

Common Practices in Trade Mark Examination

Distinctiveness – Figurative Marks Containing Descriptive/Non- distinctive Words and 3DMarks

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TOPICS

- **Introduction**
- **Distinctiveness - Figurative Marks Containing Descriptive/Non – distinctive Words**
- **Distinctiveness of Three Dimensional Marks (Shape Marks) - Containing Verbal and/or Figurative Elements when the Shape is not Distinctive in itself**

CP3: Distinctiveness - Figurative Marks containing descriptive/non-distinctive words

“Establish a common practice in relation to when a figurative mark, containing purely descriptive /non- distinctive words, passes the absolute grounds examination because the figurative element renders sufficient distinctive character.”



CP3 – Overview of the criteria

Absolute grounds for refusal for figurative marks containing purely descriptive/non-distinctive words

A – Word elements	B – Figurative elements
Typeface and font	Use of simple geometric shapes
Combination with colour	The position and proportion (size) of the figurative element in relation to the word
Combination with punctuation marks and other symbols	Whether the figurative element is a representation of the goods and/or services
Position of dominant elements	Whether the figurative element is commonly used in trade in relation to the G&S

↓ ↓

How combinations of the criteria affect distinctiveness combinations of the criteria affect distinctiveness

A. With respect to the word elements in the mark

Typeface and font



FLAVOUR AND AROMA

Flavour **and** aroma

Flavour and aroma

Flavour and Aroma

(Class 30: Coffee)

FreshSARDINE

Freshsardine

FrEsh SaRdine

Fresh Sardine

Class 29: Sardines

COMMON PRACTICE

A. With respect to the word elements in the mark

Typeface and font



flavour and aroma

FLAVOUR AND AROMA

(Class 30: Coffee)

DIY

(Class 20: Kits of parts for assembly into furniture)

COMMON PRACTICE

A. With respect to the word elements in the mark

Combination with colour

- The mere 'addition' of a single colour to a descriptive/non-distinctive 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, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

A. With respect to the word elements in the mark

Combination with colour



Flavour and aroma

Flavour and aroma

Flavour and aroma

Flavour and aroma

FLAVOUR AND AROMA

(Class 30: Coffee)

COMMON PRACTICE

A. With respect to the word elements in the mark

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.

A. With respect to the word elements in the mark

Combination with punctuation marks and other symbols



FreshSardine. TM

(Class 29: Sardines)



“Flavour and aroma”

(Class 30: Coffee)

COMMON PRACTICE

A. With respect to the word elements in the mark

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

- The way in which the word elements are positioned can add distinctive character to a sign when it is capable of affecting the consumer's perception of the meaning of those word elements. In other words, **the arrangement must be of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message.**
- In general, the fact that the word elements are arranged in vertical, upside-down or in one, two or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.

A. With respect to the word elements in the mark

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



Flavour
and
Aroma

Flavour and Aroma

(Class 30: Coffee)

Flavour
and
Aroma

COMMON PRACTICE

A. With respect to the word elements in the mark

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



F d
l n
a a
v m
o
r u
A r

(Class 30: Coffee)

A n d
r
F l a v o u r
m
a

(Class 30: Coffee)

Overview of the criteria

B. With respect to the figurative elements in the mark

Use of simple geometric shapes

The position and proportion (size) of the figurative element in relation to the word

Whether the figurative element is a representation of the goods and/or services

Whether the figurative element is commonly used in trade in relation to the G&S

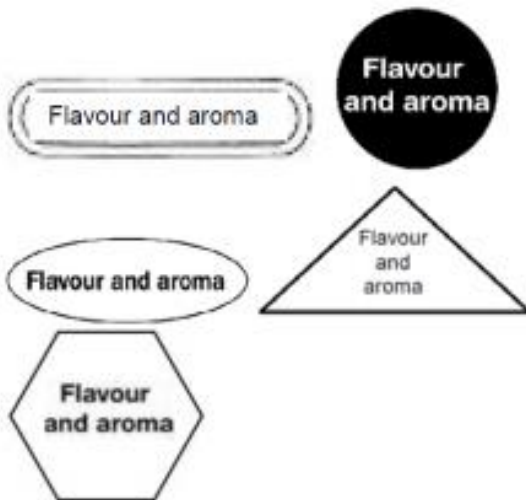
B. With respect to the figurative elements in the mark

Use of simple geometric shapes

- Combination 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 used as a frame or border.
- This is because a geometric shape which merely serves to underline, highlight or surround the word element will not have sufficient impact on the mark as a whole to render it distinctive. On the other hand, **geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive.**

B. With respect to the figurative elements in the mark

Use of simple geometric shapes

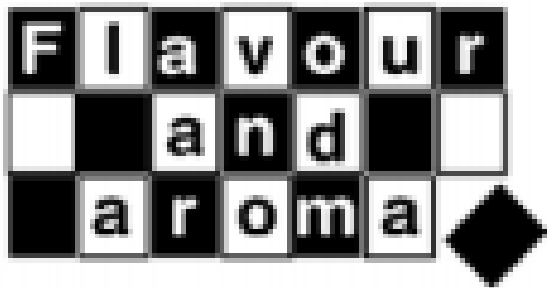


(Class 30: Coffee)

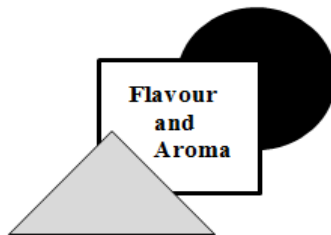
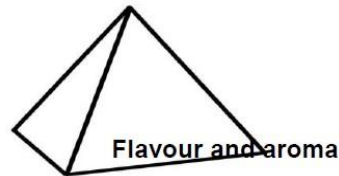
COMMON PRACTICE

B. With respect to the figurative elements in the mark

Use of simple geometric shapes



(Class 30: Coffee)



COMMON PRACTICE

B. With respect to the figurative elements in the mark

The 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 the figurative element is, due to its size and position, clearly recognisable in the sign.

B. With respect to the figurative elements in the mark

The position and proportion (size) of the figurative element in relation to the word element



Fresh Sardine

(Class 29: Sardines)

Flavour and aroma

(Class 30: Coffee)



Flavour and aroma

COMMON PRACTICE

B. With respect to the figurative elements in the mark

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

- A figurative element is, in principle, considered to be descriptive and/or devoid of distinctive character whenever:
 - it is a true-to-life portrayal of the goods and services;
 - it consists of a symbolic/stylised portrayal of the goods and services that is not significantly different from the common representation of the goods and services.
- A figurative element which does not depict the goods and services but has a direct link with the characteristics of the goods and/or services will not render the sign distinctive, **unless it is sufficiently stylised.**

B. With respect to the figurative elements in the mark

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



Fresh Sardine



From the sea to your plate



From the sea to your plate



Sardines



PEST CONTROL SERVICES

(Class 37: Pest control services)

(Class 29: Sardines)

COMMON PRACTICE

B. With respect to the figurative elements in the mark

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



(Class 29: Sardines)



(Class 37: Pest control services)

COMMON PRACTICE

B. With respect to the figurative elements in the mark

The figurative element is commonly used in trade in relation to the goods and services applied for

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

B. With respect to the figurative elements in the mark

The figurative element is commonly used in trade in relation to the goods and services applied for



(Class 30: Coffee)



LEGAL ADVICE SERVICES



(Class 45: Legal services)

COMMON PRACTICE

Overview of the criteria

C. With respect to both the word and the figurative elements in the mark

How combinations of the criteria affect distinctiveness












C. Combinations of criteria

How do combinations of the individual criteria affect distinctiveness?

- In general, a combination of figurative elements and word elements, which are – considered individually – 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 where **the combination results in an overall impression which is sufficiently different from the descriptive/non-distinctive message conveyed by the word element.**

C. Combinations of criteria

How do combinations of the individual criteria affect distinctiveness?

1.	<p> <i>Flavour and aroma</i> <i>Flavour and Aroma</i> Flavour and aroma Flavour and Aroma </p>	<p> Flavour and Aroma <i>Flavour and Aroma</i>  </p>
2.	<p> Flavour and aroma    </p>	<p> Flavour and Aroma   </p>
3.	<p>  Fresh sardine Fresh sardine  FRESH SARDINE </p>	<p>  Fresh Sardine  Fresh sardine  </p>

CP9: Distinctiveness of Three-Dimensional Marks (Shape Marks) Containing Verbal and/or Figurative Elements when the Shape is not Distinctive in Itself

Common Practice aims establish a minimum threshold for distinctiveness of shape marks when the shape itself is non-distinctive

CP9: Scope of the Common Practice

Assessment of the overall inherent distinctiveness of shape marks consisting of a non-distinctive shape of the goods themselves, packaging or containers, and other elements to which the shape mark extends, within absolute grounds examination

CP9: Common Practice Principles

Verbal and figurative elements

Factors which may affect the perception of the sign when assessing its distinctiveness:

- Size/proportion
- Contrast
- Position

CP9: Common Practice Principles

Verbal and figurative elements

Size/Proportion

The assessment is firstly based on the **representation of the sign**, as submitted by the applicant, regardless of the usual size of the product.

The distinctive element must be clearly visible in the representation to render the sign distinctive as a whole.

No specific proportions between the elements and the shape are required.

CP9: Common Practice Principles

Verbal and figurative elements

Principles

01

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.

Distinctive



SIZE/PROPORTION

Class 9 Secure digital memory cards

CP9: Common Practice Principles

Verbal and figurative elements

02

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.

SIZE/PROPORTION

Non-distinctive



Class 3 Cosmetics



Class 16 Packaging/Class 25 Shoes

CP9: Common Practice Principles

Verbal and figurative elements

03

Specific market realities must be taken into consideration. Consumers are in the habit of identifying small elements on certain goods, in which case, relatively small-sized elements may still have a sufficient impact to render the sign as a whole distinctive as long as their size still allows them to be clearly identified as distinctive.

Distinctive



Class 14 Watches



Class 18 Business card holders in the nature of card cases



Class 12 Trucks

SIZE/PROPORTION

CP9: Common Practice Principles

Verbal and figurative elements

04

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.

SIZE/PROPORTION



Class 33 Wine

Non-distinctive



Class 18 Secure digital memory card



CP9: Common Practice Principles

Verbal and figurative elements

Contrast

The use of contrast can affect the capacity of the verbal/figurative element(s) to be identified, and ultimately to render the sign distinctive as a whole.

Contrast can be achieved by the use of different shades of **colours** or by **embossing/engraving/debossing** certain elements on the specific goods.

CP9: Common Practice Principles

Verbal and figurative elements

Principles

(A) Colour contrast

- 01** The use of less contrasting colours can still be sufficient to allow an element to be identified as distinctive in the representation and result in a distinctive sign.

CONTRAST



Class 33 Wine



Class 32 Bottled drinking water

Distinctive



CP9: Common Practice Principles

Verbal and figurative elements

- 02** When the element cannot clearly be identified as distinctive in the representation due to a lack of contrast, the element will have no impact on the assessment of the distinctiveness of the sign as the consumer will not be able to immediately identify such element and ultimately to distinguish the sign from others.

CONTRAST



Non-distinctive



Class 28 Playing balls

CP9: Common Practice Principles

Verbal and figurative elements

- 04** In principle, the fact of engraving/embossing/debossing a non-distinctive element on a non-distinctive shape is not in itself sufficient to render a sign distinctive.

CONTRAST



Class 11 Toaster



Non-distinctive



Class 32 Bottled drinking water

CP9: Common Practice Principles

Verbal and figurative elements

Position

The position of an element to which the sign extends is also a factor to be taken into account when assessing the distinctive character of the sign, as it will affect the capacity of such element to be identified as distinctive or not, and ultimately convey a **distinctive character** to the sign.

CP9: Common Practice Principles

Verbal and figurative elements

Principles

- 01** In general, distinctive elements will render a sign distinctive as a whole, irrespective of their position on the good and the usual presentation of the product on the market, as long as they can be identified as distinctive in the representation of the trade mark application.

POSITION



Class 32 Bottled drinking water

WHITE
GORILLA

WHITE
GORILLA

WHITE
GORILLA

Distinctive



Class 32 Bottled drinking water

CP9: Common Practice Principles

Verbal and figurative elements

Principles

- 01** In general, distinctive elements will render a sign distinctive as a whole, irrespective of their position on the good and the usual presentation of the product on the market, as long as they can be identified as distinctive in the representation of the trade mark application.

POSITION



Class 33 Wine



Class 33 Wine

Non-distinctive



CP9: Common Practice Principles

Verbal and figurative elements

02

In some situations, elements may be perceived differently by the consumer because of their position on the goods and thus change the finding of distinctiveness.

POSITION



Distinctive



Class 3 Cosmetics



Non-distinctive



CP9: Common Practice Principles

Colours

Regard must be had to the
general interest in not
unduly restricting the
availability of colours

Libertel

CP9: Common Practice Principles

Colours

COLOURS

- Applied to the shape
- Single colour
- Combination of colours

CP9: Common Practice Principles

Colours

Principles

- 01** The mere fact of adding a single colour to the shape of a good in the absence of any other distinctive verbal or figurative distinctive element would not render the sign



Class 9 Memory card

Non-distinctive



Class 16 Pencils

CP9: Common Practice Principles

Colours

- 02** A particular arrangement of colours which is uncommon for the goods and creates an overall memorable impression can render the sign as a whole distinctive.

Distinctive

COLOURS



Class 7 Electric door opener



Class 7 Wind turbine

CP9: Common Practice Principles

Colours

COLOURS

- 02** A particular arrangement of colours which is uncommon for the goods and creates an overall memorable impression can render the sign as a whole distinctive.



Class 9 Mobile phone cases

Non-distinctive



Class 20 Chairs



CP9: Common Practice Principles

Combination of factors and elements

Where a shape mark contains more than one of the **elements** already reviewed

or

where more than one of the **factors** previously mentioned are relevant to determine the impact of the elements in the distinctiveness of the sign.

...Distinctiveness of the sign will depend on the **overall impression** produced by the combination of those factors and elements.

CP9: Common Practice Principles

Combination of factors and elements

Principles

A) Combination of factors

- 01** When several factors (such as size, position or contrast) **negatively affect** the element from being identified as distinctive, this will lead to a **non-distinctive** overall impression of the sign.



Class 33 Wine



Class 9 Glasses



CP9: Common Practice Principles

Combination of factors and elements

NON-DISTINCTIVE ELEMENTS

02

(B) Combination of non-distinctive elements

In general, combining a non-distinctive shape with verbal and/or figurative elements, which are considered **individually devoid of distinctive character**, does **not** result in a distinctive sign.



Class 33 Wine



Class 30 Cereals



Class 30 Chocolate

CP9: Common Practice Principles

Combination of factors and elements

NON-DISTINCTIVE ELEMENTS

- 03** Nevertheless, combining a non-distinctive shape with elements which are although considered individually devoid of distinctive character **could be perceived as a badge of origin** due to the perception of the relevant consumer and composition of the sign, when considered as a whole.



Class 33 Wine

Distinctive



Class 30 Chocolate



CP9: Common Practice Principles

Combination of factors and elements

DISTINCTIVE AND NON-DISTINCTIVE ELEMENTS

(C) Combination of distinctive and non-distinctive verbal/figurative elements and colours

- 04** In general, combining a distinctive element together with other non-distinctive elements on a non-distinctive shape **may render the mark distinctive as a whole**, as long as the distinctive element **can be clearly identified** amongst all the other elements.



Class 21 Coffee cups

Distinctive



Class 30 Chocolate



CP9: Common Practice Principles

Combination of factors and elements

DISTINCTIVE AND NON-DISTINCTIVE ELEMENTS

- 05** However, if the distinctive element **is not immediately perceived** by the consumer due to the presence of non-distinctive elements, the combination **may result in a non-distinctive sign**.

Non-distinctive



Class 30 Chocolate

Questions / Comments





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Thank you