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’
<table>
<thead>
<tr>
<th>Trade Mark (classes)</th>
<th>EUIPO</th>
<th>UKIPO</th>
<th>Germany</th>
</tr>
</thead>
<tbody>
<tr>
<td>(9,16,35,36,37,38,41,42)</td>
<td>✓</td>
<td>X</td>
<td>-</td>
</tr>
<tr>
<td>PreBiotic (30)</td>
<td>X</td>
<td>-</td>
<td>X</td>
</tr>
<tr>
<td>QUIKQUIT (5,10,34)</td>
<td>X</td>
<td>✓</td>
<td>-</td>
</tr>
<tr>
<td>SILENT PLUG (9)</td>
<td>X</td>
<td>✓</td>
<td>-</td>
</tr>
<tr>
<td>EasyMount (9)</td>
<td>X</td>
<td>-</td>
<td>X</td>
</tr>
</tbody>
</table>
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):

<table>
<thead>
<tr>
<th>Sign</th>
<th>Description</th>
<th>G&amp;S</th>
<th>Reasoning</th>
<th>Case</th>
</tr>
</thead>
<tbody>
<tr>
<td><img src="image" alt="Two musical notes" /></td>
<td>Two musical notes, F and C</td>
<td>35, 36, 38, 39, 41, 42</td>
<td>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.</td>
<td>EUTM No 4 010 336</td>
</tr>
<tr>
<td><img src="image" alt="Sound waves" /></td>
<td>Two extremely short blips</td>
<td>9, 38</td>
<td>Machine-generated blip that is commonly emitted by computers and other electronic devices.</td>
<td>EUTM No 9 199 167</td>
</tr>
<tr>
<td><img src="image" alt="Sound waves" /></td>
<td>‘Ping’ sound, resembling a warning signal</td>
<td>9, 16, 28</td>
<td>Sound constitutes a warning signal and a direct characteristic of the goods applied for.</td>
<td>R 2444/2013-1</td>
</tr>
</tbody>
</table>
### How to represent the mark graphically?

<table>
<thead>
<tr>
<th>Feature</th>
<th>Representation Details</th>
</tr>
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<tbody>
<tr>
<td><strong>Colour</strong></td>
<td>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 (<em>Libertel</em> case).</td>
</tr>
</tbody>
</table>
| **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?