



Promoting Intellectual
Property Rights in the
ASEAN Region

Training on ASEAN Trademark Common Guidelines : Absolute Grounds

Thom Clark | 18th October 2022



Funded by the European Union



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SIGNS ADMISSIBLE AS TRADE MARKS :

Visually Perceptible Signs

- Two-dimensional signs
- Colors
- Three-dimensional signs
- Motion marks and holograms
- Position marks

Non-visually perceptible signs

- Signs perceptible by the sense of hearing
- Signs perceptible by the sense of smell
- Signs perceptible by the sense of taste
- Signs perceptible by the sense of touch

Before we start

Basic principles

Before we start

Signs admissible as trade marks :

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

EUTM Guidelines : 1.3 Representation on the Register

Before we start

Signs admissible as trade marks :

When a sign does not comply with the established definition of ‘mark’ or ‘trademark’, or it is clear that subject matter of the application is not a sign capable of being a trademark, its registration as a mark should be refused. In this case, it will not be necessary to examine the sign as to other absolute or relative grounds for refusal.

Common Guidelines : 1 Signs Admissible as ‘Trademarks’

Before we start

Signs admissible as trade marks :

Where a law requires that a mark be visually perceptible as an absolute condition for registration, any application to register a mark consisting of a non-visually-perceptible sign could be refused. In particular, a sign perceptible, for instance, by the sense of hearing or the sense of smell could not be registered as such signs are not visually perceptible.

Common Guidelines : 1.1 Visually Perceptible Signs

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Two-dimensional signs

- Words, letters, digits, numerals, ideograms and slogans
- Figurative signs
- Mixed signs

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Words, letters, digits, numerals, ideograms and slogans

This type of sign contains only elements that can be read, including signs consisting of one or more words (with or without meaning), letters, digits, numerals or recognizable ideograms, or a combination thereof, including slogans and advertisement phrases.

Common Guidelines : 1.1.1.1 Words, Letters, Digits, Numerals, Ideograms, Slogans

Words, letters, digits, numerals, ideograms and slogans

This type of sign contains only elements that can be read, including signs consisting of one or more words (with or without meaning), letters, digits, numerals **or recognizable ideograms**, or a combination thereof, including slogans and advertisement phrases.

Common Guidelines : 1.1.1.1 Words, Letters, Digits, Numerals, Ideograms, Slogans

Words, letters, digits, numerals, ideograms and slogans

A word mark is a typewritten mark with elements including letters (either lower or upper case), words (either in lower or upper case letters), numerals or standard typographic characters.

A word mark must be represented by submitting a reproduction of the sign in standard script and layout, without any graphic feature or colour.

EUIPO Guidelines : 9.3.1 Word marks

Words, letters, digits, numerals, ideograms and slogans

Examples

Words, letters, digits, numerals, ideograms and slogans

| | |
|--------------|---|
| EUTM 6892351 | europadruck24 |
| EUTM 6892806 | TS 840 |
| EUTM 6907539 | 4 you |
| EUTM 2221497 | ESSENTIALFLOSS |
| EUTM 631457 | DON'T DREAM IT, DRIVE IT |
| EUTM 1587450 | ?WHAT IF! |
| EUTM 8355521 | ΕΙΔ ΕΛΛΗΝΙΚΟ ΙΝΣΤΙΤΟΥΤΟ ΔΙΑΤΡΟΦΗΣ (Greek) |
| EUTM 8296832 | Долината на тракийските царе (Cyrillic) |

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Two-dimensional signs

- Words, letters, digits, numerals, ideograms and slogans
- Figurative signs
- Mixed signs

Figurative signs

This type of sign will consist of one or more two-dimensional figurative elements. They may represent existing creatures (animals, flowers, etc.), real or fictitious persons or characters (portraits, cartoon characters, etc.), and real or imaginary objects or creatures (sun, stars, mountains, flying saucers, dragons, etc.). They may also consist of fanciful, abstract or geometrical shapes, devices, figures, logos or other purposely-created two-dimensional shapes.

Common Guidelines : 1.1.1.2 Figurative signs

Figurative signs

Ideograms and characters that are not understood or have no meaning for the average consumer in the country where registration is sought may be regarded as figurative signs or figurative elements of signs.

Common Guidelines : 1.1.1.2 Figurative signs

Figurative signs

Figurative signs may have one or more colors but will not contain any words, letters, digits, numerals or ideograms.

Common Guidelines : 1.1.1.2 Figurative signs

Two-dimensional signs

- Words, letters, digits, numerals, ideograms and slogans
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Mixed signs

This type of sign will consist of a combination of one or more words, letters, digits, numerals or ideograms with one or more figurative sign or non-word element. The figurative element may be embodied within the word element (for example, the figure of a sun in place of the letter “o”), be adjacent to or superposed on the word element, or be a background or a frame.

The non-figurative elements (words, numerals, etc.) may be presented in ‘standard’ characters or in special, fanciful characters, and the sign may have one or more colors.

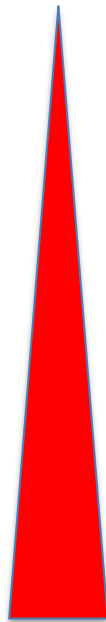
Common Guidelines : 1.1.1.3 Mixed signs

Figurative and mixed signs

Examples

Figurative signs

Common Guidelines examples



EUIPO Guidelines examples



ROSE BRAND



Jim Thompson

火瀑

Figurative and mixed signs

Common Guidelines examples



EUIPO Guidelines examples



Two-dimensional signs

Statistics

Two-dimensional signs

| | | |
|----------------------------|---------|--------|
| Word | 1442308 | 57.20% |
| Figurative | 1063231 | 42.20% |
| Colour | 1187 | 0.04% |
| Three-dimensional | 11518 | 0.50% |
| Motion marks and holograms | 198 | 0.01% |
| Postion marks | 363 | 0.01% |

SIGNS ADMISSIBLE AS TRADE MARKS :

Visually Perceptible Signs

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- **Colors**
- Three-dimensional signs
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- Position marks

Colors

A single color as such ('color per se') or a combination of two or more colors in the abstract, claimed independently of any specific shape, contour or other defining element or feature – i.e. claimed in any conceivable form – would not comply with the conditions of clarity, precision and uniformity required for an unequivocal definition of the scope of the object of registration.

Accordingly, a sign consisting of a single color in the abstract or consisting of two or more colors claimed in any conceivable combination or form, cannot be regarded as a mark for purposes of its registration.

Common Guidelines : 1.1.2 Colors

Colors

To be regarded as a mark, a color would need to be defined by a particular shape or have clear, defined contours. A combination of two or more colors would need to be defined by a particular shape or contours, or be combined in a single, predetermined and uniform presentation.

Common Guidelines : 1.1.2 Colors

Colors

A colour mark is a trade mark that consists exclusively of a single colour without contour or a combination of colours without contours. What is protected is the shade of colour(s) and, in the case of more than one colour, the systematic arrangement of the colours in a predetermined and uniform way.

EUIPO Guidelines : 9.3.6 Colours

Colors

Examples

Colors

For example, the following combination of colors silver, copper and black applied in particular positions and proportions on specific products (electrochemical cells and batteries) can be a valid mark for those goods:



Common Guidelines : 1.1.2 Colors

Colors



Description: 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.

EUIPO Guidelines : 9.3.6 Colours

Colors

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.

EUIPO Guidelines : Section 4 Absolute Grounds for refusal, 13.1 Single Colours

Colors

(...) 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. (...) Therefore, single colours are not distinctive for any goods and services except under exceptional circumstances.

EUIPO Guidelines : Absolute Grounds for refusal,
13.1 Single Colours

Colors

To the extent that single colors in the abstract are not generally used as a means of brand identification, it should be presumed that single color are functional. This means that in practice a color will function merely as a decoration or attractive presentation of goods and services, and will not be perceived as an indication of commercial provenance.



Common Guidelines : 2.1.3 Colors

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Three-dimensional signs

For the purposes of registration, the following types of three-dimensional signs may be distinguished:

- the shape of a device *adjoined* or attached to the goods or used in connection with the services that the mark will distinguish;
- the shape that is *embodied* in the goods or in a part thereof, or in accessories used in connection with the services that the mark will distinguish;
- the shape of the *container*, wrapping, packaging, etc. of the goods or an accessory related to the service that the mark will distinguish.

Common Guidelines : 1.1.3 Three-dimensional signs

Three-dimensional signs

A shape mark is a 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 shape marks cover not only shapes per se, but also shapes that contain other elements, such as word elements, figurative elements or labels.

EUIPO Guidelines : 9.3.3 Shape marks

Three-dimensional signs

Where the representation is not a computer-generated image, it may contain up to six perspectives of the same shape. (...) While different perspectives may be filed, a single view of the shape is sufficient where the shape to be protected can be ascertained from that single view.

EUIPO Guidelines : 9.3.3 Shape marks

Three-dimensional signs

Examples

Three-dimensional signs



EUIPO Guidelines : 9.3.3 Shape marks

Three-dimensional signs



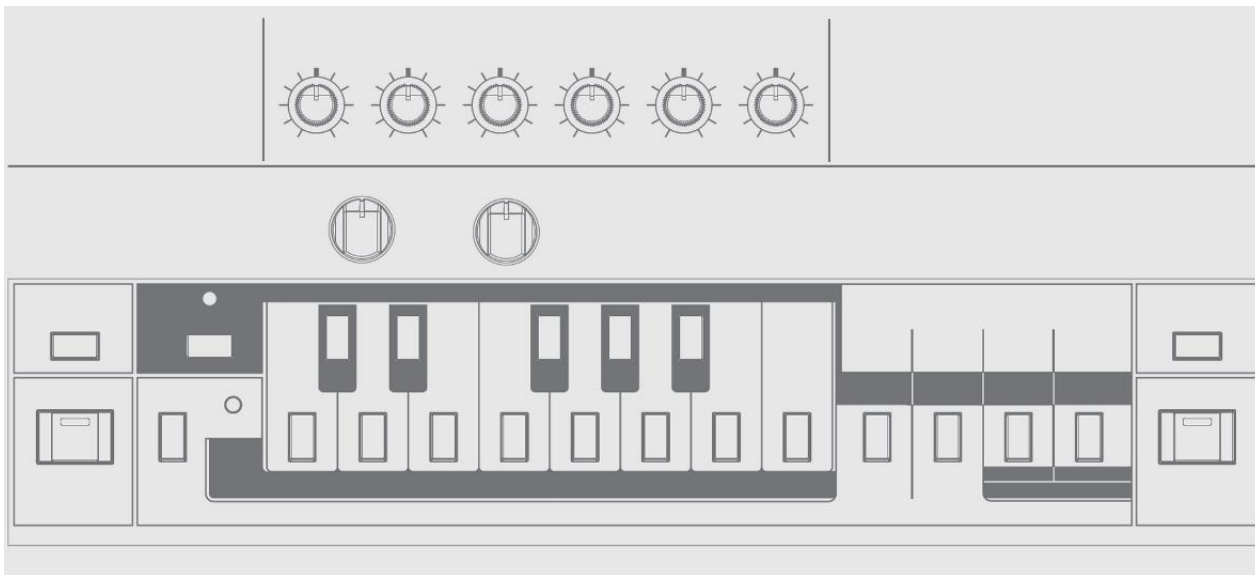
EUIPO Guidelines : 9.3.3 Shape marks

Three-dimensional signs



EUIPO Guidelines : 9.3.3 Shape marks

Three-dimensional signs



EUTM 18016159

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Motion marks

A movement or motion mark is perceived as a video clip or short film used to distinguish goods or services in the context of, for instance, visual or video communications to the public. They cannot be physically attached to the goods themselves but may be used to distinguish digital products and services on portable devices such as mobile telephones, internet-based services, etc.

Common Guidelines : 1.1.4 Movement (Motion) Signs and Holograms

Motion marks

A motion mark is defined as a trade mark consisting of, or extending to, a movement or a change in the position of the elements or of the colours of the mark. Trade marks combining movement with sounds do not qualify as motion marks and should be applied for as multimedia marks. The term 'extending to' means that, in addition to the movement itself, the mark may also include words, figurative elements, labels, etc.

EUIPO Guidelines : 9.3.8 Motion marks

Motion marks

A motion mark must be represented by submitting either a video file or a series of still sequential images showing the movement or change of position.

EUIPO Guidelines : 9.3.8 Motion marks

Motion marks

Examples

Motion marks

EUTM 18652712



Motion marks

EUTM 18647496



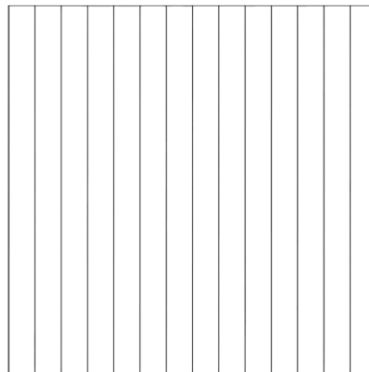
Motion marks

CP11 example

ORISonic

Motion marks

EUTM 18581151



01.00.00.00

Motion marks

EUTM 18607872

SIGNS ADMISSIBLE AS TRADE MARKS :

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Holograms

A hologram is a figurative sign that gives a seemingly three-dimensional view of the sign depending on the angle at which the sign is seen. In practice they function as two-dimensional figurative signs with a movement effect.

Common Guidelines : 1.1.4 Movement (Motion) Signs and Holograms

Holograms

A hologram mark is defined as a trade mark consisting of elements with holographic characteristics. Therefore, a hologram is an image that changes its appearance when looked at from different angles.

EUIPO Guidelines : 9.3.10 Holograms

Holograms

- 1 A hologram can be a physical flat structure that uses light diffraction to create visual images. Its flat surface, under proper illumination, appears to contain a three-dimensional image or other visual effects. In this case, a three-dimensional effect is actually a two-dimensional visual effect that is perceived by human brains as three-dimensional.
- 2 A hologram can be a digital projection or visualisation of an object displayed via light field displays. Through them, three-dimensional objects and object compositions can be visualised and seen as such. These lifelike images can be seen but not touched.

EUIPO Guidelines : 9.3.10 Holograms

Holograms

Examples

Holograms

CP11 example



Holograms

EUTM 17993401



Holograms

EUTM 18399029



SIGNS ADMISSIBLE AS TRADE MARKS :

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Position marks

A 'position' mark is a figurative, mixed, color or three-dimensional sign that is applied to a specific part of, or in a specific position on, the goods that the mark distinguishes. Such marks are placed consistently in the same position on the goods of the trademark holder, in a regular size or proportion with respect to the size of the goods.

Common Guidelines : 1.1.5 Position Marks

Position marks

However, a figurative, mixed, color or three-dimensional sign may be registered with a limitation as to its position or location on the goods specified in the application. If the applicant limits the position of the sign to a particular location on the product, this limitation should not be a ground for objection.

In particular, a sign with a limitation regarding its position must be sufficiently distinctive with regard to the specified goods (or services). The sign must be recognizable by the relevant public as a mark indicating commercial origin, rather than just an element of the aspect, design or decoration of the product.

Common Guidelines : 1.1.5 Position Marks

Position marks

A position mark is a trade mark consisting of the specific way in which the trade mark is placed on or affixed to the product.

This type of mark must be represented by submitting a reproduction that identifies appropriately the position of the mark and its size or proportion with respect to the relevant goods.

Position marks

The representation should clearly define the position of the mark and its size or proportion with respect to the relevant goods.

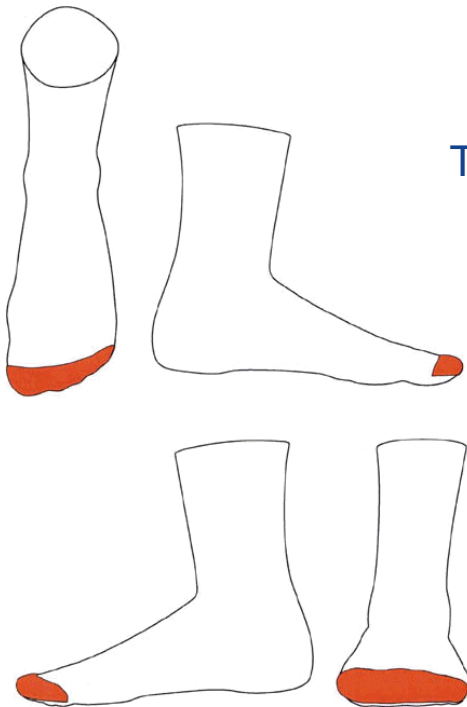
The elements that do not form part of the subject matter of the registration must be visually disclaimed, preferably by broken or dotted lines.

A description that accords with the representation of the mark may be added to indicate how the sign is affixed to the goods. This cannot, however, serve as a substitute for a visual disclaimer.

Position marks

Examples

Position marks



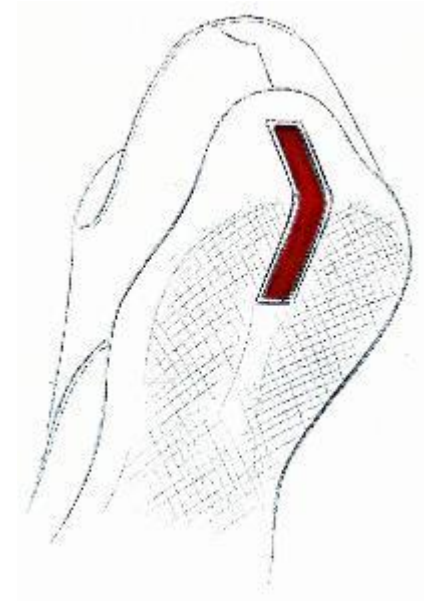
T-547/08 (“Orange coloring of toe of sock”)

Common Guidelines : 1.1.5 Position Marks

Position marks

EUTM 1027747

Description: Red stripe placed longitudinally along an item of footwear partly covering the rear area of the sole and partly the rear area of the item of footwear. Any moulding seen on the sole or on the rear part of the item of footwear and/or production characteristics are not part of the trade mark.

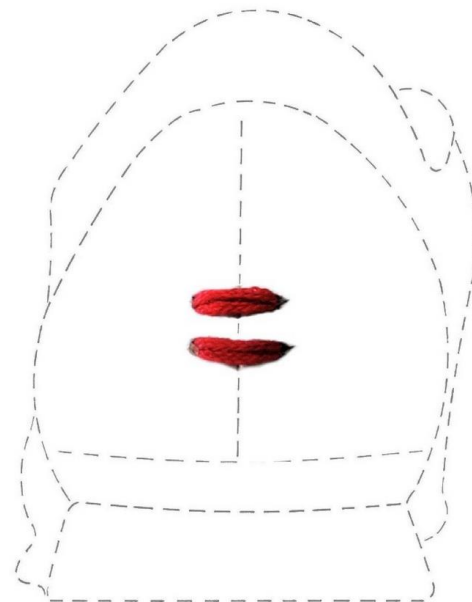


EUIPO: 9.3.4 Position Marks

Position marks

EUTM 18324997

Class 25: *Shoes; boots; sports shoes;
trainers; sandals*



Position marks

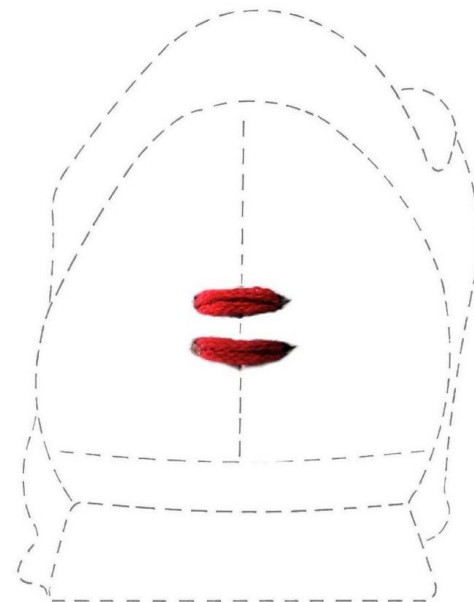
EUTM 18324997

Class 25: *Shoes; boots; sports shoes; trainers; sandals*

Refused :

Shoes; sports shoes; trainers : **not distinctive**

Boots; sandals : **not applicable to the goods**



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Questions?



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|-------------------|------------------|--|
| Presentation | | |
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| Authors | - | |
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| Version | Date | Author | Description |
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| 0.1 | DD/MM/YYYY | | |
| 0.1 | DD/MM/YYYY | | |



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