



# Manual on Types of Marks and Distinctiveness of Trade Marks in Absolute Grounds in (selected) CARIFORUM IP Offices

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## Manual on Types of Marks and Distinctiveness of Trade Marks in Absolute Grounds

	Antigua and Barbuda Intellectual Property and Commerce Office	AG
	Corporate Affairs and Intellectual Property Office of Barbados	BB
	Belize Intellectual Property Office	BZ
	Cuban Industrial Property Office	CU
	Dominica Companies and Intellectual Property Office (CIPO)	DM
	The Dominican Republic National Office of Industrial Property (Oficina Nacional de la Propiedad Industrial)	DO
	Corporate Affairs & Intellectual Property Office of Grenada	GD
	The Deeds and Commercial Registries Authority of Guyana	GY
	Intellectual Property Service Ministry of Trade and Industry of Haiti	HT
	Jamaica Intellectual Property Office	JM
	Intellectual Property Office of St. Kitts and Nevis	KN
	Registry of Companies & Intellectual Property of Saint Lucia	LC
	Intellectual Property Office of Suriname (Bureau Intellectuele Eigendom)	SR
	Intellectual Property Office of Trinidad and Tobago	TT

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## 1. BACKGROUND

This Manual has been prepared in the framework of the CARIFORUM Intellectual Property and Innovation Project, and is aimed to provide guidance for trade mark applicants and examiners, on types of marks and assessing distinctiveness of trade marks in examination of absolute grounds.

IP Registries/Offices (hereinafter referred to as Offices) of the following countries subscribe to this practice:

- Antigua and Barbuda
- Barbados
- Belize
- Cuba
- Dominica
- The Dominican Republic
- Grenada
- Guyana
- Haiti
- Jamaica
- St Kitts and Nevis
- Saint Lucia
- Suriname
- Trinidad and Tobago

The information contained in this document relates to definition of different types of marks and practical aspects of examination procedures only and is NOT intended to give advice on the scope of protection of a trade mark under national law.

The document constitutes a reference to guide applicants and examiners, and the use of it results in increased transparency, certainty, and predictability of trade mark application procedures.

It will be made widely available and will be easily accessible, providing a **clear and comprehensive explanation of the principles on which the manual is based**.

These principles will be generally applied and aimed at covering the large majority of the cases. Distinctiveness must be assessed on a case-by-case basis, with the common principles serving as guidance in order to ensure that different offices on the same grounds come to a similar, predictable outcome.

## 2. SCOPE

A trade mark registration provides exclusive right to its right holder to prevent others from using a trade mark for the goods and services applied for, for unlimited period of time.

There are several types of trade marks and grounds of refusal of trade mark registration. One of the grounds of refusal is related to distinctiveness of the mark. Trade marks which are devoid of any distinctive character will be refused registration. It is in the public interest to prevent the registration of such marks and prevent to monopolize the signs which are incapable of distinguishing the goods and/or services for which registration is sought from those of other undertakings.

The scope of this manual is to define the different types of marks and to provide a practical guide on the practice concerning distinctiveness of trade marks in absolute grounds of examination.

### 3. SIGNS ACCEPTABLE AS TRADE MARKS

#### 3.1. Definitions and Examples

A trade mark is a sign that is capable of identifying and distinguishing goods and/or services of one company from those of another company. A trade mark is used to represent business or its products in the marketplace.

Different jurisdictions provide different requirements for a trade mark registration. In certain countries, a trade mark should be represented graphically and thus visually perceivable in order to be registered, whereas other jurisdictions provide registration of visually not perceivable signs such as smell marks, olfactory marks, tactile marks or sound marks. By the broadest understanding, to be registered, a sign should be capable of being perceived by any of the human five senses: sight, hearing, taste, smell, and touch.

This section provides the definition of different types of trade marks, namely the following:

- Word marks
- Figurative marks
- Mixed marks
- Shape marks
- Position marks
- Pattern marks
- Colour marks
- Sound marks
- Motion marks
- Multimedia marks
- Hologram marks
- Smell/olfactory marks
- Tactile marks

##### 3.1.1. Word Mark

A word mark is a type of mark consisting of elements such as, letters (either lower or upper case), words (either lower or upper case), numerals, typographic characters or combination thereof with or without a meaning.


A word mark shall be represented by submitting a reproduction of the sign, according to the requirements of each office.

EXAMPLES OF WORD MARKS			
<b>SAMSUNG</b>	<b>NESCAFE</b>	<b>LET'S DO THIS AGAIN</b>	<b>FUSUS</b>
<b>CHANEL N5</b>	<b>APPLE</b>	<b>GIORGIO ARMANI</b>	<b>212</b>

##### 3.1.2. Figurative Marks

Figurative marks are two dimensional signs consisting of purely graphic elements, i.e. images, drawings, figures and illustrations that do not contain letters, words, numerals and/or typographic characters.

A figurative mark must be represented by submitting a reproduction of the sign, showing all its elements. It can be represented in black and white or in colour(s).

EXAMPLES OF FIGURATIVE MARKS		
		



### 3.1.3. Mixed Marks

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

Mixed mark can be a combination of one or more words, letters, numerals and/or typographic characters with one or more figurative elements. The figurative element may be embodied within the word element (for example, the figure of a ball 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 colours.

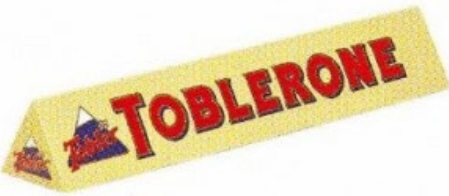

The mark shall be represented by submitting a reproduction of the sign for which registration is sought, showing all its elements and, where applicable, its colours.

EXAMPLES OF MIXED MARKS	
	

### 3.1.4. Shape Marks<sup>1</sup>


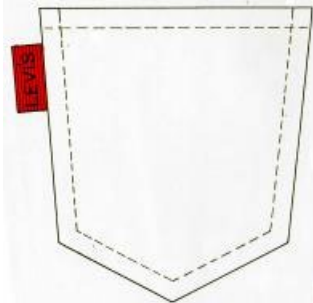
Shape marks are defined as trade marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The mark shall be represented by submitting either a graphic or photographic reproduction of the shape.

<sup>1</sup> Shape marks cannot be protected in BB and SR.

EXAMPLES OF SHAPE MARKS	
	

### 3.1.5. Position Marks<sup>2</sup>

A position mark consists of the specific way in which the mark is **placed or affixed** to the product. The mark shall be represented by submitting a reproduction which appropriately identifies the position of the mark and its size or proportion with respect to the relevant goods. The elements which do not form part of the subject matter of the registration shall be visually disclaimed, as seen in the examples below.

EXAMPLES OF POSITION MARKS	
	

### 3.1.6. Pattern Marks<sup>3</sup>

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

The mark shall be represented by submitting a reproduction showing the pattern of repetition.

<sup>2</sup> Position marks cannot be protected in BB, CU, GD, LC and SR. In CU position mark could be registered as mixed, figurative or three-dimensional signs. In SR position marks can be protected as figurative or mixed marks.

<sup>3</sup> Pattern marks cannot be protected in BB, CU and SR. In CU pattern mark could be protected as mixed, figurative or three-dimensional signs. In SR pattern mark can be protected as figurative or mixed marks.




EXAMPLES OF PATTERN MARKS	
	

### 3.1.7. Colour Marks<sup>4</sup>

Colour mark consists of (i) exclusively of a single colour without contours, or (ii) exclusively of a combination of colours without contours. What is protected is the shade of the colours and the systematic arrangement of the colours in a predetermined and uniform way.

The mark shall be represented by submitting:

- (i) a reproduction of the colour and an indication of that colour (the applicant is advised to include reference to a generally recognised colour code (such as Pantone, Hex, RAL, RGB or CMYK)) or,
- (ii) a reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner (a description detailing the systematic arrangement of the colours may also be added), and indication of the colours (the applicant is advised to include reference to a generally recognised colour code (such as Pantone, Hex, RAL, RGB or CMYK)).

EXAMPLES OF COLOUR MARKS	
	

### 3.1.8. Sound Marks<sup>5</sup>

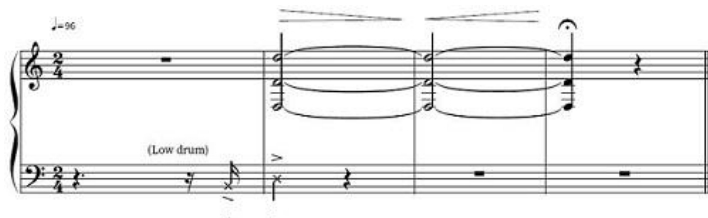
A sound mark consists exclusively of a sound or a combination of sounds that can distinguish goods and services and are audio signature of a product. Sound mark can be represented by audio file or by an accurate representation of the sound in musical notation, based on representation requirements of each office.

<sup>4</sup> Colour marks cannot be protected in CU and SR. In BB only combination of colours is protected and it is not possible to protect single colour as trade mark.

<sup>5</sup> Sound marks cannot be protected in AG, BB, BZ, CU, DM, GD, HT, LC, KN, SR. In CU legislation provides for registration of sound marks however secondary legislation is still not in place and IP Office cannot conduct examination and registration of sound marks. In JM sound marks should be represented graphically.

## EXAMPLES OF SOUND MARK

### Netflix's initial 'Da dum' sound



### Macbook start-up sound

[Link](#)

A = 432.4hz



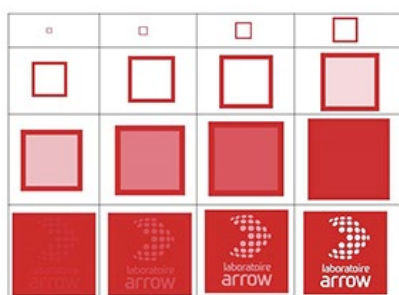
### 3.1.9. Motion Marks<sup>6</sup>

A motion mark consists of, or extends to, a movement or a change in the position of the elements of a mark. The term 'extends to' means that this mark covers not only the motion per se but also movements that contain word or figurative elements such as logos or labels.

The definition does not restrict motion mark to those depicting movement. In addition to movement, the mark may also include words, figurative elements, labels, etc. A sign may also qualify as a motion mark if it is capable of showing a change in the position of the elements (for instance a sequence of stills). Motion marks do not include sound.

The mark shall be represented by submitting a series of sequential still images showing the movement or change of position or a video file, based on representation requirements of each office.

## EXAMPLES OF MOTION MARKS



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

### 3.1.10. Multimedia Marks<sup>7</sup>

Multimedia mark consists of, or extends to, the combination of images and sounds. The term 'extends to' means that this mark covers not only the combination of sound and image per se but also combinations that include word or figurative elements.

<sup>6</sup> Motion marks cannot be protected in AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN, SR. In TT graphic representation of motion mark is required.

<sup>7</sup> Multimedia marks cannot be protected in AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN, SR.

The mark shall be represented by submitting an audio-visual file containing the combination of the image and the sound.

EXAMPLES OF MULTIMEDIA MARKS	
 <p><a href="#">Link</a></p>	 <p><a href="#">Link</a></p>

### 3.1.11. Hologram Marks<sup>8</sup>

Hologram mark consists of elements with holographic characteristics. In this regard, a hologram is an image that changes its appearance when looked at from different angles.

Hologram mark shall be represented by submitting a series of graphic or photographic images containing all the views from different angles which serve to sufficiently identify the holographic effect, or by submitting a video file, based on representation requirements of each office.

EXAMPLES OF HOLOGRAM MARKS <sup>9</sup>	
	 <p><a href="#">Link</a></p>

### 3.1.12. Smell/Olfactory Marks<sup>10</sup>

Smell or olfactory mark consists of a unique smell that identifies product or services. As smell marks lack any form of representation it is not easy to protect them. Smell mark shall be represented by

<sup>8</sup> Hologram marks cannot be protected in AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN.

<sup>9</sup> Example of hologram mark is from [EUIPN Common Practice 11: Common Communication on the Common Practice on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal](#).

<sup>10</sup> Smell marks cannot be protected in AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN and SR. In CU legislation provides for registration of smell marks, however secondary legislation is still not in place and IP Office cannot conduct examination and registration of smell marks.



precisely written description in a way that is easy to identify particular smell and not confused with any other.

Examples of a smell mark: tennis ball with fresh grass smell. Coconut smell for shoes store. Cherry smell for toothbrushes.

### 3.1.13. Tactile Marks<sup>11</sup>

Tactile or touch mark is a mark that captures the feel of a good or service. Tactile marks are characterized by feature of a product that can be felt by touch and not just seen. Its surface should have particular and recognizable texture that is capable to identify goods and services of different undertakings.

Tactile mark shall be represented by submitting a three-dimensional graphic or photographic reproduction of a mark with clear, precise and concrete description.

EXAMPLE OF TACTILE MARK	
 <p>Crackle glass texture</p>	

### 3.2. Types of Trade Marks protected by each IP Office

COUNTRIES	AG	BB	BZ	CU	DM	DO	GD	GY	HT	JM	LC	KN	SR	TT
Mark Type														
Word	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
Figurative	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
Mixed	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓
Shape	✓	✗	✓	✓	✓	✓	✓	✓	✓	✓	✓	✓	✗	✓
Position	✓	✗	✓	✗	✓	✓	✗	✓	✓	✓	✗	✓	✗	✓
Pattern	✓	✗	✓	✗	✓	✓	✓	✓	✓	✓	✓	✓	✗	✓
Colour	✓	✓ <sup>12</sup>	✓	✗	✓	✓	✓	✓	✓	✓	✓	✓	✗	✓
Sound	✗	✗	✗	✗	✗	✓	✗	✓	✗	✓	✗	✗	✗	✓
Motion	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✗	✓
Multimedia	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✗	✓
Hologram	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✓	✓
Smell/Olfactory	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✗	✓
Tactile	✗	✗	✗	✗	✗	✓	✗	✗	✗	✓	✗	✗	✓	✓

<sup>11</sup> Tactile marks cannot be protected in AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN.

<sup>12</sup> In BB only combination of colours can be protected as trade mark.

## 4. DISTINCTIVENESS OF TRADE MARKS IN ABSOLUTE GROUNDS FOR REFUSAL

### 4.1. General Remarks

Distinctiveness is one of the most important features of a trade mark, that a mark applied for should possess in order to be registered. It is an ability of a mark to identify and distinguish the goods and/or services of one undertaking, from those of other undertakings.

If a sign is not distinctive and the relevant public is not able to identify and distinguish certain goods and services marked by this sign as originating from a particular undertaking, such sign will not succeed in registration.

Thus, the 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. A minimum degree of distinctiveness is sufficient to prevent the application of the absolute ground for refusal.

### 4.2. Word Elements

Words merely indicating certain characteristic, quality or function of the goods and services or that are so commonly used in trade that they have lost any capacity to distinguish goods and services, will be considered as non-distinctive. Non-distinctive words will be refused in registration if applied for registration alone or in **combination with other non-distinctive/descriptive elements**.

When non-distinctive/descriptive terms are used in combination with other distinctive elements, they will be considered as unprotected part of a trade mark and in certain jurisdiction they will be disclaimed.

Examples of non-distinctive terms<sup>13</sup>:

- ECO as denoting 'ecological'<sup>14</sup>;
- FLEX and FLEXI as referring to 'flexible'<sup>15</sup>;
- GREEN as being 'environmentally friendly';
- MEDI as referring to 'medical'<sup>16</sup>;
- MULTI as referring to 'much, many, more than one';
- MINI as denoting 'very small' or 'tiny';
- MEGA as denoting 'big';
- Premium/PREMIUM as referring to 'best quality';
- PRO as an indication that the designated goods are intended for 'professionals' or are 'supporting' something<sup>17</sup>;
- PLUS as denoting 'additional, extra, of superior quality, excellent of its kind';
- SUPER for highlighting the 'positive qualities of the goods or services';
- ULTRA as denoting 'extremely';
- UNIVERSAL as referring to goods that are 'fit for general or universal use'.

The same applies to the **top-level domain endings**, such as .org, .net, .int, and to **abbreviations of the legal form of a company** such as INC, SAS, LLC, Ltd, etc. If these elements will be added to otherwise descriptive and/or non-distinctive words, it will not contribute to the distinctiveness of a marks. Top-level domain endings, such as '.com', only indicate the place where information can be found on the internet and thus cannot render a descriptive or otherwise objectionable mark registrable. Therefore, www.holiday.com will not be considered as distinctive trade mark for holiday

<sup>13</sup> Examples are not applicable to SR and KN. In BB when applied for mark contains non-distinctive term in combination with other distinctive elements it must be disclaimed.

<sup>14</sup> Example is not applicable to GY.

<sup>15</sup> Example is not applicable to HT and GY.

<sup>16</sup> Example is not applicable to GY.

<sup>17</sup> This example does not apply to GD.

services. The element '.com' is a technical and generic element, the use of which is required in the normal structure of the address of a commercial internet site. Moreover, it may also indicate that the applied for services are available in internet. Accordingly, the element in question must also be considered to be devoid of distinctive character in respect of the services concerned.

Names of individual persons are usually distinctive, however, if the name will be perceived as non-distinctive term in relation to the goods and services (e.g. 'Baker' for pastry products) it can be objected.

#### 4.3. Single Letters<sup>18</sup>

Registration of a single letter represented in standard characters with no graphic modifications is possible if it will be considered inherently distinctive in respect of the goods and/or services applied for and able to distinguish goods and/or services of one undertaking from those of another.

In certain fields single letters are used as an identifier of models, sizes, ingredients, or components. For example, single letter S applied for cars, as it is commonly used as an indication of sport cars. Single letters S, M, L applied for clothes will be understood as identifier of a size. Single letters C, D or F applied for pharmaceutical, or food products would be understood as containing vitamin C, D, or F. In such cases single letters will not function as trade marks.

Depending on the outcome of the prior examination, a trade mark consisting of a single letter represented in standard characters might be objectionable on the ground that it is devoid of inherent distinctiveness for the goods and/or services concerned or part thereof.

This would be the case, for example, for a trade mark consisting of the single letter 'S' for 'cars', as this letter is commonly used to designate sport cars. The relevant public would not perceive it as a sign distinguishing the commercial origin of the goods in question.

However, if it cannot be established that a given single letter is devoid of any distinctive character for the goods and/or services concerned, then it should be accepted, even if represented in standard characters or in a fairly basic manner.

For example, the letter **W** can be accepted 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.

#### 4.4. Slogans

The Office will assess the distinctiveness of marks consisting of slogans or phrases on the basis of the standard criteria applicable to other types of signs.

In general it is possible to register advertising slogans as trade marks when the public perceives them as an indication of the commercial origin of the goods or services in question. However, advertising slogans are objectionable on grounds of lack of distinctiveness when the relevant public perceives them as a mere promotional formula, not as an indication of commercial provenance.

An advertising slogan is likely to be distinctive whenever it is seen as more than a mere advertising message praising the qualities of the goods or services in question because it:

- constitutes a play on words;
- introduces elements of conceptual intrigue or surprise, so that it may be perceived as imaginative, surprising or unexpected;
- has some particular originality or resonance; and/or,

<sup>18</sup> Single letters are not considered distinctive in BB, CU, DO and SR.



- triggers in the minds of the relevant public a cognitive process or requires an interpretative effort.

In addition to the above, the following characteristics of a slogan may contribute towards a finding of distinctiveness:

- unusual syntactic structures;
- the use of linguistic and stylistic devices, such as alliteration, metaphors, rhyme, paradox, etc.

Advertising slogans that only highlight benefits and positive aspects of the goods and services applied for, or immediately conveys information about the kind, quality, intended purpose or other characteristics of the goods and services, will not be considered distinctive and perceived as trade marks<sup>19</sup>:

- 'Buy 2, get 3'.
- 'Our products are the best'.

However, if an advertising slogan is original, can be considered imaginative, or requires interpretative efforts of unusual structure, it can be perceived as distinctive. For instance, a slogan whose meaning is vague or impenetrable or whose interpretation requires considerable mental effort on the part of the relevant consumers is also likely to be distinctive since consumers would not be able to establish a clear and direct link with the goods and services for which the trade mark is protected.

Some examples of accepted slogans<sup>20</sup>:

Trade mark	Class	Justification
WET DUST CAN'T FLY	3, 7 and 37	The concept of 'wet dust' is literally inaccurate, since dust is no longer dust when it is wet. Consequently, the juxtaposition of those two words gives that concept a fanciful and distinctive character.
LOVE TO LOUNGE	25	When the mark is used in relation to the goods in question, namely clothing, footwear and items of headgear, the relevant public will have to place that mark in a certain context, which requires an intellectual effort. The contested mark will enable consumers to identify the commercial origin of the goods at issue. Consequently, that mark has inherent distinctive character.

#### 4.5. Basic Shapes and Simple Figures

A sign consisting of simple geometric shapes and figures such as circles, lines, rectangles or common pentagons are unable to convey any message that can be remembered by consumers and will accordingly not be seen by them as a trade mark<sup>21</sup>. Such signs are unable to function as trade marks to distinguish goods or services in trade and are, therefore, devoid of distinctiveness.

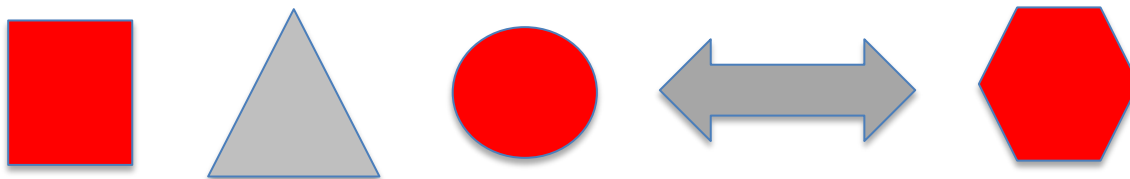
<sup>19</sup> In HT these slogans will be considered distinctive and in DO first two slogans will be considered distinctive.

<sup>20</sup> Examples in this section are mostly taken from [Guidelines for Examination of European Union Trade Marks and Registered Community Designs at the EUIPO, Part B, Section 4, Chapter 3, item 4 Slogans: Assessing Distinctive Character \(Page 372\)](#).

In HT these slogans will not be considered distinctive.

<sup>21</sup> HT and DO are not aligned with this principle.

By way of example, the following shapes would not be sufficiently distinctive to be considered as trade marks:



The same consideration will apply to:

- punctuation and typographic symbols, such as full stop (.), semicolon (;), exclamation mark (!), question mark (?), percentage symbol (%), etc.<sup>22</sup>, that will be perceived by the consumer as signs meant to catch their attention but not as a sign that indicates commercial provenance;
- mathematical symbols, such as: the plus sign (+), minus (-), multiplication sign (x), division sign (÷), etc.;
- common currency symbols, such as the €, £, \$, that depending on the goods concerned, will only inform consumers that a specific product or service is traded in that currency;
- pictograms, basic, unornamented signs and symbols that have a purely informative or instructional value in relation to the goods or services concerned, such as a white 'P' on a blue background to designate a parking place, device of lightning bolt for goods in Class 9.

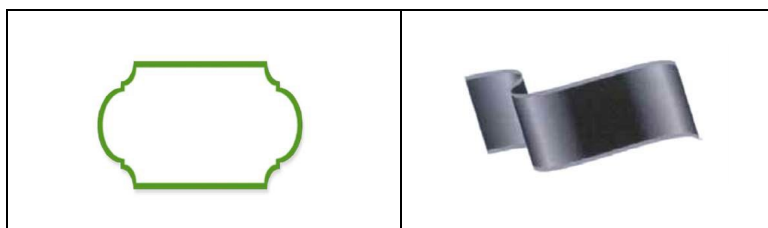


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#### 4.6. Common/Non-Distinctive Labels <sup>24</sup>

A figurative sign may be composed of shapes, designs or figures that will be perceived by the relevant public as non-distinctive labels. In this case, the reason for the refusal lies in the fact that such figurative elements are not capable of impressing themselves distinctly on the consumer's mind, since they are too simple and/or commonly used in connection with the goods/services for which protection is sought.

The following examples of labels or frames would not, in the absence of other distinctive elements, be recognized as trade marks, regardless of the type of goods or services in connection with which they are used:



However, if a distinctive sign (word or mixed) was inserted or juxtaposed on the basic label or frame

<sup>22</sup> HT does not agree with this principle.

<sup>23</sup> In CU this example will be considered as a stylized letter and thus will be distinctive.

<sup>24</sup> BB is not aligned with this principle.



in the examples above, the resulting composite sign could become distinctive and be registered as a whole.

#### 4.7. Shape Marks<sup>25</sup>

Shape marks can be grouped into three categories:

- shapes that are **unrelated to the goods** and services applied for;
- shapes of **the goods themselves** or part of the goods;
- the shape of packaging, wrapping or containers.

##### 4.7.1. Shapes unrelated to the goods or services

Shapes that are unrelated to the goods or services applied for (e.g. the Michelin Man) are usually distinctive<sup>26</sup>.

##### 4.7.2. Shape of the goods themselves or part of the goods

If a mark consists of a basic shape of the goods applied for, which does not depart significantly from the shape that usually consumers associate to this product, it will not be considered distinctive.

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<sup>27</sup>.

When a non-distinctive shape contains an element that is distinctive on its own, it will suffice to render the sign as a whole distinctive. However, non-distinctive elements or descriptive elements combined with a standard shape will not confer distinctiveness to the sign.

Having identified all the elements to which the shape extends, the assessment of distinctiveness must be based on the overall impression of the combination of the shape and the elements to which it extends, in relation to the goods in question, and considering the consumer's perception which can be influenced by specific market realities.

##### 4.7.3. Elements and factors affecting the distinctiveness of the sign as a whole when the shape is non-distinctive<sup>28</sup>

The size and proportion of the verbal/figurative elements, their contrast with respect to the shape, and their actual position on it, are all factors which may affect the perception of the sign when assessing its distinctiveness.

<sup>25</sup> This section does not apply to BB, and SR.

<sup>26</sup> HT does not agree with this principle.

<sup>27</sup> BB is not aligned with this principle.

<sup>28</sup> Examples are taken from [EUIPN Common Practice 9: Common Communication on the Common Practice of Distinctiveness of three-dimensional marks \(shape marks\) containing verbal and/or figurative elements when the shape is not distinctive in itself](#).

VERBAL AND FIGURATIVE ELEMENTS	
Size/proportion	
<p><b>DISTINCTIVE</b></p>  <p>Class 9 Secure digital memory cards</p>	<p><b>NON-DISTINCTIVE</b></p>  <p>Class 3 Cosmetics</p>
<p>When the verbal/figurative element is <b>sufficiently large</b> to be clearly identified as <b>distinctive</b> and has sufficient impact on the overall impression given by the sign, it renders the sign as a whole distinctive.</p>	<p>When the verbal/figurative element is <b>large</b>, but identified as <b>non-distinctive</b>, its size alone, in proportion to the shape, will not be sufficient to render the sign as a whole distinctive.</p>
<p><b>NON-DISTINCTIVE</b></p>  <p>Class 9 Secure digital memory card</p>	<p><b>DISTINCTIVE</b></p>  <p>Class 14 Watches</p>
<p>When the verbal/figurative element is <b>small</b> to the point it is <b>not identifiable</b> as distinctive, it will not have a sufficient impact on the overall impression and therefore will not render the shape as a whole distinctive.</p>	<p><b>Specific market realities</b> must also be taken into consideration. Consumers are in the habit of identifying small elements on certain goods. Despite the <b>small</b> size the verbal elements can still be <b>identified</b> as distinctive elements in the representation.</p>

## VERBAL AND FIGURATIVE ELEMENTS

### Colour contrast

#### DISTINCTIVE<sup>29</sup>



Class 32 Bottled drinking water

#### NON-DISTINCTIVE



Class 28 Playing balls

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. The overall assessment will depend on the distinctiveness of such an element.

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.

## VERBAL AND FIGURATIVE ELEMENTS

### Position

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.

#### DISTINCTIVE



Class 32 Bottled drinking water

#### NON-DISTINCTIVE



Class 33 Wine

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.

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.

<sup>29</sup> This example is not considered as distinctive mark in A&B and HT

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.

### DISTINCTIVE



Class 3 Cosmetics

### NON-DISTINCTIVE



Class 3 Cosmetics

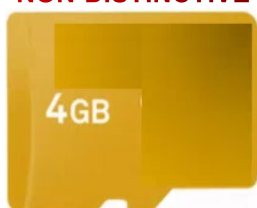
The verbal element 'CLOSE' bears no relation to the goods in Class 3. When placed centrally, the verbal element is perceived as distinctive, as it does not provide a descriptive indication of the good. Therefore, the sign as a whole is distinctive.

The verbal element 'CLOSE' bears no relation to the goods in Class 3. 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.

## COLOURS

In assessing the distinctive character of a colour, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought.

### NON-DISTINCTIVE



Class 9 Memory card



Class 20 Chairs

### DISTINCTIVE<sup>30</sup>



Class 7 Electric door opener

<sup>30</sup> This example is not considered as distinctive mark in HT.

<p>The mere fact of adding a single colour to the shape of a good in the absence of any other distinctive verbal or figurative element would not render the sign inherently distinctive.</p> <p>In the first 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.</p> <p>As regards to the chair, its colours combination conveys exclusively a decorative message and will not be recognised as a reference to its origin.</p>	<p>It cannot be excluded that 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.</p> <p>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.</p> <p>As a result, the sign as a whole is distinctive.</p>
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### COMBINATION OF FACTORS AND ELEMENTS





There are certainly situations where a shape mark contains more than one of the elements reviewed above. Moreover, there may be cases where more than one of the abovementioned factors are relevant to determine the impact of the elements in the distinctiveness of the sign. In all situations, the distinctiveness of the sign will depend on the **overall impression** produced by the combination of those factors and elements.

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.

<p style="color: red; text-align: center;"><b>NON-DISTINCTIVE</b></p>  <p>Class 9 Glasses</p>	<p style="color: green; text-align: center;"><b>DISTINCTIVE</b></p>  <p>Class 9 Glasses</p>
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<p>The size and engraving of the element do not enable it to be identifiable, as the elements cannot be found without close inspection. This results in a non-distinctive overall impression.</p>	<p>In this case, the size of the element and its contrast with the goods allow for it to be identified as distinctive: it altogether results in a distinctive overall impression.</p>
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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.

<p style="text-align: center;"><b>DISTINCTIVE</b></p>  <p style="text-align: center;">Class 30 Chocolate</p>	<p style="text-align: center;"><b>NON-DISTINCTIVE</b></p>  <p style="text-align: center;">Class 25 Shoes / Class 16 Packaging</p>
<p>The combination of a non-distinctive shape with elements which are considered devoid of distinctive character could render the sign distinctive as a whole. In this example, even though the word elements are descriptive, their arrangement as a sun or a flower results in a distinctive overall impression.</p>	<p>The random arrangement of simple geometric shapes on the shape of the good in Class 16 and of the common packaging of shoes in Class 25 does not provide an overall impression which is distinctive as the consumer will not perceive this particular combination as an indication of commercial origin but merely as a possible decoration of the packaging.</p>
<b>COMBINATION OF FACTORS AND ELEMENTS</b>	
<p>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.</p>	
<p style="text-align: center;"><b>DISTINCTIVE</b></p>  <p style="text-align: center;">Class 30 Chocolate</p>	<p style="text-align: center;"><b>NON-DISTINCTIVE</b></p>  <p style="text-align: center;">Class 30 Chocolate</p>
<p>Despite the combination of many nondistinctive elements, the verbal element 'ECS' can be identified as distinctive in the representation due to its size, position and contrast with respect to the good, and therefore it is able to render the sign distinctive as a whole.</p>	<p>The verbal element 'ECS' is lost within multiple non-distinctive elements. Due to its position, size and lack of contrast, it cannot be identified as distinctive without close inspection and therefore, cannot render the sign distinctive as a whole.</p>

#### 4.7.4. Shapes of the packaging, wrapping or containers

In case of shape of the packaging, wrapping or containers, shape will not be considered distinctive if it is common shape used by many producers and if it has any functional features. The shape must be materially different from a combination of basic or common elements and must be striking.

The Office must be especially careful about any functional character of a given shape or an element of the shape. Usage in trade might be different for different types of goods, and the Office should make a search to ascertain which shapes are on the market for a particular type of product, choosing a sufficiently broad category of the goods concerned. For instance, to assess the distinctiveness of a milk container, a search must be carried out in relation to containers for beverages in general.

#### 4.8. Position Marks<sup>31</sup>

Distinctiveness of a position marks depends on the perception of the relevant public. Position mark will be considered distinctive if the relevant public will identify it as different from the normal appearance of the product itself and the positioning of the mark upon the goods is likely to be understood as having a trade marks context.



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.



The mark 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.

#### 4.9. Pattern Marks<sup>32</sup>

Pattern marks may cover any kind of goods and services. However, in practice they are more commonly filed in relation to goods such as paper, fabrics, clothing articles, leather goods, jewellery, wallpaper, furniture, tiles, tyres, building products, etc. These are goods that normally feature designs. In these cases, the pattern is nothing else than the outward appearance of the goods. Although patterns may be represented in the form of square/rectangular labels, they should nonetheless be assessed as if they covered the entire surface of the goods specified in the application.

It must also be taken into account that when a pattern mark claims protection for goods such as beverages or fluid substances in general, normally distributed and sold in containers, the assessment of the design should be made as if it covered the outward surface of the container/packaging itself.

As a rule, in the assessment of the distinctive character of patterns, the examiner should use the same criteria that are applicable to shape marks that consist of the appearance of the product itself.

<sup>31</sup> This section does not apply to BB, CU, GD, LC, SR as position marks are not protected in these jurisdictions.

<sup>32</sup> This section does not apply to BB, CU and SR as pattern marks are not protected in these jurisdictions.



With regard to services, examiners should bear in mind that pattern marks will be used in practice on letterheads and correspondence, invoices, internet websites, advertisements, shop signs, etc.

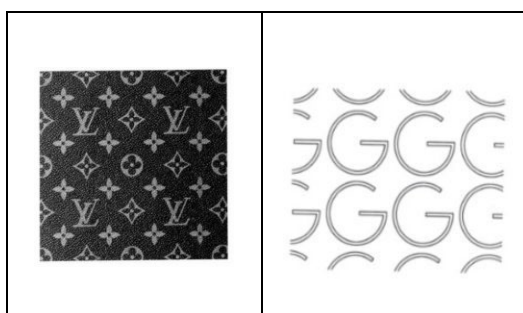
If a pattern is commonplace, traditional and/or typical, it is devoid of distinctive character. In addition, patterns that consist of basic/simple designs usually lack distinctiveness. The reason for the refusal lies in the fact that such patterns do not convey any message that could make the sign easily memorable for consumers as an indication of commercial origin and would be perceived as merely decorative elements.

For example, the following surface patterns on a product would not be perceived as marks:



However, if a pattern is fanciful, unusual and/or arbitrary, departs from the norm or customs of the sector or is, more generally, capable of being easily memorised by the targeted consumers, it may be recognized as having sufficient distinctive character to be registered as a trade mark.

Accepted pattern marks:



#### 4.10. Colour Marks<sup>33</sup>

Where colours or colour combinations as such are applied for as a trade mark, the appropriate examination standard is whether they are distinctive either if applied to the goods or their packaging, or if used in the context of delivery of services. It is a sufficient ground for a mark to be refused if the mark is not distinctive in either of these situations. For colour combinations, examination of distinctiveness should be based on the assumption that the colour combination appears on the goods or their packaging, in a way that accords with the representation, or in advertisements or promotional material for the services.

<sup>33</sup> This section does not apply to CU and SR as colour marks are not protected in these jurisdictions.



#### 4.10.1. Single Colours

A colour is not normally inherently capable of distinguishing the goods of a particular undertaking. 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.

Such exceptional circumstances require the applicant to demonstrate that the mark is unusual or striking in relation to these specific goods or services. These cases will be very rare, and refusal could be overcome for example in the case of the colour black for milk. Where the single colour is found to be commonly used in the relevant sector(s) and/or to serve a decorative or functional purpose, the colour must be refused. The public interest is an obstacle to the monopolisation of a single colour, irrespective of whether the relevant field of interest belongs to a very specific market segment.

#### 4.10.2. Colour Combinations

Combination of colour could be distinctive if the combination is not a usual or natural colour of the product. In case of combination of two colours, if one of the colours is the commonplace colour for the product or the natural colour of the product, additional colour will not add distinctiveness to the mark, and such two-colour mark will not be considered distinctive.

Combination of two colours will not be considered distinctive in the following cases:

- If a colour is a decorative element of the goods or comply with the consumer's request (e.g. colours of cars or T-shirts), irrespective of the number of colours concerned.
- A colour can be the nature of the goods (e.g. for tints).
- A colour can be technically functional (e.g. colour red for fire extinguishers, various colours used for electric cables).
- A colour may also be usual (e.g. again, red for fire extinguishers, yellow for postal services in many countries).
- A colour may indicate a particular characteristic of the goods, such as a flavour (yellow for lemon flavour, pink for strawberry 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 (e.g. the colour combination red and yellow is used by various enterprises on beer and soft drink cans).

In all these cases the trade mark should be objected to, but with careful analysis of the goods and services concerned and the situation on the market.

#### 4.11. Sound Marks<sup>34</sup>

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.

The perception of the relevant public is not necessarily the same in the case of a sign consisting of a sound as in the case of a word or figurative mark. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, consumers are not used to associate a sound to the commercial of goods or services in the absence of any graphic or word element.

<sup>34</sup> This section does not apply to AG, BB, BZ, CU, DM, GD, HT, LC, KN, SR as sound marks are not protected in these jurisdictions.

Examples in this section are taken from [EUIPN Common Practice 11: Common Communication on the Common Practice on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal](#).





Therefore, only a sound that departs significantly from the norm or customs of the trade sector, and fulfils its essential function of indicating origin, would be recognized as having sufficient distinctive character.

The kinds of sound marks that are unlikely to be accepted without evidence of factual distinctiveness include:



- very simple pieces of music consisting of only one or two notes (see examples below);
- sounds that are in the common domain (e.g. *La Marseillaise*, *Für Elise*);
- sounds that are too long to be considered as an indication of origin;
- sounds typically linked to specific goods and services (see examples below).

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.

Examples of non-acceptable trade marks:

 <p>Two musical notes, F and C Classes 35, 36, 38, 39, 41, 42</p>	<p>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.</p>
 <p>(Click the image to reproduce) Single note Class 12 Cars</p>	<p>This sound consisting of one note lacks resonance and would not be recognised by the consumer as an indication of commercial origin. Therefore, the sound mark is considered non-distinctive.</p>
 <p>The first 13 notes of 'La Marseillaise' Class: Any</p>	<p>A national anthem is in the public domain. This necessarily implies that it is a non-distinctive sign as it will not be perceived as an indicator of commercial origin.</p>
 <p>(Click the image to reproduce) Sound of a door bell Class 9 Door bells</p>	<p>The sound perceived in the mark can be easily connected to the goods for which protection is sought. Therefore, the mark would be considered non-distinctive.</p>

Examples of acceptable trade marks:

 <p>(Sequence of four different tones, initially falling by a fourth and then rising and ending on the median) Class 16, 35, 42</p>	<p>In this example, jingle-like sound sequences are capable of identifying goods and services.</p>
 <p>(Click the image to reproduce) Sound of a mooing cow Class 11 Goods toilets</p>	<p>In this example, the sound perceived in the mark has no link to the goods for which protection is sought and has sufficient resonance to be recognised by the consumer as an indication of commercial origin.</p>

#### 4.12. Motion Marks<sup>35</sup>

For motions marks, the general criteria for assessing distinctiveness will apply. It means that motion mark will be considered distinctive if it can identify the goods and/or services for which registration is sought as originating from a particular undertaking, and thus distinguish them from those of other undertakings.

This distinctiveness will be assessed by reference, first, to the goods or services for which registration is sought and, second, to the relevant public's perception of that sign.

Motion marks which are perceived as an intrinsically functional element of the goods or services themselves, or are used to control those goods will not generally be seen by the public as an indication of commercial origin, but merely as functional attributes.

The public's perception of motion marks that contain verbal or figurative elements will depend on the addition of motion and on whether the verbal or figurative element is, due to its size and position, clearly recognisable in the sign.



When assessing the distinctiveness of these types of trade marks, they will generally be considered **distinctive** if they contain a **distinctive verbal and/or figurative element** moving or changing its position, colour and/or elements, even though the movement or change of position itself may not be distinctive.

When the motion mark shows an **element** which **cannot be understood or is non-identifiable**, in that it does not attribute a meaning or create a link to the goods and/or services, as long as it is capable of being recognised as an indication of commercial origin by the consumer, it will be considered **distinctive**.

<sup>35</sup> This section does not apply to AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN, SR as motion marks are not protected in these jurisdictions.

Examples in this section are taken from [EUIPN Common Practice 11: Common Communication on the Common Practice on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal](#).

## Examples of acceptable trade marks:

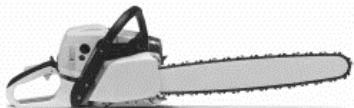

 <p>(Click the image to reproduce) Class 9 Computers</p>	<p>The figurative element in the motion mark is considered distinctive in itself. Combined with the changing colours the consumer will perceive it as indication of commercial origin for the goods applied for.</p>
 <p>(Click the image to reproduce) Class 36 Financial services</p>	<p>This motion mark contains an abstract image changing its form and colour which is capable of being recognised as an indication of commercial origin by the consumer, and thus, to function as a trade mark.</p>


In principle, when the motion mark consists of a movement produced by or connected to the goods and/or services, or to other relevant features thereof, it will be perceived by the consumer merely as a **functional element of or for the goods and/or services**. Therefore, the motion mark will be considered **non-distinctive**.

When the motion mark consists of a **non-distinctive/descriptive/generic verbal and/or figurative element** moving or changing its position, colour and/or elements, it will be considered **non-distinctive** unless the movement itself is sufficient to distract the attention from the message conveyed by the non-distinctive/descriptive verbal or figurative element.

Additionally, the consumer would not perceive motion marks as indicators of commercial origin if they do **not** create a **lasting impression** on the consumer. Therefore, these would be considered as **non-distinctive**.

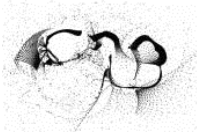
## Examples of non-acceptable trade marks:

 <p>(Click the image to reproduce) Class 7 Chainsaws</p>	<p>The consumer will not perceive this motion as a trade mark but only a movement produced by the goods. Therefore, it is considered non-distinctive.</p>
 <p>(Click the image to reproduce) Class 3 Washing powder</p>	<p>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.</p>

 <p>(Click the image to reproduce) Class 39 Travel services</p>	<p>This motion contains too many elements to leave a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</p>
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However, as in the example below, it cannot be excluded that a particular movement, which in itself is **unusual** and **striking** or creates an unusual and striking visual impact, could be sufficient to render a motion mark **distinctive** in its overall impression.

Examples of acceptable trade marks:

 <p>(Click the image to reproduce) Class 3 Washing powder</p>	<p>The addition of a particular movement to the non-distinctive/descriptive verbal element 'Eco' creates an unusual and striking visual impact, which is sufficient to render the mark distinctive as a whole.</p>
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#### 4.13. Multimedia Marks<sup>36</sup>

For multimedia marks, the general criteria for assessing distinctiveness will apply. It means that multimedia mark will be considered distinctive if it can identify the goods and/or services for which registration is sought as originating from a particular undertaking, and thus distinguish them from those of other undertakings.

This distinctiveness will be assessed by reference, first, to the goods or services for which registration is sought and, second, to the relevant public's perception of that sign.

Multimedia marks are composed of both sound and image elements, these can then be verbal or figurative in nature, with or without movement. The consumer would be more likely to perceive the mark as being an indication of commercial origin if neither of these elements has a link to the goods or services applied for.

Nevertheless, the perception of sound and image elements in a multimedia mark may vary depending on their individual components (verbal, figurative and sound). The way in which the consumer will perceive the mark will depend on the overall combination of components and any link between these and the goods and services.



In general, when at least **one of the elements** of a multimedia mark, either the sound or the image, is considered **distinctive** in itself, the trade mark as a whole will be considered distinctive. Additionally, it should be noted that when the multimedia mark is composed of distinctive and non-distinctive/descriptive/generic elements, the scope of protection of the mark will be limited to the overall impression of the multimedia mark and no exclusive rights will be given to the non-distinctive/descriptive elements in themselves.

<sup>36</sup> This section does not apply to AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN, SR as multimedia marks are not protected in these jurisdictions.

Examples in this section are taken from [EUIPN Common Practice 11: Common Communication on the Common Practice on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal](#).

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



Examples of acceptable trade marks:

 <p>(Click the image to reproduce) Class 12 Cars</p>	<p>Both the image and the sound are considered distinctive in themselves and therefore the multimedia mark is distinctive.</p>
 <p>(Click the image to reproduce) Class 12 Cars</p>	<p>The combination of an abstract image changing its form and position and a sound containing a verbal element which is invented, makes the mark capable of being recognised by the consumer as an indication of commercial origin.</p>

In the same manner, a multimedia mark combining **non-distinctive/descriptive/generic image(s)** with **non-distinctive sound(s) and motion(s)**, will, in general, be considered **non-distinctive**.

Additionally, the consumer would not perceive multimedia marks as indicators of commercial origin if they do not create a lasting impression on the consumer. Therefore, these would be considered as non-distinctive.

Examples of non-acceptable trade marks:


 <p>(Click the image to reproduce) Class 29 Sardines</p>	<p>The multimedia mark is considered non-distinctive/descriptive since it combines a non-distinctive image with a non-distinctive sound, which also serves to describe the image itself.</p>
 <p>(Click the image to reproduce) Class 39 Travel services</p>	<p>The visual features and the sound of this multimedia mark contain too many elements to leave a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</p>

However, despite containing purely non-distinctive/descriptive/generic image(s) and/or sound(s), a multimedia mark can still be accepted on absolute grounds if there are other elements in the mark which contribute to render the mark distinctive as a whole.



In this regard, a multimedia mark, which contains both non-distinctive/descriptive/generic image(s) and sound(s) cannot rely solely on these elements seen in isolation. It could be possible that such a combination would allow the multimedia mark to fulfil its essential function when applied for certain goods and services, and thus render the multimedia mark distinctive as a whole.

Examples of acceptable trade marks:

 <p>(Click the image to reproduce) Class 31 Foodstuff for animals</p>	<p>The unusual combination of image and sound results in an overall impression, which is sufficiently distinctive as a whole.</p>
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#### 4.14. Hologram Marks<sup>37</sup>


The Office will examine the distinctiveness of a hologram sign using the same general criteria applied to assess the distinctiveness of other marks. A hologram mark will be distinctive if it can identify the specified goods or services as originating from a particular undertaking and is capable of distinguishing such goods or services from those of other undertakings.

This distinctiveness will be assessed by reference to the goods or services for which registration is sought and to the relevant public's perception of that sign.

The way in which the consumer will perceive the mark will depend on the overall combination of components and any link between these and the goods and services. Hologram marks that consist exclusively of verbal and figurative elements will, generally, not be perceived as indications of commercial origin if a link can be established between the mark and the goods and services. Moreover, the assessment will depend on the holographic effect and on whether the verbal or figurative element is, due to its size and position, clearly recognisable in the sign.

When the hologram mark consists of a **verbal and/or a figurative element** which is **distinctive in itself**, even if the holographic characteristics added to those elements are non-distinctive, the hologram mark will be considered distinctive as a whole, and the scope of protection of the mark will be limited to the overall impression of the hologram mark.

Examples of acceptable trade marks:

 <p>(Click the image to reproduce) Class 12 Cars</p>	<p>The combination of the distinctive verbal and figurative elements in the hologram mark makes the hologram mark distinctive as a whole.</p>
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When the hologram mark consists of a **non-distinctive/descriptive/generic verbal and/or**

<sup>37</sup> This section does not apply to AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN as hologram marks are not protected in these jurisdictions.

Examples in this section are taken from [EUIPN Common Practice 11: Common Communication on the Common Practice on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal](#).

**figurative element**, it will be considered non-distinctive.

In general, the addition of a holographic effect to a non-distinctive verbal and/or figurative element will not necessarily be sufficient to give the mark distinctive character, since it will be perceived by the consumer merely as a banal or decorative element, regardless of whether it relates to the goods and/or services applied for.

Example of non-acceptable trade marks:

<p>(A hologram, represented in MP4, consisting of the verbal element 'Premium' with a simple typeface, that when moved and put through proper light, appears bigger and with a different typeface.)</p> <p>Class 3 Washing powder</p>	<p>The addition of the holographic effect to the non-distinctive/descriptive verbal element 'Premium' is not sufficient to distract the attention from the meaning conveyed by the verbal element. The simple change in size and typeface will be perceived by the consumer merely as a banal and decorative element. Therefore, the hologram mark is not distinctive.</p>
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#### 4.15. Smell/Olfactory Marks<sup>38</sup>

Smell mark will not be distinctive if it is a smell of the goods of applied for, if it arises due to the nature of the product or if it is a main essence of the goods. For example, strawberry smell will not be considered distinctive for strawberry jellies or any smell of the perfume for perfumery products. In order to be distinctive smell should not serve a specific function of a product and should be able to distinguish goods and services. Examples of distinctive smell marks are: a floral fragrance/scent reminiscent of roses as applied for tyres, bubble gum-scented for sandals.

#### 4.16. Tactile Marks<sup>39</sup>

Tactile mark will be considered distinctive if its texture is not banal, common, merely decorative, ornamental or functional element of the product. Tactile elements of the mark should be not only striking to the consumer but rather distinctive in nature. As other types of marks tactile mark should be able to identify and distinguish goods without reading the label or seeing the shape, but by the touching the product. For example, crackle glass texture for whiskey.

<sup>38</sup> This section does not apply to AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN, SR as smell marks are not protected in these jurisdictions.

<sup>39</sup> This section does not apply to AG, BB, BZ, CU, DM, GD, GY, HT, LC, KN as tactile marks are not protected in these jurisdictions.



## ANNEX I – LEGAL REFERENCES

COUNTRY	TM LAW	Article(s) related to distinctiveness
Antigua and Barbuda	The Trade Marks Act	2, 3(1)
Barbados	Trade Marks Acts	9 (a)(b)(c)(d)
Belize	Trade Marks Act	35 (a) (b)
Cuba	Trade Mark Law	16.1 (a)
Dominica	The Marks, Collective Marks and Trade Names Act Chapter 78:53 of the 2017 Revised Laws of Dominica	4 (a)
Dominican Republic	Industrial Property Law of the Dominical Republic	73 (1)(f)
Grenada	Trademarks Act 2012	6 (a)
Guyana	Trade Marks Act	11 (1) (e)
Haiti	Trade Marks Law	2
Jamaica	The Trade Marks Act	11 (1) (b)
St Kitts and Nevis	Marks, Collective Marks and Trade Names Act	4 (a)
St Lucia	Trade Marks Act	25
Suriname	Regulations of Industrial Property	2.1
Trinidad and Tobago	The Trade Marks Act No. 8 of 2015	8 (1) (b)