



# Descriptiveness of Trade Marks in Absolute Grounds

Sophio MUJIRI | 17 January 2023



CARIFORUM



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

[www.caripi-hub.com](http://www.caripi-hub.com)

# Descriptiveness

---

Rationale  
Definition  
Examples  
Next Steps



# INDEX

1. General Remarks
2. Word Marks
3. Figurative Marks
4. Figurative Threshold
5. Descriptiveness for Non traditional Marks (Sound marks, Motion Marks, Multimedia and Hologram marks)

## Contents

<b>1. GENERAL REMARKS</b> .....	3
1.1. NOTION OF "DESCRIPTIVENESS".....	3
1.2. REFERENCE BASE TO ESTABLISH "DESCRIPTIVENESS".....	4
1.2.1. <i>Languages</i> .....	7
1.2.2. <i>Evidence</i> .....	7
1.3. <i>Characteristics that may be described by the sign</i> .....	7
1.3.1. <i>Kind of goods and services</i> .....	8
1.3.2. <i>Quality</i> .....	8
1.3.3. <i>Quantity</i> .....	8
1.3.4. <i>Intended purpose or usefulness</i> .....	9
1.3.5. <i>Value</i> .....	10
1.3.6. <i>Geographical origin</i> .....	10
1.3.7. <i>Other characteristics</i> .....	10
<b>2. WORD MARKS</b> .....	11
2.1. SINGLE WORD.....	11
2.2. COMBINATION OF WORDS.....	13
2.2.1. <i>Combinations that do not follow grammatical rules</i> .....	17
2.2.2. <i>Combinations of words in different languages</i> .....	17
2.3. MISSPELLINGS AND OMISSION OF WORDS.....	18
2.4. ABBREVIATIONS AND ACRONYMS.....	19
2.5. SLOGANS AND COMMERCIAL PHRASES.....	20
2.6. GEOGRAPHICAL TERMS AND EXPRESSIONS.....	20
2.6.1. <i>Assessment of geographical terms</i> .....	21
2.6.2. PLAUSIBILITY AS A FACTOR TO DETERMINE DESCRIPTIVENESS OF GEOGRAPHICAL TERMS.....	22
2.7. TERMS DESCRIBING SUBJECT MATTER OR CONTENT IN GOODS OR SERVICES.....	25
2.8. SINGLE LETTERS AND NUMERALS.....	26
2.8.1. <i>Single letters</i> .....	26
2.8.2. <i>Numerals</i> .....	26
2.9. NAMES OF COLORS.....	27
2.10. NAMES OF BANKS, NEWSPAPERS AND AIRPORTS.....	29
2.11. NAMES OF HOTELS.....	30
2.12. COMBINATIONS OF NAMES OF COUNTRIES OR CITIES WITH THE NUMBER OF A YEAR.....	31
2.13. SIGNS CONSISTING OF INN CODES.....	32
<b>3. FIGURATIVE MARKS</b> .....	32
<b>4. FIGURATIVE THRESHOLD</b> .....	34
4.1. PRELIMINARY REMARKS.....	34
4.2. ASSESSMENT OF THE FIGURATIVE THRESHOLD.....	35
4.2.1. <i>Word elements in a mark</i> .....	35
4.2.2. <i>Word elements and additional figurative element(s) in a mark</i> .....	40
4.2.3. <i>Combinations of stylised words elements and additional figurative elements</i> .....	45
<b>5. DESCRIPTIVENESS FOR NON-TRADITIONAL MARKS (SOUND MARKS, MOTION MARKS, MULTIMEDIA MARKS AND HOLOGRAM MARKS)</b> .....	47
5.1. SOUND MARK.....	47
5.2. MOTION MARK.....	47

## Rationale

---

❖ The public interest is that **no exclusive rights** should be created in purely **descriptive terms** which other traders might wish to use as well.

❖ It is also in the interest of the public that terms which have a **purely informational** value should not be **reserved** for one single trader.

# Descriptiveness

---

A sign must be refused as descriptive if it has a meaning that is immediately perceived by the relevant public as providing information about the goods and services applied for, namely about

- kind,
- quality,
- quantity,
- intended purpose,
- value,
- geographical origin
- or the time of production of the goods or of rendering of the service, or
- other characteristics of the goods or service.

## Descriptiveness

HISTORY for books   
200 for cigarettes 

24/365 for retail services provided in a  
convenience store 

DURABLADE for  
razor blades 

2000 for wines 

Easy Wash  
for machines 

PARIS for  
accommodation  
services 

 PURE SILK  
for ties

S for clothing 

# Descriptiveness

Composite marks	Multiple meanings	JUST POLOS for clothing	✗	
		BIOMILD = BIO MILD	✗	
Misspellings		LINQ for goods including electronic devices		✓
	Abbreviation Acronyms	GREEN FINANCE ALLIANCE GFA for financial services	✗	ORT- organic red tomatoes for soup ✓

# 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



# How do Combination of the Individual Criteria affect Distinctiveness

<p>1.</p> <p> <i>Flavour and aroma</i>               Flavour and Aroma               Flavour and aroma               Flavour and <b>A</b>roma         </p>	<p> <b>F</b>lavour and <b>A</b>roma  <i>Flavour and Aroma</i> </p>
<p>2.</p> <p>             Flavour and aroma (in a box)              Flavour and aroma (in an oval)              Flavour and aroma (in a pink circle)              Flavour and aroma (on a tilted grey rectangle)         </p>	<p>             Flavour and Aroma (in a white trapezoid)              Flavour and Aroma (in a green pentagon)              Flavour and Aroma (in a blue triangle)         </p>
<p>3.</p> <p>             Fresh sardine (with fish icon)              Fresh sardine (with fish icon)              Fresh Sardine (with fish icon in a circle)              FRESH SARDINE (with fish icon)         </p>	<p>             Fresh Sardine (with fish icon)              Fresh sardine (with guitar icon)              FRESH SARDINE (with fisherman icon)         </p>

## NEXT STEPS

---

- **Fill in the questionnaire**
- **Analyze questionnaire**
- **Draft Manual**
- **Revise**
- **Final document**



THANK YOU  
GRACIAS  
MERCÍ  
BEDANKT



CARIFORUM



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

[www.caripi-hub.com](http://www.caripi-hub.com)