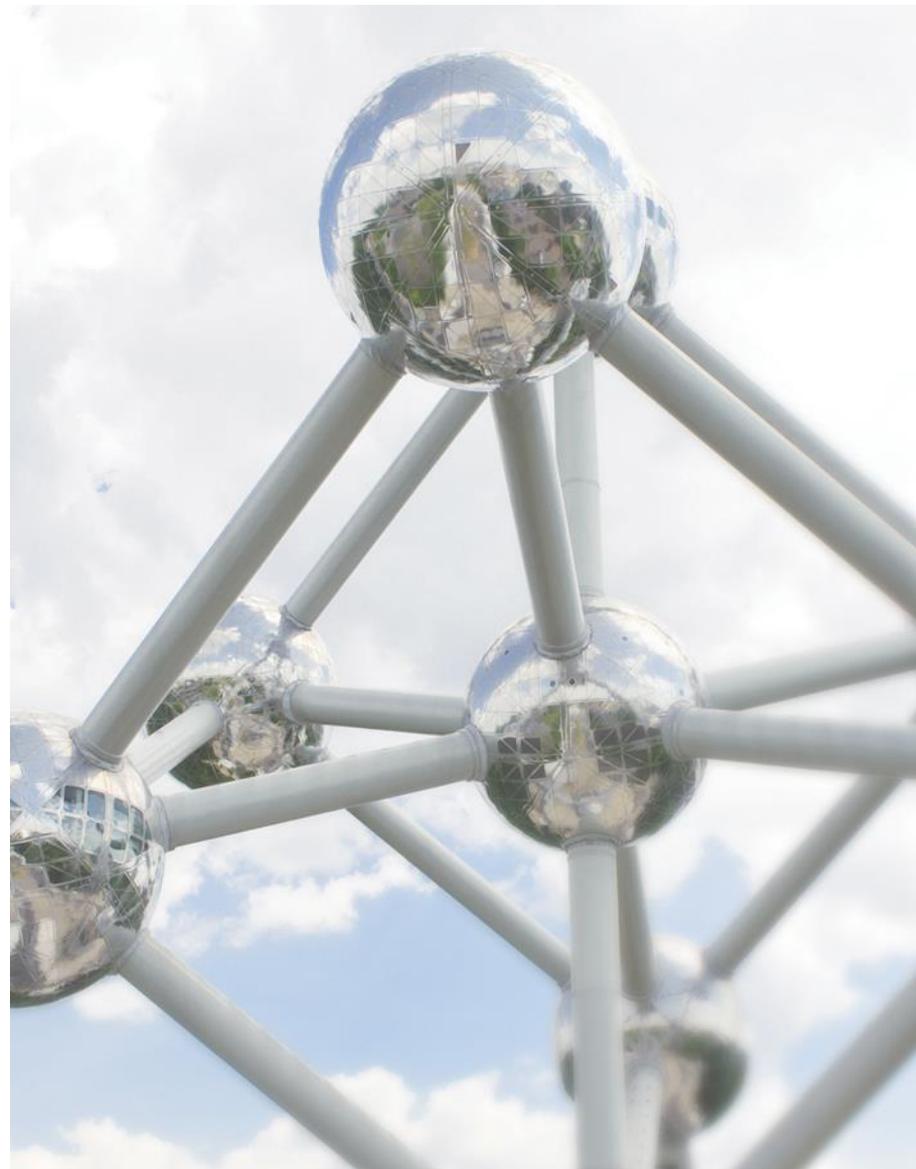


What is registrable as a trade mark?

European Perspectives



To be eligible for registration...

- > Trade Mark must be distinctive and not descriptive of the goods and/or services applied for...
- > Likely to be refused if meaning recognised in part of the EU.
But...would need to be recognised by a reasonable proportion of people in relation to those goods/services. For example, everyday English words difficult to protect.
- > Acquired distinctiveness (if shown) can help overcome objection.

Distinctiveness

- > Words are non-distinctive if they are so frequently used that they have lost any capacity to distinguish goods and services.
- > Terms merely denoting a particular positive or appealing quality or function of the goods and services should be refused

Some common examples:

- **ECO** as denoting 'ecological'
- **FLEX** and **FLEXI** as referring to 'flexible'
- **GREEN** as being 'environmentally friendly'
- **MEDI** as referring to 'medical'
- **MINI** as denoting 'very small' or 'tiny'
- **Premium/PREMIUM** as referring to 'best quality'

Distinctiveness – Comparison Chart

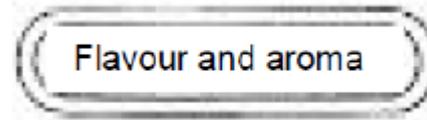
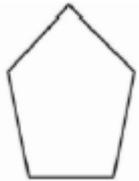
Trade Mark (classes)	EUIPO	UKIPO	Germany
 (9,16,35,36,37,38,41,42)	✓	X	-
PreBiotic (30)	X	-	X
QUIKQUIT (5,10,34)	X	✓	-
SILENT PLUG (9)	X	✓	-
EasyMount (9)	X	-	X

What about advertising slogans?

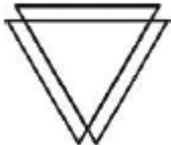
- > Inappropriate to apply to slogans stricter criteria than those applicable to other types of signs when assessing their distinctive character...but in practice they do.
- > Promotional formulas = non-distinctive unless public recognise the commercial origin.
 - Acceptable:
 - SITEINSIGHTS - degree of originality and expressiveness, which makes it easy to remember
 - WET DUST CAN'T FLY -concept of 'wet dust' is literally inaccurate, since dust is no longer dust when it is wet. Fanciful and distinctive
 - Unacceptable:
 - INVESTING FOR A NEW WORLD (35 and 36)
 - MORE THAN JUST A CARD (36)
 - SO WHAT DO I DO WITH MY MONEY (35 and 36)
 - PIONEERING FOR YOU (7, 9, 11, 37 and 42)

Simple figurative elements

- > Simple geometric shapes, not registrable. Lack any distinctive character.
- > This applies throughout the EU.
 - Refused 'simple' signs:



- Acceptable 'simple' signs:



- > But for non-traditional trade marks, sound, colour, 3d marks, there is an additional hurdle to overcome.
- > Graphical representation!

Graphical Representation

- > Article 4 of Council Regulation (EC) 207/2009 states that a trade mark may consist of *"any signs capable of being represented graphically... provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings."*

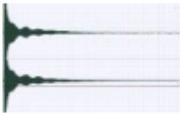
- > The case law:
 - *Libertel*
 - *Heidelberger*
 - *Dyson*
 - *Nestlé v Cadbury*
 - *Red Bull v Optimum Mark* - Currently on appeal before the GC

- > A replacement for Article 4 EUTMR will come into force on 1 October 2017.
- > Removes the requirement that a trade mark is capable of being 'represented graphically' and instead provides that it must be capable of "*being represented on the Register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.*"
- > Acknowledgement of other non traditional TMs – sounds - added to the list of examples of possible signs in the new Article
- > Impact post October? A slight increase in these type of mark being filed, and particularly applications 'testing the water'.

- > But on sound marks, some things are not expected to change, the kinds of sound marks that will still be unlikely to be accepted without evidence of factual distinctiveness include:
 - a) very simple pieces of music consisting of only one or two notes
 - b) sounds that are in the common domain (e.g. La Marseillaise)
 - c) sounds that are too long to be considered as indicators of origin
 - d) sounds typically linked to specific goods and services

- > 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.

> *Refused sound marks (that would still be refused after amendment):*

Sign	Description	G&S	Reasoning	Case
	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

How to represent the mark graphically?

Colour Easy to represent graphically. A mere sample of the colour on its own is not sufficient though. Include at least a description of the colour or pantone reference / internationally recognised colour code (*Libertel* case).

Sound (1) Musical notation (electronic sound file optional*)
(2) sonpgraph + mandatory electronic sound file*

(might change after 1/10/17)

Hologram Particularly difficult to represent graphically since a paper representation does not allow the image to 'change' as it would naturally on holographic paper.

Smell Not currently acceptable. This is because a graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

*The sound file must be in MP3 format and its file size cannot exceed two megabytes. Office requirements do not allow the sound to stream or loop.

> Three dimensional marks and graphical representation:

- The photographic or graphic representation may consist of up to six perspectives of the same shape that must be submitted in one single JPEG file in the case of e-filed applications or on one single A4 sheet in the case of paper-filed applications.
- A single view is sufficient if clear.
- Acceptable views:



Acquired distinctiveness

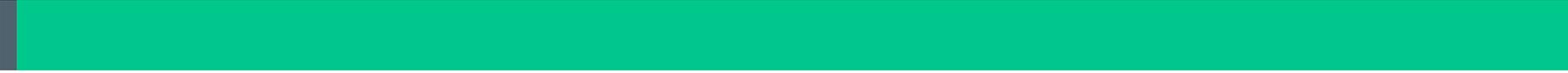
- > Evidence of use to overcome absolute ground objections.
- > In accordance with Article 7(3) EUTMR, a trade mark may still be registered even if found to be non-distinctive / descriptive.
- > Important! The Office will only examine acquired distinctive character following a request from the applicant. Must ask for it.
- > The evidence must prove that distinctiveness through use was acquired prior to the EUTM application's filing date.
- > Generally, acquired distinctiveness must be shown, in principle, with respect to all those countries where the EUTM applied for is objected. For example, its meaning in the official language (English – UK, Malta and Ireland).
- > The test – evidence to show at least a significant proportion of the relevant section of the public identifies the products or services concerned as originating from a particular undertaking

Acquired distinctiveness - 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.

Acquired distinctiveness - focus on what?

- 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
- witness statement or affidavit - submitted in the form accepted in your MS



Any questions?