



Types of Marks And Distinctiveness of Trade Marks in Absolute Grounds

Sophio MUJIRI | Gros Islet, SAINT LUCIA | 25-28 October 2022



CARIFORUM



EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

www.caripi-hub.com

Define Types of Marks

Define Distinctiveness of Trade Marks in Absolute Grounds

Fill in Questionnaires

Discuss the Content of Possible Trade Mark Manual

Define the Next Steps



WORD MARK

A word mark is a type of mark consisting of a word, words, letters, numerals, personal names, or combination thereof with or without a meaning.

SAMSUNG

212

GIORGIO ARMANI

CHANEL N5

APPLE

FIGURATIVE MARK

Figurative marks are two dimensional signs consisting of graphic elements, i.e., images, drawings, figures and illustrations that do not contain letters.

Word elements in non-Latin alphabets are as well considered as figurative marks.



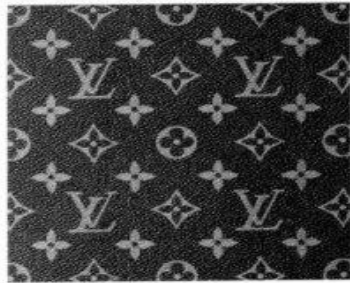
MIXED MARKS

Mixed marks are a combination of verbal and figurative elements represented in black and white or in colour.



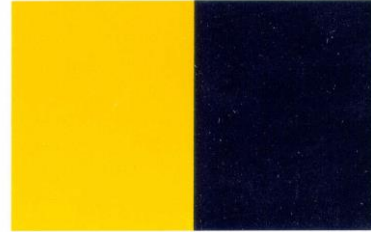
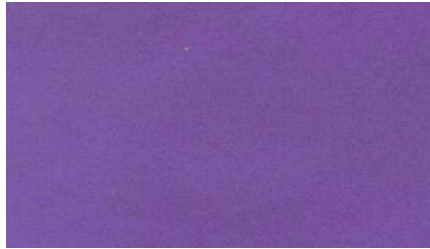
PATTERN MARKS

Pattern mark is consisting of a set of verbal and/or figurative elements which are repeated regularly and represented in black and white or in colour



COLOUR MARKS

Colour mark consists of a single colour or combination of colours without contours.



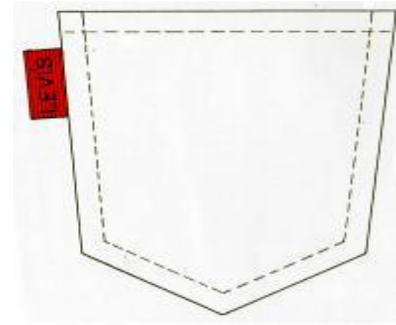
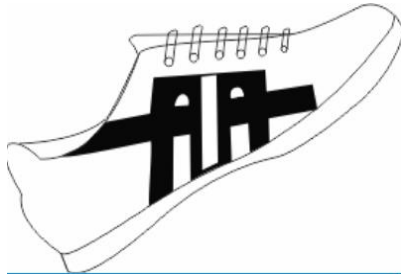
SHAPE MARKS

Shape marks are defined as trade marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance.



POSITION MARKS

A position mark consists of the specific way in which the mark is placed or affixed to the product.



SOUND MARK

A sound mark consists of a sound or a combination of sounds that can distinguish goods and services and are audio signature of a product.

A sound mark can be submitted as an audio file or in a form of musical notation.

Netflix's initial "Da dum" sound - [Link](#)

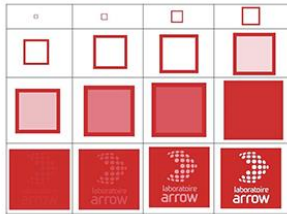
Macbook startup sound - [Link](#)



Jingle-like sound sequences

MOTION MARKS

A motion mark consists of, or extends to a movement or a change in the position of the elements of a mark. In addition to movement, the mark may also include words, figurative elements, labels, etc



a series of still sequential images

[a video file showing the movement or change of position](#)

MULTIMEDIA MARKS

Multimedia mark consists of the combination of images and sounds.



[Link](#)



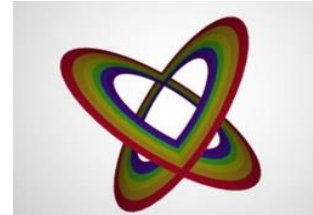
[Link](#)

HOLOGRAM MARKS

Hologram marks consist of elements with holographic characteristics.



[Link](#)



SMELL/OLFACTORY MARKS

Smell or olfactory mark consists of a unique smell that identifies product or services.

Examples of a smell mark:

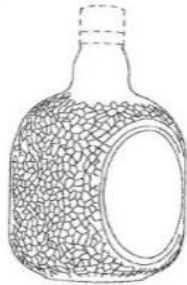
Tennis ball with fresh grass smell.

Coconut smell for shoes store.

Cherry smell for toothbrushes.

TACTILE MARKS

Tactile or touch marks are the marks that capture the feel of a good or service. Tactile marks are characterized by feature of a product that can be felt by touch.



Crackle glass texture

DISTINCTIVENESS

Ability of a mark to identify and distinguish the goods and/or services of one undertaking, from those of other undertakings.

Distinctiveness should be assessed:

- in relation to the goods and services applied for and
- in relation to the relevant public, using respective goods and services.

DISTINCTIVENESS - WORD ELEMENTS

Words or terms indicating certain characteristic, quality or function of the goods and services and that are frequently used as such, will be non-distinctive if applied for registration separately or in combination with other non-distinctive elements.

- ECO as denoting 'ecological'
- FLEX and FLEXI as referring to 'flexible'
- GREEN as being 'environmentally friendly'
- MEDI as referring to 'medical'
- MULTI as referring to 'much, many, more than one'
- MINI as denoting 'very small' or 'tiny'

DISTINCTIVENESS - WORD ELEMENTS

Top level domain endings such as **.org**, **.net**, **.int** and company legal forms **INC**, **SAS**, **LLC** do not render distinctiveness to word marks containing other descriptive or non-distinctive elements.

For example:

tv.org;

music.int

Food LLC

DISTINCTIVENESS - SINGLE LETTERS

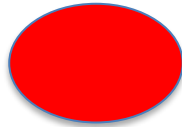
Not always can single letter function as a trade mark as it can be devoid of distinctive character for the goods and/or services concerned.

A trade mark consisting of the single letter ‘**S**’ for ‘cars’, will not be distinctive as this letter is commonly used to designate sport cars.

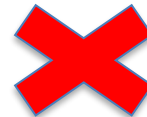
The letter **W** will be distinctive in respect of transport; packaging and storage of goods; travel arrangement in Class 39 and services for providing food and drink; temporary accommodation in Class 43

DISTINCTIVENESS - SIMPLE SHAPES AND SIMPLE FIGURES

Simple geometric shapes and figures are not distinctive



The same consideration will apply to punctuation and typographic symbols
mathematic symbols, currency symbols, pictograms



DISTINCTIVENESS - SLOGANS

Simple advertising slogans that merely convey information about the goods and services for which protection is sought and will be perceived as a mere promotional formula will not be deemed distinctive.

- Buy 2, get 3
- Our products are the best
- We give you the best quality
- The brand you can trust
- We do things better

DISTINCTIVENESS - SLOGANS

Advertising slogan might be distinctive 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
- unusual syntactic structures
- the use of linguistic and stylistic devices, such as alliteration, metaphors, rhyme
- paradox

DISTINCTIVENESS - SLOGANS

Distinctive slogans:

WET DUST CAN'T FLY for Class 3,7 and 37

LOVE TO LOUNGE for Class 25

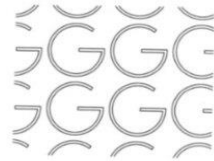
DISTINCTIVENESS – COMMON/DISTINCTIVE LABELS

Some figurative elements that are very simple and commonly used in connection to the goods and services will not be considered distinctive



DISTINCTIVENESS – PATTERN MARKS

Pattern marks will be considered distinctive, if they are original, unusual and/or arbitrary and not commonly used in the relevant field for certain goods and can be memorized by the relevant public



DISTINCTIVENESS – COLOUR MARKS

Single colours are not distinctive for any goods and services except under exceptional circumstances

Colour combinations should be refused in the following situations:

- Decorative element of the goods
- A colour can be the nature of the goods
- A colour can be technically functional
- A colour may indicate a particular characteristic of the goods, such as a flavour
- 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

DISTINCTIVENESS – SHAPE MARKS

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 or a combination of basic shapes
- 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.
- 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
- Functional shapes or features of a shape mark will be perceived by the consumer as such.

DISTINCTIVENESS – SHAPE MARKS



Class 9 Secure digital memory cards

When the verbal/figurative element is **sufficiently large** to be clearly identified as distinctive, and has sufficient impact on the overall impression given by the sign, it renders the sign as a whole distinctive

DISTINCTIVENESS – SHAPE MARKS



Class 3 Cosmetics

When the element is **large**, but identified as non-distinctive, its size alone, in proportion to the shape, will not be sufficient to render the sign as a whole distinctive.

DISTINCTIVENESS – SHAPE MARKS



Class 9 Secure digital memory card

When the verbal/figurative element is **small** to the point it is not identifiable as distinctive, it will not have a sufficient impact on the overall impression and therefore will not render the shape as a whole distinctive.

DISTINCTIVENESS – SHAPE MARKS



Class 12 Trucks

In specific segments, badges of origin are usually relatively small in proportion to the goods. In this examples, the fairly small size of the verbal element in proportion to the truck does not prevent it from being clearly identified as a distinctive element in the representation, thus having an impact on its overall impression, since consumers are accustomed to this practice.

DISTINCTIVENESS – SHAPE MARKS



Class 33 Wine

Despite the use of less contrasting colours, the figurative element on the bottle is still capable of conferring distinctive character to the sign as a whole as the element can clearly be identified as distinctive in the representation.

DISTINCTIVENESS – SHAPE MARKS



Despite the use of less contrasting colours between the verbal element and the bottle, the first can still be identified as distinctive, therefore, the overall impression results in the sign being perceived as distinctive as a whole



In this case, the element cannot be clearly identified without close inspection due to a lack of contrast between the element and its background. The combination does not render the sign as a whole distinctive

DISTINCTIVENESS – SHAPE MARKS



The verbal and figurative elements can be identified as distinctive in all of the examples, regardless of their position and thus render each sign distinctive as a whole.

DISTINCTIVENESS – SHAPE MARKS



Class 33 Wine

The label containing the descriptive verbal element, placed in a typical position for this type of packaging of goods, does not render the sign distinctive as a whole.

DISTINCTIVENESS – SHAPE MARKS



Class 33 Wine

The non-distinctive element (possibly the year of production) is placed on the bottom part of the bottle which might not be the typical position for this kind of descriptive information. Nevertheless, the unusual position does not add distinctive character to the clearly nondistinctive element, therefore, the sign is non-distinctive as a whole.

DISTINCTIVENESS – SHAPE MARKS



The verbal element 'CLOSE' bears no relation to the goods in Class 3. When placed centrally, the verbal element is perceived as distinctive, as it does not provide a descriptive indication of the good. Therefore, the sign as a whole is distinctive.

DISTINCTIVENESS – SHAPE MARKS



However, when placed at the top of the product, next to the lid, it will be perceived as a descriptive indication of the opening/closing function of the lid.

DISTINCTIVENESS – SHAPE MARKS



Class 9 Memory card

In this example, consumers will not perceive the addition of a single yellow colour to the shape as an indication of origin. Use of colour on this type of goods is common on the market.

DISTINCTIVENESS – SHAPE MARKS



The use of a single colour in this case would not be perceived as a badge of origin, but provide information on the nature of the goods in question. The sign is therefore non-distinctive.

DISTINCTIVENESS – SHAPE MARKS



This particular colour arrangement applied to a tube motor for garage doors creates an easy to remember overall impression. In this specific market the goods are almost exclusively sought by professional consumers who have got used to identifying the commercial origin of these goods by colours. The goods are regularly not visible during use, therefore, the colour combination is not perceived as decorative. As a result, the sign as a whole is distinctive.

DISTINCTIVENESS – SHAPE MARKS



Class 7 Wind turbine

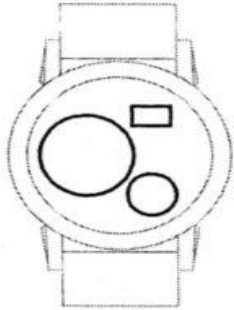
This particular colour arrangement applied to the wind turbine is unusual in the market and simple enough to create a memorable overall impression for the specialised consumer to recall as a means of identification.

DISTINCTIVENESS – SHAPE MARKS



This combination conveys exclusively a decorative message, which will not be recognised as a reference to its origin. Therefore it cannot render the sign as a whole distinctive.

DISTINCTIVENESS – POSITION MARK



The mark consists of the position of the circular and rectangular fields on a watch face.

In this case the mark is not independent or distinguishable from the form or design of the product itself and the positioned elements are not substantially different from other designs on the market.

DISTINCTIVENESS – POSITION MARK



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.

DISTINCTIVENESS – SOUND MARKS

The sound is distinctive if 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.

Non-distinctive:

- Very simple pieces of music consisting of only one or two notes
- Sounds that are in the common domain
- Sounds that are too long to be considered as an indication of origin
- Sounds typically linked to specific goods and services

DISTINCTIVENESS – SOUND MARKS

Distinctive sound marks:

- ❑ Sound of a mooing com can be distinctive of Class 11 Goods toilets

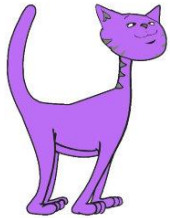
[Link](#)

- ❑ Jingle-like sound sequences are capable of identifying goods and services.



DISTINCTIVENESS – MOTION MARKS

For motions marks the general criteria for assessing distinctiveness will apply.



[Link](#)

The figurative element in the motion mark is considered distinctive in itself. Combined with the changing colours the consumer will perceive it as indication of commercial origin for the goods applied for.

DISTINCTIVENESS – MOTION MARKS

PREMIUM

[Link](#)

Considering that the movement of the non-distinctive/descriptive verbal element 'Premium' is not unusual or striking, the sign is not capable of being recognised by the consumer as an indication of commercial origin. Therefore, the motion mark is considered non- distinctive.

DISTINCTIVENESS – MULTIMEDIA MARKS

For multimedia marks the general criteria for assessing distinctiveness will apply.

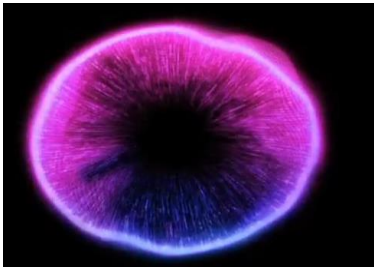
GERIVAN


[Link](#)

Both the image and the sound are considered distinctive in themselves and therefore the multimedia mark is distinctive.

DISTINCTIVENESS – MULTIMEDIA MARKS

When the multimedia mark contains an element which cannot be understood or is non-identifiable, in that it does not convey a meaning, as long as it can be recognised by the consumer, it will be considered distinctive.



[Link](#)

The combination of a melody with an abstract image changing its form and colour is capable of being recognised as an indication of commercial origin by the consumer.

DISTINCTIVENESS – HOLOGRAM MARK

The combination of the distinctive verbal and figurative elements in the hologram mark makes the hologram mark distinctive as a whole.



[Link](#)



THANK YOU
GRACIAS
MERCÍ
BEDANKT



Funded by the European Union

CARIFORUM

EU-CARIFORUM Regional project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)



www.caripi-hub.com