 12/09/2007, T-291/03, Grana Biraghi, EU:T:2007:255, § 58, 60).

#### 4.5.1.1 Descriptive elements within the meaning of Article 7(1)(c) EUTMR

No objection will be raised to the mere fact that an EUTM contains a descriptive element that is part of a GI. Examples include the GIs ‘Maçã de Alcobaça’ (‘maçã’ is the Portuguese word for apple) and ‘Jambon d’Ardenne’ (‘jambon’ is the French word for ham).

Where the descriptive nature of an element in a GI can be determined by standard dictionary definitions, the perspective of the public in the country of origin of the GI is determinative. For instance,

it suffices that the term ‘maçã’ will be perceived by Portuguese-speaking consumers as denoting a fruit for it to be concluded that it is descriptive, regardless of whether or not it can be understood by other parts of the public in the European Union.

By contrast, where no definition can be found in a standard, well-known dictionary, the descriptive nature of the term in question should be assessed following the criteria laid down by the Court, such as relevant national and EU legislation, how the term is perceived by the public, and circumstances relating to the marketing of the product in question (26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117; 12/09/2007, T-291/03, Grana Biraghi, EU:T:2007:255).

#### 4.5.1.2 Generic terms within the meaning of Regulation (EU) No 1151/2012

Pursuant to Article 3(6) of Regulation (EU) No 1151/2012, “generic terms” means the names of products which, although relating to the place, region or country where the




product was originally produced or marketed, have become the common name of a product in the Union.'

The terms 'camembert' and 'brie' have been referred to as examples of generic terms by the Court of Justice (26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117, § 36). See the PDOs Camembert de Normandie (FR/PDO/0017/0112), Brie de Meaux (FR/PDO/0017/0110) and Brie de Melun (FR/PDO/0017/0111).

Other examples are 'cheddar' and 'gouda' (see Regulation (EC) No 1107/96, footnotes to the PDOs 'West Country Farmhouse Cheddar' and 'Noord-Hollandse Gouda').

When terms have been declared to be 'generic' by the EU judicature or legislation, no objection will be raised. The following 'cheese' references are considered generic in the EU: brie, camembert, cheddar, edam, emmental and gouda (see [https://ec.europa.eu/commission/presscorner/detail/en/IP\\_96\\_153](https://ec.europa.eu/commission/presscorner/detail/en/IP_96_153)).


GI	EUTM
(none, because 'camembert' is not a geographical indication, but a generic term)	 <p>(EUTM No 7 389 158)</p>

#### 4.5.2 Terms commonly used in trade

In addition, if a GI contains or evokes a term that is **commonly used in trade** (and is **not** protected as a **traditional term for wine** or as a **traditional speciality guaranteed**) to designate the goods concerned, objections should not automatically be raised against trade marks referring to that term (e.g. 'Torre', see judgments of 18/12/2008, T-287/06, Torre Albéniz, EU:T:2008:602, § 58; 11/07/2006, T-247/03, Torre Muga, EU:T:2006:198, § 57). In particular, the Office will assess whether, by including the terms in the sign, the image triggered in the mind of the consumer is that of the product whose designation is protected.

GI	EUTM	Explanation
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<p><b>CASTELLÓ (PGI)</b> for <i>wines</i></p>	<p><b>CASTELL DE LA BLEDA</b> for <i>wines</i> EUTM No 14 202 808</p>	<p>In the <i>wine</i> sector, the term ‘castello’ (without accent, castle in Italian) is frequently used.</p> <p>It is considered that the term ‘CASTELL’ does not constitute, strictly speaking, an evocation of the PGI in question. While it is admitted that the difference is only in one letter, terms such as ‘castillo/castello’, ‘torre’, etc. are commonly used in the presentation of <i>wines</i>. In view of this, it is unlikely that the relevant consumers would associate the EUTM in question with the <i>wines</i> protected under the PGI. It is rather more likely that they will first make an immediate association with a common term in the marketing of <i>wines</i>.</p>
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GI	EUTM	Explanation
<p><b>CAVA (PDO)</b> for <i>wines</i></p>	 <p>EUTM No 11 345 824 for <i>wines</i></p>	<p><b>T-774/16</b> <b>(12/07/2018, EU:T:2018:441, § 37-67)</b></p> <p>The reference to ‘CAVE’ in the trade mark will not trigger a link with the PDO ‘CAVA’ as, considering the other elements of the trade mark and in particular the inherent meaning of the terms ‘CAVA/CAVE’ in Spanish and French as referring to ‘a wine cellar’, the possibility of evocation of the PDO ‘CAVA’ is precluded following a global assessment.</p>

### 4.5.3 Logical and conceptual unit

Objections should not be raised because of the mere presence of a GI in a trade mark application if that mark, taken as a whole, forms a logical and conceptual unit, the meaning of which, in relation to the products concerned, neither evokes nor imitates the earlier GI.

Even the Court has confirmed that ‘possible information capable of indicating that the visual and phonetic relationship between the two names is not fortuitous’ should be taken into account (21/01/2016, C-75/15, *Verlados*, ECLI:EU:C:2016:35, § 39-40). Therefore, similarity between terms may have occurred by chance as use of a term may be justified linguistically, irrespective of its similarity to the registered GI. For example, words in different languages may have a similar visual or phonetic appearance, but nothing more in common due to their inherent meaning.

When assessing the possible use/evocation of a GI within an EUTM, the fact that some GIs may have an inherent meaning distinct from the reference to a geographical place will be taken into account.

On the basis of the criteria mentioned above, a GI that coincides with **surnames or family names** is, when used in combination with other elements, unlikely to remind the relevant consumer of the product protected under the relevant GI. Again, objections should not automatically be raised just because of the presence of a GI term in the trade mark. For instance, the term ‘Leon’ is included in the PDO ‘Tierra de León’ and the PGI ‘Castilla y León’, both for *wines*. However, in combination with a first name, it is more likely to be perceived as a family name rather than an indication of geographical origin (25/04/2012, R 2274/2011-4, *MICHEL LEON*).


The term ‘Lorenzo’ is included in the PDO ‘Castel San Lorenzo’ for *wines*. However, in combination with other elements, it is more likely to be perceived as a first name rather than an indication of geographical origin. See EUTM No 14 095 228 *Organic Casa Lorenzo* (fig.).

The assessment is to take into account the perception of the relevant public when it comes to logical and conceptual units that should not be artificially dissected.

In a case concerning a conflict between the trade mark application *PORT CHARLOTTE* for *whisky* and the earlier PDO ‘PORTO’ (or its English translation, ‘Port wine’), the General Court, in a judgment confirmed by the Court of Justice, held that the sign *PORT CHARLOTTE*, read as a whole as a logical and conceptual unit, would be understood by the relevant public as designating a harbour named after a person called Charlotte, with no direct link being made with the PDO ‘porto’ or ‘port’ or port wine. Even though the term ‘port’ forms an integral part of the contested mark, the average consumer, even if he or she is of Portuguese origin or speaks Portuguese, will not, on encountering a *whisky* bearing that mark, associate it with a port wine covered by the designation of origin in question (18/11/2015, T-659/14, *PORT CHARLOTTE*, EU:T:2015:863, § 71; 14/09/2017, C-56/16 P, *PORT CHARLOTTE*, EU:C:2017:693, § 124).

In some cases, the goods applied for may play a decisive role as well.


The 'logical and conceptual unit' approach will lead to no objection in examples such as these below:

GI	EUTM	Explanation
ALBA (PDO) for <i>wines</i>	 <p><b>DANIEL ALBA</b> B O D E G A S</p> <p>EUTM No 14 955 736 for <i>wines</i></p>	The reference to 'ALBA' in the trade mark will not trigger a link with the PDO 'ALBA' as, considering the other elements of the trade mark and in particular the common first name 'Daniel', it is likely to be understood as a surname.

GI	EUTM	Explanation
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<p><b>PORTO (PDO)</b> for <i>wines</i></p>	<p><b>PORT CHARLOTTE</b> EUTM No 5 421 474 for <i>whisky</i></p>	<p><b>C-56/16 P</b>  (14/09/2017, PORT CHARLOTTE, EU:C:2017:693, §§ 115-116, 124)  § 115 ‘The incorporation in a trade mark of a name which is protected under Regulation No 1234/2007, such as the designation of origin ‘port’, cannot be held to be capable of exploiting the reputation of that designation of origin, for the purposes of Article 118m(2)(a)(ii) of that regulation, if that incorporation does not lead the relevant public to associate that mark or the goods in respect of which it is registered with the designation of origin concerned or the wine product in respect of which it is protected.’  § 116 ‘[...] that the sign ‘PORT CHARLOTTE’, since it consists of the term ‘port’ and the first name Charlotte, will be perceived by the relevant public as a logical and conceptual unit referring to a harbour, that is to say a place situated on the coast or on a river, with which a first name, which constitutes the most important and most distinctive element in the contested mark, is associated. According to the General Court, the relevant public will not perceive, in that sign, any geographical reference to the port wine covered by the designation of origin in question.’  § 124 ‘The General Court, without erring in law, applied the fundamental criterion deriving from that case-law, by holding, in paragraph 76 of the judgment under appeal, that, having regard to the findings set out in paragraph 71 of that same judgment, even though the term ‘port’ forms an integral part of the contested mark, the average consumer, even if he is of Portuguese origin or speaks Portuguese, in reaction to a whisky bearing that mark, will not associate it with a port wine covered by the designation of origin in question.’</p>
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GI	EUTM	Explanation
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<p><b>Penisola Sorrentina (PDO)</b> for <i>olive oil</i></p> <p><b>Limone di Sorrento (PGI)</b> for <i>lemons</i></p>	 <p>EUTM No 17 887 237</p> <p>for goods in Classes 29, 30 and services in Class 35</p>	<p>The EUTM is acceptable because the logical and conceptual unit translates as 'Dairy factory in/of Sorrento', which precludes the evocation of the two GIs and is a new distinct conceptual unit for the Italian public. For the part of the public that does not understand this unit, other elements of the mark will be overwhelmingly different to those of the two GIs, with the result that there will be no evocation.</p>
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#### 4.5.4 Names of countries, regions

There are a number of GIs for *spirit drinks* where the geographically significant part of the GI **refers to a whole country**, for example: *Polska Wódka/Polish Vodka*; *Suomalainen Vodka/Finsk Vodka/Vodka of Finland*; *Svensk Vodka/Swedish Vodka*; *Original Lithuanian vodka*; *Estonian vodka*; *Brandi italiano*; *Irish whiskey*.

Such GIs deserve the protection afforded by Regulation (EU) 2019/787. However, the Office considers that the geographical part of the GIs is indissolubly linked to the remaining elements of the GI. In this sense, protection of the GIs does not automatically extend to prohibitions of use of the name of the country or of its adjective for **any** spirit drink or, more broadly, any alcoholic beverage.

Consequently, when examining EUTMs applied for in respect of goods in Class 33 *alcoholic beverages* that include a term referring to a particular country (e.g. Finland) or its adjective (e.g. Finnish) in connection with which there is a registered GI (e.g. *Vodka of Finland*), the Office considers that the inclusion of the country reference or its adjective in the EUTM triggers in the consumer's mind a link with the product whose designation is protected only for **products of the same category** (e.g. *vodka*) and not for comparable goods.

GI	EUTM	Explanation
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<p><b>Vodka of Finland</b></p>	<p><b>FINNISH TASTE</b> (fig.) for alcoholic beverages (invented example)</p>	<p>The EUTM is acceptable for <i>vodka</i> complying with the specifications of the PGI 'vodka of Finland'; <i>vodka-based beverages</i> complying with the specifications of the PGI 'Vodka of Finland' and for any other <b>specific</b> alcoholic beverages, for instance:</p> <p><i>vodka</i> complying with the specifications of the PGI 'Vodka of Finland'; <i>beverages based on or containing vodka</i> complying with the specification 'Vodka of Finland'; <i>whisky</i>.</p> <p><i>alcoholic beverages except vodka and beverages based on or containing vodka</i>.</p> <p>The following limitation is, however, <b>not acceptable</b>: <i>vodka</i> complying with the specifications of the PGI 'Vodka of Finland'; <i>other alcoholic beverages</i>.</p> <p>The reference to 'other alcoholic beverages' would include vodka that does not comply with the GI specifications.</p>
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There are also GI names that, for example, all protect the same type of product, and whose names refer to different areas within a greater region.

GI	EUTM	Explanation
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<b>Alpes-de-Haute-Provence (PGI)</b> <b>Coteaux d'Aix-en-Provence (PDO)</b> <b>Coteaux Varois en Provence (PDO)</b> <b>Côtes de Provence (PDO) Les Baux de Provence (PDO)</b> All for <i>wines</i>	<b>Memories of Provence</b> for alcoholic beverages (invented example)	No objection will be raised as it would be difficult to establish a sufficiently clear and direct link with a particular <i>wine</i> . It follows from market reality that many products (in this example other <i>wines</i> ) are produced within a particular region, but not all references to a particular region are to be seen as use of references to a GI.
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GI	EUTM	Explanation
<b>Huile d'olive de Haute-Provence (PDO)</b> <b>Huile d'olive d'Aix-en-Provence (PDO)</b> Both for <i>olive oils</i>	<b>Taste of Provence</b> applied for edible oils (invented example)	No objection will be raised as it would be difficult to establish a sufficiently clear and direct link with a particular <i>olive oil</i> . It follows from market reality that many agricultural products (in this example other <i>olive oils</i> ) are produced within a particular region, but not all references to a particular region are to be seen as use of references to a GI.

Should an EUTM include an element that simply refers to a broader region, no objection will be raised, in principle, as it would be difficult to establish a sufficiently clear and direct link with a particular product. It follows from market reality that many agricultural products are produced within a particular region, but not all references to a particular region are to be seen as use of references to a GI. Nevertheless, this will not preclude an objection being raised under Article 7(1)(c) EUTMR, depending on the other elements in the EUTM.

Some of the examples might include references such as 'Agricoltori di Toscana'/'Tuscan farmers', or 'biodiversita di Sicilia'/'Sicilian biodiversity', whereby the use of 'Tuscany' and 'Sicily' is understood as a simple geographical reference to the region and not as a qualified GI, which would point to a specific product.

According to the case-law, 'some kind of association with the protected geographical indication or the geographical area relating thereto - cannot be used [as justification for an objection], as it does not establish a sufficiently clear and direct link between that element and the indication concerned' (07/06/2018, C-44/17, SCOTCH WHISKY,



EU:C:2018:415, § 53). Should such an element be present within an EUTM, it will be considered a simple reference to a geographical provenance, and not to a GI.

For the use of ‘geographical terms’ see the Guidelines, Part B, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR).

## 4.6 Trade marks in conflict with two or more GIs


In some cases an EUTM application may constitute use or evocation of more than one GI at the same time. This is likely to happen when the EUTM application contains an element (not a generic one) that appears in more than one GI.

In these cases, provided that the EUTM application covers the relevant goods, an objection should be raised for all the GIs.


1. Where there is use/evocation of two or more GIs relating to **clearly distinct geographical areas, irrespective of the GI products, limitation of the goods will not be possible, and the application will be refused.**
2. Where there is use/evocation of two or more GIs relating to **overlapping geographical areas and the goods are identical**, the objection may (to the extent possible under relevant EU regulations) be overcome by limiting the goods to the smaller geographical area (e.g. in the wine sector, it is common to find smaller geographical areas being protected as a GI within a bigger geographical area which is also a GI). In such cases, limitation to ‘a smaller GI’ will not be seen as a conflict with the other geographical reference as, under the labelling rules, both references may co-exist on the label. The Office will always rely on the applicant to provide justification in such cases. Where the goods are different, the objection can be overcome by limiting the goods to the respective GIs if use/evocation is established.
3. Where there is use of two or more GIs relating to **the same geographical area**, the objection can be overcome by limiting the goods to respective GIs and by deleting the deceptive goods. Where two or more GIs relate to the same product, the applicant may be allowed to limit the goods to one, several or all of the GIs.

*Examples of situation No 1*

GI	EUTM	Explanation
<b>RIOJA</b> (PDO-ES-A0117) <b>SANTIAGO</b> (Chilean PGI) both for <i>wines</i>	<b>RIOJA</b> <b>SANTIAGO</b> for <i>wines</i>	<p>RIOJA SANTIAGO</p> <p>(28/04/2010, R 53/2010-2)</p> <p>The trade mark applied for consists of the terms 'RIOJA' and 'SANTIAGO', each of which coincides with a PDO for <i>wines</i>, the former (RIOJA) being protected by the European Union and the latter (SANTIAGO), a geographical indication for a <i>wine</i> originating from Chile, being protected under a bilateral agreement between the European Union and the Republic of Chile.</p> <p>It is not possible to accept any limitation that includes <i>wine</i> originating from the territory of one of the two designations of origin since such a limitation automatically excludes <i>wines</i> originating from the other designation of origin, which inevitably means that the trade mark applied for will lead to confusion. By the same token, a hypothetical limitation of the list of goods to <i>wine</i> from the geographical area covered by either of the designations of origin, e.g. '<i>wines</i> from the Rioja designation of origin and <i>wines</i> from the Santiago designation of origin', in Class 33, would be covered by the prohibition of Article 7(1)(j) EUTMR insofar as the trade mark would inevitably — and confusingly — identify <i>wines</i> with a geographical origin other than that of the respective designations of origin included under the trade mark. Preventing such an eventuality is the principal purpose of that Article.</p>

GI	EUTM	Explanation
<b>MOJAMA DE BARBATE</b> (ES/PGI/005/01211) <b>MOJAMA DE ISLA CRISTINA</b> (ES/PGI/005/01210)	 EUTM No 16 842 254 for <i>mojama</i>	<p>'Mojama de Barbate' and 'Mojama de Isla Cristina' are two different PGIs for 'mojama', the major difference being geographical origin (Cádiz and Huelva, respectively).</p> <p>It is not possible to accept any limitation that includes 'mojama' originating from the territory of one of the two PGIs since such a limitation automatically excludes 'mojama' originating from the territory of the other PGI, which inevitably means that the trade mark applied for will lead to confusion.</p>

### Examples of Situation No 2

GI	EUTM	Explanation
<b>CÔTES DU RHÔNE</b> (PDO-FR-A0325)  <b>VACQUEYRAS</b> (PDO-FR-A0151)	  EUTM No 17 917 599 for <i>wines</i>	<p>A limitation can be introduced for the smaller GI. The public will not be deceived as to the geographical origin of the products as this is allowed by the labelling rules.</p> <p>Class 33: <i>Wine</i> complying with the specifications of the protected designation of origin 'Vacqueyras'.</p>

### Examples of situation No 3

GI	EUTM	Explanation
<b>TORO</b> (PDO-ES-A0886)  <b>QUESO ZAMORANO</b> (ES/PDO/0017/0089)	<b>TORO ZAMORANO</b>  for <i>wines</i> and <i>cheese</i>	<p>Toro is a region within the province of Zamora. The sign reproduces in its entirety the PDO 'Toro' and uses part of the PDO 'Queso Zamorano'.</p> <p>A limitation should be introduced for both <i>wines</i> complying with the PDO 'Toro' and <i>cheese</i> complying with the PDO 'Queso Zamorano'. PDO 'Queso Zamorano'.</p>

GI	EUTM	Explanation
<b>Sobrasada de Mallorca (PGI)</b> (type of processed <i>meat</i> product)  <b>Ensaimada de Mallorca (PGI)</b> (type of pastry)	<b>MALLORCA SUN</b>  (invented) for Class 29 <i>meat</i> , <i>eggs</i> and <i>milk</i> and Class 30 <i>bread</i> , <i>pastry</i> .	<p>A limitation can be introduced for both PGIs. The public will not be deceived as to the geographical origin of the products.</p> <p>Class 29: <i>meat</i> complying with the specifications of the PGI 'Sobrasada de Mallorca'; <i>eggs</i>; <i>milk</i>.</p> <p>Class 30: <i>bread</i>, <i>pastry</i> complying with the specifications of the PGI 'Ensaimada de Mallorca'.</p>

GI	EUTM	Explanation
<p><b>Champagne (PDO)</b> for <i>wine</i></p> <p><b>Ratafia de Champagne (PGI)</b> for <i>liqueur</i></p> <p><b>Cognac de Champagne (PGI)</b> for <i>wine spirit</i></p> <p><b>Marc de Champagne (PGI)</b> for <i>grape marc spirit</i></p>	<p><b>AXM</b> <b>CHAMPAGNE</b> for <i>alcoholic beverages</i> in Class 33</p>	<p>The application can be accepted if a limitation is introduced for one or several GIs. Depending on the outcome of such limitation, the other goods will be assessed under Article 7(1)(g) EUTMR.</p> <p>Even if the spirit drinks protected by the various GIs concerned are comparable among themselves, a limitation is acceptable for each of them, as the application includes the common term 'Champagne' protected for various types of spirit drinks.</p> <p>For example, Class 33: <i>wines</i> complying with the specifications of the PDO 'Champagne'; <i>liqueur</i> complying with the specifications of the PGI 'Ratafia de Champagne'; <i>wine spirits</i> complying with the specifications of the PGI 'Cognac de Champagne'; <i>grape marc spirit</i> complying with the specifications of the PGI 'Marc de Champagne'.</p> <p>If the EUTM application includes in full a different GI with the term 'Champagne' (e.g. AXM RATAFIA DE CHAMPAGNE), it can be accepted if the goods are properly limited (only to this GI).</p> <p>For example, Class 33: <i>liqueur</i> complying with the specifications of the PGI 'Ratafia de Champagne'.</p>

GI	EUTM	Explanation
<p><b>Prosciutto di Modena (PDO)</b></p> <p><b>Zampone di Modena (PGI)</b></p> <p><b>Cotechino di Modena (PGI)</b></p>	<p><b>AXM</b> <b>MODENA</b> (invented) for <i>meat</i> in Class 29</p>	<p>The application can be accepted if a limitation is introduced for one or various PGIs/DPOs and the deceptive goods are deleted.</p> <p>For example, <i>ham</i> complying with the specification of the PDO 'Prosciutto di Modena', <i>zampone</i> complying with the specification of the PGI 'Zampone di Modena' and <i>cotechino</i> complying with the specification of the PGI 'Cotechino di Modena'. The rest of the <i>meat</i> products are deleted.</p> <p>Even if the products concerned protected by various GIs, are comparable, a limitation can be introduced in relation to all of them, as the application includes the common term 'MODENA', which is protected for various types of meat products.</p> <p>A limitation such as <i>meat</i> complying with the specifications of the PDO 'Prosciutto di Modena' is not acceptable.</p>

GI	EUTM	Explanation
<b>Orujo de Galicia (PGI)</b> for <i>grape marc spirit or grape marc</i> <b>Licor café de Galicia (PGI)</b> for <i>liqueur</i> <b>Licor de hierbas de Galicia (PGI)</b> for <i>liqueur</i> <b>Aguardiente de hierbas de Galicia (PGI)</b> for <i>other spirit drinks (aguardiente de hierbas)</i>	<b>AXM GALICIA</b> for <i>alcoholic beverages</i> in Class 33	<p>All spirits are comparable. The application can be accepted if a limitation is introduced for one or various PGIs/DPOs and the deceptive goods are deleted (i.e. all other spirit drinks; however, <i>wines</i> are acceptable).</p> <p>For example, Class 33: <i>grape mark spirit or grape mark</i> complying with the specifications of the PGI 'Orujo de Galicia'; <i>liqueur</i> complying with the specifications of the PGI 'Licor café de Galicia'; <i>liqueur</i> complying with the specifications of the PGI 'Licor de hierbas de Galicia'; <i>aguardiente de hierbas</i> complying with the specifications of the PGI 'Aguardiente de hierbas de Galicia'; <i>wines</i>.</p> <p>If the EUTM application fully includes one of the GIs with the term 'Galicia' (e.g. AXM ORUJO DE GALICIA), it can be accepted if the goods are properly limited.</p> <p>For example, Class 33: <i>grape mark spirit or grape mark</i> complying with the specifications of the PGI 'Orujo de Galicia'.</p>

## 5 Relevant Goods under EU Regulations

Objections based on Article 7(1)(j) EUTMR can be raised **only** for specific goods of the EUTM application, namely those that are identical or 'comparable' to ones covered by the GI. The Office does not raise objections *ex officio* against different goods.

### 5.1 Identical products

Identifying the specific products that are covered by a GI can be a complex exercise.

The products covered by a GI protected under Regulation (EU) No 1308/2013 are all for *wine*.

The products covered by a GI protected under Regulation (EU) No 251/2014, refer to various types of *aromatised wines* (e.g. Glühwein, vermouth).

Regarding GIs for *spirit drinks*, protected under Regulation (EU) 2019/787, the category of products covered corresponds to one of the categories in Annex I of that Regulation (e.g. *rum*, *whisky*, *grain spirit*, *wine spirit*, etc.). They are further specified in the 'product category' that appears in the eAmbrosia database. For instance, Polish Cherry is protected for *liqueur*, Cognac for *wine spirit* and Scotch Whisky for *whisky*.

The products covered by a GI protected under Regulation (EU) No 1151/2012 mostly refer to *foodstuffs and beverages* in Classes 29, 30, 31 and 32. However, there are a number of exceptions. For example:

- Class 3: *essential oils* (e.g. Bergamotto di Reggio Calabria);
- Class 22: *wool* (e.g. native Shetland wool);
- Class 31: *flowers and ornamental plants* (e.g. Flemish laurier) or *hay* (e.g. Foin de Crau).

Importantly, the product covered by the GI is the one specified in the description of the product in the Official Journal publication containing the application for registration. The DOOR database includes a link to this publication (C series). This product should not be confused with the product class under which the DOOR database classifies the GI.

For instance, the PGI ‘Welsh Beef’ only covers ‘beef’ but is classified in DOOR under ‘Class 1.1. Fresh meat (and offal)’. Similarly, the PDO ‘Pomme du Limousin’ only covers ‘apples’ but is classified in DOOR under ‘Class 1.6. Fruit, vegetables and cereals fresh or processed’. Whether products other than ‘beef’ or ‘apples’ are acceptable for registration is a different assessment (see paragraph 5.2 below).

The applicant may overcome the objection by restricting the list of goods. This is further explained in paragraph 5.3 below.

Apart from the exact products that a GI refers to, the Office will raise an objection to any other goods in which the GI product can be seen as the **commercially relevant ingredient**.

Finally, the Office will raise an objection when identical goods constitute the *specific object* of services such as *retail, wholesale, import/export, transportation and provision of drink and food, production of [the product covered by the GI] for others*. Any objection and subsequent limitation of the goods will be duly reflected in the services for which protection is sought, should the EUTM refer to those same goods as part of its specification of services.

For example, if an EUTM refers in its elements to the PDO ‘Slavonski med’ (‘med’=‘honey’) and seeks protection for goods in Class 30 — *honey* and also for services in Class 35 — *retail services relating to honey*, the objection and subsequent limitation of ‘*honey* complying with the specifications of the PDO “Slavonski med”’ will have to be reflected in both Classes 30 and 35.

## 5.2 Comparable products

GIs are protected not only as regards trade marks applied for in respect of identical products to the product covered by the GIs but also, under certain circumstances, as regards those applied for in respect of **comparable products**.

Importantly, **while GI protection against comparable goods is automatic in situations of direct or indirect use of GIs, there is no such automatic protection in cases of evocation**. As explained in paragraph 4.2 above, consumers must also **establish a link** between the term used to designate the product (i.e. the trade mark)

and the product whose designation is protected. In establishing the link, the **degree of proximity of the products** is one of the factors to be taken into account. As a consequence, it is necessary to assess, given all the relevant factors, whether a link will be established in the mind of the relevant public. See paragraph 4.2 above for more details.

The EU GI regulations contain references to **different expressions**, all interpreted by the Office as synonyms of comparable goods.

Specifically for *wines*, the different terms used in Articles 102(1) and 103(2) of Regulation (EU) No 1308/2013 ('product falling under one of the categories listed in Part II of Annex VII' and 'comparable products', respectively) are interpreted by the Office as synonyms referring to the same concept. For ease of reference, the categories listed in Part II of Annex VII can be grouped into: (i) *wine*; (ii) *sparkling wine*; (iii) *grape must*; (iv) *wine vinegar*.

For *aromatised wines*, Article 19(1) of Regulation (EU) No 251/2014 refers to products relating to 'an aromatised wine product'. According to Article 3(1) of the Regulation, *aromatised wine* products are obtained from the *wine* sector as referred to in Regulation (EU) No 1308/2013 that have been flavoured. They are classified into the following categories: *aromatised wines*; *aromatised wine-based drinks*; and *aromatised wine-product cocktails*.

For *spirit drinks*, Regulation (EU) 2019/787 does not specify anything in this regard.

For *agricultural products and foodstuffs*, the different terms used in Articles 13 and 14 of Regulation (EU) No 1151/2012 ('comparable' products, and products 'of the same type' respectively) are interpreted by the Office as synonyms referring to the same concept.

The notion of **comparable goods must be understood restrictively and is independent of the analysis of similarity between goods in trade mark law**. Accordingly, the criteria set out in the judgment of 29/09/1998, C-39/97, Canon, EU:C:1998:442, should not necessarily be adhered to, although some of them may be useful. For example, given that a GI serves to indicate the geographical origin and the particular qualities of a product, criteria such as the nature of the product or its composition are more relevant than, for instance, whether or not goods are complementary.

In particular, the CJEU (14/07/2011, C-4/10 & C-27/10, BNI Cognac, EU:C:2011:484, § 54) has developed certain criteria for determining whether goods are comparable, specifically whether **the products have common objective characteristics, such as method of elaboration, physical appearance of the product or use of the same raw materials**.

In addition, factors such as whether the products are consumed, from the point of view of the relevant public, on **largely identical occasions**, or whether they are **distributed** through the same channels and/or subject to similar marketing rules, can be taken into account in order to **confirm** whether goods are comparable.

Although it is not possible in these Guidelines to list all the possible scenarios, the following are some examples of comparable products.

Products covered by the PDO/PGI	Comparable products
<i>Wine</i>	<p>All types of <i>wines</i> (including <i>sparkling wine</i>); <i>grape must</i>; <i>aromatised wines</i>.</p> <p>See Part II of Annex VII Regulation (EU) No 1308/2013.</p> <p><i>Wine vinegar</i>; <i>wine-based beverages</i> (e.g. <i>sangría</i>) are not ‘comparable products’, but the wine covered by the GI can be a commercially relevant ingredient; see below under ‘Products used as ingredients’.</p>
<i>Aromatised wines</i>	<p>All types of <i>wines</i>; <i>aromatised wines</i> (e.g. <i>vermouth</i>).</p> <p><i>Aromatised wine-based drinks</i> (e.g. <i>sangría</i>); and <i>aromatised wine-product cocktails</i> (e.g. <i>sparkling wine cocktail</i>). are not ‘comparable products’, but the wine covered by the GI can be a commercially relevant ingredient; see below under ‘Products used as ingredients’.</p>
<i>Spirits</i>	<p>All types of <i>spirits</i>.</p> <p><i>Spirit-based drinks</i> are not ‘comparable products’, but the spirit drink covered by the GI can be a commercially relevant ingredient; see below under ‘Products used as ingredients’.</p>
<i>Fresh fruit</i>	<p><i>Preserved, frozen, dried and cooked fruits</i> (<i>jellies, jams, compotes</i>) are not ‘comparable products’, but the fruit covered by the GI can be a commercially relevant ingredient; see below under ‘Products used as ingredients’.</p>
<i>Fresh vegetables</i>	<p><i>Preserved, frozen, dried and cooked vegetables</i> (<i>jellies, jams</i>) are not ‘comparable products’, but the vegetable covered by the GI can be a commercially relevant ingredient; see below under ‘Products used as ingredients’.</p>

Depending on the specific goods, the applicant may overcome an objection against comparable goods by restricting the list of goods. This is further explained in the next paragraph.



### 5.3 Restriction of the list of goods

According to Article 103(1) of Regulation (EU) No 1308/2013 and Article 20(1) of Regulation (EU) No 251/2014, GIs may be used by any operator marketing a *wine* or *aromatised wine* conforming to the corresponding specification.

According to Article 12(1) of Regulation (EU) No 1151/2012, ‘protected designations of origin and protected geographical indications may be used by any operator marketing [an *agricultural or foodstuff*] product conforming to the corresponding specification’.

Objections raised under Article 7(1)(j) EUTMR may be waived if the relevant goods are restricted to comply with the specifications of the GI in question.

Restricting goods can be a complex task, which may depend to a large extent on a case-by-case examination.

- **Products identical** to those covered by the GI must be restricted in order to meet the specifications of the GI. The proper wording is ‘[type of product] complying with the specifications of the [PDO ‘X’]/PGI ‘X’]’. No other wording should be proposed or allowed. Restrictions such as ‘[type of product] with the [PDO ‘X’]/PGI ‘X’]’ or ‘[type of the product] originating in [name of a place]’ are not acceptable.

GI in the EUTM	Acceptable list of goods
<b>Slovácká</b> (PDO-CZ-A0890)	<i>Wine</i> complying with the specifications of the PDO ‘Slovácká’.
<b>WELSH BEEF</b> (UK/PGI/0005/0057)	<i>Beef meat</i> complying with the specifications of the PGI ‘Welsh Beef’.
<b>TEQUILA</b>	<i>Agave spirit drinks</i> complying with the specifications of the PGI ‘Tequila’.

The category of products that includes those covered by the GI should be restricted as follows:

- For *wines* and *aromatised wines*, the restriction should designate *wines* and *aromatised wines* that comply with the specifications of the GI. The category of products is found in the Extract from the E-Bacchus Register under ‘registered as’.
- For spirit drinks, the restriction should designate the exact category of product (e.g. whisky, rum, fruit spirit, in accordance with Annex III of Regulation (EC) No 110/2008) that complies with the specifications of the GI. Although this regulation was repealed by Regulation (EU) 2019/787, Annex III remains in force until the new register has been established <sup>(20)</sup>.
- For agricultural products and foodstuffs, the category of products that includes those covered by the GI should be restricted to designate exactly the products covered by

<sup>20</sup> () See Article 49 of Regulation (EU) 2019/787.

the GI and complying with its specifications. The category of products that includes those covered by the GI in question can be consulted in the DOOR database. The exact product covered can be found in the application document attached to the publication in the Official Journal (C series), also accessible through DOOR.

PDO/PGI in the EUTM	Original specification (not acceptable)	Acceptable list of goods	Explanation
<b>TOKAJI</b> (PDO-HU-A1254)	<i>Wines</i>	<i>Wine</i> complying with the specifications of the PDO 'Tokaji'.	The EUTM can be accepted only for <i>wine</i> covered by the PDO.
<b>WELSH BEEF</b> (UK/PGI/0005/0057)	<i>Meat</i>	<i>Beef meat</i> complying with the specifications of the PGI 'Welsh Beef'.	' <i>Meat</i> ' includes products (e.g. pork) that cannot comply with the specifications of a particular PDO/PGI that covers the specific product <i>beef meat</i> .
<b>POMME DU LIMOUSIN</b> (FR/PDO/0005/0442)	<i>Fruits</i>	<i>Apples</i> complying with the specifications of the PDO 'Pomme du Limousin'.	The category <i>fruits</i> includes products such as <i>pears</i> or <i>peaches</i> , which cannot meet the specifications of a PDO that exclusively covers apples.

- **Comparable products** — An objection **must be raised** for comparable goods when they cannot be part of the restriction, for example when the goods applied for, although 'comparable', do not include the product covered by the PDO/PGI.

PDO/PGI in the EUTM	Original specification (not acceptable)	Acceptable list of goods	Explanation
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<p><b>MOSLAVINA</b> (PDO-HR-A1653)</p>	<p><i>Alcoholic beverages</i> (except <i>beers</i>)</p>	<p>e.g. <i>wine and beverages based on or containing wine</i> complying with the specifications of the PDO 'Moslavina'; <i>spirits, rum</i> (examples). e.g. <i>alcoholic beverages other than wines and beverages based or containing wine.</i></p>	<p>The EUTM can be accepted for <i>wine</i> complying with the specifications of the PDO, and for <i>beverages based on or containing wine</i> complying with the specifications of the PDO. Alternatively, <i>alcoholic beverages other than wines, and wine-based beverages</i> are acceptable to the extent that they are not deceptive.</p>
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<p><b>RIOJA</b> (PDO-ES-A0117)</p>	<p><i>Wine, spirits</i></p>	<p><i>Wine</i> complying with the specifications of the PDO '<i>Rioja</i>'.</p>	<p>The EUTM can be accepted for <i>wine</i> complying with the specifications of the PDO.</p> <p>The EUTM can, in principle, be accepted under Article 7(1)(j) EUTMR for <i>spirits</i> as they are not considered comparable to <i>wine</i>.</p>
<p><b>POMME DU LIMOUSIN</b> (FR/PDO/0005/0442)</p>	<p><i>Preserved, frozen, dried and cooked fruits</i></p>	<p><i>Preserved, frozen, dried and cooked apples</i> complying with the specifications of the PDO '<i>Pomme du Limousin</i>'.</p>	<p><i>Preserved, frozen, dried and cooked fruits</i> includes products made of other fruits, which cannot meet the specifications of a PDO that exclusively covers <i>apples</i>.</p> <p>Note also that the limitation should be not only for <i>apples</i>, but also for <i>processed apples</i>. The EUTM can, in principle, be accepted under Article 7(1)(j) EUTMR for other specific frozen fruits to the extent that they are not deceptive.</p>

<b>BRANDY DE JEREZ</b>	<i>Spirits; brandy; whisky</i>	<i>Brandy</i> complying with the specifications of the PGI 'Brandy de Jerez'.	<p><i>Whisky</i> is a category of spirit drinks that is considered comparable to the spirit drink category <i>brandy</i>.</p> <p>At the same time, <i>whisky</i> cannot meet the specifications set for <i>brandy</i>.</p> <p>As a result, the category of <i>spirits</i> must be narrowed down to the product protected by the PGI 'Brandy de Jerez', namely to <i>brandy</i>. The EUTM application must be refused for <i>whisky</i>, as being comparable to <i>brandy</i>, and for the general category of <i>spirits</i>, as all <i>spirits</i> are considered comparable.</p>
<b>SCOTCH WHISKY</b>	<i>Whisky; alcoholic beverages</i>	<i>Whisky</i> complying with the specifications of the PGI 'Scotch whisky'.	<p>The EUTM can be accepted for <i>whisky</i> complying with the specifications of the GI.</p> <p>Contrary to the situation for GIs for wines, the limitation cannot be extended to <i>alcoholic beverages other than whisky</i> as it may include alcoholic beverages comparable to <i>whisky</i>. It is up to the applicant to specifically list the non-deceptive and non-comparable spirit drinks.</p>

- **Products used as ingredients:** if the goods covered by the GI can be used as a commercially relevant ingredient (in the sense that it may determine the choice of the main product) of any of the goods included in the EUTM application, a restriction will be requested. This is because Article 13(1)(a) and (b) of Regulation (EU) No 1151/2012 expressly extend the scope of protection of a GI registered for a given product 'when those products are used as an ingredient'.

GI in the EUTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
<b>POMME DU LIMOUSIN</b> (FR/PDO/0005/0442)	<i>Jams and compotes</i>	<i>Jams and compotes of apples</i> complying with the specifications of the PDO 'Pomme du Limousin'.	The <i>fruit</i> is the main ingredient of <i>jams and compotes</i> .
<b>PROSCIUTTO DI PARMA</b> (IT/PDO/0117/0067)	<i>Pizzas</i>	<i>Pizzas with ham</i> complying with the specifications of the PDO 'Prosciutto di Parma'.	This topping is the main ingredient of a <i>pizza</i> and the one that determines the consumer's choice.
<b>RIOJA</b> (PDO-ES-A0117)	<i>Wine vinegar</i>	<i>Wine vinegar made from wine</i> complying with the specifications of the PDO 'Rioja'.	The EUTM can be accepted for <i>wine vinegar</i> complying with the specifications of the PDO. Wine is an ingredient of <i>vinegar</i> (wine vinegar is made of wine).
<b>TURRÓN DE AGRAMUNT</b> (ES/PGI/0005/0167)	<i>Ices</i>	<i>Nougat-based edible ices</i> complying with the specifications of the PGI 'Turrón de Agramunt; Torró d'Agramunt'.	'Turrón' is a commercially relevant ingredient for ice creams.
<b>BERGAMOTTO DI REGGIO CALABRIA-OLIO ESSENZIALE</b> (IT/PDO/0005/0105)	<i>Perfumes</i>	<i>Perfumes with Bergamot</i> complying with the specifications of the PDO 'Bergamotto di Reggio Calabria — Olio essenziale'.	Bergamot is an essential oil that provides a particular aroma to perfume. This aroma is what drives the consumers' choice and is thus the commercially relevant ingredient.

GI in the EUTM	Original specification (which is not acceptable)	Acceptable list of goods	Explanation
<b>SCOTCH WHISKY</b>	<i>Cocktails.</i>	<i>Cocktails containing whisky complying with the specifications of the PGI 'Scotch Whisky'.</i>	The EUTM can be accepted for cocktails made of whisky complying with the specifications of the GI.  Contrary to wines, <i>cocktails, other than whisky-based</i> are not acceptable to the extent that they may be deceptive.

A restriction is not necessary if the goods covered by the GI are used as a secondary, not commercially relevant, ingredient of the claimed goods.

GI in the EUTM	Original specification	Acceptable list of goods	Explanation
<b>ACEITE DE LA ALCARRIA</b> (ES/PDO/0005/0562)	<i>Pastry</i>	<i>Pastry</i>	The goods do not need to be restricted by the mere fact that <i>oil</i> is used in their preparation. <i>Oil</i> is a secondary ingredient that is not commercially relevant.

## 6 GIs not Protected under EU Regulations

### 6.1 GIs protected at national level in an EU Member State

The Court of Justice has stated (08/09/2009, C-478/07, Budějovický Budvar, EU:C:2009:521) that the EU system of protection for GIs for *agricultural products and foodstuffs* laid down in Regulation (EC) No 510/2006 [then in effect] is '**exhaustive in nature**'. The Court further confirmed that the same must be true for the EU system of protection for GIs for *wines* as laid down in Regulation (EC) No 1234/2007, as these 'two systems were, essentially, the same in nature, since their objectives and

characteristics were similar’ (14/09/2017, C-56/16 P, PORT CHARLOTTE, EU:C:2017:693, § 76).

The Office applies an analogous approach for GIs for *aromatised wines* and *spirit drinks* for the following reasons. The former protection at national level of geographical indications for *aromatised wines* and *spirit drinks* that now qualify for a GI under Regulation (EU) No 251/2014 and Regulation (EU) 2019/787, respectively, was **discontinued** once those geographical indications were registered at EU level (see Article 107 of Regulation (EU) No 1308/2013, Article 26 of Regulation (EU) No 251/2014, Article 37 of Regulation (EU) 2019/787, read in conjunction with Articles 15(2) and 20(1) of Regulation (EC) No 110/2008, and Article 9 of Regulation (EU) No 1151/2012 read in conjunction with recital 24 of that regulation).

Moreover, reference must also be made to Council Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin for *agricultural products and foodstuffs*. That regulation (which preceded and was repealed by Regulation (EC) No 510/2006) set out in Article 17(1) that Member States had to ‘inform the Commission which of their legally protected names ... they wish[ed] to register’ pursuant to that Regulation. Paragraph 3 added that Member States could ‘maintain national protection of the names communicated in accordance with paragraph 1 until such time as a decision on registration has been taken’ (04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 18).

In other words, the EU system of protection comprising the above EU regulations **overrides and replaces** national protection of GIs for *agricultural products and foodstuffs*, *wines*, *aromatised wines* and *spirit drinks*.

In light of the foregoing:

- geographical indications for *wines*, *spirits* and *agricultural products and foodstuffs* that now qualify for a GI under EU regulations and in the past enjoyed protection by means of national legislation do not fall within the scope of Article 7(1)(j) EUTMR. Accordingly, they do not constitute, as such, and for that reason alone, a ground for refusal under Article 7(1)(j) EUTMR, unless they have **also been registered at EU level**. Therefore, if, for example, a third party argues that an EUTM contains or consists of a geographical indication for *wines* that was registered in the past at national level in an EU Member State, the examiner will check whether the geographical indication is also registered at EU level as a GI. If not, the third-party observations will be deemed not to raise serious doubts as regards Article 7(1)(j) EUTMR.
- For *aromatised wines*, pursuant to Article 26 of Regulation (EU) No 251/2014, a transitional period applied. Member States had until 28/03/2017 to submit all relevant information for the protection of national GIs at EU level to the Commission. After that date, existing national GIs that had not been notified to the Commission lost protection. As a consequence, until 28/03/2017 both EU and national GIs fell within the scope of Article 7(1)(j) EUTMR.



However, in those areas where no uniform EU system of protection is in place, GIs protected under national law fall within the scope of Article 7(1)(j) EUTMR. This is the case, in particular, for GIs for *non-agricultural products*.

Currently, neither the Commission nor the Office keeps a database listing the GIs protected under national law for *non-agricultural products*. Given the inherent difficulty in identifying such GIs, the Office will in these cases rely principally on observations by third parties.

## 6.2 GIs from non-EU countries

The following situations refer to GIs from non-EU countries that are not simultaneously registered at EU level. If a non-EU GI is registered at EU level, paragraphs 4 and 5 of this section of the Guidelines apply (e.g. Café de Colombia, Ron de Guatemala).

### GI is protected only in the non-EU country of origin under its national legislation

Article 7(1)(j) EUTMR does not apply since the non-EU GI is not recognised and protected *expressis verbis* under EU legislation. In this respect, note that the provisions of the TRIPs Agreement are not such as to create rights upon which individuals may rely directly before the courts by virtue of EU law (14/12/2000, C-300/98 & C-392/98, Dior and Others, EU:C:2000:688, § 44).

Example: ‘Miel Blanc d’Oku’ or ‘Poivre de Penja’ from Cameroon.

For non-EU GIs protected in a Member State by virtue of an international agreement signed by that Member State (and not the EU), see below for more details.

Nevertheless, when the EUTM application contains or consists of one such protected GI, it must also be assessed whether the EUTM may be considered descriptive and/or deceptive under Article 7(1)(c) and (g) EUTMR in accordance with the general rules set out in these Guidelines. For example, where a third party observes that an EUTM application consists of the term ‘Murakami’ (invented example), which is a GI for *spirits* in accordance with the national legislation of country X, Article 7(1)(j) EUTMR will not apply for the reasons set out above, but it must be examined whether or not the EUTM will be perceived as a descriptive and/or deceptive sign by the relevant EU consumers.

### GI is protected under an agreement to which the EU is a contracting party

The EU has signed a number of trade agreements with non-EU countries to protect GIs. These instruments typically include a list of the GIs, as well as provisions on their conflicts with trade marks. The content and degree of precision may nevertheless vary from one agreement to another. GIs from non-EU countries are protected at EU level after the relevant agreement has entered into force.

In this respect, it is settled case-law that a provision of an agreement entered into by the EU with non-EU countries must be regarded as being directly applicable when, in view of the wording, purpose and nature of the agreement, it may be concluded that the provision contains a **clear, precise and unconditional obligation that is not subject, in its implementation or effects, to the adoption of any subsequent measure** (14/12/2000, C-300/98 & C-392/98, Dior and Others, EU:C:2000:688, § 42).

The scope of protection given to these GIs by non-EU countries is defined through the substantive provisions of the agreement concerned, which may, for instance, include specific requirements or authorisation for use of the protected term. While the oldest agreements usually contained only general provisions, the 'latest generation' of free-trade agreements refer to the relationship between trade marks and GIs in similar terms to Articles 102 and 103 of Regulation (EU) No 1308/2013 (see, for example, Articles 210 and 211 of the 'Trade Agreement between the European Union and its Member States, of the one part, and Colombia and Peru, of the other part', OJ L 354, 21/12/2012).

In the light of this, EUTMs that contain or consist of a non-EU GI that is protected by an agreement to which the EU is a contracting party (and that is not simultaneously registered under the EU regulations) are examined, on a case-by-case basis in accordance with the specific substantive provisions of the agreement in question on the refusal of conflicting trade marks, taking into account the case-law cited above.

Nevertheless, the mere fact that a GI from a non-EU country is protected by those instruments **does not automatically** imply that an EUTM that evokes or even contains or consists of the GI must be refused: this will depend on the **content and scope** of the agreement's relevant provisions.

Apart from applying Article 7(1)(j) EUTMR to the extent provided under each of the agreements, if in the course of the proceedings and in particular in light of third-party observations, it becomes evident that the trade mark would deceive the public, for example as regards its origin or the right to use the GI, the Office will also consider raising an objection based on Article 7(1)(g) EUTMR.

As regards the **relevant point in time** for the protection of such GIs, a case-by-case approach is necessary. GIs included in the initial agreement are normally protected as of the date when the agreement enters into force. However, the list of protected GIs can subsequently be updated in the 'second-generation agreements'. In these cases, the relevant priority date varies from agreement to agreement: in some cases the priority date may be the date of the request by the non-EU country to update the list and not the date when the Commission accepts the inclusion of the GIs.

The Commission keeps a public database where information on non-EU GIs protected in the EU under international agreements is included. It is accessible here:

[https://ec.europa.eu/info/sites/info/files/food-farming-fisheries/food\\_safety\\_and\\_quality/documents/list-gis-non-eu-countries-protected-in-eu\\_en.pdf](https://ec.europa.eu/info/sites/info/files/food-farming-fisheries/food_safety_and_quality/documents/list-gis-non-eu-countries-protected-in-eu_en.pdf)

It should be noted that the trade agreements signed by the EU with non-EU countries typically have annexed to them a list of the GIs registered at EU level that are also to be protected in the non-EU countries in question (11/05/2010, T-237/08, Cuvée Palomar, EU:T:2010:185, § 104-108; 19/06/2013, R 1546/2011-4, FONT DE LA FIGUERA).

*Examples:*

GI	Country of origin	Products
Aguardiente chileno	Chile	<i>Spirit drinks</i>
Brandy/Brandewyn	South Africa	<i>Spirit drinks</i>
Breede River Valley	South Africa	<i>Wine</i>
Abriçot du Valais	Switzerland	<i>Spirit drinks</i>

GI is protected under an international agreement signed only by Member States (i.e. the EU is not a party)

Article 7(1)(j) EUTMR applies to GIs protected by international agreements to which a Member State is a party. However, by analogy with the Office's interpretation of Article 7(1)(j) EUTMR as far as national law is concerned, the Office considers that the reference to 'international agreements to which the ... Member State concerned is party' should be interpreted as international agreements in those areas where no uniform EU protection is in place, namely *non-agricultural products* (see paragraph 5.1 above).

In its judgment of 08/09/2009, C-478/07, Budějovický Budvar, EU:C:2009:521, the Court discussed the exhaustive nature of EU law as regards GIs originating from Member States. In the Office's interpretation, this also applies to non-EU GIs in the relevant product fields that enjoy protection in the territory of a Member State through an international agreement concluded between that Member State and a non-EU country.

This interpretation also applies to international agreements signed exclusively by Member States with non-EU countries (in particular, the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration). For the sole purpose of the examination of absolute grounds for refusal, the EU is not a contracting party to these agreements, which do not impose any obligations on the EU (14/10/1980, C-812/79, Attorney General v Burgoa, EU:C:1980:231, § 9). Therefore, Article 7(1)(j) EUTMR only applies to GIs for *non-agricultural products* protected under such agreements.

In light of the foregoing, for the purposes of Article 7(1)(j) EUTMR, international agreements concluded by Member States are not applicable except:

- to the extent that they cover GIs for *non-agricultural products*. Currently, neither the Commission nor the Office keeps a database listing the GIs for *non-agricultural products* protected under international agreements concluded by Member States.
- in the case of international agreements concluded with non-EU countries by a Member State before its accession to the EU. This is because the obligations arising out of an international agreement entered into by a Member State before its accession to the EU have to be respected. However, Member States are required to take all appropriate steps to eliminate the incompatibilities between an agreement concluded before a Member State's accession and the Treaty (see Article 307,

Treaty Establishing the European Community, now Article 351 TFEU, as interpreted by the Court in its judgment of 18/11/2003, C-216/01, *Budějovický Budvar*, EU:C:2003:618, § 168-172).

- in the case of international agreements concluded with a non-EU country by a Member State after its accession to the EU but before the entry into force of the uniform EU system of protection in the given product area.

Given the inherent difficulty in identifying such GIs, the Office will in these cases rely principally on observations by third parties. Additionally, the Office will consider raising an objection based on Article 7(1)(g) EUTMR if, in the course of the proceedings and in particular in light of third-party observations, it becomes evident that the trade mark would deceive the public.

### 6.3 Relationship with other EUTMR provisions

When the mark can be objected to under Article 7(1)(j) EUTMR, further examination may still be necessary under the remaining possible grounds for refusal, such as Article 7(1)(c), (g), (k) or (l) EUTMR.

Moreover, an EUTM application may be in conflict with both a GI in the *wine* sector and a protected traditional term for *wines* or with a GI in the *agricultural and foodstuffs* sector and a protected traditional speciality guaranteed.

GI	TTW/TSG	EUTM application (invented)
Jamón de Serón	Jamón serrano	ABC Jamón serrano de Serón for <i>ham</i>
Alicante	Fondillón	ABC Fondillón Alicante for <i>wine</i>

#### Example

GI/TTW	EUTM	Limitation
RIOJA (PDO-ES-A0117) RESERVA	MARQUÉS DE SAN JUAN RESERVA 2010 RIOJA (invented example)	<i>Wines</i> complying with the specifications of the PDO 'Rioja' and with the definition/conditions of use of the traditional term for wines 'RESERVA'.

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

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

### ***Part B***

#### ***Examination***

#### ***Section 4***

#### ***Absolute grounds for refusal***

#### ***Chapter 11 Trade marks in conflict with traditional terms for wines (Article 7(1)(k) EUTMR)***

## Table of Contents

<b>1 Article 7(1)(k) EUTMR.....</b>	<b>535</b>
<b>2 General Remarks on EU Regulations.....</b>	<b>535</b>
2.1 Definition of TTWs under EU Regulations.....	535
<b>3 Relevant TTWs under EU Regulations.....</b>	<b>537</b>
3.1 Relevant point in time.....	537
<b>4 Relevant Provisions Governing Conflicts with Trade Marks.....</b>	<b>537</b>
<b>5 Relevant Goods.....</b>	<b>542</b>
5.1 Restrictions of the list of goods.....	543
<b>6 International Agreements.....</b>	<b>543</b>
<b>7 Relationship with other EUTMR Provisions.....</b>	<b>543</b>

## **1 Article 7()(k) EUTMR**

Regulation (EU) 2015/2424 amending Regulation (EC) No 207/2009 on the Community trade mark introduced Article 7(1)(k) EUTMR as a specific ground for objecting to trade marks in conflict with earlier traditional terms for wine (TTWs).

Article 7(1)(k) EUTMR applies to EUTMs that are in conflict with TTWs protected by either EU legislation or international agreements to which the EU is party.

This ground for refusal was introduced for reasons of coherence, in order to offer TTWs a degree of protection equivalent to that accorded to designations of origin and geographical indications for wines.

## **2 General Remarks on EU Regulations**

Protection of TTWs is provided for in Council Regulation (EU) No 1308/2013, in Chapter III of Commission Implementing Regulation (EU) 2019/34 and in Chapter III of Commission Delegated Regulation (EU) 2019/33 <sup>(21)</sup>, which lay down certain detailed rules for the implementation of the Council Regulation (implementing and delegated acts).

### **2.1 Definition of TTWs under EU Regulations**

As regards the definition of TTWs, recital 104 of Council Regulation (EU) No 1308/2013 indicates that 'Certain terms are traditionally used in the Union to convey information to consumers about the particularities and the quality of wines, complementing the information conveyed by protected designations of origin and geographical indications. In order to ensure the working of the internal market and fair competition and to avoid consumers being misled, those traditional terms should be eligible for protection in the Union.'

Similarly, recital 23 of Commission Delegated Regulation (EU) 2019/33 states that,

[t]he use of traditional terms to describe grapevine products is a long-established practice in the Union. Such terms designate a production or ageing method, the quality, colour, type of place or a particular event linked to the history of a grapevine product bearing a protected designation of origin or geographical indication or indicate that it is a grapevine product having a protected designation of origin or geographical indication.

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<sup>21</sup> Commission Implementing Regulation (EU) 2019/34 of 17 October 2018 laying down rules for the application of Regulation (EU) No 1308/2013 of the European Parliament and of the Council as regards applications for protection of designations of origin, geographical indications and traditional terms in the wine sector, the objection procedure, amendments to product specifications, the register of protected names, cancellation of protection and use of symbols, and of Regulation (EU) No 1306/2013 of the European Parliament and of the Council as regards an appropriate system of checks OJ L 9, 11.1.2019, pages 46-76, and Commission Delegated Regulation (EU) 2019/33 of 17 October 2018 supplementing Regulation (EU) No 1308/2013 of the European Parliament and of the Council as regards applications for protection of designations of origin, geographical indications and traditional terms in the wine sector, the objection procedure, restrictions of use, amendments to product specifications, cancellation of protection, and labelling and presentation, OJ L 9, 11.1.2019, pages 2-45.

Articles 112 and 113 of Regulation (EU) No 1308/2013 lay down the general rules regarding the use and protection of traditional terms. So as to ensure fair competition and avoid misleading consumers, a common framework should be laid down regarding the protection and registration of such traditional terms.

According to Article 112 of Council Regulation (EU) No 1308/2013, a 'traditional term' is a term traditionally used in a Member State to designate:

- that the product has a protected designation of origin or a protected geographical indication under EU or national law; or
- the production or ageing method or the quality, colour, type of place, or a particular event linked to the history of the product with a protected designation of origin or a protected geographical indication.

In the first case a TTW is used in addition to the reference to a *protected designation of origin* (PDO) (e.g. 'appellation d'origine contrôlée (AOC)', 'denominación de origen protegida (DO)', 'denominazione di origine controllata (DOC)', 'Landwein') or a *protected geographical indication* (PGI) ('Vin de Pays', 'Vino de la Tierra', 'Indicazione Geografica Tipica', 'Vinho Regional', 'Landwein').

In the second case a TTW is used as a description of product characteristics used for production or ageing methods, quality, colour, type of place, or for a particular event linked to the history of the product with a PDO or PGI (e.g. 'château', 'grand cru', 'añejo', 'clásico', 'crianza', 'riserva', 'fino', 'Federweisser').

That said, TTWs convey information to consumers about the particularities and the quality of wines, in principle complementing the information conveyed by PDOs and PGIs, for example, 'Gran Reserva de Fondillón' for wine of overripe grapes of PDO Alicante, 'Cru bourgeois' for wine from PDO Médoc.

In accordance with Article 25 of Commission Implementing Regulation (EU) 2019/34, protected traditional terms are recorded by the Commission in an electronic register, and will mention the following data:

1. the name to be protected as a traditional term;
2. the type of traditional term according to Article 112 of Regulation (EU) No 1308/2013;
3. the language referred to in Article 24 of Delegated Regulation (EU) 2019/33;
4. the grapevine product category or categories concerned by the protection;
5. a reference to the national legislation of the Member State or third country in which the traditional term is defined and regulated or to the rules applicable to wine producers in the third country, including those originating from representative trade organisations, in the absence of national legislation in those third countries;
6. a summary of the definition or conditions of use;
7. the name of the country or countries of origin;
8. the date of inclusion in the E-Bacchus electronic database.



### 3 Relevant TTWs under EU Regulations

Article 7(1)(k) EUTMR applies where a TTW (either from an EU Member State or from a third country) has been **registered** under the procedure laid down by Council Regulation (EU) No 1308/2013, in Chapter III of Commission Implementing Regulation (EU) 2019/34 and in Chapter III of Commission Delegated Regulation (EU) 2019/33.

Relevant information about traditional terms for wines can be found in the E-Bacchus database maintained by the Commission, which can be accessed at: <http://ec.europa.eu/agriculture/markets/wine/e-bacchus/>.

#### 3.1 Relevant point in time

Article 7(1)(k) EUTMR applies only to TTWs applied for before the EUTM application and registered at the time of examining the EUTM application.

The relevant dates for establishing the priority of a trade mark and of a TTW are the date of application of the EUTM (or the so-called Paris Convention priority, if claimed) and the date of application for protection of a TTW to the Commission, respectively.

Where there is no relevant date information in the E-Bacchus extract, this means that the TTW in question was already in existence on 01/08/2009, the date on which the register was set up. For any TTW added subsequently, the E-Bacchus extract includes a reference to the publication in the Official Journal, which gives the relevant information.

By analogy with the current practice for GIs, and in view of the fact that the vast majority of applications for TTWs usually mature into a registration, **an objection will be raised** when the TTW was applied for before the filing date (or the priority date, if applicable) of the EUTM application **but** had not yet been registered at the time of examination of the EUTM application. However, if the EUTM applicant indicates that the TTW in question has not yet been registered, the proceedings will be suspended until the outcome of the registration procedure for the TTW.

### 4 Relevant Provisions Governing Conflicts with Trade Marks

TTWs do not constitute intellectual or industrial property rights like GIs. They are either **used in addition to the reference to GIs** (e.g. ‘vino de la tierra, appellation d’origine contrôlée’) **or provide information to consumers on the production/ageing method, quality, colour or type of place or a particular event linked to the history of the wine** (e.g. Cannellino, riserva, clasico, château, añejo, cru classé, Amarone). Therefore, they should not be regarded as indicators of the geographical provenance of the wine (17/05/2011, T-341/09, Txacoli, EU:T:2011:220, § 33).

Nevertheless, some of the protected TTWs **are associated with the use of a (particular) GI**. For instance, the TTW ‘Cannellino’ is an exclusive term related to a type of ‘Frascati’ wine and to its production. Frascati is a PDO.

The scope of protection of protected TTWs **is narrower** than that of GIs. Pursuant to Article 113(2) of Council Regulation (EU) No 1308/2013, TTWs are protected, **only in the language and for the categories of grapevine products claimed in the application** for protection of a TTW.

A specific provision on the relationship of traditional terms for wines with trade marks (a provision analogous to Article 102 of Council Regulation (EU) No 1308/2013 governing GIs) is found in Article 32 of Commission Delegated Regulation (EU) 2019/33. According to this article:

1. The registration of a trade mark that **contains or consists of a traditional term** which does not respect the definition and conditions of use of that traditional term as referred to in Article 112 of Regulation (EU) No 1308/2013, and that relates to a product falling under one of the categories listed in Part II of Annex VII thereto shall be:
2. refused if the application for registration of the trade mark is submitted after the date of submission of the application for protection of the traditional term to the Commission and the traditional term is subsequently protected; or
3. invalidated.
4. A name shall not be protected as a traditional term where, in the light of a trade mark’s reputation and renown, such protection is liable to mislead the consumer as to the true identity, nature, characteristic or quality of the grapevine product.
5. Without prejudice to paragraph 2, a trade mark referred to in paragraph 1 which has been applied for, registered or established by use in good faith, where national legislation so provides, in the territory of the Union, prior to the date of protection of the traditional term in the country of origin, may continue to be used and renewed notwithstanding the protection of a traditional term, provided that no grounds for the trade mark’s invalidity or revocation exist under Directive 2008/95/EC of the European Parliament and of the Council <sup>(22)</sup>, Directive (EU) 2015/2436 of the European Parliament and of the Council <sup>(23)</sup> or under Regulation (EU) 2017/1001 of the European Parliament and of the Council <sup>(24)</sup>.

In such cases, the use of the traditional term will be permitted alongside the relevant trade marks.

The Office does not automatically object to trade marks that include a term that is also a TTW. It raises an objection only in the event of misuse or false/misleading use of the TTW. The list of protected TTWs includes terms that are fairly common or that have various meanings not necessarily related to wines (such as ‘NOBLE’, ‘CLASICO’ or ‘RESERVA’). Depending on the context in which these terms are used, they may or

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<sup>22</sup> Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, [OJ L 299, 8.11.2008, p. 25](#).

<sup>23</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast), [OJ L 336, 23.12.2015, p. 1](#).


<sup>24</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, [OJ L 154, 16.6.2017, p. 1](#).

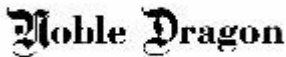
may not be associated with wine quality. As a consequence, when examining the sign, the Office will take into account in particular whether the relevant public will link the term in the sign with certain qualities or characteristics of the wine or not.

An objection was raised in the following examples.

Case No	Comment
<p>EUTM No 17 476 656</p> 	<p>CHÂTEAU is, inter alia, a historical expression related to a type of area and type of wine, and is reserved for wines originating from an estate that actually exists and/or has the exact word in its name.</p> <p>The relevant public will link the term 'château' in the sign with the traditional term 'Château'. The TM is therefore objectionable.</p> <p>As a result, the specification in Class 33 was limited to: <i>Wines complying with the definition/conditions of use of the traditional term for wines 'Chateau'; alcoholic beverages (other than wines).</i></p>
<p>EUTM No 17 967 391</p> 	<p>'Viejo' is a Spanish TTW for liqueur wine and for wines with a GI. 'Pulgar' is a term used in the wine field to refer to the part of the branch with two or three buds that is left in the vines when pruning them, so that the shoots can sprout (as depicted in the sign).</p> <p>The Office considered that, despite the fact that 'viejo' is not only a TTW but also a commonly used term to refer to 'old', and considering the elements of the sign all point to the wine field, there existed a conflict with the TTW 'viejo'.</p> <p>As a result, the specification in Class 33 was limited to: <i>wines complying with the definition/conditions of use of the traditional term for wine 'Viejo'; alcoholic beverages (except beers and wines).</i></p>
<p>EUTM No 17 874 618</p> <p>EL CLÁSICO</p>	<p>'Clásico' is a Spanish TTW for liqueur wines and wine of overripe grapes. The sign was applied for in respect of <i>wines</i>.</p> <p>The relevant public will link the term 'clásico' in the sign with the TTW 'Clásico'. The trade mark is therefore objectionable.</p>

No objection was raised in the following examples.

Case No	Comment
<p>EUTM No 15 102 015</p> 	<p>The addition of the term 'RESERVA' within the expression 'RESERVA DE LA BIOSFERA' does not misuse or give misleading/false information with regard to the TTW 'reserva'.</p> <p>The term 'reserva' in the TM should not be assessed out of context.</p> <p>'Reserva' is not only a TTW but also has, in the present case, another meaning, which has no obvious link with the TTW: in the EUTM application, combined with the word 'biosfera', 'reserva' clearly refers to a 'natural space'. Note also that the sign does not refer expressly to a wine.</p> <p>In light of the above, the expression 'RESERVA DE LA BIOSFERA', read as a whole, constitutes a logical and conceptual unit, in which 'RESERVA' is qualified by the other terms: 'DE LA BIOSFERA'. There is no direct link being made with the TTW 'RESERVA' as clearly the term will not be identified as providing information on the quality of wine.</p> <p>Moreover, the structure of the sign confirms that 'reserva' is not used in isolation or in a different typeface or size.</p> <p>The TM is acceptable.</p>

<p>EUTM No 14 997 803</p> 	<p>The inclusion of the term 'NOBLE' in the expression 'NOBLE DRAGON' does not misuse or give misleading/false information with regard to the TTW NOBLE.</p> <p>'Noble' is not only a TTW but also has, in the present case, another meaning, which has no obvious link with the TTW.</p> <p>In this particular case, the expression 'NOBLE DRAGON' constitutes a logical and conceptual unit, in which 'NOBLE' directly qualifies the term 'DRAGON' and therefore does not provide information on the quality of the wine, for example that it is 'noble' wine.</p> <p>The structure of the sign confirms that 'noble' is not used in isolation or in a different typeface or size.</p> <p>This conclusion is valid for average consumers in the EU: either they will understand the expression 'NOBLE DRAGON' as a conceptual unit or, even if they do not attribute any meaning to the sign as a whole, given the structure of the sign, in particular the arrangement of the words and the size and typeface in which they are reproduced, the term 'NOBLE' will not evoke in their minds anything particular about the wine.</p> <p>The TM is acceptable.</p>
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<p>Invented EUTM application</p> <p><b>AXN Late Harvest</b></p>	<p>'Vendange Tardive' is a French TTW. It is protected only in French.</p> <p>The translation of the TTW into English is not objectionable.</p> <p>See also the EU Commission's reply to Parliamentary question E-0622/2006, where it confirmed that the TTW 'Vendange Tardive' is protected only in French for certain wines originating in France. As traditional expressions are only protected in the language in which they are listed, the expression 'Late Harvest' is not protected in the EU.</p> <p>(<a href="http://www.europarl.europa.eu/sides/getAllAnswers.do?reference=E-2006-0622&amp;language=EN">http://www.europarl.europa.eu/sides/getAllAnswers.do?reference=E-2006-0622&amp;language=EN</a>)</p>
<p>EUTM No 17 633 819</p> <p>PAGOS DE GALIR</p>	<p>'Vino de pago' is a Spanish TTW. In the absence of the whole reference to 'vino de pago', the sign does not contain or consist of the TTW as registered.</p>

## 5 Relevant Goods

Article 113(2) of Council Regulation (EU) No 1308/2013 refers to '**categories of grapevine products claimed in the [TTW] application**'. Similarly, Article 32 of Commission Delegated Regulation (EU) 2019/33 refers to a product falling under one of these categories. The Office interprets this as meaning that, unlike GIs, objections based on conflicts with TTWs cannot be raised for comparable goods. However, objections should be raised against any relevant product referred to in Article 92(1) of Council Regulation (EU) No 1308/2013 for the following reasons.

According to Article 92(1) of Council Regulation (EU) No 1308/2013 the rules on, inter alia, traditional terms should apply to the products referred to in points 1, 3 to 6, 8, 9, 11, 15 and 16 of Part II of Annex VII. Such products are *wine, liqueur wine, sparkling wine, quality sparkling wine, quality aromatic sparkling wine, semi-sparkling wine, aerated semi-sparkling wine, partially fermented grape must, wine from raisined grapes, wine of overripe grapes*.

Since all these products are wine-based and in view of the fact that most of the EUTM applications applied for are for *wines* without any specification of category, objections should be raised against any relevant product referred to in Article 92(1) of Council Regulation (EU) No 1308/2013. For instance, in the event of an EUTM application containing the TTW 'Fondillón', for *wine* in Class 33, the objection should be raised not against *wine of overripe grapes* that is protected by the TTW, but against *wine* as such

(e.g. *wine* complying with the definition/conditions of use of the traditional term for wines ‘Fondillón’).

## 5.1 Restrictions of the list of goods

Objections raised due to conflicts with GIs may be waived if the relevant goods are restricted so as to comply with the specifications of the GI in question.

For TTWs, there are no such specifications but their registration in the E-Bacchus database includes a ‘summary of definition/conditions of use’. Therefore, objections should be waived if the relevant goods are restricted so as to comply with the definition/conditions of use of the TTW in question. The proper wording is ‘[name of the product] complying with the definition/conditions of use of the [TTW ‘X’]’. No other wording should be proposed or allowed. Restrictions such as ‘[name of the product] with the [TTW ‘X’]’ are not acceptable.

## 6 International Agreements

By analogy with GIs, where international agreements to which the EU is party can serve as a basis for raising an objection against a trade mark application, TTWs that may be protected under international agreements to which the EU is a party should be taken into account when assessing conflicts between a TTW and an EUTM application.

## 7 Relationship with other EUTMR Provisions

When the mark can be objected to under Article 7(1)(k) EUTMR, further examination may still be necessary under the remaining possible grounds for refusal, such as Article 7(1)(j) EUTMR.

In other words, an EUTM application may be in conflict with both a GI in the wine sector and a TTW.

### Examples

GI/TTW	EUTM	Limitation
RIOJA (PDO-ES-A0117)  RESERVA	MARQUÉS DE SAN JUAN RESERVA 2010 RIOJA  (invented example)	Wines complying with the specifications of the PDO ‘Rioja’ and with the definition/conditions of use of the traditional term for wines ‘RESERVA’.

Moreover, the mark consisting of the TTW can also be objected to under Article 7(1)(b)/(c) EUTMR.

### Examples

TTW	EUTM	Explanation
AÑEJO	VINO AÑEJO applied for <i>wines; alcoholic beverages except beers</i> (invented example)	'Añejo' is a Spanish TTW for 'wine' aged for a minimum period of 24 months and for liqueur wines originating from Malaga PDO. Therefore, it is objectionable under Article 7(1)(k) EUTMR. In addition, the sign is objectionable under Article 7(1)(b)/(c) EUTMR as it informs the relevant consumer of certain characteristics of the wines (e.g. wine that is aged).



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

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

### ***Part B***

#### ***Examination***

#### ***Section 4***

#### ***Absolute grounds for refusal***

#### ***Chapter 12 Trade marks in conflict with traditional specialities guaranteed (Article 7(1)(I) EUTMR)***

## Table of Contents

<b>1 Article 7(1)(l) EUTMR.....</b>	<b>547</b>
<b>2 General Remarks on EU Regulations.....</b>	<b>547</b>
2.1 Definition of traditional specialities guaranteed under EU Regulations.....	547
2.2 Relationship with trade marks.....	548
2.2.1 TSG with or without reservation of a name.....	548
<b>3 Relevant Goods Under EU Regulations.....</b>	<b>549</b>
3.1 Relevant point in time.....	549
<b>4 Situations Covered by Article 24 of Regulation (EU) No 1151/2012.....</b>	<b>550</b>
<b>5 Relevant Goods.....</b>	<b>551</b>
5.1 Restrictions of the list of goods.....	551
<b>6 International Agreements.....</b>	<b>552</b>
<b>7 Relationship with Other EUTMR Provisions.....</b>	<b>552</b>

## 1 Article 7(1)(l) EUTMR

Regulation (EU) 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trade mark introduced Article 7(1)(l) EUTMR as a specific absolute ground for refusing trade marks in conflict with traditional specialities guaranteed (TSGs).

Article 7(1)(l) EUTMR applies to EUTMs that are in conflict with TSGs protected by either EU legislation or international agreements to which the EU is party.

Just as in the case of traditional terms for wine (TTWs), it is a ground for refusal of EUTMs that has been introduced for reasons of coherence, in order to offer TSGs a degree of protection equivalent to that given to designations of origin and geographical indications.

## 2 General Remarks on EU Regulations

### 2.1 Definition of traditional specialities guaranteed under EU Regulations

Protection of TSGs is provided for in Title III of Regulation (EU) No 1151/2012.

As regards the definition of TSGs, Article 17 of Regulation (EU) No 1151/2012 indicates that: ‘A scheme for traditional specialities guaranteed is established to safeguard traditional methods of production and recipes by helping producers of traditional product[s] in marketing and communicating the value-adding attributes of their traditional recipes and products to consumers.’

According to Article 18(1) of the Regulation, ‘[a] name shall be eligible for registration as a traditional speciality guaranteed where it describes a specific product or foodstuff that:

1. results from a mode of production, processing or composition corresponding to traditional practice for that product or foodstuff; or
2. is produced from raw materials or ingredients that are those traditionally used.’

Hence, TSGs highlight the traditional characteristics of a product either in its production process or composition, for instance, ‘Lambic, Gueuze-Lambic, Gueuze’ for *Belgian acid beer during production of which spontaneous fermentation occurs*.

Unlike GIs, the TSG quality scheme does not certify that the protected food product has a link to a specific geographical area, for instance, TSG ‘Mozzarella’ for *Italian fresh pulled-curd cheese* and PDO ‘Mozzarella di Bufala Campana’ for mozzarella cheese originating from a particular geographical area.

To qualify as a TSG, a product must, according to Article 18(2) of the Regulation, be of a specific character: ‘2. For a name to be registered as a traditional speciality guaranteed, it shall:

1. have been traditionally used to refer to the specific product; or
2. identify the traditional character or specific character of the product.'

In this context, reference is made to Article 3 of Regulation (EU) No 1151/2012, which defines:

1. 'specific character' as 'the characteristic production attributes which distinguish a product clearly from other similar products of the same category';
2. 'traditional' as 'proven usage on the domestic market for a period that allows transmission between generations; this period is to be at least 30 years.'

According to Article 23 of Regulation (EU) No 1151/2012, '[a] name registered as a traditional speciality guaranteed may be used by any operator marketing a product that conforms to the corresponding specification'.

Article 24 of Regulation (EU) No 1151/2012 establishes the scope of protection of TSGs — '[r]egistered names shall be protected against any misuse, imitation or evocation, or against any other practice liable to mislead the consumer'.

## 2.2 Relationship with trade marks

In contrast with GIs, there is no specific provision in Regulation (EU) No 1151/2012 for the relationship of TSGs with trade marks (i.e. a provision analogous to Article 13). Article 24(1) prohibits the use of the TSG in a number of situations but not the registration of a trade mark.

Article 7(1)(l) EUTMR, however, refers to 'trade marks which are excluded from registration pursuant to Union legislation'.

The Office considers that a systematic approach should be followed and draws an analogy with Article 7(1)(j) EUTMR: the registration of an EUTM application should be refused or the registration of an EUTM invalidated if there is conflict with a TSG.


### 2.2.1 TSG with or without reservation of a name

Under Regulation (EC) No 509/2006 on agricultural products and foodstuffs as traditional specialities guaranteed, and more specifically Article 13 of that Regulation, the applicants had a choice of applying and subsequently registering a TSG '*with or without reservation of name*'. It meant that for a TSG registered '*without the reservation of name*', the respective name remained free to use to any operators without any limitation. Information on whether the TSG has been registered with or without reservation of the name is found in the Official Journal publishing the registration of the TSG in the C series.

Regulation (EC) No 509/2006 was repealed by Regulation (EU) No 1151/2012 on quality schemes for agricultural products and foodstuffs. The subsequent regulation provides **only** for registering of TSGs '*with reservation of name*'. The transitional provisions of Article 25 deal with the incompatibility of the old and new regimes. All the TSGs that were registered '*with reservation of name*' are entered automatically into the

register. For those TSGs the Office will refuse the EUTM should there be a conflict. On the contrary, all the TSGs that were registered '*without reservation of name*' will remain in the register until 4 January 2023, unless the applicants have opted for a 'simplified procedure' under Article 26, to have a TSG in the register but now '*with the reservation of name*'.

In the latter cases, the Office will refuse signs in conflict with the TSG.

EUTM No	Comment
EUTM No 17 238 197 	The sign is in conflict with the TSG 'Pizza Napoletana' (registered on 05/02/2010 ' <i>without reservation of name</i> ' but applied for with reservation of name).  <i>Pizzas</i> in Class 30 had to be limited to comply with the product specification of the TSG 'Pizza Napoletana'.

If a TSG was registered '*without reservation of name*', the Office would not *ex officio* refuse an EUTM containing the TSG unless the sign itself indicated 'TSG' or 'traditional specialities guaranteed'. Examples of TSGs '*without reservation of name*' are:

- IT/TSG/0007/0001, 'Mozzarella';
- BE/TSG/0007/0008, 'Kriek, Kriek-Lambic, Framboise-Lambic, Fruit-Lambic/Kriek, Kriekenlambiek, Frambozenlambiek, Vruchtenlambiek';
- ES/TSG/0007/0003, 'Leche certificada de Granja';
- ES/TSG/0107/0018, 'Panellets';
- SE/TSG/0007/0022, 'Hushållsost'.

### 3 Relevant Goods Under EU Regulations

Article 7(1)(l) EUTMR applies where a TSG has been registered under the procedure laid down by Regulation (EU) No 1151/2012.

Relevant information about traditional specialities guaranteed can be found in the DOOR database maintained by the Commission, which can be accessed online at <http://ec.europa.eu/agriculture/quality/door/list.html>.

#### 3.1 Relevant point in time

Article 7(1)(l) EUTMR applies only to TSGs that were applied for before the EUTM application and are **registered** at the time when the EUTM application was examined.

By analogy with the current practice for GIs and in view of the fact that the vast majority of applications for TSGs usually mature into a registration, an objection will be raised when the TSG was applied for before the filing date (or the priority date, if applicable)

of the EUTM application but is not yet registered at the time when the EUTM application was examined. However, if the EUTM applicant submits that the TSG in question is not yet registered, the proceedings will be suspended until the outcome of the registration procedure for the TSG.

## **4 Situations Covered by Article 2 of Regulation (EU) No 1151/2012**

TSGs are used to provide information on particular methods of production and recipes. Importantly, unlike GIs, there is no link between a TSG and a specific geographical area.

The scope of protection of protected TSGs is narrower than that of GIs. Pursuant to Article 24 of Regulation (EU) No 1151/2012, TSGs are protected against **any misuse, imitation or evocation, or against any other practice liable to mislead the consumer**. The exploitation of the reputation of the TSG is not contemplated.

The Office will apply by analogy its interpretation of the terms misuse, imitation or evocation and misleading practices referred to in Article 13 of Regulation (EU) No 1151/2012 in connection with GIs (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Designations of Origin and Geographical Indications (Article 7(1)(j) EUTMR)). The Office will take into account, in particular, whether the relevant public will link the term in the sign with the product whose designation is covered by the TSG.

EUTM No	Comment
EUTM application No 15 270 184 HEUMILCHBARON	<p>HEUMILCH is a registered TSG for milk (haymilk) (AT/TSG/0007/01035).</p> <p>The relevant public will link the term ‘heumilch’ in the sign with the product whose designation is covered by the TSG. The EUTM application is therefore objectionable.</p> <p>As a result, the specification in Class 29 was limited to: <i>Milk and milk products, in particular cheese, cheese preparations, cream cheese, soft cheese, semi-hard cheese, sliced cheese, hard cheese, cream, milk cream, whey, yoghurt, curds, butter, drinking yoghurt, buttermilk, curd, kefir [milk beverage], sour cream, smetana [sour cream], mixed milk products, fruit yoghurt, milk beverages, milk predominating, semi-prepared and prepared meals based mainly on milk or milk products, dairy foods; edible spreads; all of the aforesaid goods complying with the product specification of the Traditional Speciality Guaranteed ‘Heumilch’.</i></p>

## 5 Relevant Goods

Article 19 of Regulation (EU) No 1151/2012 requires that a TSG must comprise a ‘description of the product including its main physical, chemical, microbiological or organoleptic characteristics, showing the product’s specific character’.

Objections should be raised only to products covered by the TSG.

### 5.1 Restrictions of the list of goods

TSG applications, in accordance with Article 20 of Regulation (EU) No 1151/2012, must comprise a product specification. Therefore, objections should be waived if the relevant goods are restricted to comply with the product specification of the TSG. The proper wording is ‘[name of the product] complying with the product specification of the [TSG ‘X’]’. No other wording should be proposed or allowed. Restrictions such as ‘[name of the product] with the [TSG ‘X’]’ are not acceptable.

The TSG product specifications are published in the *Official Journal of the European Union* and are accessible via the DOOR database.

For an example of restrictions of the list of goods see paragraph 4.

## **6 International Agreements**

By analogy with GIs, where international agreements to which the EU is party can serve as a basis for raising an objection against a trade mark application, TSGs that may be protected under international agreements to which the EU is a party should be taken into account in the assessment of conflict of a TSG with an EUTM application.

Currently, the Office does not keep a record of TSGs protected under international agreements. Moreover, the DOOR database does not include them either. Given the difficulty in identifying such TSGs, the Office will in these cases rely, in principle, on observations by third parties.

## **7 Relationship with Other EUTMR Provisions**

When the mark can be objected to under Article 7(1)(l) EUTMR, further examination may still be necessary under the remaining possible grounds for refusal, such as Article 7(1)(j) EUTMR.

In other words, an EUTM application may be in conflict with both a GI in the agricultural and foodstuff sector and a protected traditional speciality guaranteed.



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

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

### ***Part B***

#### ***Examination***

#### ***Section 4***

#### ***Absolute grounds for refusal***

#### ***Chapter 13 Trade marks in conflict with earlier plant variety denominations (Article 7(1)(m) EUTMR)***

## Table of Contents

<b>1 Article 7(1)(m) EUTMR.....</b>	<b>555</b>
<b>2 Legislative Framework.....</b>	<b>555</b>
<b>3 Definition of Plant Variety Denomination.....</b>	<b>556</b>
<b>4 Situations Covered by Article 7(1)(m) EUTMR.....</b>	<b>556</b>
4.1 Registered plant variety denominations.....	556
4.2 Relevant point in time.....	558
4.3 The EUTM application consists of, or reproduces in its essential elements, the plant variety denomination.....	558
4.4 Plant varieties of the same or closely related species.....	562
4.5 Relationship with other EUTMR provisions.....	563

## 1 Article 7()(m) EUTMR

Regulation (EU) 2015/2424 amending Council Regulation (EC) No 207/2009 on the Community trade mark introduced Article 7(1)(m) as a specific ground for objecting to trade marks in conflict with earlier plant variety denominations.

In particular, Article 7(1)(m) EUTMR provides for the refusal of EUTMs that consist of, or reproduce in their essential elements, an earlier plant variety denomination — registered in accordance with EU legislation, national law or international agreements to which the European Union or the Member State concerned is a party and that provide for the protection of plant variety rights — and that are filed in respect of plant varieties of the same or closely related species.

## 2 Legislative Framework

As regards **EU legislation** protecting plant variety rights, Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights (CPVRR) establishes a system of Community plant variety rights (CPVR) as the 'sole and exclusive form of Community industrial property rights for plant varieties'.

**Plant variety** (PV) represents a more precisely defined group of plants, selected from within a species, with a common set of characteristics. For instance, within one of the strawberries species (e.g. *Fragaria moschata* or *Fragaria x ananassa* Duch.), a breeder may create a new variety.

New plant varieties can be protected by a *sui generis* intellectual property system of Plant Breeder's Rights (PBR).

Since 2005, the European Union has been party to the International Convention for the Protection of New Varieties of Plants (UPOV Convention), which has become an integral part of the European Union's legal order. Under Article 20(1) UPOV Convention, a variety 'shall be designated by a denomination which will be its generic designation'. Furthermore, each Contracting Party must ensure that no rights in the designation registered as the denomination of the variety will hamper **free use of the denomination** in connection with the variety, even after expiry of the breeder's right. This actually implies that an applicant cannot validly claim to be the holder of plant breeder's rights in order to overcome an objection based on Article 7(1)(m) EUTMR, even if those rights have not yet expired. The purpose of this Article is to ensure **free use** of the denomination in connection with the variety. Therefore, a plant breeder or their successor in title, owning a registered plant variety right, should not be able to claim an exclusive IP right over that designation registered as a plant variety denomination, under trade mark protection. The exclusive object that a plant variety right protects is a variety and not the denomination, which only represents its generic designation.

Both the CPVRR and the UPOV Convention make it obligatory for any person offering for sale or marketing propagating material of the protected variety to use the variety denominations, even after the expiry of the breeder's right in that variety.

Moreover, pursuant to Article 7(1)(m) EUTMR, plant variety denominations registered following **national law** or **international agreements** to which Member States are a party must also be taken into account.

### 3 Definition of Plant Variety Denomination

**Plant variety denominations** identify cultivated varieties or subspecies of live plants or agricultural seeds. A variety denomination must ensure clear and unambiguous identification of the variety and fulfil several criteria (Article 63 CPVRR). The applicant for a CPVR must indicate a suitable variety denomination, which will be used by anyone who markets such variety in the territory of a member of the International Union for the Protection of New Varieties of Plants (UPOV), even after termination of the breeder's right (Article 17 CPVRR).

Protection is granted to plant variety denominations in order, inter alia, to protect the **legitimate interest** of consumers and producers in knowing the variety they are using or purchasing, as well as possibly the breeder and origin of that variety. The obligation to use the variety denominations contributes to the regulation of the market and to the safety of transactions in the agricultural and food sector, thus preventing counterfeiting and any potential misleading of the public.

### 4 Situations Covered by Article 7(1)(m) EUTMR

Article 7(1)(m) EUTMR applies if the following requirements are met:

1. there is a registered plant variety denomination (at EU or national level, including in third countries that are party to the UPOV Convention);
2. the plant variety denomination was registered prior to the EUTM application;
3. the EUTM application consists of, or reproduces in its essential elements, the earlier plant variety denomination;
4. the list of goods for which protection is sought for in the EUTM application includes plant varieties of the same species as, or of species closely related to, those protected by the registered plant variety denomination.

#### 4.1 Registered plant variety denominations

The Community Plant Variety Office (CPVO), based in Angers (France), is the European Union agency responsible for managing a system for the protection of plant variety rights.

The CPVO maintains a register of protected plant varieties with their respective denominations.

### Plant variety rights

Pursuant to Article 19(1) CPVRR, plant variety rights **expire** at the end of the 25th calendar year or, in the case of varieties of vine and tree species, the 30th calendar year following the year of grant.

A plant variety right is **surrendered**, pursuant to Article 19(3) CPVRR, if the holder sends a written declaration to such effect to the CPVO before expiry of the term of the right, in which case the right lapses with effect from the day following the day on which the declaration is received by the CPVO.

Plant variety rights are **terminated** *ex tunc* if the CPVO declares the Community plant variety right null and void pursuant to Article 20 CPVRR and with effect *in futuro* if the CPVO cancels the Community plant variety right pursuant to Article 21 CPVRR.

The protected varieties and the varieties whose CPVR has been terminated/surrendered, or which has expired, can be searched, based on their variety denomination and/or other search criteria, through the CPVO Variety Finder <sup>(25)</sup>, available on the CPVO's website. This reference tool can be consulted whenever the type of goods and/or services covered by the EUTM application so dictate (see paragraph 4.4 below).

Accordingly, the protection of Article 7(1)(m) EUTMR applies not only to plant variety denominations of registered plant varieties, but also to the denominations of varieties for which protection has expired or has been surrendered or terminated. This is because, even after expiry of the protection, the variety may still be used in the market and breeders are obliged to use the denomination when trading in variety constituents.

### Plant variety denominations

Whenever the specification of an EUTM application refers to *live plants, agricultural seeds, fresh fruits, fresh vegetables* or equivalent wording, the Office will verify in the CPVO Variety Finder whether the term(s) making up the essential elements of the trade mark coincide(s) with a registered variety denomination or with the denomination of a variety for which protection has expired or been surrendered or terminated.

However, Article 7(1)(m) EUTMR is **not applicable** in respect of processed items in Class 31 such as *dried flowers (including flowers for decoration), dried plants, hay or straw*. Neither is it applicable in respect of *live animals, food for animals, animal feed* and equivalent wordings.

The search should extend to variety denominations registered for the European Union, Member States and non-EU countries on the basis of EU legislation, national law or international agreements to which the European Union or the Member State concerned is a party.

As already mentioned, both the CPVRR and the UPOV make it obligatory to use the variety denomination when offering a plant variety or the propagating material of a plant variety commercially, even after the termination of the Community plant variety right.

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<sup>25</sup> <http://cpvo.europa.eu/en/applications-and-examinations/cpvo-varieties-database>

## 4.2 Relevant point in time

Article 7(1)(m) EUTMR applies only in respect of plant variety denominations that have a registration date prior to the filing date of the EUTM application. The relevant dates are the date of filing of the EUTM application (or the 'Paris Convention priority', if claimed) and the date of registration of the plant variety denomination.

## 4.3 The EUTM application consists of, or reproduces in its essential elements, the plant variety denomination

Pursuant to Article 7(1)(m) EUTMR, objections are to be raised only if the EUTM application consists of, or reproduces in its essential elements, the plant variety denomination.

The following situations may therefore arise.

1. The EUTM applied for **consists** of an earlier plant variety denomination.
2. The EUTM applied for **contains** an earlier plant variety denomination. Whether the application is liable to be objected to or not will require a more detailed assessment. In particular, the Office will examine whether the plant variety denomination is the **essential element** of the EUTM application.

In order to determine whether a plant variety denomination is the essential element of an EUTM application (situation b) above), account must be taken of all the other elements, as these are likely to influence the outcome of the assessment. As the court has noted, it is necessary to establish whether the plant variety denomination occupies an essential position in the complex mark applied for, so that the essential function of origin of the mark, namely that of identifying the commercial origin of the products in question, is based on that plant variety denomination and not on the other elements that make up the complex mark applied for (18/06/2019, T-569/18, Kordes' Rose Monique, EU:T:2019:421, § 31-32).

In principle, a term identical to a plant variety denomination will not be considered as the essential element of an EUTM application when:

- the term identical to a plant variety denomination is visually in a **secondary position** compared with the other elements of the sign; or
- **the complexity** of the sign is such that the term that is identical to a plant variety denomination is just one of numerous elements of the sign; or
- the sign contains a conceptual meaning/message that precludes the term that is identical to a plant variety denomination from being perceived as a plant variety; or
- the combination of elements of the sign creates a single unit that should not be artificially dissected.


In principle, the term identical to a plant variety denomination will be considered one of the essential elements of the EUTM application when:


- the other elements are all visually secondary; or

- the conceptual meaning/message of the sign reinforces the perception of the term as a plant variety denomination (other elements are perceived as mere qualifiers of a plant variety, i.e. terms such as colour, size, growth or season indicators).


The objection will be waived should the applicant exclude the plant varieties protected by the plant variety denomination from its list of goods applied for.

Examples of EUTM applications containing terms identical to plant variety denominations and **objected to** under Article 7(1)(m)EUTMR:


EUTM	PVD	Goods applied for in Class 31	Reasoning	Outcome
RUBY No 16 922 791	RUBY	<i>Plums; Mirabelle plums; seeds for plums and seeds for Mirabelle plums; plum trees; Mirabelle plum trees</i>	The application consists of the PVD registered for <i>Prunus armeniaca</i> L. in France and Italy.	All the goods applied for fall within the genus ' <i>Prunus</i> '. The application was refused.
 No 17 955 254	GIOIA	Inter alia: <i>flowers</i>	GIOIA is a PVD registered for <i>Dendrobium</i> Sw., <i>Dianthus</i> L., <i>Gerbera jamesonii</i> Bolus ex Hook f. and <i>Lilium</i> L.  The size and position of the PVD are visually relevant in the sign. The other verbal elements 'CREA BONTÀ' ('it creates good things') are in a secondary position and their meaning neither contradicts nor would be seen as diluting the relevance of the PVD itself.	An objection was raised, following which the application was limited to <i>agricultural products, not included in other classes; market garden produce, not processed; pips; plants; natural plants; flowers; none of the aforesaid goods belonging to the botanical genera Dendrobium, Dianthus, Gerbera and Lilium.</i>


EUTM	PVD	Goods applied for in Class 31	Reasoning	Outcome
 No 17 496 019	AZAHAR	Inter alia: <i>agricultural products</i>	<p>AZAHAR is a PVD registered for <i>Gossypium hirsutum</i> L. in Spain.</p> <p>The additional element 'BIO' is visually secondary and could in any event be an additional indication that merely reinforces or qualifies the plant variety (organically grown AZAHAR).</p>	<p>The Office objected and proposed a limitation to exclude agricultural products of the genus <i>Gossypium</i>. In the absence of a reply from the applicant, the application was refused for <i>agricultural products</i>.</p>



EUTM	PVD	Goods applied for in Class 31	Reasoning	Outcome
 No 17 916 500	EMILIA	<i>Vegetables, fresh; Unprocessed vegetables; Root vegetables [fresh]</i>	<p>'Emilia' is a PVD registered for five varieties, only one of which is for vegetables (<i>Solanum tuberosum</i> — potato).</p> <p>Taking into account that potatoes can be red, the other word elements 'rossa naturale' (naturally red) were considered to reinforce/qualify the reference to/meaning of the plant variety (colour and growth indicator). Thus, the word 'EMILIA' had to be considered an essential element of the EUTM applied for.</p>	<p>The application was objected to and limited to <i>fresh vegetables; unprocessed vegetables; root vegetables [fresh];</i> None of the aforesaid goods belonging to the species <i>Solanum tuberosum</i> L.</p>

Examples of EUTMs containing a term identical to a plant variety denomination but **not objected to** under Article 7(1)(m)EUTMR:

EUTM	PVD	Reasoning
 No 17 182 114	QUALITY	<p>Considering the size of the term 'quality' and its position in the overall arrangement of the sign, it cannot be considered an essential element of the EUTM.</p>

EUTM	PVD	Reasoning
Rubisgold No 18 016 793	RUBIS	The term 'rubis' is conjoined with the word 'gold'. A new unit is formed and must be examined as such. No artificial dissection should be applied.
 No 17 144 387	CHOICE	The verbal elements ('butcher's choice') and the figurative elements (in particular, the knife and the meat cleaver) clearly constitute a very specific logical unit with a clear conceptual meaning, which does not reinforce or point to any possible perception of a plant variety within the EUTM.
KELP-P-MAX No 17 979 018	MAX	The term 'max' was not considered an essential element of the EUTM since the overall combination of the word elements create a single unit that cannot be artificially split to highlight the word 'MAX' or the possible perception of 'max' as a plant variety denomination.

#### 4.4 Plant varieties of the same or closely related species

A check is to be made whenever the specification of an EUTM application refers to *live plants, agricultural seeds, fresh fruits, fresh vegetables* or equivalent.

If the check shows that the word or figurative EUTM applied for consists of, or reproduces in its essential elements, an earlier plant variety denomination registered under EU law, national law or relevant international agreements, the examiner must raise an objection under Article 7(1)(m) EUTMR in respect of the relevant product.

Taking as an example the scientific name of the product 'oats', *Avena sativa*, the term *Avena* describes the genus and includes the closely related species *Avena abyssinica*, *Avena byzantine*, *Avena fatua*, *Avena nuda*, etc. Similarly, the scientific name of the most common pepper is *capsicum annuum*. The term *capsicum* describes the genus and in principle includes the closely related species *Capsicum baccatum*, *Capsicum chinense*, *Capsicum pubescens*, etc.

**RULE.** The objection should refer to the genus of the scientific name of the plant variety denomination, which covers closely related species. Wherever possible, the Office will propose a limitation by which the relevant goods are limited to goods other than those of the genus of the plant variety (for example, in the case of GIOIA above, the application was limited for flowers to *flowers; other than those of the botanical genera Dendrobium, Dianthus, Gerbera and Lilium*). If the applicant agrees with the limitation, the application will proceed to further examination.

**EXCEPTION.** There are cases where some species within the same genus are not closely related to the others, or where species from different genera are closely related.

In the first case (species within the same genus are not closely related, e.g. certain species under the genus *Solanum*), Office practice, given the difficulty in proposing limitations, is to take into account the whole genus when proposing such limitation. It would be up to the applicant to comment on this and make a proposal.

In the second case (species from different genera are closely related, e.g. *Agrostis, Dactylis, Festuca, Festulolium, Phalaris, Phleum* and *Poa*), the Office takes such species into account when drafting the objection.

The list of exceptions is exhaustive. See [Annex I to the Explanatory Notes on Variety Denominations](#) under the UPOV Convention.

Exceptions will be examined by the Office upon request from the EUTM applicant.

See also the Annex of the [CPVO Guidelines on Article 63 CPVRR](#) on the meaning of ‘closely related species’.

When the goods applied for in Class 31 are so specific as to only cover the species protected by the PVD, including closely related species, a limitation cannot overcome an objection under Article 7(1)(m) EUTMR.

Example:

The EUTM applied for covers *peppers* in Class 31 and the sign consists of a PVD that protects species in the genus *Capsicum* (which includes all possible varieties of peppers). No limitation can be proposed, as excluding the genus *Capsicum* from *peppers* in Class 31 would leave nothing remaining in the list of goods applied for.

## 4.5 Relationship with other EUTMR provisions

Where a plant variety denomination is used in the market but has not been registered or published in the CPVO or at national level, Article 7(1)(c) and (d) EUTMR might be applicable.

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

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

### ***Part B***

#### ***Examination***

#### ***Section 4***

#### ***Absolute grounds for refusal***

#### ***Chapter 14 Acquired distinctiveness through use (Article 7(3) EUTMR)***

## Table of Contents

<b>1 Introduction.....</b>	<b>566</b>
<b>2 Requests.....</b>	<b>566</b>
<b>3 The Point in Time for which Acquired Distinctiveness has to be Established.....</b>	<b>567</b>
3.1 Examination proceedings.....	567
3.2 Cancellation proceedings.....	568
<b>4 Consumers.....</b>	<b>568</b>
<b>5 Goods and Services.....</b>	<b>569</b>
<b>6 Territorial Aspects.....</b>	<b>569</b>
6.1 Special provisions with respect to the accession of new Member States.....	570
6.2 Language area.....	570
6.3 Acquired distinctiveness throughout the EU.....	571
<b>7 Standard of Proof.....</b>	<b>573</b>
<b>8 Assessment of the Evidence.....</b>	<b>574</b>
8.1 Opinion polls and surveys.....	576
8.2 Market share, advertising and turnover.....	576
8.3 Declarations, affidavits and written statements.....	577
8.4 Prior registrations and acquired distinctiveness.....	578
8.5 Manner of use.....	579
8.6 Length of use.....	579
8.7 Post-filing-date evidence.....	581
<b>9 Consequences of Acquired Distinctiveness.....</b>	<b>581</b>

## 1 Introduction

According to Article 7(3) EUTMR, a trade mark may still be registered despite the fact that it does not comply with Article 7(1)(b), (c) or (d) EUTMR, provided that it 'has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it'.

Article 7(3) EUTMR constitutes an exception to the rule laid down in Article 7(1)(b), (c) or (d) EUTMR whereby registration must be refused for trade marks that are per se devoid of any distinctive character, for descriptive marks, and for marks that consist exclusively of indications that have become customary in the current language or in the bona fide and established practices of the trade.

Distinctive character acquired through use means that, although the sign lacks inherent distinctiveness *ab initio* with regard to the goods and services claimed, at least a significant proportion of the relevant public has, owing to the use made of it on the market, come to see it as identifying the goods and services claimed in the EUTM application as originating from a particular undertaking. Thus, the sign has become capable of distinguishing those goods and services from those of other undertakings because they are perceived as originating from a particular undertaking. In this way, a sign originally unable to be registered under Article 7(1)(b), (c) or (d) EUTMR can acquire new significance, and its connotation, no longer purely descriptive or non-distinctive, allows it to overcome those absolute grounds for refusal of registration as a trade mark.

## 2 Requests

The Office will only examine acquired distinctive character following a request from the EUTM applicant. The Office is not bound to examine facts showing that the mark claimed has become distinctive through use within the meaning of Article 7(3) EUTMR unless the applicant has pleaded them (12/12/2002, T-247/01, Ecoply, EU:T:2002:319, § 47).

According to Article 2(2) EUTMR, the application may include a claim that the sign has acquired distinctive character through use within the meaning of Article 7(3) EUTMR, as well as an indication of whether this claim is meant as a principal or subsidiary one. Such claim may also be made within the period referred to in Article 42(2), second sentence, EUTMR.

Therefore, as from 01/10/2017 and in accordance with Article 2(2) EUTMR, the applicant can make the claim as a **principal** one (i.e. irrespective of the outcome on inherent distinctiveness), in which case the Office will take a single decision both on the mark's inherent distinctiveness and, where there is none, on the claim of acquired distinctiveness through use.

The second (new) option is to make the claim as a **subsidiary** one subject to a decision on inherent distinctiveness. In this case the Office will take **two** separate

decisions at different points in time: first, one on the mark's inherent distinctiveness and then, once that decision (finding lack of inherent distinctiveness) has become final, another on the claim of acquired distinctiveness through use.

The claim must clearly and precisely identify what type it is.

As regards the timing of the request, both types of claim may be made:

- together with the application; or
- at the latest, in reply to the examiner's first objection.

Therefore, it will not be possible to raise the claim of acquired distinctiveness through use for the first time in appeal proceedings.

Where the applicant has validly made a **subsidiary claim**, the examiner will only decide on the **inherent distinctiveness** of the mark applied for and allow (in application of Article 66(2) EUTMR) this partial decision to be appealed in a separate appeal. Once that partial decision has become final, the examiner will resume the examination proceedings regarding the claim for acquired distinctiveness through use, specifying — with reference to the final findings on lack of inherent distinctiveness (public, territory, goods and services) — the time limit for submitting the corresponding evidence to substantiate that claim.

### **3 The Point in Time for which Acquired Distinctiveness has to be Established**

The evidence must prove that distinctiveness through use was acquired prior to the EUTM application's filing date. In the case of an IR, the relevant date is the date of registration by the International Bureau or, if the designation takes place at a later stage, the designation date. Where priority is claimed, the relevant date is the priority date. Hereafter, all these dates are referred to as the 'filing date'.

#### **3.1 Examination proceedings**

Since a trade mark enjoys protection as of its filing date, and since the filing date of the application for registration determines the priority of one mark over another, a trade mark must be registrable on that date. Consequently, the applicant must prove that distinctive character was acquired through use of the trade mark prior to the date of application for registration (11/06/2009, C-542/07 P, Pure Digital, EU:C:2009:362, § 49, 51; 07/09/2006, C-108/05, Europolis, EU:C:2006:530, § 22). Evidence of use made of the trade mark after this date should not be automatically disregarded, insofar as it may provide indicative information regarding the situation prior to the date of application (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 49).

### 3.2 Cancellation proceedings

In cancellation proceedings, a trade mark that was registered in breach of the provisions of Article 7(1)(b), (c) or (d) EUTMR may nevertheless no longer be declared invalid if, in consequence of the use that has been made of it, it has, **after registration**, acquired distinctive character for the goods or services for which it is registered (Article 59(2) EUTMR).

The precise purpose of this norm is to maintain the registration of those marks that, due to the use that has been made of them, have in the meantime — that is to say, after their registration and in any event before the application for an invalidity request — acquired distinctive character for the goods or services for which they were registered, in spite of the fact that, when registration took place, they were contrary to Article 7 EUTMR (14/12/2011, T-237/10, Clasp lock, EU:T:2011:741, § 52-53, 86; 15/10/2008, T-405/05, Manpower, EU:T:2008:442, § 127, 146; 10/12/2008 T-365/06, BATEAUX MOUCHES, EU:T:2008:559, § 37-38).

## 4 Consumers

Distinctive character of a sign, including that acquired through use, must be assessed in relation to the perception of the average consumer for the category of goods or services in question. These consumers are deemed to be reasonably well informed, and reasonably observant and circumspect. The definition of the relevant public is linked to an examination of the intended purchasers of the goods or services concerned, since it is in relation to those purchasers that the mark must perform its essential function. Consequently, such a definition must be arrived at by reference to the essential function of a trade mark, namely to guarantee the identity of the origin of the goods or services covered by the mark to consumers or end users by enabling them, without any possibility of confusion, to distinguish the goods or services from others of another origin (29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 33, 38).

The relevant consumer includes, therefore, not only persons who have actually purchased the goods and services but also any potentially interested person in the strict sense of prospective purchasers (29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 41 et seq.).

Who prospective purchasers are is defined depending on the precise product or service for which registration is sought. If the claimed goods or services represent a broad category (for example, bags or watches), it is irrelevant that the actual products offered under the sign are extremely expensive luxury items — the public will include all the prospective purchasers for the goods claimed in the EUTM application, including non-luxury and cheaper items if the claim is for a broad category.



## 5 Goods and Services

Since the main function of a trade mark is to guarantee the origin of goods and services, acquired distinctiveness must be assessed in respect of the goods and services at issue. Consequently, the applicant's evidence must prove a link between the sign and the goods and services for which the sign is applied for, establishing that the relevant class of persons, or at least a significant proportion thereof, identify the goods and services as originating from a particular undertaking because of the trade mark (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 52; 19/05/2009, T-211/06, Cybercrédit et al., EU:T:2009:160, § 51).

## 6 Territorial Aspects

Pursuant to Article 1 EUTMR, a European Union trade mark has a unitary character and has equal effect throughout the European Union (EU). Accordingly, a mark must be refused registration even if it is devoid of distinctive character only in part of the EU. That part of the EU may be comprised of a single Member State (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 81-83; 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413 § 45 and the case-law cited).

As a logical consequence, acquired distinctiveness must be established throughout the territory in which the trade mark did not *ab initio* have distinctive character (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 83, 86; 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 30).

This may prove difficult and burdensome for the applicant, particularly with regard to three-dimensional or colour marks, where consumer perception of a potential lack of inherent distinctiveness will most likely be the same in each and every Member State of the EU. In this respect, the Court has held that, despite the fact that acquired distinctiveness must be shown **throughout the EU**, it would be **unreasonable** to require proof of acquired distinctiveness for **each individual Member State** (24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 62).

The question arises whether the Office can decide whether the evidence submitted to establish that a particular sign has acquired distinctive character through use is relevant for several Member States or even for the whole of the EU (see paragraph 6.3 below).

Evidence of acquired distinctiveness must be **examined as a whole**, taking into account, in particular, the market share held by the trade mark, and the intensity, frequency and duration of use of the mark (see paragraph 8 below). The evidence must establish that a significant proportion of the relevant public is able, by virtue of that mark, to identify the goods or services concerned as originating from a particular undertaking. Evidence from non-EU states is irrelevant, except insofar as it might

enable conclusions to be drawn about use within the EU (24/06/2014, T-273/12, Ab in den Urlaub, EU:T:2014:568, § 45).

## 6.1 Special provisions with respect to the accession of new Member States

In accordance with the provisions of the EU accession treaties, an EUTM applied for before the date of accession of a given Member State may only be rejected for reasons that already existed before the date of accession. Hence, in the Office's examination proceedings, acquired distinctiveness must be demonstrated only with respect to Member States of the EU at the time of the EUTM application, and not those that have joined the EU subsequently.

## 6.2 Language area

Without prejudice to the possibility of extrapolating the evidence (see paragraph 6.3 below), acquired distinctiveness through use must be shown, in principle, with respect to all those Member States/territories in which the EUTM applied for is objected to because:

- of its meaning in the official language of one or more Member State(s) (e.g. German in Austria and Germany); and/or
- it is in a Member State language understood by the relevant public of another Member State(s) in which that language is not an official one (e.g. basic English words); and/or
- it is in a language understood by a significant section of the relevant public in at least part of the EU, for example the Turkish word 'hellim' in Cyprus (13/06/2012, T-534/10, Hellim, EU:T:2012:292).

For further explanations about the different scenarios listed above, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trade Marks (Article 7(1)(c) EUTMR), paragraph 1.1.2.

Particular care should be taken when a language is an official language in more than one EU Member State. In such cases, when dealing with an absolute grounds objection based on the meaning of wording in a certain language, acquired distinctiveness through use must be proven for each of the Member States in which that language is official (as well as any other Member States or markets where it will be understood).

**Examples** of languages that are official languages in more than one EU Member State:

Language	Official language in the following Member States

Dutch	Belgium and Netherlands
English	Ireland, Malta and the United Kingdom <sup>(26)</sup> ,
French	Belgium, France and Luxembourg
German	Belgium, Germany, Luxembourg and Austria
Greek	Greece and Cyprus
Swedish	Finland and Sweden  (09/07/2014, T-520/12, Giffar, upholding 18/09/2012, R 46/2012-2, GIFFLAR (fig.))

It should also be taken into account that in some regions there are **substantial minorities** who have as their native language a language (or languages), other than the official language(s) of the Member State concerned, that is/are often also protected as minority language(s). By way of example, German is on a par with Italian in the Italian Autonomous Region Trentino-Alto Adige (10/10/2014, R 574/2013-G, SUEDETIROL, § 17) as is French with Italian in the Italian region of Valle d'Aosta, while Denmark has a substantial German-speaking minority (24/06/2014, T-273/12, Ab in den Urlaub, EU:T:2014:568, § 44).

### 6.3 Acquired distinctiveness throughout the EU

The acquisition of distinctive character through use must be proven for the part of the EU in which the trade mark concerned did not **initially** have this character.

This may prove difficult and burdensome for the applicant, particularly when the objection exists throughout the EU. This is normally the case for colour marks, shape marks consisting exclusively of the shape of the products themselves and purely figurative trade marks when they are found to be devoid of distinctive character, as it may be assumed that the assessment of their distinctiveness will be the same throughout the EU, unless there is concrete evidence to the contrary (24/02/2016, T-411/14, Shape of a bottle (3D), EU:T:2016:94, § 68).

The Court has pointed out that, where distinctiveness acquired through use has to be proved throughout the EU, it is not sufficient to prove it merely in a significant part of the EU (25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 78).

The Court has also held that, under these circumstances, it would be unreasonable to require proof of acquired distinctiveness for each individual Member State (24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 62).

<sup>26</sup> Subject to Brexit negotiation developments.

Furthermore, no provision in the EUTMR requires that the acquisition of distinctive character through use be established by separate evidence in each Member State. Therefore, it is possible that the evidence filed to establish that a particular sign has acquired distinctive character through use is relevant for several Member States or even for the whole of the EU (25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 80-83).

Two scenarios can be identified in this regard.

1. Regionalisation (division of the EU market into regional segments)

As the Court has confirmed, this may be the case:

1. where, for certain goods or services, the economic operators have grouped several Member States together in the same distribution network and have treated them, especially for marketing strategy purposes, as if they were one and the same market;
2. when, due to the geographical, cultural or linguistic proximity between two Member States, the relevant public in one of them has sufficient knowledge of the goods and services that are present on the national market of the other.

Therefore, where cross-border markets are sufficiently homogeneous, global evidence of distinctiveness acquired through use within such a cross-border market is likely to be relevant for all the Member States concerned, even if it contains little or no information for each Member State individually.

It follows that, although it is not necessary for the evidence of acquisition of distinctive character through use to be submitted for each individual Member State, this evidence must be capable of establishing the acquisition of distinctive character through use throughout the relevant territory (25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 83).

1. Extrapolation

Even where national markets cannot be grouped together or treated in a uniform manner, the conclusions on the acquisition of distinctive character reached on the basis of evidence concerning the territory of one or more Member States could be assumed to be applicable to other Member States too, if at least some evidence of use has been submitted regarding the latter, and if there are elements that allow this extrapolation — which would again require that the conditions in the respective markets are, if not the same, at least quite similar.

In that regard, the Court has held that evidence of acquired distinctiveness for the ‘combination of the colours green and yellow’ throughout the EU was acceptable despite a lack of turnover figures for two Member States, since it is not necessary to provide the same types of evidence for each and every Member State, considering also that the various items of evidence can be mutually corroborative (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 33-42 et seq.).

**In conclusion**, for both regionalisation and extrapolation to be successfully relied on, it is essential that the EUTM applicant convincingly explains the relevance of the

evidence for another Member State, for several Member States or for the whole of the EU, as the case may be.

For example, if surveys covering only some Member States have been submitted, the applicant will have to demonstrate that their results are also significant for other comparable national markets, either because of the similar marketing strategies applied or because of geographical, cultural or linguistic proximity (see, by analogy, 24/02/2016, T-411/14, *Shape of a bottle (3D)*, EU:T:2016:94, § 80).

The mere production of market surveys from five Member States, coupled with turnover figures, as well as marketing and advertising expenses collected Member State by Member State, could not establish the existence of one or more transnational markets made up of different Member States. Furthermore, the results of the surveys could neither be extrapolated to all the Member States, nor be completed and supported in the Member States that were not covered by those surveys (19/06/2019, T-307/17, *DEVICE OF THREE PARALLEL STRIPES* (fig.), EU:T:2019:427, § 155-157).

Similarly, market surveys in only eight Member States were found insufficient to prove that the relevant public in the EU attributed a unique commercial origin to a V-shaped guitar (28/06/2019, T-340/18, *SHAPE OF A FLYING V GUITAR (3D)*, EU:T:2019:455, § 67-68).

## **7 Standard of Proof**

The requirements to prove acquired distinctiveness through use pursuant to Article 7(3) EUTMR are not the same as those to prove genuine use pursuant to Article 47(2) EUTMR. Whilst under Article 7(3) EUTMR it is necessary to prove qualified use, such that the relevant public perceives as distinctive a sign that per se is devoid of distinctive character, the reason behind the proof of genuine use is completely different, namely to restrict the number of trade marks registered and protected, and consequently the number of conflicts between them.

Furthermore, the Court has held that the case-law relating to Article 7(3) EUTMR must not be confused with the case-law relating to the acquisition of reputation (which must be proven in a substantial part of the EU but not in every Member State). The applicant must prove the acquisition of distinctive character through use in the part of the EU in which the contested mark was devoid of any distinctive character. The case-law related to Article 7(3) EUTMR, therefore, must not be confused with the test on acquisition of reputation (21/04/2015, T-359/12, *Device of a checked pattern (maroon & beige)*, EU:T:2015:215, § 119-120 and case-law quoted therein).

Therefore, the EUTM applicant must submit evidence that enables the Office to find that at least a significant proportion of the relevant section of the public identifies the products or services concerned as originating from a particular undertaking because of the trade mark (15/12/2015, T-262/04, *Briquet à Pierre*, EU:T:2005:463, § 61 and the case-law cited therein).

The evidence must be clear and convincing. The EUTM applicant must clearly establish all the facts necessary to safely conclude that the mark has been used as a badge of origin, that is to say, that it has created a link in the mind of the relevant public with the goods or services provided by a specific company, despite the fact that, in the absence of such use, the sign at issue would lack the necessary distinctiveness to create such a link.

For example, the combination of the colours green and yellow was found to have acquired distinctiveness through use because it referred to the machines manufactured by a certain company. The means of evidence were a number of statements from professional associations according to which such combination referred to agricultural machines manufactured by that company and the fact that the company had been using the same combination of colours on its machines consistently in the EU for a considerable time prior to 1996 (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 36-37).

Therefore, acquired distinctiveness must be the result of the use of the mark as a trade mark, not as purely functional packaging (25/09/2014, T-474/12, Shape of goblets (3D), EU:T:2014:813, § 56-58 and the case-law cited therein) or as a descriptive indication on packaging. For example, use of the sign 'Giffjar' (which indicates a kind of bread in Swedish) on the packaging of pastries, together with descriptive indications of flavours, is made in a descriptive context, not as a badge of origin (09/07/2014, T-520/12, Giffjar, EU:T:2014:620, § 44-45).

For a finding of acquired distinctiveness through use, the case-law does not prescribe fixed percentages of market penetration or of recognition by the relevant public (19/06/2014, C-217/13 & C-218/13, Oberbank e.a., EU:C:2014:2012, § 48). Rather than using a fixed percentage of the relevant public in a given market, the evidence should show that a significant proportion of the public perceives the mark as identifying specific goods or services as originating from a particular undertaking.

The evidence must relate to each of the goods and services claimed in the EUTM application. After an initial absolute grounds objection under Article 7(1)(b), (c) or (d) EUTMR, only the goods and services claimed for which acquired distinctiveness through use has been proven may proceed to registration.

## 8 Assessment of the Evidence

In establishing acquired distinctiveness, account may be taken of, inter alia, the following **factors**:

- the market share held by the mark with regard to the relevant goods or services;
- how intensive, geographically widespread and long-standing use of the mark has been;
- the amount invested by the undertaking in promoting the mark for the relevant goods or services;
- the proportion of the relevant public who, because of the mark, identifies the goods or services as originating from a particular undertaking.

See judgments of 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 31; 29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 32.

Article 97 EUTMR contains a non-exhaustive list of **means of giving or obtaining evidence** in proceedings before the Office, which may serve as guidance to applicants. Examples of evidence that may help to show acquired distinctiveness include, inter alia:

- sales brochures
- catalogues
- price lists
- invoices
- annual reports
- turnover figures
- advertising investment figures and reports
- advertisements (press cuttings, billboard posters, TV adverts), together with evidence of their intensity and reach
- customer and/or market surveys
- affidavits.

For further details on means of evidence, see by analogy the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

As regards the structure and format in which written evidence must be submitted, Article 55 EUTMDR applies. For further details regarding annexes to communications to the Office, please see the Guidelines, Part A, General Rules, Section 1, Means of communication, Time limits, paragraph 3.1.3.

The basic rules on the **evaluation of evidence** are also applicable here. The Office must make an **overall assessment of all the evidence** submitted (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 49), weighing up each indication against the others.

Applicants should take great care to make sure not only that the evidence shows use of the **mark applied for** but also that it is sufficient to identify the **dates** of such use and the specific **geographical** territory of use within the EU. Evidence that cannot be related to a certain point in time will normally be insufficient to show that distinctiveness had been acquired before the filing date, and evidence of use outside the EU cannot show the required market recognition of the relevant public within the EU. Furthermore, evidence that mixes material relating to the EU with that relating to non-EU territories, and does not permit the Office to identify the specific extent of EU-only use, will be similarly devoid of probative value for the relevant EU public.

The Court has declared that direct evidence such as declarations by professional associations and market studies are usually the most relevant means for proving acquired distinctiveness through use. Invoices, advertising expenditure, magazines and catalogues may help to corroborate such direct evidence (29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 74).

In order to assess the evidential value of a document, regard should be had to its **credibility**. It is also necessary to take into account the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, superficially, the document appears sound and reliable (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 42; 16/12/2008, T-86/07, *Deitech*, EU:T:2008:577, § 46 et seq.).

## 8.1 Opinion polls and surveys

Opinion polls concerning the level of recognition of the trade mark by the relevant public on the market in question can, if conducted properly, constitute one of the most direct kinds of evidence, since they can show the actual perception of the relevant public. However, it is not an easy matter to correctly formulate and implement an opinion poll so that it can be seen to **be truly neutral and representative**. Leading questions, unrepresentative samples of the public, and undue editing of responses should be avoided, as these can undermine the probative value of such surveys.

Accordingly, any opinion poll evidence must be assessed carefully. It is important that the questions asked are not leading ones (13/09/2012, T-72/11, *Espetec*, EU:T:2012:424, § 79). The criteria for selecting the public interviewed must be assessed carefully. The sample must be indicative of the entire relevant public and must be selected randomly (29/01/2013, T-25/11, *Cortadora de cerámica*, EU:T:2013:40, § 88).

The Court does not exclude that a survey compiled some time before or after the filing date could contain useful indications, although it is clear that its evidential value is likely to vary depending on whether the period covered is close to or distant from the filing date or priority date of the trade mark application at issue. Furthermore, its evidential value depends on the survey method used (12/07/2006, T-277/04, *Vitacoat*, EU:T:2006:202, § 38-39).

However, the Court of Justice has made it clear that the results of a consumer survey cannot be the only decisive criterion in support of the conclusion that distinctive character has been acquired through use (19/06/2014, C-217/13 & C-218/13, *Oberbank e.a.*, EU:C:2014:2012, § 48). They must therefore be complemented by other means of evidence.

For further details on the assessment of opinion polls, see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

## 8.2 Market share, advertising and turnover

The **market share** held by the trade mark in relation to the goods and/or services applied for may be relevant for assessing whether that mark has acquired distinctive character through use, since such market penetration might enable the Office to infer



that the relevant public would recognise the mark as identifying the goods or services as originating from a specific undertaking, and thus distinguish them from the goods and services of other undertakings.

The **investment** in advertising or promoting the mark in the relevant market for the goods or services claimed may also be relevant for assessing whether the mark has acquired distinctive character through use (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 76 et seq.). However, many attempts to prove distinctiveness acquired through use fail because the evidence provided by the applicant is not sufficient to prove a link between the market share and advertising, on the one hand, and consumer perceptions on the other.

Information concerning **turnover** and advertising expenses is one of the most readily available forms of evidence. These figures can have a significant impact on the assessment of the evidence, but in the great majority of cases are not sufficient alone to prove acquired distinctiveness of a trade mark through use. This is because turnover/advertising costs alone, without additional corroborative details, are frequently too general to allow specific conclusions to be drawn about the use of one particular trade mark. It is thus necessary to identify precisely the turnover/advertising figures and evidence relating to the mark applied for, as well as their link to the relevant goods and services. Furthermore, it is desirable that the figures be segregated on an annual and market-by-market basis. The evidence should show the specific period(s) of use (including details of when use commenced), so that the Office is able to establish whether the evidence proves that the trade mark acquired distinctiveness before the filing date.

Goods and services are often marketed under several trade marks, which makes it difficult to see the relevant customer's perception of the EUTM applied for on its own, that is to say, without such perception being affected by the other marks present. Turnover and advertising figures can often include sales or promotion of other trade marks, or of significantly different forms of the trade mark at issue (for example, figurative trade marks rather than word marks, or differing word elements in a figurative mark), or are too general to allow identification of the specific markets under consideration. As a consequence, broadly consolidated turnover or advertising figures may not be sufficient to prove whether the relevant public perceives the trade mark at issue as a badge of origin or not.

For further details on the assessment of market share, advertising and turnover, see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

### 8.3 Declarations, affidavits and written statements

Pursuant to Article 97(1)(f) EUTMR, 'statements in writing, sworn or affirmed or having a similar effect under the law of the State in which [they are] drawn up' are valid means of evidence. With regard to **admissibility**, only in cases where the statements have not been sworn or affirmed is it necessary to consider the rules of law of the national

jurisdiction as to the effects of a written statement (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 40). In case of doubt as to whether a statement has been sworn or affirmed, it is up to the applicant to submit evidence in this regard.

The weight and **probative value** of statutory declarations is determined by the general rules applied by the Office to the assessment of such evidence. In particular, both the capacity of the person giving the evidence and the relevance of the contents of the statement to the particular case must be taken into account.

Statements from **independent trade associations, consumer organisations and competitors** are an important means of evidence insofar as they come from independent sources. However, they must be examined carefully, as they might not be enough to prove distinctiveness acquired through use if, for example, they refer to ‘the trade marks of the applicant’ instead of to the specific mark in question (13/09/2012, T-72/11, *Espetec*, EU:T:2012:424, § 83-84).

Evidence from **suppliers or distributors** should, generally, be given less weight, since it is less likely that their evidence will be from an independent perspective. In this regard, the degree of independence of the latter will influence the weight to be given to the evidence by the Office (28/10/2009, T-137/08, *Green/Yellow*, EU:T:2009:417, § 54-56).

Insofar as a declaration is **not made by an independent third party**, but by a person connected to the applicant through an employment relationship, it cannot in itself constitute sufficient evidence that the mark applied for has acquired distinctive character through use. In consequence, it must be treated as merely indicative and needs to be corroborated by other evidence (21/11/2012, T-338/11, *PHOTOS.COM*, EU:T:2012:614, § 51)

As regards **statements from chambers of commerce and industry or other trade and professional associations and certifications and awards**, the Court has noted that such statements and certifications must identify precisely the trade mark applied for (13/09/2012, T-72/11, *Espetec*, EU:T:2012:424, § 82 et seq.).

However, **cease and desist letters** against competitors or letters to newspapers complaining against the use of the sign in a generic sense have been considered evidence against acquired distinctiveness (21/05/2014, T-553/12, *BATEAUX MOUCHES*, EU:T:2014:264, § 66)

For further details on the assessment of means of evidence, see the Guidelines, Part C, Opposition, Section 5, Trade Marks with Reputation (Article 8(5) EUTMR), paragraph 3.1.4.4.

## 8.4 Prior registrations and acquired distinctiveness

For evidence that consists of or includes Member State registrations **obtained on the basis of acquired distinctiveness**, the date to which the evidence submitted at national level refers will usually be different from the filing date of the EUTM application. These registrations are not binding, but may be taken into account,

provided that the Office is able to assess the evidence submitted to the national IP office in question.

The applicant may also refer to **prior national registrations** where no acquired distinctiveness is claimed. Nevertheless, it is established case-law that such registrations do not bind the Office. Moreover, the Office is not bound by its previous decisions and such cases must be assessed on their own merits (21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264, § 72-73).

## 8.5 Manner of use

Acquired distinctiveness must be demonstrated with respect to the sign applied for. The evidence should show examples of how the trade mark is actually used (brochures, packaging, samples of the goods, etc.). Only insignificant variations may be acceptable.

It is possible to prove acquired distinctiveness of a sign that **has been used together with other trade marks** (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 27), provided that the relevant consumer attributes to the sign in question the function of identification (07/07/2005, C-353/03, Have a break, EU:C:2005:432; 30/09/2009, T-75/08, !, EU:T:2009:374, § 43; 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 46).

The Court further ruled that, although the trade mark for which registration is sought may have been used as part of a registered trade mark or in conjunction with such a mark, the fact remains that, for the purposes of registration of the mark itself, the trade mark applicant must prove that that mark alone, as opposed to any other trade mark that may also be present, identifies the particular undertaking from which the goods originate (16/09/2015, C-215/14, Nestlé KIT KAT, EU:C:2015:604, § 66; 24/02/2016, T-411/14, Shape of a bottle (3D), EU:T:2016:94, § 76; 16/03/2016, T-363/15, LAATIKON MUOTO (3D), EU:T:2016:149, § 51).

Moreover, the Court has held on numerous occasions that **advertising material** on which a sign that is devoid of any distinctive character always appears with other marks that, by contrast, do have distinctive character does not constitute proof that the public perceives the sign applied for as a mark that indicates the commercial origin of the goods. For instance, the Court considered that the use of the sign 'Gifflar' (which indicates a kind of bread in Swedish) on the packaging of pastries, together with the trade mark Pågen, was made in a descriptive context, not as a badge of origin (09/07/2014, T-520/12, Gifflar, EU:T:2014:620, § 44-45).

## 8.6 Length of use

The evidence should indicate when use commenced and should also show that the use was continuous or indicate reasons if there are gaps in the period of use.

As a general rule, long-standing use is likely to be an important persuasive element in establishing acquired distinctiveness. The longer customers and potential customers have been exposed to a mark the more likely they are to have made the connection between that mark and a single source in trade.

Considering, however, that length of use is only one of the factors to be taken into account, there may be situations where exceptions to the above rule are justified, in particular when other factors may also come into play that are capable of making up for a short length of use. For example, where products or services are the subject of a major advertising launch and/or the sign applied for is a mere variant of a sign already in long use, it may be the case that acquired distinctiveness can be achieved quite quickly.

This could be the case, for instance, where a new version of an existing and widely used computer-operating system is launched under a sign that essentially reproduces the structure and/or contents of the trade mark applied to previous versions of the product. The trade mark for such a product would be capable of achieving widespread acquired distinctiveness within a fairly short period of time simply because all existing users will immediately be made aware that the sign applied for refers to the upgrading to the new version.

In the same vein, it is in the nature of certain major sporting, musical or cultural events that they take place at regular intervals and are known to have extremely wide appeal. These major events are anticipated by millions, and the knowledge that the event is due on a particular date precedes the formal announcement of where it will take place. This circumstance creates intense interest in the nominated location of such events and in the announcement thereof ('city/country+year' marks). It is therefore reasonable to suppose that the moment a particular event, tournament or games is announced as having been allocated to a particular city or country, it is likely to become known instantly to practically all relevant consumers with an interest in the sector concerned or to professionals in the sector. This may thereby give rise to the possibility of very rapid acquired distinctiveness of a mark concerning a forthcoming event, in particular where the sign reproduces the structure of previously used trade marks with the result that the public immediately perceives the new event as a sequel to a series of well-established events.

The assessment of such rapid acquired distinctiveness will follow the general criteria regarding, for instance, extent of use, territory, relevant date or targeted public, as well as regarding the onus on the applicant to provide evidence thereof. The only particularity refers to length of use and the possibility that, under certain circumstances, the acquisition of acquired distinctiveness may occur very rapidly, or even instantaneously. As under any other claim for acquired distinctiveness, it is for the applicant to demonstrate that the public is able to perceive the trade mark in question as a distinctive sign.

## **8.7 Post-filing-date evidence**

The evidence must show that, prior to the filing date, the trade mark had acquired distinctive character through use.

However, this does not preclude the possibility that account may be taken of evidence that, although subsequent to the filing date, enables conclusions to be drawn regarding the situation as it was on the filing date (19/06/2014, C-217/13, Oberbank e.a., EU:C:2014:2012, § 60). Therefore, evidence cannot be rejected merely because it post-dates the filing date. Accordingly, such evidence must be assessed and given due weight.

As an example, a trade mark that enjoys particularly relevant recognition on the market or a substantially relevant market share a few months after the filing date may have had acquired distinctiveness also on the filing date.

## **9 Consequences of Acquired Distinctiveness**

A trade mark registered in accordance with Article 7(3) EUTMR enjoys the same protection as any other trade mark that was found inherently registrable upon examination.

If the EUTM application is accepted based on Article 7(3) EUTMR, this information is published in the EUTM Bulletin, using INID code 521.

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

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

### ***Part B***

#### ***Examination***

#### ***Section 4***

#### ***Absolute grounds for refusal***

#### ***Chapter 15 European Union collective marks***

## Table of Contents

<b>1 Character of Collective Marks.....</b>	<b>584</b>
1.1 Definition.....	584
1.2 Specific function.....	584
1.3 Relationship with individual and certification marks.....	584
1.4 Applicable provisions and examination.....	585
<b>2 Ownership.....</b>	<b>586</b>
<b>3 Specific Absolute Grounds of Refusal.....</b>	<b>586</b>
3.1 Misleading as to the character or meaning of the mark.....	586
3.2 Regulations governing use.....	587
3.2.1 Filing.....	587
3.2.2 Content.....	587
3.2.3 Compliance with public policy and morality.....	588
3.2.4 Remedies.....	588
<b>4 Specificities as Regards the General Absolute Grounds for Refusal.....</b>	<b>588</b>
4.1 Descriptive signs and the 'geographical derogation'.....	588
4.2 Objections raised under Article 7(1)(j), (k) or (l) EUTMR.....	589

## **1 Character of Collective Marks**

### **1.1 Definition**

A European Union collective mark (EU collective mark) is a specific kind of EUTM that, pursuant to Article 74(1) EUTMR, 'is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings'.

It is one of the three kinds of marks set out in the Regulation, along with individual marks and certification marks.

### **1.2 Specific function**

An EU collective mark distinguishes the goods and services of the members of the association that owns the mark from those of other companies that do not belong to that association. Therefore, the EU collective mark qualifies the commercial origin of certain goods and services by informing the consumer that the producer of the goods or the service provider belongs to a certain association and has the right to use the mark.

An EU collective mark is typically used by companies, together with their own individual marks, to indicate that they are members of a certain association. For example, Spain's Association of Shoe Manufacturers may want to apply for the collective mark 'Asociación Española de Fabricantes de Calzado', which, while belonging to the association, is also going to be used by all its members. A member of the association may want to use the collective mark in addition to its own individual mark, which could be, for example, 'Calzados Luis'.

### **1.3 Relationship with individual and certification marks**

It is up to the applicant to decide whether the trade mark fulfils the requirements of a collective mark, as opposed to those of an individual mark or certification mark within the meaning of Article 83 EUMTR. This means that, in principle, the same sign applied for as an EU collective mark might also be applied for as an individual EUTM or EU certification mark, provided that the respective conditions of the EUTMR are met for each application. The three kinds of marks do not differ necessarily with respect to the signs per se but as regards other characteristics specific to each one of them, including, in particular, the requirements of ownership and the conditions of use of the mark.

However, an applicant should be aware of the fact that, in the event of having to subsequently demonstrate genuine use of the marks, it will probably be rather difficult



to show use of the same sign for different kinds of marks. For further information regarding genuine use of a mark in accordance with its function, please see the Guidelines, Part C, Opposition, Section 6, Proof of Use, paragraph 2.3.1.

For example, an association can file an application for the word mark ‘Tamaki’ either as an individual mark, a certification mark or a collective mark, depending on the mark’s intended use (by the association itself or its members, or as a sign of guarantee of a characteristic or not). If it is applied for as an EU collective mark, certain additional formalities must be met, such as the submission of regulations governing use (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2).

After filing the application, changes to the kind of mark (between collective, certification and individual marks) are accepted only when it is obvious from the application that the wrong kind of mark has been selected (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.4).

## 1.4 Applicable provisions and examination

The EUTMR provisions apply to EU collective marks, unless Articles 75 to 82 EUTMR provide otherwise. On the one hand, EU collective marks are therefore subject to the general EUTM regime and on the other hand, to some exceptions and particularities.

It follows, firstly, that an application for an EU collective mark is, in principle, subject to the same examination procedure and conditions as an application for an individual mark. In general terms, the classification of goods and services, and the examination of formalities and of absolute grounds for refusal, follow the same procedure as that applied to individual trade marks.

For example, examiners will check the list of goods and services or the language requirements in the same way as they do with individual trade marks. Similarly, if the EU collective mark falls under one of the grounds for refusal of Article 7 EUTMR, this will also be examined.

Pursuant to the new provision of Article 16 EUTMR, the regulations submitted by the applicant governing the use of its EU collective mark **must cover its use for all the goods and services** included in the list of the EU collective mark application. For EU collective marks conflicting with PGIs/PDOs, traditional terms for wine or traditional specialties guaranteed, the regulations governing the use of an EU collective mark should accurately reflect any limitation introduced to overcome such conflicts. For example, the regulations governing use of the EU collective mark ‘XYZ Designation of Origin’ for *wines* should accurately reflect the fact that they refer to the use of the trade mark for *wines complying with the PDO ‘XYZ’*.

Secondly, the examination of an EU collective mark will also consider the exceptions and particularities of this kind of mark. These exceptions and particularities refer both to the formal and substantive provisions. As regards formalities, the requirement for regulations governing use of the mark is, for example, a specific characteristic of an EU collective mark. (For further details of the examination of formalities of EU collective

marks, including the regulations governing use of the mark, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2).

The substantive exceptions and particularities that apply to an EU collective mark are described below.

## 2 Ownership

Ownership of EU collective marks is limited to (i) associations of manufacturers, producers, suppliers of services, or traders that, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued; and (ii) legal persons governed by public law (Article 74 EUTMR).

The first type of owner typically comprises private associations with a common purpose or interest. They must have their own legal personality and capacity to act. Therefore, multiple applicants, each with a separate legal personality, or temporary unions of companies cannot be owners of an EU collective mark. As set out in the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2.1, '[c]ollective does not mean that the mark belongs to several persons [co-applicants/co-owners] nor that it designates/covers more than one country'.

Associations may be organised under different legal forms, including that of private corporations (such as *Gesellschaften mit beschränkter Haftung*). However, as the latter are generally not organised as associations, the Office considers that a private corporation cannot be the owner of an EU collective mark unless it shows that its internal structure is of an associative nature.

The same applies to the second type of owners. 'Legal persons governed by public law' have to be either associations in a formal sense or need to have an internal structure of an associative nature (the broader approach, in decision of 10/05/2012, R 1007/2011-2, REPRESENTATION OF A FLAG WITH STARS (fig.), § 17, relates to the state of the law prior to the creation of the EU certification mark by Regulation 2015/2424). This concept includes, for example, associations or corporations governed by public law, such as the *consejos reguladores* or *colegios profesionales* under Spanish law.

## 3 Specific Absolute Grounds of Refusal

### 3.1 Misleading as to the character or meaning of the mark

Under Article 76(2) EUTMR, the examiner must refuse the application if the public is liable to be misled as regards the character or the meaning of the mark, in particular if it is likely to be perceived as something other than a collective mark.

This refers to the situation where the mark will not be perceived as a collective mark by the public, but rather as an individual or certification mark.

For example, a collective mark that is available for use only by members of an association that owns the mark could be liable to mislead if it gives the impression that it is available for use by anyone that is able to meet certain objective standards.

It could also mislead if it conveys a strong certification message (for example,



(invented example), which is a clear contradiction of the function of the collective mark).

A collective mark would not, as such, be considered misleading as to its character by the sole fact that the regulations governing use may also include specific requirements of use with respect to the quality of the goods and services protected by the mark. However, where examination of the regulations governing use reveals that the mark is actually to be used as a certification mark and not as an indicator that the goods and services come from the members of the association, it will be considered to mislead the public.

## 3.2 Regulations governing use

### 3.2.1 Filing

The regulations governing use may be filed within **2 months** of the application of the collective mark (Article 75(1) EUTMR) and their content must comply with the requirements of Article 16 EUTMR.

### 3.2.2 Content

The regulations governing use form an **integral part of the collective mark**.

They must **specify** the persons authorised to use the mark and the conditions for membership of the association, and can also include the conditions of use of the mark (Article 16 EUTMR).

The regulations governing use should reflect the specific kind of mark of the application and the fact that the mark is indeed a collective mark, which will be used by the members of the association.

In addition, where the collective mark is applied for by making use of the 'geographical derogation' (see paragraph 4.1 below), the regulations governing use must explicitly authorise any person whose goods or services originate in the geographical area concerned to become a member of the association that is the proprietor of the mark.

Substantive examination of the application will begin only once the regulations governing use have been received.

### 3.2.3 Compliance with public policy and morality

If the regulations governing use of the mark are contrary to **public policy** or to **accepted principles of morality**, the EU collective mark application must be refused under Article 76(1) EUTMR. This ground for refusal applies in addition to Article 7(1)(f) EUTMR, which relates in the first place to the sign applied for.

It refers to situations where, regardless of the trade mark, the regulations governing use of the mark contain a provision that is contrary to public policy or to accepted principles of morality. This would be the case, for example, where the authorisation or conditions of use discriminate between market operators without due justification (such as a lack of objective criteria or the application of inadmissible criteria) or where the regulations governing use establish manifestly discriminatory fees.

### 3.2.4 Remedies

In some cases, it will be possible to amend the regulations governing use in order to remove a ground for refusal of an EU collective mark application (Article 76(3) EUTMR) raised by the Office under Articles 76(1) and (2) EUTMR.

## 4 Specificities as Regards the General Absolute Grounds for Refusal

In addition to the specific grounds for refusal applicable to collective marks, applications for this kind of mark need to be examined with regard to the absolute grounds for refusal listed in Article 7(1) EUTMR (Article 74(3) EUTMR). This means that EU collective mark applications will, like any other EUTM application, be assessed on **all** general grounds for refusal laid down in Article 7(1) EUTMR.

If, for example, a collective mark is not inherently distinctive under Article 7(1)(b) EUTMR, it will be refused (18/07/2008, R 229/2006-4, CHARTERED MANAGEMENT ACCOUNTANT, § 7).

### 4.1 Descriptive signs and the ‘geographical derogation’

Pursuant to Article 74(2) EUTMR, signs or indications that may serve, in trade, to designate the geographical origin of the goods or services may constitute EU collective marks.

As a result, a **sign that describes the geographical origin of the goods or services** (and that would be refused if it were applied for as an individual EUTM) **can be accepted** if:

- it is validly applied for as an EU collective mark; and
- it complies with the authorisation set out in Article 75(2) EUTMR (05/10/2006, R 280/2006-1, VINO NOBILE, § 16-17). According to this provision, the regulations

governing use of an EU collective mark that is descriptive must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association that is the proprietor of the mark.

For example, an application for the word mark 'Alicante', specifying *tourist services*, should be refused under Article 7(1)(c) EUTMR if it is applied for as an individual EUTM, given that it describes the geographical origin of the services. However, as an exception, if it is validly applied for as an EU collective mark (i.e. it is applied for by an association or a legal person governed by public law and it complies with the other requirements of EU collective marks) and the regulations governing use of the mark contain the authorisation set out in Article 75(2) EUTMR, it will be accepted for registration.

A sign that describes the geographical origin of the goods or services comprises those signs that **exclusively include a geographical term** but also those signs that include **other non-distinctive or generic terms**, for example EU collective mark No 13 729 611, Bio LËTZEBUERG, for goods and services in Classes 29, 30, 31, 32, 33 and 35.

This exception only applies to those signs that are descriptive of the geographical origin of the goods and services. If the EU collective mark is **descriptive of other characteristics of the goods or services**, this exception does not apply and the application will be refused under Article 7(1)(c) EUTMR (08/07/2010, R 934/2010-1, ENERGY WINDOW, § 38; 12/12/2014, R-1360/2014-5, DOWNMARK, § 35; 15/11/2012, T-278/09, GG, EU:T:2012:601, § 48, 49; 17/05/2011, T-341/09, Txakoli, EU:T:2011:220, § 33-35).

## 4.2 Objections raised under Article 7(1)(j), (k) or (l) EUTMR

In the event that the goods and services have to be limited as a consequence of an objection raised under Article 7(1)(j) (geographical indication), 7(1)(k) (traditional terms for wines) or 7(1)(l) EUTMR (traditional specialties guaranteed), the applicant of the EU collective mark **has to amend the regulations governing use accordingly** (Article 16(h) EUTMR). For further information regarding these objections, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapters 10, 11 and 12.

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

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

### ***Part B***

#### ***Examination***

#### ***Section 4***

#### ***Absolute grounds for refusal***

#### ***Chapter 16 European Union certification marks***

## Table of Contents

<b>1 Relevant Provisions.....</b>	<b>592</b>
<b>2 Definition and Specific Function.....</b>	<b>592</b>
2.1 Definition.....	592
2.2 Specific function.....	593
<b>3 Main Elements.....</b>	<b>593</b>
3.1 Sign and distinguishing capacity.....	593
3.2 Description as certification mark.....	593
3.3 List of goods and services.....	593
3.4 Regulations governing use.....	594
<b>4 Specific Requirement as Regards Ownership.....</b>	<b>595</b>
<b>5 Examination of the Specific Grounds of Refusal.....</b>	<b>596</b>
5.1 Misleading as to the character or the meaning of the mark.....	596
5.2 Certification of geographical origin.....	596
5.3 Regulations governing use.....	598
5.3.1 Standard to be certified.....	599
5.3.2 Persons authorised to use the mark.....	600
5.3.3 Testing, supervision and conditions of use, sanctions.....	600
5.3.4 Compliance with public order.....	601
5.3.5 Remedies.....	601
<b>6 Specificities as Regards Examination of the General Grounds for Refusal.....</b>	<b>601</b>

## 1 Relevant Provisions

As of 1 October 2017, the certification mark is **codified as a new kind of European Union trade mark** governed by **specific provisions**. Its main objective is to provide a specific legal framework for protecting EU certification marks (see recital 27 of Regulation (EU) 2015/2424 amending Council Regulation (EC) No 207/2009). Until the latest amendment of the EUTMR by Amending Regulation (EU) 2015/2424, **certification marks** could not be protected as European Union trade marks.

The relevant specific provisions for certification marks have been laid down in **Chapter VIII EUTMR** and are completed by the provision of **Article 17 EUTMR**. EU designations in international registrations (IRs) are addressed in **Article 194 EUTMR**.

The **general provisions of the EUTMR apply** to EU certification marks as well, **unless the specific provisions** of Articles 83 to 93 EUTMR **provide otherwise**. The latter lay down some particularities and exceptions to the general EUTM regime as regards EU certification marks, which need to be taken into account when filing and examining such marks.

## 2 Definition and Specific Function

### 2.1 Definition

The certification mark is a third kind of European Union trade mark established by the EUTMR in addition to the individual trade mark and the collective trade mark.

Article 83(1) EUTMR defines the EU certification mark as a mark that ‘is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified’.

The **list** of possible characteristics to be certified by an EU certification mark is **non-exhaustive** and can relate to characteristics other than material, mode of manufacture or performance, quality or accuracy. It explicitly **excludes**, however, the possibility of certifying the **geographical origin** of goods or services.

The owner of the certification mark does not necessarily have to provide the certification services itself. It is sufficient that the certification process is conducted under its control and supervision (see paragraph 5.3.3 below).



## 2.2 Specific function

A certification mark indicates that the goods or services bearing the mark (i) comply with a given standard set out by the owner of the mark (ii) as a result of a control set up by the certification mark owner, (iii) irrespective of the identity of the undertaking that actually produces or provides the goods and services at issue and actually uses the certification mark.

The certification mark's essential distinguishing function, therefore, relates to the **guarantee of specific characteristics** of certain **goods and services**.

## 3 Main Elements

### 3.1 Sign and distinguishing capacity

First, as with any EUTM, a certification mark needs to be a **sign** capable of being represented on the Register of European Union trade marks. In this respect, the general rules apply (Article 83(3) and Article 4 EUTMR).

Second, the sign should have the **capacity to fulfil the certification mark's specific function** of distinguishing goods or services that are certified with respect to a given standard from those that are not so certified (Article 83(1) and (3), Article 4(a) and Article 7(1)(a) EUTMR).

### 3.2 Description as certification mark

The applicant for a certification mark has to describe it as such in its application (Article 83 EUTMR). Therefore, when submitting an application, the applicant will include a **statement** to the effect that the application is for registration of an EU certification mark (Article 2(1)(i) EUTMR).

The kind of mark selected by the applicant will not be changed to any other kind of mark unless examination of the application reveals that the kind of mark indicated in the application is **obviously** wrong (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.4).


### 3.3 List of goods and services

Certification marks should be applied for in respect of the goods and services that will be certified by the owner of the mark.

The list of goods and services has to comply with the general rules of precision and clarity (Article 33 EUTMR).

The list does not need to contain an explicit statement that the goods and services listed are subject to certification (in general or against a particular standard), as a certification mark has in any case to be ‘described as such’ in the application.



For example, if the sign  were applied for as a certification mark for *nuts, crackers and muffins* (invented example), there would be no need to explicitly specify *certified by* ‘name of the applicant’, nor *under the certification of the certified vegan logo* or any other indication relating to the certification process itself. The applicant could simply apply for the certification mark for *vegan nuts, vegan crackers and vegan muffins*.

The list of goods and services of an EU certification mark application must also be included in the regulations of use (Article 17(d) EUTMR). The two lists (goods and services filed in the application and those listed in the regulations of use) must be identical.

### 3.4 Regulations governing use

The regulations governing use constitute an **essential element** of the certification mark since they contain information on the certification scheme and thus define its subject matter. They need to contain, in particular, the characteristics of the goods or services to be certified, the conditions of use of the certification mark and the testing and supervision measures to be applied by the certification mark owner (Article 84(2) EUTMR, Article 17 EUTMR). Given their significance, the regulations of use should be drafted in a **clear** and **accessible** manner (see paragraph 5.3 below).

The Office has prepared a template to guide applicants in the process of drafting the regulations of use; it is available on the Office website under [this link](#) (at the bottom of the page).

The regulations governing use may be filed within **2 months** of the application for the certification mark (Article 84(1) EUTMR); for further details regarding the content of the regulations governing use, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.3. The substantive examination of the application will, however, only begin once the regulations governing use have been received.

If the regulations governing use are amended, the complete modified version of the text must be submitted to the Office (Article 88(1) EUTMR), which will verify that the modifications satisfy the requirements of Article 84(2) EUTMR and Article 17 EUTMR and do not raise any grounds for refusal applicable to EU certification marks referred to in Article 85 EUTMR). When the regulations governing use refer to standards established in official or generally available sources, any changes of these standards automatically apply to the regulations governing use. In such cases, it is not necessary to amend the regulations governing use already filed at the Office.

## 4 Specific Requirement as Regards Ownership

**Any** natural or legal person can apply for and be an owner of an EU certification mark. Article 83(2) EUTMR clarifies that this includes ‘institutions, authorities and bodies governed by public law’.

The only, yet important, **limitation** is that a certification mark cannot be owned by a person running a business involving the supply of the goods and services of the kind certified (Article 83(2) EUTMR).

The **owner** of a certification mark is **precluded from using the mark** for the certified goods or services covered.

The reasons are that it would not make much sense that the proprietor certifies its own goods and services; a certifier should be neutral with respect to the business interests of the producers of the goods and the suppliers of the services it certifies.

That ‘**duty of neutrality**’ has to be understood broadly: the proprietor must not have any economic (business) interest on the relevant market.

This is, in particular, not fulfilled where:

- the producer of the goods or the supplier of the services to be certified, although formally distinct from the owner of the certification mark, is economically linked to the latter;
- use of the certification mark is conditioned by use of the goods or services provided by the owner of the certification mark (e.g. when a raw material is supplied by the owner of the certification mark). However, it is acceptable for the owner to provide some training on the certification scheme to its users since (and as long as) it is an economical field that is different from the goods and services of the kind certified.

Non-respect of this duty of neutrality by the owner of a certification mark therefore constitutes a specific ground for revocation of the certification mark (Article 91 EUTMR); see the Guidelines, Part D, Cancellation, [Section 2, Substantive Provisions](#).

The applicant has to include in the regulations governing use a **declaration** that it complies with this requirement (see Article 17(b) EUTMR and the Guidelines, Part B, Examination, Section 2, Formalities, for further details).

When examining an application for a certification mark, the Office will assume the applicant’s good faith in this respect and, for example, not object to the application for a certification mark where the applicant already owns a national or European Union mark that covers the goods and services to be certified.

The application will, however, be **rejected if it becomes evident** in the course of the proceedings (e.g. from third-party observations) that the **applicant** actually **runs a business on the relevant market**.

## 5 Examination of the Specific Grounds of Refusal

### 5.1 Misleading as to the character or the meaning of the mark

Under Article 85(2) EUTMR, an EU certification mark application must be refused if the public is liable to be misled as regards the character or the meaning of the mark, in particular if it is likely to be perceived as something other than a certification mark.

The EUTMR does not require that the depiction of the certification mark assumes a specific form or includes a specific text, such as a reference to its kind. The absence of such information does not imply that the mark will be perceived as anything other than a certification mark.

The public is also liable to be misled when **the sign** indicates a quality that is different from or contradicts the subject of the quality standard as stated in the regulations governing use. For example, 'ABC test pure orange juice' for *soft drinks*, where the regulations governing use certify that it contains juice made from apples.

To conclude, the perception of the sign by the relevant consumer is decisive. This perception will depend, on the one hand, on the sign itself and, on the other hand, on the specification of use of the mark as laid down in the regulations governing use, and the goods and services covered.

### 5.2 Certification of geographical origin

Pursuant to Article 83 EUTMR, an EU certification mark will not be capable of distinguishing goods or services certified in respect of the geographical origin.



This exception should be understood as a bar to any mark applied for:

- where the **sign** will be **perceived by the relevant public** as an indication that the goods or services at issue will be certified in respect of their geographical origin;
- where the **Regulations of use** indicate that the characteristic being certified is the geographical origin of the goods or services or impose an obligation of geographical nature (e.g. the location of the place of production);
- where the **list of goods and services** explicitly specifies that the goods and services have a geographical origin or comply with a PDO/PGI.


A certification mark that contains an inclusion of, or reference to, a **protected** geographical indication (PDO/PGI) — in its sign, list of goods and services and/or regulations governing use — will be objected under Article 83 EUTMR since by definition protected geographical indications are linked to a specific geographical origin and will be perceived as such.

However, when the reference to a geographical term does not imply any geographical origin of the goods and services the application will not fall within the scope of the objection of Article 83 EUTMR.

Examples of applications **refused** under Article 83 EUTMR:

EUTM No	Sign	Goods and services	Reasoning
17 596 917		Classes 29, 30 and 31	In particular, the rules of use clearly state that the certification mark intends to certify a geographical origin, namely that the goods in question originate from animals that have been bred according to certain specifications, among which is the necessary link to Denmark or the Danish area.
17 277 245		Class 9: oils and fats	<p>The sign contains a verbal expression that gives direct information about the geographical origin of the goods (Styrian pumpkin oil).</p> <p>It reproduces a registered PGI 'Steirisches Kürbiskernöl' for edible oil.</p> <p>The regulations of use explicitly mention that the goods are certified in relation to their geographical origin.</p>

Example of an application containing a geographical term **and registered**:

EUTM No	Sign	Goods and services	Reasoning (under Article 83 EUTMR and the prohibition of geographical origin)
17 870 740		Class 44	<p>The geographical reference in the sign ('German') read in combination with the other word elements and, in particular, the overall expression 'certified by the German cardiac society' will not be perceived as an indication of the geographical origin of the goods and services but as an indication of the certifier itself.</p> <p>There was no element in the regulations of use that would suggest otherwise.</p>

### 5.3 Regulations governing use

Given their particular significance, the regulations governing use should be drafted in a **clear** and **accessible** manner, that is to say, with sufficient clarity and precision to enable both the Office to examine the application and the market operators to understand the requirements that must be met for using the certification mark.

The regulations governing use are to be filed within **2 months** of submitting the application for the certification mark (Article 84(1) EUTMR) and, pursuant to Article 17 EUTMR, should contain:

1. the applicant's name;
2. a declaration by the applicant confirming that it complies with the requirements laid down in Article 83(2) EUTMR (that it is not engaged in business involving the supply of goods and services of the kind certified);
3. the representation of the EU certification mark (**identical** to the sign applied for and with no additional sign or possible variations of the sign. However, it is possible to indicate that the sign will be used in combination with (an)other informative

- element(s), for example, that it is a certification mark or the characteristic being certified, so long as this is not misleading as to the kind or nature of the mark);
4. the goods or services covered by the EU certification mark (**identical** to the list of goods and services of the application);
  5. the characteristics of the goods or services to be certified by the EU certification mark, such as the material, mode of manufacture of goods or performance of services, quality or accuracy;
  6. the conditions governing the use of the EU certification mark, including sanctions;
  7. the persons authorised to use the EU certification mark;
  8. how the certifying body will test those characteristics and supervise the use of the EU certification mark.

### 5.3.1 Standard to be certified

The regulations governing use must clearly specify and explain the **characteristics** in respect of which the goods or services are certified by the applicant. Access to these characteristics must be made freely available to everyone.

Those characteristics can be described in general terms, with no need to detail all the technical aspects, as long as it allows the relevant trade circles to clearly and precisely understand them.

For instance, if the applicant is certifying the heat resistance of a product, it is not necessary to detail each and every technical aspect of the parameters that are checked, etc.: an indication that enables the relevant consumers to understand, in a clear and comprehensive way, that the applicant is testing the resistance of the product to temperature is sufficient.

For that purpose, the regulations governing use can **refer** to technical standards established either by the applicant itself or by other private or public bodies. However, such references must relate to official and/or generally available sources.

The requirement of clarity and precision applies to both types of standards referred to by the certification mark: standards of the applicant/owner itself or standards established by other private or public bodies. Similarly, where reference is made to long or complex technical specifications established by third parties, no details are necessary, provided that the relevant public understands them in a clear and precise way.

A certification mark can cover a variety of products or services, with different characteristics to be certified, depending on the product/service category. In such cases, the regulations governing use should specify the standards to be certified for the different types of products or services.

All the goods and services must be covered by the/a characteristic to be certified.

### 5.3.2 Persons authorised to use the mark

The regulations governing use have to indicate who is entitled to use the certification mark. Therefore, the applicant has to clearly state in the regulations governing use whether use of the certification mark is authorised (i) for any person who meets the required standard or (ii) for a specific category of persons.

If there is a list of authorised users, it is acceptable to file this information under the form of a link to a website containing this information. This will allow an automatic update of the list without any formal amendment to the regulations of use.

Where use is limited to a specific category of persons, the regulations governing use have to clearly set out the objective criteria according to which a person can be an authorised user of the certification mark.

### 5.3.3 Testing, supervision and conditions of use, sanctions

The **testing methods** used and the **supervision** system employed by the applicant/owner of the certification mark to make sure that the goods or services marked actually possess the certified characteristics need to be specified in the regulations governing use. The testing methods and supervision must be real and effective and the responsibility must always fall on the owner or applicant of the certification mark.

The applicant/owner does not necessarily need to carry out the tests or supervise the conditions of use itself. In some cases, it might be necessary to cooperate with more specialised external testers and/or supervisors. Moreover, testing the goods and services marked, as well as supervising the conditions of use, can be limited to sample or random checks and does not need to extend to all certified goods or users.

The testing methods and supervision must never be transferred to the authorised user of the mark through a self-monitoring programme, in order to guarantee the correct functioning of the certification mark system.

Both sets of measures (testing and supervision) have to be described by the applicant with sufficient clarity as to convince the Office, as well as market operators, that these are adequate in order to ensure that the certification mark truly covers goods and services that are effectively certified. The measures can relate to the methods, sampling and frequency of the testing and supervision, the qualification of the persons carrying out the tests and the supervision, and the ‘triggers’ for additional or enhanced tests or supervision measures.

The regulations governing use need to include specific **conditions of use** imposed upon the authorised user, such as that the mark is to be used as a certification mark and, where applicable, whether there are **fees** to be paid in connection with the use of the mark, etc. It is also mandatory to specify the appropriate **sanctions** that apply if these conditions are not respected, and in particular, if the certification mark is misused.



#### 5.3.4 Compliance with public order

The regulations governing use must comply with public policy and accepted principles of morality. This **public order requirement** under Article 85(1) EUTMR **applies specifically to the regulations governing use**. It applies in addition to Article 7(1)(f) EUTMR (which relates in the first place to the sign applied for) and thus needs to be assessed separately and specifically with respect to the regulations governing use submitted by the applicant.

By way of example, regulations governing use would appear to be in breach of Article 85 EUTMR where:

1. the applicant would not be entitled to carry out the certification (e.g. for lack of compliance with statutory provisions);
2. the authorisation or conditions of use discriminate between market operators without due justification (such as a lack of objective criteria or the application of inadmissible criteria);

#### 5.3.5 Remedies

In some cases, it will be possible to amend the regulations governing use in order to remove a ground for refusal of an EU certification mark application (Article 85(3) EUTMR) raised by the Office under Articles 85(1) and (2) EUTMR.

## 6 Specificities as Regards Examination of the General Grounds for Refusal

In addition to the specific grounds for refusal applicable to certification marks, applications for this kind of mark need also to be examined with regard to the absolute grounds for refusal listed in Article 7(1) EUTMR (Article 85(1) EUTMR). This means that EU certification mark applications will, like any other EUTM application, be assessed on **all** general grounds of refusal laid down in Article 7(1) EUTMR.

However, when assessing the general grounds of refusal of **Article 7(1)(b), (c) and (d) EUTMR**, the specific function of certification marks — that is to distinguish goods or services certified by one certifier (i) from those that are not certified at all and (ii) from those certified by another certifier — must always be kept in mind.

The same applies to **Article 7(1)(g) EUTMR** to the extent that it remains applicable in addition to the specific provision of Article 85(2) EUTMR. When assessing whether or not the public is liable to be misled as regards the character or the meaning of the mark, the regulations governing use must also be taken into account. For example, if the characteristic to be certified is the kosher nature of the goods, and the certification mark applied for designates food that by its very nature cannot be kosher (e.g. shellfish), an objection under Article 7(1)(g) EUTMR should be raised since there is no possibility of non-deceptive use of the certification mark.

Likewise, to the extent that Article 7(1)(b), (c) or (d) EUTMR and the corresponding exception for acquired distinctiveness (**Article 7(3) EUTMR**) also apply to certification marks, any claim of distinctiveness acquired through use will need to be supported by evidence showing that use of the mark has been made and that the mark is in fact recognised on the relevant market as a certification mark.

When the sign applied for contains a protected geographical indication, an objection will be raised under Article 83(1) EUTMR only (and not under **Article 7(1)(j) EUTMR**) given that a limitation of the goods can never overcome the prohibition of certification of geographical origin laid down in Article 83(1) EUTMR.