

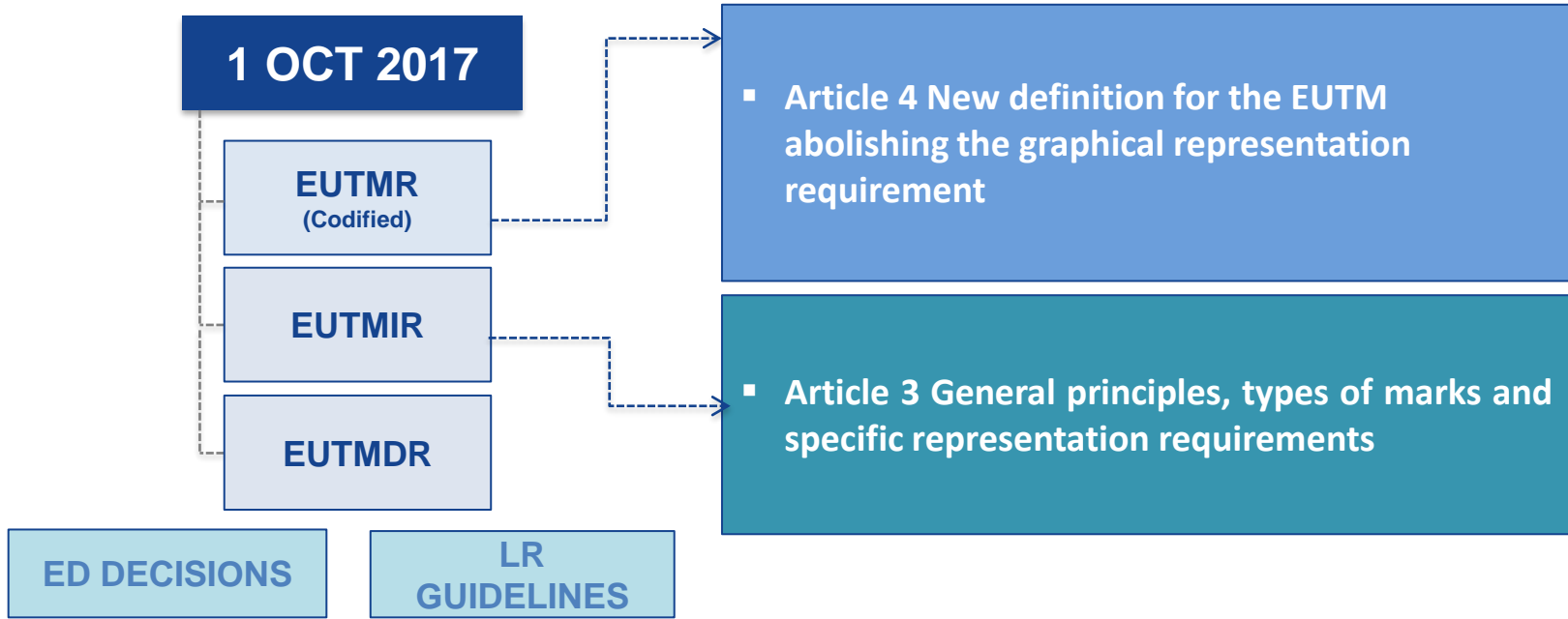
# Trade Mark Examination and Evolving Trends

## EU perspective

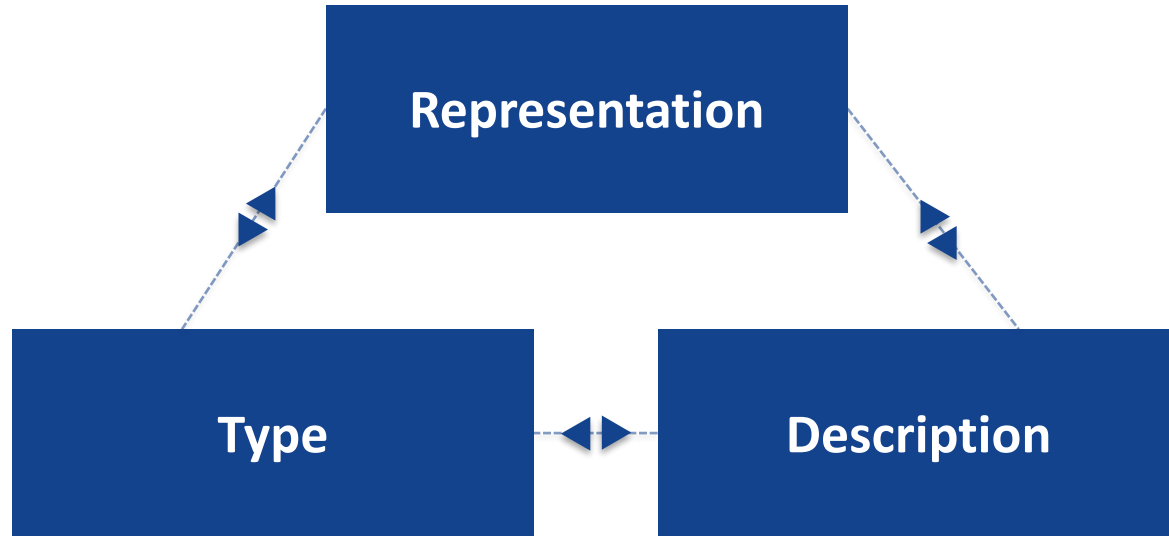
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Marianna Kondas  
06/06/2023

## LEGAL FRAMEWORK



## ART. 3 EUTMIR: REPRESENTATION PRINCIPLES



## Article 4 EUTMR

### Signs of which an EU trade mark may consist

An EU trade mark may consist of any sign, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- a) Distinguishing the g&s of one undertaking from those of other undertakings;
- b) Being represented on the Register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

## Article 3(1) of Regulation (EU) 2018/626 (EUTMIR)

### Representation of the trade mark

The TM shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor

## Art. 3 (3) IA: SPECIFIC TM TYPES

### 5 existing TM types redefined

 <p><b>WORD</b></p>	 <p><i>Figurative</i></p>	 <p>Two perfume bottles with unique shapes.</p>	 <p>A solid green rectangle above a solid black rectangle.</p>	 <p>A musical staff with notes.</p>
<b>Word</b>	<b>Figurative</b>	<b>Shape</b>	<b>Colour</b>	<b>Sound</b>

### 5 new TM types added

 <p>A shoe outline with a specific part highlighted by a dashed line.</p>	 <p>A grid pattern of vertical and horizontal lines.</p>	 <p>A blurred image of a city street at night with light trails.</p>	 <p>A 3D visualization of data or a network.</p>	 <p>A glowing, multi-colored bird-like shape.</p>
<b>Position</b>	<b>Pattern</b>	<b>Motion</b>	<b>Multimedia</b>	<b>Hologram</b>

## Art. 3 (3) IA: SPECIFIC TM TYPES

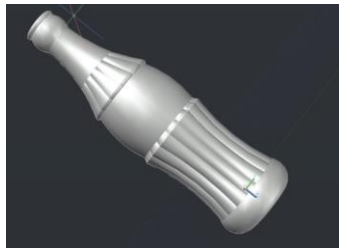
**Figurative**

火瀑

No description

No colour claim: what you see in what you get

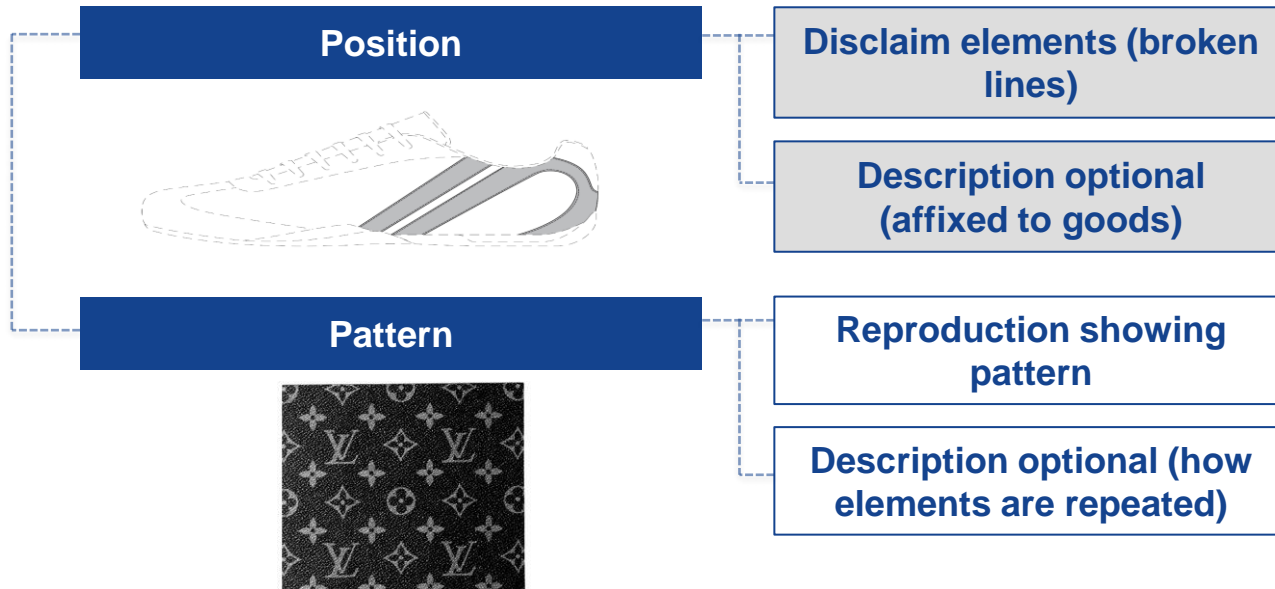
**Shape**



Definition expanded,  
includes appearance

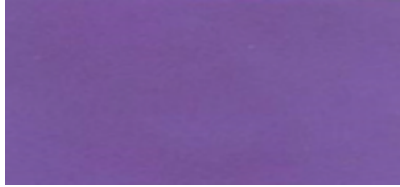
No description

New formats:  
3D modelling CAD





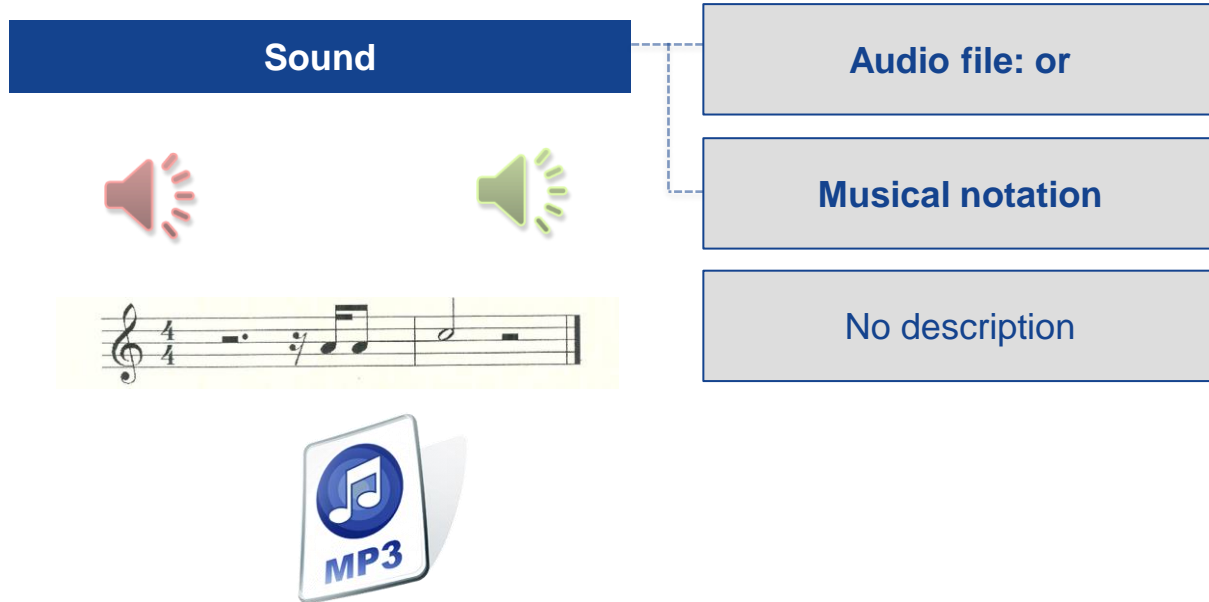
## Colour marks

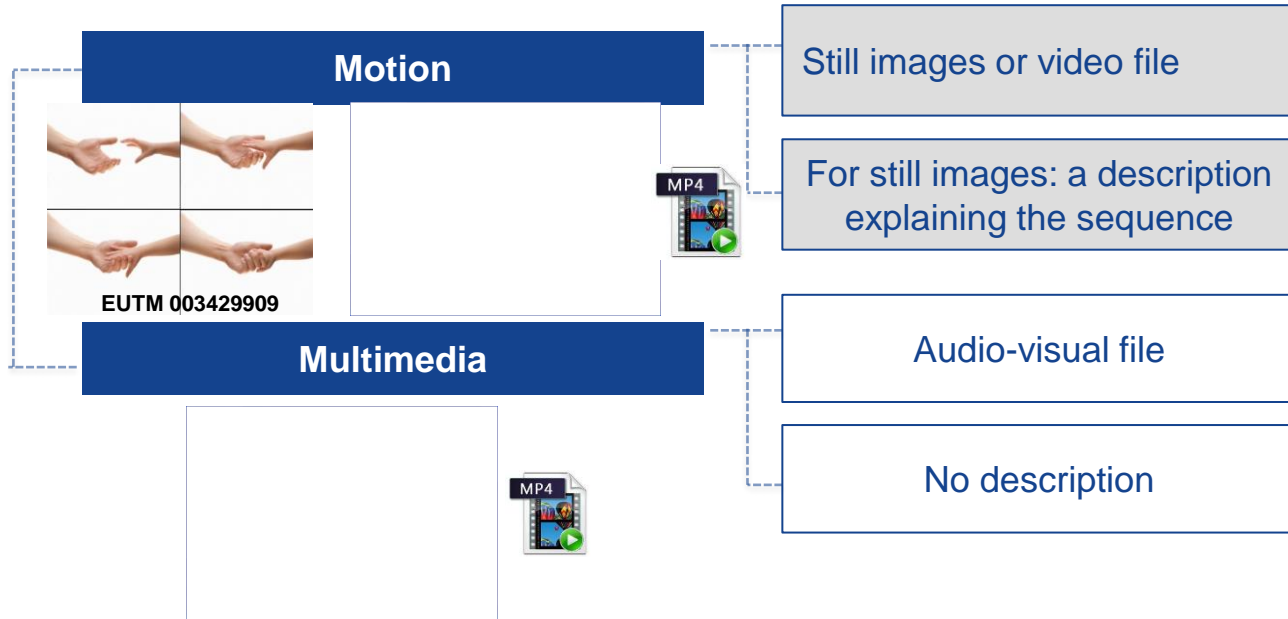


The indication of recognised colour codes remains compulsory

Colour Combinations:  
The reproduction must show the systematic arrangement of the colours

A description may be filed detailing the systematic arrangement further





## Hologram



Video file, graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety

**No description**

**'Other' marks**



Smell?

Taste?

Tactile / Texture?

**Samples not acceptable**



## TYPES OF TRADE MARKS

Type of trade mark	Description required?	Format required
Word	No	N/A
Figurative	No	JPEG
Shape	No	JPEG OBJ STL X3D
Position	Optional (previously mandatory)	JPEG
Pattern	Optional	JPEG
Colour ( <i>single</i> )	No	JPEG
Colour ( <i>combination</i> )	Optional ( <i>previously mandatory</i> )	JPEG
Sound	No	JPEG MP3 ( <i>max 2 Mb</i> )
Motion	Optional ( <i>previously mandatory</i> )	JPEG MP4 ( <i>max 20 Mb</i> )
Multimedia	No	MP4 ( <i>max 20 Mb</i> )
Hologram	No	JPEG MP4 ( <i>max 20 Mb</i> )

## CP11 - NEW TYPES OF TRADE MARKS

Common Practice that aims to provide guidance with regards to  
the examination of **formal requirements** and  
**grounds for refusal and/or invalidity** of new types of trade marks,  
namely, sound, motion, multimedia and hologram marks,  
**and the new ways of representing them**

## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### SOUND MARKS

#### WHAT CAN BE REGISTERED AS SOUND MARK?

Any sign containing one or more sounds, regardless of the kind of sound contained therein.

(e.g. verbal elements perceived in the sound, a sound in nature, sound of animals, a melody, etc.)



#### HOW CAN A MUSICAL NOTATION BE 'ACCURATE REPRESENTED'?

- **Necessary elements:** a staff divided into measures (bars) and showing, in particular, a clef and all the musical notes that are necessary to reproduce the melody.  
*C-283/01, Musical notation-Shield Mark, par. 62*
- **Optional elements:** The speed of the melody and the instrument(s).



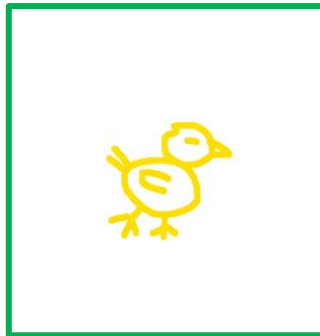
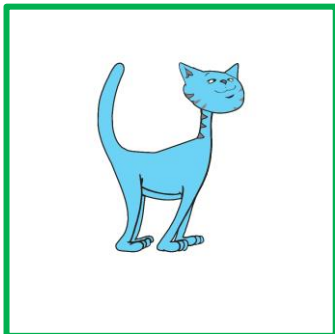


## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### MOTION MARKS

#### WHAT CAN BE REGISTERED AS MOTION MARK?

Any sign depicting movement, a change in the position of the elements, a change of colour and/or a change of elements.



#### THE ROLE OF THE DESCRIPTION ADDED TO A MOTION MARK GRAPHICALLY REPRESENTED

- Description is not mandatory.
- **Elements:** movement or change of position, the duration, repetitions and the speed of the motion/movement.
- If not added



## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### MULTIMEDIA MARKS

#### WHAT CAN BE REGISTERED AS A MULTIMEDIA MARK?

Any sign consisting of a combination of visual and audio elements.



The presence of a black or white screen in the file combined with a sound does not preclude the mark from being classified as a multimedia mark, and neither does the partial absence of sound combined with an image.

## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### HOLOGRAM MARKS

#### WHAT CAN BE A HOLOGRAM MARK?

Any sign consisting of elements with holographic characteristics

#### WHAT IS A HOLOGRAM?

An image that changes its appearance when looked at from different angles



#### GRAPHICAL REPRESENTATION OF HOLOGRAM MARKS

The images must display all the views that are necessary to sufficiently identify the holographic effect in its entirety: height, width, depth and/or morphing effects of the 3D image.

## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### GENERAL ASPECTS



#### **DESCRIPTION**

*ONLY serves to clarify the subject matter and the scope of protection of the mark, and MUST NOT extend its scope.*



#### **INDICATION OF VERBAL ELEMENT**

*Any field in the application for requiring the indication of verbal elements will serve only for search purposes and will NEVER extend the scope of protection of the TM as defined in its representation.*



#### **PREVALENCE OF REPRESENTATION**

*Representation will always prevail when there is a discrepancy between the representation and the type of mark and/or the description.*



#### **VALID MEANS FOR REPRESENTATION**

*Trade mark accepted according to the type selected by the applicant provided that it complies with the requirements for the specific type.*


## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### EXAMINATION OF PRIORITY CLAIMS

The same principles that apply to traditional trade marks with regard to the examination of priority claims also apply to new types of trade mark, with some particularities.

*A sign will be considered identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.*

C-291/00, Arthur et  
Félicie, par. 54.

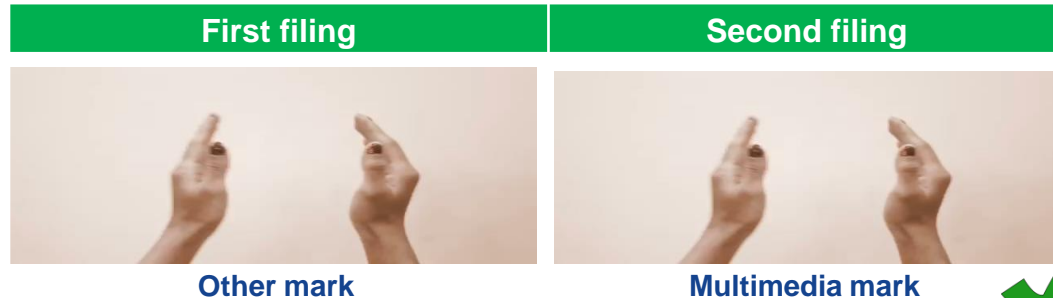


***An insignificant difference between two marks*** is a difference that a reasonably observant consumer will perceive only upon side-by-side examination of the marks.

## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### EXAMINATION OF PRIORITY CLAIMS – IDENTICAL SUBJECT MATTER

Priority claim will be accepted if the subject matter and the trade mark are the same, regardless of the format. Additionally, it may be accepted when the second filing is of a different type of trade mark but has identical subject matter.



## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### EXAMINATION OF PRIORITY CLAIMS – DIFFERENT SUBJECT MATTER

Priority claim will be rejected when it involves two trade marks with different subject matter, regardless of their format or the type of trade mark selected.

**First filing**



**Sound mark**

**Second filing**









**Sound mark**



## PART A – EXAMINATION OF FORMAL REQUIREMENTS

### EXAMINATION OF PRIORITY CLAIMS - SAME TYPE OF TRADE MARKS REPRESENTED DIFFERENTLY

A priority claim in which two **motion marks** represented in different formats, will only be accepted if all the elements of the video file and their complete movement are clearly identifiable in the sequence of still images.

First filing	Second filing	First filing	Second filing
			
	<p><b>Description:</b> this motion consists of the content of the still images appearing at intervals of half a second.</p> 		



If the second filing is represented in a sequence of still images, a description can be required to ensure that the subject matter is identical (e.g. duration, speed, repetitions).



# Principles – Part B: Examination of absolute grounds for refusal and/or invalidity

## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### THE ASSESSMENT OF CLARITY AND PRECISION OF NEW TYPES OF TRADE MARK

#### WHEN WILL A NEW TYPE OF MARK BE CONSIDERED CLEAR AND PRECISE?

- If it is represented in any appropriate form using generally available technologies,
- If it is capable of being represented in a self-contained, easily accessible, intelligible, durable and objective manner, irrespective of whether it has a concept.



**Multimedia mark**

## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### THE REQUIRED DEGREE OF DISTINCTIVENESS OF NEW TYPES OF TRADE MARK

#### WHEN WILL A NEW TYPE OF MARK BE CONSIDERED DISTINCTIVE?

- The general criteria for assessing distinctiveness of traditional types of trade mark must also apply when assessing the required degree of distinctiveness of new types of trade mark.



**CONSUMER  
PERCEPTION**



**INHERENTLY  
DISTINCTIVE MARKS**



**NON- DISTINCTIVE  
MARKS**

## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### INHERENTLY DISTINCTIVE SOUND MARKS

#### WHEN WILL A SOUND MARK BE CONSIDERED INHERENTLY DISTINCTIVE?

- Verbal element which is distinctive itself
- One note, a combination of notes or a melody;
- An element of speech which cannot be understood or is non identifiable as a word;
- A sound disassociated from the goods and/or services applied for.

As long as they are capable of being perceived by the consumer as an indications of commercial origin.



**Class 41: Providing films for entertainment purposes**



**Class 11: Toilets**

## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### NON-DISTINCTIVE SOUND MARKS

#### WHEN WILL SOUND MARKS BE CONSIDERED NON-DISTINCTIVE?

- Sounds produced by or connected to the goods and/or services, or to other relevant features thereof;
- Notes, combination of notes, tunes or melodies that lack resonance;
- Non-distinctive/descriptive/generic verbal elements;
- When the above elements are accompanied by other elements of sound, which are also non-distinctive.

A particular arrangement of different elements of sounds, **which is unusual and can be easily recognised as an indication of commercial origin by the consumer**, could be sufficient to render a sound mark distinctive as a whole.



Class 33: Wine



Class 3: Washing powder



Class 31: Fresh bananas

## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### INHERENTLY DISTINCTIVE MOTION MARKS

#### WHEN WILL A MOTION MARK BE CONSIDERED INHERENTLY DISTINCTIVE?

- Distinctive verbal and/or figurative element(s) moving or changing its position, colour and/or elements;
- If it shows an element which cannot be understood or is non-identifiable, in 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



**Class 3:  
Washing  
powder**



## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### NON-DISTINCTIVE MOTION MARKS

#### WHEN WILL MOTION MARKS BE CONSIDERED NON-DISTINCTIVE?

- Movement produced by or connected to the goods/and services, or to other relevant features thereof;
- Non-distinctive/descriptive/generic verbal and/or figurative element moving or changing its position, colour and/or elements;
- If the sign does not create a lasting impression on the consumer.



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.



Class 7: Chainsaws



Class 3: Washing powder

## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### NON-DISTINCTIVE MULTIMEDIA MARKS

#### WHEN WILL MULTIMEDIA MARKS BE CONSIDERED NON-DISTINCTIVE?

- Combination of non-distinctive/descriptive/generic image(s) and motion(s)
- If they do not create a lasting impression on the consumer.

It could be possible that a **combination of a non-distinctive/ descriptive /generic image(s) and sound(s)** 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.



CP3

Class 9: Computer hardware



Class 31: Foodstuffs for animals

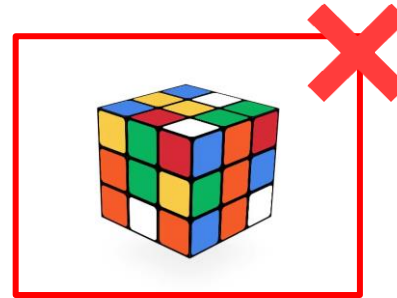


## PART B – EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY

**SIGNS THAT CONSIST EXCLUSIVELY OF SOUND, MOVEMENT AND A COMBINATION OF IMAGE AND SOUND, WHICH RESULTS FROM THE NATURE OF THE GOODS, CAN BE NECESSARY TO OBTAIN A TECHNICAL RESULT, OR CAN GIVE SUBSTANTIAL VALUE TO THE GOODS**



**Class 9: Audio-sensitive controls for lighting apparatus**



**Class 28: Three-dimensional puzzles**

# Principles – Part C: Examination of relative grounds for refusal and/or invalidity

## PART C – EXAMINATION OF OF RELATIVE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### COMPARISON OF SOUND MARKS



#### VISUAL COMPARISON

**Not possible**

even if the sound mark is represented by a musical notation



#### AURAL COMPARISON

##### Verbal elements

Coincidence in/similarity between distinctive verbal elements, if identified as such by a significant part of the relevant public, will, in principle, lead to a finding of aural similarity.

Earlier sound mark

Contested sound mark

Earlier fig. mark

Contested sound mark



**GERIVAN**

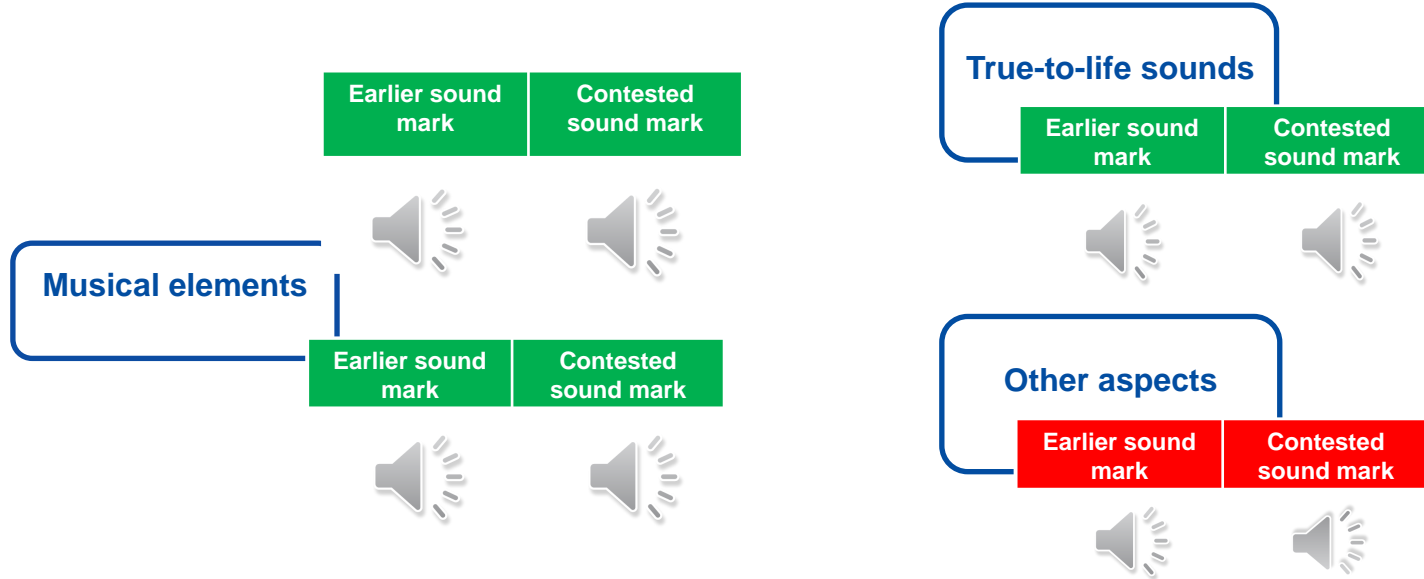


## PART C – EXAMINATION OF OF RELATIVE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### COMPARISON OF SOUND MARKS



#### AURAL COMPARISON



## PART C – EXAMINATION OF OF RELATIVE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### COMPARISON OF SOUND MARKS



#### CONCEPTUAL COMPARISON

- A sound mark can be conceptually compared when a concept can be identified.

Earlier sound mark



Contested figurative  
mark



## PART C – EXAMINATION OF OF RELATIVE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### COMPARISON OF MOTION MARKS - CATEGORIES OF ELEMENTS

# GERIVAN

Verbal  
elements



Figurative  
elements



Movement or transformation  
of verbal and/or figurative  
elements

## PART C – EXAMINATION OF OF RELATIVE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### COMPARISON OF MULTIMEDIA MARKS – CATEGORIES OF ELEMENTS



#### Visual elements

(graphically depicted verbal elements, figurative elements and movement or transformation of those elements)



#### Sound elements

(sung or spoken verbal elements, musical elements, true-to-life sounds and other sounds)



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Thank you



## PART C – EXAMINATION OF OF RELATIVE GROUNDS FOR REFUSAL AND/OR INVALIDITY

### COMPARISON OF MULTIMEDIA MARKS



#### CONCEPTUAL COMPARISON

Multimedia marks can be compared conceptually as long as a concept is conveyed.

Attention should be given to the **interaction** of the sound and visual elements as this might influence the global impression and/or meaning of the mark.

Earlier word mark

Contested multimedia mark

**ALARM**





## INTERNATIONAL PERSPECTIVE TM5 2022 data

Word mark	N/A	N/A	96,070	5,426,897	402,990	standard characters only
Figurative	N/A	N/A	77,356	452,431	142,236	includes stylized wording, words + design, and design-only. Includes non-traditional marks with visible elements
3D	331	99	378	3,427	633	configuration of listed products or packagings. Excludes 3-D traditional marks (e.g., the overall appearance of a hangtag or 3-D exterior signage for services)
Colour	7	23	38	5,938	102	
Sound	19	35	34	68	52	includes sounds with verbal and non-verbal elements
Position	30	0	110	N/A	0	No applications filed in 2022 claiming positioning as the sole distinctive element
Hologram	1	0	0	N/A	2	
Motion	18	103	45	N/A	36	
Pattern	N/A	N/A	41	N/A	35	repeating pattern applied to surface of goods or packaging
Olfactory	N/A	0	0	N/A	0	No applications filed in 2022 claiming scent as a distinctive element
Other (please specify in comments)	N/A	N/A	80	N/A	69	exterior and interior trade dress for services (50); uniforms and costumes for services (10) ; texture/touch (0); 3-dimensional point-of-sale displays (9)

## INTERNATIONAL PERSPECTIVE TM5 2021 data

Word mark	N/A	N/A	96,070	5,426,897	402,990	standard characters only
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### Search of 06/06/2023

- 3D Marks: 11811
- Colour: 1201
- Hologram: 13
- Motion: 207
- Multimedia: 87
- Pattern: 184
- Position: 415
- Sound: 474