



Types of Marks And Distinctiveness of Trade Marks in Absolute Grounds

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CARIFORUM



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



AGENDA

1. BACKGROUND
2. SCOPE
3. TYPES OF MARKS DEFINITIONS AND EXAMPLES
4. DISTINCIVENESS IN ABSOLUTE GROUNDS – PRINCIPLES AND EXAMPLES
5. LEGAL REFERENCES
6. NEXT STEPS
7. QUESTIONS/COMMENTS

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BACKGROUND

The information contained in the 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.

12 Countries filled in questionnaires:

- **Antigua and Barbuda**
- **Belize**
- **Barbados**
- **Cuba**
- **Haiti**
- **Dominican Republic**
- **Guyana**
- **Suriname**
- **Saint Lucia**
- **St Kittis and Nevis**
- **Trinidad and Tobago**
- **Jamaica**

TYPES OF MARKS BY OFFICE

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

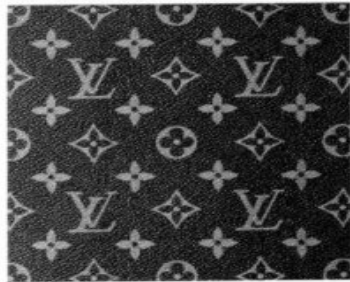
TYPES OF MARKS BY OFFICE

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

Footnote: The sections related to the types of marks not accepted by an Office will not be applicable to that country.

PATTERN MARKS

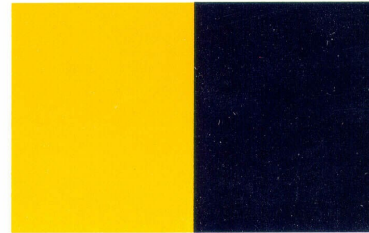
Pattern mark is consisting of a set of verbal and/or figurative elements which are repeated regularly and represented in black and white or in colour



Pattern marks are not protected in BB, CU, SR. In CU pattern mark could be registered as mixed, figurative of three-dimensional signs.

COLOUR MARKS

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



Colour marks are not protected in CU, and LC

SHAPE MARKS

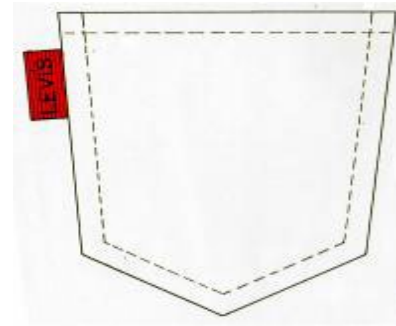
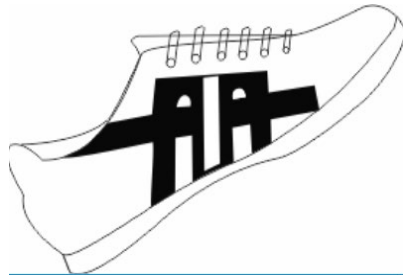
Shape marks are defined as trade marks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance.



Shape marks are not protected in BB

POSITION MARKS

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



Positions marks are not protected in BB, CU, LC. In Cuba position mark could be registered as mixed, figurative or three-dimensional signs. In SR position marks are registered as figurative or mixed marks.

SOUND MARK

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

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

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

Macbook startup sound - [Link](#)



Jingle-like sound sequences

Sound marks are not protected in AG, BB, BZ, HT, LC, KN, SR.

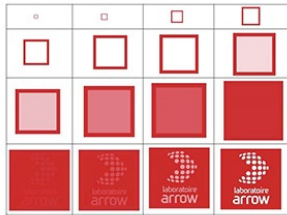
In CU legislation provides registration of sound marks. However, as secondary legislation is missing, examination procedures of sound marks are still not in place and the IP office is not ready to register sound marks.

In JM sound marks should be represented graphically.

In TT, graphic representation is also required when filing an mp3 file.

MOTION MARKS

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



a series of still sequential images [a video file showing the movement or change of position](#)

Motion marks are not protected in AG, BB, BZ, CU, GY, HT, LC, KN, SR. In TT graphic representation is required

MULTIMEDIA MARKS

Multimedia mark consists of the combination of images and sounds.



[Link](#)



[Link](#)

Multimedia marks are not protected in AG, BB, BZ, CU, GY, HT, LC, KN, SR

HOLOGRAM MARKS

Hologram marks consist of elements with holographic characteristics.



[Link](#)

Multimedia marks are not protected in AG, BB, BZ, CU, GY, HT, LC, KN, SR

SMELL/OLFACTORY MARKS

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

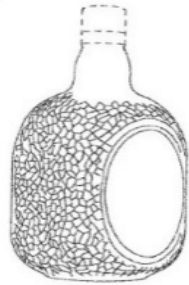
Examples of a smell mark:

- Tennis ball with fresh grass smell.
- Coconut smell for shoes store.
- Cherry smell for toothbrushes.

Smell marks are not protected in AG, BB, BZ, GY, HT, LC, KN. In CU legislation provides for registration of smell marks, however as secondary legislation is missing examination procedures of smell marks are still not in place and IP office is not ready to register sound marks

TACTILE MARKS

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



Crackle glass texture



Tactile marks are not protected in AG, BB, BZ, CU, GY, HT, LC, KN, SR

DISTINCTIVENESS

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

Distinctiveness should be assessed:

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

DISTINCTIVENESS - WORD ELEMENTS

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

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

In HT FLEX will be considered distinctive. SR and BB do not agree with the principle

DISTINCTIVENESS - WORD ELEMENTS

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

For example:

- **tv.org;**
- **music.int**
- **Food LLC**

DISTINCTIVENESS - SINGLE LETTERS

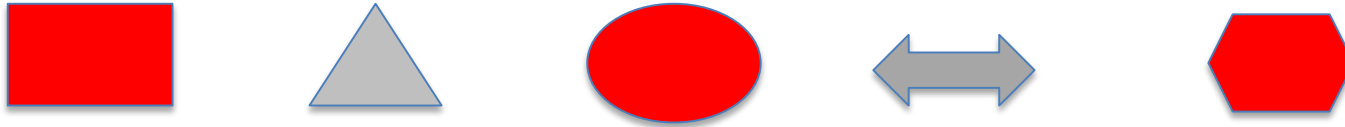
Not always can single letter function as a trade mark, as it can be devoid of distinctive character for the goods and/or services concerned.

- A trade mark consisting of the single letter '**S**' for 'cars', will not be distinctive as this letter is commonly used to designate sport cars.
- The letter **W** will be distinctive in respect of transport; packaging and storage of goods; travel arrangement in Class 39 and services for providing food and drink; temporary accommodation in Class 43

Single letters are not considered distinctive in CU, DO, KN and SR.

DISTINCTIVENESS - SIMPLE SHAPES & SIMPLE FIGURES

Simple geometric shapes and figures are not distinctive



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



In HT, SR and DO these shapes will be considered as trade marks

DISTINCTIVENESS - SLOGANS

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

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

In HT and KN these slogans will be considered distinctive and in DO first two slogans will be considered distinctive

DISTINCTIVENESS - SLOGANS

Advertising slogan might be distinctive because it:

- constitutes a play on words, and/or
- introduces elements of conceptual intrigue or surprise, so that it may be perceived
- as imaginative, surprising or unexpected, and/or
- has some particular originality or resonance, and/or
- triggers in the minds of the relevant public a cognitive process or requires an
- interpretative effort
- unusual syntactic structures
- the use of linguistic and stylistic devices, such as alliteration, metaphors, rhyme
- paradox

DISTINCTIVENESS - SLOGANS

Distinctive slogans:

- WET DUST CAN'T FLY for Class 3,7 and 37
- LOVE TO LOUNGE for Class 25

In HT these slogans will not be considered distinctive

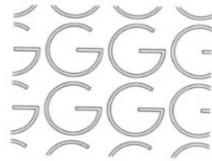
DISTINCTIVENESS – COMMON/DISTINCTIVE LABELS

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



DISTINCTIVENESS – PATTERN MARKS

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



DISTINCTIVENESS – COLOUR MARKS

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

Colour combinations should be refused in the following situations:

- Decorative element of the goods
- A colour can be the nature of the goods
- A colour can be technically functional
- A colour may indicate a particular characteristic of the goods, such as a flavour
- A colour combination should also be refused if the existence of the colour combination can already be found on the market, in particular if used by different competitors

DISTINCTIVENESS – SHAPE MARKS

The following criteria are relevant when examining the distinctiveness of shape trade marks consisting exclusively of the shape of the goods themselves.

- A shape is non-distinctive if it is a basic shape or a combination of basic shapes
- To be distinctive, the shape must depart significantly from the shape that is expected by the consumer, and it must depart significantly from the norm or customs of the sector.
- It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs
- Functional shapes or features of a shape mark will be perceived by the consumer as such.

SHAPE MARKS – VERBAL AND FIGURATIVE ELEMENTS (Size/Proportion)



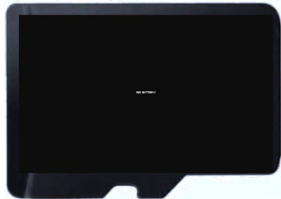
Class 9 Secure digital memory cards

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



Class 3 Cosmetics

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



Class 9 Secure digital memory cards

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.

SHAPE MARKS – VERBAL AND FIGURATIVE ELEMENTS

(Size/Proportion)



Class 12 Trucks

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

This example is not considered as distinctive mark in HT

SHAPE MARKS – VERBAL AND FIGURATIVE ELEMENTS (Colour Contrast)



Class 33 Wine

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

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



Class 32 Bottled drinking water

This example is not considered as distinctive mark in AG, HT



Class 28 Playing balls

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

SHAPE MARKS – VERBAL AND FIGURATIVE ELEMENTS (Position)



Class 32 Bottled drinking water

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.

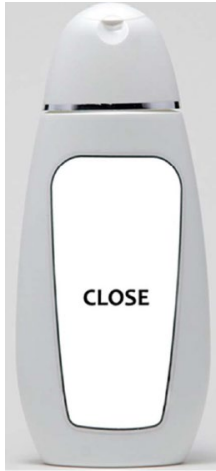
The label containing the descriptive verbal element, placed in a typical position for this type of packaging of goods, does not render the sign distinctive as a whole.



Class 33 Wine

SHAPE MARKS – VERBAL AND FIGURATIVE ELEMENTS

(Position)



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.



Class 3 Cosmetics

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.

SHAPE MARKS - COLOURS

In principle, 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 inherently distinctive.



Class 9 Memory card

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

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



Class 16 Pencils

SHAPE MARKS - COLOURS

However, 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.

In this example, this particular colour arrangement applied to a tube motor for garage doors creates an easy to remember overall impression. In this specific market the goods are almost exclusively sought by professional consumers who have got used to identifying the commercial origin of these goods by colours.

The goods are regularly not visible during use, therefore, the colour combination is not perceived as decorative. As a result, the sign as a whole is distinctive.



This example is not considered as distinctive mark in HT

Class 7 Electric door opener

SHAPE MARKS - COLOURS



Class 7 Wind turbine

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



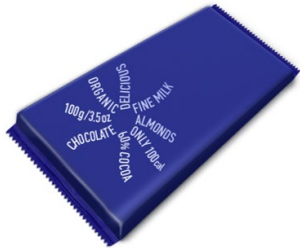
Class 20 Chairs

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

SHAPE MARKS – COMBINATION OF FACTORS/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.

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.



Class 30 Chocolate

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.



Class 25 Shoes / Class 16 Packaging

DISTINCTIVENESS – POSITION MARK

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.



Class 25

The trade 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.

DISTINCTIVENESS – SOUND MARKS

The sound is distinctive if the average consumer will perceive the sound as a memorable one that serves to indicate that the goods or services are exclusively associated with one undertaking.

Non-distinctive:

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

In CU legislation provides registration of sound marks. However, as secondary legislation is missing, examination procedures of sound marks are still not in place and the IP office is not ready to register sound marks.

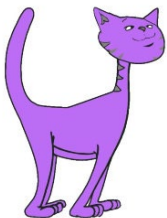
In JM sound marks should be represented graphically.

In TT, graphic representation is also required when filing an mp3 file.

DISTINCTIVENESS – MOTION MARKS

For motions 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.



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.

[Link](#)

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

[Link](#)

PREMIUM

DISTINCTIVENESS – MULTIMEDIA MARKS

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.



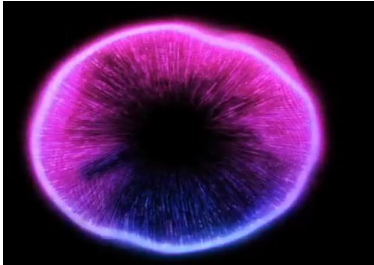
GERIVAN

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

[Link](#)

DISTINCTIVENESS – MULTIMEDIA MARKS

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



[Link](#)

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

DISTINCTIVENESS – HOLOGRAM MARK

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



[Link](#)

LEGAL REFERENCES

Country	TM Law	Article(s) related to distinctiveness
Antigua and Barbuda	The Trade Marks Act	2, 3(1)
Belize	Trade Marks Acts	35 (a) (b)
Barbados		9 (a)(c)(d)
Cuba		
Haiti	Trade Marks Law	2
Dominican Republic	Industrial Property Law of the Dominical Republic	73 (1)(f)
Guyana	Trade Marks Act	11 (1) (e)
Suriname		
St Lucia	Trade Marks Act	25
St Kitts and Nevis	Marks, Collective Marks And Trade Names Act	4 (a)
Trinidad and Tobago	The Trade Marks Act No. 8 of 2015	8 (1) (b) (2)
Jamaica	The Trade Marks Act	11 (1) (b)

NEXT STEPS

- **Finalise** the *Manual on Types of Marks And Distinctiveness of Trade Marks in Absolute Grounds* with your input today
- **Distribute** among IPOs for final confirmation/comments – 31/01/2023. Offices can send **comments** until the 25/02/2023
- **Final document** to be provided to the CarIPI team for final publication steps (ex. Translation requirements)

QUESTIONS/COMMENTS



THANK YOU FOR ALL YOUR SUPPORT TO THIS ACTIVITY



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)

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