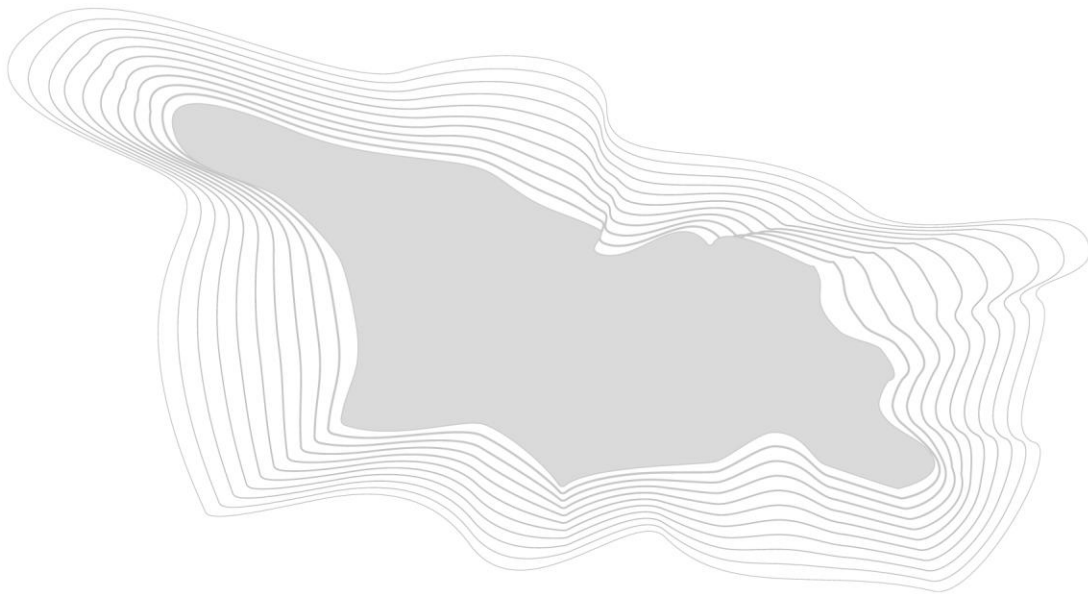




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Draft Trademark Examination Guidelines of the National Intellectual Property Center Sakpatenti



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Part A General rules

1. Introduction

1.1 Purpose of the Guidelines

This is a first attempt to create a document which would reflect National Intellectual Property Center Sakpatenti's (Sakpatenti) current trademark practice that is intended to be of practical use both to Sakpatenti staff in charge of the various procedures and to users of its services. This ambitious project became possible with support of European Union and EUIPO.

The present Guidelines hopefully will become the main point of reference for users of the Georgian trademark system and for professional advisers who want to ensure they have the latest information on Sakpatenti's examination practices.

The Guidelines explain how, in practice, the provisions of Trademark Law (Law), General Administrative Code (Code), Instruction on Trademark Registration (Instruction) being approved by order of Chairman of Sakpatenti No.05 of 19.08.2014, Resolution of Government of Georgia No.182 of 03.07.2010 on Approval of Fees Connected with Patenting, Registration and Deposition of Objects of IP (Fees Resolution), Statute of Chamber of Appeals (Statute) being approved by order of Chairman of Sakpatenti No.02 of 18.03.2011 are applied by the Sakpatenti's examination and Chamber of Appeals from receipt of both national and international application for a trademark up to its publication and registration, including consideration of appeal/opposition in case of their filing.

Guidelines have been drawn up to reflect Sakpatenti's practice in the most frequent scenarios and contain general instructions, which have to be adapted to the particularities of a case.

Therefore, the present Guidelines are not legal acts, but self-imposed rules of conduct adopted by an administrative decision. Sakpatenti is responsible for the registration of national trademarks and conducting examination regarding international registrations. These registrations provide uniform trademark protection throughout the territory of Georgia and are legally valid also on occupied territories of Autonomous Republic of Abkhazia and Tskhinvali region (the territories of the former South Ossetian Autonomous Region).

Sakpatenti deals with registration procedures (covering both the examination of applications for relative and absolute grounds for refusal) accordingly, maintains the public register of national trademark rights.

The main object of the Guidelines is to improve the coherence, predictability and quality of Sakpatenti's decisions. The Guidelines are designed to bring together, systematically, the principles of practice derived from the jurisprudence of the European Union Court of Justice, Georgian Common Courts, the practice of the Sakpatenti's Board of Appeals and decisions of the examination.

This part of the Guidelines includes those provisions regarding proceedings before the Sakpatenti except appeals and oppositions.

In the interests of efficiency and in order to prevent parties encountering different practices, Sakpatenti applies procedural rules consistently.

Proceedings before Sakpatenti can be classified into two broad types: *ex parte* proceedings, which involve only one party, or *inter partes* proceedings, in which two or more parties are in conflict.

The first category comprises, in particular, applications for registration or renewal of a national trademark or, transfer-related entries in the Register, registration of changes, licenses, pledges, seizures.

The second category includes appeal / opposition proceedings before the Chamber of Appeals of Sakpatenti regarding decisions of examination.

Guidelines include citations of the General Court and Court of Justice of the European Union as well as EUIPO Board of Appeals. Even though, some cited cases might not be directly applicable to Georgian reality, reasoning provided in the cases are relevant for the practice of Sakpatenti and they will be applied *mutatis mutandis*.

1.2 General principles

Duty to state reasons

The decisions of Sakpatenti must be in writing and state the reasons on which they are based. The reasoning must be logical and it must not lead to internal inconsistencies.

The reason for this is twofold: to explain to interested parties why the measure was taken so that they can protect their rights and to enable the courts to exercise their power to review the legality of the decision. Decisions should contain reference to the legal provisions that serve as a ground for decision and reasoning on how those provisions apply to the subject case.

However, if Sakpatenti does not respond to all the arguments raised by the parties, this does not necessarily infringe the duty to state reasons. It is sufficient that Sakpatenti sets out the facts and legal considerations of fundamental importance in the context of the decision.

Sakpatenti can use facts that are a matter of common knowledge as a basis for its reasoning. Well-known facts are those that are very likely to be known by anyone or may be learned from generally accessible sources or those that are very likely to be known by anyone with general practical experience of marketing consumer goods and in particular by the consumers of those goods.

Sakpatenti is not required to prove the accuracy of these well-known facts and, therefore, it is not obliged to give examples of such practical experience. It is up to the party concerned to submit evidence to refute it.

Right to be heard

The decisions of the Sakpatenti shall be based only on reasons or evidence on which the applicant has had an opportunity to present its comments.

The applicant's right to be heard is one of the fundamental principles of the Code (Articles 13 and 98 of the Code), according to which the applicant and other interested party must be given the opportunity to make their point of view known. In accordance with that principle, Sakpatenti may base its decision only on matters of fact or of law on which the applicant or other interested party has been able to set out his views. Consequently, where Sakpatenti gathers facts and documents to serve as a basis for its decision, it is obliged to grant access to parties of administrative proceedings to these materials.

The right to be heard covers all the matters of fact or law and evidence that form the basis for the decision of formal examination (including determination of priority). As for realisation of the "right to be heard" in regards decision of examination, applicant and third parties may exercise this right either at Chamber of Appeals or before the court by appealing decision of examination.

Sakpatenti will take legal issues into account, irrespective of whether or not they have been pleaded by the parties. As for examination and appeal proceedings, Sakpatenti and Chamber of Appeals will examine the facts on its own motion.

While Sakpatenti must rule on each head of claim, it is not required to give express reasons for its assessment in respect of each and every piece of evidence submitted or arguments put forward, where it considers that evidence or arguments to be unimportant or irrelevant to the outcome of the case.

Changing circumstances arising in the course of the examination proceedings will also be taken into account and the parties will be informed accordingly.

Compliance with time limits

Applicants must act and respond to Sakpatenti's communications within the time limits set by the Law and Instruction.

Scope of the examination carried out by Sakpatenti

When examining an application for a trademark, Sakpatenti will examine the facts of its own motion.

The examination procedure is divided into formal and substantive examination stages. Accordingly, Sakpatenti *ex officio* examines whether application meets formal requirements as well as grounds for refusal.

Trademark that has been granted favourable decision to register may be opposed at Chamber of Appeals if decision has been issued in breach of requirements referred to in Articles 4 and 5 of the Law.

If trademark has been registered in breach of the requirements referred to in Article 28 of the Law, it is liable to be challenged and invalidated if an interested party files an action before the court.

User-friendliness

One of the fundamental objectives of the Law and Instruction is that the registration of a trademark should present the minimum cost and difficulty to applicants, so as to make it readily available to any applicant, including small and medium-sized enterprises and individuals.

To that end, examiners are encouraged to contact the applicant or its representative by any means of communication including telephone to clarify issues arising from the examination of an application for a trademark, either before or after an official deficiency letter is sent.

Section 1 Means of communication

1. Procedures for Filing and for Communication with the Sakpatenti

Communications addressed to Sakpatenti can be submitted by electronic means, post and by personal delivery. Notifications issued by Sakpatenti can be made by electronic means or post.

Filing

An application for national trademark must be filed directly with Sakpatenti.

E-filing is a recommended means of filing, to the extent that the system gives guidance to the applicant, thus reducing the number of potential deficiencies. Application filed through Sakpatenti's e-filing system are subject to a reduced official fee by 20%.

Trademark can be filed electronically via Sakpatenti's website (<https://online.sakpatenti.gov.ge/ka/app/login/>). At the same time, applications can be sent by ordinary post / courier or delivered personally to Sakpatenti at the following address:

National Intellectual Property Center Sakpatenti

31, Nino Ramishvili Street, 0179 Tbilisi, GEORGIA (front office)

5, Antioch Street, 3300 Mtskheta, GEORGIA (head office)

The application must be signed by the applicant(s) or his / her representative. The date of the signature, name of the signatory must be indicated, and the authority of the signatory must be specified.

Other Communication

A document's date of notification or communication is the date on which that document, is received or is deemed to be received by the addressee. Exactly when receipt is deemed to have taken place will depend on the method of notification or communication.

Any notification addressed to the representative will have the same effect as if it had been addressed to the person represented. Any communication addressed to Sakpatenti by a representative will be considered to have originated from the person he or she represents.

If a representative has been duly appointed, Sakpatenti will send all notifications solely to the representative. 'Duly appointed' means that the representative is entitled to act as such and has been properly appointed, and that no general obstacle exists to preclude representation by that person, such as illicit representation of both parties in *inter partes* proceedings.

There are two ways of applying for registration of a trademark, that is, (1) either via direct filing, with Sakpatenti or (2) via an international registration filed with the International Bureau of the World Intellectual Property Organization and designating Georgia.

Applications and other communications to Sakpatenti must be signed by the applicant or his representative.

If the application or other communication is filed by electronic means, the indication of the sender's name is deemed to be equivalent to a signature.

Where a submission or supporting document has to be signed, the signature must be accompanied by the name of the physical person signing and, if the signature is on behalf of a legal person (company), it must also include an indication of the role of the physical person in the company or their authority as signatory (e.g. Director, President). The company's identification number (ID) may also be indicated if available. If any of these identification elements are missing from the signature, Sakpatenti may issue a deficiency requesting the missing element(s). If a submission is not signed at all, Sakpatenti will invite the party concerned to correct the deficiency.

If a deficiency is notified, and is not remedied within the set time limit, the application will be rejected or the communication not taken into account.

For joint requests submitted in one single submission by electronic means in *inter partes* proceedings, the indication of the sender's name is deemed to be equivalent to its signature; however, the other party's signature must be presented in order for the request to be acceptable.

A party may, upon submitting a document or at a later stage, request that all or part of a document be kept confidential, as long as no request for an inspection of files is pending.

The party concerned must have expressly invoked, and sufficiently justified, a special interest in keeping the document confidential. Alternatively, the party may submit evidence in such a way that avoids revealing parts of the document or information that the party considers confidential, as long as the parts of the document submitted contain the required information. For example, where contracts or other documents are submitted as evidence, certain information may be blacked out before being submitted to Sakpatenti, or certain pages may be omitted altogether.

In principle, documents of a personal nature such as passports or other identification documents, which are submitted in particular as evidence in relation to requests for transfer, evidence of 'health data', which is submitted as supporting evidence for extension requests, and bank account extracts, which may, for example, be attached to applications and requests as evidence of fee payment, because of their inherent personal nature, confidentiality vis à vis any third parties is justified, and, in principle, overrides any third- party interest.

In *inter partes* proceedings, one of the parties might request Sakpatenti to keep certain documents confidential even vis-à-vis the other party in the proceedings. Although Sakpatenti can keep documents confidential vis-à-vis third parties (inspection of files), it can under no circumstances keep them confidential vis-à-vis the other party in *inter partes* proceedings.

Written communications from Sakpatenti to the party or parties to proceedings will be 'notified'. A document is considered to be notified when it has been received or is deemed to have been received by the addressee, irrespective of whether the addressee has been advised of this. Consequently, the date of notification of a document is the date on which that document is made accessible to or has reached the addressee, and not the date on which it was sent or the date on which the person to whom it was addressed actually learned of the notification. However, exactly when receipt is deemed to take place will depend on the method of notification.

Any communication or notification from Sakpatenti will indicate the department or division of Sakpatenti and the name(s) of the official(s) responsible. These documents have to be signed by the official(s) or, if not, bear the Office's printed or stamped seal.

Sakpatenti may issue notifications in electronic form by placing in registered user's inbox in Sakpatenti's e-filing system and account holders may not opt-out of this means of receiving electronic communications from Sakpatenti as long as they applied to Sakpatenti through electronic system agreeing by the same receipt of communication from Sakpatenti electronically. Accordingly, the date on which the document is placed in an account holder's inbox will be recorded by Sakpatenti as day of receipt by the applicant irrespective of whether the recipient actually opened and read it.

Notifications by post or courier will be performed with advice of delivery because from such date is calculated term of complying of request/appeal being provided for recipient (applicant).

In the event of a dispute, Sakpatenti must be able to establish that the notification reached its destination or the date on which it was delivered to the addressee. In this regard, Sakpatenti

must establish that it had created the conditions for the document to be notified to arrive within the sphere of influence of the addressee.

[Public notification by public notice]

Public notification will be used for all notifications where the addressee's address is unknown or where a notification by post has been returned to the Office after at least one failed attempt.

This relates primarily to post returned to the Office by the Post Office marked 'not known at this address' and post that has not been claimed by the addressee.

Public notifications will be published on the Office's website. The document will be deemed to have been notified one month after the day on which it was posted on the internet.

2. Time Limits

Time limits are an essential tool for conducting orderly and reasonably swift proceedings. They are a matter of public policy and rigorous compliance with them is necessary to ensure clarity and legal certainty.

Regarding administrative proceedings concerning trademarks, the time limits specified by Sakpatenti may not be less than 10 days.

Where the Office sets a time limit in a notification, the 'relevant event' is the date on which the document is notified or deemed notified, depending on the rules governing the means of notification. A notification issued by electronic means is deemed to have been notified on the day on which the document is placed in the account holder's inbox and a notification issued by post or courier is deemed to have been notified on the day it was received by the addressee.

If 'set time limit expires on a holiday or a Saturday or Sunday it will be considered as expired on the first working day thereafter.

Any time limit will be deemed to expire at midnight on the final day (local time in Tbilisi, Georgia).

3. Means of Taking Evidence

In any proceedings before Sakpatenti, evidence may be taken. Below is the non-exhaustive list of means for taking evidence.

The means of evidence are as follows:

- hearing the parties;
- requests for information;
- the production of documents and items of evidence;
- hearing witnesses;
- opinions by experts;
- sworn or affirmed statements in writing or statements having a similar effect under the law of the State in which they are drawn up;
- inspection.

Some of these means, such as requests for information, statements in writing and, in particular, the submission of documents and items of evidence, will be used more frequently than others.

Sakpatenti will decide which of these means to use but will use them only when necessary for examining the file.

If Sakpatenti refuses a request to take evidence, an appeal can only be made together with the appeal against the final decision.

The procedure followed by Sakpatenti varies depending on the means of taking evidence proposed.

3.1 Written evidence

When taking evidence, Sakpatenti will confine itself to written evidence in most cases. This is the least costly, simplest and most flexible means of taking evidence.

Sakpatenti will therefore give preference to the submission of documents and items of evidence. However, other possible written means of taking evidence include not only a request for information or statements in writing that have been sworn or affirmed or have a similar effect thereto under the law of the State in which they are drawn up, but also opinions by experts, which may consist solely of a written report.

Sakpatenti may issue deficiency regarding submitted evidence (e.g. documents in foreign language are submitted without its Georgian translation, submitted documents are not notarized etc.) by giving reasonable time to the applicant to remedy it. Where the deficiency is not remedied within the period specified by Sakpatenti, that document or item will not be taken into account.

Sakpatenti will base its decision only on reasons on which both sides have had an opportunity to submit observations and will identify those items of evidence not taken into account due to not fulfilling the requirements of the legislation.

3.2 Oral evidence and inspections

This refers to evidence taken in oral proceedings, such as hearing the oral evidence of parties, witnesses or experts, or carrying out inspections.

Where oral proceedings are requested, it is for the requester to explain why the oral testimonies would be more apt to attest the truth of the facts alleged or why it was not able to provide those testimonies in writing or in any other form.

If Sakpatenti invites one of the parties to give evidence orally, it will advise the other parties accordingly so that they can attend.

Similarly, when Sakpatenti summons an expert or a witness to a hearing, it will advise the parties concerned. These may be present and put questions to the person giving evidence.

3.3 Specific means of evidence

Commissioning of experts by Sakpatenti

Opinions by experts will be used only as a last resort because they involve substantial costs and protract the proceedings.

It is up to Sakpatenti to decide whether or not to commission an expert's opinion, who to appoint as expert and what form the opinion should take. However, Sakpatenti does not maintain a list of experts because it uses experts as a means of taking evidence only by way of exception.

The terms of reference of the expert include:

- a precise description of their task
- the deadline for submitting their opinion
- the names of the parties to the proceedings
- details of any costs to be reimbursed by Sakpatenti

The expert opinion must be submitted in Georgian or accompanied by a certified translation into Georgian. A copy of any written opinion, and of the translation if needed, must be submitted to the parties. If Sakpatenti considers the report sufficient, and if the parties accept this form of report, it will in principle be used only in its written form.

The submission of an oral report or the hearing of oral evidence given by the expert will therefore be at Sakpatenti's discretion.

The parties can object to an expert on the grounds of incompetence or a conflict of interest, or because the expert was previously involved in the dispute or is suspected of partiality. No refusal may be based on the appointed expert's nationality. If a party objects to the expert, Sakpatenti will rule on the objection.

Affidavits

Sworn or affirmed statements in writing or statements having a similar effect under the law of the State in which the statement is drawn up are equally admissible as evidence if submitted by a party.

In order for a statement to be considered sworn or affirmed, it must be understood by the parties that making a false statement would be considered a criminal offence under the legislation of Georgia. Where that is not the case, the document will be considered simply as any other written document or statement.

The evidential value of an affidavit is relative (28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 33). In assessing the evidential value of such a document, Sakpatenti will consider first and foremost the credibility of the account it contains. It will then take account, in particular, of the person who produced the document, the circumstances in which it came about, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42 and the case-law cited therein; 18/11/2015, T-813/14, Cases for portable computers, EU:T:2015:868, § 26). Affidavits containing detailed and concrete information and/or that are supported by other evidence have a higher probative value than very general and abstractly drafted statements.

The mere fact that affidavits from third parties are made according to a predetermined draft provided by the interested party (parties) does not in itself affect their reliability and credibility, and does not call into question their probative value since the veracity of their contents is certified by the signatory (16/09/2013, T-200/10, Avery Dennison, EU:T:2013:467, § 73).

Inspections

Only in very exceptional circumstances will the Office carry out an inspection *in situ*. If it does decide to carry out an inspection, it will take an interim decision to that end, stating the means by which it intends to obtain evidence (in the present case, an inspection), the relevant facts to be proved, and the date, time and place of the inspection.

The date fixed for the inspection must allow the party concerned sufficient time to prepare for it. If the inspection cannot take place for any reason, the proceedings will continue based on the evidence on file.

4. Oral Proceedings

Article 198 of the Code and Article 7 of the Statute provide that Sakpatenti shall hold oral proceedings with participation of interested parties.

If parties do not attend oral hearings date of which was properly communicated by Sakpatenti, or parties refuse in advance their right to oral hearings, Sakpatenti will decide the case based on the information of the file.

Sakpatenti may also offer the possibility of taking part in the oral proceedings by video conference or other technical means.

4.1 Summons to oral proceedings

Where Sakpatenti has decided to appoint day of oral proceedings and to summon the parties, the period of notice must be reasonable.

Where Sakpatenti considers it necessary to hear oral evidence from the parties, witnesses or experts, it will take an interim decision stating the means by which it intends to obtain evidence, the relevant facts to be proven and the date, time and place of the hearing. The summons will provide a summary of this decision and state the names of the parties to the proceedings.

If required, and in order to facilitate the hearing, Sakpatenti may invite the parties to submit written observations or to submit evidence prior to the oral hearing. The period fixed by Sakpatenti for receiving these observations must allow sufficient time for them to reach Sakpatenti and then be forwarded to the other parties.

The parties may likewise submit evidence in support of their arguments on their own initiative. However, if this evidence ought to have been produced at an earlier stage of the proceedings, Sakpatenti will decide whether these items of evidence are admissible, taking account of the principle of hearing both parties, where appropriate.

4.2 Language of oral proceedings

Oral proceedings will be in Georgian language.

Sakpatenti may, upon prior written request, authorise a party to communicate in another language provided that simultaneous interpretation of the communication into the language of proceedings can be made available. The costs of providing simultaneous interpretation will be paid by the party making the request.

4.3 Course of the oral proceedings

Oral proceedings before the Chamber of Appeals is public.

If a party who has been duly summoned to oral proceedings does not appear before Sakpatenti, the proceedings may continue without them.

If Sakpatenti invites a party to give evidence orally, it will advise the other parties accordingly so that they can attend.

Similarly, when Sakpatenti summons an expert or a witness to a hearing, it will advise the parties concerned. These may be present and put questions to the person giving evidence.

At the end of the oral proceedings Sakpatenti will allow the parties to present their final pleadings.

4.4 Minutes of oral evidence and of oral proceedings

Minutes of the taking of oral evidence and of oral proceedings will be recorded fully. Parties will be warned that oral proceeding are recorded.

5. Content of the Decisions

Sakpatenti's decisions will be reasoned to such an extent that their legality can be assessed at the appeal stage or before the court.

The decision will cover the relevant points raised by the parties. In particular, if there are different outcomes for some goods and services of the trademark application the decision will make clear which of the goods and services are refused and which are not.

The name or names of the person(s) who took the decision will appear at the end of the decision.

At the end of the decision, there will also be a notice advising of the right to appeal.

6. Payment of Fees

6.1 General principles

Trademark applications are subject to various fees, which are established by Resolution of Government of Georgia No. 182 of 03.07.2010 on Approval of Fees Connected with Patenting, Registration and Deposition of Objects of IP (Fees Resolution).

The applicant must pay fees for examination, publication and registration.

Fees are also paid for post-registration services like renewal, registration of assignment, change(s), license etc.

In the case of multi class applications, additional fee at the formal examination stage must be paid for each additional class of the first one.

6.2 Currency, amounts and means of payment

Fees for prosecution of national trademark applications and post registration services are defined in USD but must be paid in Georgian Lari according to official exchange rate established by the National Bank of Georgia for the day of payment. Payments in other currencies are not accepted. Amount of fees are established by Fees Resolution.

Sakpatenti accepts fees only through wire transfers. Fees may not be paid by check or in cash.

Amount of fees and payment procedure for international applications are prescribed by the Madrid Agreement and by the Fees Resolution as well

6.3 Timing for payment

Fees are subject of payment within one month from the date of receipt by the applicant respective invitation (except where Instruction explicitly prescribes otherwise).

Fees for actions requested by the applicant or third parties are paid simultaneously with filing such request with Sakpatenti.

The applicants may pay full amount of fees in advance. In such case fees will be deposited and applied by Sakpatenti stage by stage, according to prosecution phase of the application.

Part B Examination

Section 1 Proceedings

1. Introduction and General Overview of Examination Proceedings

This part of the Guidelines outlines the formal and substantive examination procedure from filing to registration or refusal of national trademark applications and from substantive examination to granting protection or refusing of international trademark applications.

Once the trademark application has been filed, a filing date is accorded and Sakpatenti issues a receipt. At this early stage, Sakpatenti only checks whether certain filing date requirements of the Law have been fulfilled. The filing date will only become definitive when the formal examination fee has been paid.

The applicant should check the receipt carefully and notify Sakpatenti of any incorrect data. The applicant can only correct data that have an impact on the filing date, such as the applicant's name, the representation of the mark and the list of goods and services, if he notifies Sakpatenti on the same date as the incorrect data were submitted. After this date, any amendment is subject to the provisions of the Law and the Instruction.

Payment of the formal examination fee is validated within 1 month at the latest after the Trademark application has been filed. In case of successful completion of formal examination, Sakpatenti, request the applicant to pay substantive examination fee which is validated 3 months at the latest after the request on payment is issued. For further information on fees, see the Guidelines, Part B, Examination, Section 2, paragraph 3 Fees.

During the examination proceedings Sakpatenti examines the following: filing date, formalities, classification, priority where applicable, the regulations governing use of the mark for collective marks, and absolute and relative grounds for refusal. Examination is conducted in two stages. Formalities of the application is examined at formal examination stage. Absolute and relative grounds for refusal are examined at substantive examination stage.

The applicant will be notified of any deficiency and given 2 months to remedy it and/or submit observations.

The application that comply with the requirements of the Law is accepted for consideration and subject to favorable decision of the substantive examination which will result in its publication and consequent registration.

2. Searches

The search report which is part of the decision of the substantive examination identifies earlier rights that conflicts with the Trademark application. However, even if the search report does not indicate any similar earlier rights, an opposition could still be filed against the Trademark application after its publication.

The results of the search report form ground for the decision of substantive examination.

Figurative elements are classified under the Vienna Classification.

The search report covers the following earlier rights:

1. Trade marks, design, AO and GI applications with a filing date or priority date earlier than that of the application in question
2. Trademarks, designs, AOs and GIs already registered and/or protected in Georgia and

3. Prior international registrations (IR) designating Georgia

The search report takes into account the filing date, the verbal elements of the trademark, the figurative elements of the mark (if applicable) and the classes of goods and services according to the Nice Classification. The search is designed to identify conflicting earlier marks filed for the same classes or for classes that are considered to contain similar goods and/or services by Sakpatenti.

3. General Principles Concerning Examination Proceedings

This section describes only the procedural aspects of examining absolute and relative grounds for refusal. For substantive aspects of examining absolute and relative grounds for refusal, see the Guidelines, Part B, Examination, Section 4 and Section 5.

During the examination of each application, the trademark and the goods or services of the application must be taken into account. Sakpatenti bears in mind the nature of the trademark concerned, the manner in which the goods or services are provided and the relevant public, for example, whether it consists of specialists or the general public.

3.1 Decisions

In all cases where Sakpatenti issues refusal, it must give the ground(s) for the decision. The decision(s) must address any pertinent arguments raised by the applicant in its observations (if any). Decisions must not only refer to the appropriate parts of the Law and but also give explicit reasons, except in the most obvious cases (for example, where a document is missing or a fee has not been paid).

Where, for example, a decision is given on the basis conducted searches, Sakpatenti must provide the applicant with search report.

3.2 Appeals

Applicants have a right to appeal at the Chamber of Appeals against a refusal or decision that terminates proceedings and that adversely affects them. For practical purposes, any decision issued by Sakpatenti that terminates proceedings and is not accepted by the applicant falls into this category. Any written communication of such a decision must also inform the applicant that the decision can be appealed within 3 months.

Appeals have suspensive effect. Within the period in which an appeal can be lodged, Sakpatenti should not take any steps that cannot easily be reversed (e.g. publication or entry in the Register). The same goes for the period up until a final decision is taken where a case is brought before the court.

3.3 International registrations designating Georgia

Details about the examination of Trademark application as a result of the transformation of an IR designating Georgia are given in the Instruction.

4. Publication

Publication takes place if after conducting substantive examination Sakpatenti issues favourable decision on the registration of the trademark.

The examiner must ensure that the following details are available, where applicable:

1. Case number
2. Filing date
3. Number of first application

4. Filing date of the first application
5. Code of the country/office of origin of the first application
6. Name and legal address of the applicant
7. Representation of the trademark
8. Indication of the collective mark
9. Indication of the mark type other than word marks, for example figurative marks, shape marks, position marks, pattern marks
10. Indication of colors
11. Goods and services under the Nice Classification

5 Amendments to Application

This part of the Guidelines only covers issues that are relevant to Trademark application amendments.

For amendments to registered trademarks, see the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration.

5.1 Withdrawal of Trademark application

5.1.1 Declaration of withdrawal

Trademark application can be withdrawn at any time until a final decision is taken on its subject matter.

The withdrawal of any pending appeal (before the Chamber of Appeal or court) means that the contested decision becomes final.

There is no charge for a declaration of withdrawal, but the declaration must be made in writing.

5.1.2 Unconditional and binding character of the declaration

A declaration of withdrawal becomes effective upon receipt by Sakpatenti, provided that Sakpatenti does not receive a withdrawal of the declaration on the same day.

This means that if a declaration of withdrawal and a letter withdrawing that declaration both reach Sakpatenti on the same day (regardless of the actual time of receipt), the latter annuls the former.

Once a declaration becomes effective, it cannot be withdrawn.

Where an applicant responds to an official action by filing a restricted list of goods and services (partial withdrawal), Sakpatenti checks whether the applicant is declaring the unequivocal withdrawal of the remaining goods and services or whether the amended list of goods and services is a proposal or counterproposal by the applicant, subject to Sakpatenti's agreement.

5.2 Restriction of the list of goods and services in application

The applicant may restrict the list of goods and services of its Trademark application at any time, before final decision of Sakpatenti is taken.

In principle, declaration of restrictions follows the same rules as declaration of withdrawals; see paragraph 5.1.

Where the case is pending before the court, the restriction must be filed with Sakpatenti, not with the court. Sakpatenti will then inform the court whether or not it finds the restriction acceptable and valid.

5.2.1 Procedural admissibility of a restriction

As a matter of principle, a restriction becomes effective on the date on which Sakpatenti receives it. The restriction can only be withdrawn if the withdrawal is received on the same date as the restriction itself.

Two requirements must be met in order for a restriction to be acceptable.

1. The new wording must not constitute an extension of the list of goods and services.
2. The restriction must constitute a valid description of goods and services and apply only to acceptable goods or services that appear in the original Trademark application.

For further details on restrictions of Trademark application, see the Guidelines, Part B, Examination, Section 3, Classification.

If these requirements are not met, Sakpatenti must refuse the proposed restriction and the list of goods and services will remain unchanged.

In any restriction request the goods and/or services to be restricted must be clearly indicated.

5.3 Other amendments

This paragraph and the legal provisions cited above solely concern amendments to Trademark application requested by the applicant on its own initiative and not amendments or restrictions made following an examination, opposition or appeal procedure.

Nor does this paragraph apply to the correction of errors in Sakpatenti's publications, which is carried out *ex officio*.

Amendments require a written request. There is prescribed fee of USD 60 per each request for amendments in application. If several amendments are requested by one letter, fee still remains USD 60.

The following elements of Trademark application may be amended:

- the name and address of the applicant or representative (see paragraph 5.3.1);
- errors of wording or of copying, or obvious mistakes, provided that the correction does not substantially change the trademark (for further details on such amendments, see the Guidelines, Part B, Examination, Section 2, Formalities);
- the list of goods and services (see paragraph 5.2).

5.3.1 Name and address of applicant or representative

The name and address of an applicant or its appointed representative may be amended freely, provided that any change in the applicant's name is not the consequence of a transfer.

A change in an applicant's name that does not affect the applicant's identity is acceptable change, whereas a change in the applicant's identity is a transfer.

Changes of name and address may be the result of changed circumstances or of an error made at the time of filing.

The applicant or its representative must request a change of name and address and this request must contain the Trademark application number and the name and address of the applicant or representative, both as recorded on the file and as amended.

Applicant must submit corresponding proof such as extract from the business register or declaration to the Sakpatenti, proving change of name.

The applicant must use a specific format in its application to indicate its name and official address in accordance with the above legal provisions and may change it later using the same format. Both the name and address will be registered.

Legal persons can have only one official address. If it has any doubts, Sakpatenti may ask for evidence of the legal form, the state of incorporation and/or address. The official name and address are taken as the address for service by default. Ideally, an applicant should have only one address for service. Changes to the applicant's official designation or official address will be registered for all Trademark applications and pending proceedings, registered trade marks and, unlike the address for service, cannot be recorded only for specific portfolios of rights. In principle, these rules also apply, by analogy, to representatives.

5.3.2 Recording and publication of amendments

If an amendment is allowed, it will be recorded in the file and entered in the Register.

Where the Trademark application has not yet been published, it is published in the Bulletin in the amended form.

5.4 Division of application

Trademark application can be divided into different parts not only as a result of a partial transfer (see the Guidelines, Part E, Register Operations, Section 2, Trade Marks as Objects of Property, Chapter 1, Transfer), but also on the trade mark applicant's own initiative. Division is particularly useful for isolating a disputed Trademark application for certain goods or services while maintaining the original application for the remainder. For information on the division of trade marks see the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration.

5.4.1 Requirements

A request for division must contain the following information:

- the file number of the Trademark application to be divided;
- the name and address of the applicant;
- the list of goods and services for the divisional application or, if more than one new application will be created, the list of goods and services for each divisional application;
- the list of the goods and services that will remain in the original Trademark application.

Furthermore, the goods and services of the divisional application must not overlap with the list of goods and services of the original application.

Sakpatenti will notify the applicant of any deficiency in this regard and give it 2 months to remedy the deficiency. If it is not remedied within this period, the request for division will be refused.

There are certain periods during which, for procedural economy or to safeguard third-party rights, division is not admissible. These periods are outlined below.

1. While an opposition is pending, only the non-contested goods and services may be hived off. The same applies if the case is pending before the court. Sakpatenti interprets the legal provisions cited above as preventing the applicant from hiving off some or all of the contested goods to form a new application that would cause the opposition proceedings to be split. If such a request for division is made, the applicant is given the opportunity to amend it by hiving off the non-contested goods and services.

2. Division is not admissible during the 3-month opposition period following publication of the application. Allowing a division during this time would counteract the aim of not splitting an opposition procedure and frustrate third parties, who have to rely on the tr Bulletin to know what to oppose.

3. Division is not admissible during the period before a filing date has been issued either. This does not necessarily coincide with the first month following filing. For further details on the filing date, see the Guidelines, Part B, Examination, Section 2, Formalities.

For all practical purposes, in the period following publication of the application, division is only admissible if an opposition has been entered against the application and only for the non-contested part. The aim of the provisions cited is to allow the applicant to register its mark for the non-contested goods quickly, without having to wait for the outcome of a lengthy opposition procedure.

5.4.2 Acceptance

If Sakpatenti accepts the declaration of division, a new application is created as of the date of acceptance and not retroactively as of the date of the declaration.

The new application keeps the filing date and any priority dates. The priority effect will then become partial.

All requests and applications submitted, and all fees paid prior to the date on which Sakpatenti receives the declaration of division are also deemed to have been made or paid for the divisional application.

Section 2 Formalities

1. Introduction

Every trademark application must abide by certain formality rules. The purpose of these Guidelines is to lay down Sakpatenti's practice in relation to those rules.

2. Filing of Applications

2.1 Applicants

Any natural or legal person, including authorities established under public law, may apply Sakpatenti for trade mark registration, irrespective of their nationality or domicile.

2.2 How application can be filed

Trademark applications may be filed electronically, by post or by courier. E-filing is the strongly recommended means of filing since it can guarantee accurate quality of the trade mark representation, as well as offers discount of official fees in case of e-filing and the system gives guidance to the applicant, thus reducing the number of potential deficiencies. Trade mark can be filed electronically via Sakpatenti's website (<https://online.sakpatenti.gov.ge/ka/app/login/>).

3. The Fees

3.1 Fees in general

For the Trademark applications the following fees are applicable.

Trademark	Basic Fee (including one class)	Fee for each additional class
Individual mark	USD 420	USD 50
Individual mark filed electronically	USD 336	USD 40

Individual mark filed by accelerated procedure	USD 840	USD 300
Individual mark filed by accelerated procedure electronically	USD 672	USD 240
Collective mark	USD 1070	USD 90
Collective mark filed electronically	USD 856	USD 72
Collective mark filed by accelerated procedure	USD 1090	USD 390
Collective mark filed by accelerated procedure electronically	USD 872	USD 312

According to the Resolution of the Government of Georgia № 182 of July 3, 2010 “On Approval of Fees for the Service Related to Patenting, Registration and Deposition of Intellectual Property Subject-Matters” the fee must be paid in Georgian Lari according to the official exchange rate set by National Bank of Georgia which is valid for payment date. Payments made in other currencies are not valid.

3.2 Basic fee deficiency

If the basic fee is not paid within 1 month of the date Sakpatenti received the application, the application will be rejected.

3.3 Class fee deficiency

Where the application covers more than one class of goods and/or services, an additional class fee is payable for each additional class.

Where the fee payment made is less than the total sum of fees due for the classes selected in the application form, a deficiency letter will be issued, setting a 2-month time limit for payment of the remaining amount. If the outstanding payment is not received within the specified time limit, the application will be deemed to be withdrawn for the classes not covered by the fee paid. In the absence of other criteria to determine which classes are intended to be covered by the amount paid, SakpatentiSakpatenti will take the classes in the order of the classification (starting with the lowest class number).

Where additional class fees become payable following the rectification of classification deficiency, a deficiency letter will be issued, setting a 2-month time limit for payment. If payment is not received within the time limit specified, the application will be deemed to have been withdrawn for those classes resulting from the reclassification not covered by the fees actually paid. In the absence of other criteria to determine which classes are intended to be covered by the amount paid, SakpatentiSakpatenti will take the classes in the order of the classification (starting with the lowest class number).

4 Filing Date

4.1 Filing date requirements

A filing date is accorded where the application fulfils the following requirements:

- the application is filed in Georgian language;
- the application contains name and address of the applicant;

- the application contains representation of the mark, which fulfils requirements of the Instruction;
- the application contains list of goods and services;
- the application is signed according to the requirements of article 3(11) of the Instruction.

If any of the above requirements are not met, application deemed not to be filed and application materials are returned to the applicant.

4.1.1 Fees

The filing fee and, where appropriate, class fees, must be paid within 1 month of the filing of the application. Where the fee is not paid within 1 month Sakpatenti will reject the application.

4.1.2 Request

The application must contain a request for the registration of trade mark. Application shall be filed using Sakpatenti's paper or e-filing form, available in Georgian language.

4.1.3 Applicant

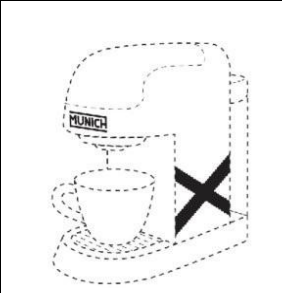
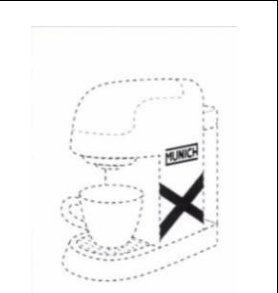
The application must contain information identifying the applicant, specifically the name and address of the applicant and the country in which it is domiciled or has its seat or an establishment. If the applicant has previously filed application electronically, in his account he can indicate applicant's details automatically which was saved in the database.

For further information on the applicant, see paragraph 7.1.

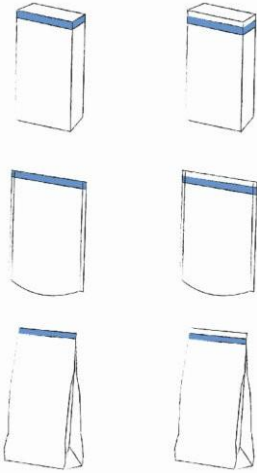

4.1.4 Representation of the mark

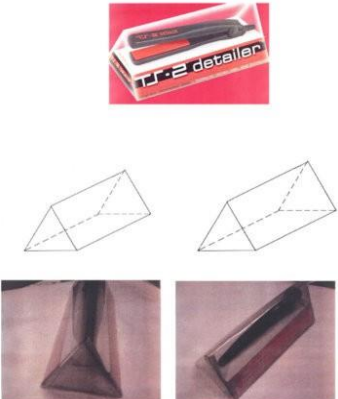
The application must contain a representation of the mark that allows to determine the clear and precise subject matter of the protection requested in accordance with Article 3(1) of the Law. For further information on the different types of marks, please see paragraph 9.


Examples



Representation No 1	Representation No 2	Explanation
		Representation submitted initially has deficiency ('representation 1'). It included two different elements within the same position mark which were not connected to each other (therefore, two position marks). 'Representation 2' satisfies the requirements for trade mark representation.

Representation No 1	Representation No 2	Explanation
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		<p>Representation submitted initially has deficiency ('representation 1'). It shows different positions on the good. "Representation 2" satisfies the requirements for trade mark representation.</p>
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Representation	Explanation
	<p>Five views that do not all show the same object. Respectively such representation is not allowed.</p>

Representation	Explanation
	<p>Including text in addition to the representation of the mark is not allowed (text below the photo of the bottle).</p>

	<p>The first and third bottles show two different perspectives of the same bottle, both with a grey lid. The second bottle has a blue lid and is therefore a different object to the first and third bottles. The fourth image is completely different, showing two bottle tops and a label. Of the four perspectives, only the first and third are views of the same object. Furthermore, including text in addition to the representation of the mark is not allowed.</p>
	<p>The first four images and the sixth image show the same shape mark from different perspectives. However, the fifth image is inconsistent with the others in that it shows a different shape mark, as it has been manipulated. Views of an object in a different state (e.g., open v closed) are not considered to be the same mark.</p>

4.1.5 List of goods and services

In order for a filing date to be accorded, there must be a list of goods and services. This list must comply with Article 9 of the Law and article 3 of the Instruction. To build their list of goods and services, applicants can select pre-approved terms from the **Harmonised Database**, which will be automatically accepted for classification purposes. Using these pre-approved terms will facilitate a smoother trademark registration process.

For applications filed electronically, please see also paragraph 5.2

4.2 Filing date receipt

4.2.1 Applications filed through Sakpatenti's User Area

For Trademark applications filed through Sakpatenti's User Area, the system immediately issues an automatic electronic filing receipt, which contains the provisional filing date. The applicant should keep this receipt.

4.2.2 Applications filed by other means

When an application is received other than through Sakpatenti's User Area, a provisional filing date is accorded and Sakpatenti issues a receipt with this filing date. The filing date will be considered the date of receipt if the application fulfils the filing date requirements

5 Goods and Services

5.1 Classification

Every Trademark application must contain a list of goods and services as a condition for being accorded a filing date (see paragraph 4.1.5).

The list must be classified in accordance with the Nice Agreement.

The scope of protection defined by the original list of goods and services cannot be extended. If an applicant wants to protect additional goods or services after filing, a new application must be filed.

For further information on the classification of goods and services, please refer to the Guidelines, Part B, Examination, Section 3, Classification.

5.2 Specific filing date deficiency and e-filing applications

The list of goods and services must be entered in the text fields provided for that purpose.

Where the list of goods and services is filed totally or partially as an attachment to an e-filing application, or is filed separately, the application will not be considered as having been filed by electronic means and the corresponding higher fee for applications not filed by electronic means will apply.

6. Languages/Translations

Trademark application shall be filed in Georgian. Power of Attorney and priority documents may be submitted in foreign languages. In case mentioned documents are submitted in foreign language, applicant must submit their certified translation within one month after submitting those documents. In case of bilingual signed documents no certified translation is needed.

6.1 The correspondence language

The correspondence language is Georgian.

6.2 Restriction of goods and services

For information on the restriction of goods and services, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.2.

7 Owner, Representative and Address for Correspondence

7.1 Applicant

Any natural or legal person, including authorities established under public law (e.g., a university), may be the proprietor of trade mark.

In Trademark application, the applicant must state its name ID or Tax registration number, legal address, address for correspondence and the country in which it is domiciled or has its seat or establishment.

Names of natural persons must be indicated by the person's family name, given name(s) and ID number. The names of legal entities must be given in full (statutory name) together with Tax registration number and only their legal forms may be abbreviated, in the customary manner, for example, PLC, S.A. If the legal form is not specified or is incorrectly indicated, a deficiency letter requesting this information will be issued. If the legal form is still not given or not correctly given, the application will be rejected. If the applicant is a foreign company, national identification number may also be specified, if available.

The address should in principle contain the street, street number, city/town or state/county, and country. If any of these particulars is missing, Sakpatenti will issue a deficiency and set a time limit of 2 months to remedy the deficiency or to provide a valid reason for omitting it. A PO box on its own does not constitute a place of business unless it can be proven, for example by submitting an extract of the company register, that it is indeed the company's official address.

The applicant should indicate legal address and address for service separately.

For more information on communication with Sakpatenti, please refer to the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits.

7.2 Representative

If the applicant has its domicile, principal place of business or a real and effective industrial or commercial establishment in Georgia there is no obligation for it to be represented.

If the applicant does not have its domicile, principal place of business or a real and effective industrial or commercial establishment in Georgia, regardless of its nationality, representation must be sought to act for it in all proceedings except the filing of the Trademark application and the payment of the application fee.

7.3 Change of name/address

The name and address of the applicant may be amended. A change in the name of the applicant is a change that does not affect the identity of the applicant, whereas a transfer is a change in the identity of the applicant. For more information on the definition of a change of name and how it compares with a transfer, see the Guidelines, Part E, Register Operations, Section 1, Changes in a Registration..

7.4 Transfer of ownership

Trade mark registrations and applications may be transferred from the previous proprietor/applicant to a new proprietor/applicant, primarily by way of assignment or legal succession. The transfer may be limited to some of the goods and/or services for which the mark is registered or applied for (partial transfer). At the request of one of the parties, a transfer will be entered in the Register and published.

For more information on the recording of transfers of ownership see the Guidelines, Part E, Register Operations, Section 2 Trade marks as objects of property, Chapter 1 Transfer,

8 Kind of Mark

The Law distinguishes between two kinds of marks: trademark and collective mark. Sakpatenti's decisions and communications will identify trademarks and collective marks, as appropriate.

8.1 Trademarks

Trademark indicates the commercial origin of the protected goods and/or services. Any natural or legal person, or person equivalent to these persons under the national law applicable to them, including authorities established under public law, may be the proprietor of a trademark, irrespective of their nationality.

8.2 Collective marks

For further information on collective marks, please see the Guidelines, Part B, Section 4, Chapter 15, Collective Marks

8.2.1 Character of collective marks

A collective mark is a specific kind of mark, described as such when the mark is applied for, that indicates that the goods or services protected by that mark originate from members of an association, rather than from just one trader. Collective does not mean that the mark belongs to several persons nor that it designates/covers more than one country.

Collective marks may be used together with the trademark of the producer of a given good or of the service provider. This allows members of an association to differentiate their own products and/or services from those of competitors.

For further information on the substantive requirements of collective marks, see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 15, Collective Marks.

8.2.2 Applicants for collective marks

Associations of manufacturers, producers, suppliers of services or traders that, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue or be sued, as well as legal persons governed by public law, may apply for a collective mark. The applicant must be either an association in a formal sense or have an internal structure of an associative nature

For further information on the ownership requirements of collective marks, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 15, Collective Marks.

8.2.3 Regulations governing use of collective marks

In addition to the information to be submitted when applying for trademark, applications for a collective mark require the submission of regulations governing use of the mark.

The regulations governing use must be submitted within 1 month of the filing date of the application (Article 4(8) of the Instruction).

Sakpatenti recommends use of its **template**, specifically created to guide applicants through the process of drafting the regulations governing use.

8.2.3.1 Content of the regulations of use

The regulations governing use referred to in Article 32 of the Law must be set out in a stand-alone document and contain the obligatory information:

1. **Name of the applicant;** (identical to the one given in the application form).
2. **Names and addresses of the members** of the association.
3. **Object of the association** or the object for which the legal person governed by public law is constituted.
4. For associations, the **conditions for membership**; containing, when appropriate, the authorisation for others to become a member of the association when the mark designates the geographical origin of the goods and services and their goods and services originate in the geographical area concerned (article 32(3) of the Law) (**regarding situations where authorisation is needed, see the Guidelines, Part B, Section 4, Absolute Grounds for Refusal, Chapter 15, Collective Marks, Point 4.1, Article 31 of the Law; geographical derogation**); the rules concerning the conditions for membership must be specifically included in the regulations governing use; cross references to other documents are not sufficient.

5. **Conditions governing use of the mark** applied for, including sanctions (e.g. where the mark is to be placed on the goods, or where a minimum size of the mark in relation to the goods is to be respected);

6. **Rights and obligations of the members of association** regarding infringement of rights on collective mark.

7. **Goods or services** covered by the collective mark (**identical** to the list of goods and services of the application), including, where appropriate, general characteristics of the goods and services covered.

8.2.3.2 Examination of formalities relating to the regulations of use

8.2.3.2.1_Regulations of use not submitted

If the regulations are not submitted with the application, or within one month after filing date of the application, Sakpatenti will reject the application.

8.2.3.2.2 Regulations of use submitted but with deficiencies

If the regulations have been submitted but fail to specify the required information, as listed in paragraph 8.2.3.1, a deficiency letter will be sent, setting a time limit of 2 months to submit the missing information.

If the deficiency is not remedied within this 2-month time limit, the application will be refused.

9 Representation, description and type of mark

9.1 Representation

A trademark may be represented graphically in any appropriate form using generally available technologies 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. The representation cannot be replaced by a description of the mark but the description, when given, must accord with the representation.

When figurative, shape, position, pattern, or 'other' marks are to be registered in colour, a coloured reproduction of the mark must be filed with the application.

If the applicant fails to submit a representation that satisfies the requirements of article 3(1) of the Law when filing Trademark application, application will be rejected.

Where the applicant has selected a mark type that does not correspond to the mark representation, the mark type will be corrected following the indications set out under paragraph 9.3.7, Correction of mark type.

9.2 Description

Description of the trademark does not have legal power to define scope of protection of the mark. However, it should correspond the representation of the mark. Where the mark description does not accord with the representation, Sakpatenti will ask the applicant to amend or delete it.

Where goods and services are mentioned in the mark description field rather than in the field for goods and services, Sakpatenti will delete them from the mark description and, if the goods and services are not already covered in the specification, inform the applicant that it must add the goods and services.

This principle applies *mutatis mutandis* in all cases where necessary information on the mark is included in the wrong field of the application form.

After the mark has been filed, a mark description can be amended or added in order to submit more detailed information. However, such amendment must not alter the nature of the mark and must accord with the representation.

9.3 Mark type

The categorisation of marks serves a number of functions. Firstly, it establishes the legal requirements for each type of mark; secondly, it can help Sakpatenti and other economic operators to understand what the applicant is seeking to register; and finally, it facilitates searches in Sakpatenti's database.

The examples of mark types in these Guidelines are given only in the context of formalities' issues without prejudice to the outcome of the examination proceedings or to their scope of protection.

9.3.1 Word marks

A word mark is a typewritten mark with elements including letters (either lower or upper case), words (either in lower or upper-case letters), numerals or standard typographic characters.

A word mark must be represented by submitting a reproduction of the sign in standard script and layout, without any graphic feature or colour. Standard layout is to be understood as written across a single line. Sakpatenti accepts signs in the Georgian, Latin, and Cyrillic alphabet as a word mark. A mark consisting of text in non-standard layout, for instance written across more than one line, will not be categorized as a word mark, as these marks are considered to be figurative.

Examples of acceptable word marks (for formalities' purposes)	
TM No 6 892 351	europadruck24
Georgian TM reg. No.35114	ძალა ზემოთ
TM No 6 892 806	TS 840
TM No 6 907 539	4 you
TM No 2 221 497	ESSENTIALFLOSS
TM No 631 457	DON'T DREAM IT, DRIVE IT
TM No 1 587 450	?WHAT IF!
TM No 8 296 832	Долината на тракийските царе (Cyrillic)

9.3.2 Figurative marks





A figurative mark is a mark consisting of:

- exclusively figurative elements;
- a combination of verbal and figurative or otherwise graphical elements;
- verbal elements in non-standard fonts;
- verbal elements in colour;
- verbal elements on more than one line;
- letters from alphabets except for Georgian, Latin or Cyrillic;
- signs that cannot be reproduced by a keyboard;
- combinations of the above.

A figurative mark must be represented by submitting a reproduction of the sign, showing all its elements and, where applicable, its colour(s).

The representation may be submitted in one single JPEG file (max. Size of 5MB) or in special slot in application form.

Application may include description of the mark. However, description has no legal power and is not taken into account for defining scope of protection of the trademark.

Examples of figurative marks (for formalities' purposes)	
Purely graphic element	
Combination of graphic element and text in standard font	
Combination of stylised font and figurative elements	
Combination of stylised font and figurative elements	

Verbal element in stylised font	<i>Houp</i>
Verbal elements in stylised font	<i>Jim Thompson</i>
Verbal elements in different fonts	FOOC FÜSSEN OUTLET CENTER
Verbal elements only, over more than one line	YVES ROCHER LIFTING BIO CULTURE BIO
Slogan in two different fonts, letters in different sizes, on more than one line	Heute handeln ist trendy
Mark represented in characters except for Georgian, Latin or Cyrillic	火瀑

9.3.3 Shape marks

A shape mark is a mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or its appearance. The term ‘extending to’ means that shape marks cover not only shapes per se, but also shapes that contain other elements, such as word elements, figurative elements or labels.

The shape mark may be represented by either a graphic representation of the shape or a photographic reproduction. The meaning of a graphic representation is extended to comprise the use of new technology, thereby allowing the filing of computer-generated images or animated designs in file formats **OBJ, STL and X3D, with a maximum size of 5 MB.**

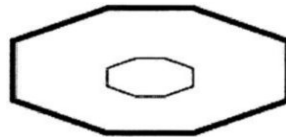
Where the application for a shape mark is intended to be used as the basis for an international application, the applicant should be aware and take into account that computer-generated images, animated designs, etc. are currently not considered acceptable mark representations under the Madrid System.

Where the representation is not a computer-generated image, it may contain up to six perspectives of the same shape. The different views must be submitted in one single JPEG file or on one single A4 sheet together with application form. While different perspectives may be filed, a single view of the shape is sufficient where the shape to be protected can be ascertained from that single view.

Where an applicant files different perspectives of a three-dimensional object on more than one sheet of paper, a deficiency will be raised, setting a time limit for the applicant to indicate which one of the representations filed will be the representation of the application. Likewise, where a single JPEG file or a single A4 sheet consists of more than six perspectives of the same three-dimensional shape, a deficiency will be raised, setting a time limit for the applicant to remove the perspective(s) exceeding the maximum number allowed, provided that the amendment does not substantially change the mark as filed.

If no mark type is indicated and only one view has been submitted, from which it cannot be inferred that the sign consists of or extends to a 3D shape, Sakpatenti will treat the representation as a figurative trademark.

Example



No mark type was selected for this sign. Sakpatenti will treat it as a figurative mark.

Application may contain description of the shape mark. However, the representation of the trademark alone defines the subject matter of the registration.

Examples of acceptable representations of shape marks (for formalities' purposes)	
Four different drawings of the same object	
Six photographs of the same object from different perspectives, with text	

<p>Two photographs in colour showing different perspectives of the same object</p>	
<p>Six views in colour showing six different perspectives of the same object</p>	
<p>Combination of photographs and drawings showing the same object</p>	
<p>One view of the object</p>	

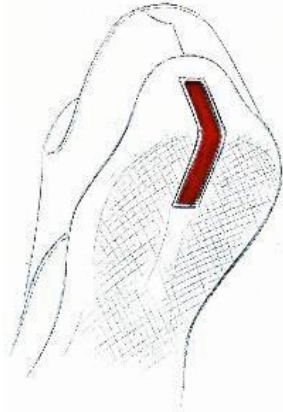
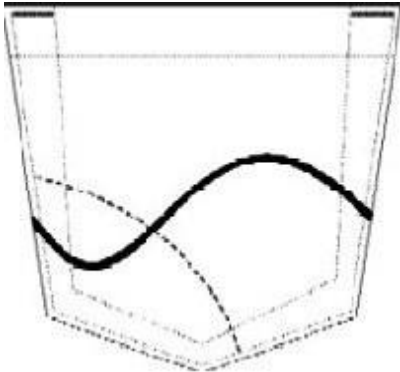
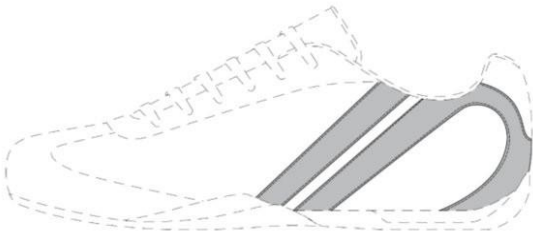
9.3.4 Position marks

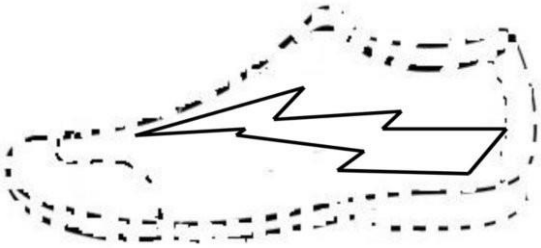
A position mark is a trademark consisting of the specific way in which the trademark is placed on or affixed to the product.

This type of mark must be represented by submitting a reproduction that identifies appropriately the position of the mark and its size or proportion with respect to the relevant goods. The representation may be submitted in one single JPEG file or on one single A4 sheet.

The representation should clearly define the position of the mark and its size or proportion with respect to the relevant goods. The elements that do not form part of the subject matter of the registration must be visually disclaimed, preferably by broken or dotted lines. A description that accords with the representation of the mark may be added to indicate how the sign is affixed to the goods. This cannot, however, serve as a substitute for a visual disclaimer. Colours, to the extent that they form an integral part of the description, may be indicated therein.

A description that infers that the position of the mark may vary with respect to the goods, for example 'The mark consists of [description of the device] applied to the outside of the goods', is not acceptable. In this case, Sakpatenti will notify a formality deficiency, requesting the applicant to amend or delete the description, as the position of the mark must be clearly defined with respect to the relevant goods.

Examples of acceptable mark description for position mark (for formalities' purposes)	
<p><u>Marktype:</u> Position mark</p> <p><u>Description:</u> Red stripe placed longitudinally along an item of footwear partly covering the rear area of the sole and partly the rear area of the item of footwear. Any moulding seen on the sole or on the rear part of the item of footwear and/or production characteristics are not part of the trademark.</p>	 <p>A technical drawing of a shoe sole from a top-down perspective. A solid red stripe is positioned longitudinally along the rear portion of the sole. The rest of the sole is shown with a fine grid pattern to indicate its shape and depth.</p>
<p><u>Description:</u> Two Curves Crossed in One Point Design inserted in a Pocket; the mark consists of a decorative stitching made of Two Curves Crossed in One Point Design inserted in a Pocket; one of the curves is characterised by an arched form, drawn with a fine stroke, while the second one is characterised by a sinusoidal form, drawn with a thick stroke; the unevenly broken lines represent the perimeter of the pocket to which the applicant makes no claim and which serves only to indicate the position of the mark on the pocket.</p>	 <p>A technical drawing of a pocket. The pocket's perimeter is indicated by a dashed line. Two decorative stitching patterns are shown: a thin, arched line and a thick, sinusoidal line. These two lines cross each other at a single point within the pocket's area.</p>
Examples of acceptable mark description for position mark (for formalities' purposes)	
<p><u>Description:</u> The trademark is a position mark. The mark consists of two parallel lines positioned on the outside surface of the upper part of a shoe. The first line runs from the middle of the sole edge of a shoe and slopes backwards towards the instep of a shoe. The second line runs parallel with the first line and continues in a curve backwards along the counter of a shoe to the heel of a shoe and ends at the sole edge of a shoe. The dotted line marks the position of the trademark and does not form part of the mark.</p>	 <p>A side-view technical drawing of a shoe. Two parallel lines are shown on the upper part of the shoe. The first line starts at the sole edge near the toe and slopes back towards the instep. The second line starts further back, parallel to the first, and curves back along the heel counter to the sole edge at the heel. A dotted line outlines the shoe's upper to show the mark's position.</p>


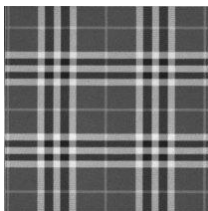
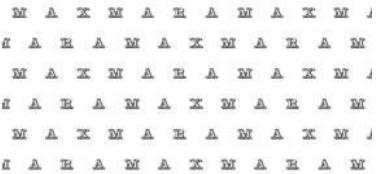
<p>Position mark without description</p>	
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9.3.5 Pattern marks

A pattern mark is a trademark consisting exclusively of a set of elements that are repeated regularly.

This type of mark must be represented by submitting a reproduction showing the pattern of repetition in one single JPEG file or on one single A4 sheet.

The representation of the pattern mark may be accompanied by a description detailing how its elements are repeated regularly. Such description must accord with the representation and not extend its scope. Colours, to the extent that they form an integral part of the description, may be indicated therein.

Examples of acceptable pattern marks (for formalities' purposes)	
<p>Mark Type: pattern mark</p>	
<p>Mark Type: pattern mark</p>	
<p>Mark Type: pattern mark</p>	

9.3.6 Sound marks

A sound mark must be represented by submitting an accurate representation of the sound in musical notation and may be accompanied by an audio file reproducing the sound..





The audio file must be in MP3 format and its size cannot exceed two megabytes.

An audio file may be submitted through e-filing or in case of paper-based filing, audio file shall be submitted together with the Trademark application on CD/DVD or USB memory stick. Sakpatenti will not accept an electronic sound file separately from the application.

Where the application for a sound mark is intended to be used as the basis for an international application, the applicant should be aware and take into account that audio files are currently not considered acceptable mark representations under the Madrid System.

Musical notations may be submitted in one single JPEG file or on one single A4 sheet. 'Accurate musical notation' means that the representation must include all the elements necessary for interpreting the melody, that is to say, pitch, lyrics (if any), etc.

If the applicant submits both an audio file and musical notations, it will be asked to choose which of the two it wishes to retain. If the applicant submits an audio file and a representation of a sonograph, the sonograph will be removed from the file by Sakpatenti.

Example of accurate musical notation	
Musical notation including musical directions	
Voice saying 'Barca'	 Link
Six notes on a piano	 Link
Two notes on a keyboard followed by a whizzing sound	 Link

9.3.7 Motion Marks

A motion mark is defined as a trademark **consisting of, or extending to**, a movement or a change in the position of the elements of the mark. Trademarks combining movement with

sounds do not qualify as motion marks and should be applied for as multimedia marks (see paragraph 9.3.8). The term ‘**extending to**’ means that, in addition to the movement itself, the mark may also include words, figurative elements, labels, etc.



~~A motion mark must be represented by submitting either a video file¹ or a series of still sequential images showing the movement or change of position. The video file must be in MP4 format and may not exceed 8 000 Kbps (kilobytes per second) and 20 MB.~~

~~A video file may be submitted only for e-filings. Sakpatenti will not accept a video file separately from the application.~~


~~Where the application for a motion mark is intended to be used as the basis for an international application, the applicant should be aware and take into account that video files are currently not considered acceptable mark representations under the Madrid System.~~

The number of images is practically unlimited as long as they all fit in one single JPEG file or on one single A4 sheet. The still images may be numbered and/or accompanied by a description explaining the sequence.

The representation of the motion mark may be accompanied by a description. Such description must accord with the representation and not extend its scope. Colours, to the extent that they form an integral part of the description, may be indicated therein.

Example of motion marks	
<p><u>Description:</u> The mark is an animated sequence with two flared segments that join in the upper right portion of the mark. During the animation sequence, a geometric object moves up adjacent to the first segment and then down adjacent to the second segment, while individual chords within each segment turn from dark to light. Stippling shown in the mark is for shading only. The entire animated sequence lasts between one and two seconds.</p>	
<p>A round green shape rotating on a black background</p>	 <p style="text-align: left; margin-top: 10px;">Link</p>

¹ Texts with strikethrough shall be added only after Sakpatenti confirms legal amendments to the trademark law.

<p>TM No 17 894 400</p> <p>The words 'WIN WIN' represented with changing letter sizes</p>	 <p>Link</p>
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9.3.8 Multimedia Marks

A multimedia mark is defined as a trademark **consisting of, or extending to**, the combination of image and sound. The term '**extending to**' means that the mark may also include words, figurative elements, labels, etc. in addition to the image and sound.

A multimedia mark can only be represented by submitting an audiovisual file containing both the image and the sound and can therefore only be filed via e-filing. Sakpatenti will not accept an audiovisual file separately from the application. The audiovisual file must be in MP4 format and may not exceed 8 000 Kbps (kilobytes per second) and 20 MB.

Where the application for a multimedia mark is intended to be used as the basis for an international application, the applicant should be aware and take into account that audiovisual files are currently not considered acceptable mark representations under the Madrid System.

It is not possible to file a mark description or indication of colour for multimedia marks. The representation of the trademark alone defines the subject matter of the registration.

Example of multimedia marks	
<p>Moving characters 'UOC' on a blue background accompanied by a musical tone, moving across to be completed with the words 'Universitat Oberta de Catalunya'.</p>	 <p>Link</p>

~~A hat, the band of which is stuffed with bank notes, moving slowly backwards to reveal a blue and white ball, all accompanied by a drum roll.~~



[Link](#)

9.3.9 Hologram Marks

A hologram mark is defined as a trademark consisting of elements with holographic characteristics.

A hologram mark must be represented by submitting either a video file or a graphic or photographic reproduction containing the views necessary for sufficiently identifying the holographic effect in its entirety.

The video file must be in MP4 format and may not exceed 8 000 Kbps (kilobytes per second) and 20 MB. A video file may be submitted only for e-filings. Sakpatenti will not accept a video file separately from the application.

The number of views is unlimited as long as they all fit in one single JPEG file or on one single A4 sheet.

Where the application for a hologram mark is intended to be used as the basis for an international application, the applicant should be aware and take into account that video files are currently not considered acceptable mark representations under the Madrid System.

9.3.10 Correction of mark type

9.3.10.1 General rules

If the mark type indicated in the application contradicts the representation submitted, or if no mark type is given, **and it is obvious** which mark type the applicant intended to apply for, Sakpatenti will correct the mark type and inform the applicant, giving a 2- month time limit for observations. If there is no response, the correction made by Sakpatenti is considered accepted by the applicant. If the applicant disagrees with the amendment, Sakpatenti will restore the original mark type indicated; however, the application may then be rejected if the subject matter for which protection as a trademark is sought is not clear and precise.

Likewise, if the mark type indicated contradicts the representation submitted, or if no mark type is given, but **it is not obvious** which mark type the applicant intended to apply for, a deficiency will be issued and a time limit of 2 months set to remedy any deficiency. If the deficiency is not remedied, the Trademark application will be refused.

9.3.10.2 Examples of recurring mark type deficiencies

9.3.10.2.1 Word marks

Where the mark type chosen is 'word', but the mark is actually a 'figurative' mark, such as in the examples in paragraph 9.2 (representation on several lines, stylised font, etc.), Sakpatenti will correct the mark type.

9.3.10.2.2 Figurative marks

If no mark type has been indicated at all and the mark is clearly figurative in accordance with the examples given above, the mark type is inserted by Sakpatenti and the applicant is informed accordingly.

~~Sometimes 'figurative' marks in colour are erroneously filed as 'colour marks'. Furthermore, the differences in typology of the miscellaneous marks within the EU Member States may lead to a mark type deficiency, in particular with regard to marks combining a word and a figurative element. In such cases, Sakpatenti will correct the mark type to 'figurative' and inform the applicant, setting a 2-month time limit for observations.~~


Example 1

~~A figurative mark applied for as a colour mark.~~

~~Sakpatenti will change the mark type from colour to figurative and send a letter confirming the amendment. If the applicant disagrees, they may submit observations. If Sakpatenti disagrees with the observations, it will restore the original indication of mark type, but the application will then be rejected. If, however, there is no response within the time limit, the change of mark type will be considered as accepted and the application will proceed.~~

Example 2

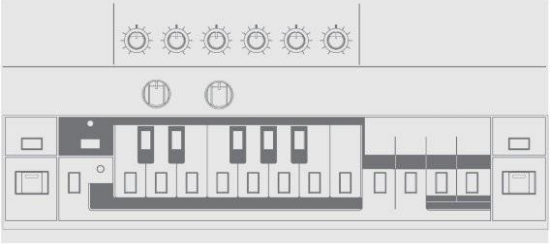
The following marks were applied for as mark type 'word mark'.

Invented example	
Invented example	

When the applicant has chosen the mark type 'word mark', instead of ticking 'figurative', and has added, in the explanatory field of the 'word mark', terms like 'text and logo', 'semi-figurative mark', but the mark applied for is clearly a figurative trademark as defined above, Sakpatenti will change the mark type from **word mark** to **figurative**.

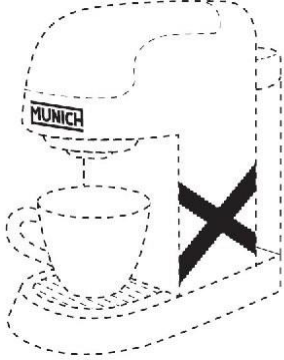
Example 3

The applicant chose the mark type 'shape' when applying for the following mark.


Invented example	
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A shape mark is a mark consisting of a three-dimensional shape, including containers, packaging, the product itself or their appearance. In the absence of any three-dimensional effect, Sakpatenti will categorise the mark as figurative.

9.3.10.2.3 Position marks

Filed as a figurative mark	Representation of sign
<p>The representation of the sign and in particular the use of dotted lines to outline the coffee machine together with the description provides indicating that the image of the coffee machine is not part of the mark itself, altogether led Sakpatenti to consider that there was a misalignment between the representation, the type and the description of the mark. Sakpatenti will correct the mark to a position mark, having previously informed the applicant.</p>	

9.3.10.2.4 Pattern marks

Filed as a figurative mark	Representation of sign
<p>The mark type was changed to 'pattern' since it was clearly a set of elements being repeated regularly.</p>	

10. Series Marks

Unlike some systems, the Law does not allow for series/serial marks. When different versions of a trademark are required, a separate Trademark application is required for each version.

Example1

A **word** mark filed as 'BRIGITTE brigitte Brigitte' will **not** be 'interpreted' as 'the word "Brigitte"', written either in upper case letters or in lower case letters or in "normal" script'; rather, it will be seen as the word mark exactly as filed, containing the female name 'Brigitte' three times. No deficiency letter will be sent and no changes to the mark will be accepted.

Example2

Likewise, a **word** mark filed as 'Linea Directa/Direct Line/პირდაპირი ხაზი' will **not** be 'interpreted' as 'the term "direct line"', either in Spanish or in English or in Georgian'; rather, it will be seen as a word mark containing all three language versions in the same sequence as applied for. No deficiency letter will be sent and no changes to the mark will be accepted.

10.1 Multiple figurative representations

In an application submitted through e-filing, the reproduction of the mark must be uploaded as a single JPEG file. When the paper application form is used, the mark reproduction must be attached on a single A4 sheet or inserted in the specific part of application form.

The JPEG file or A4 sheet must contain only one representation of the mark as applied for and no additional information whatsoever.

Where an application, filed electronically or on paper, contains a JPEG file or an A4 sheet showing what might be seen as more than one mark representation, Sakpatenti will notify the applicant and invite to file separate applications for each representation according to article 14 of the Instruction. If applicant fails to comply with the notification of Sakpatenti, the application will be rejected.

11. Priority

The effect of the right of priority is that the date of priority will count as the date of filing of the trademark application for the purposes of establishing which rights take precedence in examination or inter partes proceedings.

A priority claim of a previous trade mark is acceptable if that trade mark was granted a filing date. A priority claim of an international registration is not acceptable. This is because the principle of first filing applies, and the priority claim can only be based on the relevant basic mark.

Any filing that is equivalent to a regular national filing under the domestic law applicable to it will be recognised as giving rise to the right of priority.

11.1 Formal requirements

Article 3(10)(b) of the Instruction lays down the formal requirements for priority claims. At the examination stage, Sakpatenti will only examine whether all **formal requirements** are met.

The formal requirements are:

- priority claim filed together with the Trademark application or within one month from filing date of the application (corresponding field shall be ticked);
- number, date and country of the previous application;
- availability of official online sources to verify the priority data (DAS system), or submission of priority documents and translations.

11.1.1 Claiming priority

Priority may be claimed together with the Trademark application or in a separate communication filed within one month after filing date of the application.

The file number, together with the date and country, of the previous application must be indicated when claiming priority.

The claim may be implicit, such that the submission of the priority documents with the application or in a separate communication filed within one month after filing date of the application will be construed as a declaration of priority. Simple filing receipts containing the **country, number and date** of the earlier application(s) are accepted.

11.1.2 Priority documents

The documentation in support of the priority claim must be filed within 3 months of the filing date.

Certified copies are necessary if the priority document is not available through DAS system.

11.1.3 Language of previous application

Priority application may be submitted in the language of Sakpatenti of Origin. However, within 3 months after filing the application, the applicant shall submit certified translation of the priority application.

11.2 Substantive requirements for priority claims

The requirements that refer to the substance of the priority claims are covered by Article 11 of the Law and relate to the 6-month period, the condition of a first regular filing and triple identity (same owner, same mark and same goods and services).

The requirements under Article 11 will be examined at the formal examination stage.

11.2.1 Principle of first filing

The 'convention priority' right is a right limited in time, which is triggered by the first regular filing of a trademark. A regular national filing is any filing that is 'adequate to establish the date on which the application was filed in the country concerned, whatever the subsequent fate of the application' (Article 4A(3) Paris Convention). It may be claimed during the 6 months following the first filing, provided the country of first filing was a party to the Paris Convention or to the Agreement establishing the World Trade Organisation (WTO).

The previous application must be a first regular filing and cannot be of the same date as the Trademark application. Sakpatenti will therefore check that there was no priority claim made on the prior application(s).

Sakpatenti will also check that the Trademark application was filed no later than 6 months following the date of filing of the earlier application(s).

Where priority of more than one earlier application is claimed, the goods and/or services covered by each of those applications must be different in order for the principle of first filing to be met. For examples, please see paragraph 11.3.1.

11.2.2 Triple identity

Sakpatenti will check that the Trademark application and the priority documents contain the same mark, refer to the same applicant and have all relevant goods or services in common.

11.2.2.1 Identity of the marks

Sakpatenti follows practice of a number of trademark offices of the European Union concerning the identity of trademarks filed in black and white and/or greyscale as compared with those filed in colour. In particular, trademark filed in black and white and/or greyscale is, for the purposes of assessing priority, not identical to the same mark filed in colour unless the differences in colour or shades of grey are so insignificant that they could go unnoticed by the average consumer (19/01/2012, T-103/11, Justing, EU:T:2012:19, § 24; 20/02/2013, T-378/11, Medinet, EU:T:2013:83 & 09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199). **An insignificant difference between two marks is one that a reasonably observant consumer will perceive only upon examining the marks side by side.**

The principle described above applies to all cases where marks are compared for the purpose of priority claims. In relation to word marks, the mark applied for will in most cases be deemed to be the same as the earlier mark where there is a difference only in respect of typeface or where one mark is in upper case letters and the other in lower case. Furthermore, a difference in punctuation or the addition of a space separating two words will not usually prevent the marks from having identity (09/10/2012, R 797/2012-2, WATER JEL; 15/07/1998, R 10/1998-2, THINKPAD).

Sakpatenti will also check the mark type of the earlier application, because a different mark type may mean that the Trademark application is different from the earlier mark. For example, a figurative mark is not the same as a shape mark or a position mark. However, a word mark can be considered to be the same as a figurative mark if standard type is used in the figurative mark (see the examples in paragraph 11.3.2).

Regarding the kinds of marks (individual and collective) that can be indicated in an application and taking into account the disparities of national legislations, Sakpatenti will disregard a priority claim between different kinds of mark **only** where there is an incompatibility between the kinds of mark.

11.2.2.2 Identity of the goods and services

Sakpatenti will check that all goods or services of the Trademark application that are listed in the application are covered by the goods and services of the first filing.

11.2.2.3 Identity of the owner

Priority can be claimed by the applicant of the first application or its successor in title. In the latter case, the transfer must have taken place prior to the filing date of the Trademark application, and documentation to this effect must be submitted. The right of priority as such may be transferred independently of whether or not the first application as a whole is transferred. Priority can therefore be accepted even if the owners of the Trademark application and the earlier right are different, provided that evidence of the assignment of the priority right is produced; in this case, the execution date of the assignment must be prior to the filing date of the Trademark application.

Subsidiary or associated companies of the applicant are not considered to be the same as the trade mark applicant.

Where the applicant of the first application states that it has changed its name since the first filing, and files the Trademark application under its new name, the applicant is considered to be the same person.

For the distinction between a change of name and a transfer, see the Guidelines, Part E, Register Operations, Section 2, Trade marks as Objects of Property, Chapter 1, Transfer.

11.2.3 priority requirements not satisfied

If the priority claim does not satisfy any of the above formal or substantive requirements, the applicant will be invited to remedy the deficiencies within the time limit set by Sakpatenti. If the applicant fails to comply with the requirements of Sakpatenti, priority date will be established according to the filing date of the application with Sakpatenti.

11.3 Examples of priority claims

11.3.1 First filing

In the example below, the priority claim of more than one earlier application is acceptable because the goods covered by each of those earlier applications are different and therefore the principle of first filing is met.

First filing	Country	Goods/services	TM filed	Goods/services
6 April	Italy	Perfumes	11 September	Perfumes, bags, clothing
9 May	Germany	Bags		
23 May	Spain	Clothing		

In the example below, the two earlier trademark applications were filed for exactly the same goods. The priority claim based on the Greek application has to be rejected since the trademark was applied for in Spain first; thus the Greek application is no longer a first filing.

First filing	Country	Goods/services	TM filed	Goods/services
6 April	Spain	Cheese, wine	4 October	Cheese, wine
7 April	Greece	Cheese, wine		







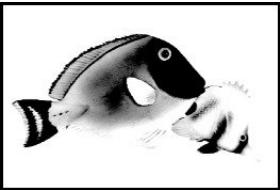
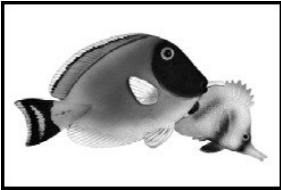


In the example below, priority cannot be claimed from a first filing in Somalia, since Somalia is not a party to the Paris Convention or the World Trade Organisation. Therefore, the first filing in Italy is the one considered for the priority claim; the other filing cannot be taken into consideration.









First filing	Country	Goods/services	TM filed	Goods/services
5 April	Somalia	Cars, T-shirts	2 October	Cars, T-shirts
7 July	Italy	Cars, T-shirts		

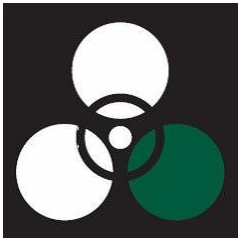



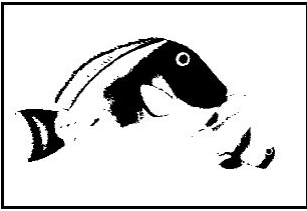
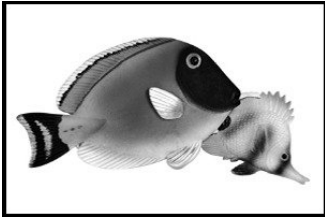
11.3.2 Comparison of the marks

The examples below cover acceptable and unacceptable priority claims for formalities' purposes where the identity of the marks is assessed. As explained under paragraph 11.2.2.1, only 'insignificant differences' between the Trademark application and the mark invoked under the priority claim will be accepted, that is to say, differences that are not considered to alter the meaning, pronunciation and visual impact of the marks.

Examples of signs considered identical

<p>Trademark application (word mark)</p> <p>EVAL</p>	<p>Priority claim (word mark)</p> <p>EVAL</p>
<p>Trademark application (word mark)</p> <p>Luna</p>	<p>Priority claim (word mark)</p> <p><i>Luna</i></p>
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 

Examples of non-identical signs	
<p>Trademark application (word mark)</p> <p>Chocolate Dream</p>	<p>Priority claim (word mark)</p> <p>Chocalate Dream</p>
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 







<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 
<p>Trademark application (figurative mark)</p> 	<p>Priority claim (figurative mark)</p> 

Further examples for word marks			
First trademark	Trademark application	Considered identical	Considered not identical
Word mark Percy & Reed	Word mark Percy + Reed		X
Word mark Percy & Reed	Word mark Percy and Reed		X
Word mark Percy & Reed	Word mark Percy & Reed	X	
Word mark Percy & Reed	Word mark Percy & REED	X	
Word mark Percy & Reed	Word mark PERCY & REED	X	

Word mark Percy & Reed	Word mark <i>Percy & Reed</i>	X	
Word mark POPEYE	Word mark POPeYe	X	
Word mark POPEYE	Word mark PopEye	X	
Word mark POPEYE	Word mark POP-EYE	X	
Word mark POPEYE	Word mark POP EYE	X	
Word mark POPEYE®	Word mark POPEYE	X*	
Word mark POPEYE	Word mark POPEYE!?		X
Word mark POPEYE	Word mark POPEYES		X
Word mark POPEYE	Word mark POPEYE·	X	
Word mark JOSÉ RAMÓN	Word mark JOSE RAMON	X	
Word mark SKAL	Word mark SKÅL		X
*The symbols TM and [®] are not considered as parts of the mark.			

Examples for identity between figurative signs as compared to word marks			
First trademark	Trademark application	Considered identical	Considered not identical
Word mark Percy & Reed	Figurative mark Percy & Reed (figurative mark in standard type face)	X	

Word mark Percy & Reed	Figurative mark Percy & Reed (words distributed over several lines)		X
Word mark Percy & Reed	Figurative mark Percy & Reed (colour claim)		X

Further examples for figurative marks			
First trademark	Trademark application	considered identical	considered not identical
			X
			X
		X*	

11.3.3 Comparison of the goods and services

The first example below is the most usual situation: the prior application corresponds fully to the Trademark application.

First filing	Country	Goods and services	TM filed	TM goods and services
5 April	UK	<i>Hats, shoes</i>	1 October	<i>Hats, shoes</i>

In the next example, both priority claims can be accepted since application number XY 1234 is the first filing with respect to *cars* and application number XY 1235 is the first filing with regard to *airplanes*.

First filing	Country	JP application No	Goods and services	TM filed	TM goods and services
5 April	Japan	XY 1234	<i>Cars</i>	2 October	<i>Cars, airplanes</i>
5 April	Japan	XY 1235	<i>Airplanes</i>		

In the next example, the priority claim concerns hats and shoes, which are common to the first filing and the Trademark application. No priority will apply with respect to bags.



First filing	Country	Goods and services	TM filed	TM goods and services
5 April	USA	<i>Cars, hats, shoes</i>	1 October	<i>Hats, shoes, bags</i>

In the last example, priority is claimed for first filings in France, Canada and China. The Trademark application has been filed within 6 months of each of the first filings and the priority claims will be accepted, although the Canadian application does not constitute a first filing for hats (as hats appear in the French application, which was filed before the Canadian one). Comparing the dates and the lists of goods and services of the three priorities, the priority claims will be accepted.

First filing	Country	Goods and services	TM filed	TM goods and services
5 April	France	<i>Hats, shoes</i>	5 October	<i>Hats, shoes, cars, beer, wine, telecommunication services</i>
6 April	Canada	<i>Cars, hats, beer</i>		
7 April	China	<i>Wine, telecommunication services</i>		

11.3.4 Priority claims based on series marks

A series of trademarks refers to a number of trademarks that resemble each other in material details and differ only in terms of non-distinctive character. Whereas the Law does not allow for the filing of series marks, some national offices (e.g. the United Kingdom, Australia) do, and such a series of marks filed in one single application can contain numerous very similar marks. When the first filing consists of a series mark, two or more slightly different mark representations will be seen. The priority claim is acceptable with regard to the one reproduction that is identical to that of the mark applied for as an TM.

Examples of priority claims based on series marks		
First filing	TM	Priority claim acceptable
Series of marks 		Yes

Series of marks		
Café@Home		
CAFÉ@HOME	CAFÉ@HOME	Yes
Café@Home		
CAFÉ@HOME		

12. Exhibition Priority

Exhibition priority entails claiming as a priority date for the Trademark application the date on which the goods or services covered by the Trademark application were displayed at an officially recognised exhibition under the mark as filed. The applicant can claim exhibition priority within 6 months of the first display. Evidence of the display must be filed.

Like 'convention priority', exhibition priority can be claimed either in the application or subsequent to the filing of the Trademark application. The claim must include the name of the exhibition and the date of first display of the goods or services.

Within 3 months of the filing date of the application, the applicant must submit to Sakpatenti a certificate issued at the exhibition by the responsible authority. This certificate must state that the mark was in fact used for the goods or services, and indicate the opening date of the exhibition and, where the first public use did not coincide with the opening date of the exhibition, the date of first public use. The certificate must be accompanied by an identification of the actual use of the mark, duly certified by the authority.

~~Priority can only be granted where the application for a TM is filed within 6 months of the first display at an exhibition recognised for this purpose, namely a world exhibition within the meaning of the Convention Relating to International Exhibitions of 22/11/1928. These exhibitions are very rare and Article 33 TMR does not protect display at other, national, exhibitions. The exhibitions can be found on the website of the Paris *Bureau International des Expositions*: <http://www.bie-paris.org/site/en/>.~~

13. Amendments to the Trademark application

The applicant may at any time withdraw its Trademark application or restrict the list of goods and services covered by it. Other changes are only contemplated to correct certain mistakes.

Any change requested on the same day of filing of the Trademark application will be accepted.

This part of the Guidelines will only describe practice of Sakpatenti practice concerning amendments to the mark representation. For further details on withdrawal or restrictions, see the Guidelines, Part B, Examination, Section 1, Proceedings and, for restrictions specifically, the Guidelines, Part B, Examination, Section 3, Classification.

Once an application has been filed in colour, it is not possible to amend it to one that is not in colour.

13.1 Amendments to the representation of the mark

Sakpatenti's practice on amendments to the mark representation is very strict. The two conditions for allowing a change to a mark once filed are cumulative:

- the mistake must be obvious, and

- the amendment must not substantially change the mark as filed.

Even if the amendment is not a substantial one, if the mistake is not obvious, Sakpatenti will not accept the amendment.

In cases where the desired positioning of a mark is not obvious, the representation of the mark must indicate the correct position by adding the word 'top' to the reproduction of the sign. Where the application is filed by electronic means, unusual positioning may be indicated in the mark description.

In cases where the desired positioning of a mark is not obvious (e.g. a mark containing a verbal element is filed in a vertical position) and there is no indication of the intended positioning in the application, the applicant will be allowed to amend the position of the mark upon request. This is because the unusual positioning of the mark will be considered an obvious mistake.

If a priority claim is filed at the same time as the Trademark application, an obvious error may be proven by comparing the 'correct' mark in the claim with the mark on the Trademark application. However, if the priority claim is filed after the Trademark application, no evidence from these claims can be taken into account.



If the mistake is obvious, the mark must then be assessed according to the next criterion, namely whether the requested change substantially alters the mark as filed.

Example of accepted change of representation	
TM as filed - TOPFLOW	Proposed change – TOP FLOW
In the application form, the applicant claimed priority for the mark 'TOP FLOW', meaning that it was obvious that a typographical error had been made. The amendment was not considered to be a substantial alteration of the mark as the addition of a space between the words 'TOP' and 'FLOW' does not alter the meaning and pronunciation of the mark, and the visual impact of the amendment is low	

Examples of unacceptable amendments (for formalities' purposes)	
Mark filed as 'RANIER'	'RAINIER'
This change is not allowed as the correction shows the addition of another letter 'I', which would substantially change the mark as filed. 'RANIER' and 'RAINIER' are two different words.	
Mark filed as 'ELECTROLITIC BOLUS'	'ELECTROLITYC BOLUS'
This change is not allowed as the correct English spelling for this word is 'ELECTROLYTIC'. Consequently, the mark as filed had one erroneous letter whilst the amendment proposal would have two erroneous letters. This would substantially alter the mark and therefore is unacceptable.	

In the case of figurative elements, only elements of minor importance can be amended; this will be dealt with on a case-by-case basis. Giving a 'fresh look' to a figurative mark (which is a frequent practice in the industry in order to adapt the appearance of a figurative mark to current design and fashion trends from time to time) is not allowed.

Examples of unacceptable amendments (for formalities' purposes)
--

TM AS FILED	PROPOSED CHANGE
	
<p>The applicant filed a priority claim with the Trademark application, which showed that the first filing consisted of a single representation of the mark. In addition, the Trademark application contained a mark description that described the single representation and not the two images that had been filed. Therefore, the mistake was considered to be obvious. The amendment request was, however, rejected as the amendment would substantially change the mark from that which was filed.</p>	

Section 3 Classification

1. Introduction

Trademark protection is granted in relation to specific goods and/or services which determine the extent of protection afforded to the trademark proprietor. It is, therefore, essential to lay down rules for the indication and the classification of goods and services and to ensure legal certainty.

The indication of goods and services corresponds to one of the essential characteristics of a trademark (Article 3 of the **Law**). For a filing date to be accorded, every Trademark application must contain a list of goods and services.

The list of goods and services for which protection is sought must be (a) identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators to determine the extent of the protection sought and (b) grouped according to the classes of the Nice Classification.

The list of goods and services may be restricted or amended by the applicant in the application, provided that the restriction or amendment does not extend the list of goods and services. After registration the trademark may be surrendered in respect of some of the goods and services.

Use of Sakpatenti's administrative IT tools for classification (see paragraph 3) is highly recommended. Any part of the list of goods and services that does not match the data from the tools will be examined following the principles set out in these Guidelines. Whenever the applicant selects a term from the available tools, it will not be examined any further, thus speeding up the registration procedure.

The purpose of this Section of the Guidelines is to describe Sakpatenti's practice in examining the classification of goods and services.

The first part (paragraphs 1 to 4) sets out the principles applied by Sakpatenti. The second part (paragraph 5) summarizes the procedure for examining the list of goods and services. In short, when examining the classification of a list of goods and services, Sakpatenti will carry out four tasks:

- checking that each of the goods and services is sufficiently clear and precise;
- checking that each term belongs to the class in which it is listed;
- notifying any deficiency;
- refusing the application, in whole or in part, where the deficiency is not remedied.

2. The Nice Classification

Goods and services in respect of which trademark registration is applied for are classified in accordance with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (the Nice Classification). The Nice Classification is administered by the World Intellectual Property Organization (WIPO).

Goods and services are organised in classes to facilitate pre-clearance searches before filing an application to avoid conflict, to allow surveillance searches and in order to monitor possible competition. In addition, the classes are taken into account to calculate class fees.

As a system aimed at reflecting market needs, the Nice Classification is updated on a regular basis. Minor improvements are published every year in versions of the current edition, while significant changes are incorporated in a new edition every 5 years.

The version of the classification under the Nice Agreement in force at the filing date will be applied to the classification of the goods or services in an application. According to the practice of Sakpatenti every list of goods and services has to:

- be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators to determine the extent of the protection sought;
- be arranged according to the Nice Classification, with each group preceded by the number of the class to which the goods or services belong, and presented in the order of the classes.

The Nice Classification contains guidance for classification.

1. **Class Headings** — these exist for each class and indicate in a general manner the fields to which, in principle, the goods or services belong.
2. **Explanatory Notes** — these exist for each class and clarify, in a more abstract manner, the criteria of which type or examples of goods or services are included, or not included, in the class.
3. **Alphabetical List** — this may be consulted in order to ascertain the exact classification of individual goods or services by analogy.
4. **General Remarks** — placed at the beginning of the Nice Classification, these are a short collection of basic principles explaining what criteria should be applied if a term cannot be classified in accordance with the Class Headings or Alphabetical List.

More information regarding the Nice Classification can be found on WIPO's website at: <http://www.wipo.int>.

3. Other Administrative Tools for Classification Purposes

When filing an electronic application, users can select preapproved terms to build their list of goods and services. These terms originate from the Harmonised Database (HDB) and will automatically be accepted for classification purposes. Using these preapproved terms will facilitate a smoother trademark registration process. The HDB brings together terms that are accepted for classification purposes by Sakpatenti.

Should the applicant use a list of goods and services that has terms not found in the HDB, Sakpatenti will have to examine whether they can be accepted.

Before filing an application, users can search the content of the HDB using the EUIPO TMclass tool [here](#). This tool brings together classification databases of participating offices both within and outside the EU and shows whether a term is accepted by Sakpatenti. TMclass groups goods and services according to shared characteristics from a market perspective, starting from the more general and ending with the more specific. This offers users a simplified search and a better overview of the content of each class, thus facilitating the selection of

appropriate terms. This grouping and ranking, also called taxonomy, has no legal effect, since the scope of protection of trade marks is always defined by the natural and usual meaning of the terms chosen, not by their position in the hierarchical structure of Sakpatenti's taxonomy.

4. Building a List of Goods and Services

4.1 Choosing adequate scope of protection

The essential function of the protection afforded by a trademark is to guarantee to the consumer an indication of origin of the goods or services, by enabling him or her, without any possibility of confusion, to distinguish the goods or services from others that have another origin.

Furthermore, the indication of goods and services may be restricted or surrendered at any time, but the initial scope of protection may never be broadened.

With that in mind, it is of crucial importance to carefully designate a list of goods and services that:

- not only covers the current interests in protection but takes into account also future possibilities, by indicating categories of goods or services the trademark proprietor might be likely to expand to,
- but also reduces potential conflict with other marks and minimises the risk of becoming vulnerable to attack, by avoiding an overly broad or unnecessarily long list of goods and services.

As far as services for which trademark protection can be sought are concerned, these are, in principle, generally offered independently to third parties and supplied for an economic consideration. Services connected with goods, such as the research and development of an undertaking's own products, do not constitute an external service for third parties. If a service is not provided to third parties, but is only an internal working of the undertaking, it would be redundant for it to be covered in the list of goods and services of the application (30/09/2016, T-355/15, ASTEX / ALPEX, EU:T:2016:591, § 37). The same applies to ancillary services such as the manufacture, sale or advertising of an undertaking's own products.

4.2 Clarity and precision

4.2.1 General principles

The goods and services for which protection of the trademark is sought must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of protection sought

An indication of goods and services is sufficiently clear and precise when its scope of protection can be understood from its natural and usual meaning.

'Natural and usual meaning' refers to the general definition of a term, in other words how the term is commonly understood. It will frequently be defined by a grammatical interpretation in the language in which the application is filed, by definitions given in the Nice Classification, by use in dictionaries and encyclopedias, and by the commercial language of traders.

The examination of the indication of goods and services as being clear and precise is independent of the examination as to absolute or relative grounds.

4.2.2 Influence of classification on the scope of protection

A correct classification should in principle be enough to allow for an unambiguous scope of protection. A particular term may be part of the description of goods and services in different

classes, but equally it may be clear and precise in a particular class without further specification. In this case its natural and usual meaning and the class number will leave no doubt as to the scope of protection.

For example, the natural and usual meaning of the term *clothing* is garments for humans with the purpose of covering the body for normal use. Therefore, this term would leave no doubt as to the scope of protection if applied for in Class 25 (see the Explanatory Note for Class 25).

If the scope of protection cannot be understood, sufficient clarity and precision may be achieved by further identifying factors such as characteristics, purpose and/or identifiable market sector². Elements that could help to identify the market sector may be, but are not limited to, the following:

- consumers and/or sales channels;
- skills and know-how to be used/produced;
- technical capabilities to be used/produced.

If protection is sought for a specialised category of goods and services or a specialised market sector belonging to a different class, further specification of the term may be necessary.

For example:

clothing for protection against fire (Class 9);
clothing for operating rooms (Class 10);
clothing for pets (Class 18);
clothing for dolls (Class 28).

From these examples it is obvious that the term *clothing* can be interpreted in various ways but must always be defined by purpose or market sector pertaining to a particular Nice class. In addition, it shows that *clothing* in Class 25 would **not** cover any of the categories of goods mentioned above.

In principle, Sakpatenti understands the class number as being indicative of the characteristics of the goods or services, such as the predominant material, the main purpose or the relevant market sector, considering the natural and usual meaning of each term at the same time. Each term is assessed in the context of the class in which it is applied for (25/01/2018, T-367/16, H HOLY HAFERL HAFERL SHOE COUTURE (fig.) / HOLY et al., EU:T:2018:28, § 50; 19/06/2018, T-89/17, NOVUS / NOVUS (fig.) et al., EU:T:2018:353, § 32-33).

Tools such as TMclass are available for determining whether the particular category of goods and services needs further specification or not.

4.2.3 Use of expressions (e.g. 'namely', 'in particular') to determine the scope of the list of goods/services

The use of the words 'namely' or 'being' is acceptable but must be understood as a restriction to the specific goods and services listed thereafter (04/10/2016, T-549/14, Castello / Castellò (fig.) et al., EU:T:2016:594, § 71). For example, *pharmaceutical preparations, namely analgesics* in Class 5 means that the application only covers analgesics and not any other type of pharmaceuticals.

The expression 'in particular' can also be accepted as it serves to indicate an example of the goods and services applied for. For example, *pharmaceutical preparations, in particular*

² Market sector describes a set of businesses that are buying and selling such similar goods and services that they are in direct competition with each other.

analgesics means that the application covers any kind of pharmaceuticals, with *analgesics* being an example.

The same interpretation applies to use of the terms ‘including’, ‘including (but not limited to)’, ‘especially’ or ‘mainly’, as in the example *pharmaceutical preparations, including analgesics*.

A term that would normally be considered unclear or imprecise can be made acceptable by making it more specific, for example, by using ‘namely’ and a list of acceptable terms. Examples include *goods of common metal, namely, screws* for goods in Class 6 and *goods of precious metals, namely bracelets* for goods in Class 14.

The HDB does not currently support use of the terms ‘namely’ or ‘in particular’. Therefore, if these terms are used in the list of goods and services, the classification will not be accepted automatically but will require verification, which may slow down the examination procedure.

Examples of acceptable use

Class 29: <i>Dairy products namely cheese and butter</i>	‘Namely’ restricts the goods to cheese and butter, excluding all other dairy products.
Class 41: <i>Provision of sports facilities, all being outdoors</i>	This restricts the services to the provision of outdoor sports facilities, excluding the provision of any indoor sports facilities.
Class 25: <i>Clothing, all being underwear</i>	The goods are restricted to those considered underwear, excluding all other types of clothing.

Specifications using ‘namely’ or ‘being’ in a manner that does not comply with the requirements of clarity and precision (e.g. *dairy products, namely peanut butter*) jeopardise the scope of protection and will therefore be objected to, and might eventually lead to a refusal of the same.

Examples of non-restrictive use

Other words or phrases may only point out that certain goods/services are important, and the inclusion of the term does not restrict the list in any way.

Class 29: <i>Dairy products, in particular cheese and butter</i>	This includes all dairy products; cheese and butter are probably the focus of the trade mark owner’s operation, but not the only goods produced.
Class 41: <i>Provision of sports facilities, for example outdoor running tracks</i>	The coverage merely gives an example of one of several possibilities.
Class 25: <i>Clothing, including underwear</i>	The coverage extends to all clothing and not just underwear.

Specifications using ‘in particular’, ‘such as’, ‘for example’ or ‘including’ in a manner that does not comply with the requirements of clarity and precision (e.g. *dairy products, in*

particular peanut butter) jeopardise the scope of protection, and will therefore be objected to, and might eventually lead to a refusal of the same.

For the correct use of restrictive wordings (e.g. 'excluding', 'except') please refer to the examples listed in paragraph 5.3.2.

4.2.4 Use of the term 'and/or'

The use of oblique strokes is acceptable in lists of goods and services; the most common example is in the phrase '*and/or*', meaning that both goods or services referred to are covered.

Examples

- Chemical/biochemical products
- Chemical and/or biochemical products
- Chemicals for use in industry/science
- Chemicals for use in industry and/or science
- Import/export agency services.

4.2.5 Punctuation

The use of correct punctuation is very important in a list of goods and services — almost as important as the words.

The use of commas may serve to separate enumerated items within a broader category or expression. For example, *flour and preparations made from cereals, bread, pastry and confectionery* in Class 30 means that the goods can be or are made from any of those materials, thus also including the rather nonsensical *preparations made from confectionery*. If the meaning of the part of the term after *preparations made from cereals* is nonsensical, the use of a comma after it is inappropriate, and a semicolon should be used instead.

The use of a semicolon means a separation between expressions. For example, *flour and preparations made from cereals; bread, pastry and confectionery* in Class 30. In this example, the terms *bread, pastry and confectionery* must be interpreted as being independent from the other terms and not as being included in *preparations made from bread, pastry and confectionery*.

The separation of terms with incorrect punctuation can lead to changes in meaning and incorrect classification.

Take the example of *computer software for use with textile machinery; agricultural machines* in Class 9. In this list of goods and services, the inclusion of a semicolon means that the term *agricultural machines* must be considered as an independent category of goods. However, *agricultural machines* are proper to Class 7. The term would have to be objected to by proposing the correct classification.

A further example would be *retail services in relation to clothing; footwear; headgear* in Class 35. The use of a semicolon means that the terms *footwear* and *headgear* refer to separate goods, not included in the retail services. In service classes, the goods listed in relation to the services for which protection is sought should always be separated by commas.

A colon can be used in a list of goods and services to explain or start an enumeration. In an enumeration following a colon, terms should be separated by a comma. An example in Class 9 is *Software for: computers, mobile phones, tablets*.

An expression between brackets is in most cases intended to define more precisely the text preceding the brackets where the latter is ambiguous.

4.2.6 Inclusion of abbreviations and acronyms in lists of goods and services

Abbreviations and acronyms within lists of goods and services should be accepted with caution. Trademarks could have an indefinite life, and the interpretation of an abbreviation could vary over time. However, provided that an abbreviation has only one meaning in relation to the class of goods or services applied for, it can be allowed. The very well-known examples *CD-ROMs* and *DVDs* are acceptable in Class 9. If the abbreviation is well known in the field of activity it will be acceptable. To this end, examiners will carry out an internet search in order to determine whether the abbreviation needs to be expanded into words.

Example

Class 9: *EPROM cards*. This could be expanded to:

Class 9: *Erasable programmable read-only memory cards*. or

Class 9: *EPROM [erasable programmable read-only memory] cards*.

4.3 Terms lacking clarity and precision

4.3.1 General indications of Nice Classification class headings lacking clarity and precision

General indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision.

~~For the sake of completeness, it is noted that, in accordance with Article 00 of the Law, the use of general terms, including general indications of the class headings of the Nice Classification, will be interpreted as including all goods or services clearly covered by the literal meaning of the indication or term within the context of the class in which it is applied for³. The use of such terms or indications will not be interpreted as comprising a claim to goods or services that cannot be understood in this way.~~

~~In collaboration with EUIPO, other (inter)national organizations, offices and various user associations, Sakpatenti has established a list of general indications of Nice Classification class headings that are deemed not to be sufficiently clear and precise in accordance with Article 00 of the Law.~~

Following 11 general indications of the Nice class headings were not found clear and precise:

Class 6: ***Goods of common metal not included in other classes***.

In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, and could target different consumers, be sold through different sales channels and therefore relate to different market sectors.

Class 7: ***Machines and machine tools***

In light of the need for clarity and precision, the term *machines* does not provide a clear indication of what machines are covered. Machines can have different characteristics or different purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, and could target different consumers, be sold through different sales channels and therefore relate to different market sectors.

Class 14: ***Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes***

³ Sakpatenti's former practice, according to which use of all the general indications listed in the class heading of a particular class constituted a claim to all goods or services falling under the class was abandoned in 0000.

In light of the need for clarity and precision, the term *goods in precious metals or coated therewith, not included in other classes* does not provide a clear indication of what goods are covered, as it simply states what the goods are made of or coated with, and not what the goods are. It covers a wide range of goods that may have very different characteristics, may require very different levels of technical capabilities and know-how to be produced, and could target different consumers, be sold through different sales channels and therefore relate to different market sectors.

Class 16: Paper, cardboard and *goods made from these materials, not included in other classes*

In light of the need for clarity and precision, the term *goods made from these materials [paper and cardboard], not included in other classes* does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, and could target different consumers, be sold through different sales channels and therefore relate to different market sectors.

Class 17: Rubber, gutta-percha, gum, asbestos, mica and *goods made from these materials and not included in other classes*

In light of the need for clarity and precision, the term *goods made from these materials [rubber, gutta-percha, gum, asbestos and mica] and not included in other classes* does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, and could target different consumers, be sold through different sales channels and therefore relate to different market sectors.

Class 18: Leather and imitations of leather, and *goods made of these materials and not included in other classes*

In light of the need for clarity and precision, the term *goods made of these materials [leather and imitations of leather] and not included in other classes* does not provide a clear indication of what goods are covered, as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, and could target different consumers, be sold through different sales channels and therefore relate to different market sectors.

Class 20: *Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics*

In light of the need for clarity and precision, this term does not provide a clear indication of what goods are covered as it simply states what the goods are made of, and not what the goods are. It covers a wide range of goods that may have very different characteristics and/or purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, and could target different consumers, be sold through different sales channels and therefore relate to different market sectors.

Class 37: *Repair*

In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are repair services, and not what is to be repaired. As the goods to be repaired may have different characteristics, the repair services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.

Class 37: *Installation services*

In light of the need for clarity and precision, this term does not provide a clear indication of the services being provided, as it simply states that these are installation services, without stating what is to be installed. As the goods to be installed may have different characteristics, the installation services will be carried out by service providers with different levels of technical capabilities and know-how, and may relate to different market sectors.

Class 40: *Treatment of materials*

In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. The nature of the treatment is unclear, as are the materials to be treated. These services cover a wide range of activities performed by different service providers on materials of different characteristics, requiring very different levels of technical capabilities and know-how, and may relate to different market sectors.

Class 45: *Personal and social services rendered by others to meet the needs of individuals*

In light of the need for clarity and precision, this term does not give a clear indication of the services being provided. These services cover a wide range of activities performed by different service providers requiring very different levels of skill and know-how, and may relate to different market sectors.

Six general indications were deleted from the class headings of the 2016 version of the 10th edition of the Nice Classification. The indications in question are set out below in bold:

Class 7: ***Machines and machine tools***

Class 37: ***Installation and repair services***

Class 40: ***Treatment of materials***

Class 45: ***Personal and social services rendered by others to meet the needs of individuals.***

Trademark applications that include any of the abovementioned general indications contained in the current or earlier versions or editions of the Nice Classification will be objected to as lacking clarity and precision. The applicant will be asked to make the unacceptable term more specific.

Unacceptable general indications mentioned above can be made clear and precise if the applicant follows the principles set out under paragraph 4.1. The following is a non- exhaustive list of acceptable specifications.

Not a clear and precise term	Example of a clear and precise term
Goods of common metal not included in other classes (Class 6)	Construction elements of metal (Class 6) Building materials of metal (Class 6)
Machines (Class 7)	<u>Agriculturalmachines</u> (Class 7) Machines for processing plastics (Class 7) Milking machines (Class 7)
Goods in precious metals or coated therewith (Class 14)	Works of art of precious metal (Class 14)
Goods made from paper and cardboard (Class 16)	Filtering materials of paper (Class 16)

Goods made from rubber, gutta-percha, gum, asbestos and mica (Class 17)	Rings of rubber (Class 17)
Goods made of these materials [leather and imitations of leather] (Class 18)	Leather straps (Class 18)
Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics (Class 20)	<u>Door fittings, made of plastics</u> (Class 20) Figurines of wood (Class 20)
Repair (Class 37)	Shoe repair (Class 37) Repair of computer hardware (Class 37)
Installation services (Class 37)	<u>Installation of doors and windows</u> (Class 37) Installation of burglar alarms (Class 37)
Treatment of materials (Class 40)	Treatment of toxic waste (Class 40) Air purification (Class 40)
Personal and social services rendered by others to meet the needs of individuals (Class 45)	Personal background investigations (Class 45) Personal shopping for others (Class 45) Adoption agency services (Class 45)

Unclear or general indications of services used in combination with unclear and general indications of goods may be acceptable if a market sector or a specific skill needed to provide such services is clearly distinguished. For example, the *repair of leather goods* would be considered sufficiently clear and precise, as the professionals carrying out those repairs would mostly be cobblers, regardless of further characteristics of the goods. The practice regarding retail services in connection with goods that are considered unclear and imprecise is explained further in the Annex, in 6.57 Retail and wholesale services. Note that terms lacking clarity and precision cannot be made specific, or acceptable, by the addition of such terms as 'including', 'in particular', 'for example', 'featuring' or 'such as', as well as 'included in this class' or 'not included in other classes'. The example *machines, including milking machines* would not be acceptable as it remains unclear and imprecise (see paragraph 4.2.3).

4.3.2 Other terms lacking clarity and precision

The same principles regarding clarity and precision as described under paragraph 4.2 are applicable to all the goods and services listed in an application. Terms that do not provide a clear indication of the goods or services covered should be objected to.

Examples

- Merchandising articles
- Fair-trade goods
- Lifestyle accessories
- Gift articles
- Souvenirs
- Collectors' articles
- Housewares

- Electronic goods⁴
- Gadgets (electronic or not)
- Hobby articles
- Advertising articles
- Memorabilia
- Wellness goods
- Association services
- Facilities management services.

All of these must be made more specific as described above, that is to say, by identifying factors such as characteristics, purpose and/or identifiable market sector.

It should be noted that the means by which a service is provided usually does not render a term sufficiently clear and precise. For classification purposes it is mostly irrelevant whether a service is provided online, on the telephone, by means of a catalogue, in a physical shop, or on-site in person.

More examples can be found in the Annex.

4.3.3 The claim for all goods/services in a class or all goods/services of the alphabetical list in a class

If applicants intend to protect all goods or services included in the alphabetical list of a particular class, they must indicate this by listing these goods or services explicitly and individually. Sakpatenti provides tools and functionalities, such as TMclass, to guide applicants through the search for goods and services by providing them with suggestions for acceptable goods or services or by starting from the more general terms and ending with the more specific. Use of the TMclass hierarchical structure for guidance and search purposes is encouraged (see paragraph 3).

Applications are sometimes filed with terms such as 'all goods in Class X', 'all services in Class X', 'all goods/services in Class X', 'all goods/services of the alphabetical list in Class X', either on their own, or together with an acceptable list of goods/services. These terms do not constitute a valid claim within the meaning of Article 9 of the Law and article 3 of the Instruction because they lack sufficient clarity and precision to determine the extent of the protection sought. Sakpatenti will invite the applicant to provide acceptable terms within a time limit set to that effect. Failure to do so will result in the application being rejected for such unclear and imprecise terms. It may proceed **only** for the acceptable part of the goods/services.

On other occasions, applications are filed merely stating the class number. This does not comply with Article 9 of the Law and article 3 of the Instruction, whereby a list of the goods or services for which the registration is requested must be given. Consequently, in these cases, in the absence of a list of goods or services in respect of which registration is sought, no filing date will be accorded pursuant to 10 of the Law. Sakpatenti will invite the applicant to remedy the deficiency with an objection on formalities. If the deficiency is remedied within the given time limit, the filing date will become the date on which a list of goods and services has been provided. See the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 4.1.

4.3.4 Reference to other classes within the list

References to other class numbers within a class are not acceptable for classification purposes. For example, the indications (in Class 39) *transport services of all goods in Classes 32 and 33* or (in Class 9) *computer software in the field of services in Classes 41 and 45* are

⁴ (01/12/2016, T-775/15, Ferli, EU:T:2016:699), electric/electronic apparatus/instruments

not acceptable as in both cases the terms are considered to be unclear and imprecise and lack legal certainty as to what goods and services are covered. The only way to overcome the objection to these lists of goods and services is for the respective goods of Classes 32 and 33, and services of Classes 41 and 45 to be specified in more detail.

The term 'goods not included in other classes' is not acceptable in-service classes because this expression only makes sense in its original goods class.

For example, *transport services of plastic materials for packaging (not included in other classes)* in Class 39 could not be accepted. The mention of *(not included in other classes)* must be deleted so that the term reads *transport services of plastic materials for packaging*.

4.3.5 Trademarks in lists of goods/services

Trademarks may not be used as generic terms or categories of goods. Therefore, they will not be accepted as goods or services per se.

Example

Class 9: *Electronic devices for transmission of sound and images; video players; CD players; iPods.*

Since iPod™ is a trademark, the applicant will be requested to replace it by a synonym such as *a small portable digital audio player for storing data in a variety of formats including MP3*.

Other examples are Caterpillar™ (the correct classification would be *crawler type vehicle*), Discman™ (*portable compact disc player*), Band-Aid™ (*sticking plasters*), Blu-Ray discs™ (*optical storage discs with enhanced capacity*) or Teflon™ (*non-stick coating based on polytetrafluoroethylene*). This list is not exhaustive and, if in doubt, examiners should refer cases to a relevant expert within Sakpatenti. If third parties are concerned about the generic use of a registered trademark within a list of goods and services of an application, they may file observations to that effect.

Sakpatenti will object to the inclusion of such terms and request that they are replaced by a generic term for the goods or services in question.

4.3.6 Inclusion of the terms parts and fittings; components and accessories in lists of goods and services

The terms *parts and fittings; components and accessories* are, on their own or in combination with each other, neither clear nor precise. Accordingly, they cannot be classified properly. Each of the terms requires further qualification to become acceptable in its proper class. Such terms could be made acceptable by adding identifying factors such as characteristics, purpose and/or identifiable market sector. It should be noted that the protection afforded by such indications will be interpreted as being limited by the scope of the class. Parts and fittings, components or accessories not belonging to that class will not be understood as covered by such indications.

Examples of acceptable terms

- *Parts and fittings for land vehicles* is acceptable in Class 12;
- *Building components of wood* is acceptable in Class 19;
- *Musical accessories* is acceptable in Class 15.

In all cases the requirements of clarity and precision must also be met.

Adding the expression *parts and fittings for all the aforementioned goods* at the end of a list will be accepted as long as it can reasonably be applied to at least one of the goods in that class. In such a case, however, the parts and fittings will be considered to cover only the goods for which they can reasonably be pertinent. For example, if the wording of Class 9 reads *computers; mobile phones; software; parts and fittings for all the aforementioned goods*, then the parts and fittings can only concern *computers and mobiles phones*. As *software* relates to goods which are virtual, it is not seen as having *parts and fittings*.

Examples of what will not be accepted

- Class 5 — Pharmaceutical preparations; parts and fittings for all the aforementioned goods.
- Class 16 — Paper and cardboard; accessories for all the aforementioned goods.
- Class 29 — Meat, fish, poultry and game; components of all the aforementioned goods.

4.3.7 Use of indefinite qualifiers

The use of qualifiers such as 'the like', 'ancillary', 'associated goods', 'and related goods' or 'etc.' in a list of goods or services is unacceptable, since they do not comply with the requirements of clarity and precision (see paragraph 4.1).

4.3.8 Geographical Indications in lists of goods and services

Geographical indications (GIs) may not be used as generic terms. Therefore, they will not be accepted as goods per se. In order to avoid protected GIs contained in lists of goods and services being perceived as generic terms (as GIs identify goods that must comply with particular specifications), the generic use of such terms will be objected to, and it will be proposed to add GI-related references.

The wording that the Office recommends is "[GI name] (GI) [product covered by the GI]". Other limitations are, however, acceptable as long as the applicant clearly identifies the GI and the use thereof.

Unacceptable examples

Class 33: Tequila; champagne .

Since Tequila and Champagne are protected GIs, they must be indicated as such. The applicant will be requested to specify these as GIs and show the goods, namely, 'Tequila' (GI) agave spirit drinks; 'Champagne' (GI) wine.

5. Examination Procedure

5.1 Parallel applications

While Sakpatenti will always strive for consistency, the fact that a wrongly classified list of goods and services has previously been accepted does not have to lead to the same list being accepted in any subsequent applications.

5.2 Objections

Where Sakpatenti considers that there is a need to amend the list of goods and services according to legislation and its practice, it should, if possible, discuss the issue with the applicant and take comments and observations into account. Whenever reasonably possible, the examiner should propose a correct classification. If the applicant submits a long list of goods/services that is not grouped under class numbers or classified at all, then the examiner should simply object under article 14(5)(d) of the Instruction and ask the applicant to provide a correct list.

The applicant's response must, under no circumstances, extend the scope or range of the goods or services originally applied for.

Where the applicant has failed to identify any classes or has incorrectly identified the class(es) for the goods or services, further explanation of the scope of the application may extend the number of classes required to accommodate the list of goods and services. It does not automatically follow that the list itself has been extended.

Example

An application covering *beer, wine and tea* in Class 33 can be corrected to:

Class 30: *Tea*

Class 32: *Beer*

Class 33: *Wine*

Although there are now three classes covering the goods, the list of goods has not been extended.

When the applicant has correctly attributed a class number to a particular term, this limits the goods to those falling under that class.

For example, an application for *tea* in Class 30 may not be amended to *medicinal tea* in Class 5 as that would extend the goods beyond those applied for, taking into consideration the nature, purpose and method of use of the goods in question (23/01/2014, T-221/12, Sun fresh, EU:T:2014:25, § 31; appeal rejected 03/06/2015, C-142/14 P, SUN FRESH / SUNNY FRESH, EU:C:2015:371).

Where there is a need to amend the classification, Sakpatenti will send a reasoned communication pointing out the deficiencies detected in the list of goods and services. The applicant will be requested to amend the list and/or make it more specific; Sakpatenti may propose how the items should be classified and provide analogous examples from the HDB.

The objection should take into account the class applied for, and the class a term would otherwise belong to, if its natural and usual meaning can be determined.

Examples

- **Natural and usual meaning is clear, class number is obviously incorrect**

Where the applicant files for the term *shoes* in Class 3, he or she will be requested to transfer this term to Class 25, since the natural and usual meaning of this term would be coverings for human feet.

- **Natural and usual meaning is clear, however, the class number could give a different context**

Where the applicant files for the term *shoes* in Class 9, he or she should be asked to amend the classification in accordance with the natural and usual meaning (footwear belongs to Class 25) or to specify the nature or purpose of these goods (protective footwear). The applicant therefore has the following options:

either

- the term is specified to read protective shoes and remains in Class 9, since footwear for protection against accident or injury belongs to this class

Or

- the term shoes is transferred to Class 25, according to its natural and usual meaning.

It should be noted that only one of these options can be chosen:

- amending the term to properly reflect its nature or purpose in relation to the class originally applied for;
- transferring the term to the correct class according to its natural and usual meaning. It is not possible to choose both as this would widen the scope of the application.

- **Natural and usual meaning is unclear, no context given by class number**

If the applicant files for the term *robots* in Class 25, he or she should be asked to define the nature or purpose of these goods, as this is not clear from the natural and usual meaning nor the class applied for. In such a case, a further specification in all applicable classes can be accepted, for instance as:

Class 7: *Robotic cleaners for household purposes; industrial robots for shaping metal*

Class 9: *Humanoid robots with artificial intelligence; laboratory robots*

Class 10: *Surgical robots; nanorobots for medical purposes*

Class 28: *Toy robots; smart robot toys.*

As the original meaning of the term was unclear, and the class number gave no additional information, this is not considered a widening of the list of goods and services as the original scope could not be defined.

Any additional information applicable to a term that needs to be transferred to a different class should also be taken into account, not only in order to prevent a broadening of the original scope, but also to avoid narrowing it down. For example, if the original list of goods in Class 12 reads *cars; car radios; parts and fittings for all the aforementioned goods*, as *car radios* are proper to Class 9, the applicant will be requested to transfer the term to Class 9, even if Class 9 was not listed in the original application. However, wherever appropriate, such a transfer should also include the *parts and fittings for all the aforementioned goods*.

The list of goods should therefore be amended as follows:

Class 9: *Car radios; parts and fittings for all the aforementioned goods*

Class 12: *Cars; parts and fittings for all the aforementioned goods.*

For example, but this time for a service class, the original list of services in Class 43 could read *travel agency services for arranging the transportation of travellers; travel agency services for making hotel reservations; information, advice and consultancy in relation to all aforementioned services*. As *travel agency services for arranging the transportation of travellers* are proper to Class 39, the applicant will be requested to transfer the term to Class 39, even if Class 39 was not listed in the original application. However, this transfer should also include the *information, advice and consultancy in relation to all aforementioned services*.

The list of services should therefore be amended as follows:

Class 39: *Travel agency services for arranging the transportation of travellers; information, advice and consultancy in relation to all aforementioned services*

Class 43: *Travel agency services for making hotel reservations; information, advice and consultancy in relation to all aforementioned services.*

The initial time limit of 2 months allowed for remedying the deficiencies can only be extended once.

Sakpatenti will send a letter informing the applicant of the list of goods and services as accepted following the amendments.

If the applicant does not remedy the deficiency(ies), the application will be rejected for the goods or services for which an objection has been made.

5.3 Amendment and restriction of a list of goods and services

Article 8 of the Instruction allows for the restriction or amendment of an application before registration, provided that 'such a correction does not substantially change the trademark or extend the list of goods and services'.

Under Article 8 of the **Instruction**, the applicant may choose to **restrict** the list of goods and services in order to clarify the scope of protection, to overcome an objection under absolute grounds, to further specify unclear and imprecise indications, or to settle a dispute. The restriction can be affected by deleting a term, further specifying a broad term, or a subcategory of such a term, or excluding terms or subcategories of goods or services.

Amendments to the indication of goods and services before registration, under Article 8 of the **Instruction**, can also be seen as a fine-tuning of the list of goods and services, and therefore can change the wording without necessarily limiting the scope of the application or changing the nature of the goods and services. However, any such fine-tuning may never broaden the scope of the application.

Restrictions made post-registration, however, must comply with the requirements of Article 8 of the **Instruction**. Once the mark has been entered in the Register, changes to the list of goods and services can only seek to limit the scope of protection, and will be refused if no actual restriction is made. Under no circumstances may the change widen the list of goods and services.

5.3.1 Rules governing restrictions and amendments

A request for restriction or amendment of the list of goods and services in the context of Article 8 of the **Instruction** takes effect when it is received by Sakpatenti and is therefore **formally binding**. This means that the goods or services excluded through a restriction cannot be reinserted into the list of goods and services at a later stage. In order for a request for restriction to be withdrawn, a corresponding declaration must reach Sakpatenti on the same day the request for restriction was received. Withdrawal of a restriction received after this date will be dismissed.

Certain **general criteria** must be respected at all times for a restriction or amendment to be acceptable.

- The request must be **explicit**. The absence of a reply to an official notification will never be considered an explicit request for restriction. Where a restriction is required by Sakpatenti, silence on the part of the applicant can, however, lead to the refusal of the terms objected to, or, eventually, to the refusal of the application in its entirety.
- A list of goods and services should still be **clear and precise** after a restriction or amendment in order to comply with the requirements of Article 9 of the **Law** and Article 3 of the Instruction and must **not go against legal certainty**.

In any request for a restriction or amendment, the goods/services to be restricted or amended must be clearly indicated.

5.3.2 Wording of restrictions

A restriction should be understood as a clear limitation of the scope of protection.

A restriction can in principle follow one or several of the following approaches, provided they do not contradict each other.

1. **Deletion** of an existing term from the list.

2. **Specification** of a broader term in the list to specific goods or services covered by the broad term, or to one or several subcategories of this term.
3. **Exclusion** of specific goods or services from a broad term, or of one or more subcategories from such a term in the list.

Examples of valid restrictions (in Class 16):

1. **Deletion:** *newspapers; magazines; books* is restricted to read *newspapers; magazines*; the term *books* is completely deleted from the list.
2. **Specification:** *newspapers; magazines; books* is restricted to read *newspapers; magazines; books, namely dictionaries or newspapers; magazines; dictionaries; cookbooks*; the term *books* has been specified to cover only the narrow subcategory of books defined as *dictionaries*, or replaced by the subcategories *dictionaries* and *cookbooks*.
3. **Exclusion:** *newspapers; magazines; books* is restricted to read *newspapers; magazines; books, except dictionaries or newspapers; magazines; books, excluding dictionaries and cookbooks*; the coverage of the term *books* remains fairly broad while at the same time clearly excludes the subcategory of *dictionaries*, or both *dictionaries* and *cookbooks* (from the second wording).

Examples of **contradictory** restrictions (in Class 16), which should therefore be refused:

- *Newspapers; magazines; books* requested to read *newspapers; magazines; all the aforementioned goods except dictionaries or newspapers; magazines; all the aforementioned goods being dictionaries*; these restrictions cannot be accepted as, by excluding the broad category of *books*, the remaining goods to which the restrictions refer no longer contain the subcategory of *dictionaries*.
- *Newspapers; magazines; books, namely dictionaries* requested to read *newspapers; magazines; books, namely dictionaries; all the aforementioned goods except cookbooks*; this restriction cannot be granted as with the specification of the broader category of *books*, the remaining goods to which the restriction could refer, that is to say, *dictionaries*, or even *newspapers* and *magazines*, no longer contain the subcategory of *cookbooks* — or are not even considered to be *books* for that matter, as in the latter case of *newspapers* and *magazines*.

A restriction can result in the deletion of an entire class or, on the contrary, in entering a longer list of goods and services than what was originally applied for. *Newspapers; magazines; books* in Class 16 could, for instance, be restricted to read *newspapers; magazines; books, namely dictionaries, cookbooks, biographies, poetry, fairy tales and philosophy books*.

Furthermore, according to the criteria mentioned under paragraph 5.3.1, the following examples represent acceptable and unacceptable restriction scenarios:

- In order to be able to restrict them, the goods or services need to be **covered by the current list of goods and services** in the class applied for.

Examples of **acceptable** restrictions:

Class 16: *Books, namely dictionaries*;

Class 25: *Footwear, only being flip-flops*.

Examples of **unacceptable** restrictions concerning different classes:

Class 5: *Diagnostic preparations, all for scientific use*;

Class 7: *Milling machines, only for dental purposes*.

Although *diagnostic preparations* can be found both in Class 1 and Class 5, Class 5 would only cover those for medical or veterinary purposes. *Diagnostic preparations for scientific use* are proper to Class 1 and therefore cannot be included in Class 5.

Similarly, although *milling machines* could indeed also be used by dental technicians, such goods are not proper to Class 7 but to Class 10. Therefore, it is impossible to include them in Class 7, as they are not proper to that class.

Example of an **unacceptable** restriction within the same class:

Class 16: *Newspapers; magazines; books.*

Restriction request: Newspapers; magazines; books; all the aforementioned goods except pencils.

In this case, even if *pencils* were proper to the same class, the exclusion of a term that is clearly not covered by the original list of goods and services is nonsensical and will therefore be objected to.

Class 35: *Retailing and wholesaling of wine* (08/10/2014, R 727/2013-1, E-WINE (fig.) / iWine (fig.).

The inclusion of a term clearly not covered by the original list (even if the remaining terms are deleted) will be seen as an unacceptable **broadening of the original scope**, even if it is proper to the same class.

5.3.2.1 References to trademarks

Generic references to trademarks will be objected to. Example **of an unacceptable** restriction: Class 9: Apparatus for the reproduction of sound, namely iPods.

5.3.2.2 Territorial restrictions

Territorial amendments that do not change the scope of protection, for example, *clothing made in Vietnam*, may be acceptable. See also paragraph 5.3.3.1 Amendments with territorial references.

Restrictions concerning the **origin** of goods are, in principle, acceptable, and, under certain circumstances, such as in relation to protected geographical indications (PGIs), might even be necessary.

5.3.2.3 Ambiguity due to regulations

Restrictions that are **ambiguous** regarding the different national regulatory regimes will not be accepted.

Example of an **unacceptable** restriction:

Class 5: *Medicines, only on prescription.*

This example would be considered unacceptable as regulations may change in time and thus, scope of protection is not clear.

5.3.2.4 Clarity and precision

Restrictions must be **clear and precise**.

It should be clear which goods or services are excluded by the restriction and which will remain in the list of goods and services. Restrictions that appear completely nonsensical within the context of the current list of goods and services will not be allowed.

Examples of **unacceptable** nonsensical restrictions:

Class 16: *Typewriters, only related to financial services.*

Where there is no possibility that the proposed limited use can be assured on the market, or where the proposed remaining scope of protection is blurred by a limitation that cannot be

clearly linked to an existing or a potential market subcategory of the goods or services, Sakpatenti will raise an objection.

Example of an **unacceptable** restriction where the goods do **not possess such characteristics**:

Class 31: *Oranges, except smart oranges.*

The fresh fruit listed in the original indication will not cover any types of smart goods. Emphasizing this fact by submitting such a disclaimer will not add relevant information to the term, and therefore has no effect on the current scope of protection.

Examples of **unacceptable** restrictions where the **remaining scope of protection** cannot be exactly determined:

Class 7: *Machines, in particular bulldozers.*

An unclear and imprecise term is not clarified or specified by simply mentioning an example of what it could cover; the term *machines* lack clarity and precision, and merely giving examples of what this broad term may cover does not make it acceptable.

Using the expressions 'including', 'in particular', 'for example' or 'such as', as well as 'included in this class' or 'not included in other classes', **does not constitute a valid restriction** or specification of the preceding goods or services.

5.3.2.5 Subjectivity

Restrictions that involve **subjective characteristics** will not be accepted.

Examples of **unacceptable** restrictions:

Class 12: *Luxury cars*

Class 29: *Tasty fruit*

Class 33: *Expensive wine.*

5.3.2.6 Targeted public

Restrictions specifying or excluding a part of the public can only be accepted if they are **relevant** to the goods or services in question, and if the scope of protection remains **clear and precise**.

Examples of **acceptable** restrictions:

Class 25: *Clothing, except clothing for children*

Class 41: *Education for the visually impaired.*

Examples of **unacceptable** restrictions:

Class 28: *Roller skates, exclusively designed for surfers*

Class 45: *Legal services, not provided to hairdressers.*

5.3.2.7 Intended use or purpose

Restrictions asking to specify or exclude the intended use or purpose of the goods or services can only be accepted if they are **relevant** to the goods or services in question and change their nature, and if the scope of protection remains **clear and precise**.

Examples of **acceptable** restrictions:

Class 9: *Operating systems, except operating systems for mobile phones*

Class 39: *Collection of domestic waste for recycling purposes.*

Examples of **unacceptable** restrictions:

Class 16: *Books, only for use with lamps*

Class 42: *Scientific research services, not for the purpose of social networking.*

5.3.2.8 Restrictions specifying subject matter

Restrictions specifying or excluding subject matter can only be accepted if they are **relevant** to the goods or services in question and change their nature, and if the scope of protection remains **clear and precise**. This is in principle only possible for goods or services that can have content. Previous comments on the generic use of registered **trademarks** in the description of goods or services also apply.

Examples of **acceptable** restrictions:

Class 9: *CDs, recorded with music*

Class 9: *MP3 files, all containing jazz*

Class 16: *Printed comics, all related to science fiction*

Class 41: *Entertainment conventions, relating to role-playing games*

Class 41: *Musical concert services for the music of Beethoven.*

5.3.3 Wording of amendments

An amendment is seen as a means to exemplify some goods or services, without changing the scope of protection or affecting the nature of the goods or services.

An amendment can follow one or several of the following approaches, provided they do not contradict each other:

1. **exemplifying items already covered** by the current scope;
2. **removal of items still covered** by the remaining scope;
3. **specification** of a **characteristic**;
4. **exclusion** of a **characteristic**.

Examples of valid amendments (in Class 30):

1. **Inclusion of items already covered:** *Sweets, in particular flavoured with strawberry and apricot flavour*. Since the scope of protection is *sweets* in general, highlighting possible characteristics by introducing some examples does not change the initial scope of protection.

2. **Removal of items still covered:** *Sweets, ~~in particular flavoured with strawberry~~*.

Despite deleting the example from the wording, it will implicitly remain covered by the broader term – the scope of protection remains the same.

3. **Specification:** *Sweets flavoured with strawberry*. Since strawberry-flavoured sweets are not a recognizable subcategory of confectionery nor a specific market sector, and since the description of the characteristics of sweets will not change the nature of these goods, the specification will be understood as an amendment.

4. **Exclusion:** *Sweets, not flavoured with strawberry*. Similarly, since strawberry- flavoured sweets are not a recognisable subcategory of confectionery nor a specific market sector, and since excluding some characteristics of sweets will not change the nature of these goods, the exclusion will be understood as an amendment.

An amendment must be **clear and precise** in order to be acceptable.

If excluding specific characteristics does not allow the scope of protection of the remaining goods or services to be understood with clarity and precision, the exclusion must be rejected. Amendments specifying subcategories that may not be contained within the relevant class will be dealt with as follows.

Examples of **acceptable** amendments:

Class 5: *Diagnostic preparations, except for scientific use*.

Although *diagnostic preparations* can be found both in Class 1 and Class 5, Class 5 would only cover those for medical or veterinary purposes. *Diagnostic preparations for scientific use*

would be proper to Class 1. The exclusion of the subcategory only clarifies the scope of the goods in Class 5. Even if this would not be a restriction, as it does not change the scope of protection, it can be accepted as an amendment as it exemplifies what is not covered.

Class 7: Milling machines, except for dental purposes.

Similarly, although *milling machines* could indeed also be used by dental technicians, such goods would not be proper to Class 7 but instead would be proper to Class 10. The exclusion of the subcategory only clarifies the scope of the goods in Class 7. Even if this would not be a restriction, as it does not change the scope of protection, it can be accepted as an amendment as it exemplifies what is not covered.

Example of an **unacceptable** exclusion:

Class 35: *Services of direct-mail campaigns and the issue of postage stamps provided they are not connected with a post office.* Sakpatenti does not allow the remaining goods and services to be understood with clarity and precision (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 18, 115).

5.3.3.1 Amendments with territorial references

Amendments relating to the **origin** of goods are, in principle, acceptable.

Example of an **acceptable** amendment indicating origin:

Class 25: *Clothing made in Vietnam.*

Such amendments are acceptable from the perspective of the examination of classification, as they do not broaden the scope of protection. However, the application may become subject to other objections (e.g. under Article 4(1)(h) of the **Law**).

5.3.3.2 Amendments specifying theme

Amendments specifying or excluding theme can only be accepted if they are **relevant** to the goods or services in question, and if the scope of protection remains **clear and precise**. This is in principle only possible for goods or services which do not have content. See also paragraph 5.3.2.8 Restrictions specifying subject matter.

Examples of **acceptable** amendments:

Class 25: *T-shirts, bearing the image of Marilyn Monroe*

Class 16: *Pen cases with pictures of cartoon characters*

Class 21: *Mugs, showing pictures of Paris.*

5.3.4 Influence of punctuation on restrictions and amendments

Punctuation also plays an important role in determining the scope of a restriction or amendment, as explained in paragraph 4.2.5. This is especially important in connection with formulations such as ‘*all the aforementioned goods except for use in connection with [...]*’ or ‘*the aforementioned services exclusively related to [...]*’:

- Thus, a restriction in Class 9 reading *operating systems; text processing applications; games software; all the aforementioned goods for the sole use with tablet computers* will be interpreted as intending to **limit all these goods, equally due to the use of a semicolon** separating the specification from the rest of the list.
- However, a restriction in Class 9 reading *operating systems; text processing applications; games software, all the aforementioned goods for the sole use with tablet computers* will be interpreted as limiting only the use of games software, since, if **separated with a comma, the specification merely involves the last preceding term** delimited by a semicolon.

A request to add ‘*all the aforementioned goods, excluding [...]*’ or ‘*all the previously mentioned services, only with regard to [...]*’ at the end of the specification within a class and separated by a semicolon will be interpreted as referring only to those preceding goods or services to which such an exclusion can reasonably apply, and will therefore be accepted as long as it can reasonably be applied to at least one good or service it refers to in that class. At the same time the criteria mentioned under paragraph 5.3.1 need to be observed.

5.4. Addition of Classes

It is possible to add a class or classes to an application, but only where the goods or services detailed in the original application were clearly included in the wrong class or when the goods or services have been clarified and need to be classified in other class(es).

For example, the original list of goods in Class 33 reads *alcoholic beverages including beer, wines and spirits*.

Since *beer [alcoholic beverages]* is proper to Class 32, the applicant will be requested to transfer the term to Class 32, even if Class 32 was not listed in the original application. If the applicant agrees, the application will then cover the said goods in Classes 32 and 33.

When transferring a term from one class to another, the scope of protection originally applied for, defined by additional information, also needs to be taken into account. In the example above, the simple addition of the term *beer* to Class 32 would in fact mean an unacceptable broadening of the original scope of protection, since the application only includes *alcoholic beverages*. As such, the term *beer* in Class 32 would, however, also cover *non-alcoholic beer*, thus going beyond the original scope of protection. Therefore, to illustrate the principle, the term to be transferred to Class 32 should specifically read *beer [alcoholic beverages]*.

When classes are added, additional fees may be payable and the applicant must be informed accordingly.

6 Annex

6.1 Introduction

When classifying goods and services, the general principles of the Nice Classification must be applied.

The purpose of this Annex is to clarify the classification of certain problematic terms. It also provides notes on classification practice (including words or phrases that should not be used). Sakpatenti's classification database, the HDB, is available through TMclass [here](#)

6.2 Accessories for vehicles

If the list reads *vehicles; cars; parts, fittings, components and accessories for all the aforementioned goods* in Class 12, it will be accepted. However, parts, fittings, components and accessories for vehicles and cars that are not proper to Class 12, such as, for instance, *car air fresheners* (Class 5), *aircraft engines* (Class 7), *bicycle helmets* (Class 9), *car radios* (Class 9), *furniture for caravans* (Class 20), *car mats* (Class 27), will not be covered by that specification. If protection is sought for parts, fittings, components and accessories for vehicles and cars that are not proper to Class 12, these goods need to be specified separately, and applied for in the proper class or classes.

The term accessories for vehicles may be accepted in relation to services as long as there is a clearly recognisable market sector for that specification. For instance, if the list reads *retail of **cars**, and parts, fittings, components and **accessories** for the aforementioned goods* in Class 35, or *retail of **bicycles**, and parts, fittings, components and **accessories** for the*

aforementioned goods in Class 35, it will be accepted, since these specific sectors are well defined on the market.

6.3 Advertising services

In principle, advertising services belong to Class 35. The main entries on advertising services in the list of services in the Nice Classification are:

- *advertising*
- *radio advertising*
- *radio commercials*
- *television advertising*
- *television commercials*
- *layout services for advertising purposes*
- *publication of publicity texts*
- *production of advertising films.*

These entries cover the design of advertising material and production of commercials for all kinds of media, as they are services that will be provided by advertising agencies.

6.4 Air freshening and perfuming preparations

See *Perfuming and air freshening preparations*.

6.5 Amusement apparatus and electronic games

Following changes to the Nice Classification on 1 January 2012 (10th edition), all *games* (whether electronic or not) are classified in Class 28. These are shown in the alphabetical list as follows:

- *games (Apparatus for-)*
- *video game machines*
- *arcade video game machines.*

Most of these Class 28 devices come loaded with the games. However, if the games are not loaded on the devices, they will be recorded on data carriers or will be downloadable. In such cases, the games are considered to be game programs especially adapted for use with gaming devices; they will therefore be classified in Class 9. See also *Computer games*.

6.6 Assembly services

These services in Class 40 cover the aspect of made-to-order manufacturing processes where several components are put together and interconnected to form finished or semi-finished goods.

Assembly services in Class 37 can only refer to the installation of goods and must be specified in more detail to that effect.

Note that the assembly of ready-built houses will be understood as construction services and therefore will only be correct in Class 37.

See also *Manufacturing services*.

6.7 Association services or services provided by an association to its members

These, and similar terms, are too vague to be acceptable. The type, or scope, of the service provided needs to be mentioned.

Examples of acceptable specifications:

Class 35: *Association services in the nature of business administration services*

Class 45: *Services provided by an association to its members in the form of legal services.*

See also *Charitable services*.

6.8 Beauty apparatus

Class 7: *Sprayers (machines) for applying artificial sun tanning preparations*

Class 8: *Hand-operated instruments/tools for beauty purposes; Tattooing needles/apparatus Depilatory apparatus (electric and non-electric)*

Class 10: *Massage apparatus; Microdermabrasion apparatus; Apparatus for the treatment of cellulite; Lasers for cosmetic beauty treatments; Laser hair removal apparatus; Photoepilation apparatus.*

Photoepilation is a procedure carried out by pulsed light devices. These devices use the same principle as lasers (i.e. heating up the hair follicle) but are not lasers

Class 11: *Ultra-violet ray lamps for cosmetic purposes; Sun beds; Steam apparatus for cleaning the skin*

Class 21: *Cosmetic brushes and applicators*

6.9 Blogs (provision of -)

The term provision of blogs on its own is analogous to provision of information, and as such the term lacks clarity and precision. The subject matter of the blog must be specified, and the term classified accordingly. See providing information.

Examples of acceptable specifications that define the subject matter of the information provided via a blog:

Class 35: *Providing corporate blogs*

Class 39: *Providing travel blogs*

Class 41: *Providing educational blogs*

Class 43: *Providing culinary art blogs.*

Services that allow users to communicate by blogs, or to host them, will be classified according to the nature of the services provided:

Class 38: *Communication by online blogs.*

Providing access to online blogs.

Class 41: *Writing services of blogs.*

Class 42: *Hosting of online blogs.*

Creation and maintenance of software for blogs.

6.10 Bringing together of services

See *Ordering of services* and *Retail and wholesale services*.

6.11 Broadcasting and/or transmission services

These services are proper to Class 38; both mean the same thing. The services provided in this area only cover the provision of the means of communication (e.g. the provision of a network of fibre-optic cables; the provision of broadcasts or transmissions via geostationary satellite transmission facilities; the rental of communications apparatus and systems). Class 38 does **not** cover any programmes, advertising, information or advice that may be transmitted by means of telecommunications or broadcasting technology. Those services would remain in the appropriate classes.

6.12 Brokerage services

These are services provided by an individual or company whereby these latter buy and sell commodities for a fee or commission. The fee may be charged to the buyer or the seller of the commodity (or both). The broker may never see the goods or services in question.

There are three listed classes for brokerage services:

Class 35: *Brokerage of name and address based lists*

Class 36: [A large number of listings for] *brokerage of futures, carbon offsets, real estate, bonds, securities and other financial based items*

Class 39: *Brokerage services relating to distribution, transport, and storage.*

6.13 Cases (and carrying bags)

Cases (and bags) adapted to carry or transport the good they are intended to contain are, in principle, classified in the same class as the good they are adapted to carry. For instance, *laptop bags* are proper to Class 9.

Cases and bags adapted to carry or transport goods should not be confused with non-adapted carrying bags, which are classified in Class 18, whilst disposable paper and plastic shopping bags and garbage bags are in Class 16, and laundry bags are in Class 22.

6.14 Charitable services

This term is too vague to be accepted in any class without further qualification. Charitable or humanitarian services are services provided for non-monetary benefit, serving the public interest or common good and are defined by the actual service offered. Therefore, they can be classified in any of the service classes, giving the correct definition.

Examples:

Class 35: Charitable services, namely administration and general Office work

Class 36: The organisation of charitable collections; charitable fund raising

Class 38: Telecommunications services for charitable purposes

Class 39: Charitable services, namely ambulance transport

Class 40: Charitable services, namely water treatment services

Class 41: Charitable services, namely education and training

Class 42: Charitable services, namely environmental protection services

Class 43: Charitable services, namely providing food and drink and temporary accommodation

Class 44: Charitable services, namely providing medical services

Class 45: Providing clothing to needy persons [charitable services].

6.15 Collection and storage services

In the case of physical goods, both collection and storage services would be proper to Class 39. This class includes *transport* and *warehousing* in its listing. This would also include the collection and physical storage of data, whether in written form or recorded on media (the Nice Classification has *physical storage of electronically stored data or documents* in Class 39).

Office services of electronically collecting, collating and manipulating data are all proper to Class 35.

Storage of digital data and electronic data storage are seen to be in analogy with *hosting services*, and so are proper to Class 42. *Cloud computing data storage services* are also proper to Class 42.

6.16 Consulting and advisory services

See Providing information.

6.17 Commercial intermediation services

These are understood as third-party services of an agent for, or arranger of, a business contract between two trading parties for a commission or a fee. Since the principal activity would be aimed at closing trade agreements for others, such services are considered proper to Class 35.

However, it is important to distinguish between such commercial intermediation, which is strictly a business service, and the arranging of services for others as such, which would in general be seen as an integral part of the provision of those services themselves and classified analogously.

6.18 Computer games and computer games apparatus

The terms *computer games* and *video games* are highly similar and are treated in the same way.

The dictionary reference for computer games is:

1. **(Noun)** 'any of various electronic games that are played by manipulating an input device in response to the graphics on the screen' (*Collins English Dictionary*).

Class 9 covers the software necessary for computer and video games, Class 28 covers the apparatus. If the terms *computer games* or *video games* are applied for as such, the class will define the nature of the goods covered.

See also *amusement apparatus and electronic games*.

Games that are acceptable in Class 28 can come loaded as part of the software. For example, the following terms can all be accepted in Class 28:

- *arcade games*
- *arcade video machines*
- *computer game consoles*
- *games (Apparatus for -)*
- *hand held computer game devices*
- *video game machines*.

6.19 Curtains and blinds

Blinds, in all their forms, can be used on windows both internally and externally. The classification of these goods depends upon the purpose of the goods and their material composition.

Curtains are normally used indoors and are classified similarly according to their material composition.

Examples of acceptable entries:

Class 6: *Outdoor blinds of metal*

External metal blinds as part of a building for security purposes

Class 17: *Curtains of asbestos (safety -)*. (The material and purpose determine the classification.)

Class 19: *Blinds [outdoor] not of metal and not of textile*. (These goods are probably made of wood.)

Class 20: *Blinds (slatted indoor -) Venetian and vertical window blinds Indoor window blinds Blinds (indoor window -) [shades] [furniture] Curtains (bamboo -) Paper blinds Curtains (bead -) [for decoration]*

Class 22: *Outdoor blinds of textile*.

The vast majority of curtains will fall under Class 24, since most domestic curtains (sometimes referred to as 'drapes') are made of textiles or plastic.

Care should be taken with any references to curtain walling, or curtain walls. These refer to a type of construction technique relating to buildings, and the associated goods are building materials proper to Class 6 (for metal goods) or Class 19 (for non-metallic goods).

6.20 Custom manufacture/manufacturing for third parties

See Manufacturing services.

6.21 Customer services

Although many businesses have departments dedicated to *customer services*, this term on its own is considered vague and must be explained further. An example of an acceptable specification in Class 35 would be *providing advice and support to clients for sales purposes and to achieve customer loyalty*.

6.22 Data services

The term cannot be accepted on its own. It must be qualified.

The provision of data can be proper to several classes depending on the way in which the data is provided or on the nature of the data being provided. In each case the exact nature of the service being offered will need to be stated; *the provision of data* is not enough.

Examples of acceptable terms and their relevant classification:

Class 44: *Provision of data (information) relating to the use of pharmaceuticals* (This would refer to the systemised provision of data that could only be interpreted by someone with specialised medical training.)

Class 45: *Provision and interpretation of data relating to animal tracking*.

(This would refer to services in relation to the relocation of a lost or stolen animal. If the data were for other purposes, the classification would be proper to other classes, for example, Class 42 for measuring or scientific reasons.)

See also *Providing information*.

6.23 Design services

Design services are, as such, proper to Class 42.

Design of advertising and *design of brand names* are both proper to Class 35 as they are both advertising services.

Likewise, *landscape design*, *floral design*, *turf design* and *planning [design] of gardens* are proper to Class 44 as they are horticultural services.

6.24 Digital imaging services

The term *digital imaging services* was deleted from Class 41 in the 10th edition of the Nice Classification. Consequently, the term cannot be accepted in Class 41 without further details. This is because digital imaging can be classified in more than one class, depending on the field the service refers to: for example, medical, information technology or photography.

Examples of acceptable terms:

- *digital imaging (photo editing)* in Class 41
- *medical imaging services* in Class 44
- *rendering of computer graphics (digital imaging services)* in Class 42

6.25 Downloadable goods

All material that is downloadable is proper to Class 9. This includes publications, music, ring tones, pictures, photographs, films or film extracts and digitalised information in general. Downloaded material is saved onto a memory unit or computer drive, telephone, tablet or other wearable device. It can then be used independently of its source. These goods can also be called *virtual goods*. All these downloadable goods can be retailed.

6.26 Electricity and energy

The following is a guide to some of the goods and services related to electricity and energy in general.

Class 4: *Electrical energy*

Class 7: *Electrical generators Wind turbines Hydroelectric installations for generating electricity*

Class 9: *Apparatus and instruments for conducting, switching, transforming, accumulating, regulating, or controlling electricity, Solar cells for electricity generation, Photovoltaic cells and modules*

Class 11: *Heat generating apparatus*

Solar collectors for heating

Class 35: *Procurement of contracts concerning energy supply*

Class 36: *Brokerage of electricity* (see also note under *Brokerage services*)

Class 37: *Recharging of batteries*

Class 39: *Distribution of electricity*

Storage of electricity

Class 40: *Generation of electricity*

Class 42: *Measuring services with regard to energy consumption.*

Note that *retail or wholesale of energy* will not be accepted since the selling of energy is considered to be trading in commodities. This term must be rephrased to reflect this and classified in Class 36.

See also *Solar power*.

6.27 Electronic and electric apparatus

The term *electronic and electric apparatus, devices or instruments* is too vague for classification purposes; it is not acceptable in any goods class and should therefore be specified in more detail.

Specifications of *electronic and electric apparatus, devices or instruments*, such as the examples listed below, are also considered too vague:

- *electronic and electric apparatus for controlling the environment*
- *electronic and electric apparatus for household purposes*
- *electronic and electric apparatus for use in hairdresser salons*
- *consumer electronics.*

6.28 Electronic cigarettes

Electronic cigarettes, e-cigarettes or e-cigs are - for classification purposes - acceptable only in Class 34, even if they are intended to serve a medical purpose. Non-electronic parts of these types of cigarettes, such as cartridges, atomisers or (aroma) substances, are also classified in Class 34.

Electronic parts, such as batteries and microcomputer-controlled circuits for electronic cigarettes, are not acceptable in these classes and belong - as usual - to Class 9.

6.29 Expert opinion services

The area of expertise has to be indicated for this type of service; classification will depend on the area of expertise indicated (see by analogy *Providing information*).

6.30 Food additives and supplements

These goods should in principle be classified according to the function group they belong to.

- Composition/consistency. Chemical and organic compositions used in the manufacture of food, such as binders, emulsifiers, stabilisers, thickeners, gelling agents or preservatives, are proper to Class 1. They are used to enhance or otherwise alter the consistency and durability of the food.
- Colour. Colourants in general are classified in Class 2.
- Flavour. Essential oils for enhancing flavour belong to Class 3.
- Health related. Veterinary or medical additives and nutritional supplements, such as digestives, anti-parasitics, antacids, trace element preparations or vitamin supplements, are meant to sustain or improve the health condition of humans or animals. They are therefore proper to Class 5.
- Fillers/bulking agents for animal feed. Class 31 contains complementary foodstuffs, or additional foods, used mostly as bulk fillers with little or no nutritional value.

Examples of such goods would be corncobs, peanut hulls or cereal by-products.

6.31 Foodstuffs

Class 29 includes mainly foodstuffs of animal origin, as well as vegetables and other horticultural comestible products that are prepared for consumption or conservation. Class 30 includes mainly foodstuffs of plant origin, except fruit and vegetables, prepared for consumption or conservation, as well as auxiliaries intended to improve the flavour of food. Class 31 includes mainly agricultural and aquacultural products not having been subjected to any form of preparation for consumption; live animals and plants; and foodstuffs for animals.

Food for babies, medical meal replacements and dietetic food, adapted for medical or veterinary use, can be found only in Class 5. However, if not specifically adapted for medical or veterinary purposes, foodstuffs enhanced with or lacking a specific ingredient, such as *dairy-free chocolate*, *gluten-free bread*, *sugar-free sweets*, *calcium-fortified milk*, *sodium-free salt* or *vitamin/mineral-enriched breakfast cereals*, do not belong to Class 5 and are classified following the instructions in the Nice Classification general remarks.

6.32 Franchising

The verb 'to franchise' refers to the giving or selling of a franchise to another party. As a noun, 'franchise' means 'an authorisation granted to an individual or group to trade in a particular area for a stated period' (*Oxford English Dictionary*).

According to the general remarks in the Nice Classification (11th edition), 'Services rendered in the framework of franchising are in principle classified in the same class as the particular services provided by the franchisor (e.g. business advice relating to franchising (Cl. 35), financing services relating to franchising (Cl. 36), legal services relating to franchising (Cl. 45)).

Without any more detailed specification, Sakpatenti will not accept the term *franchise service* or *franchising services* in Class 35. In order to be acceptable a clarification is required.

In order to classify the term properly, it is necessary to understand the actual nature of the service.

Services rendered by the franchisor **and** provided to the franchisee most commonly include business and marketing assistance (Class 35), financial management (Class 36), training (Class 41) and, to some extent, legal assistance (Class 45). This is reflected in the Nice Classification general remarks.

Examples of how the services provided by a restaurant franchisor could be classified:

Class 35: *Business assistance relating to starting and running a restaurant franchise*

Class 36: *Financial consultancy relating to franchising*

Class 45: *Licensing services relating to franchising.*

Example of how the services rendered in the context of a franchised restaurant could be classified:

Class 43: *Restaurant services; provision of food and drink* (This would be the principal business activity of the applicant, and the subject of the franchise)

It is not necessary to mention that such services are provided by a franchise.

However, services provided by a franchising agency offering to find proper third-party candidates for signing a franchising contract belong to Class 35 (by analogy to procurement of commercial contracts for others). Most services rendered by franchising agencies would fall into Class 35 as being business assistance.

6.33 Gadgets

The term *gadgets* (*electronic or otherwise*) is considered vague in all classes and must be specified in more detail.

6.34 GPS systems - location, tracking and navigating

GPS and *satellite navigation systems* (Class 9) provide location, tracking and navigating services, to provide the user with information.

The easiest way to classify these services is to divide them into those services that provide the telecommunications that run the services (Class 38) and those that provide information via a GPS device. The range of information provided goes beyond mere travel route information (Class 39).

It can include information regarding restaurants and accommodation (Class 43), information regarding shopping outlets (Class 35) or telephone numbers (Class 38).

The use of GPS devices in relation to the movement of vehicles and people can also lead to classifications over a range of classes. Route planning services (Class 39) have already been mentioned. This classification would also extend to logistic or freight moving companies keeping track of their vehicles using the same devices.

GPS systems can also be used, in conjunction with other technology, to locate the source of a mobile telephone signal. If this is done as part of a telecommunication service it will be proper to Class 38. If, however, it is done as part of a criminal investigation service it will be proper to Class 45.

Other services can be associated with the services listed above. For example, the creation of maps for GPS systems is proper to Class 42. The downloadable applications that run the service or provide alternative 'voices' are proper to Class 9. The retail services for providing the downloadable applications are proper to Class 35.

Examples of how these and other terms are classified:

Class 35: Compilation and provision of commercial directory information regarding service providers for GPS navigation

*Class 38: Satellite transmissions Providing public subscribers directory information for GPS navigation Providing access to general information supplied via satellite transmission Telecommunications services for location and tracking of persons and objects Tracking of mobile telephones via satellite signals
Location of mobile telephones via satellite signals
Providing access to GPS navigation services via satellite transmission
Satellite transmission of navigation data*

*Class 39: Providing GPS navigation services
Providing traffic information services via satellite transmission Providing road information services via satellite transmission Location services for logistics purposes of vehicles and goods Tracking services for logistics purposes of vehicles and goods*

*Class 42: Providing weather information via satellite transmission
Creation of GPS maps*

*Class 45: Tracing and locating of missing persons via satellite transmission
Tracking of persons carrying electronic tagging devices
Security tracking services of vehicles
Security location services of vehicles*

6.35 Hair styling

Most *electric and non-electric hair styling apparatus* is classified in Class 8 (e.g. *electric hair curling irons; hair tongs [non-electric hand implements]* - these could also be gas operated; *crimping irons for the hair*, etc.). Exceptions are:

Class 11: Hair dryers

Class 21: Combs and brushes (non-electric and electric)

Class 26: Hair curlers/rollers, other than hand implements (e.g. clip-on, sponge or hook-and-loop fastener type).

6.36 Hire services

See Rental services.

6.37 Hotline services

Also services of call centres. See *Providing information*.

6.38 Humanitarian aid services

Sakpatenti practice on *humanitarian aid services* is the same as that on *charitable services*: the nature of the services must be specified (see *Charitable services*).

6.39 Internet services, online services

The term *internet services* is not sufficiently clear and precise to be accepted in any class. It must be further defined.

A range of services, offered by individuals and businesses to other individuals and businesses, relate to the setting up, operation and servicing of websites. These are covered by appropriate entries in a number of classes.

An even wider range of services is offered to customers through the medium of telecommunications including via the internet. It is possible, over the internet, to shop, obtain banking advice, learn a new language, or listen to a 'local' radio station situated on the other side of the world.

The Nice Classification system generally applies regardless of whether the service is provided face-to-face, on dedicated premises, over a telephone or online via a database or website.

Examples of acceptable terms:

Class 35: *Advertising services provided over the internet*

Class 36: *On-line banking services*

Class 38: *Internet service provider services*

Class 41: *On-line gaming services*

Class 42: *Providing on-line support services for computer program users*

Class 45: *Online social networking services.*

6.40 Kits and sets

It is common in trade for certain goods to be sold in groups of more than one item. If the items are all the same - for example, a pack of three toothbrushes - then the classification is simple.

However, sometimes the collection of goods could be component parts of another item or have a function that is not defined by the individual goods. These groups of goods sometimes have collective names such as 'kit' or 'set'. These small words can have a great impact on (1) the acceptability as a collection of goods and (2) the appropriate classification.

A 'kit' can mean either:

1. a set of parts ready to be made into something (e.g. a kit for a model plane), or
2. a set of tools or equipment that is to be used for a particular purpose (e.g. a first-aid kit).

A 'set' is a number of articles that are thought of as a group. This may or may not have a defined number (e.g. a set of keys, a set of saucepans, a set of golf clubs, a cutlery set).

Examples of the use of 'kits':

Class 3: *Cosmetic kits*

Class 5: *First aid kits* (seen as a collection of plasters and treatments).

It sometimes happens that the individual goods that make up the kit or set would normally be classified in more than one class. However, Sakpatenti will not object to such collective terms, provided that they make sense and are in common usage on the market.

When determining the correct classification for a kit or set, it is necessary to understand either what the kit is going to be used for or, alternatively, if something is to be constructed from its components, what the finished article will be.

Examples of acceptable terms:

Class 8: *Manicure and pedicure sets*

Class 9: *Hands free kits for phones*

Class 12: *Tyre repair kits*

Class 27: *Rug making kit*

Class 28: *Scale model kits [toys] Toy model kits*
Class 32: *Beer making kits*
Class 33: *Wine making kits.*

If coverage is sought for the specific parts of the kit, these should be specified and classified according to their function or purpose.

6.41 Leasing

According to the general remarks in the Nice Classification (11th edition), 'Leasing services are analogous to rental services and therefore should be classified in the same way. However, hire- or lease-purchase financing is classified in Cl. 36 as a financial service.'

Note that, although the definition of *leasing* might differ across languages, for the sake of consistency it will be interpreted as indicated above, based on the meaning of the term *leasing* in English.

See also *Rental services*

6.42 Mail order

See Retail and wholesale services.

6.43 Manuals (for computers, etc

Electronic items such as computers, printers, photocopiers and other electronic items are often delivered as new goods to the customer with a list of operating instructions. The instructions can be in paper (printed) format or in an electronic format, such as a recording on a disc, or as a downloadable or non-downloadable document available on the manufacturer's website.

Examples:

Class 9: *Manuals in electronic format for computer software*

Class 16: **Printed** *manuals for computer software*

6.44 Manufacturing services

Manufacturing is only seen as a service when it is undertaken for third parties. Custom manufacturing of certain single, 'one-off', goods for third parties, for example a sailing boat or a sports car, by a specialist in that field would be proper to Class 40. Custom construction of, for example, made-to-measure kitchen units would be included in Class 40, but their installation would be proper to Class 37.

See also *Assembly services*.

6.45 News services

'News' has no boundaries; the subject could be anything. Therefore, the term *news services* as such lacks clarity and precision, and should be specified.

News agency services are proper to Class 38. They are essentially a hub or collection point through which journalists and others can file and obtain newsworthy materials (in the form of stories, script or photographs). They do not perform any other function such as editing or verification services.

News reporting services are proper to Class 41.

Other examples:

Class 38: *News broadcasting services*

Class 40: *Printing of newspapers*

Class 41: *Presentation of news (programmes) Publication of news Editing of news.*

As far as electronic news publications are concerned, *downloadable news pod casts, news clips, news items, news publications*, etc. are all goods that are proper to Class 9.

6.46 Online services

See Internet services.

6.47 Ordering of services

The ordering of goods/services for others can be accepted in Class 35 as a business service/office function. There are individuals and companies that offer services providing solutions to a variety of problems on behalf of others. For example, if you need a leaking tap to be fixed, the intermediary (service provider) will arrange the services of a plumber for you. This classification is analogous with the Nice Classification entry *procurement of services for others [purchasing goods and services for other business]*.

6.48 Perfuming and air freshening preparations

There are preparations, and associated apparatus, that serve merely to mask unpleasant smells (perfume) or chemically 'wrap up' and remove unpleasant odours (deodorisers). They are properly classified as follows:

Class 3: *Air fragranting preparations; Incense; Potpourris [fragrances]; Sachets for perfuming linen; Scented wood; Fumigation preparations [perfumes]; Room sprays*

Class 5: *Air deodorising preparations*

Air purifying preparations

Class 11: *Air deodorising apparatus*

Class 21: *Perfume burners; Vaporizers for perfume sold empty.*

Other goods that may release pleasant odours include *perfumed candles* (proper to Class 4 as the release of perfume is a secondary characteristic) and *perfumed drawer liners* (proper to Class 16 as they are analogous to *packaging material* and usually made of paper).

6.49 Personal and social services rendered by others to meet the needs of individuals

The general indication *personal and social services rendered by others to meet the needs of individuals* is not sufficiently clear and precise and will not be accepted by Sakpatenti. See also paragraph 4.2.

The applicant needs to make the wording more specific.

Many personal and social services are classifiable but are proper to classes other than Class 45.

Examples:

Class 36: *Personal insurance services* (such as life assurance)

Class 41: *Personal tuition*

Class 44: *Personal medical services*

Class 45: *Personal body guarding*

Consultancy services relating to personal appearance

Personal shopping services

Concierge services.

6.50 Personal assistant services

This term is considered to be vague and needs to be explained further. Personal assistants offer assistance in managing their employer's personal and/or business life by taking over

specific tasks, which, however, are not clearly defined. The activities involved could cover services proper to various different classes such as:

- Appointment scheduling services (Class 35)
- Telephone answering (Class 35)
- Personal trainer services [fitness training] (Class 41)
- Personal reminder services in the area of upcoming important dates and events (Class 45)
- Personal fashion consulting services (Class 45)
- Dog walking services (Class 45).

A similar assessment will be applied to the *lifestyle management* as this is also considered to be too vague for classification purposes.

6.51 Precious metal goods

The general indication *goods of precious metals or coated therewith, not included in other classes* in Class 14 is not sufficiently clear and precise and will not be accepted by Sakpatenti (see also paragraph 4.2). The applicant needs to make the wording of the term more specific.

Caution needs to be applied when classifying goods made from precious metals.

Historically, virtually all goods made from, or coated with, precious metals were grouped together in Class 14. It was considered that the material had an influence on why the goods were bought and that in turn determined where the goods were classified.

Since 1 January 2007, many goods that would have been in Class 14 have been reclassified. This reclassification of the goods is based on their function rather than the material from which they are made.

Examples of goods classified according to their function or purpose: Class 8: *Cutlery of precious metal*

Class 16: *Pen nibs of gold*

Class 21: *Teapots of precious metal*

Class 34: *Cigarette and cigar boxes made of precious metals.*

6.52 Protective clothing

If the **primary** function of items that are worn (or sometimes carried) is the prevention of serious and/or permanent injury or death, or protection against, for example, contact with or exposure to extremes of temperature, chemicals, radiation, fire, or environmental or atmospheric hazards, then those goods will be proper to Class 9.

Examples of such protective goods include hard hats worn on building sites, and helmets worn by security guards, horse riders, motorcyclists, and American football players. Bullet-proof vests, metal toe-capped shoes, fireproof jackets and metal butchers' gloves are further examples: they are not clothing as such. Aprons, smocks and overalls merely protect against stains and dirt and are not proper to Class 9 but to Class 25 as general clothing. Protective sporting articles (except helmets) are proper to Class 28 as none of them protect against loss of life or limb.

6.53 Providing a website

Unless specified as website development or as hosting of the content (Class 42), these services are understood as being analogous to providing information and are classified in accordance with the subject matter they are dedicated to.

See also *Providing information*.

6.54 Providing an online platform

These services are proper to Class 42 since they are understood to refer to the provision of a computing platform. They could also refer to the provision of an operating system, a browser, an application, a virtual machine or cloud - all being software solutions.

6.55 Providing downloadable content

Provision of downloadable content is classified according to the nature of the content (see *Providing information*); the wording of the term should make this clear.

Class 41 examples:

- *Providing downloadable electronic books* (Class 41)
- *Provision of downloadable electronic games* (Class 41)
- *Providing downloadable digital music* (Class 41).

Class 42 examples:

- *Providing downloadable applications* (Class 42)
- *Providing downloadable computer operating systems* (Class 42).

As with the term *provision of information*, *provision of downloadable content* without further specification is too vague.

The retail/wholesale of downloadable content is different - this would refer to bringing together a variety of downloadable content for the benefit of third parties, making it available to users to select from and purchase.

Class 35 examples:

- *Retail services in relation to downloadable electronic publications*
- *Retail services in relation to downloadable music files*
- *Wholesale services in relation to downloadable computer software.*

6.56 Providing information

According to the general remarks in the Nice Classification (11th edition), 'Services that provide advice, information or consultation are in principle classified in the same classes as the services that correspond to the subject matter of the advice, information or consultation, e.g., transportation consultancy (Cl. 39), business management consultancy (Cl. 35), financial consultancy (Cl. 36), beauty consultancy (Cl. 44).'

Services of providing information as such are considered to be vague and must be objected to. The applicant has to define the subject matter and classify it analogously. The fact that information is provided by electronic means (e.g. telephone, computer - email, website or blog) does not affect the classification of these services.

Providing advice, consultancy and information with regard to the aforesaid services at the end of the indication of any service class will be accepted.

6.57 Rental services

According to the Nice Classification general remarks (11th edition), 'Rental services are in principle classified in the same classes as the services provided by means of the rented objects (e.g., Rental of telephones, covered by Cl. 38).'

The same principle applies to *leasing services*, which can be found in the HDB in all of the service classes.

6.58 Retail and wholesale services

Retail is defined as '[t]he action or business of selling goods in relatively small quantities for use or consumption' (*Oxford English Dictionary*); this defines the scope of the services covered by the term 'retail services'.

There is an indication in the explanatory note to the listing of Class 35 in the Nice Classification that the term 'the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods' is acceptable in Class 35. *Retail services* are classified analogously with this entry.

However, as regards *retail services* or similar services in Class 35 relating to the sale of goods, such as wholesale services, mail order services and e-commerce services, Sakpatenti applies the judgment of 07/07/2005, C-418/02, Praktiker, EU:C:2005:425: the term *retail services* is only acceptable where the type of goods or services to be sold or brought together for the benefit of others is indicated with sufficient clarity and precision. The term *retail services of a supermarket* and, by extension, *retail services of a department store* and similar terms are not acceptable as the goods to be sold are not defined (01/12/2016, T-775/15, Ferli, EU:T:2016:699).

The 11th edition of the Nice Classification includes retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies, which shows how these terms can be expressed.

The general indications of the class headings that are not acceptable (see paragraph 4.2.1) are also not acceptable for retail services for those same general indications. For example, Sakpatenti will not accept retail services for machines. However, retail services in relation to agricultural machines is sufficiently precise and therefore acceptable.

As regards 'retail of services' (i.e. services that consist of the bringing together, for the benefit of others, of a variety of services, enabling consumers to conveniently compare and purchase those services), the Court has held that these must also be worded with sufficient clarity and precision to allow the competent authorities and other economic operators to know what services the applicant intends to bring together (10/07/2014, C-420/13, Netto Marken Discount, EU:C:2014:2069).

This decision confirms that the 'bringing together of services' is an activity that is entitled to protection. The Court placed greater emphasis on the importance of defining the services being brought together than on defining the action of 'bringing together' itself (thereby echoing its earlier judgment of 07/07/2005, C-418/02, Praktiker, EU:C:2005:425).

Terms expressing this should satisfy two requirements. Firstly, they should include familiar terms (i.e. 'bringing together', 'for the benefit of others ...' or 'enabling customers to compare and purchase ...') in order to 'frame' the services being brought together and describe the actual retail activity itself. Secondly, the terms used to describe the services being brought together must be understood and accepted in their own right (e.g. legal services, broadcasting services, slimming club services.).

In order to meet the fundamental requirements for clarity and precision under Article 9 of the Law and article 3 of the Instruction, any claim to the retailing or 'bringing together' of services must be worded in this manner.

Examples that will be considered acceptable:

- The bringing together, for the benefit of others, of a variety of legal services, enabling customers to conveniently compare and purchase those services

- The bringing together, for the benefit of others, of slimming club services, video-on-demand services, and detective agency services, enabling customers to conveniently compare and purchase those services
- The bringing together, for the benefit of others, of a variety of broadcasting services, enabling customers to conveniently compare and purchase those services.

In the case of the bringing together of services, wordings including ‘retail services connected with ...’, ‘retail services connected with the sale of ...’ and ‘electronic shopping retail services connected with ...’ do not provide a clear distinction between the retailing of services and the provision of those services in their own right.

Examples that will not be accepted and will be subject to an objection:

- *Retail services connected with takeaway services*
- *Retail services connected with the sale of legal services*
- *Mail order retail services connected with the sale of detective agency services.*

The CJEU’s ruling is not to be interpreted as providing a means of obtaining duplicate protection for services intended to be provided in their own right (whether proper to Class 35 or elsewhere). Nor should it be perceived as an alternative means of providing protection for the advertising of one’s own services. Therefore, if an application covers ‘the bringing together for the benefit of others of telecommunication services, enabling customers to conveniently compare and purchase those services’, these services do not cover the actual provision of telecommunication services, which belongs to Class 38, but only the bringing together of a variety of telecommunication service providers so as to enable consumers to compare and purchase those services conveniently.

Finally, it is not sufficiently precise to specify the goods or services using terms such as ‘including’, ‘in particular’, ‘for example’, ‘featuring’ or ‘such as’, since all these terms mean, in principle, ‘for example’. They do not restrict the goods or services that follow. Consequently, the abovementioned terms should be replaced by ‘namely’ or ‘being’, as they do restrict the goods or services that follow.

6.59 Retail of pre-paid cards

The term *retail of pre-paid cards* without a further specification lacks clarity and precision; the nature of the cards is not clear. Therefore, the exact market sector for which the cards are meant should be specified.

Examples of **acceptable** terms:

Class 35: *Retail of third-party pre-paid cards for the purchase of entertainment services*

Class 35: *Retail pre-paid cards for the purchase of clothing.*

6.60 Robots

The term *robots* lacks clarity and precision; therefore, the nature of the goods has to be specified.

Examples of **acceptable** terms:

Class 7: *Industrial robots*

Class 9: *Humanoid robots with artificial intelligence*

Class 10: *Surgical robots*

6.61 Satellite tracking

See GPS systems - location, tracking and navigating.

6.62 Sets

See Kits and sets.

6.63 Smartwatches and activity bracelets

The Nice Classification shows *smartwatches* in Class 9. These goods are seen as having the function more of communication devices than horological instruments; other similar additions in Class 9 are the terms *wearable activity trackers*, *connected bracelets [measuring instruments]* and *smartglasses*, all of which clearly show that the primary function and purpose of the goods dictate their classification.

6.64 Social networking services

Social networking services is an acceptable term in Class 45. It would be seen as a personal service that includes the identification and introduction of like-minded people for social purposes.

There are other aspects of the *social networking* industry that could be proper to classes other than Class 45, for example:

Class 38: *The operation of chat room services. The provision of online forums.*

6.65 Software publishing

Software publishing belongs to Class 41. A software publisher is a publishing company in the software industry that serves as an intermediary between the developer and the distributor. Publishing, according to its definition, includes *newspaper publishing* and *software publishing*.

6.66 Solar power

Solar power is energy that is derived from the sun and converted into heat or electricity. Goods relating to the generation and storage of electricity from solar energy are classified in Class 9.

Goods relating to the generation and storage of heat from solar energy are classified in Class 11.

Services relating to the generation of electricity from solar energy are classified in Class 40.

Class 9: *Photovoltaic cells Solar panels, modules and cells*

Class 11: *Solar collectors for heating*

Class 40: *Production of energy.*

See *Electricity and energy*.

6.67 Statistics

Regardless of the subject matter, *compilation of statistics* is proper to Class 35 as it is analogous to 'compiling of data'.

Nevertheless, statistics have to be treated as information. Therefore, *providing statistics* will also be considered vague unless the subject matter is defined. Consequently, the classification once again depends on the subject matter.

Examples:

Class 35: *Providing market research statistics*

Class 39: *Providing statistics on traffic flow*

Class 42: *Providing statistics with regard to rainfall.*

Other services connected with statistics may be classified differently and include: Class 38: *Providing access to statistical data*

Class 41: *Publication of statistics*

Class 42: *Scientific analyses of research statistics.*

6.68 Storage services

See Collection and storage services.

6.69 Supply of ...

Care should be taken in accepting this term when it is used to qualify services. It is acceptable in some circumstances, for example, *supply of electricity* in Class 39, where the term is often closely allied to *distribution*. It is also acceptable in the term *catering services for the supply of meals* (in Class 43) because the material being supplied, and the nature of the service, have both been given.

In the term *supply of computer software* (in Class 42), it is not clear what services are being provided. Whilst this class does include the services of *design, rental, updating and maintaining computer software*, it is not clear if any of those services are included in the general term *supply*. The word is often used as an apparent synonym for retail services but Class 42 does not include such services, which are proper to Class 35.

6.70 Systems

This is another term that can be too unclear or too imprecise to be accepted. It can be accepted only when qualified in a clear and unambiguous way. Examples of acceptable terms:

Class 7: Exhaust systems

Class 9: *Telecommunication systems*

Computer systems

Alarm systems

Class 16: *Filing systems.*

6.71 Tickets (for travel, entertainment, etc.)

A ticket is a 'promise to supply', in relation to a service or reservation service, the right to a service.

Examples:

Class 39: *Issuing of airplane tickets*

Class 41: *Ticket agency services (box Sakpatenti).*

Note that tickets are not seen as goods retailed in Class 35.

6.72 Tourist/Holiday services

The terms *tourist services, holiday services* as well as *tourist office services* are not sufficiently clear or precise, as they can relate to different areas of activity, and services belonging to different classes. The terms must be defined further.

Examples of **acceptable** terms:

Class 39: *Providing tourist travel information*

Class 43: *Tourist agency services for booking accommodation.*

6.73 Video games

See Computer games.

6.74 Virtual environment

The term *providing a virtual environment* is neither sufficiently clear nor precise as it can relate to different areas of activities and classes. The term must be defined further.

Examples of acceptable terms:

Class 38: *Providing a virtual chatroom Providing access to a virtual environment*

Class 42: *Hosting of a virtual environment Maintenance of a virtual environment.*

6.75 Wellness services

The term *wellness services* is not sufficiently clear or precise, and needs to be specified in more detail. This is because there is currently no definition of such services that would put them into one - and only one - class. Despite being a known market phenomenon, the interpretation of the scope of this service is not entirely clear and can differ from one enterprise to another.

Note that *wellness services provided in beauty salons* or similar indications will not render the term acceptable.

Examples of acceptable clarifications:

Class 41: *Instruction in exercise as wellness club services Teaching of meditation as part of a wellness programme*

Class 44: *Wellness services for the purpose of beauty care Health spa services for wellness Relaxing massage in wellness centers*

Class 45: *Spiritual consultancy aimed at wellness.*

Section 4 Substantive Examination. Absolute Grounds for Refusal

Chapter 1 General principles

1. Reasoned Objection

Any one of the grounds listed in Article 4 of the **Law** is sufficient for the refusal of a trademark.

For the sake of sound administration and economy of proceedings, Sakpatenti will raise any objections to registration of the sign under Article 4 of the **Law** as soon as possible and preferably all at once.

Each of the grounds for refusal listed in Article 4 of the **Law** is **independent** and must be examined separately. Therefore, when various absolute grounds for refusal are invoked, a reasoned objection will be issued, specifying the individual grounds for refusal and providing clear and distinct reasoning **for each ground**. Even when some grounds for refusal overlap, each ground for refusal must be reasoned in the light of the general interest underlying each of them.

For example, where a word mark is found to have a semantic meaning that gives rise to an objection under both Article 4(1)(c) and (d) of the **Law**, the decision on grounds for refusal should deal with each of those grounds in separate paragraphs. In such a case, it will be clearly indicated whether the lack of distinctiveness arises out of the same, or different, considerations from those that lead to the mark being deemed descriptive.

2. Decision

The decision will include the objection of the examiner which will state that the application has been refused, either partly or in its entirety, indicating the goods and services rejected. The objection will be confirmed by the order of Sakpatenti.

3. Irrelevant Criteria

The following arguments should be rejected as irrelevant:

3.1 Term not used

The fact that a descriptive use of the term applied for cannot be ascertained is irrelevant. Examination of Article 4(1)(d) of the **Law** has to be made by means of prognostics (assuming that the mark will be used with respect to the goods or services claimed).

3.2 Need to keep free

It is frequently claimed that other traders do not need the term applied for, can use more direct and straightforward indications or have synonyms at their disposal to describe the respective characteristics of the goods. All these arguments must be refused as irrelevant.

Although there is a public interest underlying Article 4(1)(d) of the **Law** that descriptive terms should not be registered as trademarks so as to remain freely available to all competitors, it is not necessary for **Sakpatenti** to show that there is, on the part of third parties, a present or future need to use, or concrete interest in using, the descriptive term applied for.

Whether there are synonyms or other, even more usual, ways of expressing the descriptive meaning is thus irrelevant.

3.3 Factual monopoly

The fact that the applicant is the only person offering the goods and services for which the mark is descriptive is not relevant for Article 4(1)(d) of the **Law**. However, in this case the applicant will be more likely to succeed on acquired distinctiveness.

3.4 Double meaning

The argument frequently put forward by applicants that the terms applied for have more than one meaning, one of them not being descriptive for the goods/services, should be rejected. It suffices for a refusal under Article 4(1)(d) of the **Law** if at least one of the possible meanings of the term is descriptive in relation to the relevant goods and services.

Given that the examination must focus on the goods/services covered by the application, arguments concerning other possible meanings of the word(s) making up the trademark applied for (that are unrelated to the goods/services concerned) are irrelevant. Equally, when the trademark applied for is a composite word mark, what matters for examination purposes is the meaning, if any, associated with the sign considered **as a whole**, and not the possible meanings of its individual elements considered separately.

4. Scope of Objections to the Goods and Services

Almost all absolute grounds for refusal, and in particular the most frequent ones of lack of distinctiveness, descriptiveness, genericness and deceptiveness, have to be assessed with respect to the goods and/or services actually claimed.

If an objection is raised, Sakpatenti must state specifically which ground (or grounds) for refusal apply to the mark in question, for each product or service claimed.

It is sufficient that a ground for refusal applies to a **single homogenous category** of goods and/or services. A homogenous category is considered a group of goods and/or services that have a sufficiently direct and specific link to each other. Where the same ground or grounds for refusal is/are given for a category or group of goods or services, only general reasoning for all of the goods or services concerned may be used

Sign	Case number
BigXtra	C-253/14 P
The Court confirmed the refusal in respect of goods and services in Classes 16, 35, and 41 to 43 by means of general reasoning because of a sufficiently concrete and direct link for all these goods and services. For all of them, 'BigXtra' will be perceived as indicating price reductions or other advantages (para. 48).	
Sign	Case number
PIONEERING FOR YOU	T-601/13
The General Court allowed general reasoning in respect of goods and services in Classes 7, 9, 11, 37 and 42 because the promotional meaning of the sign applied for would be perceived identically for each of them (paras 36-37).	

As regards descriptiveness, an objection applies not only to those goods/services for which the term(s) making up the trademark applied for is/are directly descriptive, but also to the **broad category** that (at least potentially) contains an identifiable subcategory or specific goods/services for which the mark applied for is directly descriptive. In the absence of a suitable restriction by the applicant, the descriptiveness objection necessarily affects the broad category as such. For example, 'EUROHEALTH' is to be refused for 'insurance' as a whole and not only for health insurance.

An objection also applies to those goods and services that **are directly linked** to those for which the descriptive meaning pertains. Furthermore, if the descriptive meaning applies to an activity involving the use of several goods or services mentioned separately in the specification, then the objection applies to all of them.

It is possible to claim goods and services as what can be referred to as **auxiliary goods or services** in the sense that they are meant to be used with, or support the use of, the main goods or services. Typically, this covers paper and instruction manuals for the goods to which they belong or which are packed with them. In these cases, the auxiliary goods are by definition intended to be used and sold together with the main product (e.g. vehicles and instruction manuals). It follows that if the sign is found to be descriptive of the main goods, logically it is also descriptive of the auxiliary goods, which are so closely related.

A different situation is that of the stand-alone services that support other businesses, such as advertising, transport and training. They are defined as offering/rendering the services to third parties and therefore cannot be considered auxiliary services with reference to the goods and services. Advertising, for example (as well as the other previously mentioned services), is considered to be a fully-fledged service provided to third parties, and not just an ancillary dependent vehicle to promote 'main' products.

5. Disclaimers

Sakpatenti will assess disclaimers according to the following practice applicable:

- As a general rule, a disclaimer will not help to overcome an absolute grounds objection.
- Where a trademark consists of a combination of elements, each of which in itself is clearly not distinctive, there is no need for a disclaimer of the separate elements. For example, if a

periodical had as its trademark 'Alicante Local and International News' with a figurative distinctive element, the individual word elements within it would not need to be disclaimed.

- If the applicant's disclaimer does not overcome the ground for refusing registration, the application must be refused to the extent that is required.
- Where the applicant has made a disclaimer of a non-distinctive element in its application, the disclaimer will stay even if Sakpatenti does not consider it necessary.

Disclaimers of distinctive elements will not be taken into account by Sakpatenti while conducting examination on application.

Chapter 2 Trademark Definition. of the Law4(1)(a)

1. General Remarks

Article 4(1)(a) of the **Law** reflects Sakpatenti's obligation to refuse signs that do not conform to the requirements of Article 3 of the **Law**.

According to Article 3(1) of the **Law** a trademark is a sign or any combination thereof **represented graphically** that is capable of distinguishing the goods and/or services of one company from those of another. According to Article 3(2) of the **Law** a sign may be a word or words, including personal names; letters; numerals, sounds; images; three-dimensional figures, including shapes of goods or of their packaging, as well as any other decorations of goods using colour or any combination thereof.

To be capable of constituting a trademark for the purposes of Article 3 of the **Law**, the subject matter of an application must satisfy three conditions:

1. It must be a sign
2. It must be represented graphically
3. It must be capable of distinguishing the goods or services of one undertaking from those of others

1.1 Signs

Article 3(2) of the **Law**, draw up an exhaustive list of signs that may constitute a trademark: word marks, figurative marks, 3D figures, position marks, pattern marks, sound marks and motion marks. Within this context, abstract concepts and ideas or general characteristics of goods are not specific enough to qualify as a sign, as they could apply to a variety of different manifestations. For this reason, for example, an application for a 'transparent collecting bin forming part of the external surface of a vacuum cleaner', will be rejected as the subject matter is not a particular type of bin, but rather, in a general and abstract manner, all conceivable shapes of a transparent bin with a multitude of different appearances.

1.2 Distinguishing character

Article 3(1) of the **Law** refers to the capacity of a sign to distinguish the goods of one undertaking from those of another. Unlike Article 4(1)(c) of the **Law**, which concerns the distinctive character of a trademark with regard to specific goods or services, Article 3(1) of the **Law** is merely concerned with the abstract ability of a sign to serve as a badge of origin, regardless of the goods or services.

Only in very exceptional circumstances is it conceivable that a sign could not possess even the abstract capacity to distinguish the goods or services of one undertaking from those of another. An example for the lack of abstract capacity in the context of any goods or services could be the word 'Trademark'.

1.3 Representation on the Register

According to Article 3(1) of the **Law**, the sign applied for needs to be capable of being represented graphically on the Register. Regarding the representation of the sign, **Instruction** lays down list of trademarks together with their representation requirements.

The subject matter of the registration is defined by the **representation of the mark**. In the limited number of cases where the representation is accompanied by a description (see below), the description must accord with the representation and must not extend its scope.

Whenever the sign is not represented graphically, the mark has to be refused for not complying with Article 4(1)(a) of the **Law**. This is an objective assessment and no particular consumer segment has to be taken into account.

2. 'Non-traditional' Trademarks. Article 4(1)(a) of the Law

2.1 Shape marks

A three-dimensional mark is a trademark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or its appearance. The term 'extending to' means that these marks cover not only the shapes per se, but also shapes that contain word or figurative elements, labels, etc. If the sign submitted for registration is three-dimensional, the view of its representation shall be selected so as to create the best possible idea of it.

The representation of shape marks requires the one of the following to be submitted:

- a graphic reproduction of the shape, including computer-generated imaging;
- a photographic reproduction.

The graphic or photographic reproduction may contain different views. Where the representation is not provided electronically, it may contain up to six different views.

2.2 Position marks

A position mark is a trademark consisting of the specific way in which the mark is placed on or affixed to the goods.

The abovementioned article stipulates the following mandatory and optional representation requirements for position marks.

An appropriate identification of the **position** of the mark and its size or proportion **with respect** to the relevant goods (mandatory).

A visual disclaimer of those elements that are not intended to form part of the subject-matter of the registration (mandatory). It is preferred to use broken or dotted lines.

A description explaining how the sign is affixed to the goods (optional). The representation should by itself clearly define the position of the mark as well as its size or proportion with respect to the goods. Therefore, the description may only serve explanatory purposes; it cannot serve to substitute visual disclaimers.

An objection under Article 4(1)(a) of the **Law** may be raised for those goods on which the positioning of the mark is unclear. For example, if a position mark is applied for in respect of *clothing, footwear and headgear*, but the representation identifies the position of the mark on *footwear* only, an objection should be raised for *clothing* and *headgear*.

2.3 Pattern marks


The pattern marks are marks consisting exclusively of a set of elements that are repeated regularly. The pattern marks must be represented by submitting a reproduction showing the pattern of repetition. Descriptions detailing how its elements are repeated in a regular pattern are allowed for this type of mark.

2.4 Sound marks

Sound marks are trademarks consisting exclusively of a sound or combination of sounds. If the sign submitted for registration is a sound mark, it shall contain the graphical expression of this sign (E.g. musical notation). However, electronic sound files are also permitted if submitted through e-filing and accompanied by any graphic representation of the sound.

2.5 Layout of a retail store

In its judgment of 10/07/2014, C-421/13, Apple Store, EU:C:2014:2070, § 19, the Court of Justice found that a representation that depicts the layout of a retail store may constitute a trademark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings. The layout was represented by means of a single design, combining lines, curves and shapes, without any indication of the size or proportions.

Sign	Case No.
	<p>10/07/2014, C-421/13, Apple Store, EU:C:2014:2070</p>

Following the abovementioned judgment, it cannot be excluded that the requirements for the representation of the layout of a retail store could be satisfied by a design alone, combining lines, curves and shapes, without any specific indication of the size or proportions in the description. The Court indicated that in such a case, the trademark could be registered, provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings and if no other grounds for refusal apply.

3. Relationship with other provisions of the Law

Article 4(1)(a) of the **Law** reflects Sakpatenti's obligation to refuse signs that do not conform to the requirements of Article 3 of the **Law**. If the sign does not meet these requirements and the representation is not clear and precise, the application will not be examined on the basis of the other absolute grounds for refusal. According to Article 4(3) of the **Law**, the absolute grounds for refusal under Article 4(1)(a) of the **Law** cannot be overcome through acquired distinctiveness in consequence of use of the mark.

Chapter 3 Non-distinctive trademarks (Article 4(1)(c) of the Law

1. General Remarks

The subject matter of a trademark is defined by the representation of the trademark.

The distinctiveness of a trademark within the meaning of Article 4(1)(c) of the **Law** means that the sign serves to identify the product and/or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings. Such distinctiveness can be assessed only by reference first to the goods or services in respect of which registration is sought and, second, to the relevant public's perception of that sign.

A word mark that is descriptive of characteristics of goods or services for the purposes of Article 4(1)(d) of the **Law** is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services for the purposes of Article 4(1)(c) of the **Law**.

In a similar vein, even though a given term might not be clearly descriptive with regard to the goods and services concerned, as to the point that an refusal under Article 4(1)(d) of the **Law** would not apply, the term would still be objectionable under Article 4(1)(c) of the **Law** on the ground that it will be perceived by the relevant public as only providing information on the nature of the goods and/or services concerned and not as indicating their origin. For example, the term 'medi', is considered as merely providing information to the relevant public about the medical or therapeutic purpose of the goods or of their general reference to the medical field.

An objection under Article 4(1)(c) of the **Law** would also apply in those cases where the lexical structure employed, although not correct from a grammatical point of view, can be considered to be common in advertising language and in the commercial context at issue.

2. Word Elements

Words are non-distinctive or cannot confer distinctiveness on a composite sign if they are so frequently used that they have lost any capacity to distinguish goods and services. The following terms, alone or in combination with other unregistrable elements, fall foul of this provision.

Terms merely denoting a particular **positive or appealing quality or function** of the goods and services should be refused if applied for either alone or in combination with descriptive terms:

- **ECO** as denoting 'ecological'
- **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'
- **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
- **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'

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.books.com is as objectionable for printed matter as the term 'books' alone. 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. Furthermore, it may also indicate that the goods and services covered by the trademark application can be obtained or viewed online, or are internet related. Accordingly, the element in question must

also be considered to be devoid of distinctive character in respect of the goods or services concerned.

Abbreviations of the **legal form of a company** such as Ltd., GmbH, etc. cannot add to the distinctiveness of a sign.

Names of individual persons are distinctive, irrespective of the frequency of the name and even in the case of the most common surnames, such as Jones or García⁵, and the names of prominent persons (including heads of state).

For objection based on titles of books, please see the Guidelines, Part B, Examination, Section 4, Chapter 4, Descriptive Trademarks, Paragraph 2.7.2, Titles of books.

3. *Single Letters*

3.1 *General considerations*

3.2 *Examples*

4. *Slogans: Assessing Distinctive Character*

It is inappropriate to apply to slogans stricter criteria than those applicable to other types of signs when assessing their distinctive character.

Advertising slogans are objectionable under Article 4(1)(c) of the **Law** when the relevant public only perceives them as a mere promotional formula. However, they are deemed to be distinctive if, apart from their promotional function, the public perceives them as an indication of the commercial origin of the goods or services in question.

The **following criteria** should be used when assessing the distinctive character of a slogan.

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

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.

However, the use of unorthodox grammatical forms must be carefully assessed because advertising slogans are often written in a simplified form, in such a way as to make them more concise and snappier. This means that a lack of grammatical elements such as definite articles or pronouns (THE, IT, etc.), conjunctions (OR, AND, etc.) or prepositions (OF, FOR, etc.) may not always be sufficient to make the slogan distinctive. For example, In 'Safety 1st', the use of '1st' instead of 'FIRST' is not sufficiently unorthodox to add distinctiveness to the mark.

⁵ (16/09/2004, C-404/02, Nichols, EU:C:2004:538, § 26, 30)

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 trademark is protected.

The fact that the **relevant public is a specialist one** and its degree of attention is higher than average cannot decisively influence the legal criteria used to assess the distinctive character of a sign. As stated by the Court of Justice, 'it does not necessarily follow that a weaker distinctive character of a sign is sufficient where the relevant public is specialist'.

Moreover, according to well-established case-law from the European General Court, the level of attention of the relevant public may be **relatively low** when it comes to promotional indications, whether that public consists of average end consumers or of a more attentive public made up of specialists or circumspect consumers. This finding is applicable even for goods and/or services where the level of attention of the relevant public is generally high, such as financial and monetary services.

The following examples show some of the different functions that slogans may serve and the arguments that can support an **objection** under Article 4(1)(c) of the **Law**.

Trade mark	Main function	Case No
No 5 904 438 <u>MORE THAN JUST A</u> <u>CARD</u> for Class 36	Customer service statement	R 1608/2007-4
<p>The slogan merely conveys information about the goods and services for which protection is sought. It is the kind of language an English speaker would use to describe a bank card that is a little out of the ordinary. It conveys the notion that the card has welcome features that are not obvious at first sight. The fact that the slogan leaves open what these features are, that is to say, that the mark does not describe a specific service or characteristic of the 'card', does not make the mark distinctive.</p>		
Trade mark	Main function	Case No
TM No 6 173 249 SAVE OUR EARTH NOW for Classes 3, 17, 18,	Value statement or political motto	R 1198/2008-4

The sign is a simple and straightforward appeal to take action and contribute to the Earth's well-being by favouring the purchase of environment-friendly products. Contrary to the appellant's contentions that the word 'now' constitutes an original element since nobody will believe that by purchasing the goods in question they will literally save the Earth now, the word 'NOW' is an emotional word commonly used in marketing to urge consumers to consume, to get what they want without waiting; it is a call to action. The relevant consumer will immediately recognise and perceive the sign as a promotional laudatory expression indicating that the goods represent an environment-friendly alternative to other goods of the same sort, and not as an indication of commercial origin.

Trade mark	Main function	Case No
No 4 885 323 DRINK WATER, NOT SUGAR	Inspirational or motivational statement	R 718/2007-2

The mark is a banal slogan that merely conveys the idea that the consumer will be drinking real water rather than a sugary drink. The mark lacks any secondary or covert meaning, has no fanciful elements, and its message to the consumer is plain, direct and unambiguous. For these reasons, it is unlikely to be perceived as a sign of trade origin. It is easily seen that the mark consists merely of good counsel, namely that it is better from a health point of view to drink water that has not been sugared. What better way to promote such goods than by an expression such as DRINK WATER, NOT SUGAR? Consumers will read this with approval, but will look elsewhere on the product for the trademark.

Some examples of accepted slogans

Trade mark	Classes	Case No
WET DUST CAN'T FLY	Classes 3, 7 and 37	22/01/2015, T-133/13, EU:T:2015:46
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.		
„არგაჩერდე“ (don't stop)	Class 36	Reg. N 33906
„აქ. ახლა“ (Here, now)	Class 36	Reg. N 32753

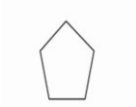

A slogan is objectionable under Article 4(1)(d) of the **Law** if it immediately conveys information about the kind, quality, intended purpose or other characteristics of the goods or services (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trademarks (Article 4(1)(d)).




5. Simple Figurative Elements

Simple geometric devices 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 trademark.


An extremely simple sign, composed of a basic geometric figure such as a circle, a line, a rectangle or a pentagon is not capable, as such, of conveying a message that consumers can remember, with the result that they will not consider it as a trademark.

Examples of refused trademarks

Sign	Goods and services	Reasoning	Case No
	<p>Class 33</p>	<p>The sign consists merely of a normal pentagon, a simple geometric figure. The geometric form, if it happened to be the form of the label, would be perceived as having a functional or aesthetic purpose rather than an origin-indicating function.</p>	<p>12/09/2007, T-304/05, Pentagon</p>
	<p>Classes 9, 14,16, 18, 21, 24, 25, 28, 35-39, 41-45</p>	<p>The sign will be perceived as an excessively simple geometric shape, essentially as a parallelogram. To fulfil the identification function of a trademark, a parallelogram should contain elements that singularize it in relation to other parallelograms' representations. The two characteristics of the sign are the fact that it is slightly inclined towards the right and that the base is slightly rounded and elongated towards the left. Such nuances would not be perceived by the general consumer.</p>	<p>13/04/2011, T-159/10, Parallélogramme, EU: T:2011:176</p>

	<p>Classes 14,18, 25</p>	<p>The sign does not contain any elements that may be easily and instantly memorised by an attentive relevant public. It will be perceived only as a decorative element, regardless of whether it relates to goods in Class 14 or to those in Classes 18 and 25</p>	<p>29/09/2009, T-139/08, Smiley, EU: T:2009:364</p>
	<p>Classes 3, 18, 24, 43, 44</p>	<p>The sign consists of merely a simple geometric figure in green. The specific colour is commonly and widely used in advertising and in the marketing of goods and services for the power to attract without giving any precise message.</p>	<p>09/12/2010, T-282/09, Carré convexe vert, EU:T:2010:508</p>
	<p>Classes 35, 41</p>	<p>It is a simple repetition of two basic triangles without any creative arrangement.</p>	<p>Invented example</p>

Example of an accepted trademark

	<p>Classes 35, 41</p>	<p>The sign gives the impression of overlapping triangles, but this is actually just an illusion formed by one single line. It is not a simple juxtaposition of basic shapes, but rather a creative arrangement of lines giving a distinctive overall impression.</p>	<p>TM No. 10 948 222</p>
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Further examples of simple figurative elements (combined with non-distinctive/ descriptive terms) can be found in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trademarks (Article 4(1)(d)).

6. *Commonplace Figurative Elements*

In some cases, the figurative element consists of a representation of the goods and services for which the trademark is protected. In principle, the said representation is considered to be descriptive and/or devoid of distinctive character whenever it is a true- to-life portrayal of the goods and services or when it consists of a symbolic/stylised portrayal of the goods and services that does not depart significantly from the common representation of the said goods and services.

In other cases, the figurative element might not represent the goods and services but might still have a direct link with the characteristics of the goods and/or services. In such cases, the sign will be considered non-distinctive, unless it is sufficiently stylised.

The following representation of a vine leaf is not distinctive for *wine*:



Similarly, the following representation of a cow for *milk products* is not distinctive:



TM No. 11 345 998, claiming Classes 29 (*milk and milk products, etc.*) and 35.

The above sign was refused, as representations of cows are commonly used in relation to *milk and milk products*. The fact that the subject mark consists of an ‘aerial’ picture of a cow is not sufficient to confer distinctive character on the sign, as slight alterations to a commonplace sign will not make that sign distinctive. The same reasoning would be applicable also to related goods such as *milk chocolate*.


Further examples of common figurative elements (combined with non-distinctive/ descriptive terms) can be found in the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 4, Descriptive Trademarks (Article 4(1)(d)).


7. *Typographical Symbols*

Typographical symbols such as a full stop, comma, semicolon, quotation mark or exclamation mark will not be considered by the public as an indication of origin. Consumers will perceive them as a sign meant to catch the consumer’s attention but not as a sign that indicates commercial origin. A similar reasoning applies to common currency symbols, such as the €, £, \$ signs; depending on the goods concerned, these signs will only inform consumers that a specific product or service is traded in that currency.

Examples of refused trademarks

Sign	Goods and services	Reasoning	TM No
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	Classes 14, 18 and 25	<p>The GC confirmed the finding of the BoA that The trademark applied for is devoid of the necessary degree of distinctive character. It consists merely of a punctuation mark with no special additional features immediately apparent to customers and is a commonplace sign that is frequently used in business or in advertising. In view of its frequent use, the relevant consumer will see the exclamation mark as being merely laudatory advertising or something to catch the eye (30/09/2009, T-75/08, !, EU:T:2009:374).</p>	TM No. 5332184
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	<p>Classes 29, 30, 31 and 32</p>	<p>The sign applied for was refused because, in the case of the goods for which the trademark is protected (foodstuffs and beverages), percentages are particularly important in relation to the price. For example, the percentage sign indicates clearly that there is a favourable cost/benefit ratio because the price has been reduced by a particular percentage in comparison with the normal price. Such a per cent sign in a red circle is also frequently used in connection with clearance sales, special offers, stock clearances or cheap no-name products, etc. The consumer will regard the sign merely as a pictogram conveying the information that the goods for which the trademark is protected are sold at a reduced price (16/10/2008, R 998/2008-1, Percent sign (fig.)).</p>	<p>TM No 5 649 256</p>
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8. Pictograms


Pictograms are basic and unornamented signs and symbols that will be interpreted as having purely informational or instructional value in relation to the goods or services concerned. Examples would be signs that indicate mode of use (like a picture of a telephone in relation to *pizza delivery services*) or that convey a universally understandable message (like a knife and fork in relation to *the provision of food*).

Commonly used pictograms, for example, a white 'P' on a blue background to designate a parking place or the design of an ice cream to designate that ice cream is sold in the vicinity, are not distinctive in relation to the goods or services in respect of which they are used. Moreover, if the pictogram immediately conveys information about the kind, quality, intended


purpose or other characteristics of the goods or services, it will also be objectionable under Article 4(1)(d) of the **Law**.

Examples of refused trademarks

Sign	Reasoning	Case No
	<p>Taking into account the kind of goods and services for which protection is sought in Classes 9, 35, 36, 38 and 42 (for example, cash dispensers, banking services), the public will see the sign as a practical indication or as directional arrows showing where the magnetic card has to be inserted into the distributor. The association of the triangles with the other elements of the trademark applied for means that the public concerned will perceive them as directional arrows. Consumers see this type of practical information every day in all kinds of places, such as banks, supermarkets, stations, airports, car parks, telephone boxes, etc. (paras 37-42).</p>	<p>02/07/2009, T-414/07, Main tenant une carte, EU: T:2009:242</p>
 <p>TM No 9 894 528 for goods in Class 9</p>	<p>This sign was refused as it is identical to the core of the international safety symbol for 'high voltage' or 'caution, risk of electric shock'. The device applied for, within the triangle denoting a hazard symbol, has been officially defined by ISO 3864 as the standard high voltage symbol. Because this sign essentially coincides with the customary international sign to indicate a risk of high voltage, it was refused, inter alia, under Article 7(1)(b) and (d) TMR. (Article 4(1)(c) and (e) and (f) of the Law)</p>	<p>21/09/2012, R 2124/2011-5, DEVICE OF LIGHTNING BOLT (fig.)</p>

 <p>Classes 9 and 38</p>	<p>Refused for goods in Class 9 and services in Class 38. An email system running on a computer or handheld device (e.g. tablet or mobile phone) must use 'icons' to represent the current status of an application or operation. There is no more apt 'icon' - which is nothing more than a small graphic representation of a program or file - to represent an electronic message than an envelope. The 'tick' indicates that something has been done correctly or that something has been checked (paras 16 and 17). It is well known what these kind of icons look like (para. 19).</p>	<p>05/04/2016, R 2256/2015-2, DEVICE OF AN OPEN ENVELOPE WITH A CHECK SIGN (fig.)</p>
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Example of accepted trademark



Sign	Reasoning	TM No
	<p>Accepted for goods and services in Classes 9 and 43.</p> <p>The representation does not have any direct discernible meaning in relation to the goods and services at issue.</p>	<p>TM No 16 314 494</p>

9. Common/Non-Distinctive Labels

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 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.

See the following examples:

Sign	Reasoning	Case No

 <p>TM No 4 373 403, filed as a three-dimensional mark claiming protection for goods in Class 16 (<i>Adhesive labels; adhesive labels for use with hand labelling appliances; and labels (not of textile)</i>)</p>	<p>The mark applied for is 'devoid of any distinctive character' and was refused under Article 7(1)(b) TMR (article 4(1)(c) of the Law) as it is as banal and ordinary as it is possible to get in relation to adhesive labels. The sign says a lot about the nature of the goods and very little, if anything, about the identity of the producer (para. 11).</p>	<p>22/05/2006, R 1146/2005-2, LABEL SHAPE (3D)</p>
 <p>TM No 9 715 319 for goods in Classes 6, 7, 8, 9 and 20</p>	<p>The mark was refused, as its basic shape combined only with a bright yellow colour could not, in the minds of the relevant professional and general public, serve to distinguish the goods for which protection was sought as originating from a particular undertaking. Here, the colour yellow may be perceived as a decoration for the goods, as well as for the purpose of attracting attention to the goods, without giving any specific information or precise message as to the commercial origin of the goods. In addition, as is generally known, bright yellow is commonly used in a functional way in relation to a wide range of goods, that is, inter alia, for increasing the visibility of objects, highlighting or warning. For these reasons, the relevant consumers will not recognise this colour as a trademark, but will perceive it as an alert or decoration.</p>	<p>15/01/2013, R 444/2012-2, DEVICE OF A LABEL IN COLOUR YELLOW (fig.)</p>

In the same way, the following marks were rejected:

 <p>TM No 11 177 912 claiming Classes 29, 30 and 31</p>	 <p>TM No 11 171 279 claiming Classes 29, 30 and 31</p>	 <p>TM No 10 776 599 claiming, inter alia, goods in Classes 32 and 33</p>
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In the two preceding cases, both the color and the shape of the labels are quite commonplace. The same reasoning applies to the stylized representation of the fruits in the last of the three cases. Furthermore, the said figurative element represents or at least strongly alludes to the ingredients of some of the claimed goods, such as, for example, *fruit juices*.

10. Shape Marks

10.1 Preliminary remarks

Shape marks are trademarks consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance. The term 'extending to' means that these marks cover not only shapes per se but also shapes that contain word or figurative elements such as logos or labels.

Article 4(1)(c) of the **Law** does not distinguish between different categories of trademarks in determining whether a trademark is capable of distinguishing the goods or services of one undertaking from those of other undertakings. In applying this uniform legal standard to different trademarks and categories of trademarks, a distinction must be made depending on consumer perception and market conditions. For signs consisting of the shape of the goods themselves, no stricter criteria apply than for other marks, but it may be more difficult to come to a finding of distinctiveness, as such marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark.

Shape marks can be grouped into three categories:


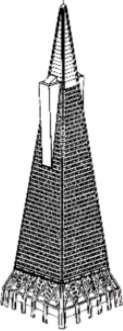
- shapes unrelated to the goods and services themselves;
- shapes that consist of the shape of the goods themselves or part of the goods;
- the shape of packaging or containers.

10.2 Shapes unrelated to the goods or services themselves

Shapes that are unrelated to the goods or services themselves (e.g. the Michelin Man) are usually distinctive.

Accepted trademarks

Sign	Reasoning	TM No
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	<p>Registered for goods in Classes 16 and 21</p> <p>The sign is clearly different to what is commonly expected for the corresponding goods (paper, rolls of paper for household use, kitchen utensils and containers, etc.).</p>	<p>TM No 1 705 367</p>
	<p>Registered for goods in Classes 36, 39 and 42 (insurance and financial services, rental and leasing of vehicles, and leasing of commercial and industrial equipment).</p> <p>The shape is unrelated to the goods and services and therefore perfectly capable of distinguishing them.</p>	<p>TM No 715 524</p>

10.3 Shape of the goods themselves or shapes related to the goods or services; shape of the packaging or containers

The cases for three-dimensional marks that consist of the representation of the shape of the product itself are also relevant for figurative marks consisting of two-dimensional representations of the product or elements of.

For a shape that is the shape or packaging of the goods applied for, the examination should be conducted in the following steps.

- Step 1: Assessment of the distinctiveness of the shape itself
- Step 2: Identification of the elements of the shape mark
- Step 3: Assessment of the distinctiveness of the sign as a whole

Step 1: assessment of the distinctiveness of the shape itself

The criteria for **distinctiveness of the shape itself** must be checked. The basic test is whether the shape is so materially different from basic, common or expected shapes that it enables a consumer to identify the goods just by their shape and to buy the same item again if he or she has had positive experiences with the goods. Frozen vegetables in the form of a crocodile are a good example of this.

The following criteria are relevant when examining the distinctiveness of shape trademarks 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. The more closely the shape resembles the shape that is most likely to be taken by the product in question, the greater the likelihood that it is not 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.

- Functional shapes or features of a shape mark will be perceived by the consumer as such. For example, for washing tablets, bevelled edges avoid damage to laundry, and layers of different colours represent the presence of different active ingredients.

While the public is accustomed to recognizing a shape mark as an indicator of source, this is not necessarily the case where the three-dimensional sign is indistinguishable from the product itself. Consequently, an assessment of distinctive character cannot result in different outcomes for a shape mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product.

Step2: identification of the elements of the shape mark

In the second step, the examiner should assess whether the representation of the shape mark extends to any other elements that might give the trademark distinctive character.

Step 3: assessment of the distinctiveness of the sign as a whole

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.

10.3.1 Elements and factors affecting the distinctiveness of the sign as a whole when the shape is non-distinctive (CP9)

As a starting point, if 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.

Sakpatenti will identify all the elements to which the shape mark extends and their inherent distinctiveness:

- verbal and figurative elements;
- colours (single and colour combinations);
- a combination of the above.

Where the shape extends to verbal/figurative elements, their identification and assessment of distinctiveness should include consideration of the following factors:

- size/proportion of the elements with respect to the shape;
- contrast of the element with respect to the shape;
- position of the element on the shape.

Where a shape extends to colour and colour combinations, their identification and assessment of distinctiveness should include consideration of the particular arrangement of colours on the specific shape.

10.3.1.1 Verbal and figurative elements

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.


10.3.1.1.1 Size/Proportion

The size and proportion of the elements must be taken into account when assessing the distinctive character of a shape mark. The assessment is first and foremost based on the representation of the sign, as submitted by the applicant, regardless of the usual size of the product. The distinctive element must be clearly visible in the representation to render the

sign distinctive as a whole. No specific proportions between the elements and the shape are required.


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

Distinctive example

Sign	Comments	Example
 <p data-bbox="225 837 560 904">Class 9 Secure digital memory cards</p>	<p data-bbox="596 557 1062 786">Despite the very small size of this type of memory cards, the verbal element is large in proportion to the shape and can clearly be identified as a distinctive element in the representation, thus rendering the sign as a whole distinctive.</p>	<p data-bbox="1190 719 1337 741">CP9 example</p>

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.




Non-distinctive example

Sign	Comments	Example
 <p data-bbox="293 1395 491 1417">Class 3 Cosmetics</p>	<p data-bbox="596 1196 1062 1464">In this example, despite the large non-distinctive verbal element on the non-distinctive shape, the sign is not distinctive as a whole. It contains descriptive information about the goods in question on a simple geometrical shape, which is also non-distinctive.</p>	<p data-bbox="1190 1305 1337 1328">CP9 example</p>

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

Distinctive examples

Sign	Comments	Example
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 <p>Class 18 Business card holders, in the nature of card cases</p>	<p>Small badges of origin are commonly used for goods such as business card holders or watches. Therefore, despite the small size of the verbal elements in proportion to the non-distinctive shapes, the sign as a whole is distinctive as the verbal elements can be identified as distinctive elements in the representation, rendering the sign as a whole distinctive.</p>	<p>CP9 examples</p>
 <p>Class 14 Watches</p>		
 <p>Class 12 Trucks</p>	<p>In this specific segment, badges of origin are usually relatively small in proportion to the goods. 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.</p>	<p>CP9 example</p>

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.

Non-distinctive examples

Sign	Comments	Example
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 <p data-bbox="316 1249 475 1279">Class 33 Wine</p>	<p data-bbox="608 248 1054 398">In these examples, the verbal/ figurative elements are so small that they cannot be identified in the representation and their distinctiveness cannot be determined.</p> <p data-bbox="608 412 1054 521">Therefore, they do not have sufficient impact on the overall impression and the sign as a whole is non-distinctive.</p>	<p data-bbox="1177 741 1337 770">CP9 examples</p>
 <p data-bbox="201 1603 584 1632">Class 9 Secure digital memory card</p>		


10.3.1.1.2 Contrast


The use of contrast can also affect the capacity of the verbal/figurative element(s) to be identified, and ultimately to render the sign distinctive as a whole. Contrast can be achieved by the use of different shades of colours or by embossing/engraving/ debossing certain elements on the specific goods.

1. Colour contrast

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.


Distinctive examples

Sign	Comments	Example
 <p data-bbox="325 1467 485 1496">Class 33 Wine</p>	<p data-bbox="638 495 1050 763">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.</p>	<p data-bbox="1189 958 1337 987">CP9 example</p>

 <p>Class 32 Bottled drinking water</p>	<p>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.</p>	<p>CP9 example</p>
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On the contrary, 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 this element and ultimately distinguish the sign from others.

Non-distinctive examples



Sign	Comments	Example
 <p>Class 28 Playing balls</p>	<p>In this case, the element (the gorilla, indicated by the arrow for clarity purposes only) 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.</p>	<p>CP9 example</p>


2. Engraving/Embossing/Debossing

Due to their nature, the colour of **engravings** (action of cutting or carving (a text or design) on the surface of a hard object), **embossings** (action of carving, moulding, or stamping a design on a surface or object so it stands out in raised relief) and **debossings** (action of carving, moulding, or stamping a design on (a surface or object) so that it stands out in recessed relief) might blend in with the product, making them harder to perceive and be identified. Nevertheless, engravings are frequently used to distinguish shape marks. The effect of engraving/embossing/debossing may influence the identification of the element and the overall assessment of the distinctiveness of the sign.


Distinctive examples

Sign	Comments	Example
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 <p>Class 32 Beverages</p>	<p>The embossed element can be identified as distinctive in the representation and therefore, the sign is distinctive as a whole.</p>	<p>CP9 example</p>
 <p>Class 16 Pencil boxes</p>	<p>The engraved element can also be identified as distinctive in the representation shown, therefore, the sign is distinctive as a whole.</p>	<p>CP9 example</p>
<p>Sign</p>	<p>Comments</p>	<p>Case No</p>

 <p>Classes 29, 30, 32</p>	<p>Accepted</p>	<p>TM No 12 485 702</p>
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Non-distinctive examples

Sign	Comments	Example
 <p>Class 11 Toaster</p>	<p>The engraved figurative element does not have enough contrast with respect to the shape and therefore cannot be clearly identified in the representation. It therefore cannot render the sign as a whole distinctive.</p>	<p>CP9 example</p>

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


Sign	Comments	Example
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Class 32 Bottled drinking water

This non-distinctive element (simple geometric shape – circle) which has been engraved on the non-distinctive shape does not bring distinctiveness to the sign as a whole. The overall impression is non-distinctive as the consumer will not be able to distinguish this good as originating from a specific undertaking.

CP9 example

	<p>An image depicting certain stones is embossed on the central part of the bottle.</p> <p>The Court confirmed the BoA decision when it considered that the applicant had failed to prove that European consumers have sufficient information and knowledge to recognise that the embossing on the central part of the bottle at issue depicts the twelve-angle stones used in Inca constructions. Without that proof, European consumers will merely perceive the embossing as such without being aware of its significance, from which it follows that they will simply perceive it as a mere decoration without any distinctive character, because it is not particularly original or striking; therefore, it will not serve to differentiate the bottle in question from other bottles widely used in the packaging of beers (para. 25 et seq.).</p>	<p>12/07/2012, T-323/11, Botella, EU: T:2012:376</p>
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10.3.1.1.3 Position

The position of an element will affect its capacity to be identified as distinctive or not, and ultimately convey a distinctive character to the sign.

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 trademark application.

Distinctive examples

Sign	Comments	Example
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 <p>Class 32 Bottled drinking water</p>	<p>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.</p> <p>Although signs of origin are not commonly placed in the bottom part of a bottle, as shown in the last example, this possibility cannot be excluded.</p>	<p>CP9 examples</p>
 <p>Class 32 Bottled drinking water</p>		
 <p>Class 25 Shoes</p>	<p>Badges of origin can be commonly found on the insole of shoes. In this case, the distinctive element has been placed in an expected position, and it can clearly be identified as distinctive in the representation, therefore, it is able to render the sign distinctive as a whole.</p>	<p>CP9 example</p>

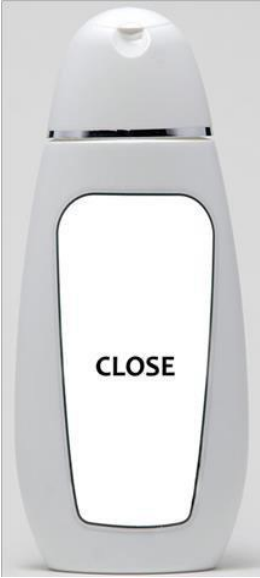

Non-Distinctive examples

Sign	Comments	Example
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 <p>Class 33 Wine</p>	<p>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.</p>	<p>CP9 example</p>
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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 Sign	Non-distinctive Sign	Comments	Example
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		<p>The verbal element 'CLOSE' bears no relation to the goods in Class 3.</p> <p>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.</p> <p>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.</p>	<p>CP9 example</p>
<p>Class 3 Cosmetics</p>	<p>Class 3 Cosmetics</p>		

10.3.1.2 Colours

The situations in which colours cannot provide distinctiveness to the goods can be the following:



- in many instances, a colour would merely be 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. the colour red for fire extinguishers, various colours used for electric cables);
- a colour may also be usual (e.g. again, red for fire extinguishers);
- a colour may indicate a particular characteristic of the goods, such as a flavour (yellow for lemon flavour, pink for strawberry flavour).

A colour is not normally inherently capable of distinguishing the goods of a particular undertaking. Therefore, a single colour will in principle not be distinctive for any goods and services except under exceptional circumstances. In all cases, the examination will require a case-by-case analysis.

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.

Non-distinctive examples


Sign	Comments	Example
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 <p>Class 9 Memory card</p>	<p>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>CP9 example</p>
	<p>This representation of a tablet for <i>washing or dishwashing preparations in tablet form</i> was refused. The shape, namely a rectangular tablet, is a basic shape and an obvious one for a product intended for use in washing machines or dishwashers. The slightly rounded corners of the tablet and the colour chosen are not of a kind to attract the consumer's attention, so the overall impression will not indicate commercial origin (19/09/2001, T-30/00, red-white squared washing tablet (fig.), EU:T:2001:223, § 43-44, 53). The same approach has been confirmed by several judgments, including that of 04/10/2007, C-144/06 P, Tabs (3D), EU:C:2007:577.</p>	<p>19/09/2001, T-30/00, red-white squared washing tablet (fig.), EU:T:2001:223</p>


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.

Distinctive example

Sign	Comments	Example
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	<p>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.</p>	<p>CP9 example</p>
<p>Class 7 Wind turbine</p>		

Non-distinctive example

Sign	Comments	Example
	<p>For mobile phone cases, use of colour combinations is common in the market. Therefore, the consumer will not perceive this colour combination as an indication of origin, but as mere decoration for these goods. The sign is not distinctive as a whole.</p>	<p>CP9 example</p>
<p>Class 9 Mobile phone cases</p>		

10.3.1.3 Combinations of factors and elements


There are 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 determining the impact of the elements on 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.

10.3.1.3.1 Combination of factors


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.

Non-distinctive examples

Sign	Comments	Example
 <p data-bbox="316 1505 470 1534">Class 33 Wine</p>	<p data-bbox="598 611 1061 965">The size, position and lack of contrasting colours of the verbal element result in a non-distinctive overall impression. The element cannot be identified as distinctive on the good without a very close inspection, as it has been placed in a less visible place on the bottle, using a very small size and a poor use of contrast. Therefore, it cannot render the mark distinctive as a whole.</p>	<p data-bbox="1189 1173 1337 1202">CP9 example</p>

	<p>The shape applied for was refused as it was considered that bunny-shaped chocolate with gold wrapping is a common phenomenon on the market corresponding to the industry concerned. An analysis of the individual elements, that is, the shape of a rabbit, the gold foil wrapping and the red ribbon with a bell, were held both individually and cumulatively devoid of distinctive character (paras 44-47).</p>	<p>24/05/2012, C-98/11 P, Hase, EU:C:2012:307</p>
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Distinctive example

Sign	Comments	Example
 <p>Class 9 Glasses</p>	<p>The size of the (verbal) element and its contrast with the goods enable it to be identified as distinctive: together, they give a distinctive overall impression.</p>	<p>CP9 example</p>

10.3.1.3.2 Combination of non-distinctive elements

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

Non-distinctive example


Sign	Comments	Example
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	<p>The verbal and figurative elements are non-distinctive as they provide descriptive information of the goods in question. Although placed in a central position on the shape, and despite their large size and sufficient contrast, they are unable to render the sign distinctive as a whole, as the consumer will not perceive the combination as a source of origin.</p>	<p>CP9 example</p>
<p>Class 33 Wine</p>		

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

Distinctive example


Sign	Comments	Example
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 <p>Class 30 Chocolate</p>	<p>The descriptive elements have been arranged in a way that they create the shape of a sun or a flower; a combination which can be perceived as a badge of origin and which therefore renders the sign distinctive as a whole.</p>	<p>CP9 example</p>
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10.3.1.3.3 Combination of distinctive and non-distinctive verbal/figurative elements and colours


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 among all the other elements.

Distinctive example

Sign	Comments	Example
 <p>Class 30 Chocolate</p>	<p>Despite the combination of many non-distinctive 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>CP9 example</p>

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

Non-distinctive example

Sign	Comments	Example
 <p>Class 30 Chocolate</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>	<p>CP9 example</p>

10.3.2 Shape of the goods themselves or shapes related to the goods or services

10.3.2.1 The specific case of toys, dolls and play figures

Applications for shape marks in respect of toys, dolls and play figures in Class 28, or for figurative marks consisting of a faithful representation of such goods, must be assessed in the **same way as for other shape marks**.

To be distinctive, the shape must depart significantly from the shape that is expected by the consumer. In other words, it must depart significantly from the norm or customs of the sector so that it enables a consumer to identify the goods just by their shape.


This may be complicated by the sheer volume and proliferation of toy animals, figures, dolls and assorted characters in this market sector. Simply adding a **basic set of clothing or basic human characteristics** such as eyes or a mouth to a common plush toy such as a rabbit or a cat will generally not suffice. It is commonplace to present toy dolls and animals in clothing and to provide a separate range of clothing options, so that the user of such goods can change the appearance of the toy. It is also common to humanise the toys to make them more attractive. Within such a high-volume marketplace, the presentation of these goods in such a way will invariably leave the relevant consumer struggling, without prior exposure, to perceive a badge of origin in such marks.




The more basic the character, the more unusual the additional elements must be in order to create a whole that serves to ensure that the relevant public is able to distinguish the applicant's goods from similar goods provided by other undertakings. The final conclusion must be based on the **appearance of the sign as a whole**.

10.3.2.2 Examples of shapes of the goods themselves or shapes related to the goods or services




The following is a list of examples of shapes of goods for which protection has been sought and an analysis of them (in relation with Article 4(1)(c) of the **Law only**).

Rejected product shapes

Sign	Reasoning	Case No
	<p>This shape was refused as it is merely a variant of a common shape of this type of product, i.e. <i>flashlights</i> (para. 31).</p>	<p>07/10/2004, C-136/02 P, Torches</p>

	<p>Three- dimensional sign is not being sufficiently different from the shapes commonly used in the chocolate sectors.</p>	<p>30/05/2016, N16-03/16, Chamber of Appeal</p>
	<p>This shape mark consisting of a handle, applied to goods in Class 8 (<i>hand-operated implements used in agriculture, horticulture and forestry, including secateurs, pruning shears, hedge clippers, shearers (hand instruments)</i>) was refused.</p>	<p>16/09/2009, T-391/07, Teil des Handgriffes, EU: T:2009:336</p>
	<p>The parrot figure applied for, on its own, does not depart sufficiently from the usual form of parrot toys to be seen as a trademark. Its coat colour resembles the green quite common among parrots. Its head is bigger than normal and it is standing on its hind legs but, in the Board's opinion, the majority of consumers would perceive the parrot shape as an ordinary parrot-shaped toy design, and a rather banal toy, but not as an indication of origin (para. 16).</p>	<p>R 2131/2013-5</p>

Accepted product shapes

Sign	Reasoning	TM No
	Accepted for <i>toys</i>	TM No 15 240 534
	Accepted for <i>ice creams</i>	TM No 10 350 593 Confirmed by the Boards of Appeal in R0590/2015-4
	Accepted in Class 9, <i>protective covers for mobile phones</i>	TM No 12 269 511

Analogous criteria, *mutatis mutandis*, apply to shapes related to services, for example the device of a washing machine for laundry services.

10.3.3 Shape of the packaging or containers

The shape applied for must be materially different from a combination of basic or common elements and must be striking. In the area of containers, regard must also be had to any functional character of a given element. As, in the field of containers and bottles, usage in trade might be different for different types of goods, it is recommended to make a search as to which shapes are on the market by choosing a sufficiently broad category of the goods concerned (i.e. in order to assess the distinctiveness of a milk container, a search must be carried out in relation to containers for beverages in general⁶;

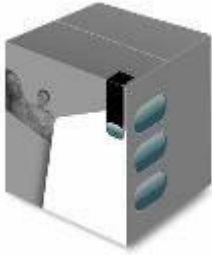
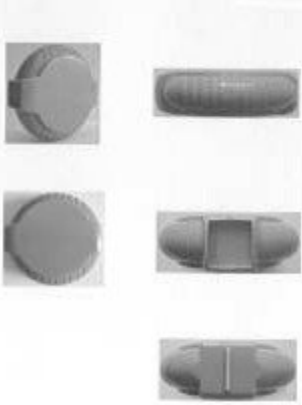
Examples of marks for which protection was sought for the shape of the packaging

⁶ the Opinion of the Advocate General of 14/07/2005, C-173/04 P, Standbeutel, EU:C:2005:474).

Rejected trademarks

Sign	Reasoning	Case No
	<p>The mark, the representation of a twisted wrapper serving as packaging for sweets (and thus not the product itself), was refused registration as it is a 'normal and traditional shape for a sweet wrapper and ... a large number of sweets so wrapped could be found on the market' (para. 56). The same applies in respect of the colour of the wrapper in question, namely 'light brown (caramel)'. This colour is not unusual in itself, and neither is it rare to see it used for sweet wrappers (para. 56). Therefore, the average consumer will not perceive this packaging in and of itself as an indicator of origin, but merely as a sweet wrapper.</p>	<p>10/11/2004, T-402/02, Bonbonverpackung, EU: T:2004:330</p>
	<p>The refusal of the shape applied for was confirmed by the General Court. The elongated neck and the flattened body do not depart from the usual shape of a bottle containing the goods for which protection was sought, namely food products including <i>juices, condiments and dairy products</i>. In addition, neither the length of the neck, its diameter nor the proportion between the width and thickness of the bottle is in any way individual (para. 50). Furthermore, even if the ridges around the sides of the bottle could be considered distinctive, these alone are insufficient to affect the overall impression given by the shape applied for to such an extent that it departs significantly from the norm or customs of the sector (para. 53).</p>	<p>15/03/2006, T-129/04, Plastikflaschenform, EU: T:2006:84</p>
	<p>The shape does not depart significantly from the norms and customs of the sector, 'where what is involved is the packaging of a liquid product and the sign consists of the appearance of the product itself'.</p>	<p>07/05/2015, C-445/13 P, Bottle, EU:C:2015:303, confirming 28/05/2013, T-178/11, Bottle, EU: T:2013:272</p>

Accepted trademarks

Sign	Reasoning	Case No
	<p>Accepted for goods in Classes 4 and 11</p>	<p>TM No 12 491 858</p>
	<p>The Board of Appeal annulled the decision refusing the registration of the shape mark for <i>chewing gums and other confectionery</i>. The Board of Appeal considered that the shape is not common in the market sector in question.</p>	<p>R 832/2012-2</p>

11. Position Marks

Position marks are trademarks consisting of the specific way in which the mark is placed on or affixed to the product.

Applications for position marks effectively seek to extend protection to the specific way in which elements (figurative, colour, etc.) are placed on or affixed to the product.

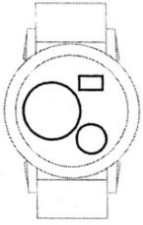

The factors to be taken into account when examining shape marks are also relevant for position marks. In particular, the examiner must consider whether the relevant consumer will be able to identify a sign that is different from the normal appearance of the products themselves. A further relevant consideration in dealing with position marks is whether the positioning of the mark upon the goods is likely to be understood as having a trademark context.

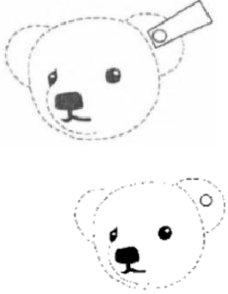
Note that even where it is accepted that the relevant public may be attentive to the different aesthetic details of a product, this does not automatically imply that they will perceive it as a trademark. In certain contexts, and given the norms and customs of particular trades, a position mark may appeal to the eye as an independent feature being distinguishable from the product itself and thus communicating a trademark message.

Examples


The following are examples of the assessment of position marks.

Rejected position marks

Sign	Reasoning	Case No
	<p>In this case, the General Court upheld an objection under Article 7(1)(b) TMR and article 4(1)(c). The mark description specified that 'The mark consists of the position of the circular and rectangular fields on a watch face'. The Court considered that the mark was not independent or distinguishable from the form or design of the product itself and that the positioned elements were not substantially different from other designs on the market.</p>	<p>14/09/2009, T-152/07, Uhr</p>
	<p>In this case involving hosiery consisting of an orange strip covering the toe area, the General Court considered that there was no evidence to suggest that the colouring of this part of the product would normally be perceived as having trademark character. On the contrary, it was considered that this feature would be likely to be perceived as a decorative feature falling within the norms and customs of the market sector. The Article 7(1)(b) TMR and article 4(1)(c) of the Law objection was therefore maintained.</p>	<p>15/06/2010, T-547/08, Strumpf, EU:T:2010:235</p>

	<p>Buttons are common decorative elements of soft toys. A button is a simple geometrical form that does not depart from the norm or customs of the sector. It is not uncommon to attach badges, rings, ribbons, loops and embroidery to the ears of a soft toy. The relevant public will therefore perceive the two signs applied for as ornamental elements but not as an indication of commercial origin.</p>	<p>16/01/2014, T-433/12, Knopf im Stofftierohr, EU:T:2014:8 & 16/01/2014, T-434/12, Fähnchen im Stofftierohr, EU:T:2014:6</p>
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Accepted position mark

Sign	Description	TM No
	<p>Class 25 Description: the trademark is a position mark. It 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 trademark on the shoe, and does not form part of the trademark.</p>	<p>TM No 13 755 244</p>

12. Pattern Marks

Pattern marks are trademarks consisting exclusively of a set of elements that are repeated regularly.

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., that is to say, 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 for which protection is sought.

It must also be taken into account that when a pattern mark claims protection for goods such as beverages or fluid substances in general, that is to say, goods that are 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.

It follows from the above that, 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.

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.

In principle, 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. Paradoxically, the same applies to patterns composed of extraordinarily complex designs. In these cases the complexity of the overall design will not allow the design's individual details to be committed to memory⁷. Indeed, in many cases the targeted public would perceive patterns as merely decorative elements.

In this regard, it must be taken into account that the average consumer tends not to look at things analytically. A trademark must therefore enable average consumers of the goods/services in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention⁸

The fact that the pattern may also have other functions and/or effects is an additional argument for concluding that it lacks distinctive character. By contrast, 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 usually deserves protection as an TM.

As seen above, the distinctive character of pattern marks must usually be assessed with regard to goods. Nevertheless, a pattern mark that has been considered devoid of distinctive character for the goods it covers must also be regarded as lacking distinctiveness for services that are closely connected to those goods. For example, a stitching pattern that is devoid of distinctive character for clothing articles and leather goods must be regarded as lacking distinctiveness also for retail services concerning those goods⁹. The same considerations would apply to a fabric pattern with regard to services such as *manufacture of fabrics*.

Examples of pattern marks



Rejected pattern marks

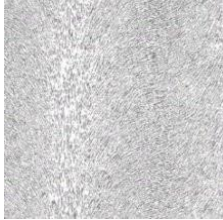
Sign	Reasoning	Case No
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⁷ (09/10/2002, T-36/01, Glass Pattern, EU:T:2002:245, § 28)

⁸ (12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 53; 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 29).

⁹ (see, by analogy, decision of 29/07/2010, R 868/2009-4, DEVICE OF A POCKET (fig.))

 <p>TM No 8 423 841, filed as a figurative mark in Classes 18, 24 and 25</p>	<p>The criteria for shape marks consisting of the appearance of the product itself are also applicable to figurative marks consisting of the appearance of the product itself. In general, a mark consisting of a decorative pattern that is simple and commonplace is considered devoid of any element that could attract the consumers' attention, and insufficient to indicate the source or origin of goods or services. The above pattern mark was a textile pattern and therefore considered to comprise the appearance of the goods itself, as the mark was applied for in Classes 18, 24 and 25.</p>	<p>19/09/2012, T-326/10, Stoffmuster, EU:T:2012:436, § 47-48</p>
 <p>TM No 8 423 501, filed as a figurative mark in Classes 18, 24 and 25</p>	<p>In this case, similarly to the previous case, the General Court confirmed the refusal of the mark.</p>	<p>19/09/2012, T-329/10, Stoffmuster</p>

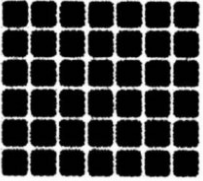


TM No 3 183 068, filed as a figurative mark, for goods in Classes 19 and 21



The mark, which was to be applied to glass surfaces, was refused under Article 7(1)(b) TMR (article 4(1)(c) of the Law). It was reasoned that the relevant consumer is not used to perceiving designs applied to glass surfaces as an indication of origin and that the design is recognisable as a functional component to make the glass opaque.

Furthermore, the complexity and fancifulness of the pattern are insufficient to establish distinctiveness, attributable to the ornamental and decorative nature of the design's finish, and do not allow the design's individual details to be committed to memory or to be apprehended without the product's inherent qualities being perceived simultaneously.

09/10/2002, T-36/01, Glass Pattern, § 26-28

 <p>TM No 10 144 848, filed as a figurative mark for goods in Classes 3, 5, 6, 10, 11, 12, 16, 18, 20 and 21</p>	<p>The mark was refused as it is composed of very simple elements and is a basic and banal sign as a whole. For the claimed goods, such as <i>cleaning cloths</i> and <i>antiseptic wipes</i>, the sign applied for can represent their appearance in the sense that the fabric used may have this structure. The sign is merely a repetition of identical squares that does not display any element or noticeable variation, in particular in terms of fancifulness or as regards the way in which its components are combined, that would distinguish it from the usual representation of another regular pattern consisting of a different number of squares. Neither the shape of each individual square nor the way they are combined is an immediately noticeable feature that could catch the average consumer's attention and cause the consumer to perceive the sign as a distinctive one.</p>	<p>14/11/2012, R 2600/2011-1, DEVICE OF A BLACK AND WHITE PATTERN (fig.)</p>
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Accepted pattern marks

Sign	Reasoning	TM No
	<p>Classes 16, 18, 25</p>	<p>TM No 15 602</p>
	<p>Classes 18, 20, 21, 24, 25, 27</p>	<p>TM No 3 191 301</p>

13. Colour Marks

13.1 Single Colours

13.2 Colour combinations

14. Sound Marks

The definition of sound marks is restricted to only those that consist exclusively of a sound or a combination of sounds.

The acceptability of a sound mark must, like words or other types of trademarks, depend upon whether the sound is distinctive per se, that is, whether 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.

Consumers are not in the habit of making assumptions about the origin of goods in the absence of any graphic or word element, because generally a sound per se is not commonly used in any field of commercial practice as a means of identification.

The perception of the relevant public is not necessarily the same in the case of a sign consisting of a sound per se as it is in the case of a word or figurative mark consisting of a sign that bears no relation to the appearance of the goods it denotes. While the public is accustomed to perceiving word or figurative marks instantly as signs identifying the commercial origin of the goods, the same is not necessarily true where the sign is merely a sound¹⁰ By the same token, **only a sound that departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin** is not devoid of any distinctive character for the purposes of Article 7(1)(b) TMR (article 4(1)(c) of the Law)¹¹

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

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

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.

Chapter 4 Descriptive trademarks (Article 4(1)(d) of the Law

1. General Remarks

1.1 The notion of 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. This is the case where the sign provides information about, inter alia, the quantity, quality, characteristics, purpose, kind and/or size of the goods or services. The relationship between the term and the goods and services must be sufficiently direct and specific, as well as concrete, direct and understood without further reflection. If a mark is descriptive, it is also non-distinctive.

¹⁰ (see, by analogy, judgment of 04/10/2007, C-144/06 P, Tabs (3D), EU:C:2007:577, § 36).

¹¹ (see, by analogy, judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 42).

Article 4(1)(d) of the **Law** does not apply to those terms that are only suggestive or allusive as regards certain characteristics of the goods and/or services. Sometimes this is also referred to as vague or indirect references to the goods and/or services.

The public interest underlying Article 4(1)(d) of the **Law** is that exclusive rights should not exist for purely descriptive terms that other traders might wish to use as well. However, it is not necessary for **Sakpatenti** to show that there is already a descriptive use by the applicant or its competitors. Consequently, the number of competitors that could be affected is totally irrelevant. Therefore, if a word is descriptive in its ordinary and plain meaning, this ground for refusal cannot be overcome by showing that the applicant is the only person who produces, or is capable of producing, the goods in question.

1.2 The reference base

The **reference base** is the ordinary understanding of the relevant public of the word in question. That can be corroborated by **dictionary entries**, examples of the use of the term in a descriptive manner found on internet **websites**, or it may clearly follow from the **ordinary understanding** of the term.

It is not necessary for **Sakpatenti** to prove that the word is the subject of a dictionary entry in order to refuse a sign. In particular for composite terms, dictionaries do not mention all possible combinations. What matters is the ordinary and plain meaning. In addition, terms used as specialized terminology to designate the respective relevant characteristics of the goods and services are to be considered descriptive. In these cases, it is not required to demonstrate that the meaning of the term is immediately apparent to the relevant consumers to which the goods and services are addressed. It suffices that the term is meant to be used or could be understood by part of the relevant public, as a description of the goods or services for which protection is sought, or a characteristic of the goods and services.

Article 4(1)(d) of the **Law** can apply to **transliterations if the mark is perceived as such**. In particular, transliterations of Georgian words into Latin characters must be treated in the same way for the purpose of examining absolute grounds for refusal as words written in Georgian characters and vice versa. This is because the Latin alphabet is known to Georgian-speaking consumers. The same applies to the Cyrillic alphabet.

The following principles in respect of both language and dictionary use apply, with regard to the reference base.

Languages

- Georgian Language

The sign must be rejected if it is descriptive in Georgian and Abkhazian language,

Under certain circumstances, consideration must be given to the understanding by the relevant public of **terms from other languages**. This may be because, depending on the goods and services claimed in the Trademark application, the relevant public:

- has at least an **intermediate understanding** of the language in question and the sign consists of an intermediate word of that language - large proportion of Georgian consumers and professionals have an average knowledge of English and Russian;
- consists of **specialists** for whom certain technical terms in English and Russian are understood;

- understands the meaning in cases where a term in one language (e.g. English) has **entered into the dictionary or parlance** of Georgian Language) and acquired a descriptive character that may or may not exist in the original language.

In some specific cases, a sign will be refused if it is descriptive in a language which is not an official language of Georgia (for example in a language of a minority living in Georgia).

For instance following should be refused based on the fact that these terms are descriptive:

- медведь: Russian expression for the word 'bear'. Should be refused for *meat* in Class 29. The relevant public includes the Russian-speaking public of Georgia
- ZERNO – Even though, the mark is composed in Latin alphabet, it is a transliteration of Russian word - ЗЕРНО (Grain). The mark should be refused for vodka in Class 33.
- “АЛКОДЕТОКС” – contains simple juxtaposition of two shortened Russian words „АЛКОГОЛЬ“ and „ДЕТОКСИКАЦИЯ“, which is almost identical to the Georgian words – “ალკოჰოლი” და “დეტოქსიფიკაცია”. Therefore, the meaning of the mark is easily perceived by the relevant Georgian public (Chamber of Appeal, N5-3/2021).

Evidence

The **evidence** can come by individual knowledge of the particular examiner or is produced via third-party under appeal proceedings at the **Chamber of Appeal**.

An internet search is also a valid means of evidence for the descriptive meaning, in particular for new terms, technical jargon or slang words, but the evidence should be carefully assessed in order to find out whether the word is actually used in a descriptive manner, as often the difference between descriptive and trademark use on the internet is vague and the internet contains a vast amount of unstructured, unverified information or statements.

1.3 Characteristics mentioned under Article 4(1)(d) of the Law

The term 'characteristic' in Article 4(1)(d) of the **Law** designates a property, easily recognizable by the relevant public for the goods or the services in respect of which registration is sought. Consequently, a sign can be refused registration under this provision only if it is reasonable to believe that it will actually be recognized by the relevant public as a description of one of those characteristics.

It is irrelevant whether this characteristic is commercially essential or ancillary. However, a characteristic within the meaning of Article 4(1)(d) of the **Law** must be 'objective' and 'inherent to the nature of that product' or service and 'intrinsic and permanent' with regard to that product or service.

Kind of goods and services

This includes the goods or services themselves, that is, their type or nature. For example, 'bank' for financial services, Qvevri for wines.

Quality

This includes both laudatory terms, referring to a superior quality of the respective goods or services, as well as the inherent quality of the goods or services. It covers terms such as 'light', 'extra', 'fresh', 'hyper light' for goods that can be extremely light. In addition, figures may refer to the quality of a product or a service, such as 24/7 for service availability; '2000', which refers to the size of the motor or '75', which refers to the horsepower (kW) of the motor.

Quantity

This covers indications of the quantity in which the goods could be sold, such as 'six pack' for beer, 'one litre' for drinks, '100' (grams) for chocolate bars. Only quantity measurements relevant in trade, not those that are hypothetically possible, count. For example, 99.999 for bananas would be acceptable.

Intended Purpose

The intended purpose is the function of a product or service, the result that is expected from its use or, more generally, the use for which the good or service is intended. Marks that may be rejected on this basis include 'Therapy' for massage tools and 'Slim belly' for fitness training apparatus, sport activities, medical and beauty care services. This rejection also applies as regards accessories: a term that described the type of goods also describes the intended purpose for accessories to those goods. Therefore, 'bass' is liable to objection for accessories for rock guitars

Value

This covers both the (high and low) price to be paid, as well as the value in quality. It therefore does not only refer to expressions such as 'extra' or 'top', but also expressions such as 'cheap' or 'more for your money'. It also includes expressions indicating, in common parlance, goods or services that are superior in quality.

Geographical origin

See paragraph 2.6 below.

Time of production of goods or of rendering of the service

This covers expressions concerning the time at which services are rendered, either expressly ('evening news', '24 hours') or in a usual manner (24/7). It also covers the time at which goods are produced if that is relevant for the goods (late vintage for wine). For wine, the numeral '1998' indicating the vintage year would be relevant, but not for chocolate.

Other characteristics

This covers other characteristics of the goods or services and shows that the preceding list of items in Article 4(1)(d) is not exhaustive. In principle, any characteristic of the goods and services must lead to a refusal under Article 4(1)(d) of the **Law**. It does not matter whether the characteristics of the goods or services are commercially essential or merely ancillary or whether there are synonyms of those characteristics.

Examples of 'other characteristics'

- the subject matter contained within the goods or services for which protection is sought: (see paragraph 2.7 below);
- the identification of the targeted consumer: 'children' for toothbrush.

2. Word Marks

2.1 One word

Descriptive terms are those that merely consist of information about the characteristics of the goods and services. This means that descriptive terms cannot fulfil the function of a trademark. Consequently, the ground for refusal applies irrespective of whether a term is already used by other competitors in a descriptive manner for the goods and services at issue.

In particular, a word is descriptive if either for the general public (if the goods or services target them) or for a specialised public (irrespective of whether the goods or services also target the general public) the trademark has a descriptive meaning.

The term 'Vegetarian' is descriptive for Services for providing food in Class 43.

'Terrier' is descriptive for 'live animals, that is to say, dogs' and 'the keeping and breeding of dogs, that is to say, puppies and animals for breeding'. Indeed, the word 'Terrier' indicates a breed of dogs.

'Hexagonal' is descriptive for screws. It would be immediately perceived by professionals as describing the fact that the screw has a hexagonal-shaped head.

However, it is important to distinguish laudatory terms that describe — although in general terms — desirable characteristics of goods and services as being cheap, convenient, of high quality, etc. and that are excluded from registration, from those terms that are laudatory in a broader sense, that is to say, they refer to vague positive connotations or to the person of the purchaser or producer of the goods without specifically referring to the goods and services themselves.

Not descriptive:

- 'BRAVO', as it is unclear who says 'BRAVO' to whom, and what is being praised.

2.2 Combinations of words

As a general rule, a **mere combination of elements**, each of which is descriptive of characteristics of the goods or services themselves, remains descriptive of those characteristics. Merely bringing those elements together without introducing unusual variations, in particular as to syntax or meaning, cannot result in anything other than a descriptive sign.

However, if due to the **unusual nature of the combination** in relation to the goods or services, a combination creates an **impression that is sufficiently far removed** from that produced by the mere combination of meanings lent by the elements of which it is composed, that

combination will be considered **more than the sum of its parts**. These notions, 'unusual nature of the combination', 'impression sufficiently far removed' and 'more than the sum of its parts' have to be interpreted as meaning that Article 4(1)(d) of the **Law** does not apply when the way in which the two descriptive elements are combined is in itself fanciful.

The following examples have been **refused** registration:

- 'ULTRA CARBON' for inter alia, deodorants and antiperspirants for personal use (26/01/2021, 101-3/2020 Chamber of appeal);
- 'Биокальций' for toothpastes in Class 3 (12/06/2020, 32-3/2020 Chamber of appeal);
- 'EURO HOME' for, inter alia, Non-metallic building materials in class 19 (30/04/2019, 21-3/2019 Chamber of appeal).

In the same way, combinations of the prefix 'EURO' or 'GEO' with purely descriptive terms must be refused where the 'EURO' or 'GEO' element reinforces the descriptiveness of the sign as a whole or where there is a reasonable connection between that term and the goods or services concerned.

The following sign has been accepted for registration:

- 'Fashion nova' for goods Class 25 (26/07/2021, 61-3/2021 Chamber of appeal)

Combinations not following grammatical rules

A combination of words can be considered a descriptive indication even though it does not follow the usual grammatical rules. If, however, the combination does amount to more than the mere sum of its parts, it may be acceptable.

- 'HIPERDRIVE' is considered descriptive of the intended purpose of setting devices for tools, despite the misspelling of the adjective 'hyper' as 'hiper'¹²

Furthermore, in the world of advertising, definite articles and pronouns (the, it, etc.), conjunctions (or, and, etc.) or prepositions (of, for, etc.) are frequently omitted. This means that a lack of these grammatical elements will sometimes not be sufficient to make the mark distinctive.

Combinations of adjectives + nouns or verbs

For combinations consisting of **nouns and adjectives**, it should be assessed whether the meaning of the combination changes if its elements are inverted. For example, 'Vacations direct' is tantamount to 'direct vacations', whereas 'BestPartner', is not the same thing as 'PartnerBest'.

The same reasoning applies to words consisting of the **combination of an adjective and a verb**.

Therefore, the word 'ULTRA CARBON' must be considered descriptive for deodorants, even though it consists of the combination (grammatically incorrect) of an adjective (ULTRA) with a verb (CARBON), since its meaning remains clearly understandable.

Combinations of words in different languages

¹² (22/05/2014, T-95/13, Hiperdrive, EU:T:2014:270, § 33-42).

Combinations made up of words from different languages may still be liable to objection if the relevant consumers will understand the descriptive meaning of all the elements without further effort. This may be the case, in particular, when the sign contains basic terms in a language that will be understood easily by the speakers of another language, or if the terms are similar in both languages. For instance, if a mark is composed of one basic descriptive term belonging to language 'A' and another descriptive word in language 'B', the sign as a whole will remain descriptive when it is assumed that the speakers of language 'B' will be able to grasp the meaning of the first term.

Applications that consist of descriptive words or expressions repeated in various languages are a special case in the sense that they are mere translations of each other. These trademarks should be considered descriptive if the relevant consumer will grasp that each of the words or expressions is in fact merely the translation of a descriptive meaning, for example, because the proximity of the terms contained in the mark to each other will lead the consumer to understand that they all have the same descriptive meaning in different languages. For instance:

- ქართული ღვინო Georgia wine ГРУЗИНСКОЕ ВИНО for Class 33.

The following example should be **refused**:

- classic ღვინო for Class 33

2.3 Misspellings and omissions

A misspelling does not necessarily change the descriptive character of a sign. First of all, words may be misspelt due to influences from another language or the spelling of a word in areas, such as American English, in slang or to make the word more fashionable. Examples should be refused:

- 'Xtra'
- 'FRESHHH'
- 'grandblu' for blue cheese (application number – 81347/3)

Furthermore, consumers will, without further mental steps, understand the '@' as the letter 'a' or the word 'at' and the '€' or '£' as the letters 'e' or 'l'. Consumers will replace specific numerals by words, for example, '2' as 'to' or '4' as 'for'.

However, if the misspelling is fanciful and/or striking or changes the meaning of the word (accepted: 'D'LICIOUS', (instead of 'delicious'), 'FANTASTICK', (instead of 'fantastic')), the sign is acceptable.

As a rule, misspellings endow the sign with a sufficient degree of distinctive character when:

- they are striking, surprising, unusual, arbitrary and/or;
- they are capable of changing the meaning of the word element or require some mental effort from the consumer in order to make an immediate and direct link with the term that they supposedly refer to.

2.4 Abbreviations and acronyms

Abbreviations of descriptive terms are in themselves descriptive if they are used in that way, and the relevant public, whether general or specialised, recognises them as being identical to

the full descriptive meaning. The mere fact that an abbreviation is derived from a descriptive term is not sufficient¹³

The following sign was refused because the descriptive meaning for the relevant public could clearly be shown:

- Face ID (03/04/2019, № 5-3/2019, Chamber of Appeal)

Note that use of internet databases such as 'AcronymFinder.com' as a reference base should be made with due consideration. Use of technical reference books or scientific literature is preferable, for example, in the field of computing. Alternatively, use of the abbreviation by a number of traders in the appropriate field on the internet is sufficient to substantiate actual use of the abbreviation.

Signs consisting of an independently non-descriptive acronym that precedes or follows a descriptive word combination should be objected to as descriptive if it is perceived by the relevant public as merely a word combined with an abbreviation of that word combination, for example 'Multi Markets Fund MMF'. This is because the acronym and word combination together are intended to clarify each other and to draw attention to the fact that they are linked¹⁴ This will be the case even where the acronym does not account for the mere 'accessories' in the word combination, such as articles, prepositions or punctuation marks, such as in the following example: 'The Statistical Analysis Corporation — SAC'.

While the above rule will cover most cases, not all instances of descriptive word combinations juxtaposed with an abbreviation of that word will be considered descriptive as a whole. This will be the case where the relevant public will not immediately perceive the acronym as an abbreviation of the descriptive word combination, but rather as a distinctive element that will make the sign as a whole more than the sum of its individual parts, as demonstrated in the following example:

- 'The Organic Red Tomato Soup Company — ORTS'.

2.5 Slogans

A slogan gives rise to an objection under Article 4(1)(d) of the **Law** when it immediately conveys the kind, quality, intended purpose or other characteristics of the goods or services.

The criteria determining whether a slogan is descriptive or not are identical to those applied in the case of a word mark containing only a single element. It is inappropriate to apply criteria to slogans that are stricter than those applicable to other types of signs, especially considering that the term 'slogan' does not refer to a special subcategory of signs.

Example of a descriptive slogan

- An application in Class 9 (*satellite navigation systems*, etc.) for 'FIND YOUR WAY', should be objected to under Article 4(1)(c) and (d) of the **Law**.

The expression 'FIND YOUR WAY' in relation to the goods applied for in Class 9 is clearly intended to inform the relevant consumer that the appellant's goods help consumers to identify geographical locations in order to find their way. The message conveyed by the sign applied

¹³ (13/06/2014, T-352/12, Flexi, EU:T:2014:519).

¹⁴ (15/03/2012, C-90/11 & C-91/11, Natur-Aktien-Index / Multi Markets Fund, EU:C:2012:147, § 32, 34, 40).

for directly refers to the fact that consumers will discover the route for travelling from one place to another when using the specified goods.

Example of a non-descriptive slogan

- 'WET DUST CAN'T FLY' does not describe the way in which the cleaning preparations, appliances and services in Classes 3, 7 and 37 operate. Cleaning preparations are not designed to moisten dust in order to prevent it from dispersing, but to make the dirt disintegrate and disappear. Cleaning appliances filter the dust through liquids but are not designed to dampen the dust in order to prevent it from flying.
- „არგაჩერდე“ (don't stop!) for class 36
- „აქ. ახლან“ (Here, now) for class 36

2.6 Geographical terms

2.6.1 Preliminary remarks

A geographical term is every existing name of a place, for example a country, region, city, lake or river. This list is not exhaustive. Adjectival forms are not sufficiently different from the original geographical term to cause the relevant public to think of something other than that geographical term. For example, 'Georgian' will still be perceived as referring to Georgia, and 'French' will still be perceived as referring to France. Furthermore, outdated terms such as 'Ceylon', 'Bombay' and 'Burma' fall within this scope if they are still commonly used or generally understood by consumers as a designation of origin.

It is in the **public interest** that signs that may serve to designate the geographical origin of goods or services remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer preferences by, for instance, associating the goods or services with a place that may elicit a favourable response.

This paragraph (2.6) uses the words 'geographical term' to refer to **any** geographical indication in an Trademark application, whereas the terms 'protected geographical indication' and 'protected designation of origin' are used **only** in the context of specific legislation protecting them. Designations of origin and geographical indications protected are dealt with under Article 5(e) of the **Law**.

2.6.2 Assessment of geographical terms

The registration of geographical names as trademarks is not possible where such a geographical name is either **already famous**, or is **known for the category of goods concerned**, and is therefore **associated** with those goods or services in the mind of the relevant class of persons, or it is **reasonable to assume** that the term may, in view of the relevant public, designate the geographical origin of the category of goods and/or services concerned.

As with all other descriptive terms, the test is whether the geographical term **describes objective characteristics of the goods and services**. The assessment must be made with reference to the goods and services for which protection is sought **and** with reference to the perception by the relevant public.

Under this part of the Guidelines, the descriptive character of the geographical term may relate to:

- the place of production of the goods;
- the place where the goods were conceived and designed;
- the place where the services are rendered;
- the place that influences consumer preferences (e.g. lifestyle) by eliciting a favourable response.

The use of geographical names as trademarks is also dealt with in other parts of the Guidelines. For example, where such a sign indicates the subject matter of the goods and/or services, the relevant part of the Guidelines applies (i.e. paragraph 2.7 below on subject matter).

The following two-step assessment must be carried out when assessing geographical names as trademarks.

First step: term is understood by the relevant public as a geographical name. The **first step** in assessing a geographical term is to determine whether it is understood as such by the relevant public. Article 4(1)(d) of the **Law** does not in principle preclude the registration of geographical names that are unknown to the relevant public — or at least unknown as the designation of a geographical location. Whether or not this is the case will be determined by taking as a basis a reasonably well-informed consumer who has sufficient common knowledge but is not a specialist in geography. For rejecting the application, Sakpatenti must prove that the geographical term is known by the relevant public as designating a place.

Second step: term either (a) designates a place associated with the goods and services or (b) may be reasonably assumed to designate the geographical origin of the goods and services. The second step is to determine whether the geographical term applied for designates a place that **is currently** associated with the claimed goods or services in the mind of the relevant public or whether **it is reasonable to assume** that it will be associated with those goods or services in the future, or whether such a name may, in the mind of the relevant public, designate the geographical origin of that category of goods or services.

In establishing whether such an association exists, the following factors should be taken into account, namely the degree of familiarity with:

- the geographical term;
- the characteristics of the place designated by the term; and
- the category of goods or services.

1. Places **currently associated** with the claimed goods or services

Geographical names that designate specified geographical locations that are already famous or are known for the category of goods or services concerned, and that are therefore associated with that category in the mind of the relevant class of persons, may not be registered as trademarks.

For example, 'Milano' should be refused for clothing, 'Frankfurt' for financial services, 'Islas Canarias' for sightseeing, tour guide and excursion services and 'Switzerland' for banking services, cosmetic products, chocolate and watches.

2. **A reasonable assumption can be made** that a place will be associated with those goods or services in the future or that a name may, in the mind of the relevant public, designate the geographical origin of that category of goods or services.

In establishing whether the abovementioned assumption can reasonably be made, the following circumstances should be considered:

- There are some geographical terms, such as the names of regions or countries, that enjoy widespread recognition and fame for the high quality of their goods and/or services. **When a sign consists of such geographical terms**, there is no need for a detailed assessment of the association between **the place and each** (category) of the goods and/or services. Such signs may be refused on the basis of being perceived as a reference to the quality of the goods and/or services, namely that linked with the geographical term.

- Nature and size of the geographical location in question. There is generally a correlation between geographical size, variety of goods and/or services made available in the place concerned and corresponding knowledge or expectations on the part of consumers. In that regard, it is assumed that the name of a country will, in principle, be associated with the relevant goods and/or services and that the public will accordingly perceive a country name as an indication of the geographical origin of the goods and/or services. This assumption, however, does not automatically rule out the need for an assessment of whether or not the public actually establishes such a descriptive link between the sign and the goods and/or services. Moreover, in line with the nature of the location, its characteristics should be taken into account. Characteristics such as natural conditions, industries typical to the geographical location or a tradition of manufacturing the goods in question are important factors to be taken into account. The mere fact that some production of the relevant goods or provision of the relevant services is located in the geographical place in question is not per se sufficient to support the abovementioned assumption.

- Market sectors. It must be borne in mind that, in certain market sectors, such as the car or furniture industries, it is common to use place names without a real geographical connotation, for example to designate models or range of products.

It is **not necessary** to establish that the name actually designates the **true** geographical origin of the goods. It is enough to demonstrate that the connection between the name of the place and the goods may enable the relevant public to perceive the contested sign as an indication of the origin of those goods. A refusal on the grounds of Article 4(1)(d) of the **Law** cannot be based solely on the argument that the goods and/or services can **theoretically** be produced or rendered in the place designated by the geographical term.

Consequently, if it can be concluded that there is a particular relationship between the geographical place designated by the sign and the goods and/or services for which the protection is sought, Sakpatenti will reject the application.

The following mark was accepted by the Chamber of Appeal:

Sign	Reasoning	Appeal No
<p style="text-align: center;">VALPARAISO</p> <p>Class 30: <i>Confectionary</i></p>	<p>VALPARAISO is a seaport city with the population of approximately 300 000. Taking into account the population, location and the long distance of the city it cannot be known to the relevant public as a geographical name.</p>	<p style="text-align: center;">05-03/17, VALPARAISO</p>

The mere fact that a geographical term is used by only one producer is not sufficient to overcome an objection, although it is an important argument to be taken into account in assessing acquired distinctiveness.

The following marks should be refused:

Sign	Reasoning	Case No
<p>BRASIL</p> <p><i>Class 32: Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages. Class 33: Whisky; whisky- based beverages.</i></p>	<p>The mere existence of whisky production in Brazil was not sufficient in itself to presume that the relevant consumer of whisky will associate the sign with the goods. However, it had to be assessed whether it was reasonable to assume that such an association might be established in the future. The BoA assessed a number of factors, including the fact that it is current practice in trade to indicate the geographical origin of whiskies and whisky-based beverages. It concluded that the designation 'Brasil' would be understood as an informative indication for whisky and whisky-based beverages (para. 29).</p>	<p>06/02/2014, R 434/2013-1, Brasil</p>
<p>AUSTRALIA</p> <p>Classes 12, 25, 28, 35 and 37</p>	<p>It is a well-known fact that Australia is a strong economic nation with a thriving economy, which has grown steadily for more than a quarter of a century. Due to its size, its political and economic importance and its popularity as a holiday destination, Australia has a strong reputation in the EU and its Member States (para. 21).</p> <p>First, with regard to all the goods and services for which protection is sought, the contested trademark is understood as a reference to a positive image, namely a particular attitude towards life. Australia is widely associated with a sense of freedom, wide open spaces and a connection with nature, of which the Australian Outback is representative. Consequently, it is likely that the geographical name 'AUSTRALIA' will influence consumers in the choice of their goods and services, as they associate the goods and services thus marked with this particular attitude to life, which triggers a positive reaction (06/02/2013, R 434/2013-1, BRASIL, § 32). The sign applied for is descriptive, as it indicates that the use or take-up of the goods and services in question contributes to creating a particular attitude to life linked to Australia (para. 26).</p>	<p>06/04/2018, R 2207/2017-2, AUSTRALIA</p>

<p>MONACO Classes 9, 16, 39, 41 and 43</p>	<p>The Court found that the word 'monaco' corresponded to the name of a principality known throughout the world, not least because of the renown of its royal family and its organisation of a Formula 1 Grand Prix and a circus festival. The Court considered that the trademark MONACO had to be refused for goods and services in Classes 9, 16, 39, 41 and 43 as the word 'monaco' could be used, in trade, to designate origin, geographical destination or the place of supply of services. The trademark was thus descriptive for the goods and services concerned.</p>	<p>15/01/2015, T-197/13, MONACO, EU:T:2015:16</p>
<p>Passionately Swiss</p>	<p>The Court held that BoA did not need to go into a detailed assessment of the association between the sign and each of the goods and services. It based its finding on Switzerland's reputation for quality, exclusiveness and comfort, which can be associated with the services in Classes 35, 41, 43 and 44 and the goods in Class 16 (para. 45).</p>	<p>15/12/2011, T-377/09, Passionately Swiss, EU:T:2011:753</p>
<p>PARIS</p>	<p>BoA established that 'PARIS' is likely to be associated with a certain idea of quality, design, stylishness and even of being avant-garde. This results in a positive feeling, an expectation with regard to the quality of the goods sold and the services provided, when 'PARIS' is put forward as an indication of geographical origin or destination.</p>	<p>26/10/2015, R 3265/2014-4, Paris</p>

The following marks can be registered:

- NEW YORK for goods in Class 9 (Typeface fonts recorded on computer software) (IR 1494009)
- HOLLYWOOD for goods in Class 30
- GREENLAND for fresh fruits and vegetables
- DENVER for lighting equipment
- PORT LOUIS in Classes 18, 24 and 25

2.7 Terms describing subject matter in goods or services

2.7.1 General considerations

Where a sign consists exclusively of a word that describes what may be the subject matter or content of the goods or services in question, it should be refused under Article 4(1)(d) of the **Law**. Commonly known terms likely to be linked to a particular thing, product or activity by the relevant public are capable of describing subject matter and should therefore be kept free for other traders.

The essential question is whether the sign applied for **may be used in trade in relation to the goods or services applied for** in a manner that will be undoubtedly perceived by the relevant public as descriptive of the subject matter of those goods or services for which protection is sought, and should therefore be kept free for other traders.

For example, a widely known name such as 'Vivaldi' will immediately create a link to the famous composer, just as the term 'skis' will immediately create a link to the sport of skiing. While Class 16 (books) is a prime example of a category of goods that contains subject matter or content, an objection made under this section may occur also with respect to other goods and services, such as *DVDs* (a term that includes not only blank DVDs but also recorded DVDs) or editorial services. With regard to this section, the terms 'subject matter' and 'content' are used interchangeably.

Names of famous persons (in particular musicians or composers) can indicate the category of goods, if due to widespread use, time lapse, date of death, popularisation, recognition, multiple performers or musical training, the public can understand them as generic. This would be the case, for example, with respect to 'Vivaldi', whose music is played by orchestras all over the world and the sign 'Vivaldi' will not be understood as an indicator of origin for music.

With regard specifically to famous titles of books, see below 2.7.2 titles of books.

In the event of services, where a sign consists of a term indicating a certain industry, such as 'CLOTHING' or 'CARS', and it can be reasonably assumed that a services provider (e.g. in the field of advertising or retail services) could specialise to meet the characteristics of that particular industry, it should be refused.

Refusal based on the above:

- will apply only to goods (e.g. *books*) or services (e.g. *education*) that contain subject matter regarding other things, products and/or activities (e.g. a book about history, or an educational course on history);
- when the sign consists exclusively of the word identifying that subject matter (e.g. 'VEHICLES' or 'HISTORY'); and
- will be made on a case-by-case basis by assessing multiple factors, such as the relevant public, the degree of attention or the descriptive character of the term in question, or the market reality (see below).

Goods and services that may contain subject matter

For most cases, the goods or services that may consist of or contain subject matter that give rise to refusal are the following.

- Class 9: *software, electronic publications (downloadable)*
 - Give rise to a refusal
 - STATISTICAL ANALYSIS for software
 - ROCK MUSIC for CDs (a term that includes not only *blank CDs* but also *recorded CDs*)
- Class 16: Printed matter, photographs and teaching materials as long as these include printed matter
 - Give rise to a refusal
 - HISTORY for books
 - PARIS for travel guides
 - CAR for magazines
 - ANIMALS for photographs
 - TRANSCENDENTAL MEDITATION for instructional and teaching material

- Class 28: Board games
 - Give rise to a refusal
 - ‘Memory’¹⁵
- Class 35: Trade fairs, advertising, retail services, import-export services.
 - Give rise to a refusal
 - ELECTRONICA for trade fairs related to electronic goods¹⁶
 - CLOTHING for retail services
 - PHARMACEUTICALS for import-export services
- Class 41: Education, training, entertainment, electronic publications (non- downloadable).
 - Give rise to a refusal
 - GERMAN for language courses
 - HISTORY for education
 - COMEDY for television programmes
 - TRANSCENDENTAL MEDITATION for education services

The above list of Nice classes is not exhaustive, although it will apply to the vast majority of cases. Consequently, refusals based on descriptive subject matter should be raised primarily in the context of the goods and services listed above.

Where the sign applied for is a descriptive term for a particular characteristic of goods or services, a designation of goods or services that excludes that particular characteristic described by the sign applied for will not avoid an objection based on subject matter. This is because it is unacceptable for an applicant to make a claim of goods or services subject to the condition that they do not possess a particular characteristic. The following invented examples illustrate designations of goods or services that will not avoid an objection:

- COMEDY for television broadcasting, except for comedy *programming*
- PENGUINS (in plural!) for books, except for books about *penguins*
- TECHNOLOGY for classes, except for classes about computers and *technology*.

Distinguishable from the examples above are positive claims of goods or services, under which it is impossible for the sign applied for to describe any subject matter or content. For example, the following invented examples would not be liable to refusal, at least with regard to signs being descriptive of subject matter:

- COMEDY for television broadcasting of economic news, politics and *technology*
- PENGUIN for comic books with country western, medieval and ancient Roman *themes*
- TECHNOLOGY for classes about creative fiction *writing*.

2.7.2 Titles of books

The fact that a sign applied for is the title of a book is not per se an obstacle for registration as a trademark. However, Sakpatenti will refuse the mark when it can be perceived as describing the subject matter of the goods and services and thus has not the capacity to identify the commercial origin of the goods or services.

¹⁵ (14/03/2011, C-369/10 P, Memory, EU:C:2011:148)

¹⁶ (05/12/2000, T-32/00, Electronica, EU:T:2000:283, § 42-44)

Trademarks consisting solely of a book title may be descriptive under Article 4(1)(d) of the **Law** in relation to goods and services that could be perceived as containing or dealing with the well-known story, a new version of it or a theme linked to the story. The reason for this is that certain stories (or their titles) have been established for so long and become so well known that they have 'entered into the language'. They are no longer linked exclusively with the original book, but have rather become well known, universal and autonomous commonplace expressions to denote a certain type of story or an entire genre.

For example, 'The Jungle Book' or 'Robinson Crusoe' are book titles originally attributable to a particular literary work and a particular author (Rudyard Kipling; Daniel Defoe). Due to the enormous popularity of the books, and facilitated by the passing of time, their titles have, in the public's perception, gradually gained a thematic significance, which extends beyond the actual content of the books concerned. They have entered into everyday language as synonyms for a particular type of story or genre (e.g. young humans succeeding on their own in the wilderness; struggle against nature, hardship, privation, loneliness).

While such famous book titles might remain perfectly capable of being distinctive for paint, clothing or pencils, they will become incapable of performing a distinctive role in relation to goods and services that could merely have the general story or genre as their content (e.g. publications, data carriers or cultural events).

The assessment of whether a book title has reached a sufficient degree of recognition depends on a thorough case-by-case analysis, taking account of the particularities of the individual case.

The following, non-exhaustive considerations might assist in evaluating whether the title of a book would be perceived as descriptive of the subject matter of the goods and services and thus not capable of denoting the commercial origin of subject-related goods and services.

- **Adaptations**

A finding of non-distinctiveness will be more likely where it can be shown that a large number of published versions of the story have appeared and/or where there have been numerous television, theatre and film adaptations reaching a wide audience.

- **Cultural Heritage**

The fact that a book or its story is included in a high-profile encyclopaedia, that it frequently forms part of school/university curricula and that it is subject to ample scientific research and abstract analysis of its main themes might be an indicator that it is considered a 'Classic', that is to say, a book that has reached a universal importance that stretches beyond its actual content and that actively forms part of the cultural DNA of the general public (e.g. 'The Odyssey', 'Cinderella', 'Romeo and Juliet', 'Don Quixote').

- **Time**

The more time has passed by since the publication of the original work, the more likely it becomes that a book's plot, its characters and its title are no longer strictly connected to a particular author or the exact story, but have rather reached a status of autonomy.

Depending on the mark in question, an objection may be taken in relation to printed matter, films, recordings, plays and shows (this is not an exhaustive list).

Examples for book titles considered to be descriptive of the subject matter:
'Pinocchio' (R 1856/2013-2): partly declared invalid for Classes 9, 16, 28, 41
'The Jungle Book' (R 118/2014-1): partly rejected for Classes 9, 16, 41

Examples for book titles considered to be sufficiently distinctive:

‘Die Wanderhure’ (TM No 12 917 621): in Classes 9, 16, 35, 38 and 41

‘Partners in crime’ (TM No 13 011 887): in Classes 9, 16 and 41

2.8 Single letters and numerals

2.9 Names of colours

Name of colours can be **single colour** names (e.g. red, green), **compound colour** names (e.g. navy blue, blood red) or more **unusual** colour names. Among unusual colour names, there are names of objects, gemstones, flowers or similar elements (e.g. magnolia, emerald, amethyst, alabaster) and combination of colour associated with another noun (e.g. flamenco red, crystal pink, vintage rose, Bermuda blue).

A sign consisting exclusively of the name of a colour must be refused under Article 4(1)(d) of the **Law** when the application claims any **goods and services for which the colour constitutes an objective characteristic, inherent to the nature of that product or service and intrinsic and permanent with regard to that product or service**. For the ground of refusal to apply, a direct and specific link is necessary in the mind of the relevant public, not just an indirect association.

For example the colour white did not constitute an ‘intrinsic characteristic’ which is ‘inherent to the nature’ of goods like food processors, electric pressure cookers and household utensils, but a purely random and incidental aspect which only some of them may have and which does not, in any event, have any direct and immediate link with their nature. Since the relevant goods are available in a multitude of colours, the mere fact that they are more or less usually available in white, among other colours, is irrelevant, since it is not ‘reasonable’ to believe that for that reason alone the colour white will actually be recognised by the relevant public as a description of an intrinsic characteristic which is inherent to the nature of those goods.

As a consequence, the name of the colour BLUE would be objected to in relation to cheese, as it describes a specific kind of cheese. GREEN describes a specific kind of tea or environmentally friendly services, while BROWN in relation to sugar describes the colour and kind of sugar.

When the goods for which protection is sought concern colourants such as paint, ink, dyes or cosmetics (e.g. lipsticks or make-up), the name of a colour may describe the actual colour of the goods, and signs consisting exclusively of a colour name should be rejected under Article 4(1)(d) of the Law, as the names of colours would not be seen as trademarks but merely as indications of the principal characteristic of the goods.

Accepted trademarks

Sign	Reasoning	Case No.
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<p style="text-align: center;">RED</p> <p>TM No 14 654 842</p> <p>registered for goods in Classes 6-9, 11,17 and 19</p>	<p>The sole fact that the goods claimed can be offered in red does not mean that 'RED' is understood as descriptive by the consumer. Colours play no role as product characteristics in the sector of the goods in question (i.e. <i>common metals and their alloys</i> (Class 6) or <i>rubber, asbestos, mica and goods made of these materials</i> (Class 17)). But even if goods like cables, wires, machines, tools, weapons, razors, household appliances, pipes, etc. may have a colour, this colour does not describe an essential characteristic of those goods. Therefore, the use of the indication 'RED' in connection with the goods claimed does not lead to the conclusion that the targeted consumers will automatically perceive the sign as a descriptive characteristic</p>	<p>Decision of the Fourth Board of Appeal of 7 November 2019, <u>R 1246/2019-4</u>, § 14</p>
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Rejected trademarks

Sign	Reasoning	Case No
<p>VISIBLE WHITE TM No 802 793</p> <p>Rejected for <i>toothpaste and mouthwash</i></p>	<p>The terms 'visible' and 'white' allow the relevant public to detect immediately and without further reflection the description of a fundamental characteristic of <i>toothpaste and mouthwash</i>, in the sense that their use makes the white colour of teeth visible. 'Visible white' describes an intrinsic characteristic that is inherent to the nature of the goods concerned, namely the reason to use them or their intended purpose.</p>	<p>09/12/2008, T-136/07, Visible White), EU:T:2008:553, § 42, 43.</p>
<p>TRUEWHITE TM No 8 272 321</p> <p>Rejected for <i>light emitting diodes (LED)</i>.</p>	<p>The term 'truewhite', applied to light-emitting diodes (LED) merely described an essential characteristic of those goods, namely their ability to reproduce light of such whiteness that could be considered to be similar to natural light. In that case, the term 'true white' also described an intrinsic characteristic inherent to the nature of the goods concerned, namely their quality.</p>	<p>07/07/2011, T-208/10, TRUEWHITE, EU:T:2011:340, § 23</p>

2.10 Names of banks, newspapers/magazines and airports

In some fields, such as banks, newspapers, magazines and airports, consumers are accustomed to recognising descriptive combinations of terms as badges of origin.

This is due to the market reality whereby a sign composed of different elements has the capacity to **identify a specific entity**. It is the case, for example, of a sign that describes an entity that is the only one to offer the respective goods and/or services.

The following marks can be accepted

Sign	TM No
BANK OF ENGLAND	11 157 641

Classes 6,8,9,14,16,18,21,28,30,35,36,41,42, 45	
AEROPORT TOULOUSE-BLAGNAC Classes 16,35,36,37,38,39,41,42,43,45	13 952 346
KOPITNARI AEROPORT Classes 16,35,36,37,38,39,41,42,43,45	Invented example

Nevertheless, descriptive combinations give rise to an objection when they do not create, at least prima facie, the impression of a clearly identifiable entity. It is the case when the sign refers to a general category and not a specific unique entity.

The following marks should be refused.

Sign	Reasoning	TM No
CHARITY BANK Classes 9, 35 and 36	The sign as a whole merely indicates that the goods and services are provided by a bank that focuses on charity more than other banks that may also support charity activities.	4 454 872
European PrivateTrust BANK Class 36	The expression taken as a whole immediately informs consumers without further reflection that the services applied for are insurances, financial and monetary services, etc., that are rendered by a European non- public trust bank that is organised to perform the fiduciary of trusts and agencies.	11 585 908
JOURNAL OF OPTOMETRY Classes 16 and 41	The relevant consumer will not see the sign as something unusual but rather as a meaningful expression: a publication related to the world of optometry with its technological projection and the knowledge of the mentioned science.	6 646 996
HEALTH JOURNAL Classes 16 and 38	The consumers will see the sign as an indication of the good itself.	1 524 396
ALICANTE-AIRPORT Class 35	The expression is not the official denomination of the main airport next to the city of Alicante. The expression 'alicante-airport' immediately informs consumers without further reflection that the services applied for are from an airport in the city or province of Alicante. Therefore, the mark conveys obvious and direct information regarding the geographical origin of rendering of the services in question.	15 140 676

2.11 Names of hotels

In the hotel sector, hotel names are often the combination of the word 'HOTEL' together with a geographical term (i.e. the name of an island, a city, a country etc.). They usually indicate specific establishments that do not have any link with the geographical term they refer to, since

they are not situated in that specific location. Consequently, due to these trade habits, consumers would not perceive expressions such as 'HOTEL BALI', or 'HOTEL ENGLAND' as descriptive indications (describing that the services are provided by a hotel that is situated in that specific location) but rather as badges of origin.

Indeed, such expressions are not equivalent to the grammatically correct ones 'HOTEL IN BALI', 'HOTEL IN ENGLAND', which clearly give rise to a refusal. This is even truer in cases where the hotel name consists of the names of two different cities, (or of two geographical terms in general), for example 'HOTEL LONDON BATUMI'. Indeed, in this case the presence of the wording BATUMI clearly indicates that 'HOTEL LONDON' must be regarded as a fanciful expression. Therefore, no refusal should be raised.

2.12 Combinations of names of countries/cities with a number indicating a year

Marks consisting of the combination of the name of a country/city with a number indicating a year must be refused under Article 4(1)(c) and (d) of the **Law** in the following cases.

Firstly, where the combination is perceived by the relevant consumers as **describing an event** happening that specific year in the designated geographic location, it must be **refused for all the goods and services** for which protection is sought, since it is considered that the descriptive link applies to any good or service.

As an **example**, the mark 'GERMANY 2006' is immediately perceived as a reference to an event that would take place in 2006. It is considered as a descriptive indication for a wide list of goods and services, ranging from *unexposed films* in Class 1 to *vehicle maintenance* in Class 37. In particular, this mark:

- is descriptive of the kind and content of those services 'of actually preparing, organising and promoting an event in Germany in 2006' (referring to the organisation of sporting events related to or associated with football championships, etc.);
- is descriptive of 'the purpose and thereby in part the level of quality of goods or services, during such competitions in Germany in the year 2006, as being suitable for competitions of the highest standard or that it has been successfully used in the context of such competitions' (referring to medical instruments, soccer balls, etc.);
- qualifies the goods as souvenir articles (referring to goods such as stickers, confetti, pyjamas, etc.).

With regard to **souvenir articles**, the Board underlined that 'merchandising and co-branding is not limited to 'classic' souvenir products. It is public knowledge that there is a tendency to try to find new markets by combining various goods with the brand of some other unrelated popular event or names'¹⁷ referring to goods such as eyeglasses, televisions, toilet paper, etc., all related to or associated with football championships). In line with the above, the Boards confirmed the refusal of the trademark 'TARRAGONA 2017' for various commemorative articles, such as goods in Class 6 (*bronzes (works of art), busts of common metal, crates of metal, bells, placards of metal, etc.*) or goods in Class 14 (*jewellery ornaments, decorative pins of precious metal, amulets (jewellery), rings (jewellery), bracelets and wrist bands, etc.*)¹⁸

Secondly, where the combination is not, or not any more, perceived by the relevant consumers as describing an event that happens, or took place, in that specific year in the designated geographic location, a sign combining the name of a country or city with a number indicating a year might still be perceived by the relevant public as an indication of another characteristic, such as the place and time of production or destination. The assessment has to be made in accordance with the criteria explained under paragraph 2.6 above.

¹⁷ (30/06/2008, R 1467/2005-1, GERMANY 2006, § 34,

¹⁸ (28/10/2016, R 2318/2015-5, TARRAGONA 2017, § 32).

2.13 INN codes

International non-proprietary names (INNs) are assigned to pharmaceutical substances by the World Health Organisation (WHO), so that each substance can be recognised by a unique name. These names are needed for the clear identification, safe prescription and dispensing of medicines, and for communication and exchange of information among health professionals. INNs can be used freely because they are in the public domain. Examples of INNs are alfacalcido, calcifediol, calcipotriol.

Stems define the pharmacologically related group to which the INN belongs. INN stems serve to indicate the mode of action of groups of drugs. These stems and their definitions have been selected by WHO experts and are used when selecting new international non-proprietary names. An example of a stem is 'calci'.

The criteria for assessing the descriptiveness of a trademark for pharmaceuticals are no different from those applicable to other categories of trademarks. The provisions of trademark law apply to pharmaceuticals in the same way as to other categories of goods.

Considering the descriptive nature of INN codes and stems, a refusal should be raised for Class 5 in the following scenarios:

- where the TM is an INN (the general rules on misspellings also apply, see paragraph 2.3 above); or
- where an INN appears within an TM and the other elements of the TM are descriptive/non-distinctive too (for instance BIO, PHARMA, CARDIO, MED, DERMA); or
- where the TM consists **only** of a stem.

A list of INN codes can be accessed after online registration on MedNet ([https:// mednet-communities.net](https://mednet-communities.net)). A list of common stems is available at the following link: http://www.who.int/medicines/services/inn/StemBook_2011_Final.pdf.


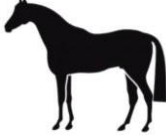
Figurative trademarks containing INN codes or stems are accepted. Sakpatenti is applying the same criteria as to any other figurative trademark containing descriptive word elements (i.e. whether the stylisation and/or the graphical features of a sign are sufficient for it to act as a trademark).

A refusal may also be based on Article 4(1)(h) of the **Law** in the unlikely scenario that the list of goods in Class 5 refers to a different kind of drug from that covered by the INN. Where the list in Class 5 includes pharmaceuticals, SakpatentiSakpatentiSakaptenti assumes good faith and no refusal under Article 4(1)(hh) of the **Law** will be raised.

3. Figurative Marks

Marks where **non-standard characters, stylisation or layout**, or a graphic feature or a colour is used are figurative marks. Signs represented in alphabets other than Georgian, Latin, or Cyrillic are to be considered figurative trademarks. However, this does not mean that the semantic content of these signs will not be taken into consideration for the purpose of the application of Article 4(1)(d) of the **Law**.

Where a figurative mark consists exclusively of a basic natural form that is not significantly different from a true-to-life portrayal that serves to indicate the kind, intended purpose or other characteristic of the goods or services, it should be rejected under Article 4(1)(d) of the **Law** as descriptive of a characteristic of the goods or services in question.

Sign	Case No
	08/07/2010, T-385/08, Hund, EU:T:2010:295
	08/07/2010, T-386/08, Pferd, EU:T:2010:296


In these cases, for goods in Classes 18 and 31, the depiction of a dog or horse, respectively, serves to indicate the type of animal for which the goods are intended.

In the first case, the Court noted that the goods in Class 18 were specially produced for dogs, such as dog leads, dog collars and other dog accessories including bags. In the field of animal accessories, it is common practice for true-to-life or stylised but realistic portrayals of animals to be used for indicating the type of animal concerned. Therefore, for the goods in Class 18, the relevant public will immediately perceive the image's message that those goods are for dogs, without any further mental steps. The portrayal of a dog, therefore, indicates an essential characteristic of the goods concerned. The sign applied for is, therefore, descriptive (paras 25-28).


The same applies to goods in Class 31. As foodstuffs for domestic animals include dog food, the mark applied for is a descriptive indication for the goods at issue that will be immediately understood by the relevant public (para. 29).

In the second case, the Court held that for *clothing, headgear and belts* in Class 25, the portrayal of a horse was descriptive of the kind or intended purpose of the goods, namely that they are particularly developed or suitable for horse riding. As the relevant public would make a direct link between a horse and horse riding, the Court maintained that there was an immediate and concrete link between the portrayal of a horse and the goods concerned (paras 35-38).

Sign	Case No
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 Classes 5, 25 and 35	29/09/2016, T-335/15, DEVICE OF A BODY BUILDER (fig.), EU:T:2016:579
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The Court noted that the image in question represents in a fairly realistic way the silhouette of a bodybuilder in a typical pose that highlights the body's muscles and, in particular, those of the arms. No detail or characteristic of that image goes beyond the standard representation of a bodybuilder. The mark applied for shows a sufficiently direct and specific relationship to the goods and services covered by the application for registration, enabling the relevant public to perceive immediately the nature and intended purpose of those goods and services. By way of example, the sign below was held to be sufficiently highly stylised to significantly differ from a true-to-life portrayal serving to indicate the kind or intended purpose of the goods or services, and, thus, was registered.

Sign	TM No	Goods and services
	844	Classes 1, 3, 5, 6, 7, 8, 9, 11, 16, 17, 18, 19, 20, 21, 22, 26, 28, 31, 41, 42

4 Figurative Threshold

4.1 Preliminary remarks

Terms or signs that are non-distinctive, descriptive or generic may be brought out of the scope of a refusal based on Article 4(1)(c), (d) or (e) of the **Law** if combined with other elements that make the sign as a whole distinctive. In other words, refusals based on Article 4(1)(c), (d) or (e) of the **Law** may not apply to signs consisting of a non-distinctive, descriptive or generic element combined with other elements that take the sign as a whole beyond a minimum level of distinctiveness.

In practice this means that one of the main questions that Sakpatenti must answer is whether the mark is figurative enough to reach the minimum degree of distinctive character that is required for registration.

Finally, the fact that a sign contains figurative elements does not prevent it from still being misleading or contrary to public order or accepted principles of morality or from falling under other grounds of refusal, such as those set forth by Article 4(1)(g) and (h) of the **Law**.

4.2 Assessment of the figurative threshold

The presence of figurative elements may give distinctive character to a sign consisting of a descriptive and/or non-distinctive word element so as to render it eligible for registration as a

TM. Therefore, the question to be considered is whether the stylisation and/or the graphical features of a sign are sufficiently distinctive for the sign to act as a badge of origin.

In the framework of the European Union Intellectual Property Network (EUIPN), Sakpatenti has agreed on a Common Practice in relation to when a figurative mark, containing purely descriptive/ non-distinctive words, should pass the absolute grounds examination because the figurative element renders sufficient distinctive character (also referred to as Convergence Project 3 or CP3 Practice).

The Common Practice establishes criteria to determine if the threshold of distinctiveness is met due to the figurative features in the mark. They consider:

- **word elements** such as typeface and font, combination with colour, punctuation marks and/or other symbols, or how the words are placed (sideways, upside-down, etc);
- **figurative elements** such as the use of simple geometric shapes, the position and proportion (size) of the figurative element(s) in relation to the word elements, or whether the figurative element is a representation of, or has direct link with, the goods and/or services, and whether the figurative element is commonly used in trade for the goods and/or services applied for;
- **both word and figurative elements** and how combinations of the criteria affect distinctiveness.

These criteria are explained in the following paragraphs.

Moreover, the Common Practice includes a number of examples. Some of them are included in the paragraphs below (marked as ‘CP3 example(s)’). The signs containing ‘Flavour and aroma’ seek protection for *coffee* in Class 30, the signs containing ‘Fresh sardine’ and ‘Sardines’ seek protection for *sardines* in Class 29, the sign containing ‘DIY’ seeks protection for *kits of parts for assembly into furniture* in Class 20, the signs containing ‘Pest control services’ seek protection for *pest control services* in Class 37, and the sign containing ‘Legal advice services’ seeks protection for *legal services* in Class 45.

4.2.1 Word elements in a mark

Type face and font

In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces — with or without font effects (bold, italics) — are not registrable.

Non-distinctive examples


Sign	Example
Fresh Sardine	CP3 example
<i>Fresh Sardine</i>	CP3 example
FrEsh SaRdine	CP3 example
<i>Flavour and aroma</i>	CP3 example

<i>Flavour and aroma</i>	CP3 example
<i>Flavour and aroma</i>	CP3 example

Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

Distinctive examples

Sign	Example
<i>flavour and aroma</i>	CP3 example
FLAVOUR AND AROMA	CP3 example
DIY	CP3 example

Sign	Case No	Goods and services
	TM No 13 448 097	Classes 5 ,9, 11, 37, 42, 45


Combination with colour

The mere 'addition' of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, will not be sufficient to give the mark distinctive character.

Use of colours is common in trade and would not be seen as a badge of origin.

However, it cannot be excluded that a particular arrangement of colours that is unusual and can be easily remembered by the relevant consumer could render a mark distinctive.

Non-distinctive examples

CP3 examples


Flavour and aroma
Flavour and aroma
Flavour and aroma

Combination with punctuation marks and other symbols

In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements.

Non-distinctive examples

CP3 examples
FreshSardine .TM
“Flavour and aroma”
“Flavour and aroma”

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

In general, the fact that the word elements are arranged vertically, upside-down or in one or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.

Non-distinctive examples

CP3 examples
Flavour and Aroma

F l a v o u r a n d A r o m a
Flavour and Aroma


Sign	Case No.	Goods and services
	12/11/2014, T-504/12, Notfall Creme, EU:T:2014:941	Classes 3, 5
	11/07/2012, T-559/10, Natural beauty, EU:T:2012:362	Class 3

However, the way in which the word elements are positioned can add distinctive character to a sign when the arrangement is of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message.

Distinctive examples

CP3 example
F d l n a a v m o r u A r
A n d r F l a v o u r m a

Sign	TM No	Goods and services
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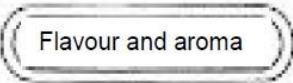

	<p>15 971 153</p>	<p>Classes 9, 16 and 35</p>
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4.2.2 Figurative elements (word element(s) and additional figurative element(s))

Use of simple geometric shapes


Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, in particular when the abovementioned shapes are used as a frame or border.



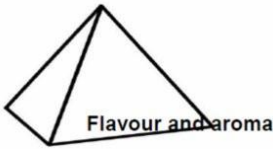
Non-distinctive examples


CP3 examples





However, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression that is sufficiently distinctive.

Distinctive examples

CP3 examples


Sign	TM No	Goods and services
	13 899 455	Class 35


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


In general, when a figurative element that is distinctive on its own is added to a descriptive and/or non-distinctive word element, then the mark is registrable, provided that said figurative element is, due to its size and position, clearly recognisable in the sign.



Non-distinctive examples

CP3 example
Flavour and aroma [®]
<i>Fresh Sardine</i>

Distinctive examples

CP3 example


Sign	TM No	Goods and services
	13 244 942	Classes 11, 37




 PLANMY.WEDDING	15 184 799	Classes 35, 41, 45
 TRANSIT CENTER	13 906 458	Classes 12, 39

The figurative element is / are presentation of, or has a direct link with, the goods and/or services



A figurative element is considered to be descriptive and/or devoid of distinctive character whenever:

- it is a true-to-life portrayal of the goods and services;
- it is a symbolic/stylised — portrayal of the goods and services that does not depart significantly from the common representation of said goods and services.


Non-distinctive examples

CP3 example	
	Fresh Sardine
	Sardines
	From the sea to your plate

Distinctive examples


Sign	Example
	CP3 example
	CP3 example

A figurative element that does not represent the goods and services but has a direct link with the characteristics of the goods and services will not render the sign distinctive, unless it is sufficiently stylized.





CP3 example
 PEST CONTROL SERVICES

Sign	TM No	Goods and services
	10 909 307	Classes 18, 21, 28, 31
	1 131 046	Classes 36, 42, 45
	874 778	Classes 9, 11
	14 512 784	Classes 11, 28, 37, 42
	14 584 262	Classes 9, 42

Distinctive examples

CP3 example
 PEST CONTROL SERVICES



Sign	Case No	Goods and services
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	<p>TM No 13 847 827</p>	<p>Classes 5, 31</p>
	<p>TM No 13 433 784</p>	<p>Classes 37,41,42</p>
	<p>11/02/2015, R 1983/2014-2</p>	<p>Class 11</p>
	<p>TM No 13 893 871</p>	<p>Classes 29, 31</p>

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

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

Non-distinctive examples

<p>CP3 examples</p>

<p>LEGAL ADVICE SERVICES</p> 

4.2.3 Word and figurative elements (stylised word elements and additional figurative element(s))

In general, a combination of figurative and word elements, which if considered individually are devoid of distinctive character, does not give rise to a distinctive mark.

Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case when the combination results in an overall impression that is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.

Examples. In order for a sign to be registrable, it must have a minimum level of distinctiveness. The purpose of the scale is to illustrate where that threshold is. The examples below from left to right contain elements with an increasing impact on the distinctiveness of the marks, resulting in marks that are either non-distinctive in their totality (red column) or distinctive in their totality (green column).

<p>1.</p>	
<p>2.</p>	
<p>3.</p>	

Non-distinctive examples

Sign	Case No	Goods and services
	03/12/2015, T-647/14, DUALSAW, EU:T:2015:932	Classes 7, 8, 35
	24/06/2015, T-552/14, Extra, EU:T:2015:462	Classes 3, 21, 30

Distinctive examples

Sign	TM No	Goods and services
	13 815 121	Classes 16, 21, 30

Chapter 5 Customary signs or indications (Article 4(1)(e) and 4(1)(f) of the Law

1. General Remarks


Article 4(1)(e) and (f) of the **Law** excludes from registration signs that consist **exclusively** of words or indications that have become customary in the current language or in the bona fide and established practices of the trade at the relevant point in time (see paragraph 2

below). In this context, the customary nature of the sign usually refers to something **other than** the properties or characteristics of the goods or services themselves.

Although there is a clear overlap between the scope of Article 4(1)(e),(f) and Article 4(1)(d) of the **Law**, signs covered by Article 4(1)(e) and (f) are excluded from registration not because they are descriptive, but on the basis of their **current usage** in trade sectors covering the goods or services for which the mark is applied for.

Moreover, signs or indications that have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that sign are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not, therefore, fulfil the essential function of a trademark.

This ground for refusal **also covers words that originally had no meaning** or had another meaning, for example, ‘yellow pages’. It also covers certain **abbreviations** that have entered informal or jargon usage and have thereby become customary in trade.

Sign	Reasoning	Case No
 <p>TM No 9 894 528 covering goods in Class 9</p>	<p>‘This device is identical to the international safety symbol known as “high voltage symbol” or “caution, risk of electric shock” ... It has been officially defined as such by the ISO 3864 as the standard high voltage symbol, whereby the device applied for is contained within the triangle which denotes that it is a hazard symbol ... Consequently, since it essentially coincides with the customary international sign to indicate a risk of high voltage, the Board deems it to be ineligible for registration as an TM in accordance with Article 7(1)(d) TMR’(article 4(1)(d) of the Law) (para. 20)</p>	<p>R 2124/2011-5</p>

Furthermore, a refusal based on Article 4(1)(e) and (f) of the **Law** also covers **figurative elements** that are either frequently used pictograms or similar indications or have even become the standard designation for goods and services for which registration is sought, for example a white ‘P’ on a blue background for parking places, the Aesculapian staff for pharmacies, or the silhouette of a knife and fork for restaurant services.

2. Point in Time of a Term Becoming Customary

The customary character must be assessed with reference to the **filing date of the Trademark application**. Whether a term or figurative element was non-descriptive or distinctive long before that date, or when the term was first adopted, will in most cases be immaterial, since it does not necessarily prove that the sign in question had not become customary by the filing date.

In some cases, a sign applied for may become customary **after the filing date**. Changes in the meaning of a sign that led to a sign becoming customary after the filing date do not lead to a declaration for invalidity *ex tunc* under Article 28(1)(a) of the **Law**, but can lead to a **revocation** with effect *ex nunc* under Article 27(2)(b) of the **Law**. For further information, see the Guidelines, Part D, Cancellation, Section 2, Substantive Provisions.

3. Assessment of Customary Terms

Whether a mark is customary must be assessed, firstly, by reference to the goods or services for which registration is sought, and, secondly, on the basis of the target public's perception of the mark.

As regards the **link with the goods and services** for which registration is sought, Article 4(1)(e) and (f) of the **Law** will not apply where the mark is a more general laudatory term that has no particular customary link with the goods and services concerned.

As regards the **relevant public**, the customary character must be assessed by taking account of the expectations that the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question.

- The relevant public to be taken into account in determining the sign's customary character comprises not only all consumers and end users but also, depending on the features of the market concerned, all those in the trade who deal with that product commercially.
- Where the trademark targets both professionals and non-professionals (such as intermediaries and end users), it is sufficient for a sign to be refused or revoked if it is perceived to be a usual designation by any one sector of the relevant public, notwithstanding that another sector may recognise the sign as a badge of origin.
- Article 4(1)(e) and (f) of the Law is not applicable when the sign's use in the market is by one sole trader (other than the TM applicant). In other words, a mark will not be regarded as customary purely for the simple reason that a competitor of the TM applicant also uses the sign in question. For customary character to be demonstrated, it is necessary for the examiner to provide evidence (which will generally come from the internet) that the relevant consumer has been exposed to the mark in a non-trademark context and that, as a result, they recognise its customary significance vis-à-vis the goods and services for which the trademark is filed.

In the assessment process of the customary character, the examiner may check whether the sign appears in dictionaries as a generic term.

Chapter 6 Shapes or Other Characteristics that Result from the Nature of the Goods, are Necessary to Obtain a Technical Result (Article 4(2) of the Law

1. General Remarks

Article 4(2) of the **Law** excludes from registration signs that consist exclusively of (i) the shape that results from the nature of the goods themselves; (ii) the shape of goods that is necessary to obtain a technical result.

The wording of this provision implies, in principle, that it does not apply to signs for which registration is sought in respect of services.

In relation to shapes, the **objective** pursued by Article 4(2) of the **Law** is the same for all of its two grounds, namely to prevent the exclusive and permanent rights that a trademark

confers from serving to extend the life of other IP rights indefinitely, such as patents, which the legislature has sought to make subject to limited periods.

Importantly, unlike the situation covered by Article 4(1)(c) of the **Law**, the **average consumer's perception is not a decisive element** when applying the ground for refusal under Article 4(2) of the **Law** but, **at most**, may be a relevant criterion for Sakpatenti when identifying the sign's essential characteristics-

For these reasons, **a refusal under Article 4(2) of the law** to marks consisting of shapes that follow from the nature of the goods or shapes or other characteristics that are necessary to obtain a technical result **cannot be overcome** by demonstrating that they have **acquired distinctive character**.

A sign consists '**exclusively**' of the shape of goods when all its **essential characteristics** — that is to say, its most important elements — result from the nature of the goods (Article 4(2)(a) of the **Law**), perform a technical function (Article 4(2)(b) of the **Law**). The presence of one or more minor arbitrary elements, therefore, will not alter the conclusion. However, a refusal under Article 4(2) of the **Law** would not be justified if the sign applied for were a shape ~~or other characteristic(s)~~ combined with additional, distinctive matter such as word or figurative elements (that qualify as essential characteristics of the sign), as the sign in its entirety would then not consist exclusively of a shape or other characteristic(s) (the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 3, Non-Distinctive Trademarks (Article 4(1)(c) of the Law), paragraph 10.3).

The correct application of Article 4(2) of the **Law** requires that **the essential characteristics of the sign at issue be properly identified**. There is no hierarchy that applies systematically between the various types of elements of which a sign may consist. Moreover, in determining the essential characteristics of a sign, Sakpatenti may either base its assessment directly on the overall impression produced by the sign, or first examine in turn each of the components of the sign concerned.

This identification may, depending on the case and in particular its degree of difficulty, 'be carried out by means of a simple visual analysis of the sign or, alternatively, be based on a detailed examination in which relevant assessment criteria may be taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously for the goods concerned', such as patents.

Once the sign's essential characteristics have been identified, it will have to be established **whether they all fall under the respective ground set out in Article 4(2) of the Law**. In this respect, the two grounds must be applied independently. In addition, where none of those grounds is fully applicable for the entire shape, they do not preclude registration of the sign. Therefore, if parts of the shape are necessary to obtain a technical result within the meaning of Article 4(2)(b) of the **Law**, for instance, and the remaining parts result from the nature of the goods (Article 4(2)(a) of the **Law**), neither of these two provisions bars the registration of the shape or other characteristics as a sign.

2. Shape Resulting from the Nature of the Goods

Under Article 4(2)(a) of the **Law**, signs that consist exclusively of the shape that results from the nature of the goods themselves cannot be registered.

This ground for refusal will apply when the sign, consists exclusively of the only natural shape of the good, that is, '**natural**' **products that have no substitute**: for example, the realistic representation below of a banana for bananas.



The same would apply to **'regulated' products** (the shape of which is prescribed by legal standards), such as a rugby ball.

Apart from 'natural' and 'regulated' products, all shapes that are **inherent to the generic function or functions** of such goods must, in principle, also be denied registration. For example: legs with a horizontal level for a table; an orthopaedic-shaped sole with a V-shaped strap for flip-flops.

3. Shape of Goods Necessary to Obtain a Technical Result

Article 4(2)(b) of the **Law** excludes from registration signs that consist exclusively of the shape of goods that is necessary to obtain a technical result. Its aim is to prevent an undertaking from obtaining a monopoly on technical solutions or functional solutions of a product.

A sign consists 'exclusively' of the shape of goods that is necessary to obtain a technical result when all the essential characteristics of a shape perform a technical function.

First, the essential characteristics of the shape must be identified; then they must be assessed to see whether they are all necessary for obtaining a technical result.

1. Identification of the essential characteristics of a sign

The essential characteristics of the sign at issue must be properly identified.

The expression 'essential characteristics' must be understood as referring to the most important elements of the sign.

Identification of the essential characteristics of a sign is carried out on a case-by- case basis, with no hierarchy between the various types of elements of which a sign may consist. It can be based directly on the overall impression produced by the sign or by examining in turn each of the components of the sign concerned.

Identification may be by simple visual analysis of the sign or by a detailed examination in which relevant assessment criteria are applied, such as surveys, expert opinions, or data relating to intellectual property rights previously conferred in respect of the goods concerned.

Information other than that relating to the graphic representation alone, such as the perception of the relevant public, may be used in order to identify the essential characteristics of the sign at issue.

For the purposes of Article 7(2)(b) of the **Law**, it is irrelevant whether the 'essential characteristics' or 'most important elements' of the sign are distinctive or not.

The presence of non-essential characteristics with no technical function is also irrelevant under Article 7(2)(b) of the **Law**.

2. Are all the essential characteristics necessary for obtaining a technical result?

For this ground of refusal to apply, the essential characteristics of the sign at issue must **all be technically necessary for obtaining the intended technical result** of the goods concerned. Article 4(2)(b) of the **Law** does not apply where there is a decorative or imaginative

element or a distinctive word component that is an essential characteristic of the sign but is not necessary for obtaining a technical result.

This ground applies even if the essential characteristics represented in the sign are not sufficient in themselves to achieve the technical result, but merely contribute to it.

The representation does not have to reveal **all** the elements that are necessary for the implementation of the technical solution concerned, provided it is shown that the implementation of that technical solution cannot be effective without the essential characteristics that are visible in the graphic representation.

The essential characteristics of the shape or of another characteristic of the goods necessary to obtain a technical result **must, wherever possible, be assessed in the light of the technical function of the actual goods represented**. Such analysis cannot be made without taking into consideration, where appropriate, any **additional elements relating to the function of the actual goods**, even if they are not visible in the representation

During the opposition proceedings before the Chamber of Appeal examination of the functional characteristics of a sign, a detailed examination may be carried out that takes into account materials relevant for appropriately identifying the essential characteristics of a sign, in addition to the representation and any descriptions filed at the time of the application for registration. These materials may consist, for example, of a product catalogue or advertising material. Information which is not apparent from the graphic representation must originate from objective and reliable sources and may not include the perception of the relevant public.

The fact that, for example, the shape concerned is, or has been, the subject of a claim in a **registered patent or a patent application may as well** be considered as prima facie evidence that the aspects of the shape identified in the patent claim as functional are necessary for achieving a technical result during the opposition proceedings before the Chamber of Appeal.


The fact that there may be alternative shapes, with other dimensions or another design, capable of achieving the same technical result does not in itself mean that this provision does not apply.

Likewise, the combination of different elements that are all functional in themselves does not make the sign registrable.

The functions performed by the essential characteristics of the shape or another characteristic of the goods must be assessed in the light of the actual goods concerned.

In assessing a Trademark application against Article 4(2)(b) of the **Law**, consideration should be given to the meaning of the expression '**technical result**'. This expression should be interpreted broadly and includes shapes that, for example:

- fit with another article
- give the most strength
- use the least material
- facilitate convenient storage or transportation

Sign	Case No	Goods and Services
	TM No 107 029 10/07/2006, R 856/2004 G 12/11/2008, T-270/06 14/09/2010, C-48/09 P	Class 28 (<i>construction toys</i>)

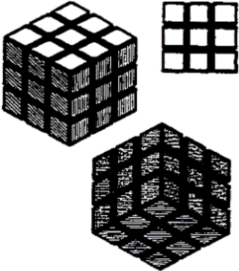
The Grand board held that various features of a Lego brick all performed ... particular technical functions, namely: *the bosses [studs]*: height and diameter for clutch power; number for fixing versatility; layout for fixing arrangement; *the secondary projections*: clutch-power; the number for best clutch-power in all positions; the thickness of the wall to act as a spring; *sides*: connected with sides of other bricks to produce a wall; *hollow skirt*: to mesh with the bosses and to enable fixing for clutch power; and *overall shape*: brick shape for building; size for children to hold (10/07/2006, R 856/2004-G, 3D SHAPE OF LEGO BRICK, § 54).

The **General Court** confirmed the Grand Board's findings, holding that the latter had applied Article 7(1) (e)(ii) TMR correctly (12/11/2008, T-270/06, Lego brick, EU:T:2008:483).

The **Court of Justice** confirmed the General Court's judgment, holding that

... the solution incorporated in the shape of goods examined is the technically preferable solution for the category of goods concerned. If the three-dimensional sign consisting of such a shape were registered as a trademark, it would be difficult for the competitors of the proprietor of that mark to place on the market shapes of goods constituting a real alternative, that is to say, shapes which are not similar and which are nevertheless attractive to the consumer from a functional perspective.

(14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 60).

Sign	Case No	Goods and services
	<p>TM No 162 784 24/10/2019, T-601/17 (23/04/2020, C-936/19 P, Cubes (3D), EU:C:2020:286)</p>	<p>Class 28 <i>Three dimensional puzzles</i></p>

Para. 70: ‘... the essential characteristics of the contested mark are limited to the overall cube shape, on the one hand, and to the black lines and little squares on each face of the cube, on the other.’

Para. 86: ‘... those black lines actually represent a physical separation between the different small cubes, allowing a player to rotate each row of small cubes independently of each other in order to gather those small cubes, in the desired colour scheme, on the cube’s six faces. Such a physical separation is necessary to rotate, vertically and horizontally, the different rows of small cubes by means of a mechanism located in the centre of the cube. Without such a physical separation, the cube would be nothing more than a solid block in which none of the individual elements could move independently of the others.’

Para. 96: ‘It is apparent from that judgment on appeal that the fact that the rotating capability of the vertical and horizontal lattices of the ‘Rubik’s Cube’ resulted from a mechanism internal to the cube, that is, an element which was not visible in the graphic representation of the contested mark, did not prevent the Board of Appeal from being able to have regard to that rotating capability in its analysis of the functionality of the essential characteristics of that mark.’

Para. 98: ‘... given that the two characteristics of the contested mark which have been correctly identified as essential by the Board of Appeal, in the present case the overall cube shape, on the one hand, and the black lines and the little squares on each face of the cube, on the other, are necessary to obtain the intended technical result of the actual goods concerned (see paragraphs 85 to 90 above), it must be concluded that that mark falls within the ground referred to in Article 7(1)(e)(ii) of Regulation No 40/94.’

Chapter 7 Trademarks contrary to public policy or acceptable principles of morality (Article 4(1)(g) of the Law

1. General Remarks

Article 4(1)(g) of the **Law** excludes from registration trademarks that are contrary to public policy or to accepted principles of morality. Article 4(1)(g) of the **Law** mirrors that of Article 6quinquies(B)(3) of the Paris Convention ⁽¹⁰⁾, which provides for the refusal of trademark applications and for the invalidation of registrations where trademarks are ‘contrary to morality or public order’.

The wording of Article 4(1)(g) of the **Law** is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trademarks against the right of the public not to encounter disturbing, abusive, insulting and even threatening trademarks.

The rationale of Article 4(1)(g) of the **Law** is not to identify and filter out signs whose use in commerce must at all costs be prevented, but to preclude trademarks from registration where granting a monopoly would contravene the state of law or would be perceived by the relevant public as going directly against the basic moral norms of society. In other words, Sakpatenti should not positively assist people who wish to further their business aims by means of trademarks that offend against certain basic values of civilised society.

The application of Article 4(1)(g) of the **Law** is not limited by the principle of freedom of expression (Article 10, Freedom of expression, European Convention on Human Rights; Georgian Constitution) since the refusal to register only means that the sign is not granted protection under trademark law and does not stop the sign from being used — even in business.

‘Public policy’ and ‘accepted principles of morality’ are two different concepts that often overlap.

The question whether the goods or services for which protection is sought can or cannot be legally offered in Georgia’s market is irrelevant for the question as to whether the sign itself falls foul of Article 4(1)(g) of the **Law**. Whether or not a mark is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the mark applied for, and not by the circumstances relating to the conduct of the person applying for the trademark.

The legislation and administrative practice of Georgia can also be taken into account in this context (i.e. for assessing subjective values), not because of their normative value, but as evidence of facts that make it possible to assess the perception of the relevant public. In such a case, the illegality of the TM applied for is not the determining factor for the application of Article 4(1)(g) of the **Law**, but rather is of evidential value with regard to the perception of the relevant public.

2. ‘Public Policy’

2.1 Concept and categories

This refusal derives from an assessment based on **objective criteria**. ‘Public policy’ is the body of all legal rules that are necessary for the functioning of a democratic society and the state of law. In the context of Article 4(1)(g) of the **Law**, ‘public policy’ refers to the **body of law applicable in a certain area**, as well as to the legal order and the state of law as defined by the Treaties and legislation, which reflect a common understanding of certain basic principles and values, such as human rights.

The following is an example when signs will be caught by this prohibition:

Trademarks that contradict the basic principles and fundamental values of the Georgian political and social order and, in particular, the universal values on which Georgia is founded, such as human dignity, freedom, equality and solidarity and the principles of democracy and the rule of law, Constitution of Georgia.

3. Accepted Principles of Morality

This refusal concerns **subjective values**, but these must be applied as objectively as possible by the examiner. The provision excludes registration as trademarks of blasphemous, racist, discriminatory or insulting words or phrases, but only if that meaning is clearly conveyed by the mark applied for in an unambiguous manner; the standard to be applied is that of the reasonable consumer with average sensitivity and tolerance thresholds.

The concept of accepted principles of morality refers to the fundamental moral values and standards to which a society adheres at a given time. Those values and norms are likely to change over time and vary in space.

The concept of morality in Article 4(1)(g) of the **Law** is not concerned with bad taste or the protection of individuals’ feelings. In order to fall foul of Article 4(1)(g) of the **Law**, a trademark must be perceived by the relevant public, or at least a significant part of it, as going directly against the fundamental moral values and standards of society.

It is not sufficient if the trademark is only likely to offend exceptionally puritanical citizens. Conversely, a trademark should not be allowed to be registered simply because it would not offend small minority at the other end of the spectrum who find even gross obscenity

acceptable. The trademark must be assessed by reference to the standards and values of ordinary citizens who fall between those two extremes.

The examination is to be based on the perception of a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered. To that end, elements such as legislation and administrative practices, public opinion and, where appropriate as well as any other factor which may make it possible to assess the perception of that public, are relevant.

National legislation and practice of Georgia are indicators to be taken into account in order to assess how certain categories of signs are perceived by the relevant public. However, Sakpatenti must not object to reject marks because of the mere fact that they are in conflict with national legislation and practice. National legislation and practice are considered to be **factual evidence** that enables an assessment of the perception of the relevant public within the relevant territory.

Examples of national legislation taken into account as evidence of a trademark being contrary to accepted principles of morality:

- use of symbols and names of illegal organisations/formations is prohibited (Article 223 of the Criminal Code of Georgia);
- The law of the Georgia Freedom Charter provides preventive measures against the principles of communist totalitarian and national socialist (Nazi) ideologies. It establishes that the Soviet totalitarian symbols cannot be used on the state or local self-government buildings, squares, and streets. The Law prohibits the propaganda instruments and other means of communist totalitarian and national socialist (Nazi) ideologies.

Signs that can be perceived as promoting the use of illegal drugs also fall under this provision. Taking into account, as factual evidence, that certain drugs are illegal in Georgia, **such trade marks** should be refused. It is an objective indication that such signs would be perceived as going directly against the basic moral norms of society.

The assessment made will take into account the term used in the mark applied for or the presence of other elements that could be perceived as promoting the use of illegal drugs. However, a refusal will not be raised if the sign contains a reference to a drug that is for medical use, as the mark would not fall, in principle, within the prohibition of Article 4(1)(g) of the **Law**.

The examination of Article 4(1)(g) of the **Law** should consider the **context** in which the mark is likely to be encountered, assuming normal use of the mark **in connection with the goods and services** covered by the application. Taking account of the goods and services for which registration of the mark is sought is normally necessary, since the relevant public may be different for different goods and services and, therefore, may have different thresholds with regard to what is clearly unacceptably offensive. For example, 'a person who is sufficiently interested in [sex toys] to notice the trademarks under which they are sold is unlikely to be offended by a term with crude sexual connotations'.

Nevertheless, although the goods and services for which protection is sought are important for identifying the relevant public whose perception needs to be examined, it has also made it clear that the **relevant public is not necessarily only that which buys the goods and services covered by the mark**, since a broader public than just the consumers targeted may encounter the mark. Accordingly, the commercial context of a mark, in the sense of the public targeted by the goods and services, is not always the determining factor in whether that mark would breach accepted principles of morality.

Illegality is not a necessary condition for giving rise to a conflict with accepted principles of morality: there are words or signs that would not lead to proceedings before the relevant authorities and courts, but that are sufficiently offensive to the general public to not be registered as trademarks. Furthermore, there is an interest in ensuring that children and young people, even if they are not the relevant public of the goods and services in question, do not encounter offensive words in shops that are accessible to the general public. Dictionary definitions will in principle provide a preliminary indication as to whether the word in question has an offensive meaning, but the key factor must be the perception of the relevant public in the specific context of how and where the goods or services will be encountered.

There is a clear risk that the wording of Article 4(1)(g) of the **Law** could be applied subjectively so as to exclude trademarks that are not to the examiner’s personal taste. However, for the word(s) to be rejected, it (they) must have a clearly offensive impact on people of normal sensitivity.


There is no need to establish that the applicant **wants** to shock or insult the relevant public; the fact that the TM applied for **might** be seen, as such, to shock or insult is sufficient.


Finally, it is not only signs with a ‘negative’ connotation that can be offensive. The banal use of some signs with a **highly positive connotation** can also be offensive.

Raising a refusal when a trademark is contrary to accepted principles of morality does not, however, prevent the sign from being also contrary to public policy (e.g. the trademark may be perceived by the relevant public as directly contrary to the basic moral norms of society and, **at the same time**, may contradict the basic principles and fundamental values of the Georgian political and social order).


4. Examples

4.1 Examples of rejected applications


Sign	Relevant Consumer	Public policy/morality	Case No
BIN LADIN	General consumer	Morality and public policy — the mark applied for will be understood by the general public as the name of the leader of the notorious terrorist organisation Al Qaeda; terrorist crimes are in breach of public order and moral principles (para. 17).	29/09/2004 R 176/2004-2
	General consumer	The board of appeal of the National IP Centre of Georgia Sakpatenti, in the Soviet decision, held that if a trademark with word element consists of a graphic representation of the Soviet Union symbol, such combination provokes the association with the Soviet Union, that is why it should be considered as a contrary to moral standards.	Chamber of appeal N10-03/16

	<p>General consumer</p>	<p>The combined trademark СТАЛИН ЦИНАНДАЛИ ქართული ღვინო (Stalin Tsinandali – Georgian Wine) and the figurative element of the person, which was easily understandable as a Joseph Vissarionovich Stalin on the basis that the mark was contrary to national dignity and moral standards.</p>	<p>Case N 88335/3</p>
<p>SCREW YOU</p>	<p>General consumer (for goods other than sex products)</p>	<p>Morality — a substantial proportion of ordinary citizens in Britain and Ireland would find the words 'SCREW YOU' offensive and objectionable (para. 26).</p>	<p>R 495/2005- G</p>
<p>Muhammad</p>	<p>For wine in Class 33</p>	<p>Morality — banal use of signs with a highly positive connotation can be offensive under Article 4(1)(g) of the Law. 'Muhammad' is a symbol of spiritual value for Muslims.</p>	<p>Invented example</p>
<p>MECHANICAL APARTHEID</p>	<p>General consumer</p>	<p>Public policy — 'APARTHEID' refers to an offensive former political regime in South Africa that included state terror, torture and the denial of human dignity. The message conveyed by the sign for computer games, related publications and entertainment is contrary to the European Union's public policy, since it contradicts the indivisible, universal values on which the EU is founded, i.e. human dignity, freedom, physical integrity, equality and solidarity, and the principles of democracy and the rule of law (para. 30).</p>	<p>06/02/2015, R 2804/2014 -5</p>


Thief in law (კანონიერი ქურდი)	General consumer	Public policy and morality —organised crime is a clear and present threat to the whole Georgia. Thief in law (კანონიერი ქურდი) is understood in Georgia as referring to a criminal organization. Such criminal activities breach the very values on which the Georgia is founded. Furthermore, Membership of the 'criminal underworld'; 'being a thief in law' is punishable under Criminal Code of Georgia (Article 223 ¹)	Invented example
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Sign	Relevant Consumer	Public policy/morality	Case No
	General consumer	The trademark was deemed insulting to the religious sentiments and traditions by the Board of Appeal of Sakpatenti. The board stated that the registration of the mark for the applied goods in class 34 (Tobacco gods) would insult the religious sentiments of orthodox people and their traditions.	Case N22367/3

4.2 Examples of accepted applications

Sign	Relevant Consumer	Comment	Case No
SCREW YOU	General consumer (for sex products)	A person entering a sex shop is unlikely to be offended by a trademark containing crude, sexually charged language (para. 29).	R 495/2005-G
	General consumer	For the goods at issue — rum (Class 33) — the relevant public will perceive the sign as provocative, transgressive, rebellious, but not as an indicator of criminal origin of the goods (para. 23).	07/05/2015, R 2822/2014-5

4.3 Examples of religious symbols accepted for registration

Sign	Relevant Consumer	Comment	Case No
	General consumer	Board considered that GIORGOBA is national religious holiday in Georgia. Hence, granting exclusive right to one person on the name of national holiday would be against public order and morality. However, as use of the sign on requested goods (wine) is not against the religion, protecting the sign as a whole without granting exclusive rights separately to the word part GIORGOBA is admissible.	123-03/13

Chapter 8 Deceptive trademarks (Article 4(1)(h) of the Law

1. Examination of the Deceptive Character

Article 4(1)(h) of the **Law** provides that marks that are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services, will not be registered.

The circumstances for refusing registration referred to in Article 4(1)(h) of the **Law** presuppose the **existence of actual deceit or a sufficiently serious risk that the consumer will be deceived**.

Pursuant to the above, Sakpatenti, as a matter of practice, makes the twin assumptions that:

1. there is no reason to assume that a trademark application has been filed with the intention of deceiving customers. No TM should be rejected based on deception if a non-deceptive use of the mark is possible vis-à-vis the goods and services specified — that is to say, an assumption is made that non-deceptive use of the sign will be made if possible.


2. the average consumer is reasonably attentive and should not be regarded as particularly vulnerable to deception. A refusal will generally only be raised where the mark leads to a **clear** expectation that is **patently contradictory** to, for instance, the nature or quality or geographical origin of the goods so that there is a sufficiently serious risk that the consumer will be deceived.

A refusal should, therefore, be raised **when the list of goods/services is worded in such a way that a non-deceptive use of the trademark is not guaranteed and there is a sufficiently serious risk that the consumer will be deceived**.

The following are three examples of marks that are considered as deceptive with regard to all or part of the claimed goods¹⁹

Sign and goods	Reasoning	Case No
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¹⁹ These examples only address the issue of whether the trade mark should be rejected or not based on deception. This paragraph does not deal with possible refusal under other absolute grounds.

<p>LACTOFREE for <i>lactose</i> in Class 5</p>	<p>The nature of the sign would immediately lead the relevant consumer to believe that the product in question, i.e. 'lactose', does not contain any lactose. It is clear that if the product being marketed under the sign 'LACTOFREE' were actually <i>lactose</i> itself, then the mark would be clearly misleading.</p>	<p>19/11/2009, R 892/2009-1</p>
<p>TITAN (German word for 'titanium') for <i>portable and relocatable buildings; modular portable building units for use in the construction of prefabricated relocatable buildings; prefabricated relocatable buildings constructed of modular portable building units, none of the aforesaid goods being made from or including titanium</i> in Classes 6 and 19.</p>	<p>During the appeal proceedings the applicant, in an attempt to overcome an objection based on deception, offered to restrict the specifications in both classes by adding, at the end, the indication <i>none of the aforesaid goods being made from or including titanium</i>. The Board held that such a restriction, if accepted, would have had the effect of rendering the trademark deceptive from the standpoint of the relevant public, as they would assume that the goods were made from titanium when in reality this is not the case.</p>	<p>23/01/2002, R 789/2001-3</p>
 <p>(Italian word for coffee) for <i>tea, cocoa, artificial coffee</i> in Class 30.</p>	<p>The Board confirmed the refusal. It considered that the consumer would falsely believe that the <i>tea, cocoa, artificial coffee</i> offered by the applicant contained coffee. The mark would give the consumer false information about the ingredients of the goods and for that reason was deceptive.</p>	<p>03/12/2014 R 1692/2014-1</p>

A possible perception of the mark by the relevant consumer in a non-deceptive manner is irrelevant, once — and thus provided that — the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived has been established.

A refusal should be raised when the list of goods/services, worded in a detailed manner, contains goods/services for which a non-deceptive use is not guaranteed, and **there is a sufficiently serious risk that the consumer will be deceived.**

In the (invented) case of trademark 'KODAK VODKA' for *vodka, rum, gin, whisky*, a sign should be refused for the specific goods for which non-deceptive use of the trademark is not possible,

that is to say, *rum, gin, whisky*. Such cases are substantially different from those (see below) where broad wording/categories are used and where non-deceptive use of the sign is possible.

Sign should not be refused when the list of goods/services is worded in such a broad way that non-deceptive use is possible.

When **broad categories** in the list of goods/services are used, the question arises whether a sign should be refused in relation to an entire category where the mark is deceptive for only some goods/services falling within that category. The policy of Sakpatenti is **not to refuse the sign** in these circumstances. The examiner should assume that the mark will be used in a non-deceptive manner. In other words, they will **not** object on the basis of deception wherever they can pinpoint non-deceptive use (within a category). For example, TM should not be rejected for 'KODAK VODKA' for *alcoholic beverages*, since this broad category includes vodka, for which the trademark is not deceptive.

Sign and goods	Reasoning	Case No
Chicken Blanca for, inter alia, <i>poultry</i> in Class 29.	The specification is sufficiently broad to include chicken. There is no specific reference in the sign, which indeed would qualify for a refusal.	invented example

2. Market Reality and Consumers' Habits and Perceptions

When assessing if a given trademark is deceptive or not, account should be taken of the characteristics of the goods and services at issue, of market reality and of consumers' habits and perceptions.

For example, in the (invented) trademark 'ELDORADO Spanish coffee' covering *coffee, preparations for use as substitutes for coffee, artificial coffee, chicory, chicory flavourings; chocolate, preparations for use as substitutes for chocolate; tea, cocoa; sugar, rice, tapioca, sago; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice* in Class 30, the examination should come to the following conclusions.

- A refusal under Article 4(1)(h) of the Law would be justified for preparations for use as substitutes for coffee, artificial coffee, chicory, chicory flavourings, because use of the mark on these goods would necessarily be deceptive. One would assume one was purchasing coffee, which would not in fact be the case.
- A refusal under Article 4(1)(h) of the Law would also be justified for products such as cocoa or tea. Like substitutes for coffee, they may be sold in packaging quite similar to that used for coffee and are often bought rather hastily; it is likely that many consumers will not take time to analyse the wording on the packaging but will choose these goods from the shelf in the (erroneous) belief that they are coffee.
- However, as far as coffee is concerned, there is no 'clear contradiction' between the claim for coffee and the wording "ELDORADO Spanish coffee", since the general category coffee may also include coffee originating from Spain. Hence, sign should not be refused under Article 4(1)(h) of the Law for the category of coffee itself. The same logic applies for goods that could be flavoured with coffee (such as chocolate, ices and pastry and confectionery) —

an assumption of non-deceptive use should be made, and there is not necessarily any contradiction between the said wording and the goods.

- Finally, for the goods such as bread, the presence of the wording ‘ELDORADO Spanish coffee’ will not give rise to any expectations at all. For such goods, this wording will be seen as clearly non-descriptive and hence there is no potential for actual deception. In the ‘real’ market, coffee is not displayed on the same shelves or in the same sections of a shop as bread.

Furthermore, the goods in question have a different appearance and taste and are normally distributed in different packaging.

3. Trademarks with Geographical Connotations Relating to the Location of the Applicant or the Place of Origin of the Goods/Services

When it comes to trademarks having certain ‘geographical’ connotations relating to the location of the applicant or the place of origin of the goods/services, the following should be noted.

As a general rule, Sakpatenti will not refuse a sign on the grounds of deception based upon the applicant’s geographical location (address). Indeed, such a geographical location bears, in principle, no relation to the geographical origin of the goods and services, that is to say, the actual place of production/offering of the goods and services covered by the mark.

For example, under Article 4(1)(h) of the **Law**, **Sakpatenti** will not object to a figurative mark containing the words **MADE IN USA** for *clothing* in Class 25 that is filed by a company with its seat in Sweden. In such cases, Sakpatenti assumes a non-deceptive use of the mark on the part of the proprietor.

Deception would nonetheless arise in the hypothetical case of a figurative mark containing the words **MADE IN USA**, filed by a company with its seat in the United States of America, being filed for a specifically limited list of goods — for example, *clothing articles made in Vietnam* — although, in practice, such cases seem unlikely to arise.


The sign could evoke in the consumers’ minds some impressions/expectations as to the geographical origin of the goods or of their designer that may not correspond to reality. For example, trademarks such as **ALESSANDRO PERETTI** or **GIUSEPPE LANARO** (invented examples) covering clothing or fashion goods in general may suggest to the relevant public that these goods are designed and produced in Italy, which may not be the case.

However, such a circumstance is not sufficient per se to render those marks misleading, wherever the goods originate from in the similar vein, Sakpatenti will not refuse a sign on the grounds of deception based upon the applicant’s geographical location (address). The mark could be revoked based on article 27(2)(c) of the **Law** if as a result of use made of the mark by the proprietor or with its consent, the mark is liable to mislead the public concerning the geographical origin of the goods.

4. Trademarks making Reference to ‘Official’ Approval, Status or Recognition

It should be noted that, under the current practice of Sakpatenti, trademarks that could evoke official approval, status or recognition without giving the firm impression that the goods/services issue from, or are endorsed by, a public body or statutory organisation, are acceptable.

The following are two examples where the marks concerned, although allusive or suggestive, were not found to be deceptive.

Sign and services	Reasoning	Case No
<p>THE E-COMMERCE AUTHORITY</p> <p>for business services, namely, providing rankings of and other information regarding electronic commerce vendors, goods and services via the Internet in Class 35 and providing research and advisory services and information in the area of electronic commerce in Class 42.</p>	<p>The Board found that the trademark was not deceptive, as it did not convey the firm impression that the services issue from a governmental or statutory organisation. (The Board, however, confirmed the refusal under Article 7(1)(b) TMR on the grounds that the mark lacked distinctive character, as it would be perceived by the English-speaking public merely as a simple statement of self-promotion that makes a claim about the level of competence of the service providers.)</p>	<p>11/07/2001, R 803/2000-1</p>
 <p>for, inter alia, teaching of skiing in Class 41.</p>	<p>The Board held that French consumers would understand that the trademark alludes to the fact that the services are supplied in France by a French teaching centre, and relate to learning how to ski 'in the French way'. Furthermore, the French public had no reason to believe that, simply because of the presence of its tricolour logo (not a reproduction of the French flag), that the services are supplied by public authorities or even authorised by such authorities.</p>	<p>11/07/2001, R 235/2009-1; confirmed 05/05/2011, T-41/10, EU:T:2011:200</p>

Chapter 9 Trademarks in conflict with flags and other symbols (Article 4(1)(i) and of the Law

1. Introduction

Article 4(1)(i) of the **Law** covers Article 6^{ter} of the Paris Convention for the Protection of Industrial Property (PC). It therefore protects armorial bearings, flags and other state emblems of states that are party to the PC, as well as official signs and hallmarks indicating control and warranty adopted by them. This protection was extended to armorial bearings, flags, other emblems, abbreviations and names of intergovernmental organisations (IGOs) in 1958. Article 4(1)(i) of the **Law** applies only if the sign coincides, fully or in one of its constituent elements with a protected 'emblem' or is a heraldic imitation of such an 'emblem'. Article 4(1)(i) of the **Law** also protects badges, emblems and escutcheons that are not protected under Article 6^{ter} PC but are of public interest.

2 Article 4(1)(i) of the Law

2.1 Objective of Article 4(1)(i) of the Law

The objective of Article 6ter PC is to exclude the registration and use of trademarks that are identical or notably similar to state emblems, official signs and hallmarks indicating control and warranty adopted by the states or the emblems, abbreviations and names of IGOs. Such registration or use would adversely affect the right of the authority concerned to control the use of the symbols of its sovereignty, and might, moreover, mislead the public as to the origin of the goods and services for which these marks are used.

Registration of these emblems and signs, as well as any imitation from a heraldic point of view, either as a trademark or as an element thereof, must be refused if no authorisation has been granted by the competent authority.

Members of the World Trade Organization (WTO) enjoy the same protection pursuant to Article 2(1) TRIPS, according to which members of the WTO must comply with Articles 1 to 12 and 19 PC.

2.2 Relevant emblems and signs protected

State flags

A state flag is defined by the constitution of a state or by a specific law of that state. Normally, a state will have only one state flag.

For instance, the Spanish flag is defined in Article 4 of the Spanish Constitution; the French flag is defined in Article 2 of the French Constitution; and the German flag is defined in Article 22 of the German Constitution.

State flags enjoy protection per se without any need for registration at WIPO pursuant to Article 6ter(3)(a) PC. There is no need to establish any link between the goods and services applied for and the country; state flags enjoy absolute protection.

Armorial bearings, flags, and other state emblems

Armorial bearings normally consist of a design or image depicted on a shield. An example of an armorial bearing is the coat of arms of Spain.



Protected under ES5.

Apart from the state flag (protected per se), a member state of the PC may also request protection for other flags, namely those of its first political division in a federal state. For instance, Germany has requested protection for the flags of each Bundesland ('federal state').



Protected under DE34 (flag of the federal state of Berlin).

The expression 'other state emblems' indicates any emblems constituting the symbol of the sovereignty of a state. This might be a representation of the national crown, or the official seal of a member state of the PC


Protected under NL 48



Protected under US1

Like state flags, armorial bearings, flags, and other state emblems enjoy absolute protection, irrespective of the goods and services applied for.

Official signs and hallmarks indicating control and warranty

The purpose of official signs and hallmarks indicating control and warranty is to certify that a state or an organisation duly appointed by a state for that purpose has checked that certain goods meet specific standards or are of a given level of quality. There are official signs and hallmarks indicating control and warranty in several states for precious metals or products such as butter, cheese, meat, electrical equipment, etc. Official signs and hallmarks may also apply to services — for instance, those relating to education, tourism, etc.

These symbols are normally registered at WIPO for specific products and services, such as:

	
Protected under BR6 for tourism; national and international promotion and advertising; marketing studies; business management; business administration; and office functions.	Protected under JP3 for agricultural, forestry and fishery products and foodstuffs.

Other typical examples are signs of warranty for metals, such as:

		
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Protected under CZ35 for platinum	Protected under IT13 for gold	Protected under HU10 for silver
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Official signs and hallmarks indicating control and warranty enjoy protection only for goods of the same or a similar kind pursuant to Article 6ter(2) PC (no absolute protection).


Armorial bearings, names, abbreviations and other emblems of intergovernmental organisations

Intergovernmental organisations of which one or more member states of the PC is a member enjoy protection for their armorial bearings, names, abbreviations and other emblems.

For instance, the following signs enjoy protection under the Paris Convention:

		
Protected under QO60.	Protected under QO1.	Protected under QO1248.

The European Union has requested, for instance, protection for the following signs, abbreviations and names:

	EUIPO	European Union Intellectual Property Office
Published under QO1717	Published under QO1742 (QO1743 to QO1746 in other languages)	Published under QO1718 (QO1719 to QO1741 in other languages)

Pursuant to Article 6ter(1)(c) PC, armorial bearings, names, abbreviations and other emblems of IGOs enjoy protection only for goods and services applied for that would suggest to the public that a connection exists between the organisation concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if the trademark misleads the public about the existence of a connection between the user and the organisation.

Though the European Union is not a state in terms of international law, but rather an international intergovernmental organisation, its area of activity is equated with that of a state²⁰

Consequently, the emblems of the European Union enjoy protection for all goods and services and there is no need to establish any specific link.

²⁰ (12/05/2011, R 1590/2010-1, EUROPEAN DRIVESHAFT SERVICES EDS (fig.), § 54; 15/01/2013, T-413/11, European Driveshaft Services, EU:T:2013:12, § 70).

Pursuant to the Article 6ter(1)(b) PC, Article 6ter PC is not applicable to any armorial bearings, flags, other emblems, abbreviations, and names that are already the subject of international agreements in force intended to ensure their protection (e.g. under the Geneva Convention).

Search for emblems

Relevant information about emblems protected under the Paris Convention is found in the WIPO Article 6ter database (<http://www.wipo.int/ipdl/en/6ter/>). The database can be searched by 'state' (i.e. country), by 'category' (i.e. the type of 'emblem') and by 'Vienna Classification'.

A Google image search (<https://images.google.com/>) might give some basic hints for identifying an emblem before the Article 6ter database is checked.

Since state flags enjoy protection per se without any need for registration at WIPO they are normally not found in the WIPO Article 6ter database (unless the flag is, at the same time, protected as another state emblem). Tools for finding flags such as <http://www.flagid.org> or <http://www.flag-finder.com> can be consulted.

2.3 Applicability of Article 4(1)(i) of the Law

To fall foul of Article 4(1)(i) of the **Law**, a trademark must coincide, fully or in one of its constituent elements or be a 'heraldic imitation' of the abovementioned symbols.

Furthermore, the competent authority must not have given its **authorisation** (see paragraph 4 below).

In principle, prohibition of the imitation of an emblem applies only to **imitations of it from a heraldic perspective**, that is to say, those that contain heraldic connotations that distinguish the emblem from other signs. Therefore, protection against any imitation from a heraldic point of view refers not to the image itself, but to its heraldic expression. Therefore, it is necessary to consider the **heraldic description** of the emblem at issue to determine whether the trademark contains an imitation from a heraldic point of view.

It follows from the above that, in the course of trademark examination, as a first step, both the protected 'emblem' and the sign applied for must be considered from a heraldic perspective.

Nonetheless, as far as 'imitation from a heraldic point of view' is concerned, a difference detected by a specialist in heraldic art between the trademark applied for and the state emblem will not necessarily be perceived by the average consumer and, therefore, in spite of differences at the level of certain heraldic details, the contested trademark may be an imitation of the emblem in question within the meaning of Article 6ter PC.

To apply Article 4(1)(i) of the **Law**, **it can therefore be sufficient that the average consumer, despite some differences in heraldic details, can see in the mark an imitation of the 'emblem'**. There may, for example, be imitation when the mark contains the main element of, or part of, the 'emblem' protected under Article 6ter PC. That element need not necessarily be identical to the emblem in question. The fact that the emblem in question is **stylised** or that only **part of the emblem** is used does not necessarily mean that there is no imitation from a heraldic point of view.






The TM applied for contains a protected ‘emblem’

As a first step, it is important that the examiner identifies the various elements of the TM applied for and establishes the part that is considered to be the reproduction or heraldic imitation of an ‘emblem’ protected under Article 6ter PC. The **size** of the protected emblem contained in the TM is irrelevant, as long as it is **legible** and **perceivable**.

The fact that the TM applied for **also contains word elements** does not in itself preclude application of Article 6ter PC. On the contrary, such a word element may even strengthen the link between the Trademark application and an emblem.

Examples:

- Heraldic imitation found

Flag	Sign applied for
The flags of Norway, France, Austria, Germany, Sweden, France, Czech Republic, Belgium, Denmark, Ireland, Italy and Finland (from the top in a clockwise circle).	
	Trademark application No 10 502 714; 17/06/2013, R 1291/2012-2, WHO WANTS TO BE A FOOTBALL MILLIONAIRE (fig.)
The colours are recognisable and follow the structure of the flags.	
	
Flag of the United Kingdom	Trademark application No 13 169 313
The trademark contains a faithful representation of the UK flag in terms of colour/configuration. The slight degree of stylisation does not take it outside the scope of heraldic imitation.	
	
French flag	18/03/2015, R 1731/2013-1, LAPIN NA LA NOUVELLE AGRICULTURE (fig.)
The French flag is incorporated into the trademark. Although it is small, it is immediately recognisable.	

 	
<p>Protected under GB3 Protected under GB4</p>	<p>TM No 5 627 245; 23/07/2009, R 1361/2008-1, SUSCIPERE ET FINIRE (fig.)</p>



The Board of Appeal took into account the heraldic description of the protected emblems in order to consider whether there was a heraldic imitation (paras 24 and 27).





As regards the emblem protected under GB3, it concluded that since central elements such as the quartered shield and the supporters were largely identical, this was in this respect an imitation in the heraldic sense. The differences were not sufficient to give the Trademark application new meaning from a heraldic point of view. As regards the emblem protected under GB4, it concluded that the only difference between the supporters was the representation of the crowns, which would go unnoticed by the general public.

	
<p>Swiss flag</p>	<p>TM No 9 273 137</p>

In spite of a slight stylisation, the Swiss flag is immediately recognisable in the sign with the same structure and colours as the protected flag.



- **Heraldic imitation not found**





Flag	Sign applied for
	

French flag	TM No 4 624 987, 05/05/2011, T-41/10, esf école du ski français (fig.)
Although the colours are recognisable, the sign does not have the structure of the French flag.	
	
Peruvian flag	TM No 14 913 438
The mark is acceptable under Article 7(1)(h) TMR. The dimensions of the stripes and also the overall shape of the figurative element are different from that of the Peruvian flag.	
	
Flag of the United Kingdom	TM No 15 008 253
The trademark is not a faithful representation of the UK flag in terms of colour/configuration. The high degree of stylisation takes it outside the scope of heraldic imitation.	





The fact that the TM applied for **contains only part of the protected ‘emblem’** does not mean that there may not be an imitation from a heraldic point of view (21/04/2004, T-127/02, ECA, EU:T:2004:110, § 41). As regards the flag of the European Union, its essential element is the circle of twelve golden mullets (stars). However, to qualify as a heraldic imitation, it is not necessary for all the stars to be present in the TM applied for. The exact orientation of the stars is irrelevant. The same is true with respect to their colour.





- Main characteristics/part of the emblem **incorporated** in the trademark

Protected ‘emblem’	Sign applied for
	
Protected under QO188	Trademark application No 6 697 916; 01/03/2012, R 1211/2011-1, DIRO.net Lawyers for Europe (fig.); 13/03/2014, T-430/12, European Network Rapid Manufacturing
The TM applied for consists of a circle of 12 stars, of which three are covered. It contains the most important element of the European flag. The adjective ‘European’ reinforces the link already established by the circle of stars.	

	
Protected under QO188	TM No 6 373 849; 14/07/2011, R 1903/2010-1, A (fig.)
<p>Since the TM contains an element that amounts to a heraldic imitation of the European emblem and the TM owner could not justify any authorisation, the registration must be declared invalid (para. 27).</p>	
	
Protected under QO188	TM No 4 819 686; 21/03/2012, R 2285/2010-2, EUROPEAN MOO DUK KWAN TANG SOO DO FEDERATION
<p>One element of the contested TM contains an imitation of all the heraldic elements of the European emblem (para. 48).</p>	

- Main characteristics/part of the protected emblem **not incorporated** in the trademark







Protected 'emblem'	Sign applied for
	
Protected under IE11	Trademark application No 11 945 797; 01/04/2014, R 139/2014-5, REPRESENTATION OF A CLOVERLEAF (fig.)
<p>It must also be taken into consideration that the graphic element of the sign applied for has a colour configuration that is clearly different from the Irish national symbols. These elements are so strong that the mere fact that the sign applied for also contains a cloverleaf does not mean that the sign is similar to one of the national emblems of Ireland (paras 18-19).</p>	
	





Protected under SE20	Trademark application No 13 580 981
The mark is not a heraldic imitation of the Swedish armorial bearing; it contains only one of the three crowns that are the main characteristic of the Swedish armorial bearing.	
	
Protected under CA2	Trademark application No 15 951 262
The mark is not a heraldic imitation of the Canadian state emblem.	
	
Protected under QO188	Trademark application No 15 889 157
The mark is not a heraldic imitation of the European emblem.	

Black and white representations of the protected emblem

Flags are often reproduced in black and white; therefore, a black and white depiction of a protected emblem (or vice versa) may still be considered a heraldic imitation.

Examples:

Flag	Sign applied for
	
Protected under QO188	21/04/2004, T-127/02, ECA
	
Protected under CA1	Trademark application No 2 793 495
	

Protected under CA2	C-202/08 P & C-208/08 P
	
Flag of the United Kingdom	Invented example
	
Protected under CH27	28/10/2014, R 1577/2014-4



However, if the black and white depiction does not allow recognition of a specific flag, there is no heraldic imitation.

Flag	Sign applied for
	
Various state flags	Invented example
It is not possible to recognise a specific flag, as the sign could be a black and white reproduction of any of the four flags reproduced above.	

Changes in colour

The use of silver v gold is important in heraldry. However, average consumers will not necessarily recognise this difference in colour; indeed, they will not even give it any importance. Slight differences in the actual colour are irrelevant (light blue v dark blue). Heraldry does not normally distinguish between different tones of the same colour. Furthermore, gold is often reproduced as yellow, consequently, this difference has no impact on the assessment.

Protected Emblem	Sign applied for
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Protected under QO188	TM No 2 180 800; 15/01/2013, T-413/11, European Driveshaft Services
<p>The Court maintained that even as regards professionals the possibility of making a connection between the sign represented above and the organisation concerned is not excluded (para. 66).</p>	

3 Article 4(1)(i) of the Law — Emblems not Protected under Article 6ter PC

3.1 Objective of Article 4(1)(i) of the Law

Article 4(1)(i) of the **Law** applies to all other badges, emblems or escutcheons that

1. Have not been communicated in accordance with Article 6ter(3)(a) PC, regardless of whether they are the emblems of a state or international intergovernmental organisation within the meaning of Article 6ter(1)(a) or (b) PC, or of public bodies or administrations other than those covered by Article 6ter PC, such as provinces or municipalities

And

2. Are of particular public interest, unless the competent authority has consented to their registration.

Article 4(1)(i) of the **Law** does not define symbols of ‘particular public interest’. The nature of these symbols could vary and could include, for example, symbols of public bodies or administrations, such as provinces or municipalities. In any case, the ‘particular public interest’ involved must be reflected in a public document, for example a national or international legal instrument, regulation or other normative act.

Following the same line of reasoning, Article 4(1)(i) of the **Law** applies where the mark is liable to **mislead the public** as to the existence of a connection between the owner of the trademark and the body to which the abovementioned symbols refer. In other words, **the protection afforded by Article 4(1)(i) of the law is conditional on a link between the mark and the symbol (no absolute protection).**

3.2 Protected symbols

The following signs (not covered by Article 6ter PC) enjoy special protection under Article 4(1)(i) of the **Law**:

- the euro sign (€), as defined by the European Commission, http://ec.europa.eu/economy_finance/euro/cash/symbol/index_en.htm);





- the symbols protected under the Geneva Conventions and their additional protocols, that is to say, the red cross, the red crescent and the red crystal emblems and their names (<https://www.icrc.org/en/war-and-law/emblem>);




However, a number of well-known red crosses have traditionally been used and are still in use, the incorporation of which in a mark would not be considered a reproduction/ heraldic imitation of the 'Red Cross'.

Examples of these crosses include the following:

'Templar cross'	
'Maltese cross'	



- the Olympic Symbol protected under the Nairobi Treaty on the Protection of the Symbol (http://www.wipo.int/treaties/en/text.jsp?file_id=287432)





<p>The five interlaced rings in blue, yellow, black, green and red, arranged in that order from left to right. The symbol consists of the Olympic rings alone, whether in a single colour or in different colours, as set out in the Nairobi Treaty on the Protection of the Olympic Symbol</p>	
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The same rules as set out above concerning the heraldic imitation and authorisations also apply with respect to Article 4(1)(i) of the **Law**.



Examples





- Reproduction/heraldic imitation found

Symbol	Sign applied for
	
	Trademark application No 6 110 423, 10/07/2013, T-3/12.

<p>The TM contains an imitation of the euro symbol in a central position. A link will be established with the European Union. The other elements reinforce the link between the TM and the euro sign (para. 109 et seq).</p>	
	
	<p>Trademark application No 2 966 265, applied for in respect of goods and services in Classes 9, 38, 42 and 44.</p>
<p>Trademark cancelled by decision of 13/05/2008, 2 192 C. The TM clearly contains the emblem of the Red Cross on a white background, as defined by and protected by the Geneva Convention, as a discernible, individual portion of the mark (para. 23).</p>	
	
	<p>Trademark application No 5 988 985, applied for in respect of goods and services in Classes 28 and 30.</p>
<p>The trademark contains the representation of the Red Cross, protected by the Geneva Convention.</p>	

- Reproduction/heraldic imitation not found

Symbol	Sign applied for
	
	<p>28/06/2007, R 315/2006-1, D&W REPAIR (fig.), applied for in respect of goods and services in Classes 8, 11 and 12.</p>
<p>In the present case, the Red Cross cannot be said to be included in the contested TM because of the difference in colour. The Red Cross, as its denomination indicates, is red and the colour constitutes a very essential element of its protection. The cancellation applicant's argument that the colour orange may be very similar to some shades of red cannot be accepted (para. 20).</p> <p>Additionally, the cross of the contested TM contains the wording 'REPAIR' which, coupled with the goods concerned (tools, car spare parts and accessories in Classes 8, 11 and 12), is likely to be associated with car and motorcycle repairs. This association makes the orange cross of the contested TM even more distinct from the Red Cross emblem protected by the Geneva Convention (para. 21).</p>	

	
	<p>Trademark application No 10 868 985, applied for in respect of goods and services in Classes 12, 35, 38, 39 and 42 (car rental related).</p>
<p>No link will be made with the European Union; the symbol rather refers to the 'good price' of the goods and services concerned.</p>	
	
	<p>Trademark application No 11 076 866, applied for in respect of goods and services in Classes 9, 35, 36, 37 and 42 (e.g. <i>electricity measuring devices, services related to building and construction</i>).</p>
<p>No link will be made with the European Union; the symbol will be perceived as a stylised letter 'E'.</p>	

4. Exceptions

The TM applied for can be registered despite Article 4(1)(i) of the **Law** if the applicant provides Sakpatenti with the authorisation to include the protected emblem or parts of it in its trademark. The authorisation must cover registration as a trademark or as a part thereof. Authorisation to use the protected emblem is not sufficient.

If there is ground for refusal under article 4(1)(i), a written notification is sent to the applicant requesting the authorization from the competent authority. Within 2 months from the date of receipt of the notification in case of regular procedure and within 15 days in case of accelerated procedure, the applicant shall submit a reply to Sakpatenti. The applicant has the right to extend the term for submitting a reply for one month, if within the above-mentioned two months he/she submits to Sakpatenti a written request for extension of the term and pays the prescribed fee. If within the above-mentioned term authorization is not submitted, Sakpatenti will reject a trademark.



It is up to the applicant to submit the authorisation. Sakpatenti cannot enquire as to whether an authorisation exists, either on an individual or general level.

Even in cases where **general** announcements or authorisations are rendered by competent authorities under national law to use a protected emblem in trade, and these are submitted by the applicant, it should be carefully examined on a case-by-case basis whether such authorisations **specifically** authorise the use of an emblem in a trademark.²¹

It is also important to mention that the provisions of Article 4(1)(i) of the law are not applicable to trademarks that were registered either before receipt of the notification from WIPO or less than 2 months after receipt of said notification.

²¹ (26/02/2015, R 1166/2014-1, ALPENBAUER BAYERISCHE BONBONLUTSCHKULTUR (fig.), § 23-29).

If a TM applied for contains or consists of the heraldic imitation of emblems of two or more states, which are similar, it is sufficient to present authorisation from one of them (Article 6ter(8) PC).

	
State flag of the Netherlands	State flag of Luxembourg

Chapter 10 Acquired distinctiveness through use (Article 4(3) of the Law)

1. Introduction

According to Article 4(3) the **Law**, a trademark may still be registered despite the fact that it does not comply with Article 4(1) (c)-(f) or (h), provided that it 'has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it'.

Article 4(3) the **Law** constitutes an exception to the rule laid down in Article 4(1) (c)-(f) or (h) of the Law whereby registration must be refused for trademarks that are per se devoid of any distinctive character, for descriptive marks, for marks that consist exclusively of indications that have become customary in the current language or in the bona fide and established practices of the trade and for deceptive marks.

Distinctive character acquired through use means that, although the sign lacks inherent distinctiveness *ab initio* with regard to the goods and services claimed, at least a significant proportion of the relevant public has, owing to the use made of it on the market, come to see it as identifying the goods and services claimed in the Trademark application as originating from a particular undertaking²². Thus, the sign has become capable of distinguishing those goods and services from those of other undertakings because they are perceived as originating from a particular undertaking. In this way, a sign originally unable to be registered under Article 4(1) (c)-(f) or (h) of the **Law** can acquire new significance, and its connotation, no longer purely descriptive or non-distinctive, allows it to overcome those absolute grounds for refusal of registration as a trademark.

2. Requests

Sakpatenti will only examine acquired distinctive character following a request from the TM applicant. Sakpatenti is not bound to examine facts showing that the mark claimed has become distinctive through use within the meaning of Article 4(3) of the **Law** unless the applicant has pleaded them.²³

3. The Point in Time for which Acquired Distinctiveness has to be Established

The evidence must prove that distinctiveness through use was acquired prior to the Trademark application's filing date. In the case of an IR, the relevant date is the date of registration by the International Bureau or, if the designation takes place at a later stage, the designation date. Where priority is claimed, the relevant date is the priority date. Hereafter, all these dates are referred to as the 'filing date'.

²² The vast majority of cases that come before Sakpatenti relate to proof of use for individual marks. As such, this document usually makes reference to identifying the goods or services as 'originating from a particular undertaking'. Where appropriate, this should also be understood as covering the different essential functions of collective marks *mutatis mutandis*.

²³ (12/12/2002, T-247/01, Ecopy, EU:T:2002:319, § 47).

3.1 Examination proceedings

Since a trademark enjoys protection as of its filing date, and since the filing date of the application for registration determines the priority of one mark over another, a trademark must be registrable on that date. Consequently, the applicant must prove that distinctive character was acquired through use of the trademark prior to the date of application for registration.²⁴ Evidence of use made of the trademark after this date should not be automatically disregarded, insofar as it may provide indicative information regarding the situation prior to the date of application.²⁵

3.2 Cancellation proceedings

In cancellation proceedings, a trademark that was registered in breach of the provisions of Article 4(1)(b)-(f) or (h) of the **Law** may nevertheless no longer be declared invalid if, in consequence of the use that has been made of it, it has, **after registration**, acquired distinctive character for the goods or services for which it is registered.

4. Consumers

Distinctive character of a sign, including that acquired through use, must be assessed in relation to the perception of the average consumer for the category of goods or services in question. These consumers are deemed to be reasonably well informed, and reasonably observant and circumspect. The definition of the relevant public is linked to an examination of the intended purchasers of the goods or services concerned, since it is in relation to those purchasers that the mark must perform its essential function.

Consequently, such a definition must be arrived at by reference to the essential function of a trademark

- for individual marks, this is to guarantee the identity of the origin of the goods or services covered by the mark to consumers or end users by enabling them, without any possibility of confusion, to distinguish the goods or services from others of another origin

The relevant consumer includes, therefore, not only persons who have actually purchased the goods and services but also any potentially interested person in the strict sense of prospective purchasers²⁶

Who prospective purchasers are is defined depending on the precise product or service for which registration is sought. If the claimed goods or services represent a broad category (for example, bags or watches), it is irrelevant that the actual products offered under the sign are extremely expensive luxury items — the public will include all the prospective purchasers for the goods claimed in the Trademark application, including non-luxury and cheaper items if the claim is for a broad category.

5. Goods and Services

Since the main function of a trademark is to guarantee the origin of goods and services, acquired distinctiveness must be assessed in respect of the goods and services at issue. Consequently, the applicant's evidence must prove a link between the sign and the goods and services for which the sign is applied for, establishing that the relevant class of persons,

²⁴ (11/06/2009, C-542/07 P, Pure Digital, EU:C:2009:362, § 49, 51; 07/09/2006, C-108/05, Europolis, EU:C:2006:530, § 22).

²⁵ 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 49).

²⁶ (29/09/2010, T-378/07, Représentation d'un tracteur en rouge, noir et gris, EU:T:2010:413, § 41 et seq.).

or at least a significant proportion thereof, identify the goods and services as originating from a particular undertaking because of the trademark.²⁷

6. *Standard of Proof*

The requirements to prove acquired distinctiveness through use pursuant to Article 4(3) of the **Law** are not the same as those to prove genuine use pursuant to Article 24 of the **Law**. Whilst under Article 4(3) of the **Law** it is necessary to prove qualified use, such that the relevant public perceives as distinctive a sign that per se is devoid of distinctive character, the reason behind the proof of genuine use is completely different, namely to restrict the number of trademarks registered and protected, and consequently the number of conflicts between them.

The TM applicant must submit evidence that enables Sakpatenti to find that at least a significant proportion of the relevant section of the public identifies the products or services concerned as originating from a particular undertaking because of the trademark.²⁸

The evidence must be clear and convincing. The TM applicant must clearly establish all the facts necessary to safely conclude that the mark is recognised by the relevant public as a badge of origin, that is to say, that it has created a link in the mind of the relevant public with the goods or services provided by a specific company, despite the fact that, in the absence of such use, the sign at issue would lack the necessary distinctiveness to create such a link.

Furthermore, acquired distinctiveness must be the result of the use of the mark as a trademark, not as purely functional packaging²⁹ or as a descriptive indication on packaging. For example, use of the sign 'Gifflar' (which indicates a kind of bread in Swedish) on the packaging of pastries, together with descriptive indications of flavours, is made in a descriptive context, not as a badge of origin.³⁰

For a finding of acquired distinctiveness through use, there is no prescribed fixed percentages of market penetration or of recognition by the relevant³¹ Rather than using a fixed percentage of the relevant public in a given market, the evidence should show that a significant proportion of the public perceives the mark as identifying specific goods or services as originating from a particular undertaking.

The evidence must relate to each of the goods and services claimed in the Trademark application. After an initial absolute grounds objection under Article 4(1) (c)-(f) or (h) of the **Law**, only the goods and services claimed for which acquired distinctiveness through use has been proven may proceed to registration.

7. *Assessment of the Evidence*

In establishing acquired distinctiveness, account may be taken of, inter alia, the following **factors**:

²⁷ (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 52; 19/05/2009, T-211/06, Cybercrédit et al., EU:T:2009:160, § 51).

²⁸ (15/12/2015, T-262/04, Briquet à Pierre, EU:T:2005:463, § 61 and the case-law cited therein).

²⁹ (25/09/2014, T-474/12, Shape of goblets (3D), EU:T:2014:813, § 56-58 and the case-law cited therein)

³⁰ (09/07/2014, T-520/12, Gifflar, EU:T:2014:620, § 44-45).

³¹ public (19/06/2014, C-217/13 & C-218/13, Oberbank e.a., EU:C:2014:2012, § 48).

- the market share held by the mark with regard to the relevant goods or services;
- how intensive, geographically widespread and long-standing use of the mark has been;
- the amount invested by the undertaking in promoting the mark for the relevant goods or services;
- the proportion of the relevant public who, because of the mark, identifies the goods or services as originating from a particular undertaking.

Below is given non-exhaustive list of **means of giving or obtaining evidence** in proceedings before Sakpatenti, which may serve as guidance to applicants. Examples of evidence that may help to show acquired distinctiveness include, inter alia:

- sales brochures
- catalogues
- price lists
- invoices
- annual reports
- turnover figures
- advertising investment figures and reports
- advertisements (press cuttings, billboard posters, TV adverts), together with evidence of their intensity and reach
- customer and/or market surveys
- affidavits.

For further details on means of evidence, see by analogy the Guidelines, **Part C, Opposition, Section 5, Trademarks with Reputation**

The basic rules on the **evaluation of evidence** are also applicable here. Sakpatenti must make an **overall assessment of all the evidence** submitted³², weighing up each indication against the others.

Applicants should take great care to make sure not only that the evidence shows use of the **mark applied for** but also that it is sufficient to identify the **dates** of such use and the specific **geographical** territory of use within Georgia. Evidence that cannot be related to a certain point in time will normally be insufficient to show that distinctiveness had been acquired before the filing date, and evidence of use outside Georgia cannot show the required market recognition of the relevant public the country.

Direct evidence such as declarations by professional associations and market studies are usually the most relevant means for proving acquired distinctiveness through use. Invoices, advertising expenditure, magazines and catalogues may help to corroborate such direct evidence.³³

In order to assess the evidential value of a document, regard should be had to its **credibility**. It is also necessary to take into account the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, superficially, the document appears sound and reliable.³⁴

7.1 Opinion polls and surveys

Opinion polls concerning the proportion of the relevant public that recognises the sign as indicating the commercial origin of the goods or services can, if conducted properly, constitute one of the most direct kinds of evidence, since they can show the actual perception of the

³² public (19/06/2014, C-217/13 & C-218/13, Oberbank e.a., EU:C:2014:2012, § 48).

³³ (29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 74).

³⁴ (07/06/2005, T-303/03, Salvita, EU:T:2005:200, § 42; 16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 46 et seq.)

relevant public. However, it is not an easy matter to correctly formulate and implement an opinion poll so that it can be seen to **be truly neutral and representative**. Leading questions, unrepresentative samples of the public, and undue editing of responses should be avoided, as these can undermine the probative value of such surveys.

Accordingly, any opinion poll evidence must be assessed carefully. It is important that the questions asked are not leading ones.³⁵ The criteria for selecting the public interviewed must be assessed carefully. The sample must be indicative of the entire relevant public and must be selected randomly.³⁶

The Court does not exclude that a survey compiled some time before or after the filing date could contain useful indications, although it is clear that its evidential value is likely to vary depending on whether the period covered is close to or distant from the filing date or priority date of the trademark application at issue. Furthermore, its evidential value depends on the survey method used.³⁷

However, the results of a consumer survey cannot be the only decisive criterion in support of the conclusion that distinctive character has been acquired through use. They must therefore be complemented by other means of evidence.

For further details on the assessment of opinion polls, see the Guidelines, Part C, Opposition, Section 5, Trademarks with Reputation (Article 8(5) of the Law), paragraph 3.1.4.4.

7.2 Market share, advertising and turnover

The **market share** held by the trademark in relation to the goods and/or services applied for may be relevant for assessing whether that mark has acquired distinctive character through use, since such market penetration might enable Sakpatenti to infer that the relevant public would recognise the mark as identifying the goods or services as originating from a specific undertaking, and thus distinguish them from the goods and services of other undertakings.

The **investment** in advertising or promoting the mark in the relevant market for the goods or services claimed may also be relevant for assessing whether the mark has acquired distinctive character through use.³⁸ However, many attempts to prove distinctiveness acquired through use fail because the evidence provided by the applicant is not sufficient to prove a link between the market share and advertising, on the one hand, and consumer perceptions on the other.

Information concerning **turnover** and advertising expenses is one of the most readily available forms of evidence. These figures can have a significant impact on the assessment of the evidence, but in the great majority of cases are not sufficient alone to prove acquired distinctiveness of a trademark through use. This is because turnover/advertising costs alone, without additional corroborative details, are frequently too general to allow specific conclusions to be drawn about the use of one particular trademark. It is thus necessary to identify precisely the turnover/advertising figures and evidence relating to the mark applied for, as well as their link to the relevant goods and services. Furthermore, it is desirable that the figures be segregated on an annual and market-by-market basis. The evidence should show the specific period(s) of use (including details of when use commenced), so that Sakpatenti is able to establish whether the evidence proves that the trademark acquired distinctiveness before the filing date.

³⁵ (13/09/2012, T-72/11, Espetec, EU:T:2012:424, § 79)

³⁶ 29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 88)

³⁷ (12/07/2006, T-277/04, Vitacoat, EU:T:2006:202, § 38-39)

³⁸ (22/06/2006, C-25/05 P, Bonbonverpackung, EU:C:2006:422, § 76 et seq.)

Goods and services are often marketed under several trademarks, which makes it difficult to see the relevant customer's perception of the TM applied for on its own, that is to say, without such perception being affected by the other marks present. Turnover and advertising figures can often include sales or promotion of other trademarks, or of significantly different forms of the trademark at issue (for example, figurative trademarks rather than word marks, or differing word elements in a figurative mark), or are too general to allow identification of the specific markets under consideration. As a consequence, broadly consolidated turnover or advertising figures may not be sufficient to prove whether the relevant public perceives the trademark at issue as a badge of origin or not.

7.3 Declarations, affidavits and written statements

Statements in writing, sworn or affirmed or having a similar effect under the law of the State in which they are drawn up are valid means of evidence. With regard to **admissibility**, only in cases where the statements have not been sworn or affirmed is it necessary to consider the rules of law of the national jurisdiction as to the effects of a written statement. In case of doubt as to whether a statement has been sworn or affirmed, it is up to the applicant to submit evidence in this regard.

The weight and **probative value** of statutory declarations is determined by the general rules applied by Sakpatenti to the assessment of such evidence. In particular, both the capacity of the person giving the evidence and the relevance of the contents of the statement to the particular case must be taken into account.

Statements from **independent trade associations, consumer organisations and competitors** are an important means of evidence insofar as they come from independent sources. However, they must be examined carefully, as they might not be enough to prove distinctiveness acquired through use if, for example, they refer to 'the trademarks of the applicant' instead of to the specific mark in question.

Evidence from **suppliers or distributors** should, generally, be given less weight, since it is less likely that their evidence will be from an independent perspective. In this regard, the degree of independence of the latter will influence the weight to be given to the evidence by Sakpatenti.³⁹

Insofar as a declaration is **not made by an independent third party**, but by a person connected to the applicant through an employment relationship, it cannot in itself constitute sufficient evidence that the mark applied for has acquired distinctive character through use. In consequence, it must be treated as merely indicative and needs to be corroborated by other evidence.⁴⁰

As regards **statements from chambers of commerce and industry or other trade and professional associations and certifications and awards**, such statements and certifications must identify precisely the trademark applied for.

However, **cease and desist letters** against competitors or letters to newspapers complaining against the use of the sign in a generic sense have been considered evidence against acquired distinctiveness.⁴¹

For further details on the assessment of means of evidence, see the Guidelines, Part B, Examination, Section 5, Trademarks with Reputation

³⁹ (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 54-56)

⁴⁰ (21/11/2012, T-338/11, PHOTOS.COM, EU:T:2012:614, § 51)

⁴¹ (21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264, § 66)

7.4 Prior registrations and acquired distinctiveness





For evidence that consists of or includes Member State registrations **obtained on the basis of acquired distinctiveness**, the date to which the evidence submitted at national level refers will usually be different from the filing date of the Trademark application. These registrations are not binding, but may be taken into account, provided that Sakpatenti is able to assess the evidence submitted to the national IP office in question.

The applicant may also refer to **prior national registrations** where no acquired distinctiveness is claimed. Nevertheless, such registrations do not bind Sakpatenti. Moreover, Sakpatenti is not bound by its previous decisions and such cases must be assessed on their own merits.⁴²

7.5 Manner of use

Acquired distinctiveness must be demonstrated with respect to the sign applied for. The evidence should show examples of how the trademark is actually used (brochures, packaging, samples of the goods, etc.). The concept of use of a trademark, within the meaning of Article 4(3) of the **Law** must be interpreted as referring not only to use of the mark in the form in which it was submitted for registration, but also to the use of the trademark in forms which differ from that form solely by insignificant variations and that are able, therefore, to be regarded as broadly equivalent to that form.⁴³

Where a trademark is extremely simple, even minor alterations to that mark may constitute significant changes, so that the amended form may not be regarded as broadly equivalent to the mark as registered. Indeed, the simpler the mark, the less likely it is to have distinctive character and the more likely it is for an alteration to that mark to affect one of its essential characteristics and the perception of that mark by the relevant public.⁴⁴

	<p>‘... reversing the colour scheme, even if a sharp contrast between the three stripes and the background is preserved, cannot be described as an insignificant variation compared to the registered form of the mark at issue’ § 77.</p>		
			
TM No 12 442 166	Examples of the sign reflected in some of the evidence of use		

⁴² (21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264, § 72-73)

⁴³ (19/06/2019, T-307/17, DEVICE OF THREE PARALLEL STRIPES (fig.), EU:T:2019:427, § 62)

⁴⁴ (19/06/2019, T-307/17, DEVICE OF THREE PARALLEL STRIPES (fig.), EU:T:2019:427, § 72)

It is possible to prove acquired distinctiveness of a sign that **has been used together with other trademarks**, provided that the relevant consumer attributes to the sign in question the function of identification.⁴⁵

Although the trademark for which registration is sought may have been used as part of a registered trademark or in conjunction with such a mark, the fact remains that, for the purposes of registration of the mark itself, the trademark applicant must prove that that mark alone, as opposed to any other trademark that may also be present, identifies the particular undertaking from which the goods originate.⁴⁶

Moreover, **advertising material** on which a sign that is devoid of any distinctive character always appears with other marks that, by contrast, do have distinctive character does not constitute proof that the public perceives the sign applied for as a mark that indicates the commercial origin of the goods. For instance, the use of the sign 'Gifflar' (which indicates a kind of bread in Swedish) on the packaging of pastries, together with the trademark Pågen, is deemed to be made in a descriptive context, not as a badge of origin.⁴⁷

7.6 Length of use

The evidence should indicate when use commenced and should also show that the use was continuous or indicate reasons if there are gaps in the period of use.

As a general rule, long-standing use is likely to be an important persuasive element in establishing acquired distinctiveness. The longer customers and potential customers have been exposed to a mark the more likely they are to have made the connection between that mark and a single source in trade.

Considering, however, that length of use is only one of the factors to be taken into account, there may be situations where exceptions to the above rule are justified, in particular when other factors may also come into play that are capable of making up for a short length of use. For example, where products or services are the subject of a major advertising launch and/or the sign applied for is a mere variant of a sign already in long use, it may be the case that acquired distinctiveness can be achieved quite quickly.

This could be the case, for instance, where a new version of an existing and widely used computer-operating system is launched under a sign that essentially reproduces the structure and/or contents of the trademark applied to previous versions of the product. The trademark for such a product would be capable of achieving widespread acquired distinctiveness within a fairly short period of time simply because all existing users will immediately be made aware that the sign applied for refers to the upgrading to the new version.

In the same vein, it is in the nature of certain major sporting, musical or cultural events that they take place at regular intervals and are known to have extremely wide appeal. These major events are anticipated by millions, and the knowledge that the event is due on a particular date precedes the formal announcement of where it will take place. This circumstance creates intense interest in the nominated location of such events and in the announcement thereof ('city/country + year' marks). It is therefore reasonable to suppose that the moment a particular event, tournament or games is announced as having been allocated to a particular city or country, it is likely to become known instantly to practically all

⁴⁵ (07/07/2005, C-353/03, Have a break, EU:C:2005:432; 30/09/2009, T-75/08, !, EU:T:2009:374, § 43; 28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 46)

⁴⁶ (16/09/2015, C-215/14, Nestlé KIT KAT, EU:C:2015:604, § 66; 24/02/2016, T-411/14, Shape of a bottle (3D), EU:T:2016:94, § 76; 16/03/2016, T-363/15, LAATIKON MUOTO (3D), EU:T:2016:149, § 51)

⁴⁷ (09/07/2014, T-520/12, Gifflar, EU:T:2014:620, § 44-45)

relevant consumers with an interest in the sector concerned or to professionals in the sector. This may thereby give rise to the possibility of very rapid acquired distinctiveness of a mark concerning a forthcoming event, in particular where the sign reproduces the structure of previously used trademarks with the result that the public immediately perceives the new event as a sequel to a series of well-established events.

The assessment of such rapid acquired distinctiveness will follow the general criteria regarding, for instance, extent of use, territory, relevant date or targeted public, as well as regarding the onus on the applicant to provide evidence thereof. The only particularity refers to length of use and the possibility that, under certain circumstances, the acquisition of acquired distinctiveness may occur very rapidly, or even instantaneously. As under any other claim for acquired distinctiveness, it is for the applicant to demonstrate that the public is able to perceive the trademark in question as a distinctive sign.

7.7 Post-filing-date evidence

The evidence must show that, prior to the filing date, the trademark had acquired distinctive character through use.

However, this does not preclude the possibility that account may be taken of evidence that, although subsequent to the filing date, enables conclusions to be drawn regarding the situation as it was on the filing date.⁴⁸ Therefore, evidence cannot be rejected merely because it post-dates the filing date. Accordingly, such evidence must be assessed and given due weight.

As an example, a trademark that enjoys particularly relevant recognition on the market or a substantially relevant market share a few months after the filing date may have had acquired distinctiveness also on the filing date.

8. Consequences of Acquired Distinctiveness

A trademark registered in accordance with Article 4(3) of the Law enjoys the same protection as any other trademark that was found inherently registrable upon examination.

Chapter 15 collective marks

1. Character of Collective Marks

1.1 Definition

Collective mark is a specific kind of mark that, pursuant to Article 30(1) of the Law, 'is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings'.

It is one of the two kinds of marks set out in the Law, along with individual marks.

1.2 Specific function

The **essential function** of a collective mark is to distinguish the goods and services of the members of the association that owns the mark from those of other companies that do not belong to that association. Therefore, the collective mark indicates the commercial origin of certain goods and services by informing the consumer that the producer of the goods or the service provider belongs to a certain association and has the right to use the collective mark.

Even **geographically descriptive collective marks** (Article 31(1) of the Law) must be capable of fulfilling the essential function of a collective mark to indicate the collective commercial origin of the goods sold under that trademark.

⁴⁸ (19/06/2014, C-217/13, Oberbank e.a., EU:C:2014:2012, § 60)

Collective mark is typically used by companies, together with their **own individual marks**, to indicate that they are members of a certain association.

For example, Georgian Association of Shoe Manufacturers may want to apply for the collective mark 'საქართველოს ფეხსაცმლის მწარმოებელთა ასოციაცია', which, while belonging to the association, is also going to be used by all its members, who might be competitors. A member of the association may want to use the collective mark in addition to its own individual mark, which could be, for example, 'ფეხსაცმელი კროსტი'.

1.3 Relationship with individual marks

It is up to the applicant to decide whether the trademark fulfils the requirements of a collective mark, as opposed to those of an individual mark within the meaning of Article 30 of the Law. This means that, in principle, the same sign applied for as a collective mark might also be applied for as an individual marks, provided that the respective conditions of the Law are met for each application. The two kinds of marks do not differ necessarily with respect to the signs per se but as regards other characteristics specific to each one of them, including, in particular, the requirements of ownership and the conditions of use of the mark.

However, an applicant should be aware of the fact that, in the event of having to subsequently demonstrate genuine use of the marks, it will probably be rather difficult to show use of the same sign for different kinds of marks. For further information regarding genuine use of a mark in accordance with its function, please see the Guidelines, Part D, Cancellation, paragraph 2.2.2 genuine use.

For example, an association can file an application for the word mark 'Tamaki' either as an individual mark, or a collective mark, depending on the mark's intended use (by the association itself or its members). If it is applied for as a collective mark, certain additional formalities must be met, such as the submission of regulations governing use (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2).

After filing the application, changes to the kind of amarks (between collective and individual marks) are accepted only when it is obvious from the application that the wrong kind of mark has been selected.

1.4 Applicable provisions and examination

Provisions of the Law apply to collective marks, unless Articles 30-38 of the **Law** provide otherwise. On the one hand, collective marks are therefore subject to the general trade mark regime and on the other hand, to some exceptions and particularities.

It follows, firstly, that an application for a collective mark is, in principle, subject to the same examination procedure and conditions as an application for an individual mark. In general terms, the classification of goods and services, and the examination of formalities and of absolute and relative grounds for refusal, follow the same procedure as that applied to individual trademarks. For example, examiners will check the list of goods and services or the language requirements in the same way as they do with individual trademarks. Similarly, if the collective mark falls under one of the grounds for refusal of Articles 4 or 5 of the **Law**, this will also be examined.

The regulations submitted by the applicant governing the use of its collective mark **must cover its use for all the goods and services** included in the list of the collective mark application.

Secondly, the examination of a collective mark will also consider the exceptions and particularities of this kind of mark. These exceptions and particularities refer both to the

formal and substantive provisions. As regards formalities, the requirement for regulations governing use of the mark is, for example, a specific characteristic of a collective mark. (For further details of the examination of formalities of collective marks, including the regulations governing use of the mark, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2).

The substantive exceptions and particularities that apply to a collective mark are described below.

2. Ownership

Ownership of collective marks is limited to (i) associations of manufacturers, producers, suppliers of services, or traders that, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued; and (ii) legal persons governed by public law (Article 30(2) of the **Law**).

The first type of owner typically comprises private associations with a common purpose or interest. They must have their own legal personality and capacity to act. As set out in the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2.1, 'collective does not mean that the mark belongs to several persons [co-applicants/co-owners] nor that it designates/covers more than one country'.

Associations may be organised under different legal forms, including that of private corporations (such as *შეზღუდული პასუხისმგებლობის საზოგადოება*). However, as the latter are generally not organised as associations, Sakpatenti considers that a private corporation cannot be the owner of a collective mark unless it shows that its internal structure is of an associative nature.

The same applies to the second type of owners. Taking into account the essential function of collective marks (i.e. to distinguish the goods or services of the *members of the association* that is the proprietor of the mark from those of other undertakings), 'legal persons governed by public law' have to be either associations in a formal sense or need to have an internal structure of an associative nature. This concept includes, for example, associations or corporations governed by public law, such as the *consejos reguladores* or *colegios profesionales* under Spanish law. However, as an exception, Legal entities of public law may also apply for collective mark. In such case, regulation governing the use of a collective mark shall clearly indicate, that use of the mark is open for all entities who satisfy the requirements set out in the regulation.

3. Specific Grounds of Refusal

3.1 Regulations governing use

The regulations governing use must be filed within **1 month** of the filing date of the application of the collective mark (Article 4(8) of the **Instruction**) and their content must comply with the requirements of Article 32(2) and (3) of the **Law**. For complete details regarding the content of the regulations governing use, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2.3, Regulations governing use of collective marks.

The regulations governing use constitute a mandatory **part** of the collective mark. In particular, they are an **essential element** of the examination since they contain relevant information on the collective mark scheme and thus define the subject matter of protection.

Given their significance, the regulations governing use should be drafted in a **clear** and **accessible** manner.

The regulations governing use should reflect the specific kind of mark claimed in the application and the fact that the mark is indeed a collective mark, which will be used by the members of the association.

The regulations governing use must comply with the formalities requirements (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 8.2.3, Regulations governing use of collective marks) and reflect the kind of mark being applied for.

Substantive examination of the application will begin only once the regulations governing use have been received.

3.2 Remedies

In some cases, it will be possible to modify the regulations governing use in order to remove a ground for refusal of a collective mark application (Article 33 of the **Law**) raised by Sakpatenti. In all cases, the applicant has to submit new and complete regulations governing use. Sakpatenti will then assess if the objection can be waived as a consequence of the content of the new text.

Section 5 Relative Grounds for Refusal

Sub-Section 1 Double identity and likelihood of confusion

Chapter 1 General principles

1 Introduction

This sub-section provides an introduction to and overview of the concepts of (i) double identity and (ii) likelihood of confusion that are applied in situations of conflict between trade marks under Article 5 of the **Law**.

The paragraphs below set out the nature of these concepts and their legal underpinning as determined by the relevant laws.

The legal concepts of double identity and likelihood of confusion are used to protect trade marks and, at the same time, to define their scope of protection. It is thus important to bear in mind what aspects or functions of trade marks merit protection. Trade marks have various functions. The most fundamental one is to act as 'indicators of origin' of the commercial provenance of goods/services. This is their 'essential function'. The **essential function of the trade mark is to guarantee the identity of the origin of the marked product** to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others that have another origin.

The essential function of trade marks as indicating origin has been emphasised repeatedly and has become a precept of trade mark law.

Whilst indicating origin is the essential function of trademarks, it is not the only one. Indeed, the term, 'essential function' implies other functions. The functions of trademarks include **not only the essential function** of the trade mark, which is to guarantee to consumers the origin of the goods or services, **but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising.**

In examining the concepts of double identity and likelihood of confusion, this chapter touches upon several themes that are explained comprehensively in the chapters of the Guidelines that follow. A summary of the key cases from the European Courts dealing with the core principles and concepts of likelihood of confusion is added in the Annex.

2 Articles 5(a), (b), (c), (d) and (g) of the Law

Under Article 5 of the **Law** a sign can be rejected in a range of situations. The present chapter will concentrate on the interpretation of double identity and likelihood of confusion within the meaning of Article 5(a), (b), (c), (d) and (g) of the **Law**.

A rejection pursuant to Articles 5(a), (b), (c), (d) and (g) of the **Law** can be based on earlier trademark registrations or earlier well-known trademarks.⁴⁹

2.1 Article 5(a) of the Law — double identity

Article 5(a) of the **Law** provides for rejection based on identity. It provides that a trade mark will not be registered if it is identical to an earlier trade mark and the goods or services for which registration is applied for are identical to the goods or services for which the earlier trade mark is protected.

The wording of Article 5(a) of the **Law** clearly requires identity between **both** the signs concerned **and** the goods/services in question. This situation is referred to as 'double identity'. Whether there is double identity is a **legal finding** to be established from a direct comparison of the two conflicting signs and the goods/services in question. Where double identity is established, there is no need to demonstrate a likelihood of confusion. The protection conferred by Article 5(a) of the **Law** is absolute. Consequently, where there is double identity, there is no need to carry out an evaluation of the likelihood of confusion.

2.2 Articles 5(b) and 5(c) of the Law — likelihood of confusion

Articles 5(b) and 5(c) of the **Law** states that, a trade mark will not be registered:... if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trademark.

Hence, in contrast to situations of double identity as seen above, in cases of mere similarity between the signs and the goods/services, or identity of only one of these two elements, a trade mark may be rejected under Articles 5(b) and 5(c) of the **Law only if** there is a likelihood of confusion.

⁴⁹ Further guidance on well-known trademarks and trademarks with reputation can be found in section 5 subsection 3

3 The Notion of Likelihood of Confusion

3.1 Introduction

The assessment of the likelihood of confusion is a calculus applied in situations of conflict between trade marks in proceedings before Sakpatenti and the Court. However, the **Law** does not contain a definition of likelihood of confusion or a statement as to what 'confusion' precisely refers to.

The concept of likelihood of confusion refers to situations where:

1. The public directly confuses the conflicting trademarks, that is to say, mistakes one for the other.
2. The public makes a connection between the conflicting trademarks and assumes that the goods/services in question are from the same or economically linked undertakings (likelihood of association).

These two situations are further discussed below (see paragraph 3.2 below). The mere fact that the perception of a later trademark brings to mind an earlier trademark does not constitute a likelihood of confusion.

Marks with a highly distinctive character enjoy broader protection than marks with a less distinctive character.

Finally, the concept of likelihood of confusion must be regarded as a legal concept rather than purely an empirical or factual assessment despite the fact that its analysis requires taking into account certain aspects of consumer cognitive behaviour and purchasing habits (see paragraph 3.4 below).

3.2 Likelihood of confusion and likelihood of association

The likelihood of confusion relates to confusion about the origin of goods/services. The likelihood of association **is not an alternative** to likelihood of confusion, but it merely serves to define its scope. Therefore, a finding of likelihood of confusion requires that there be confusion as to the origin of goods/services.

The scope of the likelihood of confusion is clarified as follows: ... the risk that the public might believe that the goods and services in question come from the **same undertaking or, as the case may be, from economically linked undertakings** ... there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically linked undertakings.

As seen above, the likelihood of confusion relates to confusion as to commercial origin of the goods/service as coming from the same undertaking or from economically linked undertakings. What matters is that the public believes that the **control** of the goods or services in question is in the hands of the same/a single undertaking. The concept of **Economically linked undertaking** is not interpreted specifically in the context of likelihood of confusion. In *Ideal Standard* the European Court held:

... A number of situations are covered: products put into circulation by the same undertaking, by a licensee, by a parent company, by a subsidiary of the same group, or by an exclusive distributor.

... In all the cases mentioned, control [is] in the hands of a single body: the group of companies in the case of products put into circulation by a subsidiary; the manufacturer in the case of products marketed by the distributor; the licensor in the case of products marketed by a licensee. In the case of a licence, the licensor can control the quality of the licensee's products by including in the contract clauses requiring the licensee to comply with his instructions and giving him the possibility of verifying such compliance. The origin that the trade mark is

intended to guarantee is the same: it is not defined by reference to the manufacturer but by reference to the point of control of manufacture.

Consequently, economic links will be presumed where the consumer assumes that the respective goods or services are marketed under the control of the trade mark proprietor. Such control can be assumed to exist in the case of enterprises belonging to the same group of companies and in the case of licensing, merchandising or distribution arrangements as well as in any other situation where the consumer assumes that the use of the trade mark is normally possible only with the agreement of the trade mark proprietor.

Therefore, the likelihood of confusion covers situations where:

1. the relevant public directly confuses the trade marks themselves; or where
2. the relevant public makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

Hence, if the perception of a later trade mark merely brings to mind an earlier trade mark, but the relevant public does not assume the same commercial origin, then this link does not give rise to a likelihood of confusion despite the existence of a similarity between the signs.

3.3 Likelihood of confusion and distinctiveness of the earlier mark

The distinctiveness of the earlier trade mark is an important consideration when assessing the likelihood of confusion, since:

- the more distinctive the earlier trade mark, the greater will be the likelihood of confusion;
- trade marks with a highly distinctive character enjoy broader protection than trade marks with a less distinctive character;
- however, the scope of protection of trade marks with low distinctive character will be narrower.

One consequence of these findings is that the enhanced distinctiveness of the earlier mark may be a decisive factor towards establishing a likelihood of confusion when the similarity between the signs and/or the goods and services is low. When the distinctiveness of the earlier trade mark is low, this may be a factor weighing against the likelihood of confusion.

3.4 Likelihood of confusion: questions of fact and questions of law

The concept of likelihood of confusion is a legal concept rather than a mere factual evaluation of the rational judgments and emotional preferences that inform the relevant public's cognitive behaviour and purchasing habits. Therefore, assessment of the likelihood of confusion depends on both legal questions and facts.

Determining the relevant factors for establishing a likelihood of confusion and whether they exist is a question of law, that is to say, these factors are established by the relevant legislation, namely, the **Law**.

For instance, Articles 5(b) and 5(c) of the **Law** establishes that the identity/similarity of goods/services is a condition for a likelihood of confusion. The identification of the relevant factors for evaluating whether this condition is met is also a question of law.

The following factors are identified to determine whether goods/services are similar:

- their nature;
- their intended purpose;
- their method of use;
- whether they are complementary or not;
- whether they are in competition or interchangeable;
- their distribution channels/points of sale;

- their relevant public;
- their usual origin.

All these factors are legal concepts and determining the criteria to evaluate them is also a **question of law**. However, it is a **question of fact** whether, and to what degree, the legal criteria for determining, for instance, 'nature', are fulfilled in a particular case.

By way of example, *cooking fat* does not have the same nature as *petroleum lubricating oils and greases* even though both contain a fat base. *Cooking fat* is used in preparing food for human consumption, whereas *oils and greases* are used for lubricating machines. Considering 'nature' to be a relevant factor in the analysis of similarity of goods/services is a matter of **law**. However, it is a matter of **fact** to state that cooking fat is used in preparing food for human consumption and that oils and greases are used for machines.

Similarly, when it comes to the comparison of signs, Articles 5(b) and 5(c) of the **Law** establishes that the identity/similarity of signs is a condition for a likelihood of confusion. It is a question of law that a conceptual coincidence between signs may render them similar for the purposes of the **Law**, but it is a question of fact, for instance, that the word 'fghryz' does not have any meaning for the Georgian public.

4 Evaluation of the Relevant Factors for Establishing a Likelihood of Confusion

4.1 List of factors for assessing the likelihood of confusion

The likelihood of confusion is assessed in the following steps, taking into account multiple factors:

- comparison of goods and services;
- relevant public and degree of attention;
- comparison of signs;
- distinctiveness of the earlier mark;
- any other factors;
- global assessment of the likelihood of confusion.

A separate chapter of the Guidelines is dedicated to each of the above factors and its specifics.

Chapter 2 Comparison of goods and services

1 Introduction

1.1 Relevance

The comparison of goods and services is primarily of relevance for the assessment of identity according to Article 5(a) of the **Law** and likelihood of confusion according to Articles 5(b) and 5(c) of the **Law**. One of the main conditions for Article 5(a) of the **Law** is the identity of goods/services, while Article 5(b) of the **Law** requires the similarity of goods/services and Article 5(c) of the **Law** requires the identity or similarity of goods/services. Consequently, if all goods/services are found to be dissimilar, one of the conditions contained in Articles 5(a), 5(b) and 5(c) of the **Law** is not fulfilled.

Furthermore, the outcome of the comparison of goods/services plays an important role in defining the part of the public for whom likelihood of confusion is analysed because the relevant public is that of the goods/services found to be identical or similar.

1.2 Nice Classification: a starting point

The goods/services to be compared are classified according to the Nice Classification. Currently the Nice Classification consists of 34 classes (1-34) for categorising goods and 11 classes (35-45) for categorising services.

1.2.1 Its nature as a classification tool

The Nice Classification was set up with the aim of harmonising national classification practices. Its first edition entered into force in 1961. Although it has undergone several revisions, it sometimes lags behind the rapid changes in product developments in the markets. Furthermore, the wording of the headings is at times unclear and imprecise.

The Nice Classification serves purely administrative purposes and, as such, does not in itself provide a basis for drawing conclusions as to the similarity of goods and services.

Examples

- Live animals are dissimilar to flowers (Class 31).
- Advertising is dissimilar to office functions (Class 35).

The fact that two specific goods/services fall under the same general indication of a class heading does not per se make them similar, let alone identical: *cars* and *bicycles* — although both fall under *vehicles* in Class 12 — are considered dissimilar.

Therefore, the fact that goods/services are listed in the same class of the Nice Classification is not, in itself, an indication of similarity. Furthermore, goods/services listed in different classes are not necessarily considered dissimilar.⁵⁰

Examples

- Meat extracts (Class 29) are similar to spices (Class 30).
- Travel arrangement (Class 39) is similar to providing temporary accommodation (Class 43).

1.2.2 Its structure and methodology

Classification may serve as a tool to identify the common characteristics of certain goods/services.

Many classes of the Nice Classification are structured according to factors such as function, composition and/or purpose of use, which may be relevant in the comparison of goods/services. For example:

- Class 1 comprises chemical goods based primarily on their chemical properties (nature), rather than on their specific application. By contrast, Class 3 covers all items that are either cleaning preparations or for personal hygiene or beautification. Although they can by their nature also be classified as chemical products, it is their specific purpose that allows a distinction and thus a different classification.
- Equally, it is because of their nature that most items made of leather are classified in Class 18, whereas clothing made of leather falls under Class 25 since it serves a very specific purpose, namely that of being worn by people and as protection from the elements.

1.2.3 Conclusions to be drawn from the structure of the Nice Classification

The structure of the class headings is not uniform and does not follow the same logic. Some classes consist of only one general indication that by definition already covers nearly all the goods/services included in this class (Class 15 *musical instruments*; Class 38 *telecommunications*). Others include many general indications — some very broad and others

⁵⁰ 16/12/2008, T-259/06, Manso de Velasco, EU:T:2008:575, § 30-31

very specific. For example, the heading of Class 9 includes more than 30 terms, ranging from *scientific apparatus and instruments* to *fire-extinguishing apparatus*.

Exceptionally, there are class headings containing general indications that include another general indication and are thus identical.

Example: *materials for dressing* in Class 5 include *plasters* in Class 5.

Other specific indications in a class heading are only mentioned to clarify that they do not belong to another class.

Example: *adhesives used in industry* are included in *chemicals used in industry* in Class 1. Its mention is mainly thought to distinguish them from *adhesives* classified in Class 16, which are for stationery or household purposes.

To conclude, the Nice Classification gives indications that can be used in the assessment of identity or similarity of goods/services. However, its structure and content is not consistent. Therefore, each heading or specific term has to be analysed according to the specific class under which it is classified. As stated before, the Nice Classification mainly serves to categorise goods/services for administrative purposes and is not decisive for their comparison.

1.2.4 Changes in the classification of goods/services

Normally, each revision of the Nice Classification brings changes in the classification of goods/services (in particular transfers of goods/services between various classes) or in the wording of headings. In such cases the list of goods/services of both the earlier and the contested mark must be interpreted according to the edition of the Nice Classification in force at the time of filing.

Examples

- *Legal services* were transferred from Class 42 to Class 45 with the 8th edition of the Nice Classification. The nature of these services has not changed.
- *Vending machines* were transferred from Class 9 to Class 7 in the 10th edition of the Nice Classification, since a vending machine is basically a powered machine and as such was considered more appropriately classified in Class 7 with other machinery. However, since the nature of these goods has not changed, *vending machines* classified in different classes due to the different filing dates of the respective applications are regarded as identical.

1.3 Definition of goods and services (terminology)

The Trademark Law does not give a definition of goods and services. Although the Nice Classification gives some general explanations to this effect in its introductory remarks, it refrains from clearly setting criteria for the distinction between goods and services.

1.3.1 Goods

In principle, the word 'goods' refers to any kind of item that may be traded. Goods comprise raw materials (unprocessed plastics in Class 1), semi-finished products (plastics in extruded form for use in manufacture in Class 17) and finished products (plastic household containers in Class 21). They include natural and manufactured goods, such as agricultural products in Class 31 and machines and machine tools in Class 7.

However, sometimes it is not clear whether goods comprise only tangible physical products as opposed to services, which are intangible. The definition and thus the scope of protection are particularly relevant when it comes to 'goods', such as *electricity*, that are intangible. This question is already answered during the examination on classification and will not usually cause any problems in the comparison of goods and services.

1.3.2 Services

A service is any activity or benefit that one party can offer to another that is intangible and does not result in the transfer of ownership of any physical object. In contrast to goods, a service is always intangible.

Importantly, services comprise economic activities provided to third parties.

- Advertising one's own goods is not a service but running an advertising agency (designing advertising campaigns for third parties) is. Similarly *shop window dressing* is only a service when provided for third parties, not when done in one's own shop.
- Selling, storing or distributing one's own goods is not a service. Retail services are meant to cover the services around the actual sale of goods, such as providing the customer with an opportunity to conveniently see, compare or test the goods.

One indication for an activity to be considered a service under trademark law is its independent economic value, that is to say, it is usually provided in exchange for some form of (monetary) compensation. Otherwise, it could be a mere ancillary activity provided together with or after the purchase of a specific product.

Example

- Delivery, including the transport of furniture that has previously been purchased (either in a physical establishment or online), is not an independent service falling under *transport services* in Class 39.

However, the intention to make profit is not necessarily a criterion for defining whether an activity can qualify as a 'service'. It is more a question of whether the service has an independent market area and targeted public rather than the way or form in which compensation is made for it.

1.3.3 Products

In common parlance the term 'products' is used for both goods and services, for example, 'financial products' instead of financial services. Whether terms in common parlance are described as 'products' is immaterial to them being classified as goods/ services.

1.4 Determining the goods/services

1.4.1 Scope of goods/services in comparison

As a preliminary step, the correct wording of the lists of goods/services under consideration must be identified. Comparison of the goods and services must be based on the wording indicated in the respective lists of goods/services. Any actual or intended use not stipulated in the list of goods/services is not relevant for this comparison since it is not an assessment of actual confusion or infringement.⁵¹

Furthermore, an analysis of the wording of the list of goods/services might be required to determine the scope of protection of those goods and services. This is especially true where terms such as 'in particular', 'namely', or equivalents are used in order to show the relationship of an individual product with a broader category.

The term 'in particular' (or 'for example', 'such as', 'including' or other equivalent) indicates that the specific goods/services are only examples of items included in the category, and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples.⁵²

⁵¹ 16/06/2010, T-487/08, Kremezin, EU:T:2010:237, § 71

⁵² on the use of 'in particular', see the reference in 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107

However, the term 'namely' (or 'exclusively' or other equivalent) is exclusive and restricts the scope of the registration to only the specifically listed goods.

For example, in the case of *chemicals used in industry*, 'namely' *raw materials for plastics* only the *raw materials for plastics* need to be compared with the goods of the other mark.

On the contrary, in the case of *chemicals used in industry*, 'in particular' *raw materials for plastics*, only the broad category of *chemicals used in industry* need be compared with the goods of the other mark.

The use of commas in the list of goods/services serves to separate items within the same or a similar category. The use of a semicolon means a separation between terms. The separation of terms by different punctuation can lead to changes in their meaning and may lead to a different assessment when comparing the goods/services. For more information on punctuation in lists of goods and services, see the Guidelines, Part B, Examination, Section 3, Classification.

For example, in *computer software for use with industrial machines; fire extinguishers* in Class 9, the inclusion of a semicolon means that the term *fire extinguishers* must be considered as an independent category of goods, regardless of whether the intention was to protect computer software to be used in the field of industrial machines and fire extinguishers.

1.4.1.1 Meaning of terms in list of goods/services

Once the wording of the goods/services to be considered has been identified, its meaning must be determined.

In some cases, the exact meaning is immediately obvious from the list of goods/ services, where a more or less detailed description of the goods/services is generally given. For example, the wording *belts, being articles of clothing* excludes by definition safety and industrial belts.

In case of doubt about the exact meaning of the terms used in the list of goods/ services, the terms have to be interpreted both in the light of the Nice Classification and from a commercial perspective. Therefore, *belts* in Class 25 are, owing to their classification, *articles of clothing*.

Where the meanings of terms in a semantic context, a commercial context and/or under the Nice Classification are ambiguous or give rise to doubt, the meaning under the Nice Classification prevails.

1.4.1.2 Unclear and imprecise terms

An analysis of the wording of the list of goods/services is also required where the wording or term used is **not sufficiently clear and precise** to enable the competent authorities and economic operators to determine, on that sole basis, the scope of protection given to the mark. This is the case where the wording or term used is too general and covers goods/services that are too variable to be compatible with the trade mark's function as an indication of origin.⁵³ This means that it is not possible to infer with a reasonable degree of certainty which specific goods/services are actually covered, as the wording or general term does not, in itself, sufficiently reveal the commercial nature and attributes of the goods/services to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin.

⁵³ 19/06/2012, C-307/10, IP Translator, EU:C:2012:361, § 54

If the term is unclear or imprecise in itself and does not sufficiently reveal the commercial nature and attributes of the goods/services to be covered, and if there is no limitation (or partial surrender) enabling Sakpatenti to clearly determine the exact scope of protection, different steps must be taken, depending on whether the unclear or imprecise term is contained in the earlier mark or the contested mark (see paragraphs 1.4.1.2.1 and 1.4.1.2.2 respectively).

The general indications from the Nice Class Headings and other examples of terms and expressions lacking clarity and precision can be found in Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7. If the earlier mark is a national (or international) registration, it is within Sakpatenti's competence to interpret its scope of protection in examination or relative grounds proceedings before Sakpatenti. As such, when Sakpatenti concludes that a particular term covered by an earlier mark does not meet the requirement of clarity and precision, it will apply the necessary consequences accordingly, as set out in paragraph 1.5.2.2.1.

In any event, it is in the interests of trade mark holders (applicants or owners) to clarify unclear or imprecise terms and thus precisely determine the scope of protection; they can do this through explicit restriction or partial surrender. See also the Guidelines, Part B, Examination, Section 3, Classification, paragraphs 5.3.1 – 5.3.3.

1.4.2.2.1 Unclear or imprecise term(s) in list of goods/services covered by earlier mark

Unclear or imprecise terms in the earlier mark may not be excluded from the outset in the comparison of goods and services simply by invoking a lack of clarity and precision (04/03/2020, Joined Cases C-155/18 P – C-158/18 P, BURLINGTON / BURLINGTON ARCADE, EU:C:2020:151, § 134). However, these terms can only be taken into account in their most natural and literal sense. Unclear or imprecise terms may not be construed as constituting a claim to goods/services that cannot be covered by this meaning without further specification. As a result, unless the same (or a synonymous) unclear and imprecise term is used in the specification of both marks (see paragraph 2.1), lack of clarity and precision of wording is not a sufficient basis in itself for arguing in support of identity or similarity where Sakpatenti is unable to clearly determine the exact scope of protection of unclear or imprecise terms. Nor may an unclear or imprecise term be interpreted in relation or by reference to other goods/ services within the same class or different classes.

Consequently, while unclear or imprecise terms in the earlier mark will be compared with the contested goods/services, taking into account the similarity factors (as specified in detail in paragraphs 3.1 to 3.3), no similarity can be found when the natural and literal meaning of an unclear or imprecise term cannot be understood to lead to a coincidence in relevant similarity factors with the contested goods/services.

For example, while the unclear and imprecise term *machines* can be understood in its natural meaning as 'equipment which uses electricity or an engine in order to do a particular kind of work' (*Collins English Dictionary*), or მექანიზმი, რომელიც ასრულებს რაიმე სამუშაოს (ქართული განმარტებითი ლექსიკონის ონლაინ ვერსია) this abstract meaning does not sufficiently reveal its specific commercial nature, that is to say what machines or types of machines are meant to be covered. Machines can have different characteristics or different purposes, may require very different levels of technical capabilities and know-how to be produced and/or used, could target different consumers and be sold through different sales channels, and therefore relate to different market sectors.

As a result, when comparing the unclear and imprecise term *machines* with, for example, *dual combustion machines for use in agriculture*, the lack of clarity and precision of the first term

cannot be used on its own for arguing identity or similarity; nor can the term be construed as relating to 'dual combustion' machines or to machines 'for use in agriculture' when such qualities or methods of use have not been expressly identified in the specification and cannot be understood from its natural and literal meaning. It follows that, while the terms may be compared and be considered to have the same abstract nature insofar as they are machines, they cannot, on the basis of the insufficient information and facts provided by the imprecise specification of the earlier mark, be considered to have the same purpose or methods of use, or to be complementary to each other or in competition. Furthermore, they cannot be considered to target the same relevant public, share the same distribution channels or be usually produced by the same undertakings. Consequently, unless the unclear and imprecise term *machines* is further specified, the goods cannot be considered either identical or similar.

However, if an unclear or imprecise term is followed by another term that expressly identifies goods/services by way of an example (e.g. *machines, in particular agricultural machines or repair services, in particular vehicle repair*), a comparison may also be made between that specific term (*agricultural machines* or *vehicle repair*) and the goods/services of the contested mark (25/06/2020, T-114/19, B (fig.) / b (fig.), EU:T:2020:286, § 51, 53). This could lead to coincidence in relevant similarity factors between that specific term and the contested goods/services.

Unclear or imprecise terms in the earlier mark can also be clarified by means of a partial surrender by the trade mark proprietor, which would facilitate comparison with the goods/services of the contested mark, and might lead to identity or similarity being found between the goods/services under comparison, based on the relevant criteria as specified in paragraphs 3.1 to 3.3.

1.4.2.2.2 Unclear or imprecise term(s) in list of goods/services covered by cited/contested mark

The applicant must identify the goods and services for which trade mark protection is sought with sufficient clarity and precision. According to Article 00 of the Law, this applies equally to the holder of an international registration designating Georgia.

Therefore, unless the same (or a synonymous) unclear and imprecise term is used in the specification of both marks (see paragraph 2.1), Sakpatenti will, where the contested mark contains an unclear or imprecise term, reopen examination of the classification of the mark under Article 00 of the Law (or where applicable under Article 00 of the Law and if possible) and suspend the opposition proceedings accordingly (27/02/2014, T-229/12, Vogue, EU:T:2014:95, § 55). See also the Guidelines, Part B, Examination, Section 3, Classification, paragraph 5.5.

The applicant may at any time clarify an unclear or imprecise term by restricting the list of goods/services contained in the application, as long as the ensuing specification is sufficiently clear and precise and does not extend the scope of protection (Article 12 (5)(c) of Trademark Law). The holder of an international registration designating Georgia may also restrict the list of goods/ services in accordance with Article 9bis(iii) of the Madrid Protocol; the restricted list will then be examined in the same way as one for a Georgian application. See also the Guidelines, Part C, Opposition, Section 1, Opposition Proceedings, paragraph 6.2

1.5 Objective approach

The comparison of the goods/services in question must be made **without** taking into account the degree of similarity of the conflicting signs or the distinctiveness of the earlier mark. It is

only in the overall assessment of a decision that the examiners will take into account all the relevant factors.

The classification of the goods/services is not conclusive, because similar goods/ services may be classified in different classes, whereas dissimilar goods/services may fall within the same class.

Identity or similarity of the goods/services in question must be determined on an objective basis.

It is necessary to base the findings on the realities of the marketplace, such as established customs in the relevant field of industry or commerce. These customs, especially trade practices, are dynamic and constantly changing. For instance, mobile phones nowadays combine many functions, such as being communication tools as well as photographic apparatus.

The degree of similarity of the goods and services is a matter of law, which must be assessed *ex officio*. However, Sakpatenti's *ex officio* examination is restricted to well-known facts, that is to say, 'facts which are likely to be known by anyone or which may be learned from generally accessible sources', which excludes facts of a highly technical nature.⁵⁴

1.6 Statement of reasons

The examiner is required to state reasons for the outcome of the comparison (identity, similarity or dissimilarity) for each of the individual goods and services specified in the application for registration. However, the examiner may use only general reasoning for groups of the goods/services concerned as long as the goods/services present analogous characteristics.⁵⁵

2 Identity

2.1 General principles

Identity exists not only when the goods and services completely coincide (the same terms or synonyms are used), but also when and insofar as the contested mark's goods/services fall within the earlier mark's broader category, or when and insofar as — conversely — a broader term of the contested mark includes the more specific goods/services of the earlier mark. There might also be identity when two broad categories under comparison coincide partially ('overlap'). Hence a distinction can be made between cases of 'full identity' and 'partial identity'.

~~Identity should not be established on the basis of similarity factors (see paragraph 3.1.1) or on the basis of an unclear and imprecise term in an earlier mark, as it is not possible to infer with a reasonable degree of certainty what specific goods/ services, that is to say what kind of goods/services, are actually covered by those terms (see paragraph 1.4.2.2.1 and the list of examples of unclear and imprecise terms in Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7). However, where the same (or a synonymous) unclear and imprecise term is used in both marks, such as *machines*, the terms coincide completely and therefore must be considered identical.~~

2.2 Identical terms or synonyms

Identity between the goods/services in dispute must be established on the basis of the wording of the relevant parts of the lists of goods/services of the two marks that have been identified

⁵⁴ 03/07/2013, T-106/12, Alpharen, EU:T:2013:340, § 51

⁵⁵ see, by analogy, 18/03/2010, C-282/09 P, P@yweb card / Payweb card, EU:C:2010:153, § 37-38; 12/04/2011, T-28/10, Euro automatic Payment, EU:T:2011:158, § 54; 17/10/2013, C-597/12 P, Zebexir, EU:C:2013:672, § 26-27

in accordance with the general principles set out in paragraph 2.1. Identity is obvious where the goods/services to be compared are listed in exactly the same terms.

Example

- *Vehicles* are identical to *vehicles*.

Where this is not the case, the terms of the respective lists of goods/services must be interpreted in order to show that they are in fact synonyms, that is to say, that their meaning is the same. The interpretation can be made based on dictionary definitions, expressions from the Nice Classification and, in particular, by taking into account the commercial perspective.

Examples

- The meaning of the words *smokers' articles* in Class 34 refers to individual objects that are used in close connection with tobacco or tobacco products. In former editions of the Nice Classification these products were called *smokers' requisites*. Therefore, despite a different term used in the current heading, these goods are identical.

However, if identical wording is used but the goods are classified in different classes, this generally means that these goods are not identical.

Examples

- *Drills* (machine tools) in Class 7 are not identical to *drills* (hand tools) in Class 8.
- *Lasers* (not for medical treatment) in Class 9 are not identical to *lasers* (for curative purposes) in Class 10.

Even though they might be similar, the classification in different classes indicates that they have a different nature, purpose or method of use, etc.

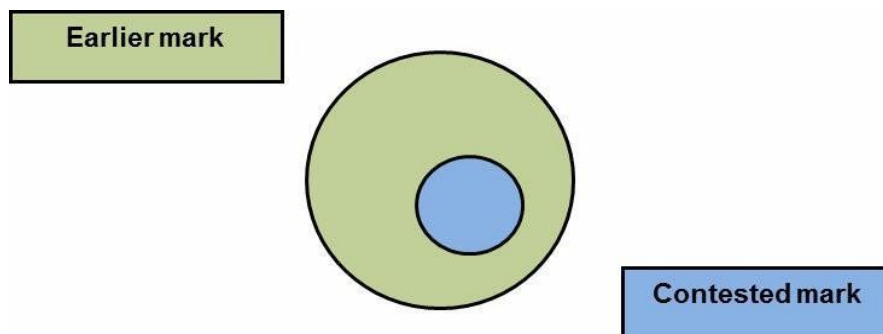
The same reasoning does not apply if the different classification is only due to a revision of the Nice Classification or where it is clear that the goods/services are wrongly 'classified' due to an obvious mistake.

Examples

- *Playing cards* (Class 16 — 7th edition) are identical to *playing cards* (Class 28 —10th edition).
- *Pharmaceutical preparations* (Class 15) — an obvious typing error — are identical to *pharmaceutical preparations* (Class 5).

2.3 Terms included in the general indication or broad category

2.3.1 The earlier mark includes the goods/services of the cited/contested mark



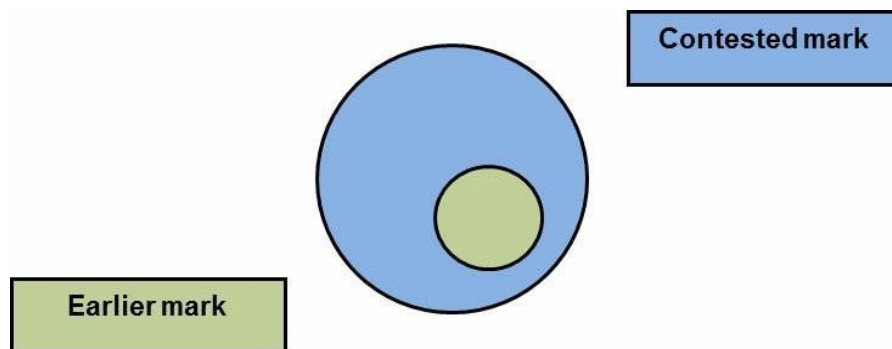
Where the list of goods/services of the earlier right includes a general indication or a broad category that covers the goods/services of the application / contested mark in their entirety, the goods/services will be identical.⁵⁶

Examples

- *Temporary accommodation* (earlier mark, Class 43) includes *youth hostel services* (contested mark, Class 43). Therefore, the services are identical.
- *Pasta* (earlier mark, Class 30) includes *spaghetti* (contested mark, Class 30). The conflicting goods are considered identical.

~~However, the same reasoning cannot apply where the earlier mark contains a general indication or other general term considered to lack the necessary clarity and precision. It is not possible, on the basis of an unclear and imprecise term, to infer with a reasonable degree of certainty what specific goods/services, that is to say what kind of goods/services, are actually covered by the term since the latter does not, in itself, sufficiently reveal the specific commercial nature and attributes of the goods/services that are meant to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin. Therefore, where the earlier mark contains an unclear and imprecise term, it should be interpreted accordingly (see paragraph 1.4.1.2.1)~~

2.3.2 The contested mark includes the goods/services of the earlier mark



If the goods/services designated in the earlier mark are covered by a general indication or broad category used in the application / contested mark, these goods/services must be considered identical since Sakpatenti cannot dissect *ex officio* the broad category of the applicant's/holder's goods/services.

Examples

- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (contested mark, Class 25). The goods are considered identical.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The goods are considered identical. The applicant/holder may, however, restrict the list of goods/services in a way that excludes identity, but could still lead to similarity.⁵⁷
- The earlier mark's *jeans* (Class 25) are included in *articles of clothing* (Class 25). The applicant/holder restricts the specification to *articles of clothing, excluding jeans*. The goods are no longer identical but remain similar.
- The earlier mark's *bicycles* (Class 12) are included in *vehicles* (contested mark, Class 12). The applicant/holder restricts the specification to *vehicles, namely automobiles*. The goods are no longer identical or similar.

⁵⁶ 17/01/2012, T-522/10, Hell, EU:T:2012:9, § 36

⁵⁷ 24/05/2011, T-161/10, E-Plex, EU:T:2011:244, § 22

If the applicant/holder does not restrict the list of goods/services, or does not do so sufficiently, Sakpatenti will treat the contested mark's general indication or broad term/ category as a single unit and find identity.

If the contested mark covers a general indication or a broad term/category as well as specific items that fall under that general indication or broad term/category, all of these will need to be compared with the specific earlier goods/services. The result of identity found with the general indication or broad term/category does not automatically extend to the specific items.

Example

- The contested mark covers *vehicles* (general indication) as well as *bicycles, aircraft, trains* (included in vehicles). Where the earlier mark is protected for *bicycles*, identity will be found with respect to *vehicles* and to *bicycles* but not for *aircraft* or *trains*.

However, if the contested mark covers a general indication or broad term/category and specific terms that are not listed independently but only as examples of goods/services included in that general indication or broad term/category, the comparison differs insofar as it is not necessary to compare the specific examples of goods/services listed, but only the general indication or broad term/category for which protection was sought or for which it was registered.

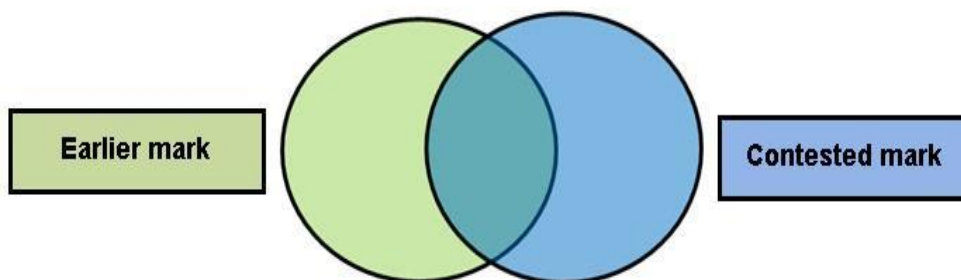
Example

- The application / contested mark covers *vehicles, 'in particular' bicycles, aircraft, trains*. The earlier mark is protected for *bicycles*. The goods in conflict are considered identical, since the broad category of *vehicles* includes *bicycles* and the specific examples of goods listed after that broad category do not need to be compared.

The applicant/holder can avoid this result by deleting the general indication *vehicles*, the expression *in particular*, and the specific category *bicycles*.

Where the list of goods/services of the contested mark reads: *vehicles, 'namely' bicycles, aircraft, trains*, the comparison differs insofar as only the specific items have to be compared. In this case only the contested *bicycles* are identical to the earlier goods.

2.4 Overlap



If two categories of goods/services coincide partially ('overlap') there might be identity if:

1. they are classified in the same class; and
2. it is impossible to clearly separate the two goods/services.

Examples

Earlier goods	Contested goods	Coinciding part
---------------	-----------------	-----------------

<i>Outdoor clothing for women</i> (Class 25)	<i>Clothing made of leather</i> (Class 25)	Outdoor clothing made of leather for women
<i>Components and spare parts for land vehicles</i> (Class 12)	<i>Vehicle seats</i> (Class 12)	Seats for land vehicles
<i>Bread</i> (Class 30)	<i>Long-life bakery products</i> (Class 30)	Long-life bread
<i>Soap</i> (Class 3)	<i>Cleaning preparations</i> (Class 3)	Soaps for cleaning purposes
<i>Scientific instruments</i> (Class 9)	<i>Optical instruments</i> (Class 9)	Scientific optical instruments, e.g. microscopes
<i>Online banking services</i> (Class 36)	<i>Commercial banking services</i> (Class 36)	Online commercial banking services

In such cases, it is impossible for Sakpatenti to filter these goods from the abovementioned categories. Since Sakpatenti cannot dissect *ex officio* the broad category of the applicant's/holder's goods, they are considered to be identical.

In the fourth example given above, the outcome changes, of course, if *soap* is limited to *soaps for personal use*. In this case the goods are no longer included in the heading *cleaning preparations* in Class 3 since the latter are only for household use.

~~Furthermore, where the earlier mark contains a general indication or other general term considered to lack the necessary clarity and precision, no overlap can be found on the basis of that term (see the list of examples in Annex I: Specific Questions on the Similarity of Goods and Services, paragraph 4.7). It is not possible to infer with a reasonable degree of certainty what specific goods/services, that is to say what kind of goods/services, are actually covered by an unclear and imprecise term, as the latter does not, in itself, sufficiently reveal the specific commercial nature and attributes of the goods/services that are meant to be covered, such as their intended purpose, method of use, the relevant public targeted, the distribution channels, relevant market sector or usual commercial origin. Therefore, where the earlier mark contains an unclear and imprecise term, it should be interpreted accordingly.~~

~~2.5 Practice on the use of general indications of the class headings~~

3 Similarity of Goods and Services

3.1 General principles

3.1.1 Similarity factors

Generally speaking, two items are defined as being similar when they have some characteristics in common. The similarity of goods and services does not depend on any specific number of criteria that could be determined in advance and applied in all cases.

The similarity of goods and services has been addressed in the European case-law of the Court of Justice in *Canon* (29/09/1998, C-39/97, Canon, EU:C:1998:442). The Court of Justice held that in assessing the similarity of goods all the relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (para. 23).

The term 'inter alia' shows that the enumeration of the above factors by the Court is only indicative. There may be other factors in addition to or instead of those mentioned by the Court that may be pertinent, depending on the particular case.

This leads to the conclusion that the following factors should be taken into account:

Canon factors

- nature
- intended purpose
- method of use
- complementarity
- competition

Additional factors

- distribution channels
- relevant public
- the usual origin of the goods/services.

These factors will be further explained in paragraph 3.2.

3.1.2 Defining relevant factors

The comparison should focus on identifying the relevant factors that specifically characterise the goods/services to be compared. Therefore, the relevance of a particular factor depends on the respective goods/services to be compared.

Example

- When comparing *skis* and *ski-boots*, it is evident that they do not coincide in their nature or method of use and are not in competition. Therefore, the comparison should focus on their purpose, their complementary character, their distribution channels, their usual origin and/or the relevant public.

Therefore, the relevant factors and features characterising a product or a service may be different depending on the goods and services with which they have to be compared.

It is not necessary to list all possible factors. What does matter, however, is whether the connections between the relevant factors are sufficiently close to find similarity.

The following questions could be asked:

- How will the goods/services be used?
- What is their purpose?
- How likely is it that they coincide in producers?
- Are they usually found in the same outlet or department store, or in the same section of a supermarket?

If the factors cannot already be defined from the wording of the goods/services, information may be derived from dictionary entries. However, dictionary entries have to be analysed against commercial realities and in particular taking into account the Nice Classification.

Example

- According to the dictionary, *ice* is the singular of *ices* and means inter alia '(an) ice cream' or 'water ice' (Oxford Dictionaries online edition). If the comparison of *ices* and *ice* in Class 30 were made on the basis of the definition from the dictionary alone, it would lead to the erroneous conclusion that *ice* is identical to *ices*. However, since both *ices* and *ice* are

mentioned in the list of goods in Class 30, *ices* are to be understood as ‘edible ices’, whereas *ice* is to be understood as ‘cooling ice’. Although they coincide in the composition to the extent that both consist (partly) of frozen water, their commercial nature is different: while one is a foodstuff, the other is an auxiliary good for preserving and/or cooling foodstuffs. This shows that the Nice Classification, in conjunction with the commercial perspective, prevails over the dictionary definition.

Once the relevant factors have been identified, the examiner must determine the relation between and the weight attributed to the relevant factors (see paragraph 3.3).

3.2 The specific similarity factors

The following paragraphs define and illustrate the various factors for similarity of goods and services.

3.2.1 Nature

The nature of a product/service can be defined as the essential qualities or characteristics by which this product/service is recognised. Nature often corresponds to the particular type or sort of product/service or the specific category to which this product/service belongs and which is usually used to define it. In other words, it is the answer to the question ‘What is it?’

Examples

- *Yoghurt* is a milk product;
- *Car* is a vehicle;
- *Body lotion* is a cosmetic product.

3.2.1.1 Indicative value of class headings and categories

The fact that goods/services to be compared fall under the same general indication of a class heading or broad category does not automatically mean that they are of the same nature. An example of such a broad category is *foodstuffs for human consumption*.

Examples

- *Fresh fruit* (Class 31) on the one hand and *coffee, flour, and bread* (Class 30) on the other hand are of a different nature despite being foodstuffs.
- *Meat, fish, poultry and game* (Class 29) are foodstuffs of animal origin. *Fruits and vegetables* (Class 31) are foodstuffs of plant origin. This slight connection, namely all being foodstuffs, does not preclude that their nature is different.

The fact that goods/services to be compared fall under a sufficiently narrow general indication of a class heading favours an identical or similar nature.

Example

- *Condensed milk* and *cheese* (both in Class 29) share the same nature because they belong to the same product category, namely milk products, which are a subcategory of foodstuffs.⁵⁸

3.2.1.2 Features of the goods defining their nature

A variety of features of the goods in question may be useful for defining their nature. These include the following:

Composition: for example, ingredients, materials of which the goods are made.

Example

- *Yoghurt* (Class 29) is a milk product (the nature of yoghurt may be defined by its basic ingredient).

⁵⁸ 4/11/2003, T-85/02, Castillo, EU:T:2003:288, § 33

Composition may be the most relevant criterion for defining nature. However, an identical or similar composition of the goods is not per se an indicator of the same nature.

Example

- A *chair* (Class 20) and a *doll* (Class 28) can both be made of plastic, but they are not of the same nature since one is a piece of furniture and the other is a toy. They belong to different categories.

Functioning principle: for example, mechanical functioning, with or without engine/ motor; optical, electrical, biological, or chemical functioning.

Example

- *Telescope* (Class 9) is an optical device (the nature of a telescope may be defined by its functioning principle, which is optical).

Although the functioning principle may help to define the nature of some goods, it is not always conclusive. There are cases where goods, in particular technology-related ones, with the same functioning principle are of a different nature.

Example

- A *blender* and an *electric toothbrush* have the same functioning principle of rotation, but they are not of the same nature.

In contrast, there are goods with different functioning principles but the same nature.

Example

- The functioning principle of *washing machines using washing powder* is chemical, which is not the same as the functioning principle of *washing machines using magnetic waves*. However, these goods are of the same nature as they are both washing machines.

Physical condition: for example, liquid/solid, hard/soft, flexible/rigid.

The physical condition is another feature of the goods that may be used to define nature but, like the functioning principle, it is not conclusive.

Examples

- All drinks are liquid. Their nature is different from the nature of solid foodstuffs. When comparing two different drinks, their physical condition should not be conclusive: *milk* (Class 29) is not of the same nature as an *alcoholic beverage* (Class 33).
- *Yoghurt* is marketed both in solid and liquid form. However, the nature of this good is not defined by its physical condition, but — as mentioned above — by its basic ingredient (milk). In both cases, the nature of a solid yogurt and of a liquid yogurt is the same (a milk product).

3.2.1.3 Nature of services

When defining the nature of services, the composition of features, functioning principle and physical condition cannot be used since services are intangible.

The nature of services can be defined, in particular, by the kind of activity provided to third parties. In most cases, it is the category under which the service falls that defines its nature.

Example

- *Taxi services* (Class 39) have the same nature as *bus services* (Class 39) as they are both transport services.

3.2.1.4 Nature of goods versus nature of services

By their **nature**, goods are generally dissimilar to services. This is because goods are articles of trade, wares or merchandise. Their sale usually entails the transfer in title of something physical. Services, however, consist of the provision of intangible activities.

3.2.2 Intended purpose

'Purpose' is generally defined as 'the reason for which something is done or made, or for which it exists'.

As a Canon factor⁵⁹, purpose means the intended use of the goods/services and not any other possible use.

Example

- A *plastic bag* can be used as protection against the rain. However, its intended purpose is to carry items.

The purpose is defined by the function of the goods/services. In other words, it answers the questions: What need do these goods/services satisfy? What problem do they solve?

It is sometimes difficult to determine the proper level of abstraction in order to determine the purpose. As in the case of defining the nature, the purpose must be defined in a sufficiently narrow way.

Example

- In the case of *vinegar*, the intended purpose should not be defined as 'human consumption', which is the general purpose that all foodstuffs share, but as 'everyday seasoning'.

3.2.3 Method of use

The method of use determines the way in which the goods/services are used to achieve their purpose.

The question to be asked is: How are these goods/services used?

Method of use often follows directly from the nature and/or intended purpose of the goods/services and therefore has little or no significance of its own in the similarity analysis.

Example

- The method of use of *newspapers* and *books* is the same in the sense that they are both read. However, similarity can already be concluded from the facts that they are both printed matter (same nature) and that they both serve to entertain or to inform (same purpose).

Notwithstanding the explanation above, the method of use may be important, independent of nature and purpose, where it characterises the goods.

Example

- *Pharmaceutical preparations for treating skin diseases* in Class 5 can take the form of creams. They have the same method of use as *cosmetic creams* in Class 3.

⁵⁹ 29/09/1998, C-39/97, Canon, EU:C:1998:442

However, even where the method of use characterises the goods under comparison and where it is identical for both goods, this fact alone will not be sufficient to establish similarity.

Example

• *Chewing gum* (Class 30) and *chewing tobacco* (Class 34) have an identical method of use. However, this fact alone does not make them similar.

3.2.4 Complementarity

Goods (or services) are complementary if there is a close connection between them, in the sense that one is indispensable (essential) or important (significant) for the use of the other in such a way that consumers may think that responsibility for the production of those goods or provision of those services lies with the same undertaking.⁶⁰

3.2.4.1 Connection (link) between goods/services

The connection between the goods/services must be established with sufficient certainty. When the connection between the goods/services is not close enough for each to be indispensable (essential) or important (significant) for the use of the other, no complementarity can be found.

When assessing whether or not the consumer would usually expect there to be a link between the goods/services, it is appropriate to take into account the economic reality on the market as it currently exists.

A **functional link** between goods/services will usually be a strong indication of complementarity: for instance when one product or service is required for the proper functioning of the other, one enables the use of the other, or one cannot be used without the other.

In the following cases there is complementarity between the goods under comparison.

Examples

• *Software, in particular for casino and amusement arcade games* in Class 9 is essential for the functioning of *games* (such as electronic or online games of chance) in Class 28 and there is complementarity between the goods.⁶¹

• The sole purpose of *cord and cable management devices* (such as holders and clips for containing and organising audio and video cables) in Class 9 is for them to be used with *electric wires and cables* (such as AV cables) in Class 9, as the former are used for holding and organising the latter. It follows that there is an undeniable link of complementarity between them.⁶²

• *Applicators for hair lotions* (Class 21) complement *hair lotions* (Class 3) and are used for applying the latter properly.⁶³

There may also be a link between a certain product on the one hand, and its parts, components and fittings on the other. There is therefore complementarity when the respective part/component/fitting is sold independently and is required for proper use of the final product

⁶⁰ 11/05/2011, T-74/10, Flaco, EU:T:2011:207, § 40; 21/11/2012, T-558/11, Artis, EU:T:2012:615, § 25; 04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 44

⁶¹ 19/04/2016, T-326/14, HOT JOKER / JOKER et al., EU:T:2016:221, § 54

⁶² 24/04/2018, T-831/16, ZOOM / ZOOM et al., EU:T:2018:218, § 81-82

⁶³ 16/12/2015, T-356/14, Kerashot / K KERASOL, EU:T:2015:978, § 37

and/or when the part/component/fitting cannot serve its intended purpose if it is not included in the final product. In the following examples the goods are considered complementary.

Examples

- *electric toothbrushes* (Class 21) and *replacement brush heads* (Class 21).
- *power saws* (Class 7) and *saw blades* (Class 7).
- *lighting apparatus* (Class 11) and *lighting fittings* (Class 11).

Principles applicable to the comparison of various kinds of goods/services among themselves also apply to the comparison between goods on the one hand and services on the other. Moreover, there may be similarity based on complementarity between goods on the one hand and services that cover identical goods on the other.⁶⁴

In the following cases there is complementarity between the goods and services under comparison.

Examples

- *Installation, repair and maintenance of water based heating systems* in Class 37 ensure the proper functioning of *heating installations* in Class 11 (such as water-based heating installations); there is complementarity between them.
- *Design and development of computer hardware and software* in Class 42 are important for the functioning of *computers*; *portable communication devices* in Class 9; there is complementarity between them.
- There is complementarity between, on the one hand, *soaps, perfumery, essential oils, cosmetics, hair lotions* in Class 3 and, on the other, *spas, Turkish baths, sauna services, health spa services* in Class 44. Treatments in spas, Turkish baths and health spas are usually followed by the application of body lotions and moisturising creams, and the public may expect to be treated with these products in such establishments. In that case, the goods in Class 3 are important for proper use of the services in Class 44.
- In the comparison of *retail services in stores of all kinds of foodstuffs, especially patisserie and confectionery* contained in Class 35, with various kinds of foodstuffs falling within Classes 29, 30 and 31, the retail services relate to a relatively broad category of goods that includes the goods covered by the other mark. Consequently, the retail services and the goods covered by the other mark were found to be complementary.⁶⁵ In this case the services in Class 35 are important for providing consumers with the goods in Classes 29, 30 and 31.
- *Medical services* in Class 44 are important, even indispensable, for the use of *pharmaceutical products* in Class 5. Similarly, administering pharmaceutical products is important, even indispensable, in providing the services in question. There is a complementarity between these goods and services.

3.2.4.2 Additional factors for establishing a link between goods and services

There is complementarity between goods and services only when the consumers of the goods and services concerned may think that the same undertaking is responsible for producing those goods or providing those services. In that sense, the relevant public and usual commercial origin of the goods and services are important factors for establishing complementarity.

The relevant public

⁶⁴ 24/09/2008, T-116/06, O Store, EU:T:2008:399, § 54-56, 07/09/2016, T-204/14, VICTOR / VICTORIA et al., EU:T:2016:448, § 108-111

⁶⁵ 05/05/2015, T-715/13, Castello (fig.) / Castelló y Juan S.A. (fig.) et al., EU:T:2015:256, § 29-31

By definition, complementary goods or services must be capable of being used together, so that goods and services directed at different publics cannot be complementary.

Examples

- *Textile products* in Class 24 (aimed at the public at large) and *treatment services relating to textile products* in Class 40 (aimed at professionals) cannot be complementary. These goods and services are not similar.
- The relevant public of plastic or synthetic products used as raw or semi-finished material (e.g. *synthetic resin plastics* in Class 1 and *plastics in extruded form* in Class 17) consists of moulders and converters, whereas the finished products (e.g. *vehicles* made in Class 12) are directed at the general public. The goods at issue are not complementary. There is no similarity between them.

There will be no complementarity between a certain product on the one hand, and its parts, components or fittings on the other, when the goods in comparison do not target the same public (e.g. the component is meant for the manufacturer, but not for the consumer of the final product) and when the parts, components or fittings are not usually sold independently as replacement parts of the final product. Therefore, in the following examples, even though the parts or components are indispensable or important for the proper functioning of the final product, there is no complementarity between the goods in comparison.

Examples

- *fan blades* (Class 7) and *hair dryer* (Class 11).
- *electric cable* (Class 9) and *lamp* (Class 11).
- *balls for ball-point pens* (Class 16) and *ball-point pens* (Class 16).

The origin of the goods/services

Goods/services that are complementary usually share the same commercial origin or give consumers some cause to believe that the same undertaking is responsible for both producing the goods and providing the services.

Examples

- *Skis* (Class 28) and *ski boots* (Class 25) are complementary because the use of one is indispensable for the use of the other. The relevant public may think that the production of these goods lies with the same undertaking. In addition, they share the same public and distribution channels. These goods are consequently considered similar.
- *Teaching materials* in Classes 9 and 16 (such as printed matter, pre-recorded data carriers and audio/video cassettes) are essential and thus complementary to *educational courses* in Class 41. Generally the materials are issued by the same undertaking, and share the same public and distribution channels. These goods are similar to the services in question.
- *Services of an architect (designing of buildings)* (Class 42) are indispensable for *building construction* (Class 37). These services are often offered together through the same distribution channels, by the same providers and to the same public. Consequently, these services are complementary and similar.⁶⁶

Conversely, there is no complementarity between goods/services that are not expected to share the same commercial origin.

Example

- There is no complementarity between financial and banking services (Class 36) on the one hand and real estate services (Class 36) on the other hand. Banking services may play a significant role in the purchase of a property, but it cannot be inferred from that alone that

⁶⁶ 09/04/2014, T-144/12, Comsa / COMSA S.A., EU:T:2014:197, § 65-67

consumers would be led to believe that the same undertaking was responsible for real estate services. To conclude otherwise would imply that any non-financial procedure that depends on the provision of financing is complementary to a financial service. Furthermore, the services do not have the same nature, the same intended purpose or the same method of use, and they are not provided on the same premises. Consequently, these services are not similar..⁶⁷

3.2.4.3 Types of interrelation between goods/services where complementarity is usually not found

In the following cases there is not usually any complementarity between the goods/ services, as neither is indispensable or important for the use of the other, and any joint use of them is a question of convenience or of consumer habits or preferences.

Use in combination

Complementarity has to be clearly distinguished from **use in combination** where goods/services are merely used together, whether by choice or convenience, but can be used also without the other or with different goods (e.g. bread and butter). Where their use together is merely optional and not indispensable or important, the necessary close link is missing.⁶⁸ In such cases similarity can be found on the basis only of other factors, not complementarity.

Example

- Although *confectionery, candy, biscuits, wafer rolls, pastries, crisps or bread* in Class 30 may be accompanied by beverages in Classes 29, 30 or 32, their use is neither indispensable nor important for the consumption of *dairy-based, coffee, coffee-based beverages or beer* or vice versa, even if the relevant public would be likely to consume them together. Consequently, there is no close connection between those goods and they cannot be considered complementary.
- Even if the functioning of *transmission belts* in Class 12 can be measured with the help of a *device for motor-vehicle testing* in Class 9, this does not mean that the goods are complementary. It can be convenient in certain cases to measure the performance of one or the other parameter but simple convenience is not sufficient to conclude that one product is indispensable for the other.⁶⁹

Aesthetic complementarity

It cannot be excluded that in some sectors, such as the fashion and body and facial care sectors, goods whose nature, purpose and/or method of use are different, apart from being functionally complementary, may be considered 'aesthetically complementary' in the eyes of the relevant public⁷⁰. The General Court defines 'aesthetic complementarity' as a connection between the products that 'must involve a true aesthetic necessity, in the sense that one product is indispensable or important for the use of the other and consumers consider it ordinary and natural to use those products'⁷¹. Therefore, the following elements have to be considered.

- The connection between the goods is subjective. Their aesthetically complementary nature is determined by the habits and preferences of consumers, to which producers' marketing strategies or even simple fashion trends may give rise.⁷²
- Aesthetic complementarity may apply when the goods in question have a common aesthetic function by jointly contributing to, for example, the external image of the consumer concerned,

⁶⁷ 17/09/2015, T-323/14, Bankia / BANKY, EU:T:2015:642, § 35, 37-38

⁶⁸ 28/10/2015, T-736/14, MoMo Monsters / MONSTER et al., EU:T:2015:809, § 29

⁶⁹ 03/10/2013, R 1011/2012-4, SUN (fig.) / SUN (fig.) et al., § 39

⁷⁰ 11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 35

⁷¹ together' (11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 36; 20/10/2011, T-214/09, Cor II, EU:T:2011:612, § 32; 25/09/2018, T-435/17, HIPANEMA (fig.) / Ipanema (fig.) et al., EU:T:2018:596, § 53

⁷² 27/09/2012, T-357/09, Emidio Tucci, EU:T:2012:499, § 51; 12/02/2015, T-505/12, B, EU:T:2015:95, § 59; 25/09/2018, T-435/17, HIPANEMA (fig.) / Ipanema (fig.) et al., EU:T:2018:596, § 53

and the relevant public considers it ordinary and natural to use the goods together. Aesthetic complementarity between certain goods can be found when it is common customer behaviour to aesthetically coordinate the goods concerned, even though how the goods are combined is ruled by preferences (as the products could serve their intended purpose independently from one another).

Examples

- *Handbags* in Class 18, on one hand and *clothing and footwear* in Class 25, on the other hand, share a common aesthetic function by jointly contributing to the consumer's 'look'. Any such coordination depends on the consumer concerned, the type of activity for which that look is put together, in particular for work, sport or leisure, or the marketing strategies of the businesses in the sector. It is, however, common customer behaviour to aesthetically combine these goods when purchasing them, and their aesthetic coordination may also be considered at the design stage.
- *Carpets* in Class 27 and *furniture* in Class 20 are used in home decoration and have a common aesthetic function that leads consumers, as a general rule, to use them together and to match them with each other, so as to create a harmonious atmosphere.⁷³

Even when acknowledged, the mere existence of 'aesthetic complementarity' between the goods is not sufficient on its own to conclude that there is similarity between them.⁷⁴ For similarity to be found, consumers must consider it usual for the goods to be sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same.

Ancillary goods

When certain goods/services only support or supplement another product or service, they are not considered to be complementary within the meaning of the case-law. **Ancillary goods** are typically those used for packaging (e.g. bottles, boxes, cans) or for promotion (e.g. leaflets, posters, price lists). Equally, goods/services offered for free in the course of a merchandising campaign are usually not similar to the primary product or service.

Examples

- *Organisation and conducting of exhibitions* (Class 41) is not similar to *printed matter, including event notes* (Class 16), since the goods merely serve to promote and announce the specific event. These goods and services are not complementary.
- *Herbal nutritional supplements* in Class 5 are not indispensable or important for the use of *beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages* in Class 32. Any combined consumption of those products is merely ancillary. Therefore, these goods are not complementary. Furthermore, since their purpose, distribution channels and usual producers are different, and they are not in competition, these goods are not similar.⁷⁵

Lastly, complementarity applies only to the use of goods, not to their production process. Goods cannot be regarded as complementary on the ground that one is used to manufacture the other. Even when one product is used to manufacture another, this does not mean that the relevant public will assume they are offered by the same undertaking. A thorough case-by-case assessment has to be carried out.

⁷³ 20/10/2011, [T-214/09](#), Cor II, EU:T:2011:612, § 33

⁷⁴ 27/09/2012, [T-39/10](#), Pucci, EU:T:2012:502, § 75

⁷⁵ 23/01/2014, T-221/12, Sun fresh, EU:T:2014:25, § 84

3.2.5 In competition

Goods/services are in competition with each other when one can substitute the other. That means that they serve the same or a similar purpose and are offered to the same actual and potential customers. In such a case, the goods/services are also defined as 'interchangeable.'⁷⁶

Examples

- *Wallpaper* (Class 27) and *paints* (Class 2) are in competition because both cover or decorate walls.
- *Rental of movies* (Class 41) and *services of a cinema* (Class 41) are in competition because they both allow you to watch a film.
- *Electric shavers* and *razor blades* (both in Class 8) are in competition because they serve the same purpose.

In some cases the price of goods/services in competition may differ significantly, but this fact alone does not affect the analysis of whether they are in competition with each other or not.

Example

- *Jewellery made of gold* and *fashion jewellery* (both in Class 14) are in competition even though their price (and value) may greatly differ.

3.2.6 Distribution channel

Although 'distribution channel' is not explicitly mentioned in the *Canon* judgment, it is widely used internationally and nationally in the assessment of whether two goods/ services are similar. It has been taken into account as an additional factor.

If the goods/services are made available through the same distribution channels, the consumer may be more likely to assume that the goods/services are in the same market sector and are possibly manufactured by the same entity and vice versa.

The term 'distribution channel' does not refer so much to the way of selling or promoting a company's product as to the place of distribution. For the analysis of the similarity of goods/services, the distribution system — whether direct or indirect — is not decisive. The question to be asked is rather: do the goods/services have the same points of sale, or are they usually provided or offered at the same or similar places?

However, too much emphasis should not be placed on this factor as modern supermarkets, drugstores and department stores sell goods of all kinds. The relevant public is aware that the goods sold in these places come from a multitude of independent undertakings. Therefore, the point of sale is less decisive when deciding whether the relevant public considers that goods share a common origin merely because they are sold at the same outlet.

Only where the goods in question are offered in the same **section** of such shops, where homogeneous goods are sold together, will this favour similarity. In such cases it must be possible to identify the section by its territorial and functional separation from other sections (e.g. dairy section of a supermarket, the cosmetics section of a department store).

Similarly, this factor may apply in cases in which goods are sold exclusively or commonly in specialised shops. In that event, consumers may tend to believe the origin of the goods to be the same if they are both sold in the same specialised shops and may tend to deny that mutual origin if they are not usually sold in the same shops.

⁷⁶ 04/02/2013, T-504/11, Dignitude, EU:T:2013:57, § 42

Conversely, different sales outlets may weigh against the similarity of goods.

Example

- *Wheelchairs* versus *bicycles*.

Although both fall under *vehicles* in Class 12, they will not be found at the same outlets. Bicycles are usually sold either in specialist bicycle stores or in a retail store where sporting equipment is available. By contrast, the distribution channels for *wheelchairs* are the specialised distributors of medical equipment and devices that supply hospitals, and specialised shops where devices for disabled or physically handicapped people are sold.

3.2.7 Relevant public

The relevant public, such as the actual and potential customers of the goods and services in dispute, constitutes another factor to be dealt with in the analysis of similarity (see the Guidelines, Part B, Examination, Section 5, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention).

The relevant public can be composed of:

- the general public (public at large) or
- a professional public (business customers or specialised public).

The relevant public does not necessarily mean the end user; for instance, the end users of *food for animals* in Class 31 are animals, not the relevant public. The relevant public in this case would be the general consumer.

The mere fact that the potential customers coincide does not automatically constitute an indication of similarity. The same group of customers may be in need of goods/ services of the most diverse origin and nature. The fact that, for example, television sets, cars and books are bought by the same relevant public, namely the public at large, has no impact on the analysis of similarity. In many cases, either one or both lists of goods/services under comparison target the public at large, but the purpose (of covering customers' needs) is different in each case. Such circumstances weigh against similarity.

While a coincidence in the relevant public is not necessarily an indication of similarity, largely diverging publics weigh heavily against similarity.

Diverging customers can be found in the following cases, where:

1. The goods/services of both lists are directed at the public at large, who can, however, be clearly categorised by their different (personal) needs, ages, etc.

Example: *wheelchairs* versus *bicycles* (Class 12).

2. The goods/services of both lists target business customers, who may, however, be acting in a very different market sector.

Example: *chemicals used in forestry* versus *solvents for the lacquer industry* (Class 1).

3. One relevant public consists of general consumers and the other of business customers.

Example: *containers for contact lenses* (in Class 9) versus *surgical apparatus and instruments* (in Class 10).

3.2.8 Usual origin (producer/provider)

Usual origin of the goods and services is of particular importance for the analysis of similarity. As the Court of Justice has stated, it is 'the risk that the public might believe that the goods/

services in question come from the same undertaking or, as the case may be, from economically linked undertakings, [that] constitutes a likelihood of confusion'.⁷⁷ Hence, there is a strong indication of similarity when, in the mind of the relevant public, the goods/services have the same usual origin.

However, this should not be misinterpreted as turning the examination of likelihood of confusion and similarity of goods/services upside down: the finding of a likelihood of confusion depends on many other factors (such as the similarity of signs and the distinctiveness of the earlier mark) and is not exclusively determined by the usual origin, which as such is only one factor in the analysis of the similarity of goods/ services.

A finding that consumers will not be confused about the origin of the goods/services is not an argument appropriate to the comparison of goods/services. This finding should be mentioned in the overall assessment of likelihood of confusion. Origin, in this context, relates mainly to the manufacturing sector (industry) or kind of undertaking producing the goods or offering the services in question rather than to the identity of the producer.

The 'origin' is not merely defined by the actual place of production/provision (e.g. factory, workshop, institute or laboratory) but primarily by taking into consideration who manages and/or controls the production/provision of the goods/services. In other words, the question to be asked is: who is responsible for manufacturing the product or providing the service?

The geographical origin (e.g. China) is not relevant for the finding of similarity of goods/services.

Even goods and services can have the same origin if it is common for the same type of company to produce/provide both. *Educational textbooks* (Class 16) were considered to have the same origin as *provision of correspondence courses* (Class 41) since 'undertakings offering any kind of course often hand out those products to pupils as support learning materials'.⁷⁸

The criterion 'usual origin' has to be applied in a restrictive way in order not to dilute it. If all kinds of goods/services deriving from one large (multinational) company or holding were found to have the same origin, this factor would lose its significance.

The relevant public will perceive different goods as having a common commercial source only where a large part of the producers or distributors of the products in question are the same.

Different categories of goods which, as a general rule, are produced by separate, specialist undertakings cannot be considered to have a common commercial source simply because they may be offered by very well-known brands, since those cases are marginal. The mere fact that **some** manufacturers produce two different categories of goods is not sufficient to demonstrate that a large part of the manufacturers or distributors of those goods are the same.

Example

- *Cosmetics* (Class 3) and *foodstuffs* (Classes 29 to 31) may be produced under the umbrella of one company but this does not reflect common trade customs, according to which these types of goods have different producers, each belonging to a specific industry.

⁷⁷ 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29

⁷⁸ 23/10/2002, T-388/00, ELS, EU:T:2002:260, § 55

3.2.8.1 Features defining a common usual origin

When determining the usual origin of a product/service the following features might be relevant.

Manufacturing sites

Example

- *Varnishes, lacquers, colorants and mordants* (Class 2) are typically produced by the same production enterprises, normally specialised chemical companies.

The place of production can be a strong indicator that the goods/services in question come from the same source. However, while the same manufacturing sites suggest a common usual origin, different manufacturing sites do not exclude that the goods come from the same or economically linked undertakings. For instance, *books* (Class 16) and *electronic media* (Class 9) (goods in competition, with e-media substituting books) are both goods of a publishing house.

Methods of manufacture

Example

- *Leather belts* (Class 25) and *leather handbags* (Class 18) are not only manufactured in the same sites, for example, leather workshops, but are also manufactured using the same tools and machines for the treatment of leather.

(Technical) know-how

Example

- *Computer virus protection services* (Class 42) and *software design* (Class 42) involve similar technical know-how in the field of information technology.

Established trade custom known to the public

An established trade custom, such as when manufacturers expand their businesses to adjacent markets, is of particular importance for concluding whether goods/services of different nature have the same origin. In such situations, it is necessary to determine whether such expansion is common in the industry or, conversely, whether it may occur in exceptional cases only.

Example where extension has become customary

- *Shoes* (Class 25) and *handbags* (Class 18): it is customary in the market for the producers of shoes also to be involved in the manufacture of handbags.

Example where extension is not (yet) common

- *Clothing* (Class 25) and *perfumes* (Class 3): even though some designers that make fashion clothes nowadays also sell perfumes under their marks, this is not the rule in the clothing industry, and rather applies only to (economically) successful designers.

- *Clothing and footwear* (Class 25) and *watches and jewellery* (Class 14) may be manufactured by certain commercially successful fashion designers, but this is, to date, marginal in the overall assessment of the market sector under consideration. There are significant differences in the nature of these goods, their manufacturing processes and the know-how required for the creation of a quality product in each of the branches in question. Even if successful fashion designers attempt to exploit their success by affixing their trade marks to a wide range of goods, that will not influence the expectations of consumers outside of the luxury sector who will not normally expect that the same undertaking would be

responsible for the manufacture of the different goods at issue, which are not at first sight related and do not, in addition, fall within the same family of goods. Hence, those consumers will not deduce that these goods constitute an extended range of goods which come from the same source.

3.3 Relation between different factors

The Canon criteria⁷⁹ were enumerated in the corresponding judgment without any indication of relationship or hierarchy (weight) among them. They were considered one by one. However, they cannot be considered independently since some criteria are interrelated and some criteria are more important than others, regardless of whether goods are being compared with goods, services with services or goods with services. As a result of weighing all these factors in accordance with their respective importance in relation to the goods/services at issue, similarity may be found to various degrees: low, average or high (see paragraph 3.3.4).

3.3.1 Interrelation of factors

In many cases there will be relationships between the factors in the sense that where one is shared, another one might coincide as well.

Examples

- Based on the purpose, it is also possible to determine who the actual and potential customers (i.e. the relevant public) are.
- The purpose, together with the relevant public, may also reveal whether goods/services are in competition.
- The same distribution channel goes hand in hand with the same public. In other words, where the distribution channels are different, the public may be different as well.
- Goods/services intended for different publics cannot be complementary.
- The method of use usually depends on the nature and purpose of the goods.

There are cases in which it is difficult to make a distinction between various factors. This is particularly true as far as 'nature', 'purpose' and 'method of use' are concerned. Where the examiner encounters such difficulties, it is sufficient to treat these factors jointly.

Example

- An *engine* is a machine for converting any of various forms of energy into mechanical force and motion. In such a case, it is difficult to distinguish the nature from the purpose of the product. Therefore, in this case, no distinction between what is nature and what is purpose is necessary.

3.3.2 Importance of each factor

In assessing the similarity of goods and services, all relevant factors characterising the relationship between them should be taken into account. However, depending on the kind of goods and services, a particular criterion may be more or less important. In other words, the various criteria do not have a standard value; rather, their specific importance should be determined in the context of each individual case.

In general, the weight of each factor will depend on the impact it has on possible confusion regarding origin. Criteria clearly suggesting that the goods/services come or do not come from the same undertaking or economically linked undertakings should take precedence.

Generally strong factors

⁷⁹ 29/09/1998, C-39/97, Canon, EU:C:1998:442

- Usual origin (because it has a strong impact on likelihood of confusion, which relates to common commercial origin).
- Purpose (because it is decisive for the choice made by the customer buying or selecting goods/services).
- Nature (because it defines the essential qualities and characteristics of the goods/services).
- Complementarity (because the close connection between the use of the goods/services makes the public believe that they share the same source).
- In competition (usually goods/services that are in competition have the same purpose and target the same public).

Less important factors

- Method of use (even dissimilar goods can be used in the same manner, e.g. baby carriages and shopping trolleys).
- Distribution channels (even dissimilar goods can be sold in the same section of stores depending on different display practices, e.g. chewing gum (Class 30) and cigarettes (Class 34)).
- Relevant public.

3.3.3 Different types of comparisons: goods versus goods, services versus services and goods versus services

In principle, the same factors for comparing goods with goods are relevant for the comparison of services with services. However, in applying these factors, the basic difference between goods and services (tangible versus intangible) must be considered.

Furthermore, the same principles that apply for the comparison between goods and goods and between services and services also apply in cases where goods are compared with services.

By their nature, goods are generally dissimilar to services. They can, however, be complementary. Services can also have the same purpose and thus be in competition with goods. It follows that under certain circumstances similarity between goods and services can be found.

3.3.4 Degree of similarity

Goods/services can be found similar to different degrees (low, average or high), depending on how many factors they share and the weight given to each of them. The degree of similarity found between the goods and services is of relevance when making a final decision on the likelihood of confusion.

Generally, one factor on its own is not sufficient for finding similarity between the goods/services, even if it is a strong factor.

Examples of dissimilarity

- *Cars* and *bicycles* (both in Class 12) share the same purpose (taking oneself from A to B), but this does not make them similar.
- Although *window glass* (Class 19) and *glasses for spectacles* (Class 9) have the same nature, they are not similar, since they do not coincide in other relevant factors, such as purpose, producers, distribution channels and relevant public.

It is the combination of various factors and their weight that allows the final conclusion on similarity. The combination of two strong factors, such as nature and producer, or the combination of one strong and two weak factors will often lead to similarity. In contrast, the combination of two weak factors, such as distribution channel and relevant public are, in principle, not conclusive for a finding of similarity between the goods and services.

Examples of similarity

- *Milk* and *cheese* (both in Class 29) have a different purpose and method of use; they are not in competition or complementary. However, the fact that they share the same nature (dairy goods) and usual origin (dairy company) is decisive for a finding of similarity.
- Although *pharmaceuticals* and *plasters* (both in Class 5) have a different nature, they share a similar purpose: treating diseases, disabilities or injuries. Furthermore, they have the same distribution channels and relevant public. Therefore, they are similar.

The number of coinciding factors found, together with their importance/weight, establishes the degree of similarity. Generally speaking, the higher the number of common factors, the higher the degree of similarity. A similarity found on the basis of only two factors would normally not be high, unlike in cases where the goods/services coincide in four or more relevant factors.

However, no mathematical analysis is possible since it always depends on the specific circumstances of each case.

4 Annex I: Specific Questions on the Similarity of Goods and Services

This part does not establish any new criteria for finding similarity between goods and services. It merely helps to clarify how to compare specific groups of goods and services for which, apart from the Canon criteria, some general rules and exceptions apply.

4.1 Parts, Components and Fittings

The mere fact that a certain product can be composed of several components does not automatically establish similarity between the finished product and its parts (27/10/2005, T-336/03, Mobilix, EU:T:2005:379, § 61).

Examples of dissimilarity

- *Fan blades* (Class 7) and *hair dryer* (Class 11)
- *Electric cable* (Class 9) and *lamp* (Class 11)
- *Balls for ball-point pens* (Class 16) and *ball-point pens* (Class 16)
- *Buttons* (Class 26) and *clothing* (Class 25).

Similarity will be found where at least some of the main factors for finding similarity (such as producer, public and/or complementarity) are present, taking into account the relationship between the factors and the importance of each factor for assessing similarity (see paragraph 3.3).

Such similarity is based on the fact that parts and fittings are often produced and/or sold by the same undertaking that manufactures the end product and target the same purchasing public, as in the case of spare or replacement parts which are also sold independently of the final product. Furthermore, there is complementarity between the goods in question when the respective part/component/fitting is required for proper use of the final product and/or when the part/component/fitting cannot serve its intended purpose if it is not included in the final product. In that case, the public may also expect part/component/fitting to be produced by, or under the control of, the 'original' manufacturer, which would also suggest that the goods were similar.

Examples of similarity

- *Electric toothbrush* (Class 21) and *replacement brush heads* (Class 21)
- *Printer* (Class 9) and *ink jet cartridges* (Class 2)
- *Sewing machines* (Class 7) and *walking feet for sewing machines* (Class 7).

4.2 Raw Materials and Semi-Processed Goods

In most cases, the mere fact that one product is used for the manufacture of another will not be sufficient in itself to show that the goods are similar, as their nature, purpose, relevant public and distribution channels may be quite distinct. The raw materials subjected to a transformation process are essentially different from the finished products that incorporate, or are covered by, those raw materials, in terms of nature, aim and intended purpose.

Furthermore, they are not complementary on the ground that one is manufactured with the other, and raw material is in general intended for use in industry rather than for direct purchase by the final consumer. In that regard, *plastic or synthetic products used as raw or semi-finished material* (in Classes 1 and 17) cannot be regarded as complementary to *finished products* (made from these materials in Classes 9 and 12) on the ground that the raw materials are intended to be turned into finished products.

Examples of dissimilarity

- *Leather, animal skins* (Class 18) and *clothing* (Class 25)
- *Precious metals* (Class 14) and *jewellery* (Class 14).

However, the final conclusion may depend on the specific circumstances of the case, such as the degree of transformation of the raw material and whether it can be obtained separately from the end product through the same distribution channels.

Examples of similarity

- *Precious stones* (Class 14) and *jewellery* (Class 14). Contrary to *precious metals*, *precious stones* can be obtained in jewellery shops independently of the end product.

See also Annex II, paragraph 5.5.1, 'Ingredients of prepared food'.

4.3 Accessories

'Accessories' with no further qualification is an unclear or imprecise term as described in paragraph 1.5.2 'The relevant scope', and should be treated accordingly.

An accessory is something extra that improves or completes the main product it is added to, and usually fulfils a decorative purpose. Unlike parts, components and fittings, an accessory, while usually used in close connection with the main product, does not constitute an integral part of it.

The mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity (see, for example, 'aesthetic complementarity', paragraph 3.2.4).

Examples of dissimilarity

- *Clothing* (Class 25) and *hair ornaments* (Class 26)

However, it is common for some accessories also to be produced by the manufacturer of the main product. Consequently the consumer may expect the main product and accessories to be produced under the control of the same entity, especially when they are distributed through the same channels of trade. In such cases, there is a strong indication of similarity.

Examples of similarity

- *Bicycles* (Class 12) and *panniers for bicycles* (Class 12)
- *Glasses* (Class 9) and *cases for glasses* (Class 9).

4.4 Installation, Maintenance and Repair Services

These services belong to the category of goods-related services.

Since, by nature, goods and services are dissimilar, similarity between goods and their installation, maintenance and repair can only be established when:

- it is common in the relevant market sector for the manufacturer of the goods to also provide such services; and
- the relevant public coincides; and
- installation, maintenance and repair of these goods are provided independently of the purchase of the goods (not aftersales services).

The installation of virtually all goods is classified in Class 37, such as *installation of air conditioning apparatus, consumer electric appliances, elevators or lifts, fire alarms, freezing machines, kitchen appliances*. The *installation and repair of computer hardware* is also in Class 37, as it is a physical repair and installation activity. However, *installation and repair of computer software* is classified in Class 42 because it involves computer programming without any physical installation or repair.

Examples of similarity

- Data processing equipment and computers (Class 9) and installation and repair of computer hardware (Class 37)
- Air conditioning apparatus (Class 11) and installation, maintenance and repair of air conditioning apparatus (Class 37)
- Machinery for working metal (Class 7) and maintenance of machinery (Class 37)

Examples of dissimilarity

- Building materials (Class 19) and installation of building insulation (Class 37)
- Shoes (Class 25) and repair of shoes (Class 37)
- Vehicles (Class 12) and dent removal for motor vehicles (Class 37).

4.5 Advisory, Consultancy and Information Services

Advisory services refer to providing advice that is tailored to the circumstances or needs of a particular user and that recommends specific courses of action for the user. *Provision of information*, however, refers to providing a user with materials (general or specific) about a matter or service but not advising the user on specific courses of action. With the 8th edition of the Nice Classification, *professional consultation services* in Class 42 were eliminated. Since then consultation services — as well as *advisory and information services* — have been classified in the class of the service that corresponds to the subject matter of the consultation. For instance, *transportation consultancy* belongs to Class 39, *business management consultancy* falls under Class 35, *financial consultancy* is classified in Class 36 and *beauty consultancy* in Class 44. The rendering of the advice, information or consultancy by electronic means (e.g. telephone, computer) does not affect the classification of these services.

Advisory, consultancy and information services are covered by the services to which they relate, insofar as they are an inherent part thereof.

However, if the advisory, consultancy or information services are not provided by the same undertaking, they may only be similar if they are complementary and target the same public through the same channels of distribution, and may even be dissimilar if they do not share any relevant factors.

Examples

- Financial information services (Class 36) are included in *financial affairs* (Class 36) and are thus identical.

- Computer software advisory services (Class 42) are similar to the installation and maintenance of software (Class 42) because, although they may not necessarily be included in installation and maintenance of software, they are often complementary.

When it comes to comparing advisory, consultancy and information services with goods, similarity can be found under conditions akin to those concerning maintenance, installation and repair (see paragraph 4.4).

Examples of similarity

- *Advisory services in computer technologies (hardware and software)* (Class 42) and *computer software* (Class 9).
- *Beauty consultancy* (Class 44) and *cosmetics* (Class 3).

Examples of dissimilarity

- *Information services concerning the purchase of fashion articles (shoppers guide information)* (Class 35) and *clothing, footwear and headgear* (Class 25), as it is not common in the market for the manufacturer of articles in Class 25 to provide such information services to consumers.
- Providing information in the field of entertainment (Class 41) and toys (Class 28), as it is not common in the market for the manufacturer of toys in Class 28 to provide such information services to consumers.

4.6 Rental and Leasing

Rental services are classified in the same classes as the service provided by means of the rented objects:

- *rental of telephones* is in Class 38 because *telecommunication services* are in Class 38;
- *rental of cars* is in Class 39 because *transport services* are in this class.

Leasing services are analogous to rental services and therefore are classified in the same way. However, hire- or lease-purchase financing is classified in Class 36 as a financial service.

These services must be clearly distinguished from any financial services. The comparison of rental and leasing services leads to the outcomes shown in the following paragraphs.

4.6.1 Rental/leasing versus related services

Even though rental services are classified in the same classes as the service provided by means of the rented objects, they are not automatically identical to this service. The comparison between these services has to be made applying normal criteria for identity and similarity.

Examples

- There is identity between *rental of flats* (Class 36) and *real estate affairs* (Class 36) because *rental of flats* is included in *real estate affairs*.
- The same reasoning cannot apply to *rental of bulldozers* (Class 37) and the related services of building construction (Class 37). *Rental of bulldozers* is not included in building construction and therefore these services are not considered to be identical.

4.6.2 Rental/leasing versus goods

Rental/leasing services are in principle always dissimilar to the goods rented/leased.

Examples

- *Vehicle rental* (Class 39) and *vehicles* (Class 12).
- *Rental of films* (Class 41) and *DVDs* (Class 9).

Exceptions exist where it is common for the manufacturer of the goods to provide rental services.

- Rental and leasing of computer software (Class 42) and computer software (Class 9) are considered to be similar.
- Rental of automatic vending machines (Class 35) and automatic vending machines (Class 7) are considered to be similar.

4.7 Examples of unclear and imprecise terms

General indications of class headings, from current and previous editions of the Nice Classification (the part shown in bold is the part which is seen as unclear and imprecise):

Class 6: *Goods of common metal not included in other classes*

Class 7: *Machines and machine tools*

Class 14: *Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes*

Class 16: *Paper, cardboard and goods made from these materials [paper and cardboard], not included in other classes*

Class 17: *Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials [rubber, gutta-percha, gum, asbestos and mica] and not included in other classes*

Class 18: *Leather and imitations of leather, and goods made of these materials [leather and imitations of leather] and not included in other classes*

Class 20: *Goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics*

Class 37: *Repair*

Class 37: *Installation services*

Class 40: *Treatment of materials*

Class 45: *Personal and social services rendered by others to meet the needs of individuals.*

Other terms lacking clarity and precision, regardless of the class for which they have been applied:

- *Merchandising articles*
- *Fair-trade goods*
- *Lifestyle accessories*
- *Gift articles*
- *Souvenirs*
- *Collectors' articles*
- *Housewares*
- *Electronic goods, electric/electronic apparatus/instruments*
- *Gadgets (electronic or not)*
- *Hobby articles*
- *Advertising articles*
- *Memorabilia*
- *Wellness goods*
- *Association services*

5. Annex II: Specific Industries

5.1 Chemicals, Pharmaceuticals and Cosmetics

5.1.1 Chemicals (Class 1) versus chemical products (Classes 3 and 5)

Although major chemical companies are usually involved in the production of all kinds of basic chemicals, speciality chemicals and life science products, including pharmaceuticals and pesticides, as well as consumer products, such as cleaning preparations and cosmetics, the mere fact that their nature coincides — as all of them can be broadly classified as chemical

products — is not sufficient to find them similar. Special attention must be drawn to the specific purpose of these chemicals, as well as to their public and distribution channel. What has been said in paragraph 4.2 as to the relation between raw materials, semi-processed and finished products particularly applies to these products.

Consequently, although goods in Class 3 and Class 5 are usually combinations of various chemicals, they are in principle not considered similar to goods included in Class 1. Their purpose as a finished product usually differs from goods in Class 1, which are mainly in their raw, unfinished state and not yet mixed with other chemicals and inert carriers into a final product. The finished products in Class 3 and Class 5 usually also target a different public and do not share the same distribution channels.

However, it cannot be excluded that goods such as *chemicals used in agriculture, horticulture and forestry* require few processing steps to be considered finished products, such as *fungicides*. Such chemicals may be considered to already share the inherent purpose of *fungicides*: to kill or inhibit fungi or fungal spores, in particular when they consist of the fungicide's active ingredient. Furthermore, the same (agro-)chemical companies may produce the semi-processed goods, as well as the final product. There is therefore a low degree of similarity between *chemicals used in agriculture, horticulture and forestry* and *fungicides*.

Furthermore, there are also goods in Class 1 that are not mere chemicals but are semi-finished or even finished products with a specific purpose of use, which is an important factor that must be taken into account when comparing goods in Class 1 with goods in other classes.

For example *manures* in Class 1 on the one hand and *pesticides, fungicides and herbicides* in Class 5 on the other are not only chemical products but also finished products with a specific use in the agricultural industry. They therefore have a similar purpose since the specific goods in Class 5 can be considered growth-enhancing by preventing conditions that could inhibit plant growth. As such they are similar to a low degree.

5.1.2 Pharmaceuticals versus pharmaceuticals

A pharmaceutical preparation refers to any kind of medicine, that is to say, a substance or combination of substances for treating or preventing diseases in human beings or animals. From its definition it can already be concluded that *veterinary preparations* — though separately mentioned in the class heading — are included in the broader term of *pharmaceutical preparations*. Therefore, they are identical.

The same applies to herbal and homoeopathic medicines since they are included in the broad term of *pharmaceutical preparations*.

Equally, testing preparations, that is to say, chemical reagents for medical — including veterinary — purposes, also fall under the general indication of *pharmaceutical preparations*.

Specific pharmaceuticals are considered to be similar to other specific pharmaceuticals. This is because several, if not all, criteria for similarity are usually met: they share the same nature because they are specific chemical products; their purpose is, broadly speaking, healing and/or curing; they are sold in the same places, namely, pharmacies; and they come from the same source, which is the pharmaceutical industry. This industry manufactures a wide variety of drugs with various therapeutic indications, something the general public is aware of. Furthermore, their method of use can be the same and they can be in competition with one another.

However, the degree of similarity found between specific pharmaceuticals may vary depending on their specific therapeutic indications.

Example 1

- *Sedatives versus pain killers.* These pharmaceuticals are highly similar.

Example 2

- *Anti-epileptics versus pharmaceutical preparations, except medicines to combat diseases in connection with the central nervous system.* These pharmaceutical preparations are considered to be similar.

Example 3

- *Cardiovascular preparations versus pharmaceutical preparations for the treatment of central nervous system [CNS] diseases.*

These pharmaceutical preparations are only similar to a low degree. In this regard, it should be noted that a low degree of similarity should only be established in exceptional cases, for example, when it can be clearly established that they have different therapeutic indications and different methods of use.

Whether a specific pharmaceutical is sold under prescription is not of particular relevance for the comparison of the goods. Therefore, a prescription medicine is generally to be considered similar to an over-the-counter drug for the reasons stated above. (For information on the relevant public and the degree of attention in relation to pharmaceuticals, see the Guidelines, Part C, Section 5, Double Identity and Likelihood of Confusion, Chapter 3, Relevant Public and Degree of Attention.)

5.1.3 Pharmaceuticals versus dietetic substances adapted for medical use

Dietetic substances and food supplements adapted for medical use are substances prepared for special dietary requirements with the purpose of treating or preventing a disease. Bearing this in mind, their purpose is similar to that of *pharmaceutical products* (substances used in the treatment of diseases) insofar as they are used to improve a patient's health. The relevant public coincides and the goods generally share the same distribution channels. For the above reasons, these goods are considered to be similar.

5.1.4 Pharmaceuticals versus cosmetics

The general categories *pharmaceuticals* and *cosmetics* are considered to be similar. Cosmetics include preparations used to enhance or protect the appearance or odour of the human body and they are also often fragranced to add a pleasant smell. Pharmaceuticals, however, comprise products, such as skin or haircare preparations with medical properties. They may coincide in purpose with cosmetics. Moreover, they share the same distribution channels since they can be found in pharmacies or other specialised shops. They target the same public and are often manufactured by the same companies.

However, when comparing specific pharmaceuticals with cosmetics, they may only show a low degree of similarity or they may even be entirely dissimilar, depending on the specific drug and its specific purpose (medical indication/effect) or its method of use.

Example

- *A painkiller is dissimilar to nail polish.*

5.1.5 Pharmaceuticals versus services

With regard to the link between, on the one hand, *pharmaceutical products* in Class 5 and, on the other, *scientific and technological services and research* including, for example, biological and pharmaceutical research, it is known that pharmaceutical companies often try to improve their products through research, development and innovation. The fact that pharmaceutical companies do not generally provide such services to third parties does not preclude them from

doing so. Therefore, it cannot be ruled out that the relevant public may believe that the same company is responsible for both the manufacturing of the pharmaceutical products and the research services, or that a company offering the services in question is economically linked to the manufacturing company. Moreover, pharmaceutical companies promote and administer pharmaceutical studies for consumers and undertake research and development in cooperation with third parties. The relevant public for these goods and services overlaps insofar as professionals are concerned as they can be both users of the services and users of pharmaceutical products. Therefore, there is similarity between these goods and services due to the close connection between them.⁸⁰

Medical services in Class 44 and pharmaceutical products in Class 5 are aimed at the same consumers, namely both professionals and the general public, and they pursue the same aim of treating disease. In hospitals, medical services often include the administration of pharmaceuticals. Food supplements may be sold in pharmacies, which offer healthcare services and advice. Similarly, veterinary services may also include the administration of veterinary products, and dentistry services may provide preparations for healthcare and pharmaceutical products. Thus, these goods and services may share the same distribution channels. Finally, these goods and services may be complementary insofar as the services are important or even indispensable for use of the goods. In particular, the provision of medical services may necessarily require the administration of pharmaceutical products. For this reason, the relevant public may believe that the same undertaking is responsible for both manufacturing the goods and providing the services. Taking all of the above factors into account, there is similarity between these goods and services⁸¹.

5.1.6 Medical and veterinary apparatus and instruments (Class 10) versus healthcare services (Class 44)

The same reasoning as above can be applied by analogy to *medical and veterinary apparatus and instruments, prosthetics and artificial implants, orthopaedic and mobility aids, and physical therapy equipment* in Class 10. These goods may also be complementary to *healthcare services* in Class 44, such as medical services, dentistry, and the services of hospitals and/or nursing homes, as the apparatus and instruments in Class 10 can be indispensable for carrying out said healthcare services. These goods and services are also aimed at the same public and serve the same purpose. Consequently, they are similar.

5.2 Automobile Industry

The automobile industry is a complex industry involving various kinds of companies, including car manufacturing companies as well as any suppliers that provide the car manufacturer with their raw materials (metal, aluminium, plastics, paints, etc.), parts, modules or complete systems. Several areas of production can be distinguished: drive engineering, chassis, electronics, interior and exterior.

The complexity of the industry and the fact that the final product incorporates some component parts and accessories complicate the examination of similarity between the end product (e.g. a car) and the various parts or materials used for its production. Furthermore, when purchasing a car, the general public knows that a car incorporates many items from many sources and that the car manufacturer might assemble components that have been manufactured by others. However, as far as the consumer of a car is concerned, the goods are normally offered under only one sign, which makes it almost impossible for the general public to identify other manufacturers or to differentiate their source of production. Exceptions include car batteries or tyres, where other signs are usually visible.

⁸⁰ 14/06/2018, T-165/17, EMCURE / Emcur et al., EU:T:2018:346, § 47, 49-51

⁸¹ 14/06/2018, T-165/17, EMCURE / Emcur et al., EU:T:2018:346, § 56-57, 60-62

As with other industries, the Canon criteria accordingly apply and in particular the general principles set out for the comparison of parts, components, and fittings have to be taken into consideration.

In particular, it should be kept in mind that there are goods that will only be purchased by the automobile industry without any possibility of them ever reaching or being purchased by the general public (end consumer). One example is the common metal (Class 6) used to form the chassis. Such goods are clearly dissimilar to the car and probably dissimilar to all other parts, components and fittings. However, there are spare parts that might also be purchased by the general public for repair or maintenance purposes. Assessment of the similarity of these goods will mainly depend on whether the specific spare part is commonly produced by the car manufacturer.

5.3 Electric Apparatus/Instruments

The expression *electric apparatus and instruments* in Class 9 is an unclear or imprecise term as described in paragraph 1.5.2, The relevant scope, and should be treated accordingly.

5.4 Fashion and Textile Industries

Goods classified in Classes 22, 23, 24 and 25 are textile related. There is a certain progression through these classes: *raw fibrous textile materials*, such as *fibres* (Class 22), are further made into *yarns and threads* (Class 23), then into *textiles*, such as fabrics (Class 24), and end up as *finished goods made of textile* (Class 24) or *clothing* (Class 25).

Moreover, Class 18 goods that are made of leather and/or imitations of leather are also related to the fashion and textile industries.

5.4.1 Raw or semi-processed materials versus finished goods

Since the relationship between Classes 22, 23, 24 and 25 is often based on the fact that one product is used for the manufacture of another (e.g. *textiles* in Class 24 are used for the manufacture of *clothing* in Class 25), in comparisons of this kind, general rules concerning raw materials apply (see Annex I, paragraph 4.2).

For example, raw materials such as *leather and imitations of leather, animal skins and hides* (Class 18) are dissimilar to clothing, footwear and headgear (Class 25). The mere fact that leather is used for the manufacture of footwear (shoes made of leather) is not sufficient in itself to conclude that the goods are similar, as their nature, purpose and relevant public are quite distinct: raw materials are intended for use in industry rather than for direct purchase by the final consumer.

However, a low degree of similarity is found between *textiles* and *textile goods* such as *bed sheets* and *table covers*, in Class 24. In such cases, the degree of transformation required from material to end product is often insignificant: the fabric is merely cut into shape and/or sewn to obtain the finished product. Furthermore, many establishments allow customers to purchase the base material or ready-made cushions, etc. made from such material. Therefore, the relevant public may expect these goods to come from the same undertakings.

5.4.2 Textile goods (Class 24) versus clothing (Class 25)

When comparing *textile goods* in Class 24 with *clothing* in Class 25 it has to be considered that most items covered by *textile goods* in Class 24 are dissimilar to most items of *clothing* in Class 25 (for example *bed linen* in Class 24 and *skirts* in Class 25). The main commonality between them is that they are all made of textile, however they serve, in principle, completely different purposes: items of clothing are meant to be worn by people, or serve as fashion articles, whereas diverse textile goods are mainly for household purposes and interior

decoration. Therefore, their method of use is different. Moreover, the distribution channels and sales outlets are different, and the relevant public will not think that they originate from the same undertaking.

However, some specific textile goods may be found similar to specific items of clothing. For example, *bath towels* in Class 24 and *bathrobes* in Class 25 are similar because these both sets of goods aim to absorb moisture from wet skin, they have a similar nature, purpose and are in competition. Additionally, the producers, distribution channels and end users may be the same.

In view of the fact that *bathrobes* are included in the broad category of *clothing* (and *bath towels* are included in the broad category of *textile goods*, similarity must also be found between the broad categories of *textile goods* in Class 24 and *clothing* in Class 25.

Other specific textile goods may also be found similar to specific items of clothing if the same or similar circumstances apply to those specific goods; this needs to be assessed on a case-by-case basis.

5.4.3 Clothing, footwear and headgear (Class 25)

Class 25 goods, namely *clothing, footwear and headgear*, are of an identical or very similar nature. They serve the same purpose since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion and are often found in the same retail outlets. Consumers, when seeking to purchase clothes, will expect to find footwear and headgear in the same department or shop and vice versa. Moreover, many manufacturers and designers will design and produce all of the aforementioned items. Therefore, these goods are similar to each other.

5.4.4 Fashion accessories

As explained in the paragraph on 'Accessories' (see Annex I, paragraph 4.3), the mere fact that a certain product is used in combination with another is not necessarily conclusive for a finding of similarity. However, it is common for some accessories to be produced by the manufacturer of the main product – at least the consumer might expect them to be produced under the control of the same entity. Furthermore, they can be distributed through the same trade channels. In such cases, there is a strong indication for similarity.

Goods such as (hand)bags, sports bags, briefcases, purses, in Class 18 are related to articles of *clothing, headgear and footwear* in Class 25, in the sense that they are likely to be considered by consumers as aesthetically complementary accessories to articles of outer clothing, headgear and even footwear. They are closely coordinated with these articles and may well be distributed by the same or linked manufacturers, and it is not unusual for clothing manufacturers to directly produce and market them. Moreover, these goods can be found in the same retail outlets. Therefore, these goods are considered to be similar to *clothing, headgear and footwear*.

In contrast, hair accessories such as *hair pins* and *ribbons* are dissimilar to *clothing*. Even though these goods might have some distant link to the fashion market, the mere fact that someone might want to match hair pins and clothing is not sufficient to conclude that these goods are complementary and therefore similar. The goods can only be considered to be complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other and is not merely ancillary. In the present case, these conditions are not fulfilled. Furthermore, the nature and method of use of these goods is different. They are not in competition with each other. The production of these goods involves different know-how, they do not belong to the same category of goods and they are not regarded as components of a general array of goods that potentially have the same commercial origin.

Likewise, luxury goods such as glasses (Class 9) and jewellery (Class 14) are considered to be dissimilar to clothing, footwear and headgear. The nature and the main purpose of these goods are different. The main function of clothing is to dress the human body whilst the main purpose of glasses is to improve eyesight, and jewels are worn for personal adornment. They do not have the same distribution channels and they are neither in competition nor complementary.

The same reasoning applies to luxury goods, such as perfumes (Class 3) — the main purpose of which is to impart a long-lasting scent to the body, stationery, etc. — and goods such as travelling bags (Class 18), which are intended for carrying things when travelling. Even though nowadays, designers also sell perfumes, fashion accessories (such as glasses and jewellery) and travel accessories under their marks, this is not the rule, and rather applies only to (economically) successful designers.

5.4.5 Sports clothing, footwear and headgear (Class 25) versus sporting and gymnastic articles (Class 28)

The general category of *clothing, footwear and headgear* includes sports clothing, footwear and headgear, which are garments or items of apparel designed specifically to be used when performing an activity or sport. Although the nature of these goods is different from those of *sporting and gymnastic articles*, which are articles and apparatus for all types of sports and gymnastics, such as weights, halters, tennis rackets, balls and fitness apparatus, there are undertakings that manufacture both *sporting and gymnastic articles* as well as *sports clothing/sports footwear*. Therefore, the distribution channels can be the same. There is a low degree of similarity when *sports clothing/sports footwear* is compared with *sporting and gymnastic articles*.

5.4.6 Fashion design (Class 42) and tailoring services (Class 40) versus clothing (Class 25)

There is a low degree of similarity between *clothing* and *fashion design* and *tailoring services* since they share the same relevant public and might coincide in the same usual origin (producer/provider). Producers of ready-made clothing (especially suits and wedding dresses) frequently provide *tailoring services*, which are closely related to *fashion design*, which is an earlier step in the clothing production process.

5.5 Food, Beverages and Restaurant Services

5.5.1 Ingredients of prepared food

Ingredients used for the preparation of foodstuffs are a subcategory of raw materials and treated in the same way as raw materials in general. Consequently, the mere fact that one ingredient is needed for the preparation of a foodstuff will generally not be sufficient in itself to show that the goods are similar, even though they all fall under the general category of foodstuffs.⁸²

Examples of dissimilarity

- Eggs (Class 29) and *ice cream* (Class 30)
- Yeast (Class 30) and *bread* (Class 30).

5.5.2 Main ingredient

When the ingredient can be considered as being the main ingredient of the prepared dish, a similarity will exist only if the goods share some other relevant criterion or criteria, in particular the usual origin, nature, purpose or method of use.

Examples of similarity (main ingredient plus other criteria)

⁸² 26/10/2011, T-72/10, Naty's, EU:T:2011:635, § 35-36

- *Milk* (Class 29) and *yoghurt* (Class 29)
- *Fish* (Class 29) and *fish sticks* (Class 29)
- *Dough* (Class 30) and *pizzas* (Class 30)

See also the judgment of the General Court of 04/05/2011, T-129/09, *Apetito*, EU:T:2011:193, where the Court confirms the finding of similarity between a particular foodstuff and prepared meals mainly consisting of the same particular foodstuff.

There is no complementarity in such cases simply because one ingredient is needed for the production/preparation of another foodstuff. Complementarity applies only to the use of goods and not to their production process.

5.5.3 Non-alcoholic beverages (Class 32) versus alcoholic beverages (except beers) (Class 33)

In Case T-150/17 of 04/10/2018, *FLÜGEL / ... VERLEIHT FLÜGEL et al.*, EU:T:2018:641, § 77-84, the Court found that a very large number of alcoholic and non-alcoholic drinks are generally mixed, consumed, or indeed marketed together, either in the same establishments or as premixed alcoholic drinks. To consider that those goods should, for that reason alone, be described as similar, when they are not intended to be consumed in either the same circumstances, or in the same state of mind, or, as the case may be, by the same consumers, would put a large number of goods which can be described as 'drinks' into one and the same category for the purposes of the application of Article 8(1) EUTMR (Articles 5(b) and 5(c) of the **Law**).

Thus, it cannot be considered that an alcoholic drink and an energy drink are similar merely because they can be mixed, consumed or marketed together, given that the nature, intended purpose and use of those goods differ, based on the presence of, or absence of alcohol in their composition ... Furthermore, it must be held that the undertakings which market alcoholic drinks premixed with a non-alcoholic ingredient do not sell that ingredient separately and under the same or a similar mark as the premixed alcoholic drink at issue'.

Therefore, most non-alcoholic drinks in Class 32 are considered to be dissimilar to most alcoholic drinks in Class 33.

However, some specific non-alcoholic drinks may be similar to some specific alcoholic drinks. For example, *alcohol free wine* and *de-alcoholised wine* in Class 32 and *wine* in Class 33. There is a growing trend in the drinks market sector for winemaking companies to also produce and offer non-alcoholic wine as an alternative to alcoholic wine. Indeed, non-alcoholic wine often goes through the same fermentation and ageing process as alcoholic wine, only to have the alcohol removed at the last stages (either through distillation or filtration). Furthermore, non-alcoholic wine is intended to be consumed in the same circumstances as alcoholic wine by consumers who cannot, or choose not to, consume alcohol. Since consumers will perceive them as alternative products they must also be considered to be in competition. In addition, it is not uncommon for non-alcoholic wine to be sold in wine shops or specialised wine sections in supermarkets. It follows that *non-alcoholic wine* is similar to *wine*. As a result, similarity must also be found between the broader categories of *non-alcoholic beverages* in Class 32 and *alcoholic beverages (except beers)* in Class 33, which include those specific goods respectively. Other specific non-alcoholic drinks may be found similar to specific alcoholic drinks if the same or similar circumstances apply to those specific goods; this needs to be assessed on a case-by-case basis.

5.5.4 Beers (Class 32), alcoholic beverages (except beers) (Class 33)

There is a similarity between different alcoholic beverages in Class 33, as well as between the broad category of *alcoholic beverages* and *beer* in Class 32. Although their production

processes are different, these goods all belong to the same category of alcoholic drinks (nature) intended for the general public. They can be served in restaurants and in bars and are on sale in supermarkets and grocery stores. These drinks can be found in the same area of supermarkets, even if some distinction according to their respective subcategory can be made. Furthermore, some alcoholic beverages may originate from the same undertakings.

Examples

- *Beers* are similar to *alcoholic beverages (except beers)*
- *Wines* are similar to *alcoholic beverages (except wines)*.

5.5.5 Provision of food and drinks versus food and drinks

The provision of food and drinks in Class 43 mainly covers services of a restaurant or similar services, such as catering, cafeterias and snack bars. These services are intended for serving food and drinks directly for consumption.

The mere fact that food and drinks are consumed in a restaurant is not sufficient reason to find similarity between them.

Nevertheless, in certain situations these goods and services can be complementary. As shown in paragraph 3.2.4, goods/services are complementary if one is indispensable or important for the use of the other in such a way that consumers may think that responsibility for the production of those goods or the provision of those services lies with the same undertaking.

The mere fact that food and/or drinks are essential to the services of restaurants, bars, cafeterias, etc. does not in itself lead consumers to think that responsibility for the production of those goods and provision of those services lies with the same undertaking (e.g. salt in restaurants).

However, consumers may think that responsibility does lie with the same undertaking if the market reality is that the provision of food and drinks and the manufacture of such goods are commonly offered by the same undertaking under the same trade mark (e.g. coffee in their coffee shops, ice cream in their ice cream parlours, beer in pubs). In such cases, there is a low degree of similarity.

5.6 Services to Support Other Businesses

All services listed in the class heading of Class 35 are aimed at supporting or helping other businesses to do or improve business. They are therefore in principle directed at the professional public.

When comparing specific services falling within Class 35 it is very useful to focus on the question: who is providing this kind of service? Is it an advertising agency, a management consultant, a human resources consultant, an accountant, an auditor, a sales agent or a tax advisor? Once the usual origin has been established, it is easier to find the general indication to which the specific service belongs.

Advertising services consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing the client's position in the market and enabling them to acquire a competitive advantage through publicity. In order to fulfil this target, many different means and products might be used. These services are provided by advertising companies, which study their client's needs, provide all the necessary information and advice for the marketing of their products and services, and create a personalised strategy regarding the advertising of their goods and services through newspapers, websites, videos, the internet, etc.

Examples of advertising services are *rental of advertising time on communication media, telemarketing services, marketing, public relations and demonstration of goods*, since they are all intended to promote other companies' goods/services, albeit via different means.

However, when compared to the *organization of trade fairs for commercial or advertising purposes*, the latter consist of the arrangement of events, presentations, exhibitions or trade fairs to facilitate or encourage the promotion and sale of the client's goods and services. These services are normally provided by specialised companies in their specific field. As such, the services in question are to be considered similar to *advertising services* since these could be offered to third parties in the form of the organisation, arranging and conducting of an exhibition or trade fair on their behalf.

Example

Marketing research is the collection and analysis of information about a particular market to assess the viability of a product or service.

The nature and purpose of advertising services are fundamentally different from the manufacture of goods or from the provision of many other services. Therefore, advertising is generally dissimilar to the goods/services being advertised. The same applies to the comparison of advertising services with goods that can be used as a medium for disseminating advertising, such as DVDs, software, printed matter, flyers and catalogues.

Management services are in Class 35 when they relate to the business aspects of an entity. As there are management services in other classes, a management service in Class 35 is taken to relate to business purposes.

Business management services are intended to help companies manage their business by setting out the strategy and/or direction of the company. They involve activities associated with running a company, such as controlling, leading, monitoring, organising, and planning. They are usually rendered by companies specialised in this specific field such as business consultants. They gather information and provide tools and expertise to enable their customers to carry out their business or to provide businesses with the necessary support to acquire, develop and expand their market share.

Examples of business management are business research and appraisals, cost-price analyses and organisation consultancy, since they are all intended to help with the strategy of a commercial undertaking. These services also include any 'consultancy', 'advisory' and 'assistance' activity that may be useful in the management of a business, such as how to efficiently allocate financial and human resources, improve productivity, increase market share, deal with competitors, reduce tax bills, develop new products, communicate with the public, carry out marketing, research consumer trends, and launch new products; how to create a corporate identity, etc.

Examples

Business research is the analysis and interpretation of economic information, such as income, employment, taxes, and demographics. This research information is used by entrepreneurs for making business decisions such as establishing marketing strategies.

Business appraisals involve an investigation into the nature and potential of a business and an assessment of its performance in relation to its competitors.

A *cost-price analysis* is a combination of both an evaluation of the proposed total price of a project and the cost of the separate elements of that project (e.g. labour, materials) to determine if they are permissible, related to the project requirements and reasonable. It is used to determine whether going ahead with a project is a sound business decision. It is

therefore considered as a service that helps with the management of the business affairs or commercial functions of an industrial or commercial enterprise. Using the information gained from a cost-price analysis, a business may then go on to make the financial decisions associated with engaging in the project.

When comparing *business management* with *advertising* it should be noted that advertising is an essential tool in business management because it makes the business itself known in the market. As stated above, the purpose of advertising services is 'to reinforce the [business] position in the market' and the purpose of business management services is to help a business in 'acquiring, developing and expanding market share'. There is not a clear-cut difference between 'reinforcing a business position in the market' and 'helping a business to develop and expand market share'. A professional who offers advice about how to efficiently run a business may reasonably include advertising strategies in that advice because there is little doubt that advertising plays an essential role in business management. Furthermore, business consultants may offer advertising (and marketing) consultancy as a part of their services, and therefore the relevant public may believe that these two services have the same professional origin. Consequently, considering the above, these services are similar to a low degree. This clear link between the two services also follows from the definitions given above of marketing research (an advertising service) and business research (a business management service).

Business administration services are intended to help companies with the performance of business operations and, therefore, the interpretation and implementation of the policy set by an organisation's board of directors. These services consist of organising people and resources efficiently so as to direct activities toward common goals and objectives. They include activities such as personnel recruitment, payroll preparation, drawing up account statements and tax preparation, since these enable a business to perform its business functions and are usually carried out by an entity that is separate from the business in question. They are rendered by, inter alia. employment agencies, auditors and outsourcing companies.

Example

Business auditing involves the evaluation of a variety of business activities. It encompasses a review of organisational structures, management, processes, etc.

When comparing *business administration* to *advertising* it should be noted that these services are usually dissimilar, since a professional who helps with the execution of business decisions or the performance of business operations will not offer advertising strategies.

The line between *business management* and *business administration* is blurred, and it is sometimes very difficult to clearly distinguish between them. They both fall under the broader category of business services. As a general rule, it can be said that business administration services are performed in order to organise and run a business, whereas business management follows a higher approach aimed at setting the common goals and the strategic plan for a commercial enterprise.

Office functions are the internal day-to-day operations of an organisation, including the administration and support services in the 'back office'. They mainly cover activities that assist in the operation of a commercial enterprise. They include activities typical of secretarial services, such as shorthand and typing, compilation of information in computer databases, invoicing, and administrative processing of purchase orders, as well as support services, such as the rental of office machines and equipment.

Example

Book-keeping is the act of recording financial transactions.

5.7 Retail Services

Retail is commonly defined as the action or business of selling goods or commodities in relatively small quantities for use or consumption rather than for resale (as opposed to wholesale, which is the sale of commodities in quantity, usually for resale).

However, it should be noted that the sale of goods is not a service within the meaning of the Nice Classification. Therefore, the activity of retail in goods as a service for which protection of TM can be obtained does not consist of the mere act of selling the goods, but in the services rendered around the actual sale of the goods, which are defined in the explanatory note to Class 35 of the Nice Classification by the terms ‘the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods’.

Moreover, the Court has held that the objective of retail trade is the sale of goods to consumers, which includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.⁸³

Retail services allow consumers to satisfy different shopping needs in one place and are usually directed at the general consumer. They can take place in a fixed location, such as a department store, supermarket, boutique or kiosk, or in the form of non-shop retailing, such as through the internet, by catalogue or mail order.

The following principles apply as regards the similarity of the goods/services at issue.

5.7.1 Retail services versus any good

Retail services in general (i.e. where the specification is not limited to the sale of particular goods) is an unclear or imprecise term, as described in paragraph 1.4.2.2. The relevant scope, and should be treated accordingly.

5.7.2 Retail services of goods versus goods

In relation to retail services of specific goods, the similarity, or the lack thereof, between the goods to which the retail services relate and the goods themselves constitute an essential factor which needs to be taken into account. Retail services of specific goods can be similar to varying degrees, or dissimilar to specific goods depending on the degree of similarity between the goods themselves, but also taking into account other relevant factors.

5.7.2.1 Retail services of specific goods versus the same specific goods

Retail services concerning the sale of specific goods are similar to an average degree to these specific goods. Although the nature, purpose and method of use of these goods and services are not the same, it should be noted that they display similarities, having regard to the fact that they are complementary and that the services are generally offered in the same places as those where the goods are offered for sale. Furthermore, they are directed at the same public.

The goods covered by the retail services and the specific goods covered by the other mark have to be identical in order to find an average degree of similarity between the retail services of those goods and the goods themselves, that is to say, they must either be exactly the same goods or fall under the natural and usual meaning of the category.

Examples of an average degree of similarity

- *Retail of sunglasses v sunglasses* (the goods themselves are identical).

⁸³ 07/07/2005, C-418/02, Praktiker, EU:C:2005:425, § 34

- *Retail of optical goods v sunglasses* (the goods themselves are identical).

5.7.2.2 Retail services of specific goods versus similar specific goods

There is a low degree of similarity between the retail services concerning specific goods and other specific similar or highly similar goods, because of the close connection between them on the market from the perspective of the consumer. Consumers are accustomed to the practice that a variety of similar or highly similar goods are brought together and offered for sale in the same specialised shops or in the same sections of department stores or supermarkets. Furthermore, they are of interest to the same consumer.

A low degree of similarity between the goods sold at retail and the goods themselves may also be sufficient to lead to a finding of a low degree of similarity with the retail services provided that the goods involved are commonly offered for sale in the same specialised shops or in the same sections of department stores or supermarkets, belong to the same market sector and, therefore, are of interest to the same consumer.

Such goods and services are dissimilar, when the goods at issue are not offered in the same places, do not belong to the same market sector and target a different consumer.

Examples of a low degree of similarity

- *Retail of sportswear v sports bags* (the goods themselves are highly similar).
- *Retail of clothing v headgear; footwear* (the goods themselves are similar).
- *Retail of computers v bags adapted for laptops* (the goods themselves are similar to a low degree, are commonly offered in the same specialised shops or in the same sections of department stores, and are of interest to the same consumer).

Example of dissimilarity

- *Retail of protective clothing v clothing* (the goods themselves pertaining to Classes 9 and 25 respectively are similar to a low degree, however, they are not commonly offered through the same channels of distribution and are of interest to different consumers).

5.7.2.3 Retail services of specific goods versus dissimilar specific goods

When goods sold at retail are dissimilar to the actual goods themselves, no similarity can be found between them.

Example of dissimilarity

- *Retail of furniture v pharmaceuticals*.

5.7.3 Retail services versus retail services or retail services of specific goods

Retail services in general (i.e. where the specification is not limited to the sale of particular goods) is an unclear or imprecise term, as described in paragraph 1.4.2.2, The relevant scope, and should be treated accordingly.

5.7.4 Retail services of specific goods versus retail services of other specific goods

Retail services of specific goods and retail services of other specific goods have the same nature as both are retail services, have the same purpose of allowing consumers to conveniently satisfy different shopping needs, and have the same method of use.

Similarity is found between the retail services of specific goods where the goods are commonly retailed together in the same outlets and they are directed at the same public. However, the degree of similarity between retail of specific goods on the one hand and retail of other specific goods on the other hand may vary depending on the proximity of the retailed goods and the particularities of the respective market sectors.

Similarity is, in principle, excluded where the goods concerned are not commonly retailed together and target different publics, or are dissimilar. Nevertheless, a degree of similarity may still be found if, because of the particularities of the market, such dissimilar goods are retailed together in the same outlets and target the same public.

Examples of similarity

- *Retail of clothing v Retail of handbags.*
- *Retail of computers v Retail of peripherals adapted for use with computers.*
- *Retail of distilled beverages v Retail of soft drinks* (despite the dissimilarity between the goods they are often retailed together and target the same public).

Example of dissimilarity

- *Retail of furniture v Retail of pharmaceuticals* (the goods are dissimilar, are not commonly retailed together and target different publics).

5.7.5 Services to which the same principles apply

The principles set out above in relation to retail services apply to the various services rendered that revolve exclusively around the actual sale of goods, such as *retail store services, wholesale services, internet shopping, catalogue or mail order services*, etc. (to the extent that these fall into Class 35).

5.7.6 Services to which the same principles do not apply

In contrast, the principles set out above in relation to retail services do not apply to other services that do not revolve exclusively around the sales of goods, or that do not fall into Class 35, such as *auctioneering services* (Class 35), *import and export services* (Class 35), *distribution and transport services* (Class 39) or *repair services* (Class 37), etc.

Example

- Auctioneering services

Auctions are public sales at which goods are sold to the highest bidder. Similarity between these services and the retail of specific products will only be found insofar as the retail services relate to goods that are commonly sold at auctions, such as objects of art.

Therefore, the specific retail or wholesale services of *pharmaceuticals, veterinary and sanitary preparations and medical supplies* for example, would be considered dissimilar to *auctioneering services*, since it is not common on the market for pharmaceuticals, etc. to be sold to the highest bidder.

Example

- Import and export services

Import and export services are not considered to be a sales service and thus cannot be subject to the same arguments as the comparison of goods with retail or wholesale services.

Import and export services relate to the movement of goods and normally require the involvement of customs authorities in both the country of import and the country of export. These services are often subject to import quotas, tariffs and trade agreements. While these services are aimed at supporting or helping other businesses to do business and are preparatory or ancillary to the commercialisation of goods, they do not relate to the actual retail or wholesale of the goods. For these reasons, goods are to be considered dissimilar to import and export services for those goods. The fact that the subject matter of the import/export services and the goods in question are the same is not a relevant factor for finding similarity.

Example

- *Import and export of tobacco products* (Class 35) is dissimilar to *tobacco products* (Class 34).

5.8 Financial Services

Financial services concern the management of money, capital and/or credit and investments and are provided by the finance industry. The finance industry encompasses a broad range of organisations that deal with the management, investment, transfer, and lending of money. Among these organisations are, for example, banks, credit card companies, consumer finance companies, stock brokerages and investment funds.

5.8.1 Banking services (Class 36) versus insurance services (Class 36)

Providing *banking services* consists of the provision of all those services carried out for savings or commercial purposes concerning the receiving, lending, exchanging, investing and safeguarding of money, issuing of notes and transacting of other financial business.

Providing *insurance services* consists of accepting liability for certain risks and respective losses. Insurers usually provide monetary compensation and/or assistance in the event that a specified contingency occurs, such as death, accident, sickness, breaking of a contract or, in general, any event capable of causing damages.

Insurance services have different purposes from the services usually provided by banks, such as providing credit or asset management, credit card services, financial evaluation or stocks and bonds brokerage. Nevertheless, they have some significant aspects in common.

Insurance services are of a financial nature, and insurance companies are subject to licensing, supervision and solvency rules similarly to banks and other institutions providing financial services. Most banks also offer insurance services, including health insurance, or act as agents for insurance companies, with which they are often economically linked. Additionally, it is not unusual to see financial institutions and an insurance company in the same economic group.

Therefore, although *insurance services* and *banking services* have different purposes, they are of a similar nature, may be provided by the same undertaking or related undertakings and share the same distribution channels. These circumstances demonstrate that *insurance services* are similar to *banking services*.

5.8.2 Real estate affairs (Class 36) versus financial affairs (Class 36)

The term 'real estate affairs' comprises real estate property management and evaluation, and real estate agency services, as well as the consultancy and provision of related information. This mainly involves finding a property, making it available for potential buyers and acting as an intermediary. Consumers clearly distinguish real estate agents' services from those of financial institutions. They do not expect a bank to find housing or a real estate agent to manage their finances.

Financial and banking services do not have the same nature, the same intended purpose or the same method of use as real estate services. Whereas financial services are provided by financial institutions for the purposes of managing their clients' funds and consist of, inter alia, the holding of deposited funds, the remittance of funds, the granting of loans or the performance of various financial operations, real estate services are services connected with a property, namely, in particular, the lease, the purchase, the sale or the management of such a property. Furthermore, as regards the fact that the services in question might be found in the same distribution channels, it is clear that real estate services are not, in principle, provided on the same premises as financial services.

Any other conclusion would mean that all non-financial transactions subject to funding would be complementary to a financial service. It must therefore be concluded that these services are dissimilar even if financial services are essential or important for the use of real estate. The consumers would not attribute responsibility for both services to the same company

5.8.3 Credit cards (Class 9) versus financial services (Class 36)

A credit card is a small plastic card issued to users as a system of payment. It allows its holder to buy goods and services based on the holder's promise to pay for these goods and services. The issuer of the card creates a revolving account and grants a line of credit to the consumer (or the user) from which the user can borrow money for payment to a merchant or as a cash advance to the user.

Financial services are offered by institutions like banks for the facilitation of various financial transactions and other related activities in the world of finance.

The intended purpose of credit cards is that they may be used in the course of financial transactions. If this were not the case, they would have no use and would serve no purpose. In this respect, it appears that credit cards have a dual nature: although they physically take the form of a plastic rectangle, they also correspond to a set of contractual relationships between, inter alia, an issuer or a supplier of financial services, which manages accounts and, as the case may be, grants credit, on the one hand, and clients, who use those cards to make payments or establish credit, on the other.

Although credit cards are generally manufactured by specialist undertakings, whose name may even appear on them, and other undertakings are also involved in the service chain (from installing payment terminals to implementing compensation mechanisms), the fact nonetheless remains that their issuers are financial institutions and that the public will not usually consider who has actually produced a credit card, but rather who has issued it. The public will therefore believe that the financial institutions that issue credit cards are responsible for ensuring that they function correctly.

Furthermore, the sole objective of producing credit cards is for use in the course of financial transactions, so that it is of little importance whether they are manufactured by entities that are distinct from the financial institutions that issue them. These goods, which are developed in order to market certain specific services, would be meaningless in the absence of those services.

Accordingly, 'credit cards' are closely connected with 'financial services' and, hence, with 'financial affairs', with the result that those goods and services are complementary..

Therefore, *credit cards* in Class 9 are considered similar to *financial, monetary and banking services* in Class 36 as they coincide in purpose and usual commercial origin insofar as their issuer/provider is concerned; as such, they are complementary.

5.9 Transport, Packaging and Storage

5.9.1 Transport of goods (Class 39) versus any product

Transport services are not considered to be similar to goods. These services are provided by specialist transport companies whose business is not the manufacture and sale of the goods concerned. As regards the nature of the goods and services, *transport services* refer to a fleet of trucks or ships used to move goods from A to B.

Example

- *Pastry and confectionery* are dissimilar to *transport services*. They are different in terms of their nature, intended purpose and method of use; they are neither complementary nor in

competition. All these differences explain why the service of transport and the goods of pastry and confectionery target different consumers. Transport is predominantly aimed at professionals (those who need to move goods) whereas pastry and confectionery target non-professional consumers (ordinary people who require food)⁸⁴.

5.9.2 Packaging and storage of goods (Class 39) versus any product

Equally, *packaging and storage services* merely refer to the service whereby a company's or any other person's goods are packed and kept in a particular place for a fee. Those services are not similar to any kind of goods, including any of the goods that may be packaged and stored.

5.10 Information Technology

5.10.1 Computers versus software

What we call a *computer* is actually a 'system', a combination of components that work together. The hardware devices are the physical components of that system. The hardware is designed to work hand in hand with *computer programs*, referred to as *software*. Computer hardware companies also manufacture software, share the same distribution channels and target the professional public (e.g. for use in banking and finance, education, medicine, business and entertainment/recreation) and/or the general public. Moreover, they are complementary. These goods are considered to be similar.

5.10.2 Software versus apparatus/services that use software

In today's high-tech society, almost all *electronic or digital apparatus* function using integrated *software*. Also, many services in the financial or business sectors in the IT and telecommunication industries clearly depend on software or computer-aided software in order to be rendered. This does not, however, lead to the automatic conclusion that software is similar to goods/services that use software to function successfully.

Examples of dissimilarity

- Although a digital scale functions using an integrated software, this does not lead to the conclusion that software and scales are similar. One could argue that the software is important for the use of the scale; however, they are not complementary because they are not aimed at the same public. The digital scale is for the general public, whereas the software is aimed at the actual manufacturer of these scales. The producers are not the same, nor are the distribution channels, and they do not have the same purpose.

- Although many financial services are rendered with the use of software, for example online banking platforms, such software is an integral part of the financial services themselves and is not sold independently from them. Financial companies or institutions are not normally engaged in the development of highly specialised software. Rather, they would outsource the development of such software to IT companies. These goods and services are clearly provided by different undertakings with expertise in completely different areas, and at the same time target different users, which rules out any complementary relationship. Besides taking into account that by nature goods are different from services, they neither coincide in their purpose, method of use or channels of distribution.

However, when the software is not an integral part of an apparatus/service, it can be purchased independently from it and serves, for example, to give more or different functionalities, similarity can be established.

Examples of similarity

- A *digital camera* and *software*, insofar as their purpose is to increase the functionalities of the camera, are both aimed at the same public and produced by the same or related

⁸⁴ 07/01/2014, R 1006/2012-G, PIONONO (fig.), § 28-36

undertakings. They are distributed through the same channels and use of the one is indispensable for use of the other.

- Telecommunication services and software, insofar as they enable access to these services, are both aimed at the same public and are provided through the same channels of distribution. Clearly, these goods and services are complementary and serve the same purpose.

5.10.3 Software, downloadable 'apps' and downloadable electronic publications

Application software, also known as 'an app', is *computer software* that is designed to help the user perform various tasks on a computer. Application software differs from system software in that it can be accessed by the user and run on a computer. Application software is usually designed with the user in mind. The definition of *application* is used to refer to the small apps that are designed to be downloaded onto smartphones; however, the definition covers all applications on tablets, computers, etc. Consequently, *software*, *application software* and *downloadable applications* are considered to be identical.

Downloadable electronic publications are electronic versions of traditional media, like e-books, electronic journals, online magazines, online newspapers, etc. It is becoming common to distribute books, magazines and newspapers to consumers through tablet-reading devices by means of apps in the form of electronic publications. Consequently, there is a complementary relationship between software/apps and downloadable electronic publications. Their producers can be the same; they follow the same distribution channels and the public is generally also the same. These goods are considered to be similar.

5.10.4 Specific software versus specific software

There are many types of software, and although software by nature (a set of instructions that enables a computer to perform a task) is the same, this does not mean that their specific purpose is the same. This implies that very specific software could even be dissimilar to another type of software.

Example

The field of application of *computer games software* is not the same as *software for apparatus that diagnose diseases*. Due to these significantly different fields of application, the expertise needed to develop these types of software is not the same, nor are their end users or distribution channels. These goods are therefore dissimilar.

5.10.5 Computers and software (Class 9) versus computer programming (Class 42)

Computer programming consists, inter alia, of the process of writing source code, and a computer program is a set of coded instructions that enables a machine, especially a computer, to perform a desired sequence of operations.

Computers are devices that compute, especially programmable electronic machines that perform high-speed mathematical or logical operations or that assemble, store, correlate, or otherwise process information. Computers need programs to operate.

Software is composed of programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation.

Therefore, *computer programming services* are closely linked to *computers* and *software*. This is because in the field of computer science, producers of computers and/or software will also commonly provide computer and/or software-related services (e.g. as a means of keeping the system updated).

Consequently, and in spite of the fact that the nature of the goods and services is not the same, both the end users and the producers/providers of the goods and services coincide.

Furthermore, they are goods and services that are complementary. For these reasons, these goods and services are considered similar.

5.10.6 Communications equipment, computers and software (Class 9) versus telecommunication services (Class 38)

Communications equipment includes means, such as computer networking-, broadcasting-, data- and point-to-point communications equipment, antennas and aerials to enable remote communication.

Owing to rapid developments in the field of information technology, in particular the growing importance of the internet, the markets for communications equipment, IT hardware and software on the one hand, and telecommunications services on the other, have clearly become interlinked.

Goods such as modems, telephones, smartphones, computers, network routers and/or servers are used in close connection with telecommunication services because they are, or can be, absolutely necessary for performing these services and, from the viewpoint of the consumer, they are indispensable for accessing them. They are, moreover, regularly marketed together.

Nowadays, computers are generally networked and their autonomous use is actually the exception to the rule; the rule being that communications equipment, computers and software, insofar as they enable access to those services or provide the ability to perform them, renders them complementary.

Therefore, these goods and services are similar, given their complementary character; although their nature is different, their purpose, consumers and distribution channels are the same.

By analogy, peripherals adapted for use with computers and other smart devices are to be found similar to telecommunication services insofar as they comply with the above rule that they enable access to telecommunication services, such as visual display screens would but, for example, mouse pads would not.

5.10.7 Data carriers and recorded content

Magnetic data carriers are carriers that use magnetic technology to operate, such as floppy discs, magnetic tapes or hard drives; *recording discs* are phonograph records. It follows that not all data carriers are covered by the general indication *magnetic data carriers*, *recording discs*; in particular, many of the more popular data carriers, such as CDs, solid-state memory devices or USB sticks, are not phonograph records and do not use magnetic technology; they are therefore not covered by this general indication.

Data carriers are all kinds of memory devices, whether removable, detachable or transportable. In particular, the term can cover diskettes as well as hard drives, which can be computer consumables, computer peripherals or parts of computers.

Where they are not further specified, data carriers (whether magnetic or digital, etc.) and discs (whether phonograph records or compact discs, etc.) must be considered to encompass both pre-recorded as well as blank media.

Therefore, for the purposes of comparison of goods and services, if data carriers or discs with pre-recorded content are similar to other goods/services, broader terms that are not specified any further, such as *data carriers* or *compact discs*, must also be found similar to those goods/services.

However, a distinction must still be made between one hand, *pre-recorded data carriers and discs* and, on the other, *blank data carriers and discs*.

Blank recording media and media that contain recorded data are very distinct products. For example, the difference between the market for blank recordable CDs and that for CDs pre-recorded with music is vast. In the latter, the subject matter recorded on the CD determines the fundamental characteristic of the product. The consumer is, in essence, purchasing the recorded data. Consumers looking for a CD of their favourite band would not buy a blank CD or another music CD instead. The recorded data characterises the product and the maker of the medium (CD) is irrelevant.

Therefore, for the purposes of comparison of goods/services, if magnetic data carriers and data carriers are specified as being blank, they cannot be found to be similar to magnetic data carriers and data carriers that are specified as being pre-recorded. There is no similarity between blank data carriers (of any kind) and pre-recorded data carriers (of any kind) merely on the basis that the latter goods have been stored or saved onto data carriers, as the latter are merely ancillary goods in this situation.

In particular, as regards goods in Class 16, these are printed on paper (*printed matter, teaching materials, printed publications, magazines*). They do not include electronic publications/books. No relevant Canon criteria apply to printed matter and blank data carriers. Consequently, blank digital or analogue recording and storage media in Class 9 and goods in Class 16 are dissimilar. However, *printed matter* in Class 16 and *data carriers* in Class 9 should be found similar insofar as the term *data carriers* encompasses data carriers with pre-recorded content, and these goods can therefore have the same purpose, target the same relevant public and originate from the same undertakings. Furthermore, they may be in competition.

Chapter 3 Relevant public and degree of attention

1 Introduction

A likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings. It is the **perception of marks in the mind of the relevant public of the goods or services in question** that plays a decisive role in the global assessment of the likelihood of confusion.

Accordingly, the first task is to define the consumer circles that are relevant for the purposes of the case. The method for identifying the relevant public is discussed in paragraph 2 below. Thereafter, the relevant public's degree of attention and sophistication must be established. The impact of the relevant public's attention and sophistication on the assessment of the likelihood of confusion is discussed in paragraph 3.

In addition, the relevant public plays an important role in establishing a number of other factors that are relevant for the assessment of the likelihood of confusion.

1.1 Comparison of the goods and services

The actual and potential customers of the goods and services in dispute constitute one of the factors to be dealt with in the analysis of their similarity. While a coincidence in the relevant public is not necessarily an indication of similarity of the goods or services, largely diverging publics weigh heavily against similarity (see the Guidelines, Part B, Examination, Section 5, Double Identity and Likelihood of Confusion, Chapter 2, Comparison of Goods and Services).

Example

Leather, animal skins and hides are raw materials that go to industry for further processing, whereas *goods made of leather* are final products targeted at the general public. The relevant public is different, which is a fundamental factor in the assessment of similarity and which leads to the conclusion that the goods in question are dissimilar. Similar reasoning applies to *precious metals and jewellery*.

1.2 Distinctive elements of the signs/distinctiveness of the earlier mark

The inherent distinctiveness of a sign or one of its elements also depends on the relevant public for the goods and services. For example, depending on the relevant public's knowledge, background and language, an element contained in a trade mark may be non-distinctive or have a low degree of distinctiveness, or it may be distinctive because, inter alia, it is perceived as a fanciful term without any meaning claimed (see the Guidelines, Part B, Examination, Section 5, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

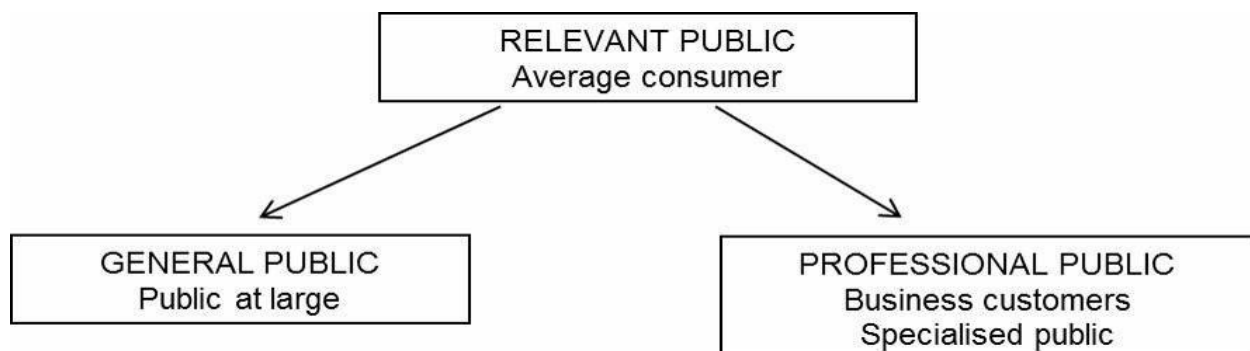
Example

Professionals in the IT and scientific fields are in general more familiar with the use of technical and basic English words than the general public. For example, the common word 'gateway' directly evokes, in the mind of the relevant consumer, the concept of a gateway, which is commonly used in the computing sector.

2 Defining the Relevant Public

In accordance with Articles 5(b) and 5(c) of the law, it must be determined whether a likelihood of confusion exists 'on the part of the public'.

The term '**average consumer**' is a legal concept that is used in the sense of the '**relevant consumer**' or '**relevant public**'. It should not be confused with the 'general public' or 'public at large'. However, in the context of relative grounds, the term 'average consumer' must not be used as a synonym of 'general public' as it can refer to both **professional** and **general public**. In this respect, in cases concerning the likelihood of confusion, the **general public** (or **public at large**), and a **professional or specialised public** (or **business customers**) are distinguished based on the goods and services in question.



In order to properly define the relevant public in the context of relative grounds, following has to be taken into account:

- the goods and services that have been found identical or similar: likelihood of confusion is always assessed against the perception of the consumers of the goods and services that have been found identical or similar. Depending on the goods or services, the relevant public is the general public or a professional/specialised public.

The relevant public always includes both the actual and the potential consumers, that is, the consumers who are currently purchasing the goods/services or who may do so in the future.

If a significant part of the relevant public for the goods or services at issue may be confused as to the origin of the goods, this will be sufficient to establish a likelihood of confusion. It is not necessary to establish that all actual or potential consumers of the relevant goods or services are likely to be confused.

The relevant public for the assessment of the likelihood of confusion is composed of users likely to use both the goods and services covered by the earlier mark and the product covered by the mark applied for that were found to be identical or similar.

When defining the part of the public by reference to which a likelihood of confusion is assessed the following applies:

- if the goods or services of both marks target the general public, the relevant public by reference to which a likelihood of confusion will be assessed is the general public.
- If the goods and services of **both marks** are directed at the same or a similar **professional public**, the likelihood of confusion will be assessed from the perspective of those specialists.

Example

The relevant goods of both the earlier and the contested mark were raw plastic materials, chemical products, resins and the like. These are goods for industrial use. The targeted consumers are, therefore, engineers and/or chemists, that is to say, highly skilled professionals who will process these products and use them in manufacturing activities. The relevant public was considered to be professional.

- If the goods or services of both marks target both the general public and specialists, the likelihood of confusion will be assessed against the perception of the part of the public displaying the lower degree of attentiveness as it will be more prone to being confused. If this part of the public is not likely to be confused, it is even more unlikely that the part of the public with a higher degree of attention will be.

Example

In a case in which both the earlier and the cited mark concerned goods in Classes 3 and 5 that targeted both the general public and professionals (e.g. doctors for pharmaceuticals in Class 5), the likelihood of confusion should be assessed only for the general public, because it is the one displaying the lower degree of attention.

- If the goods and services of the earlier mark target the general and professional public and the contested goods and services target a professional public exclusively (or vice versa), the relevant public for assessing likelihood of confusion will be the professional public only.

Example

The goods of the earlier mark are polish for metals, while the goods of the application are preparations for cleaning waste pipes for the metal-working industry. 'Although "polish for metals" can consist equally well of everyday consumer goods as of goods intended for a professional or specialised public, it is not disputed that the goods to which the trade mark application relates must be regarded as directed solely at persons operating in the metal-working industry.

Therefore, the only public likely to confuse the trade marks in question is formed of such operators'.

Example

Paints in general are sold both to professional painters (i.e. for business purposes) and to the public at large for 'do-it-yourself purposes'. By contrast, paints for industry do not target the general public. Therefore, when the specifications of the two marks cover paints in general

and paints for industry respectively, only professionals constitute the relevant public since they are likely to be the only consumers who encounter both marks.

Example

The services of the earlier mark are telecommunications. The contested services are telecommunication services, namely collocation, telehousing and interconnection services addressed at professionals only. The definition of the relevant public must be adjusted to the more specific list, and likelihood of confusion should be assessed for professionals only.

- If the relevant goods are pharmaceuticals the following applies: The relevant public of non-prescription pharmaceuticals (sold over the counter) is the general public, and the likelihood of confusion will be assessed in relation to that public.

The general public cannot be excluded from the relevant public, also in the case of pharmaceuticals that require a doctor's prescription prior to their sale to end-users in pharmacies. Thus, the relevant public comprises both general public and health professionals, such as doctors and pharmacists. Consequently, even though the choice of those products is influenced or determined by intermediaries, a likelihood of confusion can also exist for the general public, since they are likely to be faced with those products, even if that takes place during separate purchasing transactions for each of those individual products at various times. In practice, this means that the likelihood of confusion will be assessed against the perception of the general public, which is more prone to confusion.

In the case of pharmaceutical goods targeted only at specialists for professional use (e.g. sterile solutions for ophthalmic surgery), the likelihood of confusion must be assessed from the point of view of that specialist public only.

In cases where the pharmaceutical goods of the trade mark applied for are sold over the counter, while the pharmaceutical goods covered by the earlier registration would only be available on prescription, or vice versa, Sakpatenti must assume that the relevant public consists of both qualified professionals and the general public, without any specific medical and pharmaceutical knowledge. The likelihood of confusion will be assessed in relation to the general public, which is more prone to confusion.

Example

The goods covered by the earlier mark were pharmaceutical preparations with digoxin for human use for cardiovascular illnesses, while the contested goods were pharmaceutical preparations for the treatment of metabolic disorders adapted for administration only by intravenous, intra-muscular or subcutaneous injection.

Although both the goods of the earlier mark and the goods of the contested mark are prescribed by and administered under the supervision of healthcare professionals, the relevant public comprises both healthcare professionals and the general public.

3 Defining the Degree of Attention

For the purposes of the global assessment, the average consumer of the products concerned is deemed to be **reasonably well informed** and **reasonably observant and circumspect**, and that the relevant public's degree of attention is likely to vary according to the category of goods or services in question.

Whether its degree of attention will be **higher or lower will depend, inter alia, on the nature of the relevant goods and services and the knowledge, experience and purchase involvement of the relevant public.**

The fact that the relevant public consists of the **general public** does not necessarily mean that the degree of attention cannot be high (for instance, when expensive, potentially hazardous or technically sophisticated goods are purchased). Likewise, the fact that the goods at issue target **specialists** does not necessarily mean that the degree of attention is always high. It is true that, in principle, the professional public has a high degree of attention when purchasing a specific product. This is when these professional consumers are considered to have special background knowledge or experience in relation to the specific goods and services. Moreover, purchases made by professional consumers are often more systematic than the purchases made by the general public. However, this is not always the case. However, in some cases, for example, such as when the relevant goods or services are used by a given professional on a daily basis, the degree of attention paid may be average or even low even in relation to those professional consumers.

Properly defining the degree of attention of the relevant public is necessary, as this factor can weigh for or against a finding of a likelihood of confusion. Whilst the relevant consumer only rarely has the chance to make a direct comparison between the different signs and must rely on an imperfect recollection of them, a high degree of attention of the relevant consumer may lead to conclude that the relevant consumer will not confuse the marks, despite the lack of direct comparison between the trade marks. Therefore, the degree of attention will be established in the decision.

However, a **high degree of attention does not automatically lead to a finding of no likelihood of confusion.** All the other factors have to be taken into account (**interdependence principle**). For example, in view of the specialised nature of the relevant goods and/or services and the high degree of attention of the relevant public, likelihood of confusion may be ruled out. However, a likelihood of confusion can exist despite a high degree of attention. For example, when there is a strong likelihood of confusion created by other factors, such as identity or close overall similarity of the marks and the identity of the goods, the attention of the relevant public alone cannot be relied upon to prevent a likelihood of confusion.

3.1 Higher degree of attention

A higher degree of attention is usually connected with the following types of purchases: expensive purchases, the purchase of potentially hazardous or technically sophisticated goods. The average consumer often seeks professional assistance or advice when choosing or buying certain types of goods and services (e.g. cars, pharmaceutical products).

A higher degree of attention can also apply to goods when brand loyalty is important for the consumer.

3.1.1 Expensive purchases

When purchasing expensive goods, the consumer will generally exercise a higher degree of care and will buy the goods only after careful consideration. Non-specialised or non-professional consumers often seek professional assistance or advice when choosing or buying certain types of goods and services. The attention may be enhanced in cases of luxury goods and where the specific product is regarded as reflecting the social status of its owner.

Examples

Cars. Taking into consideration their price, consumers are likely to pay a higher degree of attention than for less expensive purchases. It is to be expected that these consumers will not buy a car, either new or second-hand, in the same way as they would buy articles purchased on a daily basis. The consumer will be an informed one, taking all relevant factors into consideration, for example, price, consumption, insurance costs, personal needs or even prestige.

Diamonds, precious and semi-precious stones. Consumers generally put a certain amount of thought into the selection of these goods. In many cases the goods will be luxury items or will be intended as gifts. A relatively high degree of attention on the part of the consumer may be assumed.

Financial services. These services target the general public, which is reasonably well informed and reasonably observant and circumspect. However, since such services are specialised services that may have important financial consequences for their users, the consumers' degree of attention would be rather high when choosing them.

Real estate services. The purchase and sale of property are business transactions that involve both risk and the transfer of large sums of money. For these reasons, the relevant consumer is deemed to possess a higher-than-average degree of attention, since the consequences of making a poor choice through lack of attentiveness might be highly damaging.

3.1.2 Potentially hazardous purchases

The impact on safety of goods covered by a trade mark (e.g. lights for vehicles, saws, electric accumulators, electric circuit breakers, electric relays) may result in an increase in the relevant consumer's degree of attention.

3.1.3 Brand loyalty

Furthermore, a higher degree of attention can be the consequence of brand loyalty.

Example

Although tobacco products are relatively cheap articles for mass consumption, smokers are considered particularly careful and selective about the brand of cigarettes they smoke, so a higher degree of brand loyalty and attention is assumed when tobacco products are involved. Therefore, in the case of tobacco products a higher degree of similarity of signs may be required for confusion to occur. The consumers of Class 34 goods are generally very attentive and brand loyal.

3.1.4 Pharmaceuticals

Insofar as pharmaceutical preparations are concerned, the relevant public's degree of attention is relatively high, whether or not issued on prescription.

In particular, *medical professionals* have a high degree of attentiveness when prescribing medicines. With regard to *non-professionals*, they also show a higher degree of attention, regardless of whether the pharmaceuticals are sold without prescription, as these goods affect their state of health.

3.2 Lower degree of attention

A **lower degree of attention** can be associated, in particular, with habitual buying behaviour. Purchase decisions in this area relate to, for example, inexpensive goods purchased on a daily basis.

The mere fact that the relevant public makes an impulse purchase of some goods (e.g. sweets) does not mean that the degree of that public's attention is lower than average.

Chapter 4 Comparison of signs

1 Introduction

Whether a likelihood of confusion exists depends on several interdependent factors, including (i) the similarity between the goods and services, (ii) the relevant public, (iii) the **similarity between the signs**, taking into account their distinctive and dominant elements, and (iv) the distinctiveness of the earlier mark.

This chapter deals with the comparison of signs. The purpose of comparing signs is to determine if the signs are identical (see paragraph 2 below), similar (see paragraph 3 below), or dissimilar (see paragraph 4 below).

Identity between the signs is a prerequisite for applying Article 5(a) of the Law if the goods or services are also identical ('double identity') and Article 5(b) if there is Likelihood of confusion (Identical signs/similar goods or services).

Similarity between the signs is a prerequisite for applying Article 5(b) and (c) of the Law (likelihood of confusion).

Dissimilarity between the signs excludes the likelihood of confusion. There is no need to examine further prerequisites of Article 5(b) and (c) of the Law

1.1 General Principles of Trade Mark Comparison

If the signs are not identical, it must be determined whether they are similar or dissimilar. A global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by them, bearing in mind their distinctive and dominant components.⁸⁵

It follows that signs are compared **visually** (see paragraph 3.4.1 below), **aurally** (see paragraph 3.4.2 below) and **conceptually** (see paragraphs 3.4.3 and 3.4.4 below).

Furthermore, when signs are compared, an assessment must be made of the distinctive character and dominance of their elements, if any, and the impact of these elements on the overall impression.

In light of the above, where the signs are not identical, they are, in principle, compared by assessing the distinctive and dominant character of the coinciding and differing elements, assessing the common features of and differences between the signs, and reaching a conclusion on similarity or dissimilarity.

In principle, the comparison has to lead to a finding on the **degree of similarity** in every aspect.

The degree of similarity between the signs may be decisive for the outcome of the decision. Even for identical goods and/or services, 'any similarity' may not be sufficient in itself to lead to a likelihood of confusion. The degree of similarity must be established at the very least for the **visual** and **aural** aspects as these may be decisive for assessing the likelihood of confusion, depending on the circumstances in which the goods and services at issue are normally marketed (see the Guidelines, Part B, Examination, Section 5, Double Identity and Likelihood of Confusion, Chapter 6, Global Assessment,).

In determining the degree of similarity, it is important to specify whether it is high (above average) or low (below average). However, even if it is average, the decision should say so,

⁸⁵ 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23

to avoid misunderstandings. A mere statement that ‘the signs are similar’ is not clear as it can be interpreted in two ways — either in the sense that they are similar to an average degree, or just in the general sense that there is (some) similarity allowing for further examination.

Accordingly, the degree of similarity must be specified as low, average or high. Synonyms can be used insofar as they are clear. However, the term ‘enhanced’ is not a synonym for ‘high’. Further degrees of similarity may be specified, for example, expressions like ‘only very low’ or ‘nearly identical’, if this is supported by the facts of the case and is conducive of the outcome. The wording, however, must be as clear as possible. This is not the case for expressions like ‘not particularly high’, which can be understood either as average’ or just ‘low’.

However, it is not always necessary to specify the degree of **conceptual** similarity. Depending on the particular circumstances, it may be sufficient to acknowledge similarity resulting from a semantic overlap or a similarity in a concept. If similarity arises from concepts of low distinctive character, this must be clearly indicated so that its relevance can be considered in the global assessment of the likelihood of confusion.

1.2 Signs to be compared and negligible elements

The signs have to be compared in the form in which they are protected, that is, in the form in which they are registered/applied for. The actual or possible use of the registered marks in another form is irrelevant when comparing signs.⁸⁶

The comparison should **cover signs in their entirety**. Consequently, it is wrong to discard comparing elements of signs just because they are, for example, smaller than other elements in the signs (unless they are negligible as explained below) or because they are non-distinctive.⁸⁷

Exceptionally, in the event of **negligible elements**, Sakpatenti may decide not to take such elements into consideration for the purposes of the actual comparison, after **having duly reasoned** why they are considered negligible. This is especially important where the negligible element is the common element in the signs. The notion of negligible elements should be interpreted strictly and, in the event of any doubt, the decision should cover the signs in their entirety.

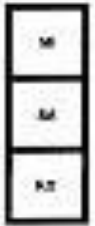






Sakpatenti considers that a negligible element refers to an element that, due to its size and/or position, is not noticeable at first sight or is part of a complex sign with numerous other elements (e.g. beverage labels, packaging) and, therefore, very likely to be disregarded by the relevant public.

Examples

Earlier sign	Contested sign	Case No
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⁸⁶ 09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 38

⁸⁷ 12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41-42; 13/12/2011, T-61/09, Schinken King, EU:T:2011:733, § 46

		<p>11/11/2009, T-162/08, EU:T:2009:432</p> <p>The words 'by missako' are almost illegible: the size and script make them difficult to decipher.</p>
	<p>LUNA</p>	<p>12/12/2011, R 2347/2010-2</p> <p>The element 'Rótulos Luna S.A.' was considered negligible.</p>
<p>MATHEUS MÜLLER</p>		<p>09/09/2010, R 396/2010-1</p> <p>The Board did not assess the elements '50 cl', '50 % vol.' 'ANNO' or '1857' phonetically or conceptually.</p>
<p>MAGNA</p>		<p>17/05/2006, R 1328/2005-2</p> <p>The Board described the contested sign in full, but negligible elements such as '70 cl' were not included in the comparison.</p>
		<p>03/09/2010, T-472/08, EU:T:2010:347</p> <p>The elements other than 'cachaça'/'pirassununga' and '51', the latter written in white within a circle that is itself partially within a broad band running from one side of the sign to the other, are negligible in the overall impression created by those marks (para. 65).</p>

It should also be noted that informative indications that the mark is registered (such as the symbols '™', and '®',) are not considered part of the mark. Consequently, such symbols will not be taken into account in the comparison of the signs.

2 Identity between the Signs

2.1 The concept of identity

As indicated above, a finding of identity between signs will lead to the success pursuant to Article 5(a) of the Law if the goods and services are also identical and pursuant to Article 5(b) if there is a likelihood of confusion (identical signs/similar goods or services).

Protection pursuant to Article 5(a) of the Law is absolute, because registration of a later identical sign for identical goods or services would compromise the function of the earlier mark as a means of identifying commercial origin. Where identical signs or marks are registered for identical goods or services, it is impossible to conceive of circumstances in which all likelihood of confusion could be ruled out. There is no need to consider any other factors, such as the degree of attention of the public or the distinctiveness of the earlier trade mark.

However, pursuant to Article 5(c) of the Law, the earlier trade mark is protected against the likelihood of confusion: even if the trade marks differ in some elements, their similarity — in combination with further elements that have to be assessed globally — may lead to the assumption that the relevant goods and services originate from the same or an economically linked undertaking.

Due to the absolute protection conferred by Article 5(a) of the Law, the concept of identity between trade marks must be interpreted strictly. The absolute protection in the case of an TM application which is identical with the [earlier] trade mark in relation to goods or services which are identical with those for which the trade mark is registered cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by [Article 5(c) of the Law].

2.2 Threshold for a finding of identity

The very definition of identity implies that the two signs should be the same in all respects. There is, therefore, identity between the signs where the TM application reproduces, without any modification or addition, all the elements constituting the earlier trade mark.

However, since the perception of identity between the two signs is not always the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between trade marks may go unnoticed by the average consumer.

Therefore, the TM application should be considered identical to the earlier trade mark ‘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’....

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


‘Insignificant’ is not an objective term, and its interpretation depends on the level of complexity of the trade marks being compared. Insignificant differences are those that, because they concern elements that are very small or are lost within a complex mark, cannot be readily detected by the human eye upon observing the trade mark concerned, bearing in mind that the average consumer does not normally indulge in an analytical examination of a trade mark but perceives it in its entirety.

The finding that an element is ‘insignificant’ must be accompanied by sufficient reasoning for its lack of impact on the global perception of the trade mark.

It follows from the definition of identity above that the following conditions have to be met in order for trade marks to be considered identical.

- **Complete identity between the signs.** Partial identity is not sufficient, but may lead to similarity between the signs and should be addressed when carrying out the examination of Article 5(c) of the Law. Any additional element is sufficient for concluding that the marks are not identical; it is immaterial whether the added element is a word, a figurative device or a combination of the two.

Consequently, two word marks will not be considered identical if one is contained within the other but is accompanied by further characters (see paragraph 2.4 below) or by words — irrespective of distinctiveness or possible descriptive character.

Earlier sign	Contested sign and comments	Case No
Millenium	MILLENIUМ INSURANCE COMPANY LIMITED It was found that 'the signs at stake were obviously not identical', even if 'Insurance company limited' was descriptive in English for the related services.	24/11/2011, R 696/2011-1
INDIVIDUAL		18/12/2008, R 807/2008-4
კრისტალი	პირველი კრისტალი	გამოგონილი მაგალითი

- **Identity in all aspects of comparison.** There must be identity between the signs in all relevant aspects of trade mark comparison, that is, visual, phonetic and conceptual. If the trade marks are identical in some aspects but not in others, they are not identical overall. In the latter case, they may be similar and, therefore, likelihood of confusion must be examined.

2.3 Identity between word marks

Word marks are marks consisting of letters, numbers and other standard typographic characters (e.g. '+', '@', '!') reproduced in standard typeface. This means that they do not claim any particular figurative element or appearance. Where both marks are registered as word marks, the typeface actually used by Sakpatenti concerned in the official publication is immaterial. Differences in the use of lower- or upper-case letters are, in general, immaterial. **Word marks** are identical if they coincide exactly in the string of letters, numbers or other typographic characters.

The following word marks are identical.

Earlier sign	Contested sign	Case No
BLUE MOON	Blue Moon	27/01/2011, R 835/2010-1

GLOBAL CAMPUS	Global Campus	23/01/2009, R 719/2008-2
DOMINO	Domino	18/03/2009, R 523/2008-2
Apetito	APETITO	04/05/2011, T-129/09, T:2011:193

Marks in Latin and Cyrillic characters must be considered as word marks. The following Cyrillic word marks are identical.

Earlier sign	Contested sign	Case No
ВАСИЛЬКИ	Васильки	31/01/2012, B 1 827 537

A difference of just one letter is sufficient for a finding of non-identity.

Earlier sign	Contested sign	Case No
NOVALLOY	NOVALOY	17/12/1999, B 29 290
HERBO FARMA	HERBOFARM	14/07/2011, R 1752/2010-1
მილკო	მილკა	გამოგონილი მაგალითი

Whether or not a space, a punctuation mark (e.g. hyphen, full stop) or an accent, or the use of a combination of upper - and lower-case letters that departs from the usual way of writing, introduces a difference so insignificant that it may go unnoticed by the consumer is assessed on a case-by-case basis, taking into consideration the relevant language. In some languages, a term can be written either together or with a space or hyphen (e.g. weekend versus week-end) so the public will not notice the difference. However, the use of a space, hyphen or accent, or the use of a combination of upper- and lower-case letters that departs from the usual way of writing, may change the meaning of the word element and therefore influence how the sign is perceived.

The following word marks **are not** identical.

Earlier sign	Contested sign	Case No
She, SHE	S-HE	23/09/2009, T-391/06, EU:T:2009:348
მზერა	მზე-რა	გამოგონილი მაგალითი



2.4 Word marks and figurative marks

A **word mark and a figurative mark**, even when both consist of the same word, will not be identical unless the differences are so insignificant that they may go unnoticed by the relevant public.

In the following examples the signs are clearly **not identical**.

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
	ELCO	13/03/2009, R 803/2008-1
eClear		09/02/2012, R 1807/2010-1
BIG BROTHER		10/05/2011, R 932/2010-4





However, the finding that trademarks are not identical can be more difficult if the figurative trademark is written in normal typeface. Nevertheless, in the following examples the trademarks were found **not** to be **identical**.



Earlier sign	Contested sign	Case No
	THOMSON	22/04/2009, R 252/2008-1
	Klepper	24/02/2010, R 964/2009-1

2.5 Identity between figurative marks

Two figurative marks are identical when both signs match in all their elements (shape, colours, contrast, shadowing, etc.)

It goes without saying that use of the same word will not suffice for a finding of identity when the figurative element is not the same. The following marks **are not** identical.

Earlier sign	Contested sign	Case No
		09/02/2012, R 558/2011-1
		31/03/2011, R 1440/2010-1

		12/04/2013, 7078 C
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However, since in the following case the difference in the presentation of the letters 'TEP' in italics would go unnoticed by the public, the marks were considered **identical**.





Earlier sign	Contested sign	Case No
		28/02/2013, B 2 031 741

2.6 Identity of an earlier black and white (B&W) or greyscale mark with a colour mark application





Sakpatenti has agreed on a Practice Paper with regard to the scope of identity of earlier B&W or greyscale marks with coloured versions of the same sign.

According to this Common Practice, the **differences** between an earlier B&W or greyscale mark and a coloured version of the same sign **will normally be noticed** by the average consumer, with the consequence that the marks are not considered identical. It is only under **exceptional circumstances** that the signs will be considered identical, namely where the differences in the colours or in the contrast of shades are so **insignificant** that a reasonably observant consumer will perceive them only upon examining the marks side by side. In other words, for the finding of identity the differences in the colour of the signs in question must be hardly noticeable by the average consumer.



Invented examples of **significant** differences with the consequence of no identity.

Earlier sign	Contested sign
	
	

Invented examples of **insignificant** differences with the consequence of identity.

Earlier sign	Contested sign
	
	

In relation to the findings above, the issue as to whether a trade mark registered in B&W or greyscale should be considered to cover all colours has also been addressed by the Court in a judgment (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199).

Earlier sign	Contested sign	Case No
		<p>09/04/2014, T-623/11, EU:T:2014:199</p>
<p>The Court considered that the fact that ‘the proprietor of a mark may use it in a colour or a combination of colours and obtain for it, as the case may be, protection under the relevant applicable provisions ... does not mean ... that the registration of a mark which does not designate any specific colour covers all colour combinations which are enclosed with the graphic representation’ (para. 39).</p> <p>In this particular case, the Court considered that the Board was right in finding ‘that one difference between the mark applied for and the first and second earlier marks lay in the fact that the mark applied for consisted, in part, of a yellow background with white vertical stripes’ (para. 40).</p>		

3 Similarity between the Signs

3.1 Introduction

The similarity of signs depends on the distinctiveness (see paragraph 3.2 below) and dominant character (see paragraph 3.3 below) of their components, and on other possible relevant factors. When comparing signs, their visual, phonetic and conceptual similarity must be assessed by weighing up the coinciding and the differing elements, and by taking into consideration their distinctiveness and dominance (see paragraph 3.4 below) as well as whether and to what extent these elements determine the overall impression conveyed by the marks.

3.2 Distinctive elements of the marks

The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. Therefore, the degree of distinctiveness of the various components of composite marks is an important criterion that must be considered within the trade mark comparison.

When assessing the similarity of signs, the degree of distinctiveness of their coinciding and differing components should be established because distinctiveness is one of the factors that determine the importance of those elements in each sign and, accordingly, their impact in the overall impression of the signs. A coincidence in a distinctive element and/or a difference in an element with no or little distinctiveness tend to increase the degree of similarity. A difference in a distinctive element tends to decrease the degree of similarity. The same applies where the coincidence found concerns an element with no or reduced distinctiveness.

Consequently, although trademark proprietors commonly use non-distinctive or weak elements as part of a trade mark to inform consumers about certain characteristics of the relevant goods or services, it may be more difficult to establish that the public may be confused as to origin due to similarities that solely pertain to non-distinctive or weak elements.

Therefore, in principle, the distinctiveness of all components of both the earlier **and** of the contested mark should be examined.

It is important to distinguish between the analysis of the distinctive character of (i) the component of a mark and (ii) the earlier mark as a whole. Analysing the components determines whether the signs in conflict coincide in a component that is distinctive (and therefore important), non-distinctive or weak (therefore being of less importance in the trademark comparison). The analysis of the earlier mark as a whole determines the scope of protection afforded to that mark, which is a separate consideration within the likelihood of confusion, independent from the comparison of the trademarks (see the Guidelines, Part B, Examination, Section 5, Double Identity and Likelihood of Confusion, Chapter 5, Distinctiveness of the Earlier Mark).

However, if either mark consists of one element only, the decision in the part dealing with the comparison of signs will establish whether the distinctiveness of that element is normal or lower than normal. In this case, it cannot be found that the element lacks distinctiveness. Regarding the earlier mark, this would amount to denying its distinctive character (.

3.2.1 What is a component of a sign

It is easy to identify components when a sign is visually divided into different parts (e.g. separate figurative and verbal components). However, the term 'component' encompasses more than these visual distinctions. Ultimately, the perception of the sign by the relevant public is decisive and a component exists wherever the relevant public perceives one. For example, the relevant public will often regard one-word signs as being composed of different components, in particular, where one part has a clear and evident meaning while the rest is meaningless or has a different meaning (e.g. in the mark EUROFIRT, 'Euro' will be widely understood as referring to Europe whereas 'Firt' is meaningless, giving this word mark two components: 'Euro' and 'Firt'). In such cases, the elements of one-word signs could be regarded as 'components'.

However, **words should not be artificially dissected**. Dissection is not appropriate unless the relevant public will clearly perceive the components in question as separate elements. A case-by-case assessment is required as to whether the division of a sign into components is artificial (e.g. whether splitting the word 'LIMEON' for fruit into the components 'LIME' and 'ON' would be artificial or not) (see also paragraphs 3.4.3.2 and 3.4.5.1 below).

3.2.2 Examination of distinctiveness

3.2.2.1 What is distinctiveness?

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, Sakpatenti must make an overall assessment of the **greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings.**

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies whereby a component of a sign can lack distinctiveness entirely, be fully distinctive (to a normal degree) or be at any point in-between.

At this point, it must be noted that it is not, in principle, Sakpatenti's practice to recognise a higher than average degree of inherent distinctiveness for individual components of signs. Any higher degree of distinctiveness (enhanced distinctiveness, reputation) is related to actual recognition of the mark by the relevant public, and is eventually examined only with respect to the earlier mark in the opposition proceedings. A mark or, by analogy, its components will not have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services.

An element of a sign is **not distinctive** if it is exclusively descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.) and/or if its use in trade is common for those goods and services. Similarly, an element of a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness.

An element of a sign may be **distinctive to a low degree (weak) if it refers to** (but it is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods might not materially affect distinctiveness, as in the following examples.

- 'Billionaire' for gaming services is allusive in a manner that would affect distinctiveness, because it implies, for instance, that you may become a billionaire.
- 'Billy O'Naire', which sounds identical to 'billionaire' in English, would be allusive for gaming services as a clever word-play on Irish names, in a manner that would not affect distinctiveness in a material way; it would be considered to have a 'normal' degree of distinctiveness.

An element of a sign that is neither non-distinctive nor weakly distinctive possesses a **'normal' degree of inherent distinctiveness**. This means that the element of a sign in question is fully distinctive, in the sense that its capacity to identify the goods and services covered by the mark as coming from a particular undertaking is not in any way diminished or impaired.

Low distinctive character of an earlier mark or its component may not be determined by the fact that there are many trade marks that consist of, or include, the element in question. Existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of registered data only, it cannot be assumed that all the trade marks have been effectively used.

3.2.2.2 Relevant goods and services

The assessment of the **inherent distinctiveness** of the components is carried out only for the goods or services that are identical or similar, that is:

- the earlier mark is assessed with respect to the registered goods and services that are identical or similar to the contested goods and services;
- the contested trade mark is assessed with respect to the contested goods or services that are identical or similar to those of the earlier mark.

3.2.2.3 General principles of examination of distinctiveness

The examination of inherent distinctiveness is carried out in two phases: first, it should be determined whether the relevant public recognises semantic content of the element at issue and, second, whether or not the semantic content perceived is related to and/or commonly used in trade for the identical or similar goods and services.

As regards the **first phase**, that is to say, whether the relevant public recognises a semantic content, the inherent distinctiveness of the components of the marks has to be evaluated by taking into account the perception of the relevant public in Georgia.

The **second phase** consists of correlating any meaning that the public perceives in the components with the identical or similar goods and services in dispute. If the relevant public perceives this meaning as descriptive, laudatory or allusive (in a manner that materially affects distinctiveness), etc. for these goods and services, then its distinctiveness will be diminished accordingly. It may be necessary to distinguish between the various goods and services involved because the finding of no or limited distinctiveness might relate to only part of those goods and services. In the event that no meaning can be attributed to a verbal element, it cannot be descriptive, laudatory or allusive in any way and as such is considered distinctive.

The criteria applied to examining the inherent distinctiveness of a component of a sign are the same as the relevant principles applied when examining marks on absolute grounds (see the Guidelines, Part B, Examination). However, in relative grounds, the question is not merely whether a component is distinctive or not (i.e. whether it reaches the minimum distinctiveness threshold for registration), but also to what degree it is distinctive within the sliding scale previously mentioned. Therefore, for instance, a term that is not descriptive but merely allusive for the goods or services in question might be distinctive enough to pass the absolute grounds test, but still have less than normal distinctiveness for the purposes of relative grounds.




The outcome of the examination of inherent distinctiveness will be one of the following.

- The component has **no distinctiveness** or has **less than normal distinctiveness**. See the examples below.
- The component has normal distinctiveness because it is neither non-distinctive nor weak for identical or similar goods or services.

As noted in paragraph 2.1 above, word marks consisting of a single word may still contain various components, some of which may be more distinctive than others.


3.2.2.4 Examples of descriptive components


Earlier sign	Contested sign	Case No
რონი	რონის პიცა	გამოგონილი მაგალითი

BYLY		14/04/2010, T-514/08, EU:T:2010:143
<p>G&S: Class 3</p> <p><i>Assessment of the element 'products':</i> '... the term "products" is not distinctive enough to be taken into consideration by the consumers' (para. 39).</p>		
Earlier sign	Contested sign	Case No
		22/06/2010, T-490/08, EU:T:2010:250
<p>G&S: Class 36</p> <p><i>Territory:</i> EU</p> <p><i>Assessment of 'CAPITAL MARKETS':</i> 'the relevant public, consisting of consumers who are very attentive, well-informed and familiar with basic English financial terminology, will attach little significance to the meaning of the words "capital" and "markets", which are descriptive of those services and which do not enable the commercial origin of the trade marks at issue to be identified' (para. 59).</p>		
Earlier sign	Contested sign	Case No
		11/01/2010, R 834/2009-1
<p>G&S: Classes 3 and 5</p> <p><i>Assessment of the earlier right:</i> even though the signs have some similarities, the expression 'NATURAL BRONZE' is descriptive of the purpose of the goods (tanning) for the goods in Class 3 (para. 31).</p>		
Earlier sign	Contested sign	Case No
	NATURAL BEAUTY FROM WITHIN	19/11/2010, R 991/2010-2
<p>G&S: Classes 3 and 5</p> <p><i>Assessment of the element 'NATURAL BEAUTY':</i> the element 'NATURAL BEAUTY' is a plain and essential indication of the kind and quality of the goods. The public understands the meaning of these two basic words as well as the combination thereof (paras 31-35).</p>		


Earlier sign	Contested sign	Case No
FORCE-X	FSA K-FORCE	04/02/2015, T-558/13, EU:T:2015:135
<p>G&S: Classes 9 and 12</p> <p><i>Assessment:</i> the word 'force', synonymous with strength and power, can describe one of the characteristics of the goods concerned. Furthermore, for some goods in Class 12, it must be held that that word can also designate one of their purposes</p>		
ინდიგო Indigo	HOTEL INDIGO	28.09.20, N72-3/2020
<p><i>Assessment of the element 'HOTEL':</i> '... the term "HOTEL" is not distinctive and will not be taken into consideration by the consumers'), Therefore, in the assessment of signs the term – HOTEL is not taken into account</p>		
EUROECHO	echo	28.09.20, N72-3/2020
<p><i>Assessment of the element 'EURO':</i> '... the term 'EURO" refers to something European, Therefore the consumer will dissect the word into two parts and pay more attention to the second verbal element – ECHO.</p>		

3.2.2.5 Examples of laudatory components

Earlier sign	Contested sign	Case No
	MAGIC SEAT	09/09/2008, T-363/06, EU:T:2008:319
<p>G&S: Class 12</p> <p><i>Assessment of the element 'MAGIC':</i> the word 'magic' will be perceived by the relevant public as a simple qualifier for the word 'seat' on account of its resemblance to the Spanish word 'mágico', which is purely laudatory (para. 39).</p>		
Earlier sign	Contested sign	Case No

STAR SNACKS		11/05/2010, T-492/08, EU:T:2010:186
<p>G&S: Classes 29, 30 and 32</p> <p><i>Assessment of the element 'STAR':</i> the word element 'STAR' is laudatory, as it merely constitutes (together with the remaining elements of the signs) a reference to high-quality food products (para. 52).</p>		


3.2.2.6 Examples of allusive components


Earlier sign	Contested sign	Case No
	WORLDLINK	27/02/2008, T-325/04, EU:T:2008:51
<p>G&S: Class 36</p> <p><i>Territory:</i> EU</p> <p><i>Assessment of the element 'LINK':</i> the element 'LiNK' of the earlier mark is not immediately descriptive of inter alia 'banking services for the dispensing of cash; funds transfer and payment services; financial information services' (Class 36) covered by the earlier mark, but merely allusive in relation to them (para. 68 et seq.).</p>		

3.2.3 Specific cases

3.2.3.1 Commonplace and banal elements

There are instances where signs are composed of one (or various) distinctive verbal element(s) and one (or various) figurative element(s) that are perceived by the relevant public as being commonplace or banal. These figurative elements frequently consist of a simple geometrical shape (e.g. frames, labels) or of colours frequently used in the market sector (e.g. red for fire extinguishers, yellow or red or orange for the postal sector). For this reason, these commonplace and banal elements are considered non-distinctive.

Earlier sign	Contested sign	Case No
ARCO		05/10/2011, R 1929/2010-2
<p>G&S: Class 9</p> <p><i>Assessment of figurative elements:</i> the verbal elements of the two signs coincide. Even if it is not negligible in terms of its size, the figurative element of the contested TM is likely to be perceived by consumers essentially as a mere decorative element, and not as an element indicating the commercial origin of the goods (para. 43). The marks are visually highly similar and phonetically and conceptually identical (paras 45-48).</p>		

Earlier sign	Contested sign	Case No
Curve		Chamber of Appeals of Sakpatenti 26.03.18, N4-3/18
<p><i>Assessment of figurative elements:</i> the difference between the verbal elements of the two signs is only one letter – R in the contested sign. The figurative element of the contested sign that is a basic geometric figure is considered as a weak element.</p> <p>The marks are similar visually, phonetically and conceptually.</p>		

3.2.3.2 Identical verbal elements accompanied by non-distinctive figurative elements

When comparing a word mark with a figurative mark containing an identical word element as its only word element, it is not necessary to assess the distinctiveness of the word if the figurative elements are not distinctive (mere colour, background or common typeface) and not dominant. In such cases, it is irrelevant that the word has only limited distinctiveness in relation to some goods and services in some languages, since this applies equally to both marks, while the figurative elements are clearly not sufficient to distinguish the marks.

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T- 277/11, EU:T:2012:295
<p>G&S: services related to travel, accommodation and congresses in Classes 35, 39, 41, 42, 43.</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> The Court did not go into the assessment of the inherent distinctiveness of the elements of the signs and agreed with the Board that the signs were visually highly similar and phonetically and conceptually identical (paras 83-92). The Board, therefore, correctly found the signs to be 'almost identical' (para. 93). The differentiating elements (the orange background and the particular way of writing) were considered to be insignificant.</p>		
Earlier sign	Contested sign	Case No
LEMON GOLD		21/11/2018, B 2 943 036, EUIPO

G&S: Class 31

Assessment: The earlier mark is entirely reproduced in the contested mark, where it is the only verbal component. Whether or not the identical verbal components are understood by the relevant public is immaterial since, given the present circumstances, they are on an equal footing regarding their distinctiveness. The only differences between the signs reside in the figurative elements of the contested sign, namely a lemon on a black, label-shaped, background. However, neither of these elements is distinctive given that lemons are the relevant goods and the label is a commonplace, banal shape. Consequently, the signs are aurally and conceptually identical, and visually highly similar.

3.2.3.3 One-letter components, numerals and short components

3.2.3.4 Disclaimers

When signs are being compared or a global assessment of the likelihood of confusion is being carried out, a disclaimer cannot have the effect of excluding, or attributing limited importance to, a trade mark component; the principle of the **overall impression** conveyed by the signs and the **actual perception** of the relevant public prevails⁸⁸. Consequently, a disclaimed element cannot be disregarded when signs are compared. In general, if a disclaimed element is indeed non-distinctive, taking it into account will not produce a different outcome⁸⁹. *However, where the disclaimed element is distinctive in Georgian (as it may happen with international registrations designating Georgia and containing a disclaimer), taking the disclaimed element into account in the comparison can produce a different outcome.*

3.2.3.5 Earlier marks, the distinctiveness of which is called into question

If the distinctiveness of the earlier mark is questioned, Sakpatenti applies the practice that, the validity of earlier trade marks may not be called into question. The elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness.

3.3 Dominant elements of the marks

It is Sakpatenti's practice to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean '**visually outstanding**'.

For a finding that there is a dominant element within a sign, the sign should have at least two identifiable components. The rules explained in paragraph 3.2.1 above apply accordingly.

The decision should establish whether there is a dominant element or codominant elements and identify them.

Sakpatenti's practice is to restrict the notion of dominant element to the visual impact of the elements of a sign, that is, to use it exclusively to mean 'visually outstanding' and to leave any other considerations for the overall assessment. As a result, practice is that the dominant character of a component of a sign **is mainly determined by its position, size, dimensions and/or use of colours**, to the extent that they affect its visual impact.

⁸⁸ 12/06/2019, C-705/17, ROSLAGSÖL, EU:C:2019:481, § 46-58, 62

⁸⁹ 12/06/2019, C-705/17, ROSLAGSÖL, EU:C:2019:481, § 53 and 55

With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.



The weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them.⁹⁰

Consequently, the fact that a component of a mark may or may not be considered non-distinctive (or as having a low degree of distinctiveness) has no bearing on the assessment of dominant character.




As a rule of thumb, the following should be considered:


- The assessment of dominant character applies to both signs under comparison.
- For a finding that there is a dominant component, the sign should have at least two identifiable components.
- Word marks have no dominant elements because by definition they are written in standard typeface. The length of the words or the number of letters is not an issue of dominance but of overall impression.
- Figurative elements may be dominant in signs where word elements are also present.
- Whether or not an element is visually outstanding may be determined in the visual comparison of the signs; if that is the case, it must be consistent with an evaluation of dominant character.
- Lastly, if it is difficult to decide which of the (at least) two components is dominant, this may be an indication that there is no dominant element or that no element is more dominant than the other (which includes cases of codominance). The establishment of dominant character implies that one component is visually outstanding compared to the other component(s) in the mark. If this applies to two or more components, they are codominant. If that assessment is difficult to make, it is because there is no dominant or codominant element(s).

Examples of cases

Sign	Dominant component and reasoning	Case No
	<p>RPT: 'the dominant element of the earlier marks is the acronym RPT, in which the letter "p" predominates' (para. 33).</p>	<p>04/03/2009, T-168/07, EU:T:2009:51</p>
	<p>Free: 'the word "free" dominates the visual impression created by the mark of which it forms part, because it is considerably larger than the other components and, in addition, is much easier to remember and pronounce than the slogan in question' (para. 39).</p>	<p>27/10/2010, T-365/09, EU:T:2010:455</p>

⁹⁰ 13/06/2006, T-153/03, Peau de vache, EU:T:2006:157, § 32

Sign	Dominant component and reasoning	Case No
	<p>Xtreme: 'Visually, it must be concluded that in the mark applied for, the term "XTREME" occupies a central position. Indeed, the size of its typeface is bigger than that of the other verbal elements, and the word is highlighted with a white outline ... The other verbal components "RIGHT GUARD" and "SPORT", are written in a much smaller type and are shifted to the right and towards the edge of the sign' (para. 55).</p>	<p>13/04/2005, T-286/03, EU:T:2005:126</p>
Sign	Dominant component and reasoning	Case No
 <p>(by missako)</p>	<p>GREEN by missako: 'It must be noted, as a first point, that the representation of the sun has an important place within the mark applied for, in that it is positioned in the centre and covers almost two thirds of the area. Next, the position of the word element "green" is also important within the mark, as it is portrayed in large-typeface, stylised upper case letters in black and takes up about one third of the area. As observed by the Board of Appeal in para. 28 of the contested decision, those two elements thus occupy the major portion of the mark applied for and are, therefore, striking in the overall impression of the mark. Lastly, as regards the word element "by missako", the Board of Appeal correctly held, in para. 28 of the contested decision, that those words were almost illegible because of their size and that the handwriting made them difficult to decipher. It follows, first, that the dominant nature of the word "green" and of the representation of the sun are thereby further reinforced and, secondly, that the word element "by missako" is negligible in nature' (paras 37-39).</p>	<p>11/11/2009, T-162/08, EU:T:2009:432</p>
Sign	Dominant component and reasoning	Case No
	<p>BÜRGER: The dominant element of the mark applied for is undeniably the word element in upper case letters that stands out, simply because of its position and the very large size of its lettering, from all the other elements that make up the label (para. 38).</p>	<p>18/09/2012, T-460/11, EU:T:2012:432</p>

Sign	Dominant component and reasoning	Case No
	<p>MATRIX: The term “MATRIX” occupies a central position. Indeed, the size of its typeface is bigger than that of the other verbal elements.</p>	28.07.2020, 50-3/2020

3.4 Comparison of signs

In the following paragraphs the application of the principles explained above will be explained with regard to the visual (see paragraph 3.4.1 below), phonetic (see paragraph 3.4.2 below) and conceptual comparison (see paragraphs 3.4.3 and 3.4.4 below). Thereafter, the impact of distinctiveness and dominant character of the common and differing elements (see paragraph 3.4.5 below) and other principles to be taken into account in the comparison of signs (see paragraph 3.4.6 below) will be presented

3.4.1 Visual comparison

Within the visual comparison it is important to note first that the public perceives word elements of a mark in a different way from other elements. Word elements can be read or associated with a sequence of letters. Other elements are just assessed as to their graphical or figurative characteristics. In the following, the principles of visual comparison will be presented depending on the type of trade marks involved.

3.4.1.1 Word marks versus word marks

A word mark is a mark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof, represented in standard script and layout, without any graphic feature or colour.

The protection of a word mark concerns the word as such. Therefore, it is irrelevant, for the purposes of the comparison of word marks, if one of them is written in lower-case letters and the other in upper-case letters.

Earlier sign	Contested sign	Case No (degree of similarity)
BABIDU	babilu	31/01/2013, T-66/11, EU:T:2013:48, § 57, 58 (high)
FRUTISOL	Solfrutta	27/01/2010, T-331/08, EU:T:2010:23, § 16, 17, 24 (low)
metabiarex	METABIOMAX	11/06/2014, T-281/13, EU:T:2014:440, § 41, 52-54 (low)

Nevertheless, where a word mark combines upper- and lower-case letters in a manner that departs from the usual way of writing (‘irregular capitalisation’), this must be taken into

account. The representation of the trade mark defines the subject matter of the registration. The perception of the relevant public, who will not fail to notice the use of irregular capitalisation, also cannot be disregarded.

Irregular capitalisation may have an impact on how the public perceives the sign, and consequently, on the assessment of similarity. The impact of irregular capitalisation on the comparison of signs is assessed on a case-by-case basis. For example, it may change the meaning of the word element in the relevant language and therefore influence how the sign is perceived.

Earlier sign	Contested sign	Case No
AIDAmia	Damia	31/03/2016, R 3290/2014-4
<p>G&S: Classes 12, 18, 25, 29, 30, 32, 35</p> <p><i>Territory:</i> EU</p> <p><i>Assessment:</i> Due to its specific spelling, the earlier sign will be divided by the consumer into the words 'aida' and 'mia'. The consumer will first and foremost perceive the 'AIDA' component of the earlier mark, which has no aural or visual equivalent in the contested sign (paras 36, 38, 45).</p>		

Hence, the use of irregular capitalisation may justify breaking down a single word into components, which may result in a relevant overlap with the conflicting mark (see paragraphs 3.4.3.2 and 3.4.5.1 below).

For word marks, the visual comparison is based on an analysis of the number and sequence of the letters/characters, the position of the coinciding letters/characters, the number of words and the structure of the signs (e.g. whether word elements are separated or hyphenated). However, the average consumer normally perceives a sign as a whole and does not proceed to analyse its various details. Therefore, small differences in the (number of) letters are often not sufficient to exclude a finding of visual similarity, particularly when the signs have a common structure.

In the following cases the marks were held to be visually similar.

Earlier sign	Contested sign	Case No (degree of similarity)
MEDINETTE	MESILETTE	13/06/2012, T-342/10, EU:T:2012:290 (average)
FORTIS	FORIS	17/03/2003, R 49/2002-4 (high)
MARILA	MARILAN	27/01/2011, R 799/2010-1 (high)
EPILEX	E-PLEX	24/05/2011, T-161/10, EU:T:2011:244 (average)
CHALOU	CHABOU	16/11/2011, T-323/10, EU:T:2011:678 (high)
კარფური	ფარფური	გამოგონილი მაგალითი

The following word marks are visually dissimilar.

Earlier sign	Contested sign	Case No
CAPOL	ARCOL	25/03/2009, T-402/07, EU:T:2009:85; 04/03/2010, C-193/09 P, EU:C:2010:121
<p>The Board held that although those marks shared the letter 'a' and the ending 'ol', they 'clearly differ[ed]' visually. The General Court agreed. It held that the same number of letters in two marks is not, as such, of any particular significance for the relevant public, even for a specialised public. Since the alphabet is made up of a limited number of letters, which, moreover, are not all used with the same frequency, it is inevitable that many words will have the same number of letters and even share some of them, but they cannot, for that reason alone, be regarded as visually similar. In addition, the public is not, in general, aware of the exact number of letters in a word mark and, consequently, will not notice, in the majority of cases, that two conflicting marks have the same number of letters (paras 81-82). The Court held that what matters in the assessment of the visual similarity of two word marks is the presence, in each of them, of several letters in the same order (para. 83). The ending 'ol' of the marks at issue constituted a common element of the marks but comes at the end and is preceded by completely different groups of letters ('arc' and 'cap' respectively), so the Board of Appeal correctly concluded that this commonality does not render the marks visually similar (para. 83). The Court of Justice upheld this assessment from a visual perspective (para. 74).</p>		

3.4.1.2 Word marks versus figurative marks with word elements

When figurative marks with word elements and word marks are compared visually, what matters is whether the signs share a significant number of letters in the same position and whether the word element in the figurative sign is highly stylised. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour.



In principle, when the same letters are depicted in the same sequence, any variation in stylisation has to be high in order to find visual dissimilarity.

The following marks were considered visually **similar** because there was no high variation in the stylisation of the word elements in the figurative marks and the word element was easily recognisable and legible.

Earlier sign	Contested sign	Case No (degree of similarity)
VITAFIT		25/10/2012, T-552/10, EU:T:2012:576 (average)
COTO DE IMAZ		04/02/2010, R 409/2009-1 (high)

vendus sales & communication group		15/07/2010, R 994/2009-4 (high)
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However, where the word in the figurative mark is highly stylised, the marks should be found visually **dissimilar**, as in the following examples.

Earlier sign	Contested sign	Case No
NEFF		20/09/2010, R 1242/2009-2
	NODUS	27/07/2007, R 1108/2006-4

The protection that results from the registration of a word mark concerns the word mentioned in the application for registration and not any specific graphic or stylistic elements that the mark might eventually adopt in the future. Therefore, the argument that a word mark may be used with a stylisation similar to that of the conflicting figurative mark, so that the signs would look more similar, cannot prosper.⁹¹

3.4.1.3 Figurative marks with word elements versus figurative marks with word elements

When comparing signs in terms of their word elements, Sakpatenti considers signs similar insofar as they share a significant number of letters in the same position and are not highly stylised or are stylised in the same or a similar manner. Similarity may be found despite the fact that the letters are graphically portrayed in different typefaces, in italics or bold, in upper or lower case or in colour⁹², appeal dismissed). In the following examples, the marks were considered visually similar because they shared some words or sequences of letters and the typeface was deemed not to be highly stylised.

Earlier sign	Contested sign	Case No (degree of similarity)
		03/09/2007, R1454/2005-4; confirmed 18/06/2009, T-418/07, EU:T:2009:208 (average)

⁹¹ see, in this regard, 20/04/2005, T-211/03, Faber (fig.) / NABER, EU:T:2005:135, § 37, 38; 13/02/2007, T-353/04, Curon, EU:T:2007:47, § 74





⁹² 18/06/2009, T-418/07, LiBRO, EU:T:2009:208; 15/11/2011, T-434/10, Alpine Pro Sportswear & Equipment, EU:T:2011:663; 29/11/2012, C-42/12 P, Alpine Pro Sportswear & Equipment, EU:C:2012:765

		<p>19/04/2016, T-198/14, EU:T:2016:222 (high); confirmed 10/11/2016, C-351/16 P, EU:C:2016:866</p>
		<p>16/01/2014, T-383/12, EU:T:2014:12 (high)</p>

In the following examples, however, the marks were considered visually **dissimilar** in spite of the fact that they shared some words and/or letters and/or figurative devices, because the shared letters were highly stylised and/or placed differently and/or there were additional figurative devices.

Earlier sign	Contested sign	Case No
		<p>11/05/2005, T-390/03, EU:T:2005:170</p>
		<p>23/01/2008, T-106/06, EU:T:2008:14</p>
		<p>05/03/2009, R 1109/2008-1</p>
		<p>02/08/2010, R 111/2010-4</p>





When comparing figurative signs with word elements visually, it is still possible to find visual similarity when the figurative elements are different (i.e. neither match nor have the same or similar contours) and the word elements are different. Similarity will be found when the overall stylisation, structure and colour combination render the signs visually similar overall. The following example illustrates how similar structure, stylisation and colour combination render signs visually similar.

Earlier sign	Contested sign	Case No (degree of similarity)
		29/09/2008, B 1 220 724 (high)
		26/03/2018, R 1563/2017-2 (high)

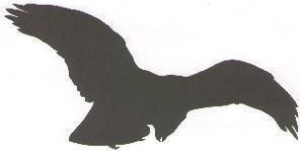

3.4.1.4 Purely figurative marks versus purely figurative marks

When comparing signs in conflict in terms of their **purely figurative elements**, Sakpatenti considers the latter as images: if they match in one, separately recognisable, element or have the same or a similar contour, it is likely that some visual similarity will be found.

The following purely figurative signs were found to be visually **similar**.

Earlier sign	Contested sign	Case No (degree of similarity)
		15/03/2012, T-379/08, EU:T:2012:125 (average)
		11/03/2009, B 1 157 769 (medium)







The following purely figurative signs were deemed to be visually **dissimilar**.

Earlier sign	Contested sign	Case No
		11/10/2010, B 1 572 059



3.4.1.5 Figurative marks with word elements versus purely figurative marks

A coincidence in a figurative element that is visually perceived in an identical or similar way may lead to a visual similarity.

The following examples are cases where there are visual similarities because of matching figurative elements.

Earlier sign	Contested sign	Case No (degree of similarity)
	  	<p>14/12/2006, T-81/03, T-82/03 & T-103/03, EU:T:2006:397 (significant)</p>
		<p>17/11/2010, R 144/2010-2 (low)</p>



In the following example the figurative elements were different and the signs were considered visually **dissimilar**.

Earlier sign	Contested sign	Case No
		<p>30/05/2002, B 134 900 The marks were considered visually dissimilar</p>

3.4.1.6 Figurative mark in black and white versus figurative mark in colour

The argument that the scope of protection of a black and white or greyscale mark would extend to all possible colours leading to a greater degree of visual similarity with a conflicting mark in



colour cannot be upheld. A mark that does not claim any specific colour cannot be considered to cover all colour combinations.⁹³

Earlier sign	Contested sign	Case No
		<p>09/04/2014, T-623/11, EU:T:2014:199</p>
<p>The registration of a mark which does not designate any specific colour cannot cover all colour combinations. The yellow colour of the background in the contested mark is one of the differences between the marks (paras 39-40).</p>		

3.4.1.7 Signs consisting of a single letter



In cases of conflicting signs consisting of the same single letter, the visual comparison is of decisive importance. The fact that the conflicting signs comprise the same single letter can lead to a finding of visual similarity between them, depending on the particular way the letters are depicted.

In the following examples, the signs were found to be visually similar to a high or medium degree.





Earlier sign	Contested sign	Case No
		<p>13/07/2004, T-115/02, EU:T:2004:234</p>
<p>G&S: Classes 9, 16, 25, 35, 41</p> <p><i>Assessment:</i> as regards the visual similarity of the conflicting signs, the Board of Appeal rightly considered that both marks in question include as a dominant element the lower-case white letter 'a', of a commonplace typeface, on a black background. That dominant element makes an immediate impression and is remembered. Conversely, the graphic differences between the trade marks in question — namely the shape of the background (oval for the trade mark applied for and square for the earlier trade mark), the position of the letter on that background (in the centre in the case of the trade mark applied for and in the lower right-hand corner in the case of the earlier trade mark), the thickness of the line used to represent that letter (the trade mark applied for uses a slightly broader line than that used in the earlier trade mark) and the calligraphic details of the letters of the respective marks — are minor and do not constitute elements that will be remembered by the relevant public as effective distinguishing features. Consequently, the conflicting signs are very similar from the visual point of view.</p>		

⁹³ (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 39; 26/03/2021, R 551/2018-G, Device (fig.) / Device (fig.), § 58)

In the following cases, the signs were found to be visually similar to a low degree (that resulted, depending on a particular case, in likelihood of confusion or no likelihood of confusion).

Earlier sign	Contested sign	Case No
		14/03/2017, T-276/15, EU:T:2017:163
<p>G&S: Class 25</p> <p><i>Assessment:</i> even though the signs can both be perceived as representing the letter 'e', they differ visually in their respective colours, typefaces and the overall impressions they convey (para. 25). The outcome of this case: likelihood of confusion for identical goods and services (this part of the BoA decision was not challenged before the General Court). No likelihood of confusion for the similar and dissimilar goods and services (inter alia, <i>electric energy emanating from wind power, plants for the production of renewable energy, leasing of wind power energy generating facilities</i>) for which the relevant public has a high degree of attention.</p>		

Finally, in the examples below the signs were found to be **visually dissimilar** due to the different stylisations or graphic elements of the single-letter signs. The final outcomes of these cases were those of no likelihood of confusion.

Earlier sign	Contested sign	Case No
		12/12/2007, R 1655/2006-4
<p>G&S: Class 25</p> <p><i>Assessment:</i> even though the marks share the presence of the letter 'm', they cannot be considered visually similar since the overall visual impression that each mark makes on the relevant public is clearly distinct. The TM applied for is a complex graphic device that includes a black lowercase letter 'm' and in addition, other significant figurative elements, namely a bold curved dark line placed above a background circle in which the letter 'm' is almost included. These additional elements are of particular importance since the heavy bold line echoes the form of the background circle and the dark shade of the letter 'm', which is placed over the background. In the earlier mark, the letter 'm' appears in outline font with a characteristic inclination to the right and an uneven height so that the right-hand side of the letter is lower. Consequently, these dissimilarities between the signs are sufficient for it to be held that they do not give the consumer the same visual impression (para. 18).</p>		
Earlier sign	Contested sign	Case No
		04/10/2010, R 576/2010-2; confirmed 24/01/2012, T-593/10, EU:T:2012:25

G&S: Classes 25, 41, 43

Assessment: due to the different colours, figurative element and stylisation, the marks were found to be visually dissimilar. Visually, the earlier mark can be perceived as a boomerang, accompanied by the letter 'B', which is the first letter of 'boomerang'.

The above considerations also apply to signs consisting of single numbers. Where 'one-letter/one-digit' signs are written out in letters, they are not considered equivalent to a sign where there is just a single element (e.g. 'ONE' is not equal to '1' or 'EM' to 'M'). Therefore, the abovementioned arguments are not directly applicable to such cases

~~It should be pointed out that the verbal representation of 'one-letter/one-digit sign' is not to be considered equivalent to the sign (e.g. 'ONE' is not equal to '1' or 'EM' to 'M'). Therefore, the aforementioned arguments are not directly applicable to such cases.~~

~~Finally, it must be noted that the above considerations also apply to signs consisting of single numbers.~~

3.4.1.8 Other types of marks

When comparing other types of marks (shape marks, motion marks, etc.), the same basic principles as for word and figurative marks as described above are to be applied.

3.4.2 Phonetic comparison

The overall phonetic impression produced by a sign is particularly influenced by the number and sequence of its syllables. The common rhythm and intonation of signs play an important role in how signs are perceived phonetically. The *Collins English Dictionary* defines 'rhythm' as 'the arrangement of words into a more or less regular sequence of stressed and unstressed or long and short syllables'. According to Georgian online dictionary rhythm is თანაბარზომიერი, პერიოდული მონაცვლეობა რაიმე ელემენტებისა (მაგ., მოძრაობათა, ბგერებისა და სხვ.) 'Intonation' is defined as 'the sound pattern of phrases and sentences produced by pitch variation in the voice'.

Therefore, the key elements for determining the overall phonetic impression of a trade mark are the syllables and their particular sequence and stress. The assessment of common syllables is particularly important when comparing marks phonetically, as a similar overall phonetic impression will be determined mostly by those common syllables and their identical or similar combination.

The following are examples of phonetically **dissimilar** marks.

Earlier sign	Contested sign	Case No
CLENOSAN	ALEOSAN	28/03/2011, R 1669/2010-2
GULAS	MARGULIÑAS	12/04/2011, R 1462/2010-2

The following are examples of phonetically similar/identical marks.

Earlier sign	Contested sign	Case No (degree of similarity)
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		<p>16/01/2014, T-528/11, EU:T:2014:10 (identity/average)</p>
<p>FEMARA</p>		<p>12/02/2010, R 722/2008-4 (above average)</p>
	<p>FOR US</p>	<p>16/09/2010, R 166/2010-1 (identity)</p>
<p>OLTERMANNI</p>	<p>Эльтермани</p>	<p>28.10.2020, N81-3/2020 Chamber of Appeals of Sakpatenti (similar)</p>





3.4.2.1 Signs and elements in signs that must be assessed

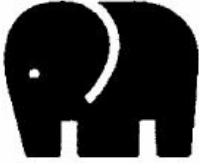
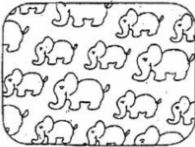
Sakpatenti conducts a phonetic comparison when both trade marks can be pronounced or have a sound. Accordingly, a figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. In other words, purely figurative marks (i.e. those not containing any word element) are not subject to a phonetic assessment. The ‘meaning’ that the image evokes, or its ‘description’, will be assessed visually and conceptually.

Sakpatenti does not undertake an indirect phonetic comparison, based on the description or a meaning attributed to the image by the public, given that in most cases, it is difficult to define which description the public will attribute to a figurative element and that the comparison based on such a description would lead to a subjective and arbitrary outcome. Furthermore, if the phonetic comparison is based on a description of a figurative element or on its meaning, it will only repeat the outcome of the visual or conceptual comparison respectively, where these elements have already been assessed.

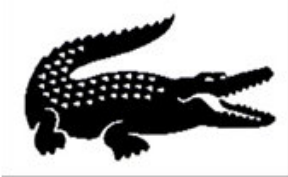

The following are examples of where no phonetic comparison could be made because the marks are purely figurative.



Earlier sign	Contested sign	Case No
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		25/11/2015, T-320/14, EU:T:2015:882
		08/10/2014, T-342/12, EU:T:2014:858

Earlier sign	Contested sign	Case No
		07/02/2012, T-424/10, EU:T:2012:58

Furthermore, when one of the signs has elements that can be read and the other has only figurative elements, the two signs cannot be phonetically compared directly, as in the following examples.

Earlier sign	Contested sign	Case No
		30/09/2015, T-364/13, EU:T:2015:738

Earlier sign	Contested sign	Case No
		17/11/2010, R 144/2010- 2

With regard to the pronunciation of figurative elements reminiscent of a letter, it should be noted that the relevant public will tend to read these figurative elements only when they are linked to or form part of a word known to the relevant public, such as in the following examples.

Earlier sign	Contested sign	Case No
ROCK		13/10/2009, T-146/08, EU:T:2009:398

In the following case, however, the figurative element will not be recognised and read as 'X' and the contested sign read as 'be light'.

Earlier sign	Contested sign	Case No
BECKs		30/05/2013, T-172/12, EU:T:2013:286

As a general rule, all word elements (including letters and numbers) are subject to the phonetic comparison. It may be the case, however, that the relevant public refers aurally to a sign by some elements and omits some words/letters.

For example, the relevant public may omit verbal elements that are clearly less prominent than ones that stand out visually, or are otherwise secondary in the overall impression given by the mark.

Furthermore, in its judgment of 03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342, the European General Court found that the public will not pronounce the words 'american blend' due to their **descriptive character**. In its judgment of 03/06/2015, in joined cases T-544/12, PENSA PHARMA, EU:T:2015:355 and T-546/12, pensa, EU:T:2015:355, the Court stated that consumers would not pronounce the word 'pharma', inasmuch as that word was superfluous because of the nature of the goods and services at issue.

Economy of language might be another reason for assuming that some elements will be pronounced while others will be omitted, particularly in case of very long marks.⁹⁴

Finally, while words, letters and numbers should in principle be assessed phonetically, some symbols and abbreviations give rise to uncertainty.

For example, the logogram '&' (ampersand) will generally be read and pronounced and therefore should be included in the phonetic comparison.

Earlier sign	Contested sign	Case No
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⁹⁴ 11/01/2013, T-568/11, interdit de me gronder IDMG, EU:T:2013:5, § 44

D&G	DNG	15/09/2010, R 160/2010-2 The ampersand ‘&’ will be pronounced and is recognised as the corresponding translation of the conjunction ‘and’.
ს & ს	ს დს ს	Invented example

The same goes for the typographic character @, which in principle will be pronounced.


Earlier sign	Contested sign	Case No
@HOME	VODAFONE AT HOME	30/08/2010, R 138/2010-2 @ will be pronounced as ‘at’ or ‘arobase’ (para. 21).

In the above case, it cannot be denied that a part of the relevant public — in particular who have at least basic knowledge of English — would read the ‘at’ symbol and thus pronounce the trade mark as ‘at home’. This possibility must, therefore, be taken into consideration, together with other possibilities such as ‘a home’ or simply ‘home’.

However, compare this with the following examples.



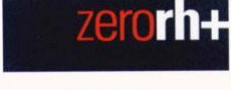
Earlier sign	Contested sign	Case No
FERCREDIT	f@ir Credit	03/02/2011, R 719/2010-1; dismissed 19/09/2012, T-220/11, EU:T:2012:444; dismissed 14/11/2013, C-524/12 P, EU:C:2013:874 The @ will be perceived as the letter ‘a’ by (at least) the EN public (para. 25).

Earlier sign	Contested sign	Case No
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		<p>20/07/2016, T-745/14, EU:T:2016:423</p> <p>The symbol '@' will easily be understood by the consumer as replacing the letter 'a' (para. 26).</p>
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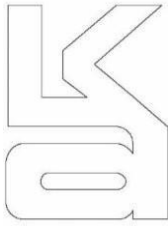


The plus (+) and minus/hyphen (-) symbols may or may not be pronounced by the relevant public, depending on the circumstances. The minus symbol may be pronounced when used in combination with a number, for example, '-1', but it will not be pronounced if used as a hyphen (as in 'G-Star').

In the following examples, the symbol '+' in the contested application would be pronounced as 'plus'.

Earlier sign	Contested sign	Case No
<p>AirPlus International</p>		<p>03/03/2010, T-321/07, EU:T:2010:64; dismissed 25/11/2010, C-216/10 P, EU:C:2010:719</p>
		<p>16/09/2009, T-400/06, EU:T:2009:331</p>

However, sometimes the way in which symbols — or letters — are used makes it unrealistic to assume that they will be read and pronounced in a particular way, for example, when in a figurative mark a symbol is repeated in order to create a pattern or is highly distorted or when the letters/numbers are otherwise not clearly legible/ identifiable. This is illustrated by the following examples.

Sign	Explanation
	<p>24/01/2012, T-593/10, EU:T:2012:25</p> <p>In this figurative mark, the letter 'B' can be read. The mark must, therefore, be assessed phonetically.</p>

	<p>24/01/2012, T-593/10, EU:T:2012:25</p> <p>In this figurative mark, the letter 'B' is so highly distorted that for part of the public it is difficult to clearly identify if it is indeed the letter 'b' or the figure '8'.</p>
	<p>22/06/2011, R 1779/2010-4</p> <p>It is very difficult to determine the pronunciation of the sign. An aural comparison may, therefore, lead to very different results, ranging from identity to dissimilarity.</p>
	<p>28/01/2009, B 1 127 416</p> <p>In this figurative mark the letter 'H' can be read and, therefore, must be assessed phonetically.</p>
	<p>28/01/2009, B 1 127 416</p> <p>In this sign, the pattern makes it unlikely that consumers will read an 'H' (or rather several 'H's). This mark cannot be assessed phonetically.</p>


Sign	Explanation
	<p>16/10/2013, T-282/12, EU:T:2013:533</p> <p>Although hardly legible at first sight, the words 'FREE' and 'STYLE' in both of the signs are pronounced identically.</p>

In summary, whether or not a given symbol/letter is pronounceable depends on the type of character in question, how it is depicted, and how it is combined with other elements of the sign.

3.4.2.2 Identical/similar sounds in different order

Where the opposing trade marks are formed of syllables or words that are identical or highly similar but in a different order, so that if just one of the syllables or words were rearranged the signs would be identical or highly similar phonetically, the conclusion should be that the signs are phonetically similar.

Examples

Earlier sign	Contested sign	Case No (degree of similarity)
VITS4KIDS	Kids Vits	09/12/2009, T-484/08, EU:T:2009:486, (para. 33).; dismissed 22/10/2010, C-84/10 P, EU:C:2010:628 (significant)
		11/06/2009, T-67/08, (para. 39).EU:T:2009:198 (high)

3.4.2.3 Signs consisting of or including foreign or invented words



When a sign contains foreign words, it should be assumed in principle that the relevant public is unfamiliar with how foreign native speakers pronounce their own language. Accordingly, the public will tend to pronounce a foreign word in accordance with the phonetic rules of Georgian language.

Earlier sign	Contested sign	Case No
LIDL	LIFEL	19/10/2010, R 410/2010-1 The first two letters and the last one are the same in both marks. Aurally, the similarity is even stronger because LIDL will often be pronounced as if spelt LIDEL. For phonological reasons, 'D' and 'L' are nearly impossible to pronounce in most languages without inserting a vowel between them. Therefore, the marks would be pronounced LIFEL and LIDEL.

As regards **invented or fanciful words** (words that do not correspond to any existing word known by the relevant public), the relevant consumer might pronounce them not only as they would sound according to the rules of pronunciation of their mother tongue but also as they are written.

3.4.2.4 Single letter signs

Marks consisting of a single letter can be compared phonetically. The following marks are phonetically identical insofar as they both reproduce the letter 'A'.

Earlier sign	Contested sign	Case No
		13/07/2004, T-115/02, EU:T:2004:234

3.4.3 Conceptual comparison: the semantic content of marks

Two signs are identical or similar conceptually when they are perceived as having the same or analogous semantic content (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24)⁹⁵. The 'semantic content' of a mark is what it means, what it evokes or, when it is an image or shape, what it represents. In this text the expressions 'semantic content' and 'concept' will be used indiscriminately.

If a mark consists of various elements (e.g. a word and a figurative element) the concept of each of the elements must be defined. However, if the mark is a meaningful expression (made up of two or more words), what matters is the meaning of the expression as a whole and not of each of the words in isolation.

The conceptual comparison may be influenced by the relevant goods and services. For example, if a term has many meanings, one of which is of particular significance to the relevant goods and services, the conceptual comparison may focus on this meaning. In any event, what matters is how the term is perceived by the relevant public. A link between the goods and services and what the sign means, evokes or represents must not be forced or artificially constructed. For example, if the relevant goods relate to *lighting* and the sign is or contains the element 'LED', 'light-emitting diode' is one of the various possible meanings of 'LED'. Therefore, the conceptual comparison may focus on this meaning.

3.4.3.1 The semantic content of words

When the mark consists of or contains a word, the first step for an examiner is to look up the explanation of that word in dictionaries and/or encyclopaedias. If the word is in the dictionary/encyclopaedia, the described meaning will be its semantic content.





For instance, in the following scenarios, languages other than the predominant one are to be taken into account.

- When the word in another language is very close to the equivalent word in the official language of the relevant territory. For example, the English word 'Alcohol' will be understood in Georgia because it is very close to the Georgian equivalent word, - „ალკოჰოლი“.
- When the word in a foreign language is commonly used in the relevant territory. For example, the word 'bravo' is commonly used as a term denoting praise, in the sense of 'well done' in Georgia.
- When it is known that the relevant public is familiar with a foreign language. For example, the general public in Georgia has at least a basic understanding of the English and Russian language.

⁹⁵ 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24

- When it is known that the relevant public is familiar with a certain language for certain classes of goods and/or services. For example, English IT terms are normally understood by the relevant public for IT goods and services, irrespective of territory.
- Very basic words, which will be understood in Georgia because they have become internationally used, such as ‘baby’, ‘love’, ‘one’, the Italian word ‘pizza’, which has also entered the Georgian language, etc.
- Finally, when any one of the parties submits evidence that a word is known by a relevant portion of the relevant public.

The following are **examples** of concepts behind words.

Sign	Concept	Case No
 STAR SNACKS	The terms ‘star snacks’ and ‘star foods’ will be understood as referring to quality food not only by English speakers, but also by most of the relevant public.	11/05/2010, T-492/08 (Star foods I), EU:T:2010:186 10/10/2012, T-333/11 (Star Foods II), EU:T:2012:536
 	There is some degree of conceptual similarity, based on ‘Mc’ and the words ‘baby’ and ‘kids’ that both refer to children (para. 42).	05/07/2012, T-466/09, EU:T:2012:346
ლაღიძის წყლები ВОДЫ ЛАГИДЗЕ LAGIDZE'S WATER		27.05.2021, 141-3/2020 Chamber of Appeals of SAKPATENTI
<p>Signs are significantly dissimilar conceptually. Contested sign is a Georgian word meaning - “Free”. Earlier sign is Georgian name and surname. Both signs are Georgian words, and difference between them is easily perceptible by the relevant public.</p> <p>The signs are visually and phonetically similar to a certain degree, however the conceptual difference outweighs those similarities and creates different overall impression,</p>		

As shown in some of the examples above, it is not always necessary to give a complete dictionary definition of what a word means. It is sufficient to use a synonym.

Additionally, when part of the public will perceive the concept while another part either will not or will perceive a different meaning, a distinction should be made accordingly.


When the mark conveys a **meaningful expression**, the meaning of the expression as a whole, as long as it is understood as such by the relevant public, and not that of the individual words, is the one that is relevant for the conceptual comparison (however, note the exception below concerning expressions in foreign languages). Therefore, individual assessment of each element of the mark should be avoided.

Fictional example: 'KING'S DOMAIN' v 'KING SIZE'.

Incorrect assessment: 'KING' means 'a male sovereign', 'DOMAIN' means 'a territory over which rule or control is exercised' and 'SIZE' means 'the physical dimensions, proportions, magnitude, or extent of an object'. The marks are conceptually similar insofar as they share the notion of 'king'.

Correct assessment: 'KING'S DOMAIN' means 'a territory under the control of a king'; 'KING SIZE' means 'larger or longer than the usual or standard size'. The marks are conceptually dissimilar even though they share the word 'KING'.

This is further illustrated by the following example from case-law:

Earlier sign	Contested sign	Case No
BLACK TRACK		06/03/2015, T-257/14, EU:T:2015:141
<p>G&S: Class 28</p> <p><i>Assessment:</i> The English-speaking public will perceive the expression 'black jack' as a whole designating a card game and will not perceive the word 'black' independently within that expression. The expression constituting the earlier mark, 'black track', will also be perceived with its distinct meaning. Therefore, it cannot be held that the signs are conceptually similar just because they both contain the word 'black'. The signs are conceptually dissimilar (paras 38-42).</p>		

Furthermore, when the mark is composed of a noun and a qualifying adjective, in general it will be perceived as a conceptual unit and will not be broken down into its constituent elements.

Earlier sign	Contested sign	Case No
მზიანი დღე	განკითხვის დღე	Invented example
EAU PRECIEUSE	NUIT PRECIEUSE	12/09/2018, T-905/16, EU:T:2018:527 (02/05/2019, C-739/18 P, EU:C:2019:356, appeal dismissed)

G&S: Class 3

Assessment: The relevant public will clearly perceive the meaning of each of the signs at issue as a complete phrase containing a noun, 'nuit' and 'eau' respectively, with an identical qualifying adjective, namely 'précieuse'. While the first sign refers to the concept of water that is precious, the second refers to the idea of a cherished or esteemed night. Those are different concepts and, regard being had to their obvious meaning, the relevant public will not dissect those signs in order to distinguish each element of them (paras 62-64).

3.4.3.2 The semantic content of parts of words



In this regard, the General Court has held that, although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements which, for them, suggest a specific meaning or which resemble words known to them.⁹⁶

Consequently, while the rule is that marks are perceived as a whole, the exception to the rule is that, under certain circumstances, consumers could break them down into smaller parts. Since this is an exception, it has to be applied restrictively.

It will be applied in the following cases:

- when a visual separation assists in identifying parts with a concept (e.g. through the use of lower- and upper-case letters, the stylisation of letters or the use of a special character separating the elements, such as a symbol, numeral, hyphen or other punctuation mark);
- when, without a visual separation, all the parts of the word suggest a concrete meaning known to the relevant public; or
- when, without a visual separation, one part of the word has a clear meaning.

i) Examples of signs where a visual separation assists in identifying parts.


Sign	Concept	Case No
	The use of capital letters allows the sign to be separated immediately into two distinct words, namely 'invest' and 'hedge'.	1/06/2009, T-67/08, EU:T:2009:198, § 35
VITS4KIDS	The mark contains VITS (allusive of 'vitamins') and KIDS.	09/12/2009, T-484/08, EU:T:2009:486
	AGRO: reference to agriculture HUN: reference to Hungary UNI: reference to universal or union.	24/03/2010, T-423/08, EU:T:2010:116

ii) Examples of signs where, despite the absence of a visual separation, the single word can be broken down into parts, **all** of which suggest a concrete meaning known to the relevant public.

⁹⁶ 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 57

Sign	Concept	Case
Ecoblue	The word element 'eco' is a common prefix or abbreviation, while the word 'blue' is English for the colour blue and part of the basic English vocabulary known to the relevant public.	12/11/2008, T-281/07, EU:T:2008:489; dismissed 22/01/2010, C-23/09 P, EU:C:2010:35
Sign	Concept	Case
Solfrutta / FRUTISO L	The elements 'sol' and 'frut' are generally recognisable and can be understood as alluding to 'sun' and 'fruit' respectively.	27/01/2010, T-331/08, EU:T:2010:23
მუკუზანის ვაზი	The term 'mukuzani vine' in the mark applied for refers directly, so far as the relevant public is concerned, to grapevine products and, more particularly, Mukuzani wine.	Invented example

iii) Examples of signs where **one** part of the single word has a clear meaning. These are usually signs that include a common prefix or suffix.

Sign	Concept	Case No
	'DERMA' may be perceived as referring to goods of a dermatological nature.	03/04/2009, B 1 249 467
RNAiFect	The relevant public, particularly the specialist public, will perceive the first three letters as a reference to the English abbreviation for ribonucleic acid.	28/10/2009, T-80/08, EU:T:2009:416
nfon	The relevant public will isolate the syllable 'fon' in the sign 'nfon', and perceive this term as relating equally to the words 'telephone' or 'phone.' (para. 60).	29/01/2013, T-283/11, EU:T:2013:41; dismissed 16/01/2014, C-193/13 P, EU:C:2014:35

As explained above, all three exceptions have to be construed narrowly; therefore, where it is not obvious that a part or parts suggest(s) a concrete meaning known to the relevant public, a sign should not be artificially dissected. In the examples below, no concept was found in the signs.




Sign	Concept	Case No
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ATOZ	The TM will not be perceived as 'from A to Z'. The letters 'to' (corresponding to an English preposition) do not stand out in any way from the letters 'a' and 'z'.	26/11/2008, T-100/06, EU:T:2008:527; dismissed 16/09/2010, C-559/08 P, EU:C:2010:529
SpagO	The word 'SpagO' is an invented word that has no meaning in Georgian. It should not be perceived as a combination formed by SPA + GO.	12/11/2009, T-438/07, EU:T:2009:434
CITRACAL --- CICATRAL	The word elements 'cica' and 'citra' do not have any concrete meaning, any more than the endings 'tral' and 'cal'. The signs at issue are, therefore, not likely to be broken down by the public into word elements that have a concrete meaning or resemble words known to it and that, together, would form a coherent whole giving a meaning to each of the signs at issue or to any one of them.	11/11/2009, T-277/08, EU:T:2009:433

3.4.3.3 The semantic content of misspelt words

It is not necessary for a word to be written properly for its semantic content to be perceived by the relevant public. For example, while the written word 'XTRA' is visually not the same as the 'correct' word 'EXTRA', because it is aurally identical to it, the concept of the 'correct' word (extra) will normally be transferred to the misspelt word (xtra).

The following examples illustrate this point.

Sign	Concept	Case
	Part of the relevant public will regard it as a reference to the English word 'store', meaning 'shop, storage'.	21/01/2010, T-309/08, EU:T:2010:22
	The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public.	15/04/2010, T-488/07, EU:T:2010:145
	The term contained in the mark will bring to consumers' minds the idea of 'yogurt', i.e. 'a semi-solid, slightly sour, food prepared from milk fermented by added bacteria'.	14/07/2009, B 1 142 688

Sign	Concept	Case
<p>C@risma</p> 	<p>The words 'KARISMA' and 'C@RISMA' refer to 'charisma' or 'charism', i.e. a special personal quality or power of an individual, making him or her capable of influencing or inspiring large numbers of people.</p>	<p>28/10/2008, B 1 012 857</p>

Examiners should take care when attaching meaning to a misspelt word: the meaning is not likely to be transferable when the words are not (aurally) identical and/or when the misspelt element cannot be perceived independently.

Sign	Concept	Case No
<p>Bebimil</p>	<p>The mark applied for does not contain the word 'baby' but a fanciful word, which is further removed and without any clear and specific meaning, i.e. 'bebi'.</p>	<p>16/09/2006, T-221/06, EU:T:2009:330</p>

3.4.3.4 The semantic content of names and surnames

In line with the broad definition of a 'concept' (paragraph 3.4.3), a sign perceived as a personal name has the concept of a person (male or female) bearing that particular name, even if the name does not designate any well-known personality. A conceptual comparison between marks containing personal names that do not designate well known personalities is therefore possible. This, however, is only relevant for the conceptual comparison in a situation where both signs share the same particular first name or surname (e.g. John / John Smith or Smith / John Smith) or contain mere variants of the same first name or surname (e.g. Ann / Ana Kapanadze, Misha / Mikheil Beridze or Kakabadze / Giorgi Kakabadze).

Just because a first name or a surname is not in use in Georgia does not prevent it from being perceived as a foreign first or surname provided that there are sufficient indications to support that finding. This is particularly the case with first names or surnames recognised after internationally known personalities or where a close equivalent exists in the country.

In addition, if the sign is perceived to be the name of a well-known personality or has a distinct (current) meaning, that specific concept is also relevant and must be taken into account.

Sign	Concept	Case No
<p>PICASSO</p>	<p>The word sign PICASSO has a clear and specific semantic content for the relevant public. The reputation of the painter Pablo Picasso is such that it is not plausible to consider, in the absence of specific evidence to the contrary, that the sign PICASSO as a mark for motor vehicles would, in the perception of the average consumer, override the name of the painter.</p>	<p>22/06/2004, T-185/02, EU:T:2004:189; Dismissed 12/01/2006, C-361/04 P, EU:C:2006:25</p>

MESSI	The fame of Lionel Andrés Messi Cuccittini is a relevant factor to be taken into account in the conceptual comparison (paras 47-48).	17/09/2020, C-449/18 P & C-474/18 P, MESSI (fig.) / MASSI et al., EU:C:2020:722
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However, the fact that the signs at issue are perceived, for example, as mere ‘names’, ‘male / female first names’ or ‘Italian surnames’, does not confer any relevant concept on the signs for the purposes of the conceptual comparison. As such, just because ‘Thomas’ and ‘Michael’ are both ‘male first names’, this does not contribute any relevant concept for the purposes of comparison.


Examples of conceptual comparison:

Sign	Concept	Case No
TM application: Antonio Basile Earlier mark: BASILE	The signs are conceptually similar in that they share the same surname.	28/06/2012, T-133/09, EU:T:2012:327 & T-134/09, EU:T:2012:328
TM application: David Sarajishvli Earlier mark: Sarajishvli		Invented example



3.4.3.5 The semantic content of figurative, shape and colour marks

The concepts of marks consisting of or containing figurative elements and marks consisting of shapes (three-dimensional marks) will be what those figurative elements or shapes represent, such as in the following examples.

Sign	Concept	Case No
	The representation of a red mug on a bed of coffee beans.	25/03/2010, T-5/08 & T-7/08, EU:T:2010:123
	Part of the relevant public may recognise a peacock.	21/04/2010, T-361/08, EU:T:2010:152


	<p>The contested trade mark will be described as a businessman playing football.</p>	<p>02/12/2009, R 403/2009-2</p>
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Consequently, when a mark has both words and images, all concepts have to be assessed.

Sign	Concepts	Case No
	<p>The word 'ugli' in the earlier mark is likely to be associated with the English word 'ugly' by the relevant public.</p> <p>A bulldog with a citrus fruit in front of it.</p>	<p>15/04/2010, T-488/07, EU:T:2010:145</p>
	<p>The term 'Rioja' in the earlier mark, which is itself conceptually strengthened by the representation of a bunch of grapes and a vine leaf, refers directly to grapevine products and, more particularly, to Rioja wine.</p>	<p>09/06/2010, T-138/09, EU:T:2010:226; dismissed 24/03/2011, C-388/10 P, EU:C:2011:185</p>

3.4.3.6 The semantic content of numbers and letters


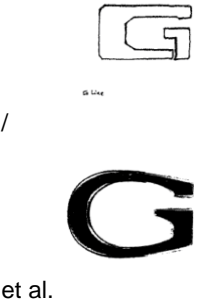
The concept of a word representing a number is the figure it identifies, such as in the examples below.

Sign	Meaning
	<p>The word zero evokes the cardinal number 0.</p>

The concept of a figure is the number it identifies, unless it suggests another concept such as a specific year.

Sakpatenti follows the approach that single letters can have an independent conceptual meaning. The Court has confirmed this approach (08/05/2012, T-101/11, G, EU:T:2012:223, § 56; 21/03/2013, C-341/12 P, G, EU:C:2013:206, appeal dismissed), finding conceptual identity where both trade marks can be seen as the same letter.


Sign	Meaning	Case No
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	<p>For the part of the relevant public that interprets the signs as the letter 'e' and the part of the relevant public that interprets them as the letter 'c', the signs are conceptually identical (para. 99).</p>	<p>10/11/2011, T-22/10, EU:T:2011:651</p>
	<p>The signs were considered conceptually identical (paras 60-61).</p>	<p>10/05/2011, T-187/10, EU:T:2011:202</p>

3.4.3.7 The semantic content of geographical names

The names of cities, villages, regions and other geographic areas evoke a concept that may be relevant for conceptual comparison if it is likely that the relevant public will recognise them as such. Usually, the general public is familiar with the names of capitals and bigger cities as well as holiday or travel destinations.

A lack of evidence or indication that the relevant public recognises the geographical name does not influence the conceptual comparison, as in the following example.

Sign	Concept	Case No
	<p>The result of conceptual comparison is neutral. It is not possible to infer from the appellant's argument that the name 'Chtoura' designates an agricultural area in Lebanon renowned for its agricultural products that this meaning will also be familiar to trade circles..</p>	<p>08/05/2010, R 1213/2008-4</p>

3.4.3.8 The semantic content of onomatopoeias

The analysis of the semantic content of onomatopoeias follows the general rules for conceptual comparison: their concept will be that depicted by the onomatopoeia in question, provided it can be established that it will be recognised as such by the relevant public. For instance, 'WOOF WOOF' represents the bark of a dog; 'MUUU' represents the mooing of a cow.

In some cases, the context in which the onomatopoeia will be used can be decisive for establishing whether the relevant public will recognise its meaning. For instance, in the following case, the EUIPO Board of Appeal considered that the relevant public would not interpret the sign 'PSS' as onomatopoeia in the context of information technology services.

Sign	Concept	Case No
PSS	The applicant's argument that the earlier mark could also be pronounced as an onomatopoeia [prompting another to be quiet] is far-fetched in view of the relevant information technology services at issue and the relevant public, who is accustomed, as noted by the applicant itself, to acronyms in this field (para. 42).	15/09/2008, R 1433/2007-2

3.4.4 How to make a conceptual comparison

In essence, when making a conceptual comparison, first it has to be determined if the signs have a concept in accordance with the principles described in the previous paragraph.

- If both signs have a concept, the conceptual comparison can lead to three possible outcomes.
 - If the signs, each as a whole, refer to the same concept, they are conceptually identical.
 - If the signs refer to similar concepts, they are conceptually similar.
 - If both signs have a meaning and each refers to different concepts, they are conceptually dissimilar/not similar.
- If only one of the signs evokes a concept, the signs are conceptually dissimilar/Not similar.
- If neither sign has any concept, a conceptual comparison is not possible. The conceptual aspect does not influence the assessment of the similarity of the signs.

As also explained in paragraph 3.4.5.2 below, the fact that **the signs have a descriptive or otherwise non-distinctive element in common** does not suffice to deny all conceptual similarity between them. This fact does not alter the conceptual content of the signs. Nevertheless, depending on the circumstances of the particular case, for example where the only non-distinctive element in common is accompanied by a meaningful distinctive element, the marks may, exceptionally, be found conceptually dissimilar.

The signs cannot be considered conceptually similar on the sole ground that a generic term covering both of them exists and/or they fall under the same general category of signs. If the semantic meanings are too different, the signs may share a general concept, but one so broad that the conceptual relationship is not relevant, as in the following cases.

- The mere fact that two words or symbols can be grouped under a common generic term by no means makes them conceptually similar. For example, an apple and a pear had features in common, both being fruits that are closely related in a biological sense and are of similar size, colour and texture, such common features had a very limited influence on the overall impression. Relevant public would notice such common features only after a detailed analysis. Furthermore, apples and pears are not the only fruit that can be red, yellow or green, and the same applies to the comparable size and texture. Consequently, these elements are insufficient to counterbalance the clear conceptual differences between the marks, which thus rendered them conceptually dissimilar.⁹⁷
- The same happens when two signs belong to the same general category or type of mark: the fact that 'TDL' and 'LNF' are both three-letter abbreviations is conceptually irrelevant and therefore, a conceptual comparison is not possible.
- Another example of signs 'belonging to the same category' concerns names and surnames that have a similar semantic content (see paragraph 3.4.3.4 above). If FRANK and MIKE are compared, the fact that they are both names is conceptually irrelevant (since they are on completely different levels).



⁹⁷ 31/01/2019, T-215/17, PEAR (fig.) / APPLE BITE (fig.) et al., EU:T:2019:45, § 77-79

In particular, the marks will be conceptually identical or similar in the following situations.



3.4.4.1 Both marks share a word and/or expression



When the two marks share the same word or expression, the marks will be conceptually similar, as in the following examples.

Earlier sign	Contested sign	Opposition No
სასტუმრო მზე	მზე საქართველო	Invented example
Similar: the marks share the concept of Georgian word „მზე“ (= sun: ‘the star that is the source of light and heat for the planets in the solar system’).		
Earlier sign	Contested sign	Case No
BLUE	ECOBBLUE	12/11/2008, T-281/07, EU:T:2008:489; dismissed 22/01/2010, C- 23/09 P, EU:C:2010:35 (EU)
The marks at issue are conceptually similar because they both refer to the colour blue.		

Earlier sign	Contested sign	Opposition No
		29/09/2008, B 1 220 724 (BL, BX, CY, CZ, DE, ES, FR, HU, RO, SK and IT)
The marks above are conceptually similar because both signs have an image of the same fish (a shark) and a reference to the word SHARK (= ‘any of numerous chiefly marine carnivorous fishes of the class <i>Chondrichthyes</i> (subclass <i>Elasmobranchii</i>) ...’).		

As already mentioned, misspellings may also have a semantic content and in such cases can be compared, as in the following examples.


Earlier sign	Contested sign	Case No
		14/07/2009 B 1 142 688 (EU)

Both marks refer to the word yogurt and consequently share the concept of 'a dairy product produced by bacterial fermentation of milk'.		
		28/10/2008, B 1 012 857 (ES)
The above marks are conceptually similar because they both refer to the concept of 'charisma' (= 'the ability to develop or inspire in others an ideological commitment to a particular point of view').		

3.4.4.2 Two words or terms have the same meaning but in different languages

It is possible for the relevant public to assign a conceptual similarity or even identity in cases of marks with elements in different languages, as long as the meanings of the words in those languages are known to that public.

In the following invented example the marks are conceptually identical because a substantial part of the Georgian public would understand the words constituting the marks at issue given (i) the close proximity of the English word 'vitamin' to the Georgian equivalent term 'ვიტამინი' (vitamini), (ii) 'water' is a basic English word likely to be understood by substantial part of the Georgian public, (iii) that 'aqua' is a widespread Latin expression and is understood by Georgian public.

Earlier sign	Contested sign
VITAMINWATER	

As it is the actual understanding of the relevant public that matters, the mere fact that one term is objectively the foreign-language equivalent of the other may not be relevant at all in the conceptual comparison.

3.4.4.3 Two words refer to the same semantic term or variations thereof

There is conceptual identity where synonyms are involved, that is to say where two words exist for the same semantic meaning (invented examples where English is the reference language: baggage/luggage; bicycle/bike; male horse/stallion).


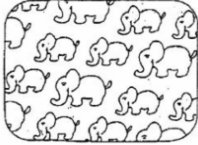




Conceptual similarity was found in the following cases.

Earlier sign	Contested sign	Case No
SECRET PLEASURES	PRIVATE PLEASURES	15/06/2000, R 616/1999- 1

	<p>ORPHAN INTERNATIONAL</p>	<p>14/06/2010, R 1142/2009-2</p>
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3.4.4.4 Two purely figurative marks represent the same or a similar concept

When two purely figurative marks represent the same or a similar concept, the signs will be conceptually identical or similar.

Earlier sign	Contested sign	Case No
		<p>07/02/2012, T-424/10, EU:T:2012:58, § 52 (similarity)</p>
		<p>12/04/2012, R 703/2011-2 (identity)</p>
		<p>17/06/2011, R 1107/2010-2 (identity)</p>

3.4.4.5 When there is a word versus a figurative, shape or colour mark representing the concept behind the word



Conceptual identity also exists between a word and an image showing what the word represents (fictional examples: word mark 'TIGER' compared with a figurative mark depicting a tiger; or word mark 'orange' and a mark for the colour orange per se).

3.4.4.6 When both marks have figurative elements with the same or an analogous concept, one or both accompanied by verbal elements

If each of the signs has a non-negligible figurative element with an independently identifiable concept, and these concepts are the same (identical) or analogous (similar), the signs as a whole are conceptually similar. The degree of similarity depends on various factors, such as whether the concepts are identical or similar, whether the verbal elements reinforce the concept of the figurative elements or rather introduce different concepts, whether the verbal elements appear in both signs or in only one, and the distinctiveness of the common concept.



Earlier sign	Contested sign	Case No
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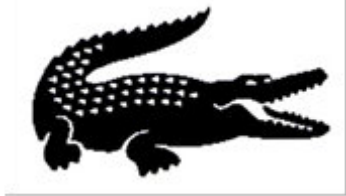

		16/10/2018, T-548/17, EU:T:2018:686
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Earlier sign	Contested sign	Case No
<p>G&S: Classes 14, 18, 25</p> <p><i>Assessment:</i> Notwithstanding the verbal elements that have no meaning, both marks represent a monkey that results in conceptual similarity for the signs taken as a whole (paras 46-49).</p>		
Earlier sign	Contested sign	Case No
		27/02/2002, R 68/2001-4 & R 285/2001-4
<p>G&S: Classes 18, 24, 25, 28</p> <p><i>Assessment:</i> the wording 'La Maison de la Fausse Fourrure' is not sufficient to reduce the impression of similarity between the conflicting marks. In addition to its possibly descriptive nature, the wording, compared with the footprint device, occupies a secondary position (it is placed under the device), is of a relatively limited size (four times smaller) and is in a conventional writing style (para. 22).</p>		

Signs with figurative elements corresponding to the meaning of the verbal elements

The concept inherent in the figurative element may be reinforced by the verbal part in defining a particular **concept** and may even help with the understanding of words that, in principle, might not be widely known to consumers. This strengthens the conceptual similarity.

Earlier sign	Contested sign	Case No
		17/04/2008, T-389/03, EU:T:2008:114
<p>G&S: Classes 1, 2, 17</p> <p><i>Assessment:</i> As regards the earlier trade marks, it must be held that the word element 'Pelikan' will be understood by consumers as a direct reference to the figurative element. Each of those two elements, appearing side by side, reinforces the other, so that consumers more easily understand one because of the other. Taken together, the two elements clearly call to mind the idea of a pelican. The signs are conceptually identical (paras 90-91).</p>		

Earlier sign	Contested sign	Case No
		30/09/2015, T-364/13, EU:T:2015:738
<p>G&S: Classes 18, 25</p> <p><i>Assessment:</i> The verbal element in the contested mark will be understood as a direct reference to the figurative element where the word 'kajman' or its close linguistic variation exists. Since the marks at issue are perceived as representing a reptile of the crocodylian order, they have analogous semantic content and are thus conceptually similar to at least an average degree (paras 47, 48, 53).</p>		



Earlier sign	Contested sign	Case No
		20/10/2011, T-238/10, EU:T:2011:613
<p>G&S: Class 18</p> <p><i>Assessment:</i> Even assuming that some consumers might wonder for a moment whether the figurative element depicts a horse in the contested mark, any possible confusion is removed by the word element 'horse', which will be understood as such by the majority of the relevant public. The word and figurative elements reinforce each other, with the result that consumers will more easily understand one because of the other. As both marks will evoke the same concept of a horse, they are conceptually identical (paras 30, 39).</p>		

3.4.4.7 When the signs have a meaningful word in common that is distinctive, and one of them contains an additional word or figurative element without any meaning
Where the signs have a meaningful word in common that is distinctive, and one or both of them contains an additional word element without any meaning (a fanciful word or one that will not be understood in the relevant language area), the signs are considered conceptually highly similar, and not identical. In such a case, even if not understood, the relevant public will note the presence of the additional term that prevents the signs from being perceived as conceptually totally identical.

Earlier sign	Contested sign	Case No
VIKING	VIKING PRUX	Invented example
VIKING DREMBL	VIKING PRUX	Invented example

Earlier sign	Contested sign	Case No
The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood in Georgia and is distinctive for the goods at issue. The words 'PRUX' and 'DREMBL' have no meaning. The signs are conceptually highly similar.		

However, where the word that the signs have in common is accompanied by additional figurative elements that lack any particular concept (such as a background, colours or a particular typeface), the signs are considered conceptually identical. In such a case, the additional figurative elements have no impact on the conceptual perception of the signs.

Earlier sign	Contested sign	Case No
		Invented example
The goods at issue are <i>cosmetics</i> in Class 3. The word 'VIKING' is understood in Georgia and is distinctive for the goods at issue. The additional figurative elements do not introduce any concept capable of altering the conceptual perception of the signs. The signs are conceptually identical.		

3.4.5 Impact of the distinctive and dominant character of the components on the similarity of signs

When assessing similarity between signs, account must be taken of (i) whether the element they have in common is recognisable or rather remains unnoticed in the overall impression of both marks (paragraph 3.4.5.1 below), (ii) the distinctiveness and dominant character of the common elements (paragraph 3.4.5.2 below), and the (iii) impact of the remaining elements in the overall impression conveyed by each of the marks (paragraph 3.4.5.3 below).

3.4.5.1 Identifiable common element




Two marks are similar when, from the point of view of the relevant public, they are at least partly identical as regards one or more relevant aspects.⁹⁸ Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, the fact remains that, when perceiving a word sign, they will break it down into elements that, for them, suggest a specific meaning or that resemble words known to them.⁹⁹ The element in common can be clearly identified when it appears **independently** in each sign.


Earlier sign	Contested sign	Reason	Case No
BEYOND VINTAGE	BEYOND RETRO	Coinciding first word.	30/04/2014, T-170/12, EU:T:2014:238

The element in common may also be identified as a **part of** a single word where a **visual** separation allows it to be perceived independently (e.g. through the use of lower- and upper case letters, the stylisation of letters or the use of a special character, such as a symbol, numeral, hyphen or other punctuation mark).

⁹⁸ 23/10/2002, T-6/01, Matratzen + Matratzenmarkt Concord (fig.), EU:T:2002:261, § 30

⁹⁹ 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 57

Earlier sign	Contested sign	Reason	Case No
ip_law@mbp	MBP	The earlier mark is composed of the elements 'ip-law' and 'mbp' separated by the '@' symbol, so that the marks have the element 'mbp' in common (para. 53).	16/09/2013, T-338/09, EU:T:2013:447
MAXX		The use of upper-case and lower-case letters and different colour shades immediately allows separate identification of the elements 'Nara' and 'Maxx'. notwithstanding that neither of them has any meaning for the relevant public.	22/09/2017, T-586/15, EU:T:2017:643, § 37, 46
		The letters 'FŁT' have an independent role in the TM application due to the colour red (para. 48).	14/05/2013, T-19/12, EU:T:2013:242

Earlier sign	Contested sign	Reason	Case No
TRONIC		The common element 'TRONIC' is separated visually in the contested mark by its white lettering (para. 38).	12/05/2016, T-775/14, EU:T:2016:293

Furthermore, the element in common may also be identified as a **part of** a single word where a clear **conceptual meaning** allows it to be perceived independently (see also paragraph 3.4.3.2 above).

Earlier sign	Contested sign	Reason	Case No
MARINE BLEU	BLUMARINE	The part 'marine' in the TM application will be understood as a reference to the sea and 'blu' as a misspelling of 'blue'.	14/05/2014, T-160/12, EU:T:2014:252
BLUE	ECOBUE	The relevant public will split the TM application into the commonly used prefix 'eco' and the word 'blue' (para. 30) — likelihood of confusion.	2/11/2008, T-281/07, EU:T:2008:489; Confirmed 22/01/2010, C-23/09P, EU:C:2010:35

On the contrary, if it remains unnoticed, the mere coincidence in a string of letters is not enough for a finding of similarity. The rule remains that the public compares the marks as a whole and will not artificially dissect them. In the following cases **the similarity of the marks**

was denied despite an overlap in some letters (see also paragraph 4 below, especially paragraph 4.2.4).

Earlier sign	Contested sign	Reason	Case No
CS	CScreen	The contested sign will probably be broken down into the elements 'C' and 'Screen', which has a meaning highly relevant for computers and their peripherals. It will not be perceived as containing the separate entity 'CS' corresponding to the earlier mark.	18/08/2010, R 545/2009-4

3.4.5.2 Distinctiveness and dominant character of the common elements

For the conclusion of similarity, the **degree of distinctiveness of the common element** (or elements) must be taken into account. The more distinctive the common element is, the higher the degree of similarity. A finding that the common element has limited distinctiveness will lower the degree of similarity, with the consequence that if the only common element of both marks is non-distinctive, the degree of similarity will be low or the marks will even be dissimilar depending on the impact of the elements that differentiate the marks (see paragraph 4.2.5 below).



In the following examples, the common element was considered descriptive or otherwise non-distinctive, with the consequence that the degree of similarity was considered low.

Earlier sign	Contested sign	Case No
FSA K-FORCE	FORCE-X	04/03/2015, T-558/13, EU:T:2015:135
The element 'force' has a weak distinctive character for the goods concerned (goods within Classes 9 and 12). Low visual, phonetic and conceptual similarity — no likelihood of confusion.		

Earlier sign	Contested sign	Case No
PINK LADY	WILD PINK	15/10/2018, -164/17, EU:T:2018:678
The element 'pink' in both signs will be understood by the relevant public as denoting the colour pink. The element has a low degree of distinctive character as it indicates the colour of the relevant goods (fruits). The signs are considered to share at least a low degree of visual and aural similarity. They are deemed to have a low degree of conceptual similarity owing to the shared concept of the colour pink (§ 79, 81, 88-89).		

Earlier sign	Contested sign	Case No
ACTU+	News+	

		12/12/2014, T-591/13, EU:T:2014:1074
<p>The presence of the '+' sign in both signs cannot generate a visual similarity as this is a mathematical symbol that implies a concept of increase, so it only enjoys a weak distinctive character (para. 29). The signs share a weak similarity on the phonetic side because of the presence of the '+' sign (paras 35-36) — no likelihood of confusion.</p>		

Earlier sign	Contested sign	Case No
		22/05/2012, T-60/11, EU:T:2012:252
<p>The word premium is laudatory (para. 44). The coincidence leads only to a low visual and phonetic and an average conceptual similarity — no likelihood of confusion.</p>		

The fact that the coinciding element is a non-distinctive element, does not however, suffice to deny any similarity between the marks, unless there are further factors differentiating them (see paragraph 4.2.5 below). If the public will notice the overlap, it must be taken into account in the comparison. The fact that an element is descriptive or otherwise non distinctive is not on its own sufficient to conclude that that word is negligible in the overall impression produced by that mark. (For the impact of common weak or non-distinctive components on likelihood of confusion see the Guidelines, Part B, Examination, Section 5, Double Identity and Likelihood of Confusion, Chapter 6, Global Assessment).

The conclusion on similarity also has to take into account **whether the common element is dominant** (visually outstanding) or **at least codominant** in the overall impression of the marks. As explained previously (see paragraph 3.3 above), within the assessment of the dominant character of one or more components, the intrinsic qualities (size, striking graphical representation, etc.) of each of those components have to be compared with the intrinsic qualities of the other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the composite mark.¹⁰⁰

The distinctiveness and dominant character of the common element(s) are separate but related terms.

It should also be noted that where some elements of a trade mark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them..¹⁰¹

¹⁰⁰ 08/06/2017, T-341/13 RENV, So'bio etic (fig.) / SO...? et al., EU:T:2017:381, § 40 and 44-56; confirmed by 28/02/2019, C-505/17 P, So'bio etic (fig.) / SO...? et al., § 39-53



¹⁰¹ 31/01/2013, T-54/12, Sport, EU:T:2013:50, § 24 and the case-law cited

3.4.5.3 Importance of additional (not common) elements

Within the comparison of trade marks as a whole, the impact of the non-common elements in their overall impression also has to be taken into account in order to reach a conclusion on similarity. The more differences the remaining elements of the marks present, the lower would be the similarity resulting from the common element.

It cannot be generally assumed that the elements of difference between the marks would tend to become less marked in the consumer's memory in favour of the elements of similarity. In accordance with settled case-law, the extent of the similarity or difference between the signs at issue may depend, in particular, on the inherent qualities of the signs.¹⁰²

The distinctiveness and dominant character of the differentiating elements has to be, therefore, taken into account. If these elements are the distinctive ones and dominate the overall impression of the marks, the degree of similarity will decrease.

Earlier sign	Contested sign	Case No
		18/06/2013, T-338/12, EU:T:2013:327
As regards the visual comparison, the figurative element representing a dog in the earlier mark constitutes the dominant one. Given that the respective graphic elements are different, the coincidence in the word element 'K9' leads to a visual similarity only to a low degree. The marks are phonetically similar to a high degree. As to the conceptual comparison, the contested mark does not contain any figurative element conveying the concept of a dog, the marks are not conceptually similar (paras 27-34).		

On the contrary, if the element in which the marks differ is of less inherent distinctiveness than the common element, this will increase the degree of similarity.

Earlier sign	Contested sign	Case No
ვეფხვი (Tiger)	(შავი ვეფხვი (black tiger))	invented example

¹⁰² 13/05/2015, T-169/14, Koragel / CHORAGON, EU:T:2015:280, § 84


. ‘შავი’ is descriptive for the relevant goods in Class 32, since it may be used in Georgian to designate brown beer, i.e. the type of beer sold under the trade mark შავი ვეფხვი. The attention of the average Georgian consumer will be focused on the coinciding word ‘ვეფხვი’.

3.4.6 Other principles to be taken into account in the comparison of signs

3.4.6.1 The impact of the verbal element in the case of composite marks

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements.¹⁰³

However, the verbal element of a sign does not automatically have a stronger impact and in certain cases, the figurative element of a composite mark may, owing to, inter alia, its shape, size, colour or position within the sign, rank equally with the word element (. Below are some examples of such a scenario:

Earlier sign	Contested sign	Case No
GIOVANNI		03/06/2015, T-559/13, EU:T:2015:353
<p>G&S: Class 3</p> <p><i>Assessment.</i> The figurative element of the mark applied for is as important as the word elements and has a significant impact on the overall visual impression given by that mark. It is positioned above the word elements and occupies more space than both of those elements combined. Furthermore, it is distinctive for the goods at hand, as a duck has no connection with cosmetic or cleaning preparations. In addition, the drawing of the duck is quite elaborate. Even if the element ‘GIOVANNI’ is placed before the element ‘GALLI’, there is only a low degree of visual similarity between the marks at issue, in view of the significant impact of the figurative element of the mark applied for on the overall impression given by that mark (paras 62-64, 72, 74).</p>		

¹⁰³ 14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 19/12/2011, R 233/2011-4, BEST TONE (fig.) / BETSTONE, § 24; 13/12/2011, R 53/2011-5, JUMBO (fig.) / DEVICE OF AN ELEPHANT (fig.), § 59



G&S: Classes 32 and 33

Assessment. the figurative element of the mark applied for, consisting of the stylised representation of a bovine animal viewed in profile looking to the left and which may be perceived as a European bison, is of a similar size to that of the verbal element 'wisent' and occupies a comparable space in that mark. As a result of its shape, its size, its colour and its position, that representation of a bison [...] helps clearly to establish the image of the contested mark which the relevant public will retain in their mind, with the result that **it cannot be discounted in the perception of that mark** [...].

As regards the earlier mark, a naturalistic representation of a bison standing on four legs in a circle against a background of trees, coloured green, brown and black, is clearly perceptible in that mark. That representation of a bison occupies a central position and is of a slightly larger size than the only perceptible verbal element, the term 'zubrówka', represented in yellow and black and placed above that representation. Therefore, **the figurative element** consisting of a naturalistic representation of a bison **cannot be discounted in the overall impression created by the earlier mark** [...]. Despite the presence of different verbal elements, as a whole the marks are **visually similar to a low degree** given the fact that they both contain a bison, the image of which will easily be retained by consumers in their memory as a result of their position within the marks at issue and their size (paras 76-77, 82, 85-86, 111, 113).

3.4.6.2 Beginning of the signs in the visual and phonetic comparison

In word signs or in signs containing a verbal element, the first part is generally the one that primarily catches the consumer's attention and, therefore, will be remembered more clearly than the rest of the sign. This means that in general the beginning of a sign has a significant influence on the general impression made by the mark.¹⁰⁴

Nevertheless, the concept 'beginning of the sign' is undetermined, as there is no particular indication of what forms the beginning, what is the end or even if there is or is not a middle part of the sign. Again, this perception mostly depends on the circumstances of the case (length of sign, syllabic distribution, use of typeface, etc.) and not on a set rule. It could even be that a sign is perceived as having a short beginning and ending and a proportionally much larger middle or central part. Consequently, depending on the circumstances, the rule of the relevance of the beginning of the sign could have less weight to the benefit of a more relevant central part.

As it is usually the beginning of a sign that catches consumers' attention, where signs only differ in their endings, this difference is often insufficient to exclude similarity. However, this is not a fixed rule and the outcome depends on the circumstances of the case. Moreover, this rule only applies when the sign contains a verbal element (which would explain reading from

¹⁰⁴ 15/12/2009, T-412/08, Trubion, EU:T:2009:507, § 40; 25/03/2009, T-109/07, Spa Therapy, EU:T:2009:81, § 30

left to right) and when this verbal element is not very short (otherwise the sign will be perceived immediately in its entirety). Sakpatenti considers signs consisting of three or fewer letters/numbers as very short signs (see in more detail paragraph 3.4.6.3 below).

In principle, coincidences at the beginning of signs increase their similarity more than in the middle or at the end.

Earlier sign	Contested sign	Case No
ALENTIS	ALENSYS	10/02/2011, R 1243/2010-1
<p>G&S: Class 42</p> <p><i>Assessment:</i> while both marks do not have any meaning and, thus, no conceptual comparison can be made, the trade marks are visually and phonetically highly similar, in particular because they coincide in their first four letters 'ALEN'. It is generally accepted that people pay more attention to the first part of a trade mark, at least when they perceive the mark visually (para. 33).</p>		
Earlier sign	Contested sign	Case No
AZURIL	AZULIB	Invented example
<p>G&S: Class 5</p> <p><i>Assessment:</i> the signs share five of their six letters and the first two syllables are identical. There is a certain degree of visual similarity. Aurally the signs are highly similar as the initial part, which is normally the most important, is identical. Neither sign has a meaning in Georgian</p>		

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning.

Earlier sign	Contested sign	Case No
CALSURA	CALSORIN	invented example
<p>G&S: Class 5</p> <p><i>Assessment:</i> visually, the marks share some similarity due to the coinciding letters 'C', 'A', 'L', 'S' and 'R' placed in the same order. Aurally, there is a low degree of similarity. Conceptually, the marks are similar insofar as they both contain the component 'CAL'. However, since this element clearly alludes to the kind of goods (containing 'calcium'), not much weight can be given to this conceptual similarity— no likelihood of confusion.</p>		
Earlier sign	Contested sign	Case No
ALBUMAN	ALBUNORM	01/02/2011, R 489/2010-2

G&S: Class 5

Assessment: visually, phonetically and conceptually the signs are similar insofar as they have the prefix 'ALBU' (abbreviation of 'albumin' or 'albumen') in common. But this similarity is of little significance because the prefix is generic and so devoid of distinctiveness. The second element of the earlier mark, 'MAN', is visually, phonetically and conceptually completely different from the second element, 'NORM', of the contested mark.

3.4.6.3 Short signs

The comparison of signs must be based on the **overall impression** given by the marks.

The length of signs may influence the effect of the differences between them. In principle, the shorter a sign, the more easily the public is able to perceive all its single elements. In contrast, the public is usually less aware of differences between longer signs. **However, each case must be judged on its own merits, having regard to all the relevant factors.**

The signs with three or less than three letters/numbers are considered by Sakpatenti as short signs. The paragraphs below thus analyse the impact on the overall impression, and thus, on the similarity of the respective signs for one-, two- and three-letter/number signs.

The comparison between signs consisting of a single letter or a combination of three or less than three letters not recognisable as a word, **follows the same rules** as that for word signs comprising a word, a name or an invented term.¹⁰⁵

Single-letter/Single-number signs

It follows from the case-law of the Court that in the assessment of likelihood of confusion between signs comprising the same single letter, the **visual comparison** (see paragraph 3.4.1.6 above) is, in principle, decisive. The aural and conceptual identity may be overridden, in the assessment of likelihood of confusion, by sufficient visual differences between the signs (see the Guidelines, Part B, EXAMINATION, Section 5, Double Identity and Likelihood of Confusion, Chapter 6, Global Assessment).




Two-letter/number signs

The over-mentioned rule on the importance of visual comparison applies to two-letter/ number marks accordingly. The comparison of these signs depends on their stylisation and, especially, on whether the letters are recognisable as such in the sign. Consequently, the visual overall impression of the signs may be different when two conflicting signs, albeit containing or consisting of the same combination of two-letters, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element.




In the following examples, the **marks were found visually similar** due to the graphic representations/visual similarities of the same two-letter combinations.

Earlier sign	Contested sign	Case No
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¹⁰⁵ 06/10/2004, T-117/03 - T-119/03 & T-171/03, NL, EU:T:2004:293, § 47-48; 10/05/2011, T-187/10, G, EU:T:2011:202, § 49



<p>(i)</p>  <p>(ii)</p> 		<p>31/03/2000, B 61 046</p>
<p>G&S: Class 36</p> <p><i>Assessment:</i> the overall visual impression of the conflicting marks is that they consist of two letters in an arbitrary figurative design that conveys the same impression. The trade marks are considered similar.</p>		

In the following example, the signs were found visually and phonetically dissimilar due to the different graphic representation and the fact that they may not be read as the same letters.

Earlier sign	Contested sign	Case No
<p>(i)</p>  <p>(ii)</p> 		<p>18/11/2011, R 82/2011-4</p>
<p>G&S: Class 33</p> <p><i>Assessment:</i> from a visual point of view, the graphic stylisation of the earlier marks is very different compared with the contested mark. The mere fact that one or both letters of the marks are identical is not enough to render the marks visually similar. There is no aural similarity if the contested mark will be pronounced as 'B' or 'PB' as in short signs differences have a higher impact on the overall impression than in longer marks. Conceptually, the contested mark and the earlier marks with no additional elements to the letter combination 'AB' do not have a meaning in any of the relevant languages: the conceptual comparison remains thus neutral (paras 17-19).</p>		


As to the difference in one of the letters see the following examples.

Earlier sign	Contested sign	Case No
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(i) CX		
(ii) 	KX	21/01/2011, R 864/2010-2
<p>G&S: Class 7</p> <p><i>Assessment:</i> visually, the initial letters 'K' and 'C' show a clearly different shape and can be considered only visually similar to a low degree. The same degree of similarity — low — applies for the phonetic comparison. Aurally, the signs will be pronounced 'K-X' and 'C-X' respectively, and not as words. Neither of the marks has a conceptual meaning (paras 25-27).</p>		
Earlier sign	Contested sign	Case No
KA		22/03/2011, T-486/07, EU:T:2011:104
<p>G&S: Classes 9, 11, 12</p> <p><i>Assessment:</i> it must be concluded that, for each of the possible perceptions by the relevant public of the mark applied for, that public will perceive significant visual differences for each of the earlier marks (para. 65). Some degree of phonetic similarity between the marks at issue must be recognised, but it is not very high. Without making an error, the Board of Appeal, therefore, could find that the phonetic similarity between the marks at issue was not 'notable' (para. 71). As both marks have no meaning, no conceptual comparison can be made (para. 72).</p>		

Three-letter / number signs




When the signs in conflict are three-letter/number signs, a difference of one letter does not exclude similarity, especially if this letter is phonetically similar.

Earlier sign	Contested sign	Case No
	ELS	23/10/2002, T-388/00, EU:T:2002:260
<p>G&S: Classes 16, 35, 41</p> <p><i>Assessment:</i> two of the three letters are identical and in the same sequence; the difference in a single letter does not constitute a significant visual and aural difference. The letters 'E' and 'I' are pronounced similarly (paras 66-71).</p>		
Earlier sign	Contested sign	Case No
Ran	R.U.N.	17/12/2009, T-490/07, EU:T:2009:522

G&S: Classes 35, 38, 42


Assessment: the Court held that the signs in the mind of the relevant consumer, having a good command of the English language, are visually, aurally and conceptually similar (para. 55).

In contrast, when trademarks are composed of only three letters, with no meaning, the difference of one letter may be sufficient to render them not similar.

Earlier sign	Contested sign	Case No
(i) 		07/02/2001, R 393/1999-2
(ii) 		

G&S: Class 25

Assessment: in this case the pronunciation of the first letters of the marks in dispute, i.e. 'J' and 'T', is different in all relevant languages. These letters are also visually dissimilar. Furthermore, the figurative elements of the compared marks do not resemble each other (paras 17-18).

Earlier sign	Contested sign	Case No
	COR	23/05/2007, T-342/05, EU:T:2007:152

G&S: Class 3


Assessment: the GC considered that the signs were only aurally similar to a low degree (paras 47, 50). The relevant public will certainly notice the differences in the beginning of the signs.

3.4.6.4 The impact of conceptual difference

Where at least one of the signs at issue has a clear and specific meaning that can be grasped immediately, the resulting conceptual difference may offset the visual and aural similarity between the signs. This is the so-called principle of 'neutralisation'. That impact of conceptual difference is taken into consideration when making the overall assessment of similarity between the signs.¹⁰⁶

Not just any conceptual dissimilarity can lead to neutralisation. Neutralisation can only be applied exceptionally, if at least one of the signs **as a whole** has a **clear and specific meaning that can be grasped immediately** by the relevant public.

¹⁰⁶ 05/10/2017, C-437/16 P, CHEMPIOIL / CHAMPION et al., EU:C:2017:737, § 44; 04/03/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 75

Earlier sign	Contested sign	Case No
	CHEMPIOIL	05/10/2017, C-437/16 P, EU:C:2017:737
<p>G&S: Classes 1, 3 and 4</p> <p><i>Assessment:</i> The word 'champion' has a clear and specific meaning that will be understood by the relevant public, as it is used extensively in various fields of daily life, such as the arts, literature, cinema, music or sport. Whilst the term 'chempioil' alludes to oil or chemicals, it does not convey any clear meaning for the sign as a whole. Despite the visual and phonetic similarities between the signs, the consumer would make a distinction between them due to the clear concept conveyed by the earlier sign. Consequently, the visual and aural similarities of the signs at issue are offset by the conceptual difference conveyed by the meaning of the term 'champion' (§ 31, 46-47 and 55).</p>		

Where neither of the signs as a whole has a clear and specific meaning, any conceptual difference between the signs that may result from a vague concept that the sign may evoke is insufficient to offset the visual and aural similarities.

Furthermore, for neutralisation to apply, the meaning of the sign must be clear and specific for **the entire public** for whom the signs are visually and phonetically similar. If neither of the signs has a clear and specific meaning that could be grasped immediately by a significant part of the public, neutralisation is not appropriate, notwithstanding the fact that for another part of the public at least one of the signs had such a meaning.

However, even if at least one of the signs does have a clear and specific meaning that could be grasped immediately by the entire relevant public, the visual or aural similarity may be so high that the resulting conceptual differences could still not be offset.

3.5 Conclusion on similarity

An assessment of similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another. The comparison must be made by examining each of the marks in question as a whole. However, this does not mean that the overall impression conveyed by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. In general, the more features the marks have in common, the higher the degree of similarity.

The conclusion reached on the similarity between the signs is the result of an evaluation of all of the relevant factors discussed in detail above.

It must also be borne in mind that since the assessment of similarity is based on the overall impression of the signs, once signs have been found to be similar, it would not be consistent to find later, in the global assessment of the likelihood of confusion, that 'the overall impression of the signs is different' in order to support an outcome of no likelihood of confusion.



In general, the following should be considered when assessing similarity and degrees of similarity.

Impact of the distinctiveness of the elements

The greater or lesser degree of distinctiveness of the common elements of the signs is one of the relevant factors in assessing the similarity between signs.

For example, if the coincidences between the signs on any of the three aspects of comparison derive from an element with limited distinctiveness, the established degree of visual, aural and/or conceptual similarity, respectively, will be lower than where the elements in common have a normal distinctiveness.

In the following examples the signs involved weak/descriptive elements but with different outcomes.

Earlier sign	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295 (likelihood of confusion)
<p>G&S: Classes 35, 39, 41, 42 and 43</p> <p><i>Assessment:</i> the Court found the signs visually highly similar, and identical phonetically and conceptually (paras 86, 88, 91 and 93).</p>		
Earlier sign	Contested sign	Case No
	TRIDENT PURE	16/12/2015, T-491/13, EU:T:2015:979 (No likelihood of confusion)
<p>G&S: Class 30</p> <p><i>Assessment:</i> The Court established a low degree of visual similarity given that the coinciding element 'PURE', despite being descriptive for part of the public, was not on its own sufficient to conclude that the word is negligible in the overall impression produced by the mark (paras 69-71). Aurally, the marks were deemed similar to a low degree for those who understood the non-distinctive meaning of 'PURE' but to an average degree for the remaining part of the public (para. 87). Conceptually, they are similar for those who understand 'PURE' as a descriptive term referring to the purity of the goods at issue and to the purity of breath. The fact that the word 'pure' is descriptive of the characteristics of the goods in question does not alter the conceptual content of the marks (para. 93).</p>		

Impact of the dominant elements



The conclusion on similarity also has to take into account whether the common element is dominant (visually outstanding) or at least codominant in the overall impression of the marks.

It should also be noted that where some elements of a trademark are descriptive or non-distinctive, they are not generally regarded by the public as being dominant in the overall impression conveyed by that mark, unless, particularly because of their position or their size, they appear likely to make an impression on consumers and to be remembered by them.

It should be emphasised that the abovementioned factors may not be applicable to all cases and the assessment of similarity is always undertaken on a case-by-case basis and a consideration of further factors may be necessary. Furthermore, it should be noted that the above factors and principles do not call into question the principle that the examination of the similarity of trademarks must take into account the overall impression produced by them on the relevant public.

Impact of word versus figurative elements

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component.

Earlier sign	Contested sign	Case No
		16/01/2014, T-149/12, EU:T:2014:11 (likelihood of confusion)
<p>G&S: Class 9</p> <p><i>Assessment:</i> the signs were found visually highly similar and phonetically identical, notwithstanding the descriptive character of the element 'MICRO' (paras 54-55, 60) and taking into account that the differences were limited to banal graphical elements.</p>		

In general, the identity or similarity of the figurative component of the signs is insufficient to establish a considerable degree of similarity where at least one of the signs contains a further verbal component that is not contained in the other sign.

However, although the word elements of a mark may have a greater impact, this is not necessarily the case where the figurative element visually dominates the overall impression made by the mark (see paragraph 3.4.6.1 above).



Beginning of signs

In principle, coincidences at the beginning of signs increase their similarity more than coincidences in the middle or at the end of signs.

Therefore, consumers attach less importance to the end of the mark and coincidences located at the end of signs would lead to a finding of a lower degree of visual similarity than common elements at the beginning of signs (see first example below). Likewise, the position of the coinciding/similar phonemes or syllables at the beginning of the conflicting signs would increase the degree of aural similarity.

However, the degree of similarity will usually be lower, despite identical beginnings, if those are the weak elements in the signs or if the remaining elements have a clearly different meaning (see second example below).

Earlier sign	Contested sign	Case No
OXYGESIC	Maxigesic	16/10/2013, T-328/12, EU:T:2013:537

<p>G&S: Class 5</p> <p><i>Assessment:</i> the signs were found visually similar to a low degree due to the descriptive character of the suffix 'GESIC', given that it refers to painkillers (paras 35, 47), as well as the different beginnings (para. 49). Phonetically, they were found similar to an average degree (para. 51) and conceptually dissimilar, the latter again due to the descriptive content of 'GESIC' and the differing associations that could be made with the respective prefixes of the signs ('OXY' refers to oxygen/oxycodon and 'MAXI' to maximum (para. 53)), with the result that a likelihood of confusion was excluded.</p>		
		<p>05/02/2015, T-33/13, EU:T:2015:77</p>
<p>G&S: Class 35, 36 and 42.</p> <p><i>Assessment:</i> visually, the signs were deemed to have at least a certain degree of visual similarity, even if the coincidence in 'bonus' related to an element of a weak distinctive character (paras 32, 41). Phonetically, the signs were found similar to an average degree due to the identical pronunciation of the first two syllables (para. 34). Conceptually, there is at least a certain degree of similarity for a significant part of the public for whom the common element 'bonus' conveys an identical meaning (para. 42).</p>		

Short signs

The length of the signs may influence their overall impression and thus the effect of the differences between them. In principle, the shorter a sign is, the more easily the public is able to perceive all its single elements. In contrast, the public is usually less aware of differences between longer signs.

The application of the abovementioned principles and factors should not be automatic. The decision has to explain their relevance for the particular case and weigh them up.

However, the rules explained in this chapter have a general character and the particularities of a specific case may justify different findings. However, in such cases it is of even greater importance to provide a clear and thorough reasoning in the decision.

4 Dissimilarity of Signs

4.1 Introduction

The similarity of signs is a necessary condition for a finding of a likelihood of confusion under Article 5(c) of the **Law**. An assessment of the similarity between two marks must be based on the **overall impression** created by them, in particular, by their distinctive and dominant components. Where the overall impression is that the signs are dissimilar, this excludes the likelihood of confusion.

The finding as to whether signs are similar or dissimilar overall is the result of a combined assessment of (i) the visual, phonetic, conceptual overlaps and differences and (ii) the significance of the overlaps and differences in the perception of the relevant public.

The finding that the signs are dissimilar has the following consequences:

- The goods and services are not compared.

- There is no global assessment of factors. The decision concludes that in the absence of one of the conditions, the refusal under Article 5(c) of the **Law** shall not be issued
- The signs will be considered dissimilar also for the purposes of opposition proceedings. In particular, any claim under Articles 5(a), 5(b), 5(c), 5(d) and 5(g) of the **Law** will be rejected.

Chapter 5 Distinctiveness of the earlier mark

1 General Remarks

Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

The distinctive character of the earlier trademark must be taken into account when determining whether the similarity between the goods or services covered by the two trademarks is sufficient to give rise to the likelihood of confusion.

The assessment of the distinctiveness of an earlier mark is **especially** important in cases when there is only a low degree of similarity between the signs, as it must be assessed whether this low degree can be compensated by the high degree of similarity between the products and vice versa.

It is necessary to distinguish between the **notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark**, and the **notion of the distinctive character which an element of a composite mark possesses, which determines its ability to dominate the overall impression created by the mark**. While it is true that it is necessary to examine the **distinctiveness of an element of a composite mark at the stage of assessing the similarity of the signs, the degree of distinctiveness of the earlier mark is an element to be taken into account in the context of the global assessment of the likelihood of confusion**. It is therefore not appropriate to take account of what may be a low degree of distinctiveness of the earlier mark at the stage of assessing the similarity of the signs.

Sakpatenti therefore distinguishes between: (i) the analysis of the distinctive character of the earlier mark as a whole, which determines the scope of protection afforded to that mark and is one of the factors in the global assessment of the likelihood of confusion, and (ii) the analysis of the distinctive character of a component of the marks within their comparison.

Whereas distinctive character must be assessed for the components of both the earlier mark and the contested mark, distinctiveness of the mark as a whole is assessed only in respect of the earlier mark. The distinctiveness of the contested mark as a whole is not relevant, as such, to the assessment of the likelihood of confusion, as explained in more detail in paragraph 2.1.2 below. Therefore, any reference below to the distinctiveness of the mark **as a whole** refers exclusively to the earlier mark.

2 Assessment of Distinctiveness of the Earlier Mark

The more distinctive the earlier mark, the greater will be the likelihood of confusion, and (ii) earlier marks with a highly distinctive character because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character. Consequently, the distinctive character of the earlier mark as a whole determines the strength and breadth of its protection and must be taken into consideration for the purposes of assessing the likelihood of confusion.

2.1 General issues

2.1.1 Distinctiveness

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, overall assessment should be made of the **greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings.**

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies, whereby a sign can lack distinctiveness entirely, be highly distinctive or be at any point in between.



A sign is **not distinctive** if it is descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.), laudatory and/or if its use in trade is common for those goods and services. Similarly, a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness. The rules for the assessment of distinctive character follow those established by examination on absolute grounds.

A sign may be **distinctive to a low degree** if it alludes to (but is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods and/or services might not materially affect distinctiveness. For example:

- 'Billionaire' for gaming services is allusive in a manner that would affect distinctiveness because it implies, for instance, that you may become a billionaire.
- 'Billy O'Naire', which sounds identical to 'billionaire' in English, would be allusive for gaming services as a clever wordplay on Irish names, in a manner that would not affect distinctiveness in a material way; it would be considered to have a 'normal' degree of distinctiveness.

A sign is deemed to possess a **'normal' degree of inherent** distinctiveness if there is no indication for a limitation thereof (e.g. due to a descriptive character, laudatory meaning, etc.). This means that the sign in question is fully distinctive, in the sense that its capacity to identify the goods and services for which it has been registered as coming from a particular undertaking is not in any way diminished or impaired.

Any **higher degree of distinctiveness** acquired by the earlier mark, which is often claimed by the opponent in order to broaden its scope of protection, has to be proven by its proprietor by submitting appropriate evidence (see paragraph 2.3 below). A mark will not necessarily

have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services.

However, TM applicant may argue that the earlier sign is distinctive to a low degree. One of the most frequent arguments brought by applicants is that the earlier trade mark or one of its components has low distinctive character given that there are many trade marks that consist of, or include, the element in question. It should be noted that the existence of several trade mark registrations is not per se particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of register data only, it cannot be assumed that all the trade marks have been effectively used.

When dealing with the distinctiveness of the **earlier mark as a whole**, the latter should always be considered **to have at least a minimum degree of inherent distinctiveness**. Earlier marks, enjoy a 'presumption of validity'. It should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character

2.1.2 Inherent and enhanced distinctiveness

In substantive examination stage Sakpatenti must consider, the overall **inherent distinctiveness** of the earlier mark (see paragraph 2.2 below).

The degree of distinctiveness of the earlier sign is one of the factors to be taken into account in the overall assessment. It is a matter of law which must be examined by Sakpatenti. In contrast, the degree of enhanced distinctiveness acquired through use of the earlier sign is a matter of law **and** fact, which Sakpatenti cannot examine unless the opponent claims and substantiates it in due time..

2.1.3 Relevant goods and services

The assessment of the **inherent distinctiveness** of the earlier mark is carried out only for the goods or services that have been found to be identical or similar to the contested goods and services.

Assessment of the **enhanced distinctiveness** of the earlier mark is carried out only in respect of the goods or services protected by the sign for which enhanced distinctiveness is claimed and that have been found to be identical or similar to the contested goods and services.

Furthermore, it is the perception of the relevant public for these goods and services that is of relevance (e.g. whether a specialist public is involved or not).

2.2 Examination of inherent distinctiveness of the earlier mark

2.2.1 General principles

The first step in examining the distinctiveness of the earlier mark is to examine its inherent distinctiveness. The same rules and principles apply as those for the examination of distinctiveness of components, in terms of the relevant public and relevant goods and services, etc. (see the Guidelines, Part B, EXAMINATION Section 5, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs, paragraph 3.2).

At the stage of determining the distinctiveness of the earlier mark as a whole, distinctiveness of its various components (or its only component) has already been established in the section on comparison of signs. In principle, if an earlier mark contains a normally distinctive component, then the inherent distinctiveness of such an earlier mark as a whole is also normal, regardless of the possible presence of other non-distinctive or weak components. If the most distinctive component of the earlier mark is distinctive only to a low degree, then in principle the overall inherent distinctiveness of that mark will be no more than low.

The outcome of the examination of inherent distinctiveness of the earlier mark as a whole will be one of the following:

- The earlier mark has less than normal distinctiveness because, as a whole, it is allusive (in a way that materially affects distinctiveness) or laudatory of the characteristics of identical or similar goods or services (or because it is otherwise weak). As set out above, Sakpatenti will not conclude that an earlier mark as a whole is descriptive and/or non-distinctive.
- The earlier mark has normal distinctiveness because, as a whole, it is not descriptive, allusive (in a way that materially affects distinctiveness) or laudatory (or is not otherwise weak) in relation to identical or similar goods or services.

When an earlier mark is not descriptive (or is not otherwise non- distinctive), to consider it as having no more than a normal degree of inherent distinctiveness. As indicated above, this degree of distinctiveness can be further enhanced if appropriate evidence is submitted showing that a higher degree of distinctiveness of the earlier mark has been acquired through use or because it is highly original, unusual or unique. It should, however, be recalled that a mark will not necessarily have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services.

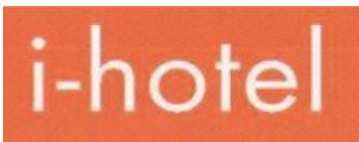
2.2.2 Impact of the low distinctiveness of the earlier mark


As explained in paragraph 2.1.1 above, Sakpatenti attributes at least a minimum degree of distinctiveness to the earlier mark.

A finding that a trademark has a low or even very low (minimal) degree of distinctiveness may have a different impact on the likelihood of confusion. In general, this finding is an argument against a likelihood of confusion. It must however be balanced with the other factors, like the degree of similarity of the signs and the goods or services, as well as the degree of attention and sophistication of the relevant public.

A finding of a low distinctive character for the earlier trademark does not prevent a finding of a likelihood of confusion. Although the distinctive character of the earlier mark must be taken into account when assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Thus, even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a high degree of similarity between the signs and between the goods or services covered.

The **likelihood of confusion was affirmed** for similar and identical goods, when the trademarks differed only in stylisation or non-distinctive figurative elements and showed therefore a high degree of similarity.

Earlier mark	Contested sign	Case No
	iHotel	13/06/2012, T-277/11, EU:T:2012:295
G&S: Class 43 and others related to travel and hotel services <i>Assessment:</i> the trademarks are visually highly similar; there is phonetic and conceptual identity.		
Earlier mark	Contested sign	Case No

SHE		15/10/2015, T-642/13, EU:T:2015:781
G&S: Class 25		
<p><i>Assessment:</i> the trademarks are visually and conceptually similar; there is phonetic identity.</p> <p>The finding of the likelihood of confusion is not called into question by the argument that the earlier word mark is purely descriptive and thus has a low distinctive character.</p> <p>The fact that the mark at issue consists of the same word sign as the earlier word mark and differs from it solely by a figurative element without particular meaning could be perceived as a particular configuration of the earlier word mark (paras 73, 77).</p>		

However, **the likelihood of confusion was excluded** even for identical goods in cases where the degree of similarity between the marks was low due to differences resulting from an additional fully distinctive element:

Earlier mark	Contested sign	Case No
POST	TPG POST	13/05/2015, T-102/14, EU:T:2015:279
<p>G&S: Class 39 and others related to postal services</p> <p><i>Assessment:</i> the earlier mark has limited distinctiveness. The differences between the marks due to the addition of the distinctive element 'TPG' will be perceived visually, phonetically and conceptually (paras 61, 68).</p>		
Earlier mark	Contested sign	Case No
F1	F1H2O	21/05/2005, T-55/13, EU:T:2015:309
<p>G&S: Class 9, 25, 38, 41</p> <p><i>Assessment:</i> the visual and phonetic similarity is low, the signs are conceptually dissimilar. The element 'F1' is indeed likely to create a link in the mind of the relevant public between those goods and services and the field of motor racing. The distinctiveness of the earlier word marks does not help confer on those marks, or on the element of the mark applied for composed of the alphanumeric combination 'F1', a dominant character or independent distinctive character, inasmuch as the mark applied for is not broken down by the relevant public, but would be perceived by that public in its entirety (paras 45, 50).</p>		

2.2.3 Specific themes

2.2.3.1 ~~One-letter signs, numerals and short signs~~

2.2.3.2 Collective marks

Where the rejection of a trade mark is based on a collective mark, its inherent distinctiveness is to be assessed in the usual way. The mark may have a low or even very low degree of inherent distinctiveness when it refers to the nature or other characteristics of the goods concerned. The fact that the mark is a collective mark does not imply that its scope of protection is broader.

Even where the earlier mark is a collective mark that contains a geographically descriptive element and is registered pursuant to Article 31(1) of the **Law**, its distinctiveness is to be assessed in the usual way. The geographically descriptive elements in such collective marks will be considered to be devoid of distinctive character. This is because the distinctiveness of such marks must stem from the addition of other elements enabling the consumer to distinguish the goods or services of the members of the proprietor association from those of other undertakings. If the earlier mark consists only of a geographically descriptive element, its distinctiveness should be considered low.

2.3 Examination of enhanced distinctiveness


Examination of enhanced distinctiveness is possible only by the Chamber of appeals in opposition proceedings. The Chamber of appeals assesses whether the earlier mark has acquired enhanced distinctiveness at the time of filing (or priority date) of the contested TM application as a consequence of the use that the opponent has made of it.

The distinctiveness of the earlier mark always has to be taken into account when deciding on the likelihood of confusion. The more distinctive the earlier trade mark, the greater will be the likelihood of confusion. Therefore, marks with a highly distinctive character, enjoy broader protection than marks with a less distinctive character.

In practice, this means that the fact that an earlier trade mark enjoys enhanced distinctive character or reputation is an argument in favour of finding a likelihood of confusion.

Enhanced distinctiveness of an individual mark means that the relevant public recognises the mark as having an enhanced ability or a high capacity to identify the goods or services for which it is registered as coming from a particular undertaking. The enhanced recognition of a mark must be related to its essential function, which is, in the case of individual marks, that of indicating commercial origin. Enhanced distinctiveness of the mark is the result of its use in accordance with its essential function.

Use in accordance with the mark's essential function may enhance the distinctiveness of marks with little or no inherent distinctiveness or of those that are inherently distinctive.

Earlier mark	Contested sign	Case No
CRISTAL		17/11/2003, R 37/2000-2

G&S: Class 33

Assessment. (earlier mark 'CRISTAL') 'As regards the claim that "Cristal" is a descriptive word for the goods at issue (sparkling wines with crystalline character), the EUIPO Board of Appeal cannot accept it. On the one hand, it is an evocative indication which suggests the crystalline character of wines, but which in no way describes the product. On the other hand, [the Board] considers that a highly distinctive character of the mark CRISTAL had been shown.' (para. 31).


There are some guidance and a non-exhaustive list of factors in respect of the evaluation of distinctiveness acquired through use of the earlier mark.

In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

The evidence of enhanced distinctiveness acquired through use must refer to both (i) the geographical area and (ii) the relevant goods and services. The opponent may claim enhanced distinctive character of the earlier mark for only part of the registered goods and services. According to the evidence submitted, Chamber of appeals must establish precisely for which goods and services distinctiveness has been acquired. The nature, factors, evidence and assessment of enhanced distinctiveness are the same as for reputation. For further details on the evidence required and its assessment.

However, a finding of reputation requires that a certain threshold of recognition be met whilst, as set out above, the threshold for a finding of enhanced distinctiveness may be lower.

Enhanced distinctiveness is anything above inherent distinctiveness.

Earlier mark	Contested sign	Case No
EL COTO	<p style="text-align: center;">Coto D'Arcis</p> 	<p style="text-align: center;">12/03/2008, T-332/04, EU:T:2008:69</p>

G&S: Classes 33, 35, 39

Assessment: enhanced distinctiveness of the trade mark 'EL COTO': 'The Board of Appeal took into account the market knowledge of the earlier mark 'EL COTO' and made a proper assessment of the relevant case-law principles to conclude that the earlier mark 'EL COTO' has a highly distinctive character; it based its finding on the following facts: the certificate issued by the Secretary General of the Consejo Regulador de la Denominación de Origen Calificada 'Rioja', which certifies that the owner markets its wines, among others, under the brand names 'El Coto' and 'Coto de Imaz' since 1977 and that these marks 'enjoy a significant well-known character' in Spain, various decisions of the Spanish Patent and Trade Mark Office acknowledging that the mark 'EL COTO' is well known in Spain, a document on sales evolution, indicating that they had sold under the mark 'El Coto' 339 852, 379 847, 435 857 and 464 080 boxes of twelve bottles of wine in 1995, 1996, 1997 and 1998, respectively' (para. 50).

Importantly, acquisition of enhanced distinctive character by a mark may be a result of its use as part of another registered trade mark.

The outcome of the examination of enhanced distinctiveness will be one of the following:

- Where there is no evidence of enhanced distinctiveness as regards the relevant goods and services or the territory, or the evidence is insufficient, the degree of distinctiveness of the earlier mark will be its inherent distinctiveness (less than normal or normal).
- Where there is evidence of enhanced distinctiveness as regards all or some of the relevant goods and services and the territory, and the evidence is sufficient:
 - if the earlier mark has less than normal inherent distinctiveness, the mark/component may have acquired a normal or even a high degree of distinctiveness, depending on the evidence submitted; or
 - if the earlier trade mark has normal inherent distinctiveness, it may have acquired high distinctiveness.

It must be recalled that although a mark as a whole may have acquired enhanced distinctiveness, there may be descriptive elements that will have less than normal or no distinctiveness. For example, the enhanced distinctiveness of the mark 'Coca Cola' as a whole does not alter the fact that the element 'Cola' remains entirely descriptive for certain products.

Chapter 6 Global assessment

1 Introduction

A likelihood of confusion (including a likelihood of association) exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. If a significant part of the relevant public of the goods or services at issue may be confused as to the origin of the goods or services, this is sufficient. Therefore, there is no need to establish that all actual or potential consumers of the relevant goods or services are likely to be confused.

The likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case; this appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods and services.

Sakpatenti normally examines the most salient and habitually relevant factors relating to likelihood of confusion and establishes their degrees:

1. Similarity of the goods and services
2. The relevant public and its degree of attention and sophistication

3. Similarity of the signs taking into account their distinctive and dominant elements
4. The distinctiveness of the earlier mark

In the last section of a decision containing the global assessment, those factors are weighed up. However, the global assessment can weigh up many other factors that are relevant to deciding on likelihood of confusion.

2 Interdependence Principle

The evaluation of likelihood of confusion implies some **interdependence between the relevant factors** and, in particular, between the previously established findings on the degree of similarity between the marks and that between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa. This principle of interdependence is crucial to the analysis of likelihood of confusion.

The concept of similarity is to be interpreted in relation to the likelihood of confusion, the assessment of which depends on numerous elements and, in particular, on the recognition of the mark on the market, the association that can be made with the used or registered sign, the degree of similarity between the mark and the sign and that between the goods or services identified.

The requirement for a global assessment and the principle of interdependence means that, where there is at least some degree of similarity between the signs and the relevant goods/services, there will be an assessment of likelihood of confusion involving an iterative process that weighs up all the relevant factors. This process takes place in the global assessment section.

In practice, this means that Sakpatenti **will weigh up**, inter alia, the degree of similarity between the goods and services and the degree of attention paid by the relevant public to those goods and services, the degree of similarity between the signs, and whether the impression produced in any aspect of the comparison (visual/aural/conceptual) is more important, and the distinctiveness of the earlier mark.

The outcome depends on the particularities of each case, but as a rule of thumb it can be said that, when there is an average degree of similarity between the signs and between the goods or services, the degree of attention of the relevant public is average and the earlier trade mark has a normal distinctiveness, there will be a likelihood of confusion. However, the lower the degree of one factor, the higher the degree of other factors must be in order to find a likelihood of confusion (bearing in mind that the likelihood of confusion is inversely affected by an increased degree of attention of the relevant public). Therefore, on the basis of an average degree of distinctiveness of the earlier mark and an average degree of attentiveness of the public, the finding of a likelihood of confusion may be justified when the signs are identical or highly similar, despite a low degree of similarity between the goods/services. However, such a finding is more difficult on the basis of a limited distinctiveness of the earlier mark and/or when the degree of attention of the public is higher than average. Furthermore, it is true that, by virtue of the principle of interdependence, a lesser degree of similarity between the goods or services covered may be offset by a greater degree of similarity between the marks, and vice versa. However, there is nothing to prevent a finding that, in view of the circumstances of a particular case, there is no likelihood of confusion, even where identical goods are involved and there is a certain degree of similarity between the marks at issue.

Moreover, the factors to be taken into account and their importance in the global assessment **will vary** according to the particular circumstances. For example, in clear-cut cases where the goods/services and the signs are highly similar or identical, Sakpatenti may find a

likelihood of confusion without assessing all factors — such as enhanced distinctiveness, family of marks, etc.

Importantly, it is not possible to set out in the abstract whether one factor carries more weight than another, because these factors will have varying degrees of relative importance depending on the circumstances. For instance, the degree of visual similarity may weigh more heavily in connection with goods that are usually examined visually, whilst the degree of aural similarity may be more relevant to goods normally ordered orally (see paragraph 4 below).

3 Imperfect Recollection

Although the average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect, account is taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks and must place trust in the imperfect picture of them that he or she has kept in mind. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question. Even consumers with a high degree of attention need to rely on their imperfect recollection of trade marks.

4 Impact of the Method of Purchase of Goods and Services

When evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods or services in question and the way they are marketed. Those factors must be taken into account at the stage of the global assessment of the likelihood of confusion and not at the stage of assessing the similarity of the signs.





The category of goods and services involved may increase the importance of one of the different aspects of similarity between signs (visual, phonetic and conceptual) because of how goods and services are ordered and/or purchased. An aural or conceptual comparison between signs may be less important in the case of goods and services that are usually examined visually or may be tried on before being bought. In such cases, the visual impression of signs counts more in the assessment of likelihood of confusion.

However, it is important to emphasise that, as with all of the factors that are relevant to likelihood of confusion, the factors are interlinked and each set of circumstances must be examined on a case-by-case basis. This means that no general rule should be applied to broad categories of goods or services

4.1 Visual similarity

A good example of where visual similarity can play a greater — but not exclusive — role in the global assessment of the likelihood of confusion is *clothing*. Generally, in clothes shops, customers can either choose the clothes they wish to buy themselves or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion. These considerations played a role in finding no likelihood of confusion between the marks below for, inter alia, certain goods in Class 25.


Earlier sign	Contested sign
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The same considerations were central to a finding of likelihood of confusion in the following cases also for, inter alia, certain goods in Class 25.

Earlier sign	Contested sign
	
<p>PETER STORM</p>	<p>PEERSTORM</p>
	


However, granting preferential consideration to the visual perception does not mean that identical verbal elements can be overlooked due to the presence of striking figurative elements, as can be seen in the case below, where likelihood of confusion was found for goods in Class 25.

Earlier sign	Contested sign
	<p>FISHBONE</p>


In a similar way, the visual impression for marks covering *video games* has also been held to be particularly relevant because these goods are normally purchased after a comprehensive examination of their respective specifications and technical characteristics, firstly upon the basis of information that appears in specialist catalogues or on the internet, and then at the point of sale. For these reasons, the visual differences were key to the finding of no likelihood of confusion.¹⁰⁷

Earlier sign	Contested sign
	

The visual similarity between signs may also have an increased importance where the goods are **ordinary consumer products** (e.g. goods in Classes 29 and 30) that are most commonly purchased in supermarkets or establishments where goods are arranged on shelves and where consumers are guided more by the visual impact of the mark they are looking for. Consequently, for such goods, the visual differences were central to a finding of no likelihood of confusion

Earlier sign	Contested sign
	EGLÉFRUIT

However, the broad principle above does not mean that, for goods that are normally purchased visually, the phonetic impression can be overlooked. This latter point was highlighted in a case involving the marks below where the General Court, confirming the finding of a likelihood of confusion, held that, although *computers and computer accessories* are sold to consumers 'as seen' on shelves in self-service areas, the phonetic identity between the marks at issue was, in this case, at least as important as their visual similarity because an oral discussion of the characteristics of the goods and their mark is also likely to take place at the time of purchase. Furthermore, those goods could be advertised orally, on the radio or by other consumers.

Earlier sign	Contested sign
CMORE	

¹⁰⁷ 08/09/2011, T-525/09, Metronia, EU:T:2011:437, § 38-47

4.2 Aural similarity

In contrast to the cases above, where visual similarity played a stronger role, the aural similarity may have more weight than the visual when the goods or services at issue are, in a significant amount of cases, also ordered orally.

Where goods are ordered orally, the phonetic perception of the sign may also be influenced by factors such as the likely presence of various other sounds perceived by the recipient of the order at the same time. Such considerations are relevant where the goods in question are normally ordered at sales points with an increased noise factor, such as **bars or nightclubs**. In such cases, attaching particular importance to the aural similarity between the signs at issue may be appropriate. These considerations came into play in the finding of likelihood of confusion between the marks below for certain goods in Class 33.¹⁰⁸

Earlier sign	Contested sign	Case No
MIXERY		T-99/01

Nevertheless, the broad principle above does not mean that the visual impression can be overlooked for goods normally purchased orally. Indeed, the General Court of EU has held that although preponderant importance had sometimes been accorded to the phonetic perception of marks for beverages, the phonetic dissimilarities of the marks did not merit particular importance where the specific beverages were widely distributed and sold not only in specialist shops, where they would be ordered orally, but also in large shopping centres, where they would be purchased visually.¹⁰⁹

4.3 Conclusion

The circumstances set out above demonstrate that in certain situations Sakpatenti should grant preferential consideration to the visual or aural perception of marks depending on how the goods and services at issue are ordered or purchased. However, identical or highly similar visual or aural elements cannot be entirely overlooked even in these situations because all the relevant factors are interlinked and interdependent, and each set of circumstances must be examined on a case-by-case basis.

5. Impact of Conceptual Identity or Similarity on the Likelihood of Confusion

A conceptual **similarity** between signs with **analogous** semantic content may give rise to a likelihood of confusion where the earlier mark is particularly distinctive¹¹⁰, where the signs shared the broader concept of a 'bounding feline' but did not evoke the same animal: a puma in the earlier mark and a cheetah in the contested mark).



However, exceptionally, where the signs have the **same** distinctive concept in common accompanied by visual similarities between the signs, this may lead to a likelihood of confusion even in the absence of a particularly high distinctiveness of the earlier mark, as illustrated by the following example.

Earlier sign	Contested sign	Case No
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¹⁰⁸ 15/01/2003, T-99/01, Mystery, EU:T:2003:7, § 48

¹⁰⁹ 03/09/2010, T-472/08, 61 a nossa alegria, EU:T:2010:347, § 106

¹¹⁰ 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24

		<p>14/12/2006, T-81/03, T-82/03 & T-103/03, EU:T:2006:397</p>
<p>G&S: Classes 32, 33</p> <p><i>Assessment:</i> The Court found that the signs had the same concept and that there was significant visual similarity. In the absence of a clear semantic link between a deer or a deer's head and alcoholic or non-alcoholic beverages, the Court found it impossible to deny that the concept of a deer's head portrayed facing forward inside a circle had at least average distinctive character for designating beverages (para. 110). Enhanced distinctiveness was not considered — likelihood of confusion</p>		

A conceptual similarity between the signs may not be sufficient to outweigh the visual and phonetic differences where the concept in common is non-distinctive.

Earlier sign	Contested sign	Case No
<p>K2 SPORTS</p>		<p>31/01/2013, T-54/12, EU:T:2013:50</p>
<p>G&S: Classes 18, 25, 28</p> <p><i>Assessment:</i> Contrary to the Board's finding that there is no conceptual similarity, the term 'sport', notwithstanding its descriptive character, refers to the same concept and leads to the conclusion that there is a degree of conceptual similarity. The Court concluded that this similarity was weak in the context of the overall impression of the signs and in particular of the very weak distinctive character of this term. However, the weak conceptual similarity did not offset the significant visual and phonetic differences between the signs (para. 49) — no likelihood of confusion.</p>		

6 Impact on Likelihood of Confusion of Components that are Non-Distinctive or Distinctive Only to a Low Degree

When assessing the similarity of the signs, an analysis of whether the coinciding components are descriptive, allusive or otherwise weak is carried out in order to calculate the extent to which these coinciding components have a lesser or greater capacity to indicate commercial origin. It may be more difficult to establish that the public may be confused as to origin due to similarities that solely pertain to non- distinctive elements.

Sakpatenti has agreed on a **Common Practice** under the European Trade Mark and Designs Network with regard to the impact on likelihood of confusion of components that are non-distinctive or distinctive only to a low degree.



6.1 Common components with a low degree of distinctiveness

According to the Common Practice, when the marks share an element with a low degree of distinctiveness, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks, as previously assessed in the



comparison of signs. That assessment takes into account the similarities/differences and distinctiveness of the non-coinciding components.

A coincidence in an element with a low degree of distinctiveness **will not normally on its own lead to likelihood of confusion**. However, there may be likelihood of confusion if the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar. There may also be likelihood of confusion if the overall impression of the marks is highly similar or identical.

No likelihood of confusion was found in the following examples.

Earlier sign	Contested sign	Case No
	<p>TORO XL</p>	<p>24/05/2012, T-169/10, EU:T:2012:261</p>
<p><i>G&S: Class 33 Alcoholic beverages</i></p> <p><i>Assessment.</i> The coinciding letters 'XL' have a low degree of distinctiveness for the goods in question. 'XL' is an abbreviation of extra-large size. For the goods in question, namely <i>alcoholic beverages</i>, the public is likely to associate it with an extra quantity of a drink (paras 34, 35). The word element TORO is distinctive (para. 42).</p> <p>The marks are visually, and phonetically dissimilar (paras 46, 48) and there is only a weak conceptual similarity (para. 52). The likelihood of confusion is excluded (para. 57).</p>		
Earlier sign	Contested sign	Case No
<p>ZITRO SPIN BINGO,</p>		<p>29/01/2015, T-665/13, EU:T:2015:55</p>
<p><i>G&S: Classes 9, 41, 42 in relation to games</i></p> <p><i>Assessment.</i> The word 'bingo' is descriptive of the corresponding game of chance, the English word 'spin' alludes to a rotating object or to the action of spinning something (para. 36).</p> <p>The Court confirmed the Board's finding that there was a low degree of visual, aural and conceptual similarity between the signs at issue, despite the fact that they contain the expression 'spin bingo'. Visually, the degree of similarity is low because, regarding the earlier sign, the public would pay attention to the more distinctive element 'zitro', which is devoid of any meaning in the relevant languages and is at the beginning of the sign. Concerning the contested sign, consumers will pay as much attention to the different colour elements of the device which are the circles and the reel on which there is a representation of a smiling face. Aurally, the similarity was weak as well in the light of the descriptive meaning of the expression 'spin bingo', and the fact that the public will pay attention to the more distinctive element 'zitro'. Conceptually, the word 'zitro' was dominant and was not similar to the contested sign (paras 11, 44). There is no likelihood of confusion.</p>		

In the following example there was a likelihood of confusion because other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar.

Earlier sign	Contested sign	Caso no.
		11/02/2015,T-395/12,EU:T:2015:92
<p>G&S: Class 19.</p> <p><i>Assessment:</i> The word element 'solid floor' of the earlier mark is only of weak distinctive character (para. 32), but the differentiating element in the contested sign, 'The professional's choice', will be perceived by the relevant public as a clearly laudatory and banal slogan with no trade mark connotations that would allow them to perceive it as a badge of origin (para. 34) and the figurative elements of the signs at issue are limited (para. 35).</p> <p>There is a [average] visual similarity and a high degree of phonetic and conceptual similarity (paras 36,38, 40).</p> <p>There is a likelihood of confusion for identical and similar goods, namely <i>building materials, not of metal, parquet flooring of plastic and wood, flooring of wood, cork and laminate; subfloors; transportable floors, not of metal</i></p>		

Earlier sign	Contested sign	Caso no.
waterPerfect	AquaPerfect	28/01/2015, T-123/14,EU:T:2015:52
<p>G&S: Class 7</p> <p><i>Assessment:</i> while the element 'Perfect' has a laudatory character, the fact remains that none of the other elements in the signs can be considered to have a greater distinctive character or be dominant. The elements 'aqua' and 'water' also have a weak distinctive character owing to the fact that they will be perceived by the relevant public as meaning 'water' and the goods covered all involve, in one way or another, <i>water</i> (para. 42). Visually and phonetically, the similarity of the signs at issue is not limited to the presence of the term 'perfect' within each of those two signs, since those signs also have the same length and the same number of syllables, that are identically stressed, and an almost identical sequence of vowels; based on an overall impression, the similar elements between the signs referred to prevail globally over the dissimilar elements (paras 28, 32) .The signs were found visually, phonetically and conceptually similar to an average degree (paras 32-33, 40</p>		

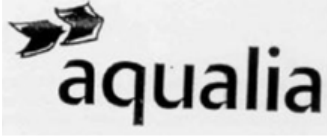

6.2 Common components with no distinctiveness

According to the Common Practice, when marks share an element with **no distinctiveness**, the assessment will focus on the impact of the non-coinciding components on the overall impression of the marks. The assessment will take into account the similarities/differences and distinctiveness of the non-coinciding components.



A coincidence only in non-distinctive components **does not lead to a likelihood of confusion**. However, when marks also contain other figurative and/or word elements that are similar, there will be likelihood of confusion if the overall impression of the marks is highly similar or identical.

No likelihood of confusion was found in the following example, as the signs coincide solely in a non-distinctive element.

Earlier sign	Contested sign	Case No
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		<p>25/02/2016, T-402/14, EU:T:2016:100</p>
<p>G&S: Classes 35, 37, 39, 40, 42</p> <p><i>Assessment.</i> The Court confirmed that the lack of distinctive character of the term 'AQUA' has to be taken into account and that the specialised relevant public will not pay much attention to the descriptive element 'AQUA', the only common element of the conflicting signs (paras 84-85). The figurative elements of the signs are totally different. They are basic but not insignificant, so they must be taken into account in the overall impression of the signs (paras 54-55). There is a low degree of visual similarity. There is a low degree of phonetic and conceptual similarity, even though the different suffixes allow the specialised public to gather a different conceptual content (paras 71-73).</p> <p>The differences between the signs are sufficient to exclude the likelihood of confusion, even for identical services and taking into account that the earlier trademark, as a whole, has an enhanced distinctiveness (para. 86).</p>		

Likelihood of confusion was found in the following examples because the marks also contain other figurative and/or word elements that are similar, and the overall impression of the marks is highly similar or identical.

Earlier sign	Contested sign	Case No
		<p>20/07/2016, T-745/14, EU:T:2016:423</p>
<p>G&S: Classes 36, 38</p> <p><i>Assessment:</i> The Court confirmed that the signs at issue are visually and phonetically highly similar, and conceptually identical, given that they coincide in their word elements, and despite the figurative nature of the signs at issue, the fonts used for the word elements do not make it possible to detect any particular difference between them (para. 28 in fine).</p>		

Earlier sign	Contested sign	Case No
<p>BIOCERT</p>	<p>BIOCEF</p>	<p>10/12/2014 T-605/11, EU:T:2014:1050</p>
<p>G&S: Class 5</p> <p><i>Assessment.</i> The Court found that although the element 'BIO' is descriptive for the goods in question, the trademarks coincide not only in these three letters, but also in their fourth and fifth letters, 'c' and 'e' (para. 38).</p> <p>The difference in the last letters, 'rt' versus 'f', does not counteract the important similarity arising from the fact that the first five letters at the centre of the two signs, which are of very similar length, are identical (para. 39).</p> <p>There is an average degree of visual and phonetic similarity (paras 40, 46), whereas the conceptual comparison is neutral (para. 48)</p>		

6.3 Distinctiveness of the earlier mark versus distinctiveness of the common component

The abovementioned examples concern the coincidence in a weakly distinctive or non-distinctive element of the marks. The distinctiveness of an element of the mark is a separate question from the assessment of the distinctiveness of the earlier mark as a whole (see the Guidelines, Part B, Examination, Section 5, , Chapter 5, Distinctiveness of the Earlier Mark). The enhanced distinctiveness of the earlier mark does not automatically lead to an enhanced distinctiveness of the common element.

However, when the earlier trade mark is entirely contained in the contested TM application and recognisable as such, its degree of distinctiveness naturally equals that of the coinciding element, with the following consequences.

The analysis of the cases where the earlier mark is entirely contained in the contested TM application cannot follow the principles established in paragraph 6.2 above (Common components with no distinctiveness) but rather those established in paragraph 6.1 (Common components with a low degree of distinctiveness). This is because Sakpatenti applies the practice clarified in the judgment of 24/05/2012, C-196/11 P, F1-LIVE, EU:C:2012:314, namely that in proceedings opposing the registration of TM application, the validity of earlier trademarks may not be called into question. Consequently, the elements corresponding to the earlier mark cannot be considered as devoid of distinctive character in the trade mark comparison, but must be deemed to be endowed with some (low/minimal) degree of distinctiveness (see the Guidelines, Part B, Examination, Section 5, Chapter 4, Comparison of Signs, paragraph 3.2.3.5 (Earlier marks, the distinctiveness of which is called into question)).

If the earlier mark contained in the contested TM application enjoys enhanced distinctiveness through use despite low inherent distinctiveness, the common element corresponding to that mark cannot be considered distinctive to a low degree and the principles of the Common Practice mentioned in paragraphs 6.1 and 6.2 above do not apply.

Earlier sign	Contested sign	Case No
MINI		23/01/2015, R 596/2014-4, confirmed 10/03/2016, T-160/15, EU:T:2016:137
<p>G&S: Class 12 <i>Assessment:</i> The earlier trade mark is reputed for <i>cars</i>, and accordingly, it has enhanced distinctive character in the UK. Thus, for the relevant public in the UK, the contested composite sign will be perceived as the widely-known trade mark 'MINI' in combination with the descriptive word 'CARGO'. This is as a direct consequence of the earlier trade mark's repute in the field of motor vehicles (paras 19, 25-26).</p>		

7 Specific Cases

7.1 Short signs

As indicated before, the Courts have not exactly defined what a short sign is. However, signs with three or fewer letters/numbers are considered by Sakpatenti as short signs.

The global assessment of the likelihood of confusion between signs consisting of a single letter (or a combination of letters not recognisable as a word) **follows the same rules** as that in respect of word signs comprising a word, a name or an invented term.¹¹¹

¹¹¹ 06/10/2004, T-117/03 – T-119/03 & T-171/03, NL, EU:T:2004:293, § 47-48; 10/05/2011, T-187/10, G, EU:T:2011:202, § 49

In the assessment of the likelihood of confusion it is important to establish the degree of **inherent distinctiveness** of the earlier trademark, and therefore its scope of protection. See in this respect the Guidelines, Part B, Examination, Section 5, Chapter 5, Distinctiveness of the Earlier Mark, paragraph 2.2.3.1.

As to the overall assessment of likelihood of confusion, the fact that two trademarks consisting of the same letter (or of the same sequence of letters) are found to be identical from an aural and a conceptual point of view is relevant when it comes to assessing the existence of a likelihood of confusion. In such cases, it is only when the later trademark causes a **sufficiently different visual impression** that a likelihood of confusion can be safely ruled out.

Consequently, a likelihood of confusion can be safely excluded when two conflicting signs, albeit containing or consisting of the same single letter or a combination of letters not recognisable as a word, are stylised in a sufficiently different way or contain a sufficiently different figurative element, so that their different overall graphical representation eclipses the common verbal element. See examples in the Guidelines, Part B, Examination, Section 5, Chapter 4, Comparison of Signs, paragraph 3.4.1.6.

Where the applicant has successfully proven that its earlier mark has acquired enhanced distinctiveness through intensive use or reputation, the impact thereof on the final outcome has to be carefully assessed. Firstly, enhanced distinctiveness on the part of an earlier mark containing or consisting of a single letter or a combination of letters cannot justify a finding of a likelihood of confusion if the overall visual impression of the signs is so different as to safely set them apart. Secondly, if the evidence shows use of a single letter or combination of letters stylised or accompanied by additional figurative elements, the benefit of the resulting broader scope of protection accrues to the form in which it was used and not to the single letter as such or any other stylised variation.

7.2 Names

When assessing the likelihood of confusion between signs containing names there are certain specificities that must be taken into account, as explained in paragraphs 7.2.1 and 7.2.2.

7.2.1 Personal Names

The objective visual, phonetic and conceptual similarities resulting from an overlap in a first name or a surname, even where the goods and services at issue are identical and concern the public at large with an average degree of attention, are not decisive as to the question of likelihood of confusion. Rather, what is decisive is the relative importance to be attributed to an overlap in a first name or surname, such as whether a given name and/or surname is common or not in Georgia.

The perception of signs made up of personal names may vary. Surnames have, in principle, a higher intrinsic value as indicators of the origin of goods or services than first names. This is because common experience shows that the same first names may belong to a great number of people who have nothing in common, whereas the presence of the same surname could imply the existence of some link between them (identity of the persons or a family link).



7.2.2 Business names in combination with other components

The assessment of the likelihood of confusion may be influenced by the fact that one of the signs contains several verbal elements, where one such element could be seen as a business name, that is to say, indicating a specific trade origin (typically, a company name preceded by the preposition 'by').

In such a situation, either element (i.e. the business name or the element typically indicating the mark designating the line of product) may become more relevant in the overall impression

of the sign, even if it has a lower degree of distinctiveness or is visually less prominent. This is because in such a situation, both elements of the sign (i.e. the business name and the mark designating the product line) will in principle play an independent distinctive role even where the distinctiveness per se of one of them is lower. On account of this particular configuration of the sign the consumer will perceive the elements independently, as each indicating an aspect of the commercial origin of the goods or services designated by it (e.g. a business name and a mark designating the product line).

Consequently, if the earlier mark is identical (or highly similar) to either element (the business name or the mark designating the product line), even if it is the one that otherwise would be less relevant (e.g. due to its size or due to its lower distinctiveness), there will, in principle, be a likelihood of confusion.

Earlier sign	Contested sign	Case No
		09/04/2014, T-386/12, EU:T:2014:198
<p>G&S: Classes 32, 38, 39</p> <p><i>Assessment:</i> In the present case, the particular structure of the mark applied for must also be taken into account. As the Opposition Division has pointed out, the presence within the mark applied for of the preposition 'by' will lead the consumer, insofar as they understand the meaning, to think that the mark applied for consists of two brands, the sub-brand 'elite' and the main brand 'Mondariz'. As a consequence, the word 'elite' will not be perceived as a mere denomination of one of the characteristics of the goods and services it designates, but rather as an independent and distinct part of the mark in question. That element is likely to reinforce the similarity between the signs at issue, regardless of the higher or lesser intrinsic distinctiveness of the word 'elite' (para. 107) — likelihood of confusion.</p>		

Sub-Section 2 Rights under Articles 5(e) and 5(f) of the Law

1. Appellations of origin and geographical indications

According to article 5(e) of the Law, sign shall be refused registration if it is identical, is similar, incorporates a geographical indication or an appellation of origin, protected in Georgia, or there is a risk of confusion with it, including confusion based on association, and the registration of the trademark is requested for the identical or similar goods, or using such a trademark will result in using the reputation of the protected geographical indication or appellation of origin.

The Law refers to different situations of 'use' against which AOs and GIs are protected:

1. any use of a GI (direct or indirect):
 - a. in respect of products not complying with the product specification of a GI; or
 - b. insofar as such use exploits the reputation of a GI.
2. any misuse, imitation or evocation.

For the purpose of finding whether or not there is use of an AO or GI (hereinafter GI), Sakpatenti will assess whether a TM **contains** a GI as a whole or a term that could be considered **phonetically and/or visually highly similar thereto**.

Under Article 5(e) of the **Law**, it is irrelevant whether or not there are other word or figurative elements that may give the trademark distinctive character. The sign can be acceptable as a whole under Articles 4(1)(c) and 4(1)(d) of the **Law** and can still be objected to under Article 5(e) of the **Law**.

If the mark consists solely of the GI, the TM also falls under **Articles 4(1)(c) and 4(1)(d) of the Law**, since it is considered descriptive both of the geographical origin of the goods and of their quality. This means that Sakpatenti's objection will **simultaneously** raise several absolute grounds for refusal.

While **restricting the relevant goods** (to comply with the specifications of the GI) is usually a means of waiving the objection under Article 5(e) of the Law, it is irrelevant for Articles 4(1)(c) and 4(1)(d) of the **Law**.

For example, an application for the word mark 'MUKUZANI' for *wines* will simultaneously be objected to under both Article 4(1)(d) and Article 5(e) of the **Law**: it consists solely of the AO 'MUKUZANI' and is therefore descriptive both of the geographical origin of the wine and of its quality. Therefore, it lacks as well of distinctive character. If the goods are subsequently limited to *wines* complying with the specifications of the AO 'MUKUZANI', the objection under Article 5(e) of the **Law** will be waived but the trade mark will still be descriptive and non-distinctive and the objection under Articles 4(1)(c) and 4(1)(d) of the **Law** will be maintained.

In addition, there must be a **logical separation of the GI from the rest of the term** for it to be identifiable and liable to objection. In other words, a trade mark will not be liable to objection when it contains the GI as part of a word element that does not bring to the consumer's mind the product whose designation is protected. This is normally the case when the term has its own meaning.

Examples where an objection should not be raised: TORONTO (it does not evoke the PDO 'Toro'), EXCAVADORA (it does not evoke the PDO 'Cava'), IMPORT (it does not evoke the PDO 'Port').

1.1 Limits to the scope of protection

1.1.1 Elements that will not be afforded protection

If a GI contains more than one element within its name (i.e. the indication of a type of a product and the geographical reference, or a grape variety and the geographical reference), some of which would be considered **descriptive or generic**, protection does not extend to the descriptive/generic element.

1.1.1.1 Descriptive elements within the meaning of Article 4(1)(d) of the Law

No objection will be raised to the mere fact that TM contains a descriptive element that is part of a GI. Examples include the GIs 'მაჭახელას თაფლი' ('თაფლი' is the Georgian word for honey) and 'ახალქალაქის კარტოფილი' ('კარტოფილი' is Georgian word for potato).

Where the descriptive nature of an element in a GI can be determined by standard dictionary definitions, the perspective of the public in the country of origin of the GI is determinative. For instance, it suffices that the term 'maçã' will be perceived by Portuguese-speaking consumers as denoting a fruit for it to be concluded that it is descriptive regardless of whether or not it can be understood public in Georgia.

1.1.1.2 Generic terms

"Generic terms" means the names of products which, although relating to the place, region or country where the product was originally produced or marketed, have become the common name of a product in Georgia.

The terms ‘camembert’ and ‘brie’ have been referred to as examples of generic terms by the Court of Justice of the European Union 26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117, § 36).

Other examples are ‘cheddar’ and ‘gouda’¹¹²

1.1.1.3 Names of countries and regions

There are a number of GIs for spirit drinks where the geographically significant part of the GI refers to a whole country, for example: Polska Wódka/Polish Vodka; Suomalainen Vodka/Finsk Vodka/Vodka of Finland; Svensk Vodka/Swedish Vodka; Original Lithuanian vodka; Estonian vodka; Brandi italiano; Irish whiskey.

Sakpatenti considers that the geographical part of the GIs is indissolubly linked to the remaining elements of the GI. In this sense, protection of the GIs does not automatically extend to prohibitions of use of the name of the country or of its adjective for any spirit drink or, more broadly, any alcoholic beverage.

Consequently, when examining TMs applied for in respect of goods in Class 33 alcoholic beverages that include a term referring to a particular country (e.g. Finland) or its adjective (e.g. Finnish) in connection with which there is a registered GI (e.g. Vodka of Finland), Sakpatenti considers that the inclusion of the country reference or its adjective in the TM triggers in the consumer’s mind a link with the product whose designation is protected only for products of the same category (e.g. vodka) and not for comparable goods.

Should a TM include an element that simply refers to a broader region, no objection will be raised, in principle, as it would be difficult to establish a sufficiently clear and direct link with a particular product. It follows from market reality that many agricultural products are produced within a particular region, but not all references to a particular region are to be seen as use of references to a GI. Nevertheless, this will not preclude an objection being raised under Article 4(1)(c) of the Law, depending on the other elements in the TM.

Some of the examples might include references such as ‘Agricoltori di Toscana’/‘Tuscan farmers’, or ‘biodiversita di Sicilia’/‘Sicilian biodiversity’, whereby the use of ‘Tuscany’ and ‘Sicily’ is understood as a mere geographical reference to the region and not as a qualified GI, which would point to a specific product.

4.2 Comparable goods

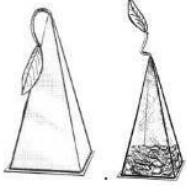

4.3 Exploit or reputation

2. Designs

In the case of a Design, the Standards while comparing earlier design and TM will apply according to the design law of Georgia. In particular, examiner should determine whether trademark has novelty and individual character in comparison with earlier design. Standard of comparison of signs for trademarks is not used while comparing earlier design with TM application.

Earlier right	Contested sign	Case No
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¹¹² see Regulation (EC) No 1107/96, footnotes to the PDOs ‘West Country Farmhouse Cheddar’ and ‘Noord-Hollandse Gouda

 <p>(earlier RCD)</p>	 <p>(shape of a teabag)</p>	<p>14/02/2012, R 2492/2010-2</p>
<p>According to the Design Law of the scope of the protection conferred by a design includes any design which does not produce on the informed user a different overall impression. The earlier Design and the contested TM provoke a different overall impression. ... Furthermore, it is observed that the earlier design introduces additional differences, such as the presence of a remarked base that does not form part of the contested TM. Consequently, the rights conferred by design in present case cannot be invoked against the contested TM' (paras 59-64).</p>		

Sub-Section 3 Trade marks with reputation (Articles 5(d) and 5(g) of the Law)

1 Introduction

1.1 Purpose of Article 5(g) of the Law

Whereas, under Article 5(g) of the **Law**, double identity of signs and goods/services and, under Articles 5(b) and 5(c) of the **Law**, a likelihood of confusion are the necessary preconditions for the protection of a registered trademark, Article 5(g) of the **Law** requires neither identity/similarity of goods/services nor a likelihood of confusion. Article 5(g) of the **Law** grants protection for registered trademarks not only as regards identical/ similar goods/services but also in relation to dissimilar goods/services without requiring any likelihood of confusion, provided the signs are identical or similar, the earlier mark enjoys a reputation, and the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.

The rationale behind the extended protection under Article 5(g) of the **Law** is the consideration that the function and value of a trademark are not confined to its being an indicator of origin. A trade mark can also convey messages other than an indication of the origin of the goods and services, such as a promise or reassurance of quality or a certain image of, for example, luxury, lifestyle, exclusivity, etc. ('advertising function'). Trade mark owners frequently invest large sums of money and effort in creating a certain brand image associated with their trade mark. This image associated with a trade mark confers on it an — often significant — economic value, which is independent of that of the goods and services for which it is registered.

Article 5(g) of the **Law** aims at protecting this advertising function and the investment made in creating a certain brand image by granting protection to reputed trademarks, irrespective of the similarity of the goods or services or of a likelihood of confusion, provided it can be demonstrated that use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. Consequently, the main focus of Article 5(g) of the **Law** is not the protection of the general public against confusion as to origin, but rather the protection of the trademark proprietor against use that takes unfair advantage of, or is detrimental to, the distinctive character or repute of a mark for which it has made significant investments.

1.2 Legal framework

According to Article 5(g) of the **Law**, upon opposition by the proprietor of a registered earlier trade mark, the trade mark applied for will not be registered: where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied

are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, an earlier trade mark has a reputation in Georgia, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

2 Scope of Applicability

2.1 Applicability to registered marks

2.1.1 The requirement of registration

According to the clear wording of the Article 5(g) of the **Law** this norm protects a 'registered earlier trade mark'. Hence, the applicability should be limited only to earlier trademarks that are already registered.

2.1.2 Relationship between marks with reputation and well-known marks

The requirement of **registration** serves to mark the border between Articles 5(g) and 5(d) of the **Law**. However, neither Article 5(d) of the **Law** nor Article 6*bis* of the Paris Convention stipulate expressly that the well-known mark must be a non-registered mark. The reason for the principle that only non-registered marks are covered by these latter provisions results indirectly both from the spirit and the *ratio legis* of these provisions.

Even though the terms 'well known' (a traditional term used in Article 6*bis* of the Paris Convention) and 'reputation' denote distinct legal concepts, there is a **substantial overlap** between them, as shown by a comparison of how well-known marks are defined in the WIPO Joint Recommendation Concerning Provision on the Protection of Well-Known Marks with how reputation was described by the Court of Justice in its judgment of 14/09/1999, C-375/97, Chev, EU:C:1999:408, § 22 (concluding that the different terminology is merely a '... nuance, which does not entail any real contradiction ...').

In practical terms, the threshold for establishing whether a trademark is well known or enjoys reputation will usually be the same. Therefore, it will not be unusual for a mark that has acquired well-known character to have also reached the threshold laid down for marks with reputation, given that in both cases the assessment is principally based on quantitative considerations regarding the degree of knowledge of the mark among the public, and that the thresholds required for each case are expressed in quite similar terms ('known ...' or 'well known in at least one relevant sector of the public' for well-known marks, and 'known by a significant part of the public concerned' for marks with reputation).

This has also been confirmed by case-law. In its judgment of 22/11/2007, C-328/06, Fincas Tarragona, EU:C:2007:704, the Court qualified the notions of 'reputation' and 'well known' as kindred concepts, underlining in this way the substantial overlap and relationship between them (para. 17).

The requirements for applying Article 6*bis* of the Paris Convention and Article 5(d) of the **Law** are the same, although the terminology used is different. Both provisions require similarity or identity between the goods or services, and similar or identical signs (Article 6*bis* uses the terms 'reproduction', which is equivalent to identity, and 'imitation', which refers to similarity). Both Articles also require a likelihood of confusion ('liable to create confusion' is the phrase used in Article 6*bis*). However, required degree of similarity in both cases is lower compared to the requirement for Article 5(c) (further on assessment of similarity see paragraph 3.2 below). Furthermore, Articles 5(c) and 5(d) of the **Law** also applies even where the goods are dissimilar if the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

If the opponent bases the opposition on (i) an earlier registration invoking Articles 5(b) or 5(c) and Article 5(g) of the **Law** and (ii) an identical earlier well-known mark under Article 5(d) of the Law, the earlier right must be examined:

1. Under Articles 5(b) or 5(c) of the **Law** as an earlier **registration** with enhanced distinctiveness (in view of its well-known character).
2. Under Article 5(g) of the **Law**, as an earlier **registration** with reputation.
3. Under Article 5(d) of the **Law** as an earlier **non-registered well-known mark** (which will only be useful if registration is not proven, as otherwise the outcome is the same as in bullet point 1 above).

Even if the opponent has not expressly based its opposition on Articles 5(d) or 5(g) of the **Law**, the contents of the opposition must be carefully analysed with a view to objectively establishing whether the opponent also wants to rely on Articles 5(d) or 5(g) of the **Law**.

2.2 Applicability to similar and identical goods and services

According to the clear wording of the Article 5(g) of the **Law**, the protection provided by this provision is 'irrespective of whether the goods or services for which [the later mark] is applied are identical with, similar to or not similar to those for which the earlier trademark is registered'.

3 Conditions of Application

The following conditions need be met for Article 5(g) of the **Law** to apply:

1. earlier **registered mark with reputation** in Georgia.
2. **identity or similarity** between the contested TM application and the earlier mark.
3. use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark.
4. such use must be **without due cause**.

These conditions are **cumulative** and failure to satisfy any one of them is sufficient to render that provision inapplicable.

The order in which these requirements are examined may vary depending on the circumstances of each case. For instance, the examination may start by assessing the similarities between the signs, especially where there is little or nothing to say on the subject, either because the marks are identical or because they are patently similar or dissimilar.

3.1 Earlier mark with reputation

3.1.1 Nature of reputation

The nature and scope of reputation are not defined by the Law. Given the lack of statutory definition, the nature of reputation should be defined by reference to the purpose of the relevant provision. The text of the Law 'implies a **certain degree of knowledge of the earlier trade mark** among the public' and it 'is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks ... and that the earlier mark may consequently be damaged' .

In view of these considerations, the reputation is a **knowledge threshold requirement**, implying that it must be principally assessed on the basis of **quantitative** criteria. In order to satisfy the requirement of reputation, the earlier mark must be known by a significant part of the public concerned by the goods or services covered by that trade mark.¹¹³

Moreover, if reputation is to be assessed on the basis of quantitative criteria, arguments or evidence relating to the esteem in which the public might hold the mark, rather than to its

¹¹³ 14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 22-23; 25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 34

recognition, are not directly relevant for establishing that the earlier mark has acquired sufficient reputation for the purposes of Article 5(g) of the **Law**. However, as the economic value of reputation is also the protected subject-matter of this provision, any **qualitative aspects** thereof are relevant when assessing the possibility of detriment or unfair advantage (see also paragraph 3.4 below). Article 5(g) of the **Law** protects ‘famous’ marks not as such, but rather for the success and renown (‘goodwill’) they have acquired in the market. A sign does not enjoy any reputation inherently, for example, simply because it refers to a renowned person or event, but only for the goods and services it designates and the use that has been made of it.

Case No	Comment
22/07/2010, R 11/2008-4, CASAS DE FERNANDO ALONSO (fig.) / FERNANDO ALONSO	All the evidence submitted by the opponent related to the fame of Fernando Alonso as a champion racing driver and to the use of his image by different undertakings to promote their goods and services. There was no proof of reputation for use of the earlier mark as registered for the relevant goods and services (paras 44 and 48).
03/03/2011, R 201/2010-2, BALMAIN ASSET MANAGEMENT / BALMAIN (fig.)	The only items of evidence regarding reputation of the earlier mark submitted within the time limit, namely a page showing websites containing the word ‘BALMAIN’, a Wikipedia extract about the French designer Pierre Balmain, and five extracts from the website www.style.com referring to the ‘BALMAIN’ wear collection, were clearly not sufficient to establish the reputation of the earlier mark in the EU. Therefore, the opposition was rejected as unsubstantiated (paras 36 and 37).

3.1.2 Scope of reputation

3.1.2.1 Degree of recognition

Having defined reputation as a knowledge threshold requirement, the question that necessarily follows is **how much awareness** the earlier mark must attain among the public in order to pass this threshold. The ‘degree of knowledge required must be considered to be reached when the earlier trade mark is **known by a significant part** of the public’ and it ‘cannot be inferred from the Law that the trade mark must be known by a given percentage of the public’.¹¹⁴

Therefore, the use of fixed criteria of general applicability is not recommended since a predetermined degree of recognition may not be appropriate for a realistic assessment of reputation if taken alone.

Hence, in determining whether the earlier mark is known by a significant part of the public, account must be taken not only of the degree of awareness of the mark, but also of **any other factor** relevant to the specific case. For more about the relevant factors and their interplay, see paragraph 3.1.3 below.

However, where goods or services concern quite **small groups of consumers**, the limited overall size of the market means that a significant part thereof is also restricted in absolute numbers. Hence, the limited size of the relevant market should not be regarded in itself as a factor capable of preventing a mark from acquiring a reputation within the meaning of Article 5(g) of the **Law**, as reputation is more a question of proportions and less of absolute numbers.

The need for the earlier mark to be known by a significant part of the public also serves to mark the difference between the notions of **reputation** as a necessary condition for the

¹¹⁴ 14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 25-26; 16/11/2011, T-500/10, Doorsa, EU:T:2011:679, § 45

application of Article 5(g) of the **Law** and **enhanced distinctiveness through use** as a factor for evaluating likelihood of confusion for the purposes of Article 5(c) of the **Law**.

Even though both terms are concerned with the recognition of the mark among the relevant public, in the case of **reputation** a **threshold** exists below which extended protection cannot be granted, whereas in the case of **enhanced distinctiveness** there is **no threshold**. It follows that in the latter case any indication of enhanced recognition of the mark should be taken into account and evaluated according to its significance, regardless of whether it reaches the limit required by Article 5(g) of the **Law**. Therefore, a finding of 'enhanced distinctiveness' under Article 5(c) of the **Law** will not necessarily be conclusive for the purposes of Article 5(g) of the **Law**.

Case No	Comment
21/04/2010, R 1054/2007-4, MANDARINO (fig.) / MANDARINA DUCK (fig.)	The documents submitted by the opponent showed promotional efforts in such a way that the distinctiveness was increased through use. However, the use was not enough to reach the threshold of reputation. None of the documents referred to the recognition of the earlier trade mark by the relevant end consumers; nor was any evidence submitted about the market share of the opponent's goods (para. 61).

3.1.2.2 Relevant public

The 'public amongst which the earlier trade mark must have acquired a reputation is **that [public] concerned by that trade mark**, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector'.

Hence, if the goods and services covered by the mark are **mass consumption** products, the relevant public will be the **public at large**, whereas if the designated goods have a very **specific application** or exclusively target **professional or industrial users**, the relevant public will be limited to the **specific purchasers** of the products in question.

Case No	Comment
04/08/2011, R 1265/2010-2, MATTONI (fig.) / MATTONI	Taking into account the nature of the goods for which the opponent claims reputation, namely <i>mineral water</i> , the relevant public is the public at large (para. 44).
15/09/2011, R 2100/2010-1, SEXIALIS / CIALIS et al.	The goods for which the sign enjoys reputation are <i>medicinal preparations for the treatment of sexual dysfunction</i> . The relevant public is the general public and professionals with a high level of attention (para. 64).
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl; Confirmed 10/05/2012, C-100/11 P, Botolist / Botocyl	The goods for which the earlier mark enjoys reputation are <i>pharmaceutical preparations for the treatment of wrinkles</i> . The evidence of the promotion of the earlier mark 'BOTOX' in English in the scientific and general-interest press was sufficient to establish the mark's reputation amongst both the general public and health-care professionals (C-100/11 P, paras 65 to 67). Therefore, both these categories of consumers have to be taken into account.

In addition to the actual buyers of the relevant goods, the notion of the relevant public extends to the **potential purchasers** thereof, as well as to those members of the public that only come **indirectly into contact** with the mark, to the extent that such consumer groups are also targeted by the goods in question, for instance, sports fans in relation to athletic gear, or frequent air-travellers as regards air carriers, etc.

Case No	Comment
10/05/2007, T-47/06, Nasdaq, EU:T:2007:131	The relevant services are stock exchange price quotation services in Classes 35 and 36, which normally target professionals. The opponent submitted evidence showing that the mark 'NASDAQ' appears almost daily in many newspapers and on many television channels that can be read/viewed throughout Europe. Therefore, the Board was right to hold that the reputation of the trade mark 'NASDAQ' had to be determined for European consumers not only among the professional public, but also in an important subsection of the general public (paras 47 and 51).
06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348	The evidence submitted in respect of reputation supports and reinforces the fact that the relevant public for <i>theatre productions</i> is the public at large and not a limited and exclusive circle. The intervener's activities were advertised, presented and commented on in numerous newspapers targeting the public at large. The intervener toured different regions throughout the United Kingdom and performed before a wide public in the United Kingdom. An activity on a large scale and, hence, a service offered to the public at large, is reflected both in the high turnover and the high box-office sales. Furthermore, it is clear from the documents submitted by the intervener that the intervener received substantial annual sponsorship income from undertakings in diverse sectors that also reach the public at large, such as banks, undertakings in the alcoholic drinks sector and car manufacturers (paras 35 and 36).

Quite often, a given product will concern **various purchaser groups** with different profiles, as in the case of multipurpose goods or goods that are handled by several intermediaries before they reach their final destination (distributors, retailers, end- users). In such cases the question arises whether reputation has to be assessed within each separate group or if it should cover all the different types of purchaser. The example given by the Court in its judgment of 14/09/1999, C-375/97, Chevy, EU:C:1999:408 (traders in a specific sector) implies that reputation within one single group may suffice.

Likewise, if the earlier trade mark is registered for quite **heterogeneous goods/ services**, different segments of the public may be concerned by each type of good/ service, and, therefore, the overall reputation of the mark will have to be assessed separately for each category of goods involved.

The foregoing only deals with the kind of public to be taken into account when assessing whether the earlier mark has reached the threshold of reputation laid down by the Court in *Chevy (General Motors)*. However, a relevant question arises when assessing detriment or unfair advantage, namely whether the earlier mark must also be known to the public concerned by the goods and services of the later mark, since otherwise it is difficult to see how the public will be in a position to associate the two. This issue is discussed in paragraph 3.4 below.

3.1.2.3 Goods and services covered

The goods and services must first of all be those for which the earlier trade mark is registered and for which reputation is claimed.

Case No	Comment
28/04/2011, R 1473/2010-1, SÜEDTIROL / SÜDTIROL (fig.) et al.	The opposition was dismissed since the earlier marks were not registered for the services that, according to the opponent, enjoy a reputation. Article 8(5) TMR can only be invoked if the trademark affirmed to be well known/renowned is a registered trade mark and if the goods/services for which this reputation/renown is claimed appear on the certificate (para. 49).

The goods and services to which the evidence refers have to be identical (not only similar) to the goods and services for which the earlier trademark is registered.

Case No	Comment
09/11/2010, R 1033/2009-4, PEPE / bebe	The goods that were assessed to be reputed in Germany by the decision and order referred to only concern articles of skin and body care and children's cream. These articles are not identical to the earlier mark's goods in Class 3, <i>make-up products; nail treating products; namely nail lacquer and remover</i> . Therefore, the opponent did not prove reputation for the earlier German mark in the relevant territories (para. 31).

Where the earlier mark is registered for a wide range of goods and services targeting different kinds of public, it will be necessary to assess reputation separately for each category of goods. In such cases the earlier mark may not have a reputation for all of them, as it may not have been used at all for some of the goods, whereas for others it may not have reached the degree of knowledge necessary for the application of Article 5(g) of the **Law**.

Hence, if the evidence shows that the earlier mark enjoys a **partial reputation**, that is, the reputation only covers some of the goods or services for which it is registered, it is only to that extent that this mark may be protected under Article 5(g) of the **Law**. Consequently, it is **only these goods** that may be taken into account for the purposes of the examination.

Case No	Comment
14/06/2011, R 1588/2009-4, PINEAPPLE / APPLE	The Board concluded that the enhanced distinctiveness and reputation of the earlier marks did not concern the opponent's G&S, which were considered to be identical or similar to the contested G&S. For these G&S no enhanced distinctiveness or reputation was proven, with the exception of <i>computer software</i> in Class 9 (para. 43).
10/12/2009, R 1466/2008-2 & R 1565/2008-2, COMMERZBANK ARENA / ARENA et al.	The evidence submitted sufficiently demonstrated that the 'ARENA' brand was known by a significant part of the relevant public. However, the evidence did not include any relevant information that could allow the level of brand awareness of the 'ARENA' brand in sectors other than <i>swimwear and swimming articles</i> to be determined (paras 58 and 60).

3.1.2.4 Relevant territory

According to Article 5(g) of the **Law**, the **relevant territory** for establishing the reputation of the earlier mark is Georgia.

3.1.2.5 Relevant point in time

The opponent must show that the earlier mark had acquired a reputation by the **filing date** of the contested TM application. Where appropriate, any **priority** claimed must be taken into account provided that the priority claim has been accepted by Sakpatenti.

In addition, the reputation of the earlier mark must subsist until the decision on the opposition is taken. However, in principle it will be sufficient for the opponent to show that its mark already had a reputation on the filing/priority date of the TM application, while any subsequent **loss of reputation** is for the applicant to claim and prove. In practice, such an occurrence will be rather exceptional, since it presupposes a dramatic change of market conditions over a relatively short period of time.

In general, the **closer to the relevant date** the evidence is, the **easier** it will be to assume that the earlier mark had **acquired reputation** at that time. The evidential value of a particular document is likely to vary depending on how close the period covered is to the filing date. Evidence of reputation with regard to a later point in time than the relevant date might nevertheless allow conclusions to be drawn as to the earlier mark's reputation at the relevant date.¹¹⁵

For this reason, the materials submitted with a view to proving reputation must be dated, or at least **clearly indicate when** the facts attested therein took place. Consequently, undated documents, or documents bearing a date added afterwards (e.g. hand-written dates on printed documents), are not appropriate for giving reliable information about the material time.

Case No	Comment
15/03/2010, R 55/2009-2, BRAVIA / BRAVIA	The evidence showed that the mark 'BRAVIA/ BRAVIA' was used for LCD televisions in Austria, the Czech Republic, France, Germany, Hungary, Italy, the Netherlands, Poland, Portugal, Slovakia and Turkey. However, none of the documents were dated. The opponent failed to submit any information regarding duration. Therefore, the evidence, taken as whole, was insufficient to prove reputation in the European Union (paras 27 and 28).
09/11/2010, R 1033/2009-4, PEPE / bebe	In the Board's view, a judgment from 1972 was not able to prove enhanced distinctiveness at the time of filing the mark, that is, 20/10/2006. Furthermore, it follows from the decision of the [Court] [21/04/2005, T-164/03, monBeBé, EU:T:2005:140] that the reputation of the earlier mark has been assessed as from 13 June 1996, i.e. more than ten years before the reputation date to be taken into consideration' (para. 31).

If the **period** between the latest evidence of use and the filing of the TM application is quite **significant**, the relevance of the evidence should be carefully assessed by reference to the kind of goods and services concerned. This is because changes in consumer habits and perceptions may take some time to happen, usually depending on the particular market involved.

For instance, the clothing market is strongly tied to yearly seasons and to the different collections presented every quarter. This will have to be taken into account in assessing a possible loss of reputation in this particular field. Likewise, the market for internet providers and e-commerce companies is very competitive and undergoes rapid growth, as well as rapid demise, which means that reputation in this area may be diluted faster than in other market sectors.

A similar question arises in the case of **evidence that post-dates the filing date** of the TM application. Even though such evidence will not usually be sufficient on its own to prove that the mark had acquired a reputation when the TM was filed, it is not appropriate to reject it as irrelevant either. Given that reputation is usually built up over a period of years and cannot simply be switched on and off, and that certain kinds of evidence (e.g. opinion polls, affidavits) are not necessarily available before the relevant date, as they are usually prepared only after the dispute arises, such evidence must be evaluated on the basis of its contents **and in conjunction with the rest of the evidence**. For example, an opinion poll conducted after the material time but showing a sufficiently high degree of recognition might be sufficient to prove that the mark had acquired a reputation on the relevant date if it is also shown that the market conditions have not changed (e.g. the same levels of sales and advertising expenditure were maintained before the opinion poll was carried out).

¹¹⁵ 27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 31; 17/04/2008, C-108/07 P, Ferro, EU:C:2008:234, § 53; 15/12/2005, T-262/04, Briquet à Pierre, EU:T:2005:463, § 82

Case No	Comment
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed 10/05/2012, C-100/11 P, EU:C:2012:285	Although the reputation of an earlier mark must be established at the filing date of the contested mark, documents bearing a later date cannot be denied evidential value if they enable conclusions to be drawn with regard to the situation as it was on that date (para. 52).
05/10/2020, T-51/19, apiheal (fig.) / APIRETAL, EU:T:2020:468	Even if some documents submitted to prove the reputation of the earlier mark bear a date which is e.g. 5 years earlier than the filing date of the contested EUTM, this fact does not deprive such documents of their evidential value. It cannot automatically be ruled out that a document drawn up some time before or after the relevant date may contain useful information since the reputation of a trade mark is, in general, acquired progressively (para. 112).


The possibility cannot automatically be ruled out that a document drawn up some time before or after that date may contain useful information in view of the fact that the reputation of a trade mark is, in general, acquired progressively. The evidential value of such a document is likely to vary depending on how close the period covered is to the filing date.

Case No	Comment
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed by 10/05/2012, C-100/11 P	The press articles submitted proved that there was significant media coverage of the products marketed under the trademark BOTOX on the filing date of the disputed marks (para. 53).


3.1.2.6 Reputation acquired as part of another mark


Reputation proven for a complex sign refers to that sign as such and not a particular element alone. As an example, the reputation acquired by a figurative mark may, but will not automatically, benefit a word mark with which it is subsequently used.


To establish the reputation of a trade mark on the basis of evidence relating to the use and well-known nature of a different trade mark, the former must be included in the latter and play therein 'a predominant or even significant role'. When the earlier mark has been used as part of another mark, it is incumbent on the opponent to prove that the earlier mark has independently acquired a reputation. The examples below give guidance.

Case No	Comment
17/03/2015, T-611/11, Manea Spa, EU:T:2015:152 (Relevant Classes 3, 24, 25, 43 and 44)	The word mark 'Spa' was used as part of another registration combining the word element with the logo of a pantomime character, as reproduced here  The word element occupies a central position in the complex sign, and therefore plays a 'distinct and predominant' role.

Case No.	Comment
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<p>17/02/2011, T-10/09, F1-Live, EU:T:2011:45; 24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314 (Relevant Classes 16, 38 and 41) And 21/05/2005, T-55/13, F1H20 / F1 et al., EU:T:2015:309 (Relevant Classes 9, 25, 38 and 41)</p>	<p>On the other hand, in case T-10/09 it was held that the evidence of reputation referred to the earlier figurative mark 'F1 Formula 1'  and not to the earlier word marks, 'F1'. Without its particular logotype the text 'Formula 1' and its abbreviation 'F1' are perceived as descriptive elements for a category of racing cars or races involving those cars. The reputation was not proven for the word marks (see paras 53, 54 and 67).</p>
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Case No	Comment
<p>12/02/2015, T-76/13, QUARTODIMIGLIO QM, EU:T:2015:94</p>	<p>The same conclusion applies to a 'winged hourglass' figurative element used in a complex mark in association with the word 'Longines' </p> <p>The figurative element remains clearly ancillary and in the background in the overall impression conveyed by the complex mark (paras 104 to 106). The Court found that the opponent had failed to submit opinion polls showing the recognition of the 'winged hourglass' logo independently of the word element, and the use of this figurative element alone in a limited number of documents was found insufficient from both a quantitative and qualitative point of view (paras 91 to 93 and para. 112).</p>

Case No	Comment
<p>27/06/2019, T-334/18, ANA DE ALTUN (fig.) / ANNA (fig.) et al., EU:T:2019:451</p>	<p>The evidence showed reputation of the earlier word mark 'ANNA DE CODORNIU', but that evidence did not prove that the earlier figurative mark </p> <p>was reputed on its own (paras 38-39). While a mark may also acquire reputation as a result of its use under a different form, in particular under the form of another registered mark, this is dependent on the condition that the relevant public continues to perceive the goods as originating from the same undertaking (para. 45).</p>

3.1.3 Assessment of reputation — relevant factors

Apart from indicating that '[i]t cannot be inferred from either the letter or the spirit of Article] that the trade mark must be known by a **given percentage** of the public', **all the relevant facts** must be considered when assessing the reputation of the earlier mark, 'in particular the **market share** held by the trade mark, the **intensity, geographical extent** and **duration** of its use, and the **size of investment** made by the undertaking in promoting it'.

If these two statements are taken together, it follows that the level of knowledge required for the purposes of Article 5(g) of the Law cannot be defined in the abstract, but should be evaluated on a **case-by-case** basis, taking into account **not only the degree of awareness of the mark, but also any other fact relevant to the specific case**, that is, any factor capable of giving information about the performance of the mark in the market.

The list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark (such as the market share held by the trade mark, the intensity, geographical extent and

duration of its use, and the amount spent by the undertaking in promoting it) only serve as examples. The conclusion that the mark enjoys reputation does not necessarily have to be reached on the basis of indications regarding all those factors.

Case No	Comment
10/05/2007, T-47/06, Nasdaq, EU:T:2007:131	<p>The opponent provided detailed evidence relating to the intensity, geographical extent and duration of use of its trademark, Nasdaq, as well as to the amount spent in promoting it, demonstrating that it was known by a significant part of the relevant public. The Court considered that the fact that it did not produce figures regarding market share did not call this finding into question (para. 51).</p> <p>The Court concluded that, first, the factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence produced by the intervener is already sufficient in itself to conclusively prove the reputation of its mark, Nasdaq (para. 52).</p>

Moreover, the relevant factors should be assessed with a view not only to establishing the degree of recognition of the mark amongst the relevant public, but also to ascertaining whether the **other requirements** related to reputation are fulfilled, for example, whether the alleged reputation covers a significant part of Georgia or whether the reputation had indeed been acquired by the filing/priority date of the contested TM application.

The same kind of test is applied to ascertain whether the trade mark has acquired **enhanced distinctiveness** through use for the purposes of Articles 5(b) or 5(c) of the **Law**, or whether the mark is **well known** within the meaning of Article 6*bis* of the Paris Convention, since what has to be proven in all these cases is in substance the same, namely the degree to which the mark is known by the relevant public, without prejudice to the threshold required in each case.

3.1.3.1 Trademark awareness

The statement that it is not necessary for the mark to be ‘known by a given percentage of the public’, cannot be taken in itself as meaning that figures of trademark awareness are irrelevant, or should be given a lower probative value, when assessing reputation. It only implies that percentages of awareness defined in the abstract may not be appropriate for all cases and that, consequently, it is **not possible to fix a priori a generally applicable threshold of recognition** beyond which it should be assumed that the mark is reputed¹¹⁶.

Therefore, the **degree of recognition** of the mark amongst the relevant public is **directly relevant** and can be particularly helpful in evaluating whether the mark is sufficiently known for the purposes of Article 5(g) of the **Law**, provided of course that the method of its calculation is reliable.

As a rule, the **higher the percentage** of trademark awareness, the **easier** it will be to accept that the **mark has a reputation**. However, in the absence of a clear threshold, only if the evidence shows a **high degree** of trademark awareness, will percentages of recognition be **persuasive**. Percentages alone are not conclusive. Rather, as explained before, reputation has to be evaluated by making an overall assessment of all the factors relevant to the case. The higher the degree of awareness, the less additional evidence may be required to prove reputation and vice versa.

¹¹⁶ 04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 52; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 24; 16/11/2011, T-500/10, Doorsa, EU:T:2011:679, § 52

Case No.	Comment
24/02/2010, R 765/2009-1, Bob the Builder (fig.) / BOB et al.	The evidence submitted proved that the earlier mark enjoyed a very significant reputation in Sweden for <i>jellies, jams, fruit stews, fruit drinks, concentrates for production of drinks and juice</i> . According to the survey conducted by TNS Gallup, spontaneous awareness (answers by telephone to the question 'What brands for — 'the relevant group of products is mentioned' — have you heard about or do you know about?') of the trade mark 'BOB' varied between 25 % and 71 %, depending on the goods: <i>apple sauces, jams, marmalades, soft drinks, fruit drinks and fruit juices</i> . Supported awareness (answers to a questionnaire showing the products bearing the mark) varied between 49 % and 90 %, depending on the goods. Furthermore, the market share for 2001 to 2006 averaged 30-35 % in the above product groups (para. 34).

Where the evidence shows that the mark only enjoys a **lesser degree of recognition**, it should not automatically be assumed that the mark is reputed; this means that, most of the time, **mere percentages will not be conclusive** in themselves. In such cases, only if evidence of awareness is coupled with sufficient indications of the overall performance of the mark in the market will it be possible to evaluate with a reasonable degree of certainty whether the mark is known by a significant part of the relevant public.

3.1.3.2 Market share

The **market share** enjoyed by the goods offered or sold under the mark and the **position** it occupies in the market are valuable indications for assessing reputation, as they both serve to indicate the **percentage of the relevant public that actually buys** the goods and to measure the success of the mark against competing goods.

Market share is defined as the **percentage of total sales** obtained by a brand in a particular sector of the market. When defining the relevant market sector, the goods and services for which the **mark has been used** must be taken into account. If the scope of such goods and services is narrower than those for which the mark is registered, a situation of partial reputation arises, similar to the one where the mark is registered for a variety of goods, but has acquired a reputation only for part of them. This means that, in such a case, only **the goods and services for which the mark has actually been used and acquired a reputation will** be taken into account for the purposes of the examination.

Therefore, a very **substantial market share**, or a **leader position** in the market, will usually be a **strong indication of reputation**, especially if combined with a reasonably high degree of trade mark awareness. Conversely, a **small market share** will in most cases be an **indication against reputation**, unless there are other factors that suffice on their own to support such a claim.

Case No.	Comment
16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed 10/05/2012, C-100/11 P, EU:C:2012:285	'... the size of the market share of BOTOX in the United Kingdom, 74.3 % in 2003 , like the degree of awareness of the trade mark of 75 % among the specialised public accustomed to pharmaceutical treatments against wrinkles, is sufficient to substantiate the existence of a considerable degree of recognition on the market' (para. 76).
13/12/2004, T-08/03, Emilio Pucci, EU:T:2004:358	The Court considered that the opponent failed to prove the enhanced distinctiveness or reputation of its earlier trade marks, since the evidence submitted (advertisements, seven letters from a number of advertising directors and a video cassette) did not include adequately substantiated or verifiable objective evidence to make it possible to assess the market share held by the marks Emilio Pucci in Spain, how intensive, geographically widespread and long-standing use of the marks had been, or the amount invested by the undertaking in promoting them (para. 73).

Another reason why a **moderate market share will not always be conclusive against reputation** is that the percentage of the public that in reality knows the mark may be much higher than the number of actual buyers of the relevant goods. This would be the case, for example, for goods that are normally used by more than one user (e.g. family magazines or newspapers) or for luxury goods, which many may know, but few can buy (e.g. a high percentage of European consumers know the trade mark 'Ferrari' for cars, but only few own one). For this reason, the market share proved by the evidence should be assessed taking into account the particularities of the specific market.

Case No	Comment
29/05/2012, R 1659/2011-2, KENZO / KENZO	KENZO identifies, in the eyes of the public, a pre-eminent provider of recognised fashion and luxury items in the form of perfumes, cosmetics and clothing. The relevant public however was considered to be the general public (para. 29).

In certain cases it will **not be easy to define the market share** of the earlier mark, for example when the exact size of the relevant market cannot be measured accurately, owing to peculiarities of the goods or services concerned.

Case No	Comment
12/01/2011, R 446/2010-1, TURBOMANIA / TURBOMANIA	The limited presence of the product on the market by no means prevented it from becoming well known by the relevant public. The evidence clearly showed that the trade mark appeared continuously in specialist magazines for the market from December 2003 to March 2007 (the date of the TM application). That meant that the public targeted by the magazines had constant, ongoing exposure to the opponent's trade mark over a long period covering more than 3 years prior to the relevant date. Such a huge presence in the press specifically targeting the relevant public was more than sufficient evidence that the relevant public was aware of the trade mark (para. 31).

In such cases, **other similar indications** may be relevant, such as TV audience ratings, as in the case of motor racing and other sporting or cultural events.

Case No	Comment
10/05/2007, T-47/06, Nasdaq, EU:T:2007:131	The opponent submitted evidence showing that the mark Nasdaq appeared almost daily, particularly with reference to the Nasdaq indices, in many newspapers and on many television channels that can be read/viewed throughout Europe. The opponent also submitted evidence of substantial investments in advertising . The Court found reputation proven, even though the opponent did not submit any market share figures (paras 47 to 52).

3.1.3.3 Intensity of use

The intensity of use of a mark may be demonstrated by **sales volumes** (i.e. the number of units sold) and **turnover** (i.e. the total value of those sales) attained by the opponent for goods bearing the mark. Usually, the relevant figures correspond to sales in 1 year, but there may be cases where the time unit used is different.

Case No	Comment
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<p>15/09/2011, R 2100/2010-1, SEXIALIS / CIALIS et al.</p>	<p>The documents submitted (press articles, sales figures, surveys) showed that the earlier sign, CIALIS, was intensively used before the filing date of the TM application, that the products under the mark CIALIS were marketed in several Member States where they enjoyed a consolidated position among the leading brands, and that there was a high degree of recognition when compared with the market leader Viagra. Large and constantly growing market share and sales numbers also showed 'the vast expansion of CIALIS' (para. 55).</p>
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In evaluating the importance of a given turnover or sales volume, account should be taken of **how large the relevant market is in terms of population**, as this has a bearing on the number of potential purchasers of the products in question.

Moreover, whether or not a given sales volume or turnover is substantial will depend on the **kind of product** concerned. For example, it is much easier to achieve a high sales volume for everyday mass consumption goods than for luxury or durable products that are bought rarely, without this meaning that in the former case more consumers have come into contact with the mark, as it is likely that the same person has bought the same product more than once. It follows that the **kind, value and durability** of the goods and services in question should be taken into consideration in determining the significance of a given sales volume or turnover.

Turnover and sales figures will be more useful as **indirect indications**, to be assessed in conjunction with the rest of the evidence, than as direct proof of reputation. In particular, such indications can be especially helpful for **completing the information given by percentages** as regards market share and awareness, by giving a more **realistic impression** of the market. For example, they may reveal a very large amount of sales behind a not-so-impressive market share, which may be useful in assessing reputation in the case of competitive markets, where it is in general more difficult for a single brand to account for a substantial portion of the overall sales.

By contrast, where the market share of the products for which the mark is used is not given separately, it will not be possible to determine whether a given turnover corresponds to a substantial presence in the market or not, unless the opponent also submits evidence showing the **overall size of the relevant market in monetary terms**, so that the opponent's percentage of the market can be inferred.

Case No	Comment
<p>21/04/2010, R 1054/2007-4, MANDARINO (fig.) / MANDARINA DUCK (fig.)</p>	<p>Reputation was not sufficiently proven, in particular because none of the documents referred to recognition of the earlier trademark by the relevant end consumers. Nor was any evidence about the market share of the opponent's goods submitted. Information about market share is particularly important in the sector in which the opponent had its core business (<i>handbags, transport items, accessories and clothing</i>), as it is 'a quite atomized and competitive sector' and 'there are many different competitors and designers in that product range' (paras 59 to 61).</p>

This does not mean that the importance of turnover figures or volume of sales should be underestimated, as both are significant indications of **the number of consumers** that are expected to have encountered the mark. Therefore, it **cannot be excluded** that a **substantial** amount of turnover or sales volume may, in certain cases, be **decisive** for a finding of reputation, either alone, or in conjunction with very little other evidence.

Case No	Comment
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<p>12/01/2011, R 445/2010-1, FLATZ / FLATZ</p>	<p>Although, for reasons of <i>force majeure</i>, it was not possible for the earlier trade mark to become well known by traditional methods, that is, through sales of the product, it did become extremely well known as a result of promotional activities, through the trade mark being extensively, continually and constantly publicised in the specialist press and at sector fairs, thereby reaching virtually the whole of the three relevant sectors of the public. The limited presence of the product on the market by no means prevented it from becoming well known by the relevant public that, on the relevant date, FLATZ was the trade mark with which the opponent identified its <i>electronic bingo machines</i> (paras 41,42, 50 and 51).</p>
<p>10/12/2009, R 1466/2008-2 & R 1565/2008-2, COMMERZBANK ARENA / ARENA ET AL.</p>	<p>The lack of figures regarding market share held by the trade mark ARENA in the relevant countries was not in itself capable of calling the finding of reputation into question. First, the list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serves to illustrate examples, as all the relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence submitted by the opponent is already sufficient in itself to prove conclusively the substantial degree of recognition of the ARENA mark amongst the relevant public (para. 59).</p>

However, as this would deviate from the rule that reputation has to be evaluated by making an overall assessment of all factors relevant to the case, findings of reputation based almost exclusively on such figures should be generally avoided, or at least confined to exceptional cases in which such a finding would really be justified.

3.1.3.4 Geographical extent of use

Indications of the territorial extent of use are mainly useful for determining whether the alleged reputation is **widespread enough to cover a substantial part** of Georgia. In this assessment, account should be taken of the population density in the areas concerned, as the critical criterion is the proportion of consumers knowing the mark, rather than the size of the geographical area as such. Similarly, what is important is public awareness of the mark rather than availability of the goods or services. A mark may, therefore, have a territorially widespread reputation on the basis of advertising, promotion, media reports, etc.

In general, the more widespread the use, the easier it will be to conclude that the mark has passed the required threshold, whereas any indication showing use beyond a substantial part of the country will be a positive indicator of reputation. Conversely, a very limited amount of use in Georgia will be a strong indication against reputation, as for example where the vast majority of the goods are exported to a third jurisdiction in sealed containers directly from their place of production.

However, evidence of actual use in Georgia should not be regarded as a necessary condition for the acquisition of reputation, as what matters most is knowledge of the mark and not how it was acquired.

Such knowledge may be generated by, for example, intensive advertising prior to the launching of a new product or, in the case of high levels of cross-border shopping, it may be fuelled by a significant price difference in the respective markets, a phenomenon often referred to as **‘territorial spill-over’ of reputation** from one territory to another. However, when it is claimed that such circumstances have occurred, the corresponding evidence must demonstrate this.

3.1.3.5 Duration of use

Indications of the duration of use are particularly useful for determining the **longevity** of the mark. The longer the mark has been used in the market, the larger will be the number of consumers that are likely to have encountered it, and the more likely it is that such consumers

will have encountered the mark more than once. For example, a market presence of 10, 20 or 30 plus years is considered a strong indication of reputation.

Case No	Comment
29/03/2012, T-369/10, Beatle, EU:T:2012:177 (appeal dismissed in 14/05/2013, C-294/12 P, EU:C:2013:300)	The Beatles group was considered to be a group with an exceptional reputation, lasting for more than 40 years (para. 36).

The duration of use of the mark should not be inferred by mere reference to the term of its registration. Registration and use do not necessarily coincide, as the mark may have been put to actual use either before or after it was filed. Therefore, where the opponent invokes actual use preceding the term of registration, it must prove that such use actually began before it applied for its mark.

Nevertheless, a long registration period may sometimes serve as an indirect indication of a long presence on the market, as it would be unusual for a proprietor to maintain a registered mark for many decades without any economic interest behind it.

In the end, the decisive element is whether the earlier mark had a reputation at the time of filing of the contested application. Whether that reputation also existed at some earlier point in time is legally irrelevant. Therefore, evidence of **continuous use up to the filing date** of the application will be a positive indicator of reputation.

By contrast, if **use of the mark was suspended** over a significant period, or if the period between the latest evidence of use and the filing of the TM application is quite long, it will be more difficult to conclude that the mark's reputation survived the interruption of use, or that it subsisted until the filing date of the application (see paragraph 3.1.2.5 above).

3.1.3.6 Promotional activities

The **nature** and **scale of the promotional activities** undertaken by the opponent are useful indications when assessing the reputation of the mark, to the extent that these activities were undertaken to build up a brand image and enhance trademark awareness among the public. Therefore, **a long, intensive and widespread** promotional campaign may be a **strong indication** that the mark has acquired a reputation among the potential or actual purchasers of the goods in question, and that it may actually have become known beyond the circle of the actual purchasers of those goods.

Case No	Comment
12/01/2011, R 445/2010-1, FLATZ / FLATZ	Although, for reasons of <i>force majeure</i> , it was not possible for the earlier trade mark to become well known by traditional methods, that is, through sales of the product, it did become extremely well known as a result of promotional activities, through the trade mark being extensively, continually and constantly publicised in the specialist press and at sector fairs, thereby reaching virtually the whole of the three relevant sectors of the public. The limited presence of the product on the market by no means prevented it from becoming well known by the relevant public that, on the relevant date, FLATZ was the trade mark with which the opponent identified its <i>electronic bingo machines</i> (paras 41,42, 50 and 51).
29/05/2012, R 1659/2011-2, KENZO / KENZO (confirmed, 22/01/2015, T-393/12, EU:T:2015:45, § 57)	The opponent's goods, <i>cosmetics, perfumes and clothing</i> , have been advertised and articles have been written about them in many of the world's leading fashion-related lifestyle magazines, and in some of Europe's leading mainstream periodicals. In line with the case-law, the reputation of KENZO for the said goods is confirmed (para. 29).

Even though it cannot be ruled out that a mark acquires a reputation before any actual use, promotional activities will usually not be sufficient on their own for establishing that the earlier mark has indeed acquired a reputation (see paragraph 3.1.3.4 above). For example, it will be difficult to prove knowledge amongst a significant part of the public exclusively by reference to promotion or advertising, carried out as preparatory acts for the launching of a new product, as the actual impact of publicity on the perception of the public will be difficult to measure without reference to sales. In such situations, the only means of evidence available to the opponent are opinion polls and similar instruments, the probative value of which may vary depending on the reliability of the method used, the size of the statistical sample, etc. (for the probative value of opinion polls, see paragraph 3.1.4 below).

The impact of the opponent's promotional activities may be shown either **directly**, by reference to the **amount of promotional expenditure**, or **indirectly**, by way of inference from the **nature of the promotional strategy** adopted by the opponent and **the kind of medium used** for advertising the mark.

For example, advertising on a nationwide TV channel or in a prestigious periodical should be given more weight than campaigns of a regional or local scope, especially if coupled with high audience or circulation figures. Likewise, the sponsoring of prestigious athletic or cultural events may be a further indication of intensive promotion, as such schemes often involve a considerable investment.

Case No	Comment
22/01/2010, R 1673/2008-2, FIESTA / FIESTA (fig.) ET AL.	It is apparent from Ferrero's various advertising campaigns on Italian television (including Rai) that the earlier mark was widely exposed to viewers in 2005 and 2006. Many of these spots appear to have been broadcast at peak viewing times (e.g. during Formula 1 Grand Prix coverage) (para. 41).

Furthermore, the **contents of the advertising strategy** chosen by the opponent can be useful for revealing the **kind of image** the opponent is trying to create for its brand. This may be of particular importance when assessing the possibility of detriment to, or unfair advantage being taken of, a particular image allegedly conveyed by the mark, since the existence and contents of such an image must be abundantly clear from the evidence submitted by the opponent (see paragraph 3.4 below).

Case No	Comment
11/01/2011, R 306/2010-4, CARRERA / CARRERA, (under appeal, 27/11/2014, T-173/11, Carrera / CARRERA, EU:T:2014:1001)	The opponent's trade mark is not only known per se but, due to the high price of sports cars and the opponent's intensive expenditure on advertising, and against the background of its successes in racing, the public associates it with an image of luxury, high technology and high performance (para. 31).

3.1.3.7 Other factors

The above list of factors is only indicative and has underlined that all the facts relevant to the particular case must be taken into consideration when assessing the reputation of the earlier mark. Other factors may also be found e.g. in WIPO's Joint Recommendation. Therefore, depending on their relevance in each case, the following factors may be added: record of successful enforcement; number of registrations; certification and awards; and the value associated with the mark.

Record of successful enforcement

Records of successful enforcement of a mark against dissimilar goods or services are important because they may demonstrate that, at least in relation to other traders, there is acceptance of protection against dissimilar goods or services.

Such records may consist of the successful prosecution of complaints outside the courts, such as the acceptance of cease and desist requests, delimitation agreements in trade mark cases, etc.

Furthermore, evidence showing that the reputation of the opponent's mark has been repeatedly recognised and protected against infringing acts by **decisions of judicial or administrative authorities** will be an important indication that the mark enjoys a reputation in the relevant territory, especially where such decisions are recent. That effect may be reinforced when there is a substantial number of decisions of this kind (on the probative value of decisions, see paragraph 3.1.4.4 below). This factor is mentioned in Article 2(1)(b)(5) of WIPO's Joint Recommendation.

Number of registrations

The **number** and **duration of registrations** and applications for the mark in Georgia or in the world is also relevant, but is in itself a weak indication of the degree of recognition of the sign by the relevant public. The fact that the opponent has many trade mark registrations and in many classes may indirectly attest to the international circulation of the brand, but cannot decisively prove a reputation in itself. This factor is mentioned in Article 2(1)(b)(4) of the WIPO Joint Recommendation, where the need for actual use is made clear: the duration and geographical area of any registrations, and/or any applications for registration, of the mark are relevant 'to the extent that they reflect use or recognition of the mark'.

Certification and awards

Certification, awards, and similar public recognition instruments usually provide information about the history of the mark, or reveal certain quality aspects of the opponent's products, but as a rule they will not be sufficient in themselves to establish reputation and will be more useful as indirect indications. For example, if the certification concerns facts that are related to the performance of the mark, its relevance will be much higher.

The value associated with the mark

The fact that a mark is solicited by third companies for reproduction on their products, either as a trademark, or as mere decoration, is a strong indication that the mark possesses a high degree of attractiveness and an important economic value. Therefore, the extent to which the mark is exploited through licensing, merchandising and sponsoring, as well as the scale of the respective schemes, are useful indications in assessing reputation. This factor is mentioned in Article 2(1)(b)(6) of the WIPO Joint Recommendation.

3.1.4 Proof of reputation

3.1.4.1 Standard of proof

The opponent must submit evidence enabling the Chamber of Appeals to reach the **positive conclusion** that the earlier mark has acquired a reputation in Georgia. The wording used in Article 5(g) of the **Law** is quite clear in this respect: the earlier mark deserves enlarged protection only if it 'has a reputation'.

It follows that the **evidence must be clear and convincing**, in the sense that the opponent must clearly establish all the facts necessary to safely conclude that the mark is known by a significant part of the public. The reputation of the earlier mark must be established to the satisfaction of the **Chamber of Appeals** and not merely assumed.

3.1.4.2 Burden of proof

The Chamber of Appeals is restricted in its examination to the facts, evidence and arguments provided by the parties. It follows that, when assessing whether the earlier mark enjoys reputation, the Chamber of Appeals may **neither take into account** facts known to it as a result of its own **private knowledge** of the market **nor conduct an ex officio investigation** but should exclusively base its findings on the information and evidence submitted by the opponent.

Whether or not a mark has passed the threshold of reputation is not in itself a pure question of fact, since it requires the legal evaluation of several factual indications, and the reputation of the earlier mark may therefore not be simply assumed to be a universally known fact. In particular, qualitative aspects of the reputation, such as a specific image associated with the reputed mark, may only be assessed on the basis of specific pertinent evidence. However, some facts on which the argumentation is used may be well established and, accordingly, presumed to be known to the Georgian Office (e.g. the fact that a country has a certain number of consumers, or the fact that food products target the general public).

Case No	Comment
22/06/2004, T-185/02, Picaro, EU:T:2004:189 (confirmed 12/01/2006, C-361/04 P, Picaro, EU:C:2006:25)	The Board of Appeal may take into consideration, in addition to the facts expressly put forward by the parties, facts that are well known, that is, which are likely to be known by anyone or that may be learnt from generally accessible sources.

The burden of putting forward and proving the relevant facts lies with the opponent, by expressly requiring it to provide evidence attesting that the earlier mark **has a reputation** for the goods and services claimed. The opponent may also refer to facts and evidence submitted in the course of another opposition, provided that the relevant materials are indicated in a clear and unambiguous way.

If the evidence of reputation is in a foreign **language**, the Chamber of Appeals may, of its own motion or upon reasoned request by the other party, require the opponent to submit a translation of the evidence in Georgian, within a period specified by the Chamber of Appeals.

As regards the structure and format in which written evidence of reputation must be filed, the documents or other items of evidence must be contained in annexes to the opposition, which must be numbered consecutively.

Submissions must include an index indicating, for each document or item annexed thereto the following:

1. The number of the annex.
2. A short description of the document or item, and if applicable, the number of pages.
3. The page number of the submission where the document or item is mentioned.

The opponent may also indicate, in the index of annexes, which specific parts of a document it relies upon in support of its arguments.

3.1.4.3 Evaluation of the evidence

The basic rules on the evaluation of evidence are also applicable here: the evidence should be assessed **as a whole**, that is, each indication should be weighed up against the others, with information confirmed by more than one source generally being considered more reliable than facts derived from isolated references. Indeed, the more independent, reliable and well-informed the source of the information is, the higher the probative value of the evidence will be.

Therefore, information **deriving directly from the opponent** is unlikely to be enough on its own, especially if it only consists of **opinions** and **estimates** instead of facts, or if it is of an **unofficial character** and lacks objective confirmation, as for example when the opponent submits internal memoranda or tables with data and figures of unknown origin.

Case No	Comment
29/04/2010, R 295/2009-4, PG PROINGEC CONSULTORIA (fig.) / PROINTEC (fig.) et al.	The content of the documentation submitted does not clearly demonstrate that the earlier marks enjoy a reputation. The documentation emanates, in the main, from the respondent directly and contains information taken from its trade catalogues, its own advertising and documents downloaded from its website. There is insufficient documentation/ information from third parties to reflect clearly and objectively what precisely the respondent's position on the market is. Reputation not proved (para. 26).
16/11/2011, T-500/10, Doorsa, EU:T:2011:679	To assess the evidential value of such a document, account should be taken first and foremost of the credibility of the account it contains. The General Court added that it is then necessary to take account, in particular, of the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, prima facie, the documents appear sound and reliable (para. 49).

However, if such information is publicly available or has been compiled for official purposes and contains information and data that have been objectively verified, or reproduces statements made in public, its probative value is generally higher.

As regards its contents, the more indications the evidence gives about the various factors from which reputation may be inferred, the more relevant and conclusive it will be. In particular, evidence that, as a whole, gives **little or no quantitative data and information** will not be appropriate for providing indications about **vital factors**, such as trademark awareness, market share and intensity of use and, consequently, will not be sufficient to support a finding of reputation.

3.1.4.4 Means of evidence

There is no direct indication in the Law as to which kind of evidence is more appropriate for proving reputation. The opponent may avail itself of **all the means of evidence**, provided they are capable of showing that the mark does indeed have the required reputation.

The following means of evidence are the most frequently submitted by opponents in opposition proceedings before the Chamber of Appeals (this list does not reflect their relative importance or probative value):

1. Sworn or affirmed statements.
2. Decisions of courts or administrative authorities.
3. Decisions of the Chamber of Appeals.
4. Opinion polls and market surveys.
5. Audits and inspections.
6. Certification and awards.
7. Articles in the press or in specialised publications.
8. Annual reports on economic results and company profiles.
9. Invoices and other commercial documents.
10. Advertising and promotional material.

Evidence of this kind may also be submitted in order to prove that the earlier mark has obtained a higher degree of distinctiveness, or in relation to well-known marks.

Sworn or affirmed statements

The weight and probative value of statutory declarations is determined by the general rules applied by the Chamber of Appeals to the assessment of such evidence. In particular, both the capacity of the person giving the evidence and the relevance of such evidence to the particular case must be taken into account.

Case No	Comment
12/05/2011, R 729/2009-1, SKYBLOG / SKY et al.	The statement submitted by an expert consultancy firm in the area of digital media strategy in the UK attests to the fact that the opponent is 'the leading supplier of digital television in the UK' and that 'Sky has an enormous and impressive reputation' (para. 37).

Decisions of Georgian civil courts

Decisions of Georgian civil courts that have accepted the reputation of the earlier mark are admissible evidence and may have evidentiary value, but they are not binding, in the sense that it is not mandatory for the Chamber of Appeals to follow their conclusion. Since such decisions may serve to indicate reputation and to record successful enforcement of the mark, their relevance should be addressed and examined.

If the decision is not yet final, or if it is outdated due to the time that has elapsed between the two cases, its probative value will be diminished accordingly.

Consequently, the probative value of decisions should be assessed on the basis of their contents and may vary depending on the case.

Decisions of the Chamber of Appeals.

The opponent may also refer to earlier **Chamber of Appeals** decisions, on condition that such a reference is clear and unambiguous.

Even where the reference is admissible and the decision is relevant, the **Chamber of Appeals** is not bound to come to the same conclusion and must examine each case on its own merits. Recognition of the reputation of an earlier mark cannot depend on prior recognition in the context of separate proceedings concerning the parties and different legal and factual elements. It is therefore for any party relying on the reputation of its earlier mark to establish, in the circumscribed context of each set of proceedings to which it is a party and on the basis of the facts that it considers most appropriate, that that mark has acquired a reputation; it cannot merely claim to adduce that evidence by virtue of its having been recognised, even for the same mark, in a separate administrative procedure.¹¹⁷

It follows that previous Sakpatenti decisions only have a relative probative value and should be evaluated in conjunction with the rest of the evidence, especially where the opponent relies on a previous Chamber of Appeals decision without referring to particular materials filed in the corresponding proceedings, that is, where the applicant has not had a chance to comment on such materials, or where the time that has elapsed between the two cases is quite long. The situation may be different if the evidence to which the opponent refers had been submitted in other proceedings between the same parties and the applicant had been aware of the evidence concerning the reputation of an earlier mark.¹¹⁸

Opinion polls and market surveys

¹¹⁷ 23/10/2015, T-597/13, dadida / CALIDA, EU:T:2015:804, § 43-45

¹¹⁸ 22/01/2015, T-322/13, KENZO, EU:T:2015:47, § 18

Opinion polls and market surveys are the most suitable means of evidence for providing information about the degree of knowledge of the mark, the market share it has, or the position it occupies in the market in relation to competitors' goods.

The probative value of opinion polls and market surveys is determined by the status and degree of independence of the entity conducting it, by the relevance and accuracy of the information it provides, and by the reliability of the method applied.

More particularly, in evaluating the credibility of an opinion poll or market survey, the Chamber of Appeals needs to know the following.

1. Whether or not it has been conducted by an independent and recognised research institute or company, in order to determine the reliability of the source of the evidence.
2. The number and profile (sex, age, occupation and background) of the interviewees, in order to evaluate whether the results of the survey are representative of the different kinds of potential consumers of the goods in question.
3. The method and circumstances under which the survey was carried out and the complete list of questions included in the questionnaire. It is also important to know how and in what order the questions were formulated, in order to ascertain whether the respondents were confronted with leading questions.
4. Whether the percentage reflected in the survey corresponds to the total amount of persons questioned or only to those who actually replied.

Unless the above indications are present, the results of a market survey or opinion poll should not be considered of high probative value, and will not in principle be sufficient on their own to support a finding of reputation.

Case No	Comment
08/04/2011, R 925/2010-2, 1 CLEAN! 2 FRESH! 3 STRONG! (fig.) / FRESH & CLEAN et al.	The cancellation applicant did not submit sufficient proof of the reputation of its trade marks. According to the extracts from the 2001 survey conducted in Italy, although the level of 'prompted recognition' stands at 86 %, the rate of 'spontaneous recognition' is only 56 %. Moreover, no indication is given of the questions put to the people surveyed, making it impossible to determine whether the questions were really open and unassisted. The survey further fails to state for which goods the trade mark is known (para. 27).
27/03/2014, R 540/2013-2, Shape of a bottle (3D)	The surveys do not seem to be carried out by the well-known GfK company, as the applicant argues, but rather by a Mr Philip Malivore who, according to his own declaration, is only 'a former director of GfK'. The Board is thus perplexed as to how a former employee of GfK can be authorised to use that company's logo on each and every page of the surveys when he is now 'an independent market research consultant'. These facts cast considerable doubt on the source, reliability and independent nature of the surveys (para. 49).

Likewise, if the above indications are given, but the reliability of source and method are questionable, the statistical sample is too small, or the questions were leading, the credibility of the evidence will be diminished accordingly.

Case No	Comment
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<p>15/03/2011, R 1191/2010-4, MÁS KOLOMBIANA...Y QUÉ MÁS!! / COLOMBIANA LA NUESTRA</p>	<p>The survey submitted by the opponent does not provide conclusive information to demonstrate that the earlier sign is well known to the Spanish public for <i>aerated waters</i> as the interviewees were carefully selected on the basis of their origin, that is, Colombians resident in Spain. This is only a very small part of the population living in Spain. The figures relating to sales, to investment in publicity and to the mark's presence in publications directed at the immigrant public, contained in the statement made before a notary public, are likewise insufficient for a finding that the earlier sign is well known. Moreover, the statements are not corroborated by conclusive data on the extent or turnover of the goods (para. 23).</p>
<p>01/06/2011, R 1345/2010-1, Fukato Fukato (fig.) / DEVICE OF A SQUARE (fig.) et al.</p>	<p>In support of its claim under Article 8(5) TMR, the opponent relies exclusively on an opinion poll that was carried out in 2007. That opinion poll was conducted by an independent company. In principle, samples of 1 000-2 000 interviewees are considered sufficient, provided they are representative of the type of consumer concerned. The opponent's opinion poll was based on a sample of 500 interviewees, which is not sufficient in respect of the services for which reputation is claimed. According to the opinion poll, the logo of the earlier mark has been associated especially with services in the financial and insurance fields. Since the opposition is only based on Class 42 with regard to the earlier European Union trade mark, it does not cover financial and insurance services. Consequently, the opinion poll submitted is not suitable proof of the reputation of the opponent's European Union trade mark (para. 58).</p>

Conversely, opinion polls and market surveys that fulfil the above requirements (independence and trustworthiness of source, reasonably large and widespread sample and reliable method) will be a strong indication of reputation, especially if they show a high degree of trademark awareness.

Audits and inspections

Audits and inspections of the opponent's undertaking may provide useful information about the intensity of use of the mark, as they usually comprise data on financial results, sales volumes, turnover, profits, etc. However, such evidence will be pertinent only if it specifically refers to the goods sold under the mark in question, rather than to the opponent's activities in general.

Audits and inspections may be carried out on the initiative of the opponent itself, or may be required by company law and/or financial regulations. In the former case, the same rules as for opinion polls and market surveys apply, that is, the status of the entity conducting the audit and the reliability of the applied method will be of essence for determining its credibility, with the probative value of official audits and inspections being as a rule much higher, since they are usually conducted by a state authority or by a recognised body of auditors on the basis of generally accepted standards and rules.

Certification and awards

This kind of evidence includes certification and awards by public authorities or official institutions, such as chambers of commerce and industry, professional associations and societies, consumer organisations, etc.

The reliability of certification by authorities is generally high, as emanating from independent and specialised sources, which attest facts in the course of their official tasks. For example, the average circulation figures for periodicals issued by the competent press-distribution associations are conclusive evidence about the performance of a mark in the sector.

Case No	Comment
25/01/2011, R 907/2009-2, O2PLS / O2 et al.	The many brand awards won by the mark were, together with the huge investment in advertising and the number of articles published in different publications, considered an important part of the evidence for reputation (para. 9(iii) and para. 27).

The same applies to quality certification and awards granted by such authorities, as the opponent usually has to meet objective standards in order to receive the award. Conversely, prizes and awards offered by unknown entities, or on the basis of unspecified or subjective criteria, should be given very little weight.

The relevance of a certification or award to the specific case largely depends on its contents. For example, the fact that the opponent is a holder of an ISO 9001 quality certificate, does not automatically mean that the sign is known to the public. It only means that the opponent's goods meet certain quality or technical standards. However, if such evidence is coupled with other indications of quality and market success, it may lead to the conclusion that the earlier mark has a reputation.

Articles in the press or in specialized publications

The probative value of press articles and other publications concerning the opponent's mark mainly depends on whether such publications are covert promotional matter, or if, on the contrary, they are the result of independent and objective research.

Case No	Comment
16/12/2010, T-345/08 & T-357/08, Botolist/Botocyl, confirmed 10/05/2012, C-100/11 P	The very existence of articles in a scientific publication or the general-interest press constitutes a relevant factor in establishing the reputation of the products marketed under the trade mark BOTOX amongst the general public, irrespective of the positive or negative content of those articles (para. 54).
10/03/2011, R 555/2009-2, BACI MILANO (fig.) / BACI & ABBRACCI	The reputation of the earlier trade mark in Italy was proven by the copious amount of documentation submitted by the opponent, which included, inter alia, an article from <i>Economy</i> revealing that in 2005 the 'BACI & ABBRACCI' trade mark was one of the fifteen most counterfeited fashion brands in the world; an article published in <i>Il Tempo</i> on 05/08/2005, in which the 'BACI & ABBRACCI' trade mark is mentioned alongside others, including Dolce & Gabbana, Armani, Lacoste and Puma, as being targeted by counterfeiters; an article published in <i>Fashion</i> on 15/06/2006, in which the trade mark is defined as 'a true market phenomenon'; publicity campaigns from 2004 to 2007, with testimonials from entertainment and sports celebrities; and a market survey conducted by the renowned independent agency Doxa in September 2007, from which it emerges that the trade mark is 'top of mind' in the fashion sector for 0.6 % of the Italian public (para. 35).

Hence, if such articles appear in publications of a high status or are written by independent professionals, they will have quite a high value, as for example when the success of a specific brand becomes the object of a case study in specialised journals or in scientific publications. The presence of a mark in a dictionary (which is not a press article but is still a publication) is a means of evidence with high value.

Case No	Comment
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<p>16/12/2010, T-345/08 & T-357/08, Botolist/Botocyl, confirmed by 10/05/2012, C-100/11 P</p>	<p>The inclusion of a word in a dictionary is the expression of a fair amount of recognition on the part of the public. The references in the 2002 and 2003 editions of a number of dictionaries published in the United Kingdom constitute one of the items of evidence that may establish the reputation of the trade mark BOTOX in that country or amongst the English-speaking public of the European Union (paras 55 and 56).</p>
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Annual reports on economic results and company profiles

This type of evidence includes all kinds of internal publications giving varied information about the history, activities and perspectives of the opponent's company, or more detailed figures about turnovers, sales, advertising, etc.

To the extent that such evidence derives from the opponent and is mainly intended to promote its image, its probative value will mostly depend on its contents, and the relevant information should be treated with caution, especially if it mainly consists of estimates and subjective evaluations.

However, where such publications are circulated to clients and other interested circles and contain objectively verifiable information and data, which may have been compiled or revised by independent auditors (as is often the case with annual reports), their probative value will be substantially enhanced.

Invoices and other commercial documents

All kinds of commercial documents may be grouped under this heading, such as invoices, order forms, distribution and sponsoring contracts, samples of correspondence with clients, suppliers or associates, etc. Documents of this sort may provide a great variety of information on intensity of use, geographical extent and duration of use of the mark.

Even though the relevance and credibility of commercial documents is not disputed, it will generally be difficult to prove reputation on the basis of such materials alone, given the variety of factors involved and the volume of documents required. Furthermore, evidence relating to distribution or sponsoring contracts and commercial correspondence are more appropriate for giving indications about the geographical extent or promotional side of the opponent's activities, than for measuring the success of the mark in the market, and thus may only serve as indirect indications of reputation.

Case No	Comment
<p>14/04/2011, R 1272/2010-1, GRUPO BIMBO (fig.) / BIMBO et al. (08/07/2015, T-357/11 INTP, GRUPO BIMBO (fig.) / BIMBO et al., EU:T:2015:534)</p>	<p>The evidence submitted shows a high level of recognition of the mark on the Spanish market. The total invoices on the Spanish tin-loaf market in 2004 amounted to EUR 346.7 million, of which the opponent's invoices amounted to EUR 204.9 million. The invoices submitted cover advertisements on TV, as well as in newspapers and magazines. Therefore, the reputation of 'BIMBO' in Spain for <i>industrially produced bread</i> has been substantiated (para. 64).</p> <p>The Court did not address this point.</p>

Advertising and promotional material

This kind of evidence may take various forms, such as press cuttings, advertising spots, promotional articles, offers, brochures, catalogues, leaflets, etc. In general, such evidence

cannot be conclusive of reputation on its own, due to the fact that it cannot give much information about actual trademark awareness.

However, some conclusions about the degree of exposure of the public to advertising messages concerning the mark may be drawn by reference to the kind of medium used (national, local) and the audience rates or circulation figures attained by the relevant spots or publications — if, of course, this kind of information is available.

Case No.	Comment
<p>10/01/2011, R 43/2010-4, FFR (fig.) / CONSORZIO VINO CHIANTI CLASSICO (fig.), (05/12/2012, T-143/11, F.F.R., EU:T:2012:645)</p>	<p>The documents submitted show that the device of a black rooster has acquired reputation and will be associated with wines from the Chianti Classico region. The opponent provided several copies of advertisements in newspapers and magazines, showing its promotional activity, as well as independent articles displaying a black rooster in connection with the Chianti Classico region. However, given that the reputation only pertains to the device of a black rooster and given that this device is only one part of the earlier marks, serious doubts arise about whether reputation can be attributed to the marks as a whole. Moreover, for the same reason, doubt also arises about which marks the reputation could be attributed to, given that the opponent owns several marks. (paras 26 and 27).</p> <p>The Court did not assess the evidence on reputation</p>

In addition, such evidence may give useful indications of the kind of goods covered, the form in which the mark is actually used and the kind of image the opponent is trying to create for its brand. For example, if the evidence shows that the earlier registration for which reputation is claimed covers a device, but in fact this device is used in combination with a verbal element, it would not be correct to accept that the device itself has a reputation. Rather, it should be assessed whether the reputation extends to the device. For that purpose, it is important to assess whether the device plays a predominant or even significant role when used in combination with the verbal element, and has acquired a reputation in itself. This has to be assessed on a case-by-case basis. See paragraph 3.1.2.6 above.

Evidence of a presence and activity on the Internet

As a consequence of the growing importance of information technologies and the Internet to personal, social and economic life, parties are increasingly relying on evidence originating from the Internet to show the use and reputation of their marks.

Before all, it must be clarified that a mere reference to a website (even if by a direct hyperlink) where the Office can find further information is insufficient. Online evidence may only take the place of physical evidence where it concerns the filing or registration of the earlier rights, or the contents of the relevant national law to the extent it is accessible online from a source recognised by the Office. This option is not contemplated in the law for other evidence. Furthermore, external hyperlinks cannot guarantee the continued secure availability and stability of the content they link to.

Evidence showing the presence of the earlier trade mark on the Internet may help establish that trade mark's reputation. If the earlier trade mark has a significant presence on the Internet (evidenced by the number of subscribers to accounts dedicated to this trade mark on social networks, or the number of visitors to blogs mentioning this trade mark), this may help assess

the knowledge of the trade mark by the public concerned and may therefore support a finding of reputation¹¹⁹.

The nature of materials originating from the Internet raises the question of reliability of that evidence as it may be difficult to establish the actual content available on the Internet and the date or period of time this content was in fact made available to the public. Screenshots of a website or extracts from social media do not necessarily show whether the mark was used during the relevant time period or in the relevant territory. Nor do they establish the intensity of the alleged commercial use, as they do not show who viewed the mark or when, or provide information about related transactions. Relevant indications that do more than merely show the mark's presence on the Internet and which serve to provide information about its extent of use and level of exposure could be, for instance, data on the number of visits to the site, emails received via the site or the volume of business generated. Other forms of communication or interaction with the website can also be helpful and the data can be corroborated by further evidence such as analytics reports, website traffic, reports showing the geographical location of users, etc.

Extracts from the online encyclopaedia Wikipedia or similar sources cannot be considered to be probative on their own, as the content may be amended at any time and, in certain cases, by any visitor, even anonymously. The reliability of such evidence should be assessed in the context of the evidence as a whole, with information confirmed by more than one source generally being considered more reliable than facts derived from isolated references.

3.2 The similarity of the signs

A certain degree of similarity between the signs must be found for an opposition under Article 5(g) of the **Law** to succeed. If the signs are found **dissimilar** overall, the examination aimed at establishing whether the other requirements under Article 5(g) of the **Law** are met **should not be carried out**, as the opposition cannot succeed.

A subject that gives rise to some uncertainty is the relationship between the term 'similar' within the meaning of Article 5(g) of the **Law** and the term 'similarity' used in Article 5(c) of the **Law**. According to the clear wording of these two provisions, **similarity (or identity) between the signs is a precondition for the application of both Articles 5(c) and 5(g) of the Law**. The use of essentially the same term in both provisions is an argument in favour of the need to interpret this term in the same way. In particular, similarity of signs shall be assessed using the same criteria. However, as it is discussed below, degree of similarity requested for articles 5(c) and 5(g) is different.

Accordingly, similarity should be assessed according to the **same criteria** that apply in the context of Article 5(c) of the **Law**, thus taking into account elements of **visual, aural or conceptual similarity** (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 28, relating to the interpretation of Article 5(2) TMD; 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 52). See the Guidelines, Part B, Examination, Section 5, Chapter 4, Comparison of Signs.

The general rules for assessing signs established for examining this criterion under Article 5(c) of the **Law** apply, such as the rule that consumers perceive the sign as a whole and only rarely have the chance to make a direct comparison between the different marks, and must place their trust in the imperfect image of them that they have kept in mind (see the Guidelines, Part B, Examination, Section 5, Double Identity and Likelihood of Confusion, Chapter 6, Global Assessment)

¹¹⁹ 26/06/2019, T-651/18, HAWKERS (fig.) / HAWKERS (fig.) et al., EU:T:2019:444, § 33

3.2.1 Notion of ‘similarity’ pursuant to Article 5 (g) of the **Law** compared with Article 5(c) of the **Law**

Despite application of the same criteria for similarity of the signs in Articles 5(c) and 5(g) of the **Law**, the purposes underlying these Articles are different: in Article 5(c), the aim is to prevent the registration of a later trade mark that, if used, could confuse the relevant public as regards the commercial origin of the goods or services concerned, whereas in Article 5(g), the aim is to prevent the registration of a later trade mark that, if used, could take unfair advantage of, or be detrimental to, the reputation or distinctiveness of the earlier reputed trade mark.

In the context both of Articles 5(c) and 5(g) of the **Law**, a finding of similarity between the marks in question requires the existence, in particular, of elements of visual, aural or conceptual similarity.¹²⁰

However, those provisions differ in terms of the degree of similarity required. Whereas the protection provided for under Article 5(c) is conditional upon a finding of a degree of similarity between the marks at issue such that there is a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 5(g). Accordingly, the types of injury referred to in Article 5(g) may result from a lesser degree of similarity between the marks in question, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is, to establish a link between them.¹²¹

To sum up, the application of both Articles 5(c) and 5(g) of the **Law** require a finding of similarity between the signs. Consequently, if, when Article 5(c) is examined, the signs are found to be **dissimilar**, the opposition will necessarily fail under Article 5(g) too.

However, once the signs have been found to be **similar**, depending on whether Articles 5(c) and 5(g) of the **Law** is involved, the examiner will independently assess whether the degree of similarity is sufficient for the relevant provision to apply (in correlation with the further relevant factors).

Therefore, a degree of similarity between the marks that, after an overall assessment of the factors, leads to a partial finding of likelihood of confusion under Article 5(c) does not **necessarily** trigger a link between the signs under Article 5(g) of the **Law**, for example because the markets concerned are completely distinct. A full analysis must take place. This is because **the similarity of the signs is only one of the factors to be considered when assessing whether there is such a link** (see the relevant criteria listed under paragraph 3.3 below on the ‘link’).





Depending on the case, the following scenarios are possible.

- Article 5(c) of the **Law** fails because the signs are dissimilar — Article 5(g) of the **Law** fails too, since the same conclusion applies.
- Likelihood of confusion pursuant to Article 5(c) of the **Law** is excluded (e.g. because the goods or services are dissimilar or very remotely similar), but the signs are similar — the examination of Article 5(g) of the **Law** must be carried out (05/12/2012, T-143/11, F.F.R., EU:T:2012:645, § 66-71).
- The similarity of the signs together with the other relevant factors justifies the exclusion of likelihood of confusion pursuant to Article 5(c) of the **Law**, but the similarity between the signs might be sufficient to establish a link between them under Article 5(g) of the **Law**, in view of the other relevant factors to be taken into account.

¹²⁰ 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 28

¹²¹ 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 27, 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57, 58, 66

The following case-law examples illustrate the degree of similarity required for the purposes of applying Article 5(g) of the Law.

Earlier mark	TM application	Case No
		11/12/2014, T-480/12, MASTER, EU:T:2014:1062
<p>G&S: Class 29, 30, 32 Territory: EU Assessment: The earlier mark is reputed for non-alcoholic drinks. While there are clear visual differences between the marks, there are also elements of visual similarity. The marks each have a 'tail' flowing from their first letters in a signature flourish. Moreover, they use the same font type, the Spenserian script, which is not commonly used in contemporary business. Given the degree of similarity, however faint, between those marks, it is not altogether inconceivable that the relevant public could make a link between them and, even if there is no likelihood of confusion, be led to transfer the image and the values of the earlier mark to the goods bearing the contested mark (paras 46-48, 57, 74).</p>		
Earlier mark	TM application	Case No
		16/01/2018, T-398/16, COFFEE ROCKS (fig.) / STARBUCKS COFFEE (fig.) et al., EU:T:2018:4
<p>G&S: Class 43 Territory: EU Assessment: The earlier mark is claimed to be reputed for coffee and cafeteria services. The marks have the same general appearance, in as much as they are circular devices consisting of a figurative element placed in the centre and a surrounding broad band with word elements of identical structures and two smaller white figurative elements; they use the same colours (black and white) and font type; they share the word 'coffee', which, despite its descriptive character, is an important similarity factor, especially considering the claim of reputation. Phonetically, the signs are similar due to the presence of the word 'coffee' and because the ending 'rocks' is phonetically similar to the ending 'bucks', particularly on account of the relevant English-speaking public's pronunciation of the letters 'o' and 'u'. Conceptually, the relevant public will associate both marks with the concept of a 'coffee house' due to the general appearance of the marks and the presence of the word 'coffee' in both of them (paras 51-64).</p>		

3.3 The link between the signs

In order to assess whether use of the contested mark would be likely to cause detriment to, or take unfair advantage of, the distinctive character or repute of the earlier mark, it is **necessary to find if a link (or association) between the signs will be established in the mind of the relevant public**. Such an analysis should follow finding the similarity between the signs and precede the final assessment of the existence of a risk of injury.

The notion of a link between the signs was addressed by the Court in its judgment of 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 30.

The types of injury are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them.

The term '**link**' is often also referred to as '**association**' in other paragraphs of this part of the Guidelines. These **terms** are, at times, **used interchangeably**.

The mere fact that the marks in question are similar **is not sufficient** for it to be concluded that there is a link between them. Rather, **whether or not there is a link between the marks at issue must be appreciated globally**, taking into account all factors relevant to the circumstances of the case.

The following may be **relevant factors** when assessing whether such a link exists.

- The strength of the **earlier mark's reputation**.
- The **degree of similarity** between the conflicting marks. The more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public.
- The **nature of the goods or services** for which the earlier mark is reputed and the later mark seeks registration
- The degree of **similarity or dissimilarity between those goods or services**, and the relevant section of the public. The goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public (Intel, paragraph 49). It must nevertheless be remembered that one of the key features of Article 5(g) is that it provides protection also against dissimilar goods and services.
- The degree of the **earlier mark's distinctive character**, whether inherent or acquired through use. The more inherently distinctive the prior mark, the more likely it will be brought to a consumer's mind when encountering a similar (or identical) later mark. Conversely, the less inherently distinctive the earlier mark is, the more difficult it may prove to establish a link.
- The existence of **likelihood of confusion** on the part of the public.

This list is not exhaustive, and a link between the marks at issue may be established or excluded on the basis of only some of those criteria.

The question of whether the relevant public will establish a link between the marks at issue is a **question of fact**, which must be answered in the light of the facts and circumstances of each individual case.

The assessment of whether a 'link' will be established must take into account all the relevant factors that will then need to be balanced. Therefore, even a faint or remote degree of similarity between the signs still justifies assessing all the relevant factors to determine if it is likely that a link between the signs will be established in the mind of the relevant public.

Although that global assessment implies some interdependence between the relevant factors, and a low degree of similarity between the marks may therefore be offset by the strong distinctive character of the earlier mark ... the fact remains that where there is no similarity between the earlier mark and the challenged mark, the reputation or recognition enjoyed by the earlier mark and the fact that the goods or services respectively covered are identical or similar are not sufficient for it to be found that ... the relevant public makes a link between them ...

... It is only if there is some similarity, even faint, between the marks at issue that the Court must carry out a global assessment in order to ascertain whether, notwithstanding the low degree of similarity between them, there is, on account of the presence of other relevant

factors such as the reputation or recognition enjoyed by the earlier mark, a likelihood of confusion or a link made between those marks by the relevant public.

The fact that the goods and services designated by the marks at issue belong to distant sectors of trade is not, in itself, sufficient to exclude the possibility of the existence of a link. The specific reputation of the earlier mark (including qualitative aspects, such as a particular image, lifestyle, or particular circumstances of marketing that have become associated with the reputation of the mark) and the degree of similarity between the marks could make it possible for the image of the reputed mark to be transferred to the contested mark notwithstanding the distance between the relevant market sectors.

However, where the goods and services designated by the marks address the general public on the one hand, and a specialised public on the other, the mere fact that members of the specialised public are necessarily part of the general public is not conclusive as to the existence of a link. The fact that a specialised public may be familiar with the earlier mark covering goods or services aimed at the general public, that is not sufficient to demonstrate that that specialised public will establish a link between the marks at issue¹²².

The existence of a family of marks is a factor to be taken into account in assessing the establishment, on the part of the relevant public, of a link between the marks at issue.

Case-law has made it clear that a link is not sufficient, in itself, to establish that there may be one of the forms of damage referred to in Article 5(g) TMR (26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 96, and the case-law cited therein). However, as will be explained in detail under paragraph 3.4, ‘The risk of injury’, below, the existence of a link (or association) between the signs is necessary before it can be determined whether detriment or unfair advantage is likely.


Examples where a link was found between the signs

The following are examples where it was found that the degree of similarity between the signs (together with further factors) was sufficient to conclude that consumers would establish a link between them.

Earlier reputed sign	TM application	Case No
BOTOX	BOTOLIST and BOTOCYL	16/12/2010, T-345/08 & T-357/08 Confirmed by 10/05/2012, C-100/11 P, EU:C:2012:285

¹²² 26/09/2018, T-62/16, PUMA (fig.) / PUMA (fig.) et al., EU:T:2018:604, § 45-46



The trade mark **BOTOX** had a reputation for *pharmaceutical preparations for the treatment of wrinkles* in the United Kingdom on the filing date of the contested marks, which cover a range of goods in Class 3. The General Court confirmed the Board's finding that there is a certain overlap between the goods, namely a low degree of similarity between the opponent's *pharmaceutical preparations for the treatment of wrinkles* and the contested *cosmetics among other creams*, whereas the remaining contested goods, namely *perfumes, sun-tanning milks, shampoos, bath salts, etc.*, are dissimilar. Nevertheless, **the goods at issue concern related market sectors**. The General Court confirmed the Board's finding that the relevant public — practitioners as well as the general public — would not fail to notice that both the trade marks applied for, **BOTOLIST** and **BOTOCYL**, begin with 'BOTO-', which comprises almost the whole of the mark **BOTOX**, which is well known to the public. The General Court pointed out that 'BOTO-' is not a common prefix, either in the pharmaceutical field or in the cosmetic field and that it has no descriptive meaning. Even if the sign **BOTOX** could be broken down into 'bo' for 'botulinum' and 'tox' for 'toxin', in reference to the active ingredient that it uses, that word would then have to be considered to have acquired a distinctive character, inherent or through use, at least in the United Kingdom. **In light of all the relevant factors, the public would naturally be led to establish a link between the marks BOTOLIST and BOTOCYL and the reputed mark BOTOX** (paras 65 to 79).

Earlier reputed sign	TM application	Case No
RED BULL		11/01/2010, R 70/2009-1
<p>The Board found that a link would be established between RED DOG and RED BULL because (i) the marks have some relevant common features, (ii) the conflicting goods in Classes 32-33 are identical, (3) the RED BULL mark is reputed, (iv) the RED BULL mark has acquired a strong distinctive character through use and (v) there might be a possibility of confusion (para. 19). It is reasonable to assume that the average consumer of beverages, who knows the reputed RED BULL mark and sees the RED DOG marks on the same kind of beverages would immediately recall the earlier mark. According to the <i>Intel</i> judgment, this is 'tantamount to the existence of a link' between the marks (para. 24).</p>		

Earlier reputed sign	TM application	Case No
Viagra	Viaguara	25/01/2012, T-332/10, EU:T:2012:26
<p>The trade marks are highly similar overall (para. 42). Visually, all the letters of the earlier trade mark are present in the contested one, and the first four and final two are in the same order. There is visual similarity, especially since the public tends to pay more attention to the beginnings of words (paras 35 and 36). The identity of the first and last syllable, together with the fact that the middle syllables have the sound [g] in common, leads to a high degree of phonetic similarity (paras 38 and 39). Neither of the signs has a meaning and, therefore, the public will not differentiate them conceptually (para. 40).</p> <p>The earlier mark covers <i>pharmaceuticals for the treatment of erectile dysfunctions</i> in Class 5, whereas the contested mark covers <i>non-alcoholic and alcoholic drinks</i> in Classes 32 and 33. The reputation of the earlier sign for the goods mentioned is not disputed. The General Court found that although no direct connection can be established between the goods covered by the marks in dispute since they are dissimilar, an association with the earlier mark remains possible, taking into account the high degree of similarity between the signs and the strong reputation acquired by the earlier mark. Therefore, the General Court concludes that a link is likely to be established between the marks (para. 52).</p>		

Earlier reputed sign	TM application	Case No
RSC-ROYAL SHAKESPEARE COMPANY	Royal Shakespeare	06/07/2012, T-60/10, EU:T:2012:348

As the contested trade mark is exclusively made up of the central and distinctive element of the earlier trade mark, namely the expression 'royal shakespeare', **the signs at issue are visually, phonetically and conceptually similar**. Therefore, **the average consumer will establish a link between those signs** (para. 29). The earlier mark covers services in Class 41, including *theatre productions*, whereas the contested mark covers *non-alcoholic and alcoholic drinks* in Classes 32 and 33 and *providing of food and drink, restaurants, bars, pubs, hotels; temporary accommodation* in Class 42. **The General Court confirmed the Board's finding of the 'exceptional' reputation of the earlier mark in the United Kingdom for theatre productions**. The relevant public for the contested trade mark is the same as the relevant public for the earlier trade mark, namely the public at large (para. 58). **Although the contested goods in Classes 32-33 do not appear to be directly and immediately linked to the opponent's theatre productions, there is a certain proximity and link between them**. The General Court refers to the judgment of 04/11/2008, T-161/07, Coyote ugly, EU:T:2008:473, § 31-37, where a certain similarity between *entertainment services and beer* was found due to their complementarity. The General Court added that it is common practice, in theatres, for bar and catering services to be offered either alongside and during the interval of a performance. Moreover, irrespective of the above, in view of the established reputation of the earlier trade mark, the relevant public, namely the public at large in the United Kingdom, would be able to make a link with the intervener when seeing a beer with the contested trade mark in a supermarket or in a bar (para. 60).



Earlier reputed sign	TM application	Case No
		20.08.21, N136-3/2020 Chamber of Appeals
<p>The Board held that due to high degree of reputation of the earlier mark, certain degree of similarity between the sign and proximity/similarity between the contested goods (e.g. Cocoa and chocolate drinks) and earlier goods - soft drinks (being daily products for daily consumption with same points of sale) there is a close link between the earlier and contested marks.</p>		


Earlier reputed sign	TM application	Case No
JACK DANIEL'S	„black jack ბლექ ჯექ“	08.10.21, N13-3/2021 Chamber of Appeals
<p>The Board held that the conceptually contested sign could be perceived by the relevant public literally as black (colour) jack (the name) or as the card game and the earlier mark as Name and surname. However, board held that considering the high degree of reputation of the earlier mark the contested mark would be conceptually linked to the reputed mark.</p> <p>The Board held that contested goods are alcoholic beverages and alcoholic preparations for making beverages earlier</p> <p>mark has reputation in relation to whisky. Whisky is included in the broad category - alcoholic beverages and is considered identical. As to the alcoholic preparations for making beverages, even though the goods are dissimilar, they are related to the alcoholic beverage industry. Furthermore, the whisky is covered by the contested good, therefore there is proximity between those goods.</p> <p>Finally, due to the high degree of reputation of the marks, identity/proximity of the goods and similarity of the marks the board found that there will be a link between the earlier and contested signs.</p>		


Examples where no link was found between the signs

The following are examples where an overall assessment of all of the relevant factors showed that it was unlikely that a link would be established between the signs.


Earlier reputed sign	TM application	Case No
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		<p>11/11/2020, T-820/19, Lottoland / LOTTO (fig.) et al., EU:T:2020:538, § 64, 66</p>
<p>Notwithstanding the strong reputation of the earlier figurative mark and the above-average degree of similarity between the marks, the lack of any link between the services (relating to gambling in Class 41 of the earlier mark and scientific and technological services in Class 42 of the contested mark) and the difference between the relevant publics, one of which is a specialist public with a high level of attention, are such that the existence of a link between the marks can be ruled out (para. 66).</p>		

Earlier reputed sign	TM application	Case No
<p>G-STAR and</p>		<p>21/01/2010, T-309/08, EU:T:2010:22</p>
<p>Visually the signs give a different overall impression, due to the figurative element of a Chinese dragon's head placed at the beginning of the mark applied for. Aurally, there is a rather close aural similarity between the marks at issue. The signs are conceptually different, since the element 'star' of the earlier marks is a word that is part of basic English vocabulary, the meaning of which is widely understood throughout the EU. Therefore, the earlier marks will be perceived as referring to a star or a famous person. It is possible that a part of the relevant public will attribute to the element 'stor' of the contested mark the sense of the Danish and Swedish word 'stor', meaning 'big, large', or will regard it as a reference to the English word 'store' meaning 'shop, storage'. It is, however, more likely that the majority of the relevant public will not attribute any particular meaning to that element. Therefore, the relevant public will perceive the marks at issue as conceptually different inasmuch as the earlier marks have a clear meaning throughout the EU, while the mark applied for has either a different meaning for part of the relevant public or no meaning. According to settled case-law, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences between those signs may counteract the visual and aural similarities between them. The Board of Appeal was right to find that the visual and conceptual differences between the marks prevented any assumption of a possible link between them (paras 25 to 36).</p>		

Earlier reputed sign	TM application	Case No
<p>ONLY</p>		<p>07/10/2010, R 1556/2009-2 (confirmed) 08/12/2011, T-586/10, EU:T:2011:722</p>
<p>The goods in Class 3 are identical and target the same public. There is a slight degree of visual and conceptual similarity between the signs at issue and a moderate degree of aural similarity. Even if the earlier marks had a reputation, the differences between the signs, in particular due to the conceptual unit created by the combination of the element 'only' and the distinctive dominant element 'givenchy', would be significant enough for the public not to make any connection between them. Therefore, the Board of Appeal was correct in finding that one of the conditions for applying Article 8(5) TMR, namely that the signs be sufficiently similar to lead the relevant public to make a connection between them, has not been met (paras 65 and 66).</p>		

Earlier reputed signs	TM application	Case No
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KARUNA		29/06/2010, R 696/2009-4, (confirmed 20/06/2012, T-357/10, EU:T:2012:312)
<p>The goods concerned, <i>chocolate</i> in Class 30, are identical. The signs differ visually not only because of the figurative elements in the sign applied for, but also because of their verbal elements. Even though the verbal elements of the marks at issue have three letters out of six in common, a difference arises because the earlier marks begin with the letters 'ka' while the mark applied for begins with the letters 'co', and because the consumer normally attaches more importance to the first part of words. There is a low degree of phonetic similarity between the signs taken as a whole. Conceptually, the word 'corona', meaning 'crown' in Spanish, does not have any meaning in Estonian, Latvian or Lithuanian. Accordingly, no conceptual comparison is possible between the signs at issue in the three Baltic States. The mere fact that the Lithuanian word 'karūna' means 'crown' is not sufficient to establish that the relevant public associates the terms 'karuna' or 'karūna' with the word 'corona', which remains a foreign word. To conclude, the General Court reiterated that if the condition of similarity of the signs is not met under Article 8(1)(b) TMR, it must also be held, on the basis of the same analysis, that that condition is not met under Article 8(5) TMR either (paras 30 to 34 and 49).</p>		

Earlier reputed sign	TM application	Case No
SYLVANIA		30/09/2016, T-430/15, Silvania Food (fig.) / SYLVANIA et al., EU:T:2016:590
<p>The lack of any similarity between the goods and services combined with the fact that the earlier mark does not have a strong reputation rule out any link between the marks at issue. It is unlikely that the quality image of the earlier mark associated with lights and lamps might be transferred to the foodstuffs or food industry services covered by the contested mark (para. 46).</p>		

3.4 The risk of injury

3.4.1 Protected subject matter

Article 5(g) of the **Law** does not protect the reputation of the earlier mark as such, in the sense that it does not intend to prevent the registration of all marks identical with or similar to a mark with reputation. In addition, there must be a likelihood that use of the contested application without due cause would take unfair advantage of, or would be detrimental to, the distinctive character or the repute of the earlier mark. Therefore, once the condition as to the existence of reputation is fulfilled, the examination has to proceed regarding the condition that the earlier mark must be detrimentally affected.

Apart from indicating origin, a trade mark may also fulfil other functions worthy of protection. More particularly, a trade mark can offer a guarantee that all the goods coming from a single undertaking have the same quality (**guarantee function**) and that it can serve as an advertising instrument by reflecting back the goodwill and prestige it has acquired in the market (**advertising function**).

It follows that trade marks serve not only to indicate the origin of a product, but also to convey a certain **message or image** to the consumer, which is **incorporated in the sign** mostly through use and, once acquired, forms part of its distinctiveness and repute. In most cases of reputation these features of the trade mark will be particularly developed, as the commercial success of a brand is usually based on product quality, successful promotion, or both, and, for this reason, will be especially valuable to the trade mark owner. This **added value** of a mark

with reputation is precisely what Article 5(g) of the **Law** intends to protect against undue detriment or unfair advantage.

Hence, the protection under Article 5(g) of the **Law** extends to all cases where the use of the contested trade mark applied for is likely to have an adverse effect on the earlier mark, in the sense that it would diminish its attractiveness (**detriment to distinctiveness**) or devalue the image it has acquired among the public (**detriment to repute**), or where use of the contested mark is likely to result in misappropriation of its powers of attraction or exploitation of its image and prestige (**taking unfair advantage of the distinctive character or repute**).

Given also that a **very strong reputation** is both easier to harm and more tempting to take advantage of, owing to its great value, it is underlined that ‘the stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it’. The same must be accepted as regards the unfair advantage that the applicant might enjoy at the expense of the earlier mark.

3.4.2 Assessment of the risk of injury

As stated in paragraph 3.3, any type of injury under Article 5(g) of the **Law** is the consequence of an association between the conflicting marks in the minds of the public, made possible by the similarities between the marks, their distinctiveness, the reputation and other factors.

The more immediately and strongly the earlier mark is brought to mind by the later sign, the greater the likelihood that current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to it.

Therefore, the evaluation of detriment or unfair advantage must be based on an overall assessment of all the factors relevant to the case (including in particular the similarity of signs, the reputation of the earlier mark, and the respective consumer groups and market sectors), with a view to determining whether the marks may be associated in a way that may adversely affect the earlier trade mark.

3.4.3 Types of injury

Article 5(g) of the **Law** refers to the following types of injury: ‘take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark’. Therefore, Article 5(g) of the **Law** applies if any of the following **three alternative requirements** is fulfilled, namely if use of the contested mark would:

- take unfair advantage of the distinctiveness, or the repute of the earlier mark;
- cause detriment to the distinctiveness;
- cause detriment to the repute.

As regards the first type of injury, the wording of Article 5(g) of the **Law** suggests the existence of two kinds of unfair advantage, but it is treated as a single injury under Article 5(g) of the **Law**. For the sake of completeness, both aspects of the same injury will be dealt with under paragraph 3.4.3.1 below.

Likelihood of confusion relates **only** to confusion about the commercial origin of goods and services. Article 5(g) of the **Law**, in contrast, protects earlier **reputed** marks in cases of association or confusion that does not necessarily relate to the commercial origin of goods/services. Article 5(g) of the **Law** protects the heightened effort and financial investment that is involved in creating and promoting trademarks to the extent that they become reputed by protecting these marks against later similar marks taking unfair advantage of, or being detrimental to, the distinctive character or the repute of the earlier trade mark. There is a rich

lexicon of vocabulary that is used in relation to this area of trademark law. The most common terms are set out below.


Terms in Article 5(g) of the Law	Commonly used equivalents
Unfair advantage	Free-riding, riding on the coat-tails
Detriment to distinctiveness	Dilution by blurring, dilution, blurring, watering down, debilitating, whittling away
Detriment to repute	Dilution by tarnishing, tarnishment, degradation

3.4.3.1 Taking unfair advantage of distinctiveness or repute

The nature of the Injury

The notion of taking **unfair advantage of distinctiveness or repute** covers cases where the applicant benefits from the attractiveness of the earlier right by affixing on its goods/services a sign that is similar (or identical) to one widely known in the market and, thus, misappropriating its attractive powers and advertising value or exploiting its reputation, image and prestige. This may lead to unacceptable situations of commercial parasitism, where the applicant is allowed to take a ‘free ride’ on the opponent’s investment in promoting and building up goodwill for its mark, as it may stimulate sales of the applicant’s products to an extent that is disproportionately high in comparison with the size of its promotional investment.

The unfair advantage exists where there is a transfer of the image of the mark or of the characteristics that it projects to the goods identified by the identical or similar sign. By riding on the coat-tails of the reputed mark, the applicant benefits from the power of attraction, reputation and prestige of the reputed mark. The applicant also exploits, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the image of that mark. It concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that marketing of those goods is made easier by that association with the earlier mark with a reputation.¹²³

Earlier reputed sign	TM application	Case No
RSC-ROYAL SHAKESPEARE COMPANY 	Royal Shakespeare	06/07/2012, T-60/10, EU:T:2012:348
The unfair advantage taken of the distinctive character or the repute of the earlier trade mark consists in the fact that the image of the mark with a reputation or the characteristics that it projects will be transferred to the goods covered by the mark applied for, with the result that the marketing of those goods can be made easier by the association with the earlier mark with a reputation (para. 48).		

¹²³ 19/06/2008, T-93/06, Mineral Spa, EU:T:2008:215, § 40; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40; 30/01/2008, T-128/06, Camelo, EU:T:2008:22, § 46

Relevant consumer

The concept of 'unfair advantage' focuses on benefit to the later mark rather than harm to the earlier mark; what is prohibited is the exploitation of the earlier mark by the proprietor of the later mark. Accordingly, the existence of the injury consisting of unfair advantage obtained from the distinctive character or repute of the earlier mark must be assessed **by reference to average consumers of the goods or services for which the later mark is applied for.**

The assessment of unfair advantage

In order to determine whether the use of a sign takes unfair advantage of the distinctive character or repute of the mark, it is necessary to undertake an **overall assessment**, which takes into account all the factors relevant to the circumstances of the case.

The misappropriation of the distinctiveness and repute of the earlier mark presupposes an **association** between the respective marks, which **makes possible the transfer of attractiveness and prestige** to the sign applied for. The more immediately and strongly the earlier reputed mark is brought to mind by the contested mark, the greater the likelihood that the current or future use of the mark would take unfair advantage of the distinctiveness or repute of the earlier mark. An association of this kind will be more likely in the following circumstances.

1. Where the earlier mark possesses a **strong reputation or a very strong (inherent) distinctive character**, because in such a case it will be both more tempting for the applicant to try to benefit from its value and easier to associate it with the sign applied for. Such marks will be recognised in almost any context, exactly because of their outstanding distinctiveness or 'good' or 'special' reputation, in the sense that it reflects an image of excellence, reliability or quality, or some other positive message, which could positively influence the choice of the consumer as regards goods of other producers. The stronger the distinctive character of the earlier mark, the more likely it is that, when encountering a later identical or similar mark, the relevant public will associate it with that earlier mark¹²⁴.

2. The **more similar the marks** are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public.¹²⁵

3. Where there is a **special connection** between the goods/services, which allows for some of the qualities of the opponent's goods/services to be attributed to those of the applicant. This will be particularly so in the case of **neighbouring markets**, where a 'brand extension' would seem more natural, as in the example of *pharmaceuticals* and *cosmetics*; the healing properties of the former may be presumed in the latter when it bears the same mark. Similarly, the Court has held that certain drinks (Classes 32 and 33) commercialised as improving sexual performance were linked to the properties of the goods in Class 5 (pharmaceutical and veterinary products and substances) for which the earlier mark, *Viagra*, was registered. Conversely, such a link was not found between *credit card services* and *cosmetics*, as it was thought that the image of the former is not transferable to the latter, even though their respective users largely coincide.

4. Where, in view of its special attractiveness and prestige, the earlier mark may be **exploited even outside its natural market sector**, for example, by licensing or merchandising. In this case, if the applicant uses a sign that is identical or similar to the earlier mark for goods for which the latter is already exploited, it will obviously profit from its de facto value in that sector.

¹²⁴ 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 27

¹²⁵ 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 26; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 44

5. Although likelihood of confusion between the two marks at issue is not required to demonstrate that the later mark takes unfair advantage of the earlier mark, where such likelihood is established on the basis of facts, this will be taken as proof that unfair advantage has been taken or that, at least, there is a serious risk of such injury in the future).

6. The existence of a family of marks may also be a relevant factor for assessing whether unfair advantage is being taken.¹²⁶

Taking unfair advantage of the distinctiveness or repute of a trade mark may be a deliberate decision, for example where there is clear exploitation and riding on the coat-tails of a famous mark, or an attempt to trade upon the reputation of a famous mark. However, taking unfair advantage does not necessarily require a deliberate intention to exploit the goodwill attached to someone else's trade mark.

Therefore, bad faith is not in itself a condition for the application of Article 5(g) of the **Law**, which only requires that the advantage be '**unfair**', in that there is **no justification** for the applicant's profit. However, where the evidence shows that the applicant is clearly acting in bad faith, there will be a strong indication of unfair advantage. The existence of bad faith may be inferred from various factors, such as an obvious attempt by the applicant to imitate an earlier sign of great distinctiveness as closely as possible, or where there is no apparent reason why it chose for its goods a mark that includes such a sign. Moreover, instances of actual use of the mark applied for (even outside the country) may serve as basis for a logical inference relating to the likely commercial use of the mark applied for in Georgia, in order to establish whether a risk of unfair advantage exists.¹²⁷

Finally, the concept of unfair advantage in Article 5(g) of the **Law** does not relate to the **detriment** caused to the reputed mark. Accordingly, advantage taken by a third party of the distinctive character or repute of the mark may be unfair even if the use of the identical or similar sign is not detrimental to the distinctive character or repute of the mark or, more generally, to its proprietor. It is, therefore, not necessary for the opponent to show that the applicant's benefit is detrimental to its economic interests or to the image of its mark (unlike with tarnishing, see below), as in most cases the 'borrowed' distinctiveness/prestige of the sign will principally affect the applicant's competitors, that is, traders dealing in identical/similar/neighbouring markets, by putting them at a competitive disadvantage. However, the possibility of simultaneous detriment to the opponent's interests should not be ruled out completely, especially in instances where use of the sign applied for could affect the opponent's merchandising schemes or would hinder its plans to penetrate a new market sector.

Cases on unfair advantage


Risk of unfair advantage established

Earlier reputed sign	TM application	Case No
INTEL	INTELMARK	26/06/2008, C-252/07, EU:C:2008:370

¹²⁶ 05/07/2016, T-518/13, MACCOFFEE, EU:T:2016:389, § 103

¹²⁷ 07/12/2017, T-61/16, MASTER (fig.) / COCA-COLA (fig.) et al., EU:T:2017:877, § 88

In her opinion in the *Intel* preliminary ruling, Advocate General Sharpston referred to unfair advantage as follows: 'The concepts of taking unfair advantage of the distinctive character or repute of the mark in contrast must be intended to encompass "instances where there is clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation". Thus by way of example Rolls Royce would be entitled to prevent a manufacturer of whisky from exploiting the reputation of the Rolls Royce mark in order to promote his brand. It is not obvious that there is any real difference between taking advantage of a mark's distinctive character and taking advantage of its repute; since however nothing turns on any such difference in the present case, I shall refer to both as free-riding' (para. 33).

Earlier reputed sign	TM application	Case No
CITIBANK et al.		16/04/2008, T-181/05, EU:T:2008:112

'... the reputation of the trade mark CITIBANK in the European Community in regard to banking services is not disputed. That reputation is associated with features of the banking sector, namely, solvency, probity and financial support to private and commercial clients in their professional and investment activities.'

'...there is a clear relationship ... between the services of customs agencies and the financial services offered by banks such as the applicants, in that clients who are involved in international trade and in the import and export of goods also use the financial and banking services, which such transactions require. It follows that there is a probability that such clients will be familiar with the applicants' bank given its extensive reputation at international level.'


'In those circumstances, the Court holds that there is a high probability that the use of the trade mark applied for, CITI, by customs agencies, and therefore for financial agency activities in the management of money and real estate for clients, may lead to free-riding, that is to say, it would take unfair advantage of the well-established reputation of the trade mark CITIBANK and the considerable investments undertaken by the applicants to achieve that reputation. That use of the trade mark applied for, CITI, could also lead to the perception that the intervener is associated with or belongs to the applicants and, therefore, could facilitate the marketing of services covered by the trade mark applied for. That risk is further increased because the applicants are the holders of several trade marks containing the component "citi"' (paras 81 to 83).


Earlier reputed sign	TM application	Case No
Spa	Mineral Spa	19/06/2008, T-93/06, EU:T:2008:215

MINERAL SPA (for soaps, perfumeries, essential oils, preparations for body and beauty care, preparations for the hair, dentifrices in Class 3) could take unfair advantage of the image of the earlier trade mark SPA and the message conveyed by it in that the goods covered by the contested application would be perceived by the relevant public as supplying health, beauty and purity. It is not a question of whether toothpaste and perfume contain mineral water, but whether the public may think that the goods concerned are produced from or with mineral water (paras 43 and 44).

Earlier reputed sign	Case No
L'Oréal et al.	12/07/2011, C-324/09, EU:C:2011:474

According to L'Oréal et al., the defendants manufactured and imported perfume that was a 'smellalike' of L'Oréal's fragrances but sold at a considerably lower price, using packaging that was reminiscent of the get-up covered by L'Oréal's marks. The defendants used comparison lists to present the perfumes, which they marketed as being imitations or replicas of goods bearing a trade mark with repute. Under Council Directive 84/450/EEC, comparative advertising that presents the advertiser's products as an imitation of a product bearing a trade mark is inconsistent with fair competition and thus unlawful. Therefore, any advantage gained by the advertiser through such advertising will have been achieved as a result of unfair competition and must be regarded as taking unfair advantage of the reputation of that mark).

Earlier reputed sign	TM application	Case No
Nasdaq		10/05/2007, T-47/06, EU:T:2007:131
<p>'Taking account of the fact that the financial and stock market listing services supplied by the intervener under its trade mark Nasdaq and, therefore, the trade mark Nasdaq itself, undeniably present a certain image of modernity [the link between the signs] enables the transfer of that image to sports equipment and, in particular, to the high-tech composite materials which would be marketed by the applicant under the mark applied for, which the applicant appears to recognise implicitly by stating that the word 'nasdaq' is descriptive of its main activities.</p> <p>Therefore, in light of that evidence, and taking account of the similarity of the marks at issue, the importance of the reputation and the highly distinctive character of the trade mark Nasdaq, it must be held that the intervener has established prima facie the existence of a future risk, which is not hypothetical, of unfair advantage being drawn by the applicant, by the use of the mark applied for, from the reputation of the trade mark Nasdaq. There is therefore no need to set aside the contested decision on that point' (paras 60 and 61).</p>		

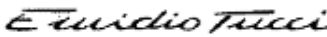
Earlier reputed sign	TM application	Case no.
RSC-ROYAL SHAKESPEARE COMPANY 	Royal Shakespeare	06/07/2012 T- 60/10, EU:T:2012:348
<p>There is a certain proximity and link between <i>entertainment services</i> and <i>beer</i>, even a certain similarity due to their complementarity. The public in the United Kingdom would be able to make a link with the Royal Shakespeare Company (RSC) when seeing a beer with the contested mark Royal Shakespeare in a supermarket or in a bar. The contested mark would benefit from the power of attraction, the reputation and the prestige of the earlier mark for its own goods and services, which would attract the consumers' attention thanks to the association with RSC, thereby gaining a commercial advantage over its competitors' goods. The economic advantage would consist of exploiting the effort expended by RSC to establish the reputation and the image of its earlier mark without paying any compensation in exchange. That equates to an unfair advantage (para. 61).</p>		

Earlier reputed sign	TM application	Case No
Viagra	Viagura	25/01/2012, T-332/10, EU:T:2012:26

While recognising that the primary function of a trade mark was as an indicator of origin, the General Court held that a mark could also serve to transmit other messages, concerning particular qualities or characteristics of the designated goods or services, or the images and sensations projected by the mark itself, such as luxury, lifestyle, exclusivity, adventure or youth. In this sense, a trade mark possessed an intrinsic economic value that was autonomous and distinct to that of the goods or services for which it was registered (para. 57).

The risk of taking unfair advantage encompasses cases of manifest exploitation or parasitism of a mark with reputation, namely the risk of transferring the image of the mark with reputation or the characteristics projected by it to the goods covered by the mark applied for, thus facilitating the marketing of those goods through association with the earlier mark with reputation (para. 59).

The Court concluded that, even if the drinks claimed by the mark applied for would not in reality produce the same benefit as the 'immensely well-known' pharmaceutical for the treatment of erectile dysfunction, what was important was that the consumer, because of the transfer of positive associations projected by the image of the earlier mark, would be inclined to purchase such drinks in the expectation of finding similar qualities, such as an increase in libido (paras 52 and 67).


Earlier reputed sign	TM Application	Case no
EMILIO PUCCI		27/09/2012, T-373/09, Emidio Tucci, EU:T:2012:500 (18/06/2009, R 770/2008-2 & R 826/2008-2, EMIDIO TUCCI (fig.) / EMILIO PUCCI (fig.))

Although the applicant's cosmetic products are dissimilar to the opponent's clothes, they both fall squarely within the realm of products that are often sold as luxury items under famous marks of well-known designers and manufacturers. Taking into account that the earlier mark is very well known and that the commercial contexts in which the goods are promoted are relatively close, BoA concluded that consumers of luxury clothes will make a connection between the applicant's mark for soaps, perfumery, essential oils, cosmetics and hair lotions in Class 3 and the famous mark 'EMILIO PUCCI', an association that will produce a commercial benefit as per the Board's findings (BoA para. 129).



BoA concluded that there was a strong likelihood that the applicant could exploit the reputation of the opponent's mark for its own benefit. The use of the mark applied for in connection with the goods and services mentioned above will almost certainly draw the relevant consumer's attention to the opponent's highly similar and very well-known mark. The applicant will become associated with the aura of luxury that surrounds the 'EMILIO PUCCI' brand. Many consumers are likely to think that there is a direct connection between the applicant's goods on the one hand, and the famous Italian fashion house on the other, perhaps in the form of a licensing agreement. The applicant could take unfair advantage of the fact that the public knows the trade mark 'EMILIO PUCCI' well in order to introduce its own highly similar trade mark without incurring any great risk or the costs of introducing a totally unknown trade mark onto the market (BoA para. 130).

The General Court confirmed the BoA findings.

Earlier reputed sign	TM Application	Case no
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McDONALD'S et al		10/10/2019, T-428/18, mc dreams hotels Träumen zum kleinen Preis! (fig.) / McDONALD'S et al., EU:T:2019:738
<p>The prefix 'mc' of the opponent's family of marks has acquired a high degree of distinctiveness through its use on the fast-food market. Given the exceptional nature of the reputation of the earlier mark, the average level of attention of the relevant public, the existence of a degree of similarity between the marks and the significant degree of similarity between the services, as well as the existence of a family of marks, the structure of which is reproduced, at least in part, by the mark applied for, the relevant public would establish a link between the marks, even though the opponent did not offer any form of accommodation or hotel services. The relevant public would associate the mark applied for with the image of reliability, efficiency, low-cost services and, on that account, choose it instead of the services provided by its competitors. The mark applied for would therefore ride on the coat-tails of the earlier mark to benefit from the power of attraction, the reputation and the prestige of that mark. The economic advantage would consist, for the applicant, of exploiting the effort expended by the opponent to establish the reputation and the image of its earlier mark, without paying any compensation in exchange (paras 71, 85, 90 and 98).</p>		

Risk of unfair advantage denied

Earlier reputed sign	TM Application	Case no
	BEPOST	20/02/2018, T-118/16, BEPOST / ePOST (fig.) et al., EU:T:2018:86
<p>Due to the significant differences between the marks and the weak distinctive character of the common element 'post', the relevant public will not make any link between the mark applied for and the earlier national word mark POST, since the term 'post', in the context of the mark applied for, is likely to be perceived merely as a reference to postal services (para. 115).</p>		
Earlier reputed sign	TM application	Case No
O2		03/07/2012, R 2304/2010-2, O2 0% MDI emission (fig.) / O2 et al.
<p>The Board of Appeal found that (1) the marks have very limited similarities and are dissimilar overall; (2) use of the common designation 'O2' is descriptive in the mark applied for; and (3) given the completely different areas of use — and the descriptive use of the common element — there can be no possibility of the applicant benefiting from the distinctive character of the earlier mark, even if there may be an overlap in the relevant public (para. 55).</p>		

Earlier reputed sign	TM application	Case No
Vips	Vips	22/03/2007, T-215/03, EU:T:2007:93
<p>The earlier mark Vips has a reputation for restaurants, in particular fast-food chains. However, it was not proven that it also enjoys any particular prestige. The term Vips is laudatory in itself and extensively used in this manner. There is no explanation as to how the sales of software products under the mark Vips could possibly benefit from their association with a fast-food chain, even if a link were made. Therefore, the Court rules out the risk that use of the mark applied for would take unfair advantage of the distinctive character or repute of the earlier mark.</p>		
Earlier reputed sign	TM application	Case No
Spa	Spa-Finders	25/05/2005, T-67/04, EU:T:2005:179
<p>Spa has a reputation for <i>mineral water</i> in the Benelux. The contested mark, Spa-Finders, covers <i>publications, catalogues, magazines, newsletters, travel agency services</i>. The General Court declared that there was no detrimental link between the signs. The sign Spa is also used to denote the town of Spa and the racing circuit of the same name. There is no evidence of unfair advantage or any kind of exploitation of the fame of the earlier mark. The word Spa in the mark applied for only denotes the kind of publication concerned.</p>		

Earlier reputed sign	TM application	Case No
TDK	TDK-EPC	19/12/2014, R 2090/2013-2, TDK / TDK-EPC (fig.) et al.
<p>The earlier mark 'TDK' has a reputation within the European Union for 'audio and videotape goods'. The opponent argued that '[b]uilding and construction is a specific commercial area in which use of a TDK could diminish a reputation of the sort and nature of a company such as the opponent'. The Board found that this argument, which seems to be a mixture of allegations that there is detriment to the reputation and detriment to the distinctive character of the earlier mark, is no more than a mere statement, which is not corroborated by any evidence that would demonstrate <i>prima facie</i> a serious risk of change in economic behaviour or of a reduction in the trade mark's power of attraction.</p>		

3.4.3.2 Detriment to distinctiveness

The nature of the injury

Detriment to the distinctive character of an earlier reputed mark (also referred to as 'dilution', 'whittling away' or 'blurring') is caused when that mark's ability to identify the goods/services for which it is registered and used as coming from its proprietor is weakened because use of a later similar mark leads to dispersion of the identity of the earlier reputed mark by making it less distinctive or unique.¹²⁸

Article 5(g) of the **Law** states that a proprietor of a reputed mark may oppose TM applications that, without due cause, would be detrimental to the **distinctive character** of earlier reputed marks. Clearly, therefore, the object of protection is the **distinctiveness** of the earlier reputed mark. 'Distinctiveness' refers to the greater or lesser capacity of a mark to identify the goods/services for which it has been registered as coming from a particular undertaking. Therefore, Article 5(g) of the **Law** protects reputed marks against a reduction of their distinctive quality by a later similar mark even where the later mark relates to dissimilar goods/services.

¹²⁸ 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 29

The protection provided in Article 5(g) of the **Law**, acknowledges that unrestrained use of a reputed mark by third parties, even on dissimilar goods, will eventually reduce the distinctive quality or uniqueness of that reputed mark. For example, if Rolls Royce were used on restaurants, pants, candy, plastic pens, yard brushes, etc., its distinctiveness would eventually be dispersed and its special hold upon the public would be reduced — even in relation to cars, for which it is reputed. Consequently, the Rolls Royce mark's ability to identify the goods/services for which it is registered and used as coming from its proprietor would be weakened in the sense that consumers of the goods for which the reputed mark is protected and reputed will be less inclined to associate it **immediately** with the owner that has built up the trade mark's reputation. This is because, for those consumers, the mark now has several or many 'other' associations, where it previously had only one.

Relevant consumer

Detriment to the distinctive character of the earlier reputed mark must be assessed by reference to the average consumers of the goods and services **for which that mark is registered**, who are reasonably well informed and reasonably observant and circumspect.

The assessment of detriment to distinctiveness

Detriment to the distinctiveness of the earlier reputed mark occurs where use of a later similar mark reduces the distinctive quality of the earlier reputed mark. However, this cannot be found to occur merely because the earlier mark has a reputation and is identical with or similar to the mark applied for — such an approach would apply an automatic and indiscriminate finding of likelihood of dilution against all marks that are similar to reputed trademarks and would negate the requirement of proving detriment.

As held by the European Court of Justice in *Intel*, the proof that use of the later mark would be detrimental to the distinctive character of the earlier mark requires evidence of a 'change in the economic behaviour' of the average consumer of the goods/services for which the earlier mark was registered, or a serious likelihood that such a change will occur in the future.

The European Court of Justice has further elaborated on the concept of 'change in the economic behaviour of the average consumers' in its judgment of 14/11/2013, C-383/12 P, *Répresentation d'une tête de loup*, EU:C:2013:741. It indicated that it is an autonomous objective condition, which cannot be deduced solely from subjective elements such as how consumers perceive the dispersion of the reputed mark's image and identity. The mere fact that consumers note the presence of a new similar sign that is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the mark's proprietor, is not sufficient by itself to establish the existence of detriment or a risk of detriment to the distinctive character of the reputed mark (paras 35 to 40).

Whilst the opponent does not need to submit evidence of **actual** detriment, it must convince Sakpatenti by adducing evidence of a serious future risk — which is not merely hypothetical — of detriment. The opponent may do this by submitting evidence that proves a likelihood of detriment on the basis of logical deductions made from an analysis of the probabilities (and not mere suppositions), and by taking account of normal practice in the relevant commercial sector as well as of all the other circumstances of the case.¹²⁹

First use

Detriment to distinctive character is characterised by an 'avalanche effect', meaning that the first use of a similar mark in a distinct market may not, in itself, dilute the identity or 'uniqueness' of the reputed mark but, over time, this would be the result, because this first use

¹²⁹ 16/04/2008, T-181/05, *Citi*, EU:T:2008:112, § 78, as cited in 22/05/2012, T-570/10, *Répresentation d'une tête de loup*, EU:T:2012:250, § 52; confirmed 14/11/2013, C-383/12 P, *Répresentation d'une tête de loup*, EU:C:2013:741, § 42-43

may trigger further acts of use by different operators, thus leading to its dilution or detriment to its distinctive character.

The first use of an identical or similar mark **may** suffice, **in some circumstances**, to cause actual and present detriment to the distinctive character of the earlier mark or to give rise to a serious likelihood that such detriment will occur in the. In opposition proceedings before Sakpatenti, use of the contested sign may not have occurred at all. In this regard, Sakpatenti takes into account that future use of the contested sign, even if it were first use, may trigger further acts of use by different operators, under particular circumstances that are to be provided by the opponent, therefore leading to dilution by blurring. As seen above, the wording of Article 5(g) of the **Law** provides for this by stating that use of the mark applied for without due cause '**would ... be detrimental to ... the distinctive character or the repute of the earlier trademark**'.

Nevertheless, as set out above, the opponent bears the burden of showing that actual or future use causes, or is likely to cause, detriment to the distinctiveness of the earlier reputed mark.

Inherent distinctiveness of the earlier mark

'The more "unique" the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character'.¹³⁰ Indeed, the earlier mark must possess an exclusive character in the sense that it should be associated by the consumers with a single source of origin — since it is only in this case that a likelihood of detriment to distinctiveness may be envisaged. If the same sign, or a variation thereof, is already in use in connection with a range of different goods, there can be no immediate link with any of the goods it distinguishes and, thus, there will be little or no room for further dilution.

Accordingly, '... the risk of dilution appears, in principle, to be lower if the earlier mark consists of a term which, because of a meaning inherent in it, is very common and frequently used, irrespective of the earlier mark consisting of the term at issue. In such a case, reuse of the term in question by the mark applied for is less likely to result in a dilution of the earlier mark'.

If, therefore, the mark is suggestive of a characteristic shared by a wide range of goods, the consumer is more likely to associate it with the specific feature of the product that it alludes to rather than with another mark.



Thus, if the applicant shows that the earlier sign or the element that gives rise to similarity is commonplace and is already used by different undertakings in various sectors of the market, it may successfully refute the existence of a likelihood of dilution, because it will be difficult to accept that the attractiveness of the earlier mark risks being diluted if it is not particularly unique.

Cases on dilution by blurring

Dilution established

Earlier reputed sign	TM application	Case No
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¹³⁰ 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 74; 28/10/2010, T-131/09, Botumax, EU:T:2010:458

		<p>28/01/2014, R 69/2013-4, CAMEL BRAND (fig.) / CAMEL (fig.) et al.</p>
<p>Reputed for tobacco products</p>	<p>Foodstuffs in Classes 29, 30 and 32</p>	
<p>First of all, taking into account the very high similarity between the conflicting marks and the high reputation of the earlier mark, there is a risk that the public will be led to believe that the CAMEL food products originate from, or that the mark is used with the consent of, the opponent. Moreover, the capacity of the reputed CAMEL mark to arouse immediate association with the opponent's business will be diminished by the use of the contested mark. The use of a highly similar mark for food products would be detrimental to the distinctive character of the reputed CAMEL trademark for tobacco products, making this mark ordinary, which is in essence a diminution of the power of attraction of the mark. This will lead to dispersion of the identity and hold upon the public's mind of the earlier mark. The earlier mark, used to arouse immediate association with the goods for which it is registered, will no longer be capable of doing so. It follows that there is a clear probability of damage to the earlier mark's advertising function as a vehicle for building up and retaining brand loyalty, and that the economic value of the earlier reputed mark will be impaired, in the medium or long term, as a consequence of the use of the contested mark, in the sense that consumers of the goods for which the reputed mark is protected and known will be less inclined to associate it immediately with the undertaking that has built up the trade mark's reputation; this must be considered a change in their economic behaviour (para. 41).</p>		

Dilution denied

Earlier reputed sign	TM application	Case No
<p>Vips</p>	<p>Vips</p>	<p>22/03/2007, T- 215/03,</p>
<p>Reputed for <i>fast food restaurant chain</i> in Class 42</p>	<p><i>Computer programming for hotel services</i> in Class 42</p>	<p>EU:T:2007:93</p>



So far as concerns, first, detriment to the distinctive character of the earlier mark by the use without due cause of the mark applied for, that detriment can occur where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used (*SPA-FINDERS*, paragraph 34 above, paragraph 43). That risk thus refers to the “dilution” or “gradual whittling away” of the earlier mark through the dispersion of its identity and its hold upon the public mind (Opinion of Advocate General Jacobs in *Adidas-Salomon and Adidas-Benelux*, paragraph 36 above, point 37)’ (para. 37).

‘As far as concerns, first, the risk that the use of the mark applied for would be detrimental to the distinctive character of the earlier mark, in other words the risk of “dilution” and “gradual whittling away” of that mark, as explained in paragraphs 37 and 38 above, it must be pointed out that the term “VIPS” is the plural form, in English, of the abbreviation VIP (“Very Important Person”), which is widely and frequently used both internationally and nationally to describe famous personalities. In those circumstances, the risk that the use of the mark applied for would be detrimental to the distinctive character of the earlier mark is limited’ (para. 62).

‘That same risk is also even less probable in the present case as the mark applied for covers the services “Computer programming relating to hotel services, restaurants, cafés”, which are directed at a special and necessarily more limited public, namely the owners of those establishments. The consequence is that the mark applied for, if registration is allowed, will probably be known, through use, only by that relatively limited public, a factor that certainly reduces the risk of dilution or gradual whittling away of the earlier mark through the dispersion of its identity and its hold upon the public mind’ (para. 63).

Earlier reputed sign	TM application	Case No
Spa	Spa-Finders	25/05/2005, T-67/04, EU:T:2005:179
Reputed for <i>mineral waters</i> in Class 32	<i>Printed publications including catalogues, magazines, newsletters</i> in Class 16, <i>Travel agency</i> in Class 39	

‘In the present case, the Court finds that the applicant does not put forward any evidence to support the conclusion that there is a risk of detriment to the distinctive character of the mark SPA by the use of the mark SPA-FINDERS. The applicant stresses the alleged immediate link that the public will establish between SPA and SPA-FINDERS. It infers from that link that there is detriment to the distinctive character. As the applicant acknowledged at the hearing, the existence of such a link is not sufficient to demonstrate the risk of detriment to the distinctive character. The Court notes, moreover, that since the term “spa” is frequently used to designate, for example, the Belgian town of Spa and the Belgian racing circuit of Spa-Francorchamps or, in general, places for hydrotherapy such as hammams or saunas, the risk of detriment to the distinctive character of the mark SPA seems to be limited’ (para. 44).

Earlier reputed sign	TM application	Case No
		14/11/2013, C-383/12 P, Représentation d’une tête de loup, EU:C:2013:741,
Reputed for machine tools in Class 7	Machines for professional and industrial processing of wood and green waste; professional and industrial wood chippers and shredders in Class 7	

In the present case, the Court of Justice annuls the judgment of the General Court by stating that the detriment or the risk of detriment to the distinctive character of the earlier marks cannot be established without adducing the evidence of 'change in the economic behaviour of the average consumer' (para. 36). While the dispersion of the reputed mark's image and identity in the public's perception is a subjective condition, the change in the economic behaviour of this public is objective. It cannot be deduced from the mere fact that consumers note the presence of a new similar sign in a way that is likely to undermine the earlier mark's ability to identify the goods for which it is registered as coming from the proprietor of that mark (paras 37 and 39). The General Court should have examined whether any actual change in economic behaviour had occurred, or was likely to occur, on the basis of 'an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case' (para. 43). Since it failed to do so, the General Court violated Article 8(5) EUTMR.

3.4.3.3 Detriment to repute

The nature of the injury

The final type of damage under Article 5(g) of the **Law** concerns harming the earlier mark by way of detriment to its repute. It can be seen as a step beyond blurring in that the mark is not merely weakened but actually degraded by the link that the public makes with the later mark. Detriment to repute, also often referred to as 'dilution by tarnishing' or simply as 'tarnishing', relates to situations where use of the contested mark without due cause is likely to devalue the image or the prestige that a mark with reputation has acquired among the public.

The reputation of the earlier trademark may be tainted or debased in this way, either when it is reproduced in an obscene, degrading or inappropriate context, or in a context that is not inherently unpleasant but that proves to be incompatible with a particular image the earlier trade mark has acquired in the eyes of the public due to the promotional efforts of its owner. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality that is liable to have a negative impact on the image of the mark. For example, if a reputed mark for gin were used by a third party on liquid detergent, this would reverberate negatively on the reputed mark in a way that makes it less attractive.

In short, tarnishment occurs where there is an association between the earlier reputed mark, at the level of either the signs or the goods, that is injurious to the earlier trademark's repute.

Relevant consumer

As with dilution by blurring, detriment to the reputation of the earlier mark must be assessed by reference to average consumers of the goods and services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect.¹³¹

The assessment of tarnishment

In order to establish detriment to the repute of an earlier mark, the mere existence of a connection in the mind of the consumer between the marks is neither sufficient nor determinative. Such a connection must certainly exist, but, **in addition**, either the signs or the goods/services covered by the later mark must provoke a negative or detrimental impact when associated with the reputed mark.

For example, if a mark that is associated in the minds of the public with an image of health, dynamism and youth is used for *tobacco products*, the negative connotation conveyed by the latter would contrast strikingly with the image of the former (see further examples below). For tarnishment to occur, therefore, the goods/services on which the contested mark is used must

¹³¹ 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35; 07/12/2010, T-59/08, Nimei La Perla Modern Classic, EU:T:2010:500, § 35


have characteristics or qualities that are potentially detrimental to the reputation of the earlier mark.¹³²

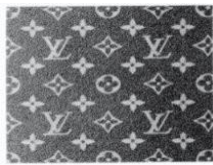
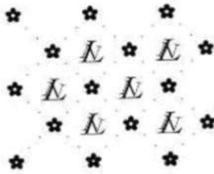
Frequently, opponents argue that the applicant's goods/services are of inferior quality or that the opponent cannot control the quality of such goods/services. The Chamber of Appeals does not accept such an argument, per se, as a means of demonstrating detriment. Proceedings before the Chamber of Appeals do not provide for assessing the quality of goods and services, which, apart from being highly subjective, would not be feasible in cases where the goods and services are not identical or in situations where the contested sign has not yet been put to use.

Therefore, when assessing whether use of the contested trade mark is likely to damage the reputation of an earlier trade mark, the Chamber of Appeals can only consider the goods and services as indicated in the specification of each trade mark. Consequently, for the purposes of the Chamber of Appeals analysis, the harmful effects of use of the contested sign in connection with the goods and services applied for must derive from the nature and usual characteristics of the goods at issue in general, not their quality in particular instances. This approach does not leave the opponent without protection, because, where a later mark is used on low-quality goods/services in a manner that calls to mind an earlier reputed mark, this would in any case normally take unfair advantage of the distinctive character or repute of the earlier trade mark or be detrimental to its distinctiveness.

Cases on dilution by tarnishing

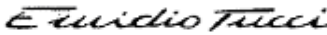
Tarnishment established

Earlier reputed sign	TM application	Case No
KAPPA 	KAPPA	12/03/2012, R 297/2011-5, KAPPA / KAPPA et al.
<i>Reputed for sports clothing and footwear</i>	<i>tobacco products, cigarettes, cigars, amongst others</i>	
<p>The contested application was filed for tobacco and related goods in Class 34. Smoking tobacco is universally considered to be an extremely unhealthy habit. For this reason, use of the sign KAPPA for tobacco and related goods is likely to prompt negative mental associations with the respondent's earlier marks or associations, conflicting with and being detrimental to their image of a healthy lifestyle (para. 38).</p>		



Earlier reputed sign	TM application	Case No
		06/10/2011, R 2124/2010-

¹³² 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 67

<p>Reputed for goods in Classes 18 and 25</p>	<p><i>Scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; amongst others.</i></p>	<p>1, LN (fig.) / LV (fig.) et al.</p>
<p>The opponent demonstrated that the prestigious image of its trade marks is linked to the traditional manufacturing method of its fine leather goods, which are handmade by master craftsmen who work only with top-quality raw materials. It is this image of luxury, glamour and exclusivity, combined with the exceptional quality of the product, that the opponent has always striven to convey to the public, as the evidence adduced testifies. This image would be quite incompatible with goods of a strongly industrial and technological nature, such as electric meters, scientific microscopes, batteries, supermarket cash registers, fire-extinguishing apparatus or other instruments, for which the applicant intends to use its trade mark (para. 28).</p> <p>What would be detrimental to the image of its trade marks, which the opponent has carefully fostered for decades, is the use of a trade mark that recalls its own and is applied to goods characterised, in the public's perception, by a significant technological content (whereas a fine-leather article is rarely associated with technology) or as having an industrial origin (whereas fine leather goods are traditionally associated with craftsmanship) (para. 29).</p> <p>The use of a trade mark that is practically identical to a trade mark that the public has come to perceive as synonymous with fine leather goods of excellent manufacture for technical apparatus or electrical tools of all kinds will diminish its attraction, that is, its reputation, amongst the public that knows and values the earlier trade marks (para. 30).</p>		


Earlier reputed sign	TM application	Case no.
<p>EMILIO PUCCI</p>		
<p>Reputed for <i>clothing and footwear for women</i></p>	<p>Class 3: <i>Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; (abrasive preparations) soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.</i></p> <p>Class 21: <i>Materials for cleaning purposes and steelwool</i></p>	<p>27/09/2012, T-373/09 (R 770/2008-2 & R 826/2008-2)</p>
<p>In its decisions of 18/06/2009 in R 770/2008-2 & R 826/2008-2, the Board stated that the risk of detriment to repute can occur where the goods and services covered by the mark applied for have a characteristic or a quality that may have a negative influence on the image of an earlier mark with a reputation on account of the mark applied for being identical or similar to the earlier mark with reputation. The General Court confirmed the Board's finding, adding that due to the great similarity between the signs at issue, the strong distinctive character of the Italian mark and its repute in the Italian market, it can be concluded that there is a link between the signs in conflict — a link that could damage the idea of exclusivity, luxury and high quality and therefore be detrimental to the repute of the Italian mark (para. 68).</p>		

Tarnishment denied

Earlier reputed sign	TM application	Case No
 <p>SEVE TROPHY</p>		17/12/2010, T-192/09, EU:T:2010:553
Reputed for <i>organisation of sports competitions</i>	Class 9	
<p>The Court noted that the opponent had not demonstrated any risk of injury to the reputation of the earlier marks, since it had not indicated how the attractiveness of the earlier marks would be diminished by use of the contested mark on the contested goods. Specifically, it did not allege that the contested goods have any characteristic or quality that could have a negative influence on the image of the earlier marks (para. 68).</p>		

Earlier reputed sign	TM application	Case No
Spa	Spa-Finders	25/05/2005, T-67/04, EU:T:2005:179
Reputed for <i>mineral waters</i> in Class 32	<i>Printed publications including catalogues, magazines, newsletters</i> in Class 16, <i>Travel agency</i> in Class 39	
<p>'In the present case, SPA and SPA-FINDERS designate very different goods consisting, on the one hand, in mineral waters and, on the other, in publications and travel agency services. The Court finds that it is therefore unlikely that the goods and services covered by the mark SPA-FINDERS, even if they turn out to be of lower quality, would diminish the power of attraction of the mark SPA' (para. 49).</p>		

Earlier reputed sign	TM application	Case no
Vips	Vips	T-215/03
Reputed for fast food restaurant chain in Class 42	<i>Computer programming for hotel services</i> in Class 42	
<p>The Court pointed out that, 'although some fast food chain marks have an indisputable reputation, they do not, in principle and failing evidence to the contrary, convey a particularly prestigious or high-quality image, the fast food sector being associated with other qualities, such as speed or availability and, to a certain extent, youth, since many young people frequent that type of establishment' (para. 57) The Court further stated that 'the services covered by the mark applied for do not have any characteristic or quality capable of establishing the likelihood of detriment of that type to the earlier mark. The applicant neither cited, nor a fortiori proved, any characteristic or quality of that kind. The mere existence of a connection between the services covered by the conflicting marks is neither sufficient nor determinative. It is true that the existence of such a connection strengthens the probability that the public, faced with the mark applied for, would also think of the earlier mark. However, that factor is not, in itself, sufficient to diminish the earlier mark's power of attraction. Such an outcome can arise only if it is established that the services covered by the mark applied for have characteristics or qualities that are potentially detrimental to the reputation of the earlier mark. Such evidence has not been adduced in the present case' (para. 67).</p>		

Earlier reputed sign	TM application	Case no
WATERFORD		23/11/2010, R 240/2004-2, WATERFORD STELLENBOSCH (fig.) / WATERFORD
Reputed for <i>crystal products, including glassware</i> in Class 21	<i>Alcoholic beverages, namely wines produced in the Stellenbosch district, South Africa</i> in Class 33	
<p>'In the present case, on the one hand, it is not possible to attribute from the outset either any specific image to the reputed trade mark or any <i>prima facie</i> evidence of its tarnishment. On the other hand, the opponent has confined itself to pleading that "use and registration of the [contested] trade mark will take unfair advantage of the opponent's trade mark", without giving any evidence or <i>prima facie</i> evidence, even only by way of logical deductions, of such tarnishment. On the contrary, the Board finds no antagonism between either the nature or the way of using glassware and wine, such as that the use of the contested mark might tarnish the earlier mark's image.' (para. 91).</p>		

3.4.4 Proving the risk of injury

3.4.4.1 Standard and burden of proof

In opposition proceedings **detriment or unfair advantage may be only potential**, as confirmed by the conditional wording of Article 5(g) of the **Law**, which requires that the use of the applied-for mark without due cause **'would take** unfair advantage of, **or be** detrimental to the distinctiveness or repute of the earlier mark'.

In opposition proceedings **actual detriment or unfair advantage** will occur only exceptionally, since in most cases the applicant will not have effectively used its mark when the dispute arises. Nevertheless, such a possibility should not be ruled out completely and if there is evidence of actual use or damage, it will have to be considered and given appropriate weight.

However, the fact that detriment or unfair advantage may be only potential does not mean that a mere possibility is sufficient for the purposes of Article 5(g) of the **Law**. The risk of detriment or unfair advantage must be **serious**, in the sense that it is **foreseeable (i.e. not merely hypothetical) in the ordinary course of events**. Therefore, it is not enough to merely show that detriment or unfair advantage cannot be excluded in general, or that it is only remotely possible. The proprietor of the earlier mark **must adduce prima facie evidence** of a future risk, which is **not hypothetical**, of unfair advantage or of detriment. Such a finding may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of normal practice in the relevant commercial sector as well as of all the other circumstances of the case.

As a rule, **general allegations** (such as merely citing the relevant wording of the Law) of detriment or unfair advantage will **not be sufficient** in themselves for proving potential detriment or unfair advantage: the opponent must adduce evidence and/or develop a cogent line of argument to demonstrate specifically how the alleged injury might occur, taking into account both marks, the goods and services in question and all the relevant circumstances.

As such, the **opponent cannot merely contend that detriment or unfair advantage would be a necessary consequence** flowing automatically from use of the sign applied for, owing to the strong reputation of the earlier mark, since, otherwise, marks with reputation would enjoy blanket protection against identical or similar signs for virtually any kind of product. This

would be clearly inconsistent with the wording and spirit of Article 5(g) of the **Law**, because otherwise reputation would become the sole requirement, rather than being only one of several conditions.

The precise threshold of proof that must be satisfied to show that the risk of potential detriment or unfair advantage is **serious** and not merely hypothetical will be determined case by case, following the criteria indicated below. For example, where there is a claim of taking unfair advantage, it cannot be ruled out that if the mark has a high reputation and there is a proven link, the risk of injury can be more readily established.

3.5 Use without due cause

The last condition for the application of Article 5(g) of the **Law** is that use of the sign applied for should be without due cause.

However, if it is established that none of the three types of injury exists, the registration and use of the mark applied for cannot be prevented, as the existence or absence of due cause for use of the mark applied for is, in those circumstances, irrelevant.

The existence of a cause justifying use of the trade mark applied for is a **defence** that the applicant may raise. Therefore, it **is up to the applicant to show that it has due cause to use the mark applied for**. This is an application of the general rule according to which ‘he who asserts must prove’, which is the expression of the ancient rule *ei qui affirmat incumbit probatio*. When the proprietor of the earlier mark has shown that there is either actual and present injury to its mark or, failing that, a serious risk that such injury will occur in the future, it is for the proprietor of the later mark to establish that there is due cause for the use of that mark.¹³³

In the absence of any indications in the evidence providing an apparent justification for the applicant’s use of the contested mark, lack of due cause must be generally **presumed**. However, the applicant may avail itself of the possibility of rebutting such a presumption by showing that it has a legitimate justification that entitles it to use the mark.

For example, such a situation could be envisaged if the applicant had been using the sign for dissimilar goods in Georgia before the opponent’s mark was applied for, or acquired a reputation, especially where such coexistence has not in any way affected the distinctiveness and repute of the earlier mark.

The proprietor of a trade mark with a reputation might be obliged, pursuant to the concept of ‘due cause’ within the meaning of that provision, to tolerate use by a third party of a sign similar to that mark in relation to a product that was identical to that for which that mark had been registered, if it was demonstrated that the sign was being used before the mark had been filed and that use of the sign in relation to the identical product was in good faith.

Due cause may be found where the applicant establishes that it cannot reasonably be required to abstain from use of the mark (for example, because its use of the sign is a generic use to indicate the type of goods and services — whether by generic words or generic figurative devices), or where it has some specific right to use the mark for the goods and services (for example, it shows that a relevant coexistence agreement permits its use of the sign).

The condition of due cause is not fulfilled merely by the fact that (a) the sign is particularly suitable for identifying the products for which it is used, (b) the applicant has already used this sign for these products or similar products within Georgia, or (c) the applicant invokes a right

¹³³ 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 67; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 39

ensuing from a filing over which the filing of the opponent's trade mark takes precedence. Mere use of the sign is not enough — what must be shown is a valid reason justifying that use.

3.5.1 Examples of due cause

3.5.1.1 Due cause was accepted

Case No	Comment
02/06/2010, R 1000/2009-1, GigaFlex / FLEX (fig.) et al., § 72	The EUIPO Board of Appeal confirmed that the applicant had a due cause within the meaning of Article 8(5) TMR for inserting the term FLEX in the mark applied for, holding that this term was free from monopolies, since nobody holds exclusive rights in it and it is a suitable abbreviation, in many languages of the EU, to indicate that beds and mattresses are flexible.
30/07/2007, R 1244/2006-1, MARTINI FRATELLI (fig.) / MARTINI	The EUIPO Board confirmed that the applicant had two good reasons to use the name MARTINI in the mark applied for: (i) MARTINI is the family name of the founder of the applicant's company, and (ii) a coexistence agreement was signed in 1990.
20/04/2007, R 710/2006-2, SPA et al. / CAL SPAS	The EUIPO Board confirmed that the applicant had due cause to use the term SPAS as it corresponds to one of the generic uses of the term 'spa' as indicated by the Court of First Instance in the judgment of 19/06/2008, T-93/06, Mineral Spa, EU:T:2008:215.
23/01/2009, R 237/2008-1 & R 263/2008-1, CARLORONCATO/ RONCATO et al.	The business affairs of the Roncato family, showing that both parties had the right to use the name RONCATO as a trade mark in the suitcase and trunk sector, were held to constitute 'due cause' for use of the RONCATO name in the contested trade mark.
25/08/2011, B 1 708 398, Posten AB v Česká pošta s.p.	It was held that the applicant had due cause to use the figurative element of a postal horn since that device is widely used as a long-standing and historical symbol of postal services (trade mark registrations and internet evidence were submitted showing 29 European countries use the postal horn as a symbol for their postal services).

3.5.1.2 Due cause was not accepted

Case No	Comment
06/07/2012, T-60/10, Royal Shakespeare	The General Court held that, in order to establish due cause, it is not use per se of the contested trade mark that is required, but a reason justifying use of the trade mark. In this case, the applicant merely claimed to have 'demonstrated how and for which product the contested trade mark has been used in the past' but, even assuming that that aspect is relevant, provided no additional indication or explanation. Accordingly, the Court held that the applicant had not established due cause for such use.
25/03/2009, T-21/07, Spaline, EU:T:2009:80	There was no due cause, since it had not been shown that the word 'spa' had become so necessary to the marketing of cosmetic products that the applicant could not reasonably be required to refrain from use of the mark applied for. The argument that 'spa' was of descriptive and generic character for cosmetic products was rejected, since such character does not extend to cosmetic products 'but only to one of their uses or destinations'

16/04/2008, T-181/05, Citi	The General Court held that the use of the trade mark Citi in just one EU Member State (Spain) could not constitute due cause because, first, the extent of geographical protection of the national trade mark did not correspond to the territory covered by the trade mark applied for, and, second, the legal validity of that national registration was subject to dispute before the national courts. By the same token, the ownership of the domain 'citi.es' was held to be irrelevant.
10/05/2007, T-47/06, Nasdaq; confirmed 12/03/2009, C-320/07 P, Nasdaq	The Court held that the only argument put forward before the Board of Appeal in respect of due cause (namely, that the word Nasdaq had been chosen because it is an acronym for 'Nuovi Articoli Sportivi Di Alta Qualità') was not convincing, noting that prepositions are not generally included in acronyms.

Case No	Comment
23/11/2010, R 240/2004-2, WATERFORD STELLENBOSCH (fig.) / WATERFORD	<p>Contrary to the applicant's arguments that there was due cause because the term WATERFORD was allegedly very common in names and trade marks, the Board held that the applicant had failed to give any evidence of market coexistence of WATERFORD marks or to submit any element from which it would be possible to infer that the relevant general public (in the UK) considers Waterford as a commonplace geographical name.</p> <p>To the extent that such arguments play a role in assessing the uniqueness of a sign in order to establish whether the necessary link exists in the mind of the relevant public between the signs at issue, the Board held that, nevertheless, once such uniqueness had been established, such arguments cannot serve as due cause.</p> <p>Furthermore, the Board noted that the condition of due cause is not fulfilled merely by the fact that (a) the sign is particularly suitable for identifying the products for which it is used, (b) the applicant has already used the sign for these products or similar products within and/or outside the relevant territory of the European Union, or (c) the applicant invokes a right ensuing from a filing over which the filing of the opponent's trade mark takes precedence.</p>
22/01/2015, T-322/13, KENZO	According to the Court, the fact that the applicant's forename is Kenzo is not enough to constitute due cause for use of the mark applied for.
06/10/2006, R 428/2005-2, TISSOT / TISSOT	The Board held that the applicant's claim (unsubstantiated by any evidence) that the sign TISSOT is derived from the name of a trading company associated with the applicant's company since the early 1970s, would, even if proven, not amount, on its own, to 'due cause'. People who inherit a surname that happens to coincide with a famous trade mark should not assume that they are entitled to use it in business in a manner that would unfairly take advantage of the reputation that has been built up by the efforts of the brand owner.
18/08/2005, R 1062/2000-4, GRAMMY / GRAMMY	The applicant argued that GRAMMY is an internationally easy and nice-sounding abbreviation of the applicant's family name (Grammatikopoulos). The Board rejected this argument as insufficient to establish the due cause.

<p>15/06/2009, R 1142/2005-2, MARIE CLAIRE (fig.) / MARIE CLAIRE et al.</p>	<p>Due cause under Article 8(5) TMR means that, notwithstanding the detriment caused to, or unfair advantage taken of, the distinctive character or reputation of the earlier trade mark, registration and use by the applicant of the mark for the goods applied for may be justified if the applicant cannot be reasonably required to abstain from using the contested mark, or if the applicant has a specific right to use the mark for such goods that takes precedence over the earlier trade mark invoked in the opposition proceedings. In particular, the condition of due cause is not fulfilled merely by the fact that (a) the sign is particularly suitable for identifying the products for which it is used, (b) the applicant has already used the sign for these products or similar products within and/or outside the relevant territory of the EU, or (c) the applicant invokes a trade mark with a filing date that is earlier than the opponent's trade mark (decision of 25/04/2001, R 283/1999-3, HOLLYWOOD).</p> <p>As regards the tolerance of the proprietor of the earlier mark, the Board held that such tolerance was merely for magazines and not for goods closer to its market sector (i.e. textiles). It noted that national case-law showed that while protection exists for each party within its own field of business, extension should be refused when they come closer to the other party's field of activities and could infringe upon their rights.</p>
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Part C Appeal/Opposition

Sub-Section 1 Introduction

1 Overview of Opposition Proceedings — the Difference Between Absolute Grounds' and 'Relative Grounds' for Refusal of a Trademark Application

Chamber of Appeals of Sakpatenti is authorised to consider appeals of the applicant and oppositions of third parties concerning decision of the examination. Appeal/ Opposition shall be filed in Georgian language.

Refusal of Sakpatenti's substantive examination may be appealed before the Chamber of Appeals within three months after the date of receipt of the refusal by the applicant or his representative. In case of international registration, refusal may be appealed within three months from its publication in Official Gazette of WIPO.

Favourable decision of Sakpatenti's substantive examination may be appealed before the Chamber of Appeals within three months of its publication date in Official Bulletin of Industrial Property.

The Chamber of Appeals shall consider appeal/opposition and issue the decision within three months of its filing date.

The decisions of the Chamber of Appeals must state the reasons on which they are based. The reasoning must be logical, and it must not disclose internal inconsistencies.

If an appeal/opposition is based on the grounds that are examined during substantive examination (Articles 4 and 5 of the **Law**), such grounds are subject to revision by the Chamber of Appeals according to the principles and practice set out in present Guidelines, Part B, Examination.

The decision of the Chamber of Appeals will be based only on reasons or evidence(s) on which the parties concerned have had an opportunity to present their comments.

Opposition is a procedure that takes place before Sakpatenti when a third party requests the Chamber of Appeals to reject a national trademark application (trademark application) or an international registration designating Georgia on the basis of absolute grounds or relative grounds for refusal. Relevant provisions are found in Articles 4 and 5 of the **Law**, which bear those titles.

When an opposition is filed against an international registration designating Georgia, any reference in these Guidelines to national applications must be read to cover international registrations designating Georgia.

When an appeal/opposition is filed within a prescribed time limit and the relevant fee has been paid, the proceedings are managed by the Chamber of Appeals of Sakpatenti. The Chamber of Appeals will first examine the admissibility of the appeal/opposition. If the opposition is found admissible, the copy of the opposition is sent to applicant / representative of the applicant, who should respond within 10 calendar days from receipt of the opposition. After considering observations of the parties, and conducting oral hearings, the Chamber of Appeals of Sakpatenti will decide (in an appealable 'decision') either to reject the contested application totally or in part or to reject the opposition. If the trademark application is not totally rejected and provided there are no other oppositions pending and decision of the Chamber of Appeals was not appealed at court, it will proceed to registration for the goods and/or services for which it is not rejected. If the Chamber of Appeals of Sakpatenti reverses the refusal of Sakpatenti's substantive examination, trademark application will be published in Official Bulletin of

Industrial Property and trademark will proceed to registration if no opposition is filed within 3 month opposition period.

2 The Grounds for Opposition

According to Article 16(1) of the **Law**, applicant may file an appeal at the **Chamber of Appeals** against a decision of Sakpatenti on formal requirements concerning termination of the application proceedings, as well as a decision of the substantive examination on refusal or partial refusal of the trademark registration (Article 16(2) of the **Law**).

Any interested person may file opposition against published trademark application on the ground that requirements of Article 4 (absolute grounds for refusal) and article 5 (relative grounds for refusal) are not met.

3 The 'Earlier Rights' upon which an Opposition must be Based

The meaning of 'earlier' priority for Articles 5(a), 5(b), 5(c), (d) and 5(g) of the **Law** is defined in **Article 11** of the **Law**, meaning such rights having an earlier date of application for registration than the trademark application, including applicable claimed priority dates, or have become well known in Georgia before the trademark application or, if appropriate, its claimed priority date.

In essence, these rights consist of registered trademarks and 'well-known' marks in the sense of Article 6bis of the Paris Convention (which need not be registered). For a detailed explanation of these 'well-known' marks under Article 5(d) of the **Law**, and how they differ from Article 5(g) of the **Law** marks with reputation, see the Guidelines, Part B, Examination, Section 5: Trademarks with Reputation (Article 5(g) of the **Law**), paragraph 2.1.2.

Article 5(e) of the **Law** is the ground for opposition based on designations of origin or geographical indications protected under Georgian legislation that confer on the person authorised under such laws the right to prohibit the unauthorised use of a subsequent trademark. The opponent must prove that the designation of origin or geographical indication invoked is earlier than the date of application or, as the case may be, the priority date of the contested mark.

Article 5(f) of the **Law** is the ground for opposition based on earlier design registration that confer the owner of the design to prohibit use of the sign identical to the registered design in a subsequent trademark.

Various legal grounds, based on different grounds for refusal may be alleged in either the same or multiple oppositions against the same trademark application.

4 The Purpose of Opposition Proceedings and the Most Expedient Way to Treat Them

The sole purpose of opposition proceedings is to decide whether the application may proceed to registration and not to pre-emptively settle potential conflicts.

4.1 Restricting the examination to part of the relevant public

When an opposition is filed pursuant to Articles 5(b) or 5(c) of the **Law** and a likelihood of confusion can be found for a (substantial) part of the public, the reasoning of the decision should concentrate on that part of the public that **is most prone to confusion** and the analysis should not extend to all parts. This would apply in particular in the following situation:

- Where the relevant public consists of both general and professional consumers, the finding of a likelihood of confusion in relation to just one part of the public is sufficient to uphold an opposition. Usually, it is the general public that is more prone to confusion. Consequently, if the likelihood of confusion is to be confirmed on the part of the general public, there is no need to examine it based on the perception of professionals.

In such circumstances, it should be explained from the beginning of the decision why such a focus has been chosen.

4.2 Examining the likelihood of confusion without undertaking a comparison of goods and services

When the opposition is based on Article 5(b) or 5(c) of the **Law** and the likelihood of confusion cannot be ruled out on the basis of a 'dissimilarity of the goods and services' or 'dissimilarity of the signs', the Chamber of Appeals could decide, for reasons of procedural economy, to proceed on the basis of the **assumption that all the goods and services at issue are identical**. The comparison of the goods and services may be dispensed with, even in the absence of any identical pair of goods and services, if upon examining all the other relevant factors (such as the degree of similarity of the signs, distinctiveness of the earlier mark, degree of attention of the relevant public and the principle of interdependence) **any likelihood of confusion can be ruled out**.

4.3 No need to examine evidence of enhanced distinctiveness

The Chamber of Appeals may decide not to examine the opponent's claim and evidence of enhanced distinctiveness of the earlier marks, if based on the other relevant factors a **likelihood of confusion can be established** on the basis of the inherent distinctiveness of the marks.

Where appropriate, the **Chamber of Appeals** may decide to proceed on the basis of the **assumption that the earlier marks enjoy enhanced distinctiveness**. The examination of the claim and evidence of enhanced distinctiveness of the earlier marks may be dispensed with if upon examining all the other relevant factors **any likelihood of confusion can be ruled out**.

4.4 Likelihood of confusion: questions of fact and questions of law

The concept of likelihood of confusion is a legal concept rather than a mere factual evaluation of the rational judgments and emotional preferences that inform the consumer's cognitive behaviour and purchasing habits. Therefore, assessment of the likelihood of confusion depends on both legal questions **and** facts.

4.4.1 Fact and law — similarity of goods/services and of signs

Determining the relevant factors for establishing a likelihood of confusion and whether they exist is a question of law, that is to say, these factors are established by the relevant legislation, namely, the **Law**.

For instance, Articles 5(b) and 5(c) of the **Law** establish that the identity/similarity of goods/services is a condition for a likelihood of confusion. The identification of the relevant factors for evaluating whether this condition is met is also a question of law.

The following factors are identified to determine whether goods/services are similar:

- their nature;
- their intended purpose;
- their method of use;
- whether they are complementary or not;
- whether they are in competition or interchangeable;
- their distribution channels/points of sale;
- their relevant public;
- their usual origin.

All these factors are legal concepts and determining the criteria to evaluate them is also a **question of law**. However, it is a **question of fact** whether, and to what degree, the legal criteria for determining, for instance, 'nature', are fulfilled in a particular case.

By way of example, *cooking fat* does not have the same nature as *petroleum lubricating oils and greases* even though both contain a fat base. *Cooking fat* is used in preparing food for human consumption, whereas *oils and greases* are used for lubricating machines. Considering 'nature' to be a relevant factor in the analysis of similarity of goods/services is a matter of **law**. However, it is a matter of **fact** to state that cooking fat is used in preparing food for human consumption and that oils and greases are used for machines.

Similarly, when it comes to the comparison of signs, Articles 5(b) and 5(c) of the **Law** establishes that the identity/similarity of signs is a condition for a likelihood of confusion. It is a question of **law** that a conceptual coincidence between signs may render them similar for the purposes of the **Law**, but it is a question of **fact**, for instance, that the word 'fghryz' does not have any meaning for the Georgian public.

4.4.2 Fact and law — evidence

In appeal/opposition proceedings, the parties must allege and, where necessary, prove the facts in support of their arguments.

Therefore, in some cases it is up to the appellant to state the facts on which the claim of similarity is based and to submit supporting evidence. For instance, where *wear-resistant cast iron* is to be compared with *medical implants*, it is not up to the Chamber of Appeals to answer the question of whether *wear-resistant cast iron* is actually used for *medical implants*. This must be demonstrated by the appellant as it seems improbable.

An admission by the applicant of legal concepts is irrelevant. It does not discharge the Chamber of Appeals from analysing and deciding on these concepts. Therefore, the parties may agree as to which facts have been proven or not, but they may not determine whether or not these facts are sufficient to establish the respective legal concepts, such as similarity of goods/services, similarity of the signs, and likelihood of confusion.

Chamber of Appeals on its own initiative take into consideration facts that are already notorious or well known or that may be learnt from generally accessible sources, for example, that PICASSO will be recognised by Georgian consumers as a famous Spanish painter. However, The Chamber of Appeals or Examiner cannot quote *ex officio* new facts or arguments (e.g. reputation or degree of knowledge of the earlier mark).

Moreover, even though certain trademarks are sometimes used in daily life as generic terms for the goods and services that they cover, this should never be taken as a fact by the Chamber of Appeals. In other words, trademarks should never be referred to (or interpreted) as if they were a generic term or a category of goods or services. For instance, the fact that in daily life part of the public refers to 'X' when talking about *yoghurts* ('X' being a trademark for *yoghurts*) should not lead to using 'X' as a generic term for *yoghurts*.

4.5 Relevant point in time

The relevant point in time for assessing the likelihood of confusion is the date the opposition decision is taken.

Where the opponent relies on enhanced distinctiveness of an earlier trademark, the conditions for this must have been met on or before the filing date of the trademark application (or any priority date) and must still be fulfilled at the point in time the decision is taken.

Consequently, the inherent distinctiveness of the earlier mark(s) should be assessed at the time of the decision. The enhanced distinctiveness of the earlier trademark(s) (if claimed) should exist (i) at the time of filing of the contested trademark application (or any priority date), and (ii) at the time of the decision.

Where the trademark applicant relies on a reduced scope of protection (weakness) of the earlier trademark, only the date of the decision is relevant.

Earlier registered trademarks are presumed to have at least a minimum degree of inherent distinctiveness, even where persuasive evidence is submitted to challenge this presumption. If the trademark applicant proves that it has started a cancellation action against the earlier registered mark, then it might be necessary to suspend the opposition proceedings pending the outcome of the said action.

Annex

General principles coming from case-law of the EU Court of Justice (these are not direct citations) related to principles of comparison of signs.

11/11/1997, C-251/95, Sabèl, EU:C:1997:528

- The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case (para. 22).
- The appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trademark on the market, on the association that the public might make between the two marks and on the degree of similarity between the signs and the goods (para. 22).
- The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components (para. 23).
- The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (para. 23).
- The more distinctive the earlier mark, the greater will be the likelihood of confusion (para. 24).
- It is not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character (para. 24).
- However, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion (para. 25).
- The concept of likelihood of association is not an alternative to likelihood of confusion but serves to define its scope (para. 18).
- The mere association that the public might make between two marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion (para. 26).

29/09/1998, C-39/97, Canon, EU:C:1998:44

- The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion (para. 29).
- By contrast, there can be no such likelihood where the public does not think that the goods come from the same undertaking (or from economically linked undertakings) (para. 30).

- In assessing the similarity of the goods and services, all the relevant factors relating to those goods or services themselves should be taken into account (para. 23).
- Those factors include, inter alia, their nature, the purpose for which they are used and their method of use, and whether they are in competition with each other or are complementary (para. 23).
- A global assessment of the likelihood of confusion implies some interdependence between the relevant factors and in particular a similarity between the marks and between these goods or services. A lesser degree of similarity between the goods may be offset by a greater degree of similarities between the marks and vice versa (para. 17).
- Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (para. 18).
- Registration of a trademark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive (para. 19).
- The distinctive character of the earlier mark and in particular its reputation must be taken into account when determining whether the similarity between the goods and services is enough to give rise to the likelihood of confusion (para. 24).
- There may be a likelihood of confusion, even if the public thinks that these goods have different places of production (para. 30).

Sub-Section 2 Appeal/Opposition proceedings

1 Introduction — General Outline of Opposition Proceedings

Opposition proceedings start upon receipt of the notice of opposition.

Opposition may be submitted to the Chamber of Appeals in material form or through the electronic system, which can be accessed in the electronic file accessible on the Sakpatenti's website in e-filing system, if trademark application was filed via this system. An appeal shall be submitted with the use of the appeal form approved by the Chairman of the Chamber of Appeals.

Opposition can be filed through electronic system. In this case an appeal shall be submitted through the electronic system of Sakpatenti using the following website - www.online.sakpatenti.gov.ge

The Chamber of Appeals verifies the admissibility of the opposition.

After the examination of admissibility of the opposition, the notice of opposition and other documents received are sent together with the notification to the applicant, who should submit the response within 10 calendar days from receipt of the opposition.

When an opposition is filed against the decision on granting protection to an international trademark in Georgia, the notification of provisional refusal based on an opposition is sent to the International Bureau of the World Intellectual Property Organization (WIPO). A response to this opposition can be filed at the Chamber of Appeals no later than 2 months from the date of publication of the notification.

The parties are allowed to submit additional documents not later than 5 working days before the hearings.

If after completing of oral hearings and before the Board issues the decision, newly-discovered circumstances essential for the proceedings are revealed, interested party should be informed concerning the same and given opportunity to submit his/her observations. The Board is entitled to reconsider newly-discovered circumstances on additional oral hearings.

2 Notice of Opposition

2.1 Notice of opposition in writing

The notice of opposition has to be received by the Chamber of Appeals in written form or via e-filing system accessible through Sakpatenti's website, within the opposition period, namely within 3 months from the publication of the contested trademark application in official bulletin.

Once submitted electronically, the electronic form will be processed automatically and a receipt will be issued for the opponent. If filed on paper the receipt is not issued.

2.2 Payment

For general rules on payments, refer to the Guidelines, Part A, General Rules, Section 1, Payment of Fees, Costs and Charges.

2.2.1 Notice of opposition late, payment within the opposition period

If the payment was received by the Chamber of Appeals within the opposition period but the notice of opposition was received late, the opposition is inadmissible. In this case the Chamber of Appeals will return the opposition fee.

2.2.2 Time of payment

Opposition/Appeal should be submitted together with document confirming the payment of official fee for consideration of opposition / appeal. Otherwise, the Chamber of Appeals will invite the opponent/appellant to remedy the deficiency and if the opponent/appellant does not remedy the deficiency within timeframe estimated by the Chamber of Appeals, the opposition/appeal is inadmissible.

2.3 Languages and translation of the notice of opposition

Appeal/opposition shall be filed in Georgian language. Annexes and evidence may be filed in any other language. However, Chamber of Appeals will consider only evidence and documents which are accompanied by certified Georgian translation (at least relevant parts).

Part D Cancellation

1 General Remarks

1.1 The grounds for cancellation

The purpose of this section is to explain how, in practice, the provisions of Articles 27 and 28 of the **Law** are applied. Present section covers the grounds which are not examined neither during examination nor before the Chamber of Appeals of Sakpatenti.

The grounds for revocation are established in Article 27 of the **Law**.

The grounds for invalidity are established in Article 28 of the **Law**.

In addition to those general grounds, specific grounds can be invoked to cancel a collective mark as per Article 37 of the **Law** (grounds for revocation) and Article 38 of the **Law** (grounds for invalidity).

1.2 Inter partes proceedings

Cancellation proceedings are never initiated by the Office itself. The initiative lies with the claimant requesting either revocation or invalidation of the registered trademarks. Both cases are dealt solely by the civil courts of Georgia.

Respondent in cancellation proceedings is the holder of the contested mark. Sakpatenti is not involved in the proceedings.

1.3 The consequences of revocation and invalidity

1.3.1 The legal effect of revocation

According to Article 29(1) of the **Law**, in the event of revocation, and to the extent that the rights of the proprietor have been revoked, the trademark will be deemed not to have the effects from the date of the recording of the registration in the Registry, unless any other date is specified in a court decision.

An earlier date on which one of the grounds for revocation occurred may be fixed by the Court if this is requested by one of the parties, provided that the requesting party shows a legitimate legal interest in this respect.

1.3.2 The legal effect of invalidity

According to Article 29(2) of the **Law**, in the event of a **declaration of invalidity**, the trademark will be deemed not to have had, as from the outset, unless any other date is specified in a court decision.

2 Revocation

2.1 Introduction

According to Article 27(2) of the **Law**, there are three grounds for revocation:

- The trademark has not been put to ~~genuine~~ use during a continuous period of 5 years.
- The trademark has become generic ~~due to acts/inactivity of its proprietor.~~
- The trademark has become misleading due to the use made by its proprietor or with its consent.

These grounds are examined in further detail in the paragraphs below. According to Article 27(4) of the **Law**, where the grounds for revocation exist for only some of the registered goods and services, the trademark proprietor's rights will be revoked only for those goods and services.

In addition to these grounds, Article 37 of the **Law** lists further specific ground on which the rights of the proprietor of a **collective mark** may be revoked.

2.2 Non-use of the trademark article 27(2)(a) of the Law

According to Article 27(2)(a) of the **Law**, if within a continuous period of 5 years after the trademark has been registered and before the filing of the action for revocation the trademark has not been put to ~~genuine~~ use, then the trademark must be revoked unless there are proper reasons for non-use.

Pursuant to Article 27(4) of the **Law**, if the trademark has been used for only some of the goods and services for which it is registered, the revocation will be limited to the goods and services not used.

2.2.1 Burden of proof

The burden of proof lies with the trademark proprietor. However, in order to ensure admissibility of the claim, the claimant should provide reasonable evidence at the initial stage (e.g letters from pharmacies or supermarket chains stating that goods with contested

trademark have not been sold for last five years) justifying assumption that trademark has not been used. The role of the Court is to assess the evidence put before it in the light of the parties' submissions. The Court cannot determine *ex officio* genuine use of trademarks. It has no role in collecting evidence itself.

2.2.2 Genuine use

2.2.2.1 General principles

The **Law** does not define what is to be regarded as 'genuine use' in order to establish non-use of the trademark. However, the European Court of Justice (the 'Court') has laid down several important principles as regards the interpretation of this term.

In *Minimax* (11/03/2003, C-40/01, EU:C:2003:145), the Court established the following principles:

- genuine use means actual use of the mark (paragraph 35);
- genuine use must, therefore, be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark (paragraph 36);
- genuine use must be consistent with the essential function of a trademark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling the latter, without any possibility of confusion, to distinguish the product or service from others that have another origin (paragraph 36);
- genuine use entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned (paragraph 37);
- genuine use must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns (paragraph 37);
- when assessing whether there has been genuine use, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark (paragraph 38);
- the circumstances of the case may, therefore, include giving consideration, inter alia, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark (paragraph 39);
- use need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market (paragraph 39).

In its order of 27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, the Court further elaborated the *Minimax* criteria as follows:

- the question whether use is sufficient to preserve or create market share for the goods or services concerned depends on several factors and on a case-by-case assessment. The characteristics of the goods and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence that the proprietor is able to provide, are among the factors that may be taken into account (paragraph 22);
- use of the mark by a single client that imports the goods for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (paragraph 24);
- a *de minimis* rule cannot be laid down (paragraph 25).

Genuine use: standard of proof

Genuine use of a trademark cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.

The Court does not necessarily require a high threshold of proof of genuine use. It is not possible to prescribe, in the abstract, **what quantitative threshold should be chosen** in order to determine whether use was genuine or not, and accordingly there can be no objective *de minimis* rule to establish a priori the level of use needed in order for it to be 'genuine'. So, whilst a minimum extent of use must be shown, what exactly constitutes this minimum extent depends on the circumstances of each case. The general rule is that, when it serves a real commercial purpose, **even minimal use of the trademark could be sufficient to establish genuine use**, depending on the goods and services, and the **relevant market**.

In other words, it is sufficient if the evidence of use proves that the trademark owner has seriously tried to acquire or maintain a commercial position in the relevant market. However, not just any proven commercial exploitation can automatically be qualified as genuine use of the mark in question.

The indications and evidence required in order to provide proof of use must concern the **place, time, extent and nature of use** of the respondent's trademark for the relevant goods and services.

These requirements for proof of use are **cumulative**.¹³⁴ This means that the respondent is obliged not only to indicate but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the **entirety** of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable.¹³⁵

Thus, the Court evaluates the evidence submitted in **an overall assessment**. All the circumstances of the specific case have to be taken into account and all the materials submitted must be assessed **in conjunction with each other**. Therefore, although pieces of evidence may be insufficient by themselves to prove the use of an earlier trademark, they may contribute to proving use in combination with other documentation and information.

Evidence of use may be **of an indirect/circumstantial nature**, such as evidence about the share in the relevant market, the importing of the relevant goods, the supply of the necessary raw materials or packaging to the owner of the mark, or the expiry date of the relevant goods. Such indirect evidence can play a decisive role in the overall assessment of the evidence submitted. Its probative value has to be carefully assessed. For instance, the judgment of 08/07/2010, T-30/09, Peerstorm, EU:T:2010:298, § 42 et seq. found that catalogues in themselves could — under certain circumstances — be conclusive evidence of sufficient extent of use.

It is necessary to take into account **the specific kind of the goods and services involved** when assessing the probative value of the evidence submitted. For example, it may be common in a particular market sector for the samples of the goods and services themselves not to bear indications of the place, time, extent and nature of use. In these cases it is obviously inappropriate to disregard such evidence of use if indications in this respect can be found in the other evidence submitted.

Each of the documents submitted has to be carefully evaluated as to whether in their entirety they really reflect genuine use within the 5 years period preceding the date of application for

¹³⁴ 05/10/2010, T-92/09, STRATEGI / Stratégies, EU:T:2010:424, § 43

¹³⁵ 17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 31

revocation. In particular, the dates and place of use shown on orders, invoices and catalogues are carefully examined.

Material submitted **without any indication of date of use** may, in the context of an overall assessment, still be relevant and taken into consideration **in conjunction with other pieces** of evidence that are dated. This is the case in particular if it is common in a particular market sector for the samples of the goods and services themselves not to bear indications of time.¹³⁶

2.2.2.2 Nature of use

The term 'nature of use' refers to:

- use of a mark in accordance with its essential function;
- use in the course of trade;
- use of the mark as registered or of a variation thereof; and
- use in connection with the goods and services for which it is registered.

(a) Use of the mark in accordance with its essential function

(i) Use of individual marks

The Law requires proof of genuine use in connection with the goods or services for which the trademark is registered and which the respondent cites as reasoning. Hence, the respondent has to show that the mark has been genuinely used as a trademark on the market.

As a trademark has, inter alia, the function of operating as a link between the goods and services and the person responsible for their marketing, the proof of use must establish a **clear link between the use of the mark and the relevant goods and services**. It is not necessary for the mark to be affixed to the goods themselves¹³⁷. A representation of the mark on packaging, catalogues, advertising material or invoices relating to the goods and services in question constitutes direct evidence that the mark has been put to genuine use (see also paragraph 2.3.3.2 below).

Genuine use requires that use is made as a **trademark**:

- not for purely illustrative purposes or on purely promotional goods or services;
- in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered.

Therefore, by way of example, the use as a **Geographical Indication (GI)** is **not suitable** for supporting genuine use of a **trademark**.

The essential function of GIs is to designate the origin of goods as being from a particular region or locality. This is in contrast with the main function of an individual trademark, namely to serve as an indicator of commercial origin. When a GI is contained within an individual mark that guarantees to consumers that the goods which it designates come from a single undertaking under the control of which those goods are manufactured and which is responsible for the quality of those goods, the respondent must submit proof of use as an individual mark. Evidence of use as a GI (e.g. general statements of Regulatory Councils) cannot serve for proving use as an individual mark.

Depending on the circumstances, the following situations may be suitable for supporting genuine use of the registered trademark. That is because use of the sign can serve more than one purpose at the same time. Consequently, the following uses can also be use of the sign

¹³⁶ 05/09/2001, R 608/2000-4, PALAZZO / HELADERIA PALAZZO, § 16, noting that ice-cream menus are rarely dated

¹³⁷ 12/12/2014, T-105/13 TrinkFix, EU:T:2014:1070, § 28-38

as a trademark. However, the purpose for which a sign is used needs to be assessed individually.

1. **Use of a sign as a business, company or trade name** can be regarded as trademark use provided that the relevant goods or services themselves are identified and offered on the market under this sign. In general, this is not the case when the business name is merely used as a shop sign (except when proving use for retail services) or appears on the back of a catalogue or as an incidental indication on a label.

In principle, use of the sign as a **company name or trade name**, is not, of itself, intended to distinguish goods or services. The purpose of a **company name** is to identify a company, whereas the purpose of a **trade name or a shop name** is to designate a business that is being run. Accordingly, where use of a company name, trade name or shop name is limited to identifying a company or designating a business that is being run, such use cannot be considered as being 'in relation to goods or services'.

Use of a business, company or trade name can be regarded as **use 'in relation to goods'** where:

- a party affixes the sign constituting its company name, trade name or shop name to the goods or
- even though the sign is not affixed, the party uses the sign in such a way that a link is established between the company, trade or shop name and the goods or services.

Provided that either of these two conditions is met, the fact that a word element is used as the company's trade name does not preclude its use as a mark to designate goods or services.

For example, the presentation of the business name at the top of **order forms or invoices** may, depending on how the sign appears on them, be suitable to support genuine use of the registered trademark. Simultaneous use of the company name and the trademark on invoices may, when the two indications can be clearly distinguished, prove use of the sign as an indicator of the commercial origin of the services provided, irrespective of the fact that the invoices may also show other sub-brands.¹³⁸

However, mere use of a business name at the top of invoices without a clear reference to specific products/services is not sufficient.

2. Use of a **sign as a domain name or as part of a domain name** primarily identifies the website as such. However, depending on the circumstances, such use may also be use of a registered mark (this presupposes that it connects to a site on which the goods and services appear).

The mere fact that the respondent has registered a domain name containing the earlier trademark is not sufficient in itself to prove genuine use of the trademark. It is necessary for the party to prove that the relevant goods or services are offered under the trademark contained in the domain name.

(ii) Use of collective marks

The requirements of the Law relating to the conditions of use apply. However, the different function of these marks must be taken into account. The respondent must demonstrate that the authorised persons used the collective mark in accordance with its essential function.

¹³⁸ 03/10/2019, T-666/18, ad pepper (fig.), EU:T:2019:720, § 82-84

The essential function of a **collective mark** is to distinguish the goods or services of the members of the **association** that is the proprietor of the mark from those of other undertakings. The specific characteristic of collective marks is to indicate the **collective** commercial origin of the goods or services, that is to say to indicate that certain products or services come from a member of a certain 'collective', which is the proprietor of the collective mark, and not an **individual** commercial origin as is the case with individual marks. Therefore, unlike an individual mark, a collective mark does not have the function of indicating to consumers 'the identity of origin' of the goods or services in respect of which it is registered. Manufacturers, producers, suppliers or traders who are affiliated with the association that is the proprietor of a collective mark do not have to form part of the same group of companies that manufacture or supply the goods or services under unitary control. In fact, they can be competitors, each of which uses, on the one hand, the collective mark indicating their affiliation with that association and, on the other, an individual mark indicating the identity of origin of their goods or services. However, like an individual mark, a collective mark must be used by the members of the association to create or preserve an outlet for the registered goods or services.

(b) Public use versus internal use

The use must be public, that is to say it must be external and apparent to actual or potential customers of the goods or services. Use in the private sphere or purely internal use within a company or a group of companies does not amount to genuine use.¹³⁹

The mark must be used **publicly and outwardly** in the context of commercial activity with a view to economic advantage for the purpose of ensuring an outlet for the goods and services that it represents.¹⁴⁰ Outward use does not necessarily imply use aimed at end consumers. For instance, the relevant evidence can validly stem from an **intermediary**, whose activity consists of identifying professional purchasers, such as distribution companies, to which the intermediary sells products it has had manufactured by original producers.¹⁴¹

Relevant evidence can also validly come from a **distribution company** that forms part of a group. Distribution is a method of business organisation that is common in the course of trade and implies use of the mark that cannot be regarded as purely internal use by a group of companies, since the mark is also used outwardly and publicly.¹⁴²

Use of the mark must **relate to goods or services** already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way. Mere preparation to use the mark — such as the printing of labels, producing of containers, etc. — is internal use and, therefore, not use in the course of trade for the present purposes.¹⁴³

(c) Commercial activity versus promotional activity

Where the mark is protected for goods or services of **not-for-profit enterprises**, and the mark has been used, the fact that there is no profit motive behind the use is irrelevant: 'The fact that

¹³⁹ 09/12/2008, C-442/07, Radetzky, EU:C:2008:696, § 22; 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37; 09/09/2015, T-584/14, ZARA, EU:T:2015:604, § 33

¹⁴⁰ 12/03/2003, T-174/01, Silk Cocoon, EU:T:2003:68, § 39; 30/04/2008, T-131/06, Sonia Sonia Rykiel, EU:T:2008:135, § 38

¹⁴¹ 21/11/2013, T-524/12, RECARO, EU:T:2013:604, § 25-26

¹⁴² 17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 32

¹⁴³ 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37

a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services’.

Goods and services offered **free of charge** may constitute genuine use when they are offered commercially, that is to say with the intention of creating or maintaining an outlet for those goods or services, as opposed to the goods or services of other undertakings, and therefore of competing with them.¹⁴⁴

Mere use of the mark on **promotional material for other goods** cannot normally be considered as sufficient (indirect) evidence of use within the meaning of trademark law for the type of promotional items on which the mark is or has been used. For example, giving away articles of clothing such as T-shirts and baseball caps at promotional events with the purpose of marketing a certain other product, such as a drink, cannot be considered as genuine use of the mark at issue for clothing.

(d) Use in relation to goods

Trademarks have traditionally been used on goods (printed on the goods, on labels, etc.) or their packaging. However, showing use on goods or their packaging is not the only way of proving use in relation to goods. It is sufficient, if there is a proper connection between the mark and the goods, for the mark to be used ‘in relation to’ the goods or services, such as on brochures, flyers, stickers, signs inside places of sale, etc.

For example, when the respondent sells its goods only through catalogues (mail-order sales) or the internet, the mark may not always appear on the packaging or even on the goods themselves. In such cases, use on the (internet) pages where the goods are presented — provided it is otherwise genuine in terms of time, place, extent and nature (see paragraph 2.2.2.4 below) — will generally be considered sufficient. The owner of the mark will not have to provide proof that the mark actually appeared on the goods themselves.

Earlier sign	Case No
PETER STORM	08/07/2010, T-30/09, Peerstorm, EU:T:2010:298
The evidence produced to show genuine use of the mark at issue may include catalogues. ‘It must be pointed out that, in addition to items of clothing designated by different marks, more than 80 different items are offered for sale in that catalogue under the mark PETER STORM. They comprise men’s and women’s jackets, jumpers, trousers, tee-shirts, footwear, socks, hats and gloves, the respective characteristics of which are briefly described. The earlier mark appears, in stylised characters, next to each item. In that catalogue, the prices of the items in GBP and the reference number for each item are stated’ (paras 38-39).	

However, the situation is different when a trademark is used, for example, in a catalogue or advertisements, or on bags or invoices, to designate the retailer of the goods and not the goods themselves.

Earlier sign	Case No
Schuhpark	13/05/2009, T-183/08, Jello Schuhpark II, EU:T:2009:156

¹⁴⁴ 09/09/2011, T-289/09, Omnicare Clinical Research, EU:T:2011:452, § 67-68

The General Court found that the use of the sign *Schuhpark* for footwear on advertisements, bags and invoices was not meant to identify the origin of the shoes (which bore their own mark or no mark at all) but rather the **company name or trade name** of the shoe retailer. This was considered insufficient to establish a link between the sign *Schuhpark* and the shoes. In other words, *Schuhpark* may well be a mark for the retail of shoes, but it was not used as a trademark for goods (paras 31-32).

(e) Use in relation to services

Marks cannot be directly used 'on' services. Therefore, use of marks registered for services will generally be on business paper, in advertising, or in some other way directly or indirectly related to the services. Where the use on such items demonstrates genuine use, such use will be sufficient.

Earlier sign	Case No
M&P	06/11/2014, T-463/12, MB, EU:T:2014:935
The earlier trademark was registered in Class 42 for, inter alia, the services of a patent attorney. Its use on invoices, business cards and business correspondence was considered sufficient to show genuine use in connection with the services of a patent attorney.	

(F) Use in advertising

Trademarks fulfil their function of indicating the commercial origin of goods or services and symbols of the goodwill of their owner not only when they are actually used on or for goods or services, but also when they are used in advertising. In fact, the advertising or market communication function of trademarks is one of their most important functions.

Therefore, use in advertising will generally be considered as amounting to genuine use:

- if the volume of advertising is sufficient to constitute genuine public use of the mark; and
- if a relation can be established between the mark and the goods or services for which the mark is registered.

The outcome in a particular case will depend very much on the individual circumstances, as demonstrated by the following examples.

Earlier Sign	Case No
BLUME	28/10/2002, R 681/2001-1, Blumen Worldwide (fig.) / BLUME, LEOPOLDO BLUME

Services: services of a publishing company in Class 41.

The Board confirmed that the evidence (consisting of catalogues, press notes and advertisements) read in conjunction was enough to prove genuine use of the trademark.

'Although the order record and the receipt of the bank account do not provide any information on how and to what extent the mark was used in Spain, the remaining documents, namely the catalogues, press notes and advertisements, when read in conjunction, demonstrate that during the relevant period, the opponent has published in Spain books and magazines under the trademark BLUME. Even if the opponent does not provide any invoices, orders or sales figures, there is some reason to assume that it advertised its books and magazines, promoted and sold them under the trademark BLUME. Although the advertising documents and the press notes were identified and dated by the opponent, the trademark BLUME is always mentioned in the press notes and on the cover page of the quoted books. In addition, the text is in the Spanish language and the price mentioned in pesetas. When read together with the catalogues, these press notes demonstrate that they refer to some of the books expressly quoted in the catalogues' (para. 23).

Earlier sign	Case No
BIODANZA	13/04/2010, R 1149/2009-2, BIODANZA (fig.) / BIODANZA; Confirmed 08/03/2012, T-298/10, Biodanza, EU:T:2012:113
<p>G&S: Classes 16 and 41.</p> <p>The Board rejected the Opposition Division's finding that the evidence (only advertisements) proved genuine use.</p> <p>It follows clearly from the finding of the contested decision that the evidence of use submitted by the opponent consists solely of advertisements that can prove only that the opponent advertised a yearly 'BIODANZA' festival during the whole of the relevant period and workshops on both a regular and irregular basis from 2002.</p> <p>However, contrary to the finding of the contested decision, such advertisements cannot provide proof of their distribution to a potential German clientele. Nor can they prove the extent of any distribution or the number of sales or contracts made for the services protected by the mark. The mere existence of advertisements could, at most, make it probable or credible that the services advertised under the earlier mark were sold or, at least, offered for sale within the relevant territory, but it cannot prove this, as was unduly supposed by the contested decision.</p>	

Where advertising is carried out in parallel with the marketing of goods and services and there is proof of both activities, advertising will support the genuineness of the use.

Advertising in advance of the actual marketing of goods and services — if it is with a view to establishing a market for the goods or services — will generally be considered to constitute genuine use.

Whether mere advertising, without any current or future plans to actually market goods or services, constitutes genuine use appears doubtful.

(g) Use on the internet

The standard applied when assessing evidence in the form of printouts from the internet is no stricter than when evaluating other forms of evidence. Consequently, the presence of the trademark on websites can show inter alia the nature of its use or the fact that products or services bearing the mark have been offered to the public. However, the mere presence of a trademark on a website is, of itself, not sufficient to prove genuine use unless the website also shows the place, time and extent of use or unless this information is otherwise provided.

Earlier sign	Case No.
SHARP	20/12/2011, R 1809/2010-4, SHARPMASTER / SHARP (fig.)
The opponent submitted 'extracts from the opponent's websites for different countries'. The Board considered that 'simple print-outs from a company's own Internet page is not able to prove use of a mark for certain goods without complementary information as to the actual use of the Internet site by potential and relevant consumers or complementary advertising and sales figures regarding the different goods, photos of the goods with the corresponding mark etc.' (para. 33).	
WALZERTRAUM	17/01/2013, T-355/09, Walzer Traum, EU:T:2013:22; confirmed 17/07/2014, C-141/13 P, Walzer Traum, EU:C:2014:2089
The opponent, a confectioner, which owns the German trademark 'WALZERTRAUM' for goods in Class 30, sought to prove the extent of use of its mark by submitting evidence relating to an advertising brochure published on the internet, which gives general information about its working methods, the ingredients used for its products and the product range, including its 'WALZERTRAUM' chocolate. However, the goods could not be ordered online via the web page. For this reason, the General Court held that a connection between the website and the number of items sold could not be established (para. 47).	

In particular, the value in terms of evidence of internet extracts can be strengthened by submitting evidence that the specific website has been visited and, in particular, that orders for the relevant goods and services have been made through the website by a certain number of customers in the relevant period. For instance, useful evidence in this regard could be records that are generally kept when operating a business web page, for example records relating to the number of hits attained at various points in time.

As to the **relevant period**, information on the internet or in online databases is considered to be of the date on which the information was posted. Internet websites often contain highly relevant information. Certain information may even be available only from such websites. This includes, for example, online catalogues that are not available in printed format.

The nature of the internet can make it difficult to establish the actual date on which information was in fact made available to the public. For instance, not all web pages mention when they were published. In addition, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records that enable members of the public to establish precisely what was published when.

In this context, the date of use on the internet will be considered reliable in particular where:

- the website time-stamps each entry and thus provides information relating to the history of modifications applied to a file or web page (for example, as available for Wikipedia or as automatically appended to content, e.g. forum messages and blogs); or
- indexing dates are given to the web page by search engines (e.g. from the Google™ cache); or
- a screenshot of a web page bears a given date.

The evidence submitted must show that the online transactions were **connected with the goods or services** designated by the mark.

Earlier sign	Case No
ANTAX	02/02/2012, T-387/10, Arantax, EU:T:2012:51
The respondent has submitted, inter alia, internet extracts from the home pages of several tax consultancies using the opposing mark. The General Court considered that the indications on the internet pages allowed the reader to establish a link between the trademark and the services provided (paras 39-40).	

Whereas the nature of the mark and, to a certain extent, the time (as seen above) and place are less complex elements to prove, the extent of use presents more difficulties if only evidence of internet use is provided. It should be taken into account that transactions on the internet tend to eliminate most of the ‘traditional’ evidence of sales such as invoices, turnover, taxation documents, etc. New ‘electronic’ evidence tends to substitute them, or has already substituted them, as certified means of payment, orders and confirmations thereof, registrations of safe transactions, etc.

Earlier sign	Case No
Skunk funk (fig.)	31/03/2011, R 1464/2010-2, SKUNK FU! (fig.) / SKUNK FUNK (fig.)
<p>[E]xcerpts from third parties’ websites, despite having been printed out on 10 June 2008, contain consumers’ comments about ‘SKUNKFUNK’ clothes and shops dated within the relevant period. In particular, as regards the relevant territory, the documents show various comments made by consumers in Spain and dated December 2004 and February-March-April-May-July 2007. Moreover, as the Opposition Division pointed out, a blog comment (dated 4 March 2007) on the Internet page www.cybereuskadi.com mentions that the respondent (‘designer of Skunkfunk’) “exports surf clothes worldwide and has a turnover of nearly 7 million euros per year” (para. 21).</p>	

2.2.2.3 Place of use

Trademarks must be genuinely used in Georgia. The use of the mark in other countries cannot be taken into account.

A trademark needs not be used in an extensive geographic area for use to be deemed genuine, since this will depend on the characteristics of the goods or services concerned on the corresponding market and, more generally, on all the facts and circumstances relevant to establishing whether commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered.¹⁴⁵

All the relevant facts and circumstances must be taken into account, including the characteristics of the market concerned, the nature of the goods or services protected by the trademark and the territorial extent and scale of the use as well as its frequency and regularity.¹⁴⁶

What matters is the impact of use in the internal market and, more specifically, whether it is sufficient to maintain or create market share in that market for the goods and services covered by the mark and whether it contributes to a commercially relevant presence of the goods and services in that market. Whether that use results in actual commercial success is not relevant.¹⁴⁷

The Court must determine on a case-by-case basis whether the various indications and evidence can be combined for the purpose of assessing the genuine character of use, the geographical dimension of which is only one of the aspects to be considered.

Use in the import and export trade

¹⁴⁵ 19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 55; 07/11/2019, T-380/18, INTAS / INDAS (fig) et al., EU:T:2019:782 § 80

¹⁴⁶ 19/12/2012, C-149/11, Onel / Omel, EU:C:2012:816, § 58

¹⁴⁷ 07/11/2019, T-380/18, INTAS / INDAS (fig) et al., EU:T:2019:782, § 82

The affixing of the trademark to goods or to the packaging thereof in Georgia solely for **export** purposes also constitutes use within the meaning of Article 24 of the Law. The mark has to be used (i.e. affixed to goods or their packaging) in Georgia — that is, the geographical area where it is registered.

Case No	Earlier trademark	Comment
04/06/2015, T-254/13, EU:T:2015:156	STAYER	Genuine use may result from the export to a single operator located outside Europe, who can be an intermediary, for the purpose of selling to the end consumer in a non-EU country. Proof that the products have been put on the market in the non-EU importing country is not required (paras 57-61).

Evidence relating only to the **import** of the goods in the relevant area may, depending on the circumstances of the case, suffice as proof of use in this area.

The mere **transit** through Georgia cannot constitute genuine use of the mark in this territory.

2.2.2.4 Time of use

The trademark becomes susceptible to revocation if it has not been put to genuine use within a continuous period of 5 years. However, no person may claim that the proprietor's rights in a trademark should be revoked where, during the interval between expiry of the 5-year period and filing of the application for revocation, genuine use of the trademark has started or resumed. Further if the request for revocation is granted, the effective date of revocation is when a respective entry – revocation of a trademark registration - is recorded in the Registry of Sakpatenti, unless an earlier date is specified in a court decision'.

It follows from those provisions that the proprietor must prove genuine use of the contested trademark within the **5-year period preceding the date of the action for revocation**.

For example, if the trademark was registered on 01/01/2011, it became susceptible to revocation on 02/01/2016. If the action for revocation was filed on 15/09/2016, the trademark proprietor would have to prove genuine use of its mark within the period from 15/09/2011 to 14/09/2016.

Even in the case where a trademark has not been put to genuine use in any continuous 5-year period after its registration, it cannot be revoked if genuine use commenced or was resumed before the filing of the application for revocation.

In no case can evidence of genuine use **preceding** a continuous 5-year period of non- use be taken into account, regardless of how long-standing that use may have been.

If an **earlier effective date of revocation** is requested this can only be granted — subject to the claimant proving a legitimate interest — if no genuine use of the contested mark has been proved **both** within the 5-year period preceding the date of application for revocation **and** within the 5-year period preceding the earlier effective date requested. However, even if such an earlier effective date is requested, the trademark proprietor's prime interest is to prove genuine use of the contested mark within the 5-year period immediately preceding the date of action for revocation. If genuine use of the contested trademark within this period is proven, the contested mark cannot be revoked at all. Proof of genuine use of the contested mark within the 5-year period preceding the requested earlier effective date may become relevant only if there is no proof of genuine use of the contested mark within the 5-year period immediately preceding the date of application for revocation.

2.2.2.5 Extent of use

In this regard, it has to be evaluated whether, in view of the market situation in the particular industry or trade concerned, it can be deduced from the material submitted that **the owner has seriously tried to acquire a commercial position in the relevant market**. The trademark has to be used for goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns.¹⁴⁸ This does not mean that the respondent has to reveal the total volume of sales or turnover figures.

Concerning the extent of use made of the earlier mark, account must be taken, in particular, of the **commercial volume** of all the acts of use on the one hand and the **duration** of the period in which those acts of use occurred, as well as the **frequency** of those acts, on the other¹⁴⁹.

The assessment entails a **degree of interdependence between the factors** taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa.¹⁵⁰

Under certain circumstances, even **circumstantial evidence** such as catalogues featuring the trademark, despite not providing direct information on the quantity of goods actually sold, can be sufficient by themselves to prove the extent of use in an overall assessment.

Use does not have to be made during a minimum period of time to qualify as 'genuine'. In particular, **use does not have to be continuous** throughout the relevant period of 5 years. It is sufficient if use was made at the very beginning or end of the period, provided the use was genuine¹⁵¹.

The exact **decisive threshold** proving genuine use cannot be defined out of context. The turnover and volume of sales of the product must always be assessed in relation to all the other relevant factors, such as the volume of business, production or marketing capacity, or the degree of diversification of the undertaking using the trademark, and the characteristics of the products or services on the relevant market. Use need not always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.

Low turnover and sales, in absolute terms, of a medium- or low-priced product might support the conclusion that use of the trademark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient. It is, therefore, always necessary to take the characteristics of the market in question into account. A *de minimis* rule cannot be laid down. Use of the mark by a single client, which imports the products for which the mark is registered, can be sufficient to demonstrate that such use is genuine if it appears that the import operation has a genuine commercial justification for the proprietor of the mark.

Genuine use is not excluded only because all use involves the same customer, as long as the trademark is used publicly and outwardly and not solely within the undertaking that owns the earlier trademark or within a distribution network owned or controlled by that undertaking.¹⁵²

¹⁴⁸ 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37

¹⁴⁹ 08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 35

¹⁵⁰ 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 42

¹⁵¹ 16/12/2008, T-86/07, Deitech, EU:T:2008:577

¹⁵² 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 50; 08/10/2014, T-300/12, Fairglobe, EU:T:2014:864, § 36

The smaller the commercial volume of the exploitation of the mark, the more necessary it is for the opposing party to produce additional evidence to dispel any doubts as to its genuineness.¹⁵³

Concerning the ratio between the turnover generated by the sales of products under the earlier mark and the applicant's annual turnover, it should be noted that the degree of diversification of the activities of undertakings operating in one and the same market varies. Moreover, the obligation to produce evidence of genuine use of an earlier trademark is not designed to monitor the commercial strategy of an undertaking. It may be economically and objectively justified for an undertaking to market a product or a range of products even if their share in the annual turnover of the undertaking in question is minimal.

2.2.2.6 Examples of insufficient genuine use

Case No	Comment
18/03/2015, T-250/13, SMART WATER	The test sales of 15 000 water bottles are considered symbolic in the light of the size of the European market (paras 34-35).
16/07/2014, T-196/13, NAMMU, EU:T:2014:1065	The applicant provided an affidavit signed by the Head of the Import Department and Quality Manager, as well as photos, including one of a Nanu-Nana shop front, and other undated products. No evidence was submitted to prove the turnover figures given in the affidavits, and the photos were undated (para. 33).
30/04/2008, T-131/06, Sonia Sonia Rykiel, EU:T:2008:135	54 units of women's slips and 31 units of petticoats were sold over a period of 13 months, for a total sum of EUR 432. The General Court considered these modest quantities with regard to the relevant market (everyday consumption goods, sold at a very reasonable price) to be insufficient.
27/02/2009, R 249/2008-4, AMAZING ELASTIC PLASTIC II	500 plastic balloon kits given away as 'samples' free of charge cannot constitute genuine use.
20/04/2001, R 378/2000-1, RINASCIMENTO/ RENACIMIENTO	The Board of Appeal confirmed the decision of the Opposition Division that the submission of one bill of lading showing the delivery of 40 packages of sherry is insufficient to prove genuine use.
09/02/2012, R 239/2011-1, GOLF WORLD (fig.9 / GOLF WORLD et al. (B 1 456 443, Golf World)	As the only evidence of use for <i>printed matter</i> , the opponent submitted evidence that proved 14 subscribers for a magazine in Sweden. The OD held that this is insufficient to prove genuine use in Sweden, particularly taking account of the fact that magazines are not high-priced articles.
20/05/2011, R 2132/2010-2, SUSURRO (fig.) / SUSURRO	Nine invoices concerning the sale of wine in 2005, 2006, 2007 and 2008, showing that over a period of 36 months, goods marketed under the earlier mark and worth EUR 4 286.36 were sold, as well as an undated sample of a product label, were not considered sufficient proof of genuine use of a Spanish trademark registered for <i>alcoholic drinks (except beers)</i> in Class 33. The evidence showed that the sales of wine had been made in a small, very provincial, part of Spain. For a country with over 40 million inhabitants, the amount sold of a relatively cheap wine was found to be too small to create or preserve an outlet for goods (wine) that are consumed in large quantities by the average Spanish consumer
07/07/2011, R 908/2010-2, ALFA-REN / ALPHA D3 et al.	Table of sales figures for ALFACALCIDOL products in Lithuania between 2005 and 2008, indicating products sold by Teva Corp. under the trademark ALPHA D3' (source: IMS health database, Lithuania); an undated copy of packaging for a product 'ALPHA D3' (undated); and a copy of an advertisement for 'ALPHA D3' products sold in Lithuania (not translated) were found insufficient to show genuine use of the mark in Lithuania. It could not be seen from the evidence submitted whether the marked goods were actually distributed and, if so, the quantities involved.

¹⁵³ 08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 37

16/03/2011, R 820/2010-1, BE YOU / BEYU	Sales of goods with profits below EUR 200 during the 9-month period of use were not considered sufficient proof of genuine use of the opposing mark in respect of the goods in Class 14.
06/04/2011, R 999/2010-1, TAUTROPFEN CHARISMA (fig.) / CHARISMA	Eleven invoices showing that 13 units of <i>perfumery</i> goods were sold in Spain between 2003 and 2005, for a total amount of EUR 84.63, were deemed as insufficient proof of genuine use of the sign. Account has been taken of the fact that the goods were intended for daily use and available at a very affordable price.
27/10/2008, B 1 118 605, Viña la Rosa	Photocopies of three independent wine guides mentioning the opponent's trademark (without further explanation as to the volume, edition, publisher, etc.) were not considered sufficient to prove use for wines.
21/06/1999, B 70 716, Oregon	The Opposition Division found an invoice for 180 pairs of shoes as insufficient to prove genuine use.
30/01/2001, B 193 716, Lynx	As evidence of use the opponent submitted two invoices, for a total amount of 122 items of clothing, and four undated labels with no indication of what goods they were to be affixed to. The Opposition Division considered them insufficient.

2.2.2.6 Examples of genuine use

Case No	Comment
16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675	Nine invoices dated between April 2001 and March 2002, representing sales of around EUR 1 600 (with a turnover figure barely above EUR 1 000 000 per year) and showing that items were delivered to different customers in small quantities (12, 24, 36,48, 60, 72 or 144 pieces), for widely used products like <i>shoe polish</i> , in the largest European market, Germany, with approximately 80 million potential consumers, were deemed as providing evidence of use that objectively is such as to create or preserve an outlet for <i>polishing cream</i> and <i>leather conditioner</i> . Furthermore, the volume of sales, in relation to the period and frequency of use, was deemed to be significant enough not to be considered merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark. Confirmed by the General Court (para. 68)
10/09/2008, T-325/06, Capiro, EU:T:2008:338	Evidence (invoices, lists of sales) proving that the intervener sold 4 hollow-fibre oxygenators with detachable hard-shell reservoirs in Finland in 1998, 105 in 1999 and 12 in 2001, for a total amount of EUR 19 901.76, was deemed sufficient proof of genuine use of the EUTM registered for <i>oxygenators with integrated pump; controllers for integrated pump; regulating devices of air pressure for integrated pump; suction pumps; blood flow meters</i> in Class 10 (paras 48, 60).
25/03/2009, T-191/07, Budweiser, EU:T:2009:83	The Board of Appeal (20/03/2007, R 299/2006-2, 'BUDWEISER/BUDWEISER BUDVAR (fig.) et al., § 26) found essentially that the documents presented to it during the administrative proceedings — invoices proving the sale of beer in France amounting to more than 40 000 litres between October 1997 and April 1999, 23 invoices issued in Austria between 1993 and 2000 to a single buyer in Austria, and 14 invoices issued in Germany between 1993 and 1997 — were sufficient to demonstrate the extent of use of the earlier international word mark BUDWEISER (IR No 238 203) in those countries. The Board's findings were confirmed by the General Court.
11/05/2006, C-416/04 P, Vitafruit, EU:C:2006:310	Evidence of the sale to a single customer in Spain of concentrated fruit juices during a period of 11.5 months, with a total volume of sales of EUR 4 800, corresponding to the sale of 293 cases of 12 items each, was considered sufficient use of the earlier Spanish trademark (paras 68-77).

08/07/2010, T-30/09, Peerstorm, EU:T:2010:298	As evidence of use, the opponent (merely) provided several catalogues for end consumers, featuring the relevant trademark on clothing articles. The Court held that '...it is true that those catalogues provide no information on the quantity of goods actually sold by the intervener under the trademark PETER STORM. However, it is necessary to take into account ... the fact that a large number of items designated by the trademark PETER STORM were offered in the catalogues and that those items were available in more than 240 shops in the United Kingdom for a significant part of the relevant period. Those factors support the conclusion, in the context of a global assessment ... that the extent of its use was fairly significant' (paras 42 to 43).
04/09/2007, R 35/2007-2, DINKY	The sale of approximately 1 000 miniature toy vehicles was considered sufficient extent of use in light of the products being sold mainly to collectors at a high price in a particular market.
11/10/2010, R 571/2009-1, VitAmour / VITALARMOR	The sale of 500 kg of milk proteins for a total value of EUR 11 000 was considered sufficient to prove genuine use for <i>milk proteins for human consumption</i> . In view of the nature of the products, which are not consumer goods but ingredients for use by the food processing industry, the amount and values shown did demonstrate a market presence above the threshold required.
27/07/2011, R 1123/2010-4, Duracryl / DURATINT et al.	Eleven invoices made out to different undertakings in various regions of Spain, showing that the proprietor of the mark sold, in the relevant period and under the mark, 311 containers of the product, in different sizes, for a net amount of EUR 2 684, were deemed sufficient to prove genuine use of a mark registered for <i>preservatives against deterioration of wood</i> in Class 2.
26/01/2001, B 150 039	The Opposition Division regarded evidence of sales of around 2 000 furry toy animals in a high-priced market sector as sufficient.
18/06/2001, B 167 488	The opponent submitted one invoice referring to the sale of one high-precision laser cutting machine for FRF 565 000, a catalogue describing its performance and some photographs depicting the product. The Opposition Division considered them as sufficient evidence taking into account the nature of the product, the specific market and its considerably high price.

2.2.3 Use of the mark in forms different from that registered

The use of the mark in a form different from that registered still constitutes use of the trademark as long as the differing elements do not alter the distinctive character of the trademark, regardless of whether or not the trademark in the form as used is also registered in the name of the proprietor.

The purpose is to allow its proprietor to make variations in the sign that, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.

The strict conformity between the sign as used and the sign registered is not necessary. However, the difference must be in negligible elements and the signs as used and registered must be broadly equivalent.

In order to decide whether the sign as used and the sign as registered are broadly equivalent, it must first be established what elements are negligible.

Present paragraph will deal with these criteria including showing practice in relation to the 'variation' of marks, 'additions' of elements to marks and 'omissions' of elements of marks.

In brief, the test consists of first determining what the distinctive and dominant elements of the registered sign are and then verifying if they are also present in the sign as used.

The assessment of the distinctive or dominant character of one or more components of a complex trademark must be based on the intrinsic qualities of each of those components, as

well as on the relative position of the different components within the arrangement of the trademark.¹⁵⁴

With regard to **additions**:

- several signs may be used simultaneously without altering the distinctive character of the registered sign
- if the addition is not distinctive, is weak and/or is not dominant, it does not alter the distinctive character of the registered trademark.

With regard to **omissions**:

- if the omitted element is in a secondary position and not distinctive, its omission does not alter the distinctive character of the trademark.

~~The principles set out in this section must be read in line with those adopted by the European Union Intellectual Property Network in its **Common Practice CP8 – Use of a trademark in a form differing from the one registered**. This Common Practice was published on 15/10/2020 and has been applied by the Office since that date, including in ongoing proceedings.~~

In general, it has to be assessed whether use of the mark constitutes an acceptable or unacceptable ‘variation’ of its registered form.

Therefore, there are two questions to be answered. Firstly, it must be clarified what is to be regarded as the distinctive character of the mark as registered¹⁵⁵. Secondly, it must be evaluated whether the mark as used alters this distinctive character. These questions have to be answered on a case-by-case basis.

There is **interdependence** between the strength of the distinctive character of a mark and the effect of alterations. Marks of strong distinctive character may be less influenced by changes than marks of limited distinctiveness. Adding elements to or omitting elements from the mark are more likely to affect the distinctive character of marks of limited distinctiveness.

Where a mark is composed **of several elements**, only one or some of which are distinctive and have rendered the mark as a whole registrable, an alteration of that distinctive element(s) or its omission or replacement by another element will generally mean that the distinctive character is altered.

In order to determine whether the use of a variation of the mark should be accepted or whether the distinctive character is altered, account must be taken of the practices in the branch of business or trade concerned and the relevant public.

Case No	Registered mark	Actual use	Comment
12/12/2014, T-105/13, TrinkFix	Drinkfit		Relevant goods were <i>beverages</i> in Classes 29 and 32. The labels on bottles of beverages are narrow, so it is not unusual for a word mark to be written on two lines (para. 47).

¹⁵⁴ 24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 36

¹⁵⁵ See the Guidelines, Part B Examination, Section 2, Double Identity and Likelihood of Confusion, Chapter 4, Comparison of Signs.

Additions

As indicated above, with regard to additions, if the addition is non-distinctive or weak and/or not dominant, it does not alter the distinctive character of the registered trademark.


Below is provided examples of these two types of scenarios:

- Use of several marks or signs simultaneously;
- additions of other verbal elements;
- additions of figurative elements.

Addition of other verbal elements

In principle, a difference in words or even letters constitutes an alteration of the distinctive character of the mark. However, below a number of situations are described where additions are acceptable.

Addition of non-dominant elements

Registered form	Actual use	Case No
COLORIS		30/11/2009, T-353/07, Coloris
<p>The General Court confirmed that the use of the mark <i>Coloris</i> with additional word elements such as 'global coloring concept' or 'gcc' did not alter its distinctive character because the additional elements were merely used together with the mark <i>Coloris</i> and positioned below it and were of such a size that they were not predominant in the mark.</p>		


Additions with generic or descriptive meaning

Use of a registered word mark (or any other mark) together with a generic indication of the product or descriptive term will be considered as use of the registered mark. Additions that are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, do not in general constitute use of a variant but use of the mark itself.

For example:

Registered form	Actual use	Case No
HALDER	HALDER I, HALDER II, HALDER III, HALDER IV, HALDER V	13/04/2011, T-209/09, Alder Capital

The Court indicated that ‘the fact that, in that newspaper article, the names of the funds are composed of the term “halder”, to which a number in Roman numerals has been added, is not such as to call into question the conclusion on use of the mark, since, because of their brevity, their weak distinctive character and their ancillary position, those additions do not alter the distinctive character of the mark in the form in which it was registered’ (para. 58).

		<p>09/07/2013, R 1190/2011-4, VIÑA ALBERDI / VILLA ALBERTI; confirmed 30/06/2015, T-489/13, VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446</p>
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The figurative signs reproduced in the evidence of use contain the distinctive elements of the earlier mark and those elements are clearly visible on the labels. The inversion of the figurative and word elements of the sign and the additional indication of the respective appellation of origin (Soave, Soave Superiore and Chianti) do not alter the distinctive character of the earlier mark, which appears reproduced in the sign with all its distinctive elements. Consumers of wines are particularly interested in knowing the precise geographical origin of these products; however, the addition of this information about the geographical origin of the goods is not capable of altering the distinctive character of a trademark in its essential function of identifying a particular commercial origin (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 19).

<p>ARKTIS</p>	<p>ARKTIS LINE</p>	<p>16/04/2015, T-258/13, ARKTIS, EU:T:2015:207</p>
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The Court stated that the term ‘line’, synonymous with the German word ‘Linie’, is commonly used in advertising and business in relation to a product line. It is likely to be perceived automatically as an additional element by the average consumer, particularly in Germany. The Court agreed with the Board of Appeal that the term ‘line’ did not alter the distinctive character of the disputed mark and that use of this trademark in combination with this term was a use of that mark (paras 26-27).

Other acceptable additions

The addition of **insignificant elements** such as punctuation marks does not alter distinctive character:


Registered form	Actual use	Case No
<p>PELASPAN-PAC</p>	<p>PELASPAN PAC</p>	<p>22/03/2013, R 1986/2011-4, PELASPAN / PELASPAN et al.</p>

The use of the earlier mark ‘PELASPAN-PAC’ without the hyphen connecting the elements ‘PELASPAN’ and ‘PAC’ does not alter the distinctive character of the earlier mark as registered and therefore counts for the genuine use assessment.

In the same way, the use of plural or singular forms in meaningful words (for instance, by adding/omitting a letter 's' in English or other languages) normally does not alter distinctive character:

Registered form	Actual use	Case No
Tentation	Tentations	29/07/2008, R 1939/2007-1, TEMPTATION FOR MEN YANBAL (fig.)/TENTATION
<p>'In the case in hand, and after an examination of the proof submitted, which focuses essentially on the Spanish market, the Board is of the opinion that use of the "TENTATION" registered trademark through use of the "TENTATIONS" sign does not alter the distinctive character of the original registered trademark. Specifically, the mere addition of the letter "S" to the end of the trademark does not substantially alter the visual appearance or pronunciation of the registered trademark and does not create a different conceptual impression on the Spanish market either. The trademark in question will be perceived merely as being in its plural form as opposed to its singular form. Therefore, said change does not alter the distinctive character of the sign' (para. 17).</p>		

The addition of the '**type of enterprise**' is also acceptable:




Registered form	Actual use	Case No
	<p>The form used contained the logo plus the words 'SOCIEDAD LIMITADA' (in small letters) underneath the term 'SISTEMAS' and/or the 'E' device with the words 'epco SISTEMAS, S.L.' in bold</p>	<p>19/01/2009 R 1088/2008-2, EPCOS (fig.) / E epco SISTEMAS (fig.); confirmed 15/12/2010, T-132/09, Epcos</p>
<p>'... these signs are not, as the applicant seems to suggest, significant alterations of the distinctive character of the earlier mark as registered' (para. 24).</p>		

Unacceptable additions

Registered form	Actual use	Case No
VILA VITA PARC	<p>vila vita hotel & feriendorf panno[n]ja</p>	<p>14/07/2014, T-204/12, Via Vita, EU:T:2014:646</p>
<p>'... whereas the German word "Feriendorf", meaning "holiday village", could be perceived as descriptive of the relevant [hotel] services, the same was not true for the word element "panno[n]ja"' (para. 30). Consequently, the addition of the word 'panno[n]ja' alters the distinctive character of the mark.</p>		
Captain	Captain Birds Eye	<p>23/04/2001, R 89/2000-1 EL CAPITAN PESCANOVA / CAPTAIN</p>
<p>'It cannot be considered ... that the use of CAPTAIN BIRDS EYE constitutes use of the mark CAPTAIN in a form which does not alter the distinctive character of the mark as registered, since the two signs appear essentially different' (para. 20).</p>		

Addition of figurative elements

In cases where the figurative element plays only a minor role, being merely decorative, the distinctive character of the sign as registered is not affected.

Registered form	Actual use	Case No
DRINKFIT		12/12/2014, T-105/13, TrinkFix
The addition of the semi-circular graphical element does not change the overall impression of the sign (para. 49).		
SEMBELLA		23/01/2014, T-551/12, Rebella, EU:T:2014:30
The figurative elements are only decorative or even negligible and do not alter the distinctive character of the mark (para. 43).		
BIONSEN		18/04/2008, R 1236/2007-2
<p>'[T]his material shows that the respondent's products also contain other elements, in particular a Japanese character within a small circle, which is depicted either above or below the word "BIONSEN" (para. 19).</p> <p>'However, in the present case, the combination of the stylised form of the word "BIONSEN" and the Japanese character, independently of whether it is above or under the word "BIONSEN", constitutes at the most use which differs from the form in which it was registered only in negligible elements. The word "BIONSEN" as used is merely a slight and banal stylisation of the word 'BIONSEN'. As to the addition of the figurative element in the form of a circular element with a Japanese character, this will hardly be noticed by the average consumer due to its relatively small size and position, either under or on the right side above the word "BIONSEN" (para. 23).</p>		


Use of several marks or signs simultaneously

It is quite common in some market areas for goods and services to bear not only their individual mark, but also the mark of the business or product group ('house mark'). In these cases, the registered mark is not used in a different form, but the two independent marks are validly used at the same time.

Two or more trademarks may be used together in an autonomous way, or with the company name, without altering the distinctive character of the earlier registered trademark. It is

common practice in the trade to depict independent marks in different sizes and typeface, so these clear differences, which emphasise the house mark, indicate that two different marks are being used jointly but autonomously.

The condition of genuine use of a registered trademark may be satisfied both where it has been used as part of another composite mark or where it is used in conjunction with another mark, even if the combination of marks is itself registered as a trademark. Similarly, use can be genuine where a figurative mark is used in conjunction with a word mark superimposed over it, even if the combination of those two marks is itself registered, to the extent that the differences between the form in which that trademark is used and that in which it was registered do not change the distinctive character of that trademark as registered.

Registered form	Actual use	Case No
<p>CRISTAL</p>		<p>08/12/2005 T-29/04 Cristal Castellblanch</p>
<p>'In the present case the mark CRISTAL appears clearly four times on the neck of the bottle marketed by the intervener and twice on the main label, accompanied by the symbol [®]. On the neck, that mark is separate from the other elements. In addition, the mark CRISTAL appears alone on the boxes in which bottles of the mark CRISTAL are marketed. Equally, on the invoices produced by the intervener reference is made to the term "cristal" with the mention "1990 coffret". It should be noted that the mark CRISTAL thus identifies the product marketed by the intervener' (para. 35).</p> <p>'As regards the mention "Louis Roederer" on the main label, it merely indicates the name of the manufacturer's company, which may provide a direct link between one or more product lines and a specific undertaking. The same reasoning applies to the group of letters "lr", which represents the initials of the intervener's name. As pointed out by [the Office], joint use of those elements on the same bottle does not undermine the function of the mark CRISTAL as a means of identifying the products at issue' (para. 36).</p> <p>'Furthermore, [the Office's] finding that the use of the word mark together with the geographical indication "Champagne" cannot be considered to be an addition capable of altering the distinctive character of the trademark when used for champagne must be endorsed. In the wine sector the consumer is often particularly interested in the precise geographical origin of the product and the identity of the wine producer, since the reputation of such products often depends on whether the wine is produced in a certain geographical region by a certain winery' (para. 37).</p>		

Registered form	Actual use	Case No
<p>L.114</p>	<p>Lehning L114</p>	<p>29/02/2012, T-77/10 & T-78/10, L112, EU:T:2012:95</p>


L.114 is a French trademark registered for *pharmaceutical products* in Class 5. The Court found that:

- 1) the missing full-stop between the capital letter 'L' and the number 114 constituted a minor difference that did not deprive earlier mark L.114 of its distinctive character (para. 53).
- 2) 'Lehning' was the house mark — the fact that earlier mark 'L.114' was used together with that house mark did not alter its distinctive character within the meaning of Article 15(1)(a) of Regulation (EC) 207/2009 [now Article 18(1)(a) EUTMR] (para. 53).

YGAY	YGAY together with a number of other verbal and figurative elements	24/09/2008, R 1695/2007-1, I GAI (fig.) / YGAY et al.; confirmed 21/09/2010, T-546/08, i Gai
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In the Board's decision (confirmed 21/09/2010, T-546/08, i Gai, EU:T:2010:404, § 19, 20) it was pointed out that the trademark YGAY appears in many photographs on both the label and the box in which the bottle is sold. On the labels, the trademark in question is separated from the other elements. On some labels, it appears on its own, beneath the phrase MARQUES DE MURRIETA, written in large bold letters. On others, the phrase BODEGAS MARQUES DE MURRIETA is written in small letters in the upper part, while the elements CASTILLO YGAY are written in large, stylised letters across the label. The trademark YGAY also appears on its own or together with the phrase CASTILLO YGAY on the boxes in which the bottles are sold. Reference is also made, on the invoices submitted by the respondent, to the trademark YGAY, along with general information such as the year of production and origin, etc. It follows, therefore, that the sign YGAY functions as the trademark identifying the goods, *wine*, sold by the respondent (para. 15).

The mention of MARQUES DE MURRIETA in this context might merely be an indication of the name of the manufacturer's company or the vineyard that produces and sells the wine, which might provide a direct link between one or more product lines and a specific undertaking (08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 36) (para. 16).

Registered form	Actual use	Case no.
 <p>Mark No 1</p>	 <p>Mark No 2</p>	18/04/2013, C-12/12, Colloseum Holding
<p>Levi Strauss is the proprietor of the two EUTMs reproduced above. Mark No 1 is always used in conjunction with the word mark LEVI'S, i.e., as in Mark No 2. The Court found that the condition of 'genuine use' may be fulfilled where an EU figurative mark is used only in conjunction with an EU word mark that is superimposed over it, and the combination of those two marks is, furthermore, itself registered as a European Union trademark, to the extent that the differences between the form in which the trademark is used and that in which it was registered do not change the distinctive character of the trademark as registered.</p>		
MINUTO	DUBOIS MINUTO	12/09/2001, R 206/2000-3, MINU' / MINUTO

The Board of Appeal regarded the presentation of the two words as the use of two separate marks, since the evidence submitted by the respondent showed that one of them was an old brand of the respondent with its own identity and was present on the market with a number of accompanying signs, as is common practice in the labelling of the specific products (wine).



“DUBOIS” and “MINUTO” are separate marks that are affixed together in the concrete product, as is common practice in the labelling of wine products (name of the winery and name of the product). As regards Spanish brands, see for example “TORRES” — “Sangre de Toro”, “TORRES” — “Acqua d’Or”. When asking for “MINUTO” wine, the relevant consumer will be aware that such wine is included within the line of products “DUBOIS”, however, “MINUTO” will be perceived as a trademark of its own, even if it may appear next to the sign “DUBOIS” in the invoices, brochures and/or product labels’ (para. 18).

Omissions

When considering ‘omissions’ of elements of a mark in its used form, care has to be taken to check that the distinctive character of the mark has not been altered.

If the omitted element is in a **secondary position and not distinctive**, its omission does not alter the mark.



Omissions of non-dominant elements

Registered form	Actual use	Case No
		24/11/2005, T-135/04, Online Bus
<p>The General Court considered that both the registered form of the earlier mark and the form used included the word ‘BUS’ and the figurative element of ‘three interlaced triangles’. The presentation of the elements is not particularly original or unusual in either form. The variation in them does not affect the distinctive character of the trademark. As regards the omission of ‘Betreuungsverbund für Unternehmer und Selbständige e.V.’, the latter was ‘a string of words, written in small characters and occupying a secondary position, at the bottom of the sign. Its meaning (Association for the assistance of businessmen and the self-employed, registered association) refers to the services in question ‘Therefore, in the light of the descriptive content of that element and its accessory position in the presentation of the sign, it must be held that it is not distinctive ... It follows from the foregoing that the form used of the earlier trademark used does not contain any differences such as to alter the distinctive character of that trademark’ (para. 34 et seq.).</p>		

Omissions of generic or descriptive elements

Where a registered mark contains a **generic** indication of the product or **descriptive** term, and this term is omitted in the used form of the sign, such use will be considered as use of the registered mark.

Omissions that are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, in general constitute use of an acceptable variant.

Registered form	Actual use	Case No
		29/09/2011, T-415/09, Fishbone, EU:T:2011:550; Confirmed 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484
<p>The Board considered that although in some pieces of evidence the earlier mark did not include the word 'beachwear', this did not alter the distinctiveness of the earlier mark because it was plainly descriptive of the nature of the goods (<i>t-shirts, beachwear</i>).</p> <p>The General Court held:</p> <p>'In the present case, the earlier mark is a composite mark, representing a ship's wheel, that is to say, a sign with a rounded shape. In the centre of the sign there is a fish skeleton, at the top of which is written the term "fishbone", and at the bottom the term "beachwear". ... although the use of the earlier mark varies in certain items of evidence and is used in a form different from that under which it was registered, in the sense that the sign does not include the term "beachwear", such a fact does not affect its distinctive character. The term "beachwear", which means "beach clothing" in English, is descriptive of the nature of the goods covered by the earlier mark [emphasis added]. That descriptive character is obvious in the case of the "beach clothing" covered by the earlier mark, but also in the case of "t-shirts", for which the term "beachwear" will immediately be perceived as meaning that it refers to a t-shirt to be worn in casual situations, for example, on the beach in summer. Consumers will thus understand that term as designating the type of goods and will not perceive it as an indication of their commercial origin. The fact that the term "beachwear" is written in a more fanciful font than that of the term "fishbone", which is written in ordinary capital letters, cannot alter such an assessment. Furthermore, ... the font of the term "beachwear" cannot be regarded as uncommon, since it comprises printed lower-case characters. As for the horizontal position of the term "beachwear" in the earlier mark, which runs in a perpendicular sense across the bottom of a ship's wheel, it is no more graphically incisive than that of the term "fishbone" which, also written horizontally, follows the rounded shape of that wheel' (paras 62-63).</p>		



Other acceptable omissions

The omission of **insignificant prepositions** does not alter the distinctive character:

Registered form	Actual use	Case No
CASTILLO DE PERELADA	CASTILLO PERELADA	B 103 046
It is not considered that the absence of the word 'de' affects the distinctive character of the trademark.		

There are instances where the earlier sign is composed of a distinctive verbal element (or several) **and** a figurative element (or several), with the latter perceived by the relevant public as banal. Such banal elements are considered non-distinctive, and their omission does not change the distinctive character of the sign. Therefore, it is important to establish which elements influence the distinctive character of the mark and how consumers will perceive them.

Registered form	Actual use	Case No
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		<p>27/02/2014, T-225/12, LIDL express, EU:T:2014:94, paras 49-53; appealed 06/09/2016, C-237/14 P, LIDL express (fig.) / LIDL MUSIC (fig.) et al., EU:C:2016:667</p>
<p>The Court confirmed (para. 53) the finding of the Board that the 'distinctiveness of the mark is largely dominated by the wording 'LIDL MUSIC' and only marginally influenced by the figurative elements used to represent the letters and the small monogram underneath' (21/03/2012, R 2379/2010-1, LIDL express (fig.)/LIDL MUSIC (fig.) et al., para. 19).</p>		

The omission of the **transliteration of a term** is generally considered as an acceptable alteration.

Registered form	Actual use	Case No
<p>ΑΡΑΛΙΑ-ΑΠΑΛΙΑ</p>	<p>ΑΡΑΛΙΑ</p>	<p>15/09/2011, R 2001/2010-1, ΑΡΑΝΙ / ΑΡΑΛΙΑ-ΑΠΑΛΙΑ</p>
<p>The omission of the transliteration of the term in Greek characters does not alter the distinctive character of the mark as the form used contains the term ΑΡΑΛΙΑ, which is distinctive and dominant.</p>		


Unacceptable omissions

In principle, a difference in **words or even letters** constitutes an alteration of the distinctive character of the mark.

Registered form	Actual use	Case No
<p>TONY HAWK</p>	<p>HAWK</p> 	<p>B 1 034 208</p>
<p>'[T]he absence of the word element 'TONY' in the first two marks significantly alters the distinctive character of the registered earlier mark 'TONY HAWK'. Therefore, these marks will be perceived as separate marks and their use cannot be considered as the use of the word mark 'TONY HAWK'.</p>		
Registered form	Actual use	Case No
		<p>03/02/2010, R 1625/2008-4 LT LIGHT-TECHNO / (FIGURATIVE); (appeal 10/11/2011, T-143/10, LT Light-Thecno, EU:T:2011:652 did not refer to the Spanish trademarks)</p>

'In the present matter, the Board has been able to verify that none of the proof of use supplied reproduces the earlier Spanish signs in the form in which they were registered, as either a representation of the mark in its purely visual form appears, that is, without the expression "light technology", or the visual element accompanied only by the term "Light" and other word elements or the expression "LT Light-Technology" also in word form without the visual element which obviously characterises the earlier Spanish marks on which the opposition is based ... In view of these circumstances and taking into consideration that the modifications made to the representation of earlier marks modify their distinctive character, it is considered that, in any event, the proof submitted does not demonstrate the use of the Spanish marks in the basis of the opposition' (paras 15-16).



In cases where the **figurative element** is the dominant or distinctive element and not merely decorative or banal, its omission can alter the distinctive character of the sign.

Registered form	Actual use	Case No
	ESCORPION	28/03/2007, R 1140/2006-2 SCORPIO / ESCORPION
<p>'The earlier trademarks are strongly characterised by the presence of the figurative element. However, the documents submitted during the opposition proceedings and, even if they were to be taken into account, the appeal proceedings, do not show any use of the figurative element contained in the earlier trademarks' (para. 19).</p> <p>'Therefore, the Office considers that the alteration of the opponent's trademark appearing in the way it is currently used is not an acceptable alteration and consequently use of the registered mark is not shown.</p>		



Other alterations – Acceptable alterations

Word marks are considered used as registered regardless of typeface, use of upper/ lower case or colour. It would not be correct to analyse this type of use from the perspective of whether distinctive character is altered. However, a **very particular typeface** (highly stylised) may lead to a different conclusion.


Changing the **letter size** or switching between **upper/lower case** is customary when using word marks. Therefore, such use is considered use of the registered mark.

Registered form	Actual use	Case No
PALMA MULATA		12/03/2014, T-381/12, Palma Mulata EU:T:2014:119
<p>The Court confirmed that the use of a [standard] typeface does not alter the distinctive character of a word mark. It rather helps to distinguish the mark from the descriptive elements 'ron' and 'de Cuba' (para. 34).</p>		
MILENARIO		18/09/2009, R 289/2008-4 Sierra Milenario / MILENARIO

The Board confirmed OD's views that use of the word mark 'MILENARIO' written in stylised bold characters did not affect the distinctive character of the mark, as the word 'MILENARIO' was considered to be the dominant element of the mark registered for *sparkly wines and liquors* in Class 33 (para. 13).

AMYCOR		25/05/2009, R 1344/2008-2, CLAMYCOR / AMYCOR
<p>Representation of the word mark, registered for <i>pharmaceutical and sanitary preparations; plasters; materials for dressings; fungicides; disinfectants</i> covered by the earlier trademark in Class 5, in a stylised form together with figurative elements was not considered as substantially changing the distinctive character of the word trademark 'AMYCOR' as registered.</p>		
THE ECONOMIST		05/08/2011, R 56/2011-4 eIECONOMISTA (fig.) / THE ECONOMIST et al.
<p>'The applicant's argument that the proof of use is insufficient because it refers to the device mark ... and not to the word mark 'THE ECONOMIST' fails. First, the submitted evidence refers to both earlier marks (i.e. the word mark and the device mark). Furthermore, use of the earlier device mark constitutes use of the earlier word mark. In this respect it should be noted that word marks are considered used as registered, also if the typeface is different (this may be different if the typeface is a very particular one), if there is a usual change in the letter size or a usual change between lower-case and capital letters, if used in a specific colour or if used in combination with generic additions. Use of the word "THE ECONOMIST" in a standard typeface, with the usual use of capitals at the beginning of the words "The" and "Economist", in a white colour on a contrasting background is considered use, not only of the earlier device mark but of the earlier word mark as well' (para. 14).</p>		

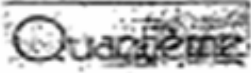




Word marks are registered in black and white. It is customary to use marks in **colour**. Such use does not constitute a variant but use of the registered mark.

Registered form	Actual use	Case No
SILVER		B 61 368
<p>'The actual use of the trademark which can be seen on the beer pack, the newspaper extract and on the calendar is not the use of the registered <i>word</i> mark SILVER, but of the <i>colour device</i> mark, namely a beer label with the word SILVER written in white capital letters in a red banner which overlaps a golden circle which contains the word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg". This does not automatically mean that the mark was not used as registered. Each case must be looked at on its own merits. In this case, the Office finds that the mark SILVER is the actual trademark. The appearance of the other word elements "Bière sans alcool", "Bière de haute qualité", "pur malt" and "Brassée par le Brasseries Kronenbourg" and the figurative element is only secondary to the mark SILVER. It is also clear from the marketing study, the newspaper extract and the invoices that the actual trademark is SILVER. The Office finds that the use of the word SILVER is so dominant in the figurative mark that it fulfils the requirements of having been used as registered.'</p>		


Figurative marks

Using a **purely figurative mark** (without word elements) in a form other than registered often constitutes an unacceptable alteration. In the case of **composite marks** (i.e. marks composed

of word and figurative elements), **changes to certain figurative elements do not** normally affect the distinctive character of the marks.

Registered form	Actual use	Case No
		12/01/2006, T-147/03, Quantum, EU:T:2006:10; dismissed 15/03/2007, C-171/06 P, Quantum, EU:C:2007:171
<p>'[T]he only elements which differentiate the earlier national mark, as it was registered, from the sign used by the applicant are the stylisation of the letter "q", suggesting the face of a watch, and the use of capital letters to write the verbal element of the earlier national mark ... In the first place, although it is true that the stylisation of the letter "q" is more pronounced in the representation of the sign used than in that of the earlier national mark, the distinctive character of the earlier mark is still based on the entire verbal element of that mark. In any case, since the stylisation of the letter "q" suggests, as has just been said, the face of a watch, it is not particularly distinctive for goods in Class 14. In the second place, as regards the use of capital letters, it suffices to note that that is not at all original and also does not alter the distinctive character of the earlier national mark ... It follows that the proof furnished by the applicant which refers to the sign reproduced in paragraph 10 above for the Class 14 goods "watches and watch bands or straps" could legitimately be taken into account by the Board of Appeal for the purposes of assessing whether the applicant had shown genuine use of the earlier national mark' (paras 28-30).</p>		
		18/11/2015, T-361/13, VIGOR / VIGAR, EU:T:2015:859
<p>The word 'vigar' is an invented word and is, therefore, inherently distinctive. Given the fact that the word 'vigar' is the only word element, and given its inherent distinctiveness, its central position and the fact that the additional elements highlight its presence, the word is the most distinctive element of the earlier mark. The form as used differs from the earlier mark as registered only in the ascending orientation of its oval background, the use of lower case instead of upper case letters and the replacement of the crown element by a sequence of three dots. The Court agreed that a different orientation of the same background, the use of upper case or lower case letters when they are standard letters that reproduce the same term, or the substitution of an ornamental element (the sequence of dots) for a laudatory element when both of those elements serve to reinforce the term 'vigar', are minor differences that do not alter the distinctive character of the earlier trademark as registered. That finding is not called into question if the second form of use is taken into account, inasmuch as, even though, in that case, the basic background disappears and the word 'spain' is present, the latter will be understood as a merely descriptive addition (paras 70-74).</p>		
Registered form	Actual use	Case No
	vieta	10/12/2015, T-690/14, Vieta, EU:T:2015:950
<p>The distinctive character of the mark is essentially derived, not from its figurative elements, but from the word 'vieta'. The element has a high level of distinctive character and occupies an important position in the overall impression created by the mark as registered, whilst the figurative elements have only weak distinctive character and occupy merely an ancillary position in the overall impression. Those figurative elements, including the typeface used, have a relatively marginal visual impact. The rectangular border does not present any originality in relation to usual commercial use. As regards the figurative elements made up of, on the one hand, grey rectangles separating the letters of the word 'vieta' and, on the other hand, white rectangles appearing in the middle of the sides of the rectangular border, they are very small in size, are not striking and do not present any originality (paras 47 and 48).</p>		

This is particularly relevant in cases where the figurative element is mainly descriptive of the relevant goods and services.







Registered form	Actual use	Case No
GRECO TAVERNA		01/03/2013, R 2604/2011-1, Taverna MEDITERRANEAN WHITE CHEESE
<p>'In relation to the "FETA" product, as regards the two Greek flags next to the word "TAVERNA" it should be noted that the obligation to use a trademark as registered does not require its proprietor to use the mark in isolation in the course of trade. Article 15(1) CTMR [now Article 18(1) EUTMR] does not preclude the possibility of the trademark's proprietor adding further (decorative or descriptive) elements, or even other marks such as its house mark on the packaging of the product, as long as the trademark 'as registered' remains clearly recognisable and in an individual form. The two Greek flags do not possess any distinctive character in relation to the products at hand which are commonly known to be food specialities originating from Greece. This is supported by the whole get-up of the product, coloured in blue and white in accordance with the colours of the Greek flag, the depiction of scenery which calls to mind a Mediterranean scene and the symbol for a Protected Designation of Origin below the picture' (para. 39).</p>		

This is also the case where the dominant elements remain unchanged.

For **alterations in colour** specifically, the main question that needs to be addressed is whether the mark as used alters the distinctive character of the registered mark, that is to say whether use of the mark in colour, while being registered in black and white or greyscale (and vice versa) constitutes an alteration of the registered form. A change only in colour does not alter the distinctive character of the trademark as long as:

- the word/figurative elements coincide and are the main distinctive elements
- the contrast of shades is respected
- the colour or combination of colours does not have distinctive character in itself
- the colour is not one of the main contributors to the overall distinctiveness of the sign

Registered form	Actual use	Case No



		<p>24/05/2012, T-152/11, Mad, EU:T:2012:263</p>
<p>The Court took the view that, if no colour is claimed in the application, the use of different colour combinations 'must be allowed, as long as the letters contrast against the background.' The Court also noted that the letters M, A, D were arranged in a particular way in the EUTM. Accordingly, representations of the sign that do not alter the arrangement of the letters, or the contrast of colour, constitute genuine use (paras 41 and 45).</p>		
		<p>23/06/2011, R 1479/2010-2, VOLKS-LASUR (fig.) / LASUR et al.</p>
<p>The word element was considered to be the dominant feature of the figurative mark, since it was in a central position and in large letters. It was considered that the distinctive character was not changed (para. 15).</p>		
		<p>29/04/2010, R 877/2009-1, Kaiku Bifi actiVium (fig.) / Bi-Fi (fig.)</p>
<p>'The orange background is the colour of packaging of the products. The mark is used in black on a white background, outlined in silver similar to the earlier registered mark. The typeface has been slightly modernised and the small hyphen between "Bi" and "Fi" has been deleted. Nevertheless, these may be considered as minor changes which do not alter the distinctive character of the mark in the form in which it is registered ... The typeface has been modernised, but the letters keep their rounded shape and the deletion of the hyphen may pass unnoticed. The distinctive character of the earlier mark is still based on the large black letters "Bi Fi", the "B" and "F" being in capital letters and the two "i" letters in lower case, on a white background and outlined in silver' (para. 45).</p>		

3D marks

The use of a 3D mark in varying sizes usually amounts to use of the mark as registered. The addition of a word/figurative element to such a mark does not generally alter the distinctive character of the sign.

Unacceptable alterations

Where a mark is composed of several elements, only one or some of which are distinctive, that have rendered the mark as a whole registrable, an alteration of that element or its omission or replacement by another element will generally mean that the distinctive character is altered.

Registered form	Actual use	Case No
MEXAVIT	MEXA-VIT C	30/03/2007, R 159/2005-4, Metavit / MEXA-VIT C et al.
In this case the use of the mark with a different spelling and the addition of the letter 'C' alter the distinctive character of the registered sign, because the letters 'VIT' are now seen as a descriptive element, namely 'VIT C' (which refers to 'Vitamin C').		
		15/12/2015, T-83/14, ARTHUR & ASTON Arthur, EU:T:2015:974
There are significant differences between the sign used and the earlier mark in its registered form. Those differences are such as to alter, from the perspective of the average French consumer to whom the goods in Class 25 are addressed, the distinctiveness of the earlier mark in its registered form. The graphic element of that mark, consisting of a stylised signature, disappears entirely from the sign used and is replaced by a radically different graphic element which is very classical, symmetrical and static. The earlier mark in its registered form attracts attention by its asymmetry and the dynamism conferred by the movement of the letters from left to right. The differences between the abovementioned mark and sign are not negligible and the mark and sign cannot be regarded as being broadly equivalent within the meaning of the case-law.		

2.2.4 Use for the goods or services for which the mark is registered

In accordance with article 27(4) of the Law, if ground for revocation of trademark exists for the part of the goods and services for which it is registered, Court will revoke registration only for that part.

Hence, the analysis of genuine use must in principle extend to all of the registered goods and/or services challenged in the lawsuit.

2.2.4.1 Comparison between goods/services used and specification of goods/services

It must always be carefully assessed whether the goods and services for which the mark has been used fall within the category of the registered goods and services.

Examples

Registered G&S	Used G&S	Comment
<i>Footwear.</i>	<i>Retail of footwear.</i>	Not OK
<i>Pharmaceuticals, veterinary and disinfectant products. In class 05</i>	<i>Napkins and napkin pants for incontinence.</i>	Not OK, even though the specific goods might be distributed by pharmacies.
<i>Telecommunication services in class 38.</i>	<i>Providing an internet shopping platform.</i>	Not OK

<i>Preserved, dried and cooked fruits and vegetables; concentrated citrus fruit and fruit extracts, preserves; sugar, biscuits, cakes, pastry and confectionery in class 30</i>	<i>Dessert toppings that are strawberry, caramel or chocolate flavoured.</i>	Not OK
<i>Baby diapers of textile in class 25</i>	<i>Disposable diapers of paper and cellulose (Class 16).</i>	Not OK
<i>Administration, representation and general counsel in class 35</i> <i>Technical, economic and administrative projects in class 42.</i>	<i>Administration of funds and personal assets or real estate affairs (Class 36).</i>	Not OK
<i>Electric switches and 'parts of lamps'. In class 9</i>	<i>Apparatus for lighting.</i>	Not OK
<i>Education services. In class 41</i>	<i>Entertainment services.</i>	Not OK
<i>Transportation and distribution services in class 39</i>	<i>Home delivery of goods purchased in a retail store.</i>	Not OK as the registered services are provided by specialist transport companies whose business is not the provision of other services, while the home delivery of goods purchased in a retail store is just an additional auxiliary service integrated in retail services.
<i>Advertising, business management, business administration, office functions in Class 35</i>	<i>Retail services.</i>	Not OK. If a trademark is registered for the general indications in Class 35, but use is proven only for <i>retail services</i> for particular goods, this cannot amount to valid proof of use for any of the specific indications of Class 35 or the class heading as a whole (para. 25 by analogy).

2.2.4.2 Relevance of the classification

It is relevant to establish whether the specific goods or services for which a mark has been used fall under any **general indication** listed in the **class heading** of a particular class of goods or services, and if so, which.

For instance, in Class 25, the class heading is *clothing, footwear, headgear*, and each of these three items constitutes a 'general indication'. Whereas, in general, classification does not serve more than administrative purposes, it is relevant, in order to assess the nature of the use, to establish whether the goods for which a mark has been used fall under the general indication of *clothing, footwear, headgear*.

This is apparent when similar categories of goods have been classified differently for certain reasons. For instance, shoes have been classified in various classes according to their intended purpose: *orthopaedic shoes* in Class 10 and ordinary *shoes* in Class 25. It must be established, according to the evidence provided, to which kind of shoes the use relates.

2.2.4.3 Use and registration for general indications in ‘class headings’

Where a mark is registered under **all** or **part of** the general indications listed in the class heading of a particular class and where it has been used for several goods or services that are properly classified in the same class under one of these **general indications**, the mark will be considered as having been used for that specific **general indication**.

Example: The earlier mark is registered for *clothing, footwear, headgear* in Class 25. The evidence relates to ‘skirts’, ‘trousers’ and ‘T-shirts’.

Conclusion: The mark has been used for *clothing*.

On the other hand, when a mark is registered for only **part** of the **general indications** listed in the class heading of a particular class but has been used only for goods or services which fall under **another** general indication of that same class, the mark will not be considered as having been used for the registered goods or services.

Example: The earlier mark is registered for *clothing* in Class 25. The evidence relates to ‘boots’ only.

Conclusion: The mark has not been used for the goods for which it is registered.

2.2.4.4 Use for subcategories of goods/services and similar goods/services

This part deals with the extent of protection granted where there is use for subcategories of goods and of ‘similar’ goods (or services).

In general, it is not appropriate to accept proof of use for ‘different’ but somehow ‘linked’ goods or services as automatically covering registered goods and services. In particular, the concept of **similarity of goods and services is not a valid consideration** within this context.

Example: The earlier mark is registered for *clothing* in Class 25. The evidence relates to ‘boots’ only.

Conclusion: The mark has not been used for the goods for which it is registered.

The mark registered for broad category of goods/services

If a trademark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords defense in revocation proceedings, only for the sub-category or sub-categories to which the goods or services for which the trademark has actually been used belong.¹⁵⁶

Therefore, if the trademark has been registered for a **broad category** of goods or services but the respondent provides evidence of use only for specific goods or services **falling within this category**, this raises the question of whether the submitted evidence is to be regarded strictly as proof of use only for the particular goods or services, which are not mentioned as such in the list of goods or services, or for the broad category as specified in the registration.

¹⁵⁶ 14/07/2005, T-126/03, Aladin, EU:T:2005:288, § 45; see also 16/07/2020, C-714/18 P, tigha / TAIGA, EU:C:2020:573, § 43

Therefore, it is necessary to take account of the breadth of the categories of goods or services for which the mark is registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do so in the light of the goods or services for which genuine use has actually been established.

On the other hand, it is not necessary for the respondent to file evidence of all the commercial variations of similar goods or services but merely of those goods or services that are sufficiently distinct to constitute coherent categories or subcategories. The underlying reason is that in practice it is impossible for the proprietor of a trademark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration.

Thus, defence is available **only** for the subcategory or subcategories to which the used goods or services belong if:

1. A trademark has been registered for a **category** of goods or services
 - a. that is sufficiently broad to cover a number of subcategories other than in an arbitrary manner;
 - b. that are capable of being perceived as being independent from each other.

and

2. It can be shown that the mark has been genuinely used in relation to only **part** of the initial broad specification.

Appropriate reasoning should be given for defining the subcategories and, on the basis of the evidence submitted by the defendant, it must be explained whether use has been shown in relation to only **part** of the initial broad specification or subcategory/ subcategories.

This is especially important in the case of trademarks registered for *pharmaceutical preparations*, which are usually used only for one kind of medicine for treating a certain disease.

On the other hand, the use for a whole category has to be accepted if there are examples of different kinds of products belonging to this category and there is no other subcategory that covers the different products.

Contested sign	Case No
CARRERA	09/09/2009, R 260/2009-4, (revocation)
<p>The use of a trademark shown on:</p> <ul style="list-style-type: none"> • decorative lettering; • increased performance packages; • covers for storage compartments; • wheel sets and complete wheel sets for summer and winter; and • door sill cover plates. <p>was considered sufficient proof of use for <i>motor vehicle and land vehicle parts</i> overall, for which the mark was registered. The main arguments were that it was used for numerous different motor vehicle parts and the goods for which use had been proven thus covered a wide spectrum of motor vehicle parts: elements of the chassis, the bodywork, the engine, the interior design and decorative elements.</p>	

In the case of a mark registered for a **broad category of goods and services that is not sufficiently clear and precise** to enable the competent authorities and economic operators, on that sole basis, to determine the scope of protection, it should be possible, in principle, to

determine the precise scope through proof of use.¹⁵⁷ The general principles stated above apply.

2.2.4.5 Examples

In order to define adequate subcategories of general **indications**, the **criterion of the purpose or intended use of the product or service** in question is of fundamental importance, as consumers do employ this criterion before making a purchase.¹⁵⁸ If the goods or services concerned have several purposes, it is not possible to create, in a non-arbitrary manner, separate subcategories by considering in isolation each of those purposes.


Other applicable criteria for defining adequate subcategories could be the characteristics of the product or service, for instance the nature of the product or service or the target consumer of the product or service. The geographical origin of the goods is not relevant. Even if the geographical origin of wines is an important factor when they are being chosen, such a factor is not so important that wines with different appellations of origin could constitute subcategories of goods that could be viewed autonomously.¹⁵⁹

Earlier sign	Case No
ALADIN	14/07/2005, T-126/03
<p>G&S: <i>polish for metals</i> in Class 3.</p> <p>Assessment: the mark was registered for <i>polish for metals</i> in Class 3, but was actually used genuinely only for <i>magic cotton</i> (a product for polishing metals consisting of cotton impregnated with a polishing agent). The Court held that 'polish for metals', which in itself is already a subcategory of the class heading term <i>polishing preparations</i>, is sufficiently precise and narrowly defined in terms of the function and intended purpose of the claimed goods. No further subcategory can be established without being artificial, and thus, use for the entire category of <i>polish for metals</i> was assumed.</p>	
PELLICO	15/06/2018, R 2595/2015-G, PELLICO (fig.) Revocation
<p>G&S: <i>footwear</i> in Class 25.</p> <p>Assessment: use has been proven for <i>women's footwear</i> only, which constitutes a sufficiently distinct subcategory within the broad category of <i>footwear</i>. The targeted consumer does not wish only to satisfy the needs of covering and protecting their own feet, but is looking specifically for ladies' shoes. Market realities also support such division: many shoe shops offer exclusively women's footwear or physically separate the women's footwear section from the rest (paras 32, 39-42).</p>	
Turbo	19/06/2007, R 378/2006-2, TURBO Revocation
<p>G&S: <i>clothing</i> in Class 25.</p> <p>Assessment: In addition to swimwear, other types of clothing were referred to in the invoices and could be found in the catalogues, for example t-shirts, Bermuda shorts, cycling shorts and female underwear (para. 21). Thus, use of the contested mark had been proved for <i>clothing</i> (para. 22).</p>	

¹⁵⁷ 29/01/2020, C-371/18, SKY, EU:C:2020:45, § 68-70; 04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, BURLINGTON / BURLINGTON ARCADE et al., EU:C:2020:151, § 136

¹⁵⁸ 13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 29-30; 23/09/2009, T-493/07, Famoxin, EU:T:2009:355, § 37

¹⁵⁹ 30/06/2015, T-489/13, VIÑA ALBERDI / VILLA ALBERTI, EU:T:2015:446, § 37

	<p>19/01/2009, R 1088/2008-2, EPCOS (fig.) / E epco SISTEMAS (fig.); confirmed 15/12/2010, T-132/09, Epcos, EU:T:2010:518</p>
<p>G&S: <i>measuring apparatus and instruments</i> in Class 9.</p> <p>Assessment: the mark was used for apparatus and parts thereof for the measurement of temperature, pressure and level. The contested decision considered that the original specification of the earlier mark for <i>measuring apparatus and instruments</i> was a 'very wide' one, and determined, applying the criteria established in the <i>Aladin</i> judgment, that use had in fact only been shown for a subcategory of goods, namely: <i>measuring apparatus, all being for the measurement of temperature, pressure and level; parts for the aforesaid apparatus.</i></p>	

Earlier sign	Case No
HEMICELL	20/09/2010, R 155/2010-2, HICELL (fig.) / HEMICELL
<p>G&S: foodstuffs for animals in Class 31, and animal foodstuffs, animal feed and non-medicated additives for animal feed; all included in Class 31.</p> <p>Assessment: the contested decision erred in considering that the earlier mark had been put to genuine use for foodstuffs for animals in Class 31, and animal foodstuffs, animal feed and non- medicated additives for animal feed; all included in Class 31, since this finding is contrary to the findings of the Court in <i>Aladin</i>. The reason given by the contested decision is not acceptable because it should have been tested whether or not the category of goods covered by the mark was susceptible of being divided into independent subcategories and whether the goods for which use of the earlier mark had been proven could be classified in one of those. Therefore, the Board considers that the TM is, deemed to be used in respect of additives for animal feed only in Class 31.</p>	

Pharmaceutical preparations

The purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. Thus, the *therapeutic indication* is the key for defining the relevant subcategory of pharmaceutical products. Other criteria (such as dosage form, active ingredients, whether it is sold on prescription or over the counter) are irrelevant in this regard.

The following subcategories for *pharmaceutical preparations* were assumed to be adequate by the General Court:

Case No	Adequate	Non-adequate
13/02/2007, T-256/04, Respicur	<i>Pharmaceutical preparations for respiratory illnesses.</i>	<i>Multi-dose dry powder inhalers containing corticoids, available only on prescription.</i>
23/09/2009, T-493/07, Famoxin	<i>Pharmaceutical preparations for cardiovascular illnesses.</i>	<i>Pharmaceutical preparations with digoxin for human use for cardiovascular illnesses.</i>
16/06/2010, T-487/08, Kremezin, EU:T:2010:237	<i>Pharmaceutical preparations for heart treatment.</i>	<i>Sterile solution of adenosine for use in the treatment of specific heart condition, for intravenous administration in hospitals.</i>

17/10/2006, T-483/04, Galzin, EU:T:2006:323	<i>Calcium-based preparations.</i>	<i>Pharmaceutical preparations.</i>
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Use of the mark as regards integral parts and after-sales services of the registered goods

In certain circumstances, use of the mark may be considered genuine also for ‘registered’ goods that had been sold at one time and were no longer available.¹⁶⁰

- This may apply where the proprietor of the trademark under which such goods had been put on the market sells parts that are integral to the make-up or structure of the goods previously sold.
- The same may apply where the trademark proprietor makes actual use of the mark for after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

Sign	Case No
Minimax	11/03/2003, C-40/01
<p>G&S: <i>fire extinguishers and associated products v components and after-sales services.</i></p> <p>Assessment: the authorisation for the fire extinguishers sold by Ansul under the Minimax trademark expired in the 1980s. Since then, Ansul has not been selling fire extinguishers under that mark. However, Ansul nonetheless sold component parts and extinguishing substances for fire extinguishers bearing the mark to undertakings with responsibility for maintaining them. During the same period, it also maintained, checked and repaired equipment bearing the Minimax mark itself, used the mark on invoices relating to those services and affixed stickers bearing the mark and strips bearing the words ‘Gebruiksklaar Minimax’ (Ready for use Minimax) to the equipment. Ansul also sold these stickers and strips to undertakings that maintain fire extinguishers.</p>	

However, this finding be interpreted **strictly** and applied only in very exceptional cases. In *Minimax*, the Court accepted use for goods other than those registered, which runs counter to the general rule laid down in the Law.

Use for the sale of the manufacturer’s own goods

Retail services in Class 35 are defined in the explanatory note of the Nice Classification as ... the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores, wholesale outlets, through vending machines, mail order catalogues or by means of electronic media, for example, through web sites or television shopping programmes.

It follows from that explanatory note that the concept of ‘retail services’ relates to **three essential characteristics**: firstly, the purpose of these services is the sale of goods to consumers; secondly, they are addressed to consumers with a view to enabling them to conveniently view and purchase the goods; and, thirdly, they are provided for the benefit of others.¹⁶¹ The ‘others’ benefiting from the ‘bringing together of a **variety** of goods’ are the various manufacturers looking for an outlet for their goods.

¹⁶⁰ 11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 40 et seq.

¹⁶¹ 04/03/2020, C-155/18 P, C-156/18 P, C-157/18 P & C-158/18 P, *BURLINGTON / BURLINGTON ARCADE et al.*, EU:C:2020:151, § 126

The objective of retail trade is the sale of goods to consumers. This includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question, rather than with a competitor. For example, the concept of 'retail services' includes a shopping arcade's services aimed at consumers with a view to enabling them to conveniently view and purchase the goods, for the benefit of the businesses occupying the arcade concerned. The Court has confirmed that services can also be the subject of retail trade as there are situations in which a trader selects and offers an assortment of third-party services so that the consumer can choose among those services from a single point of contact¹⁶².

In the same way that advertising one's own goods does not constitute use for advertising services in Class 35, there is no use for retail services in Class 35 where the manufacturer is merely selling its own goods from its shop or website. The sale by the manufacturer of its own goods is not an independent service but an activity covered by the protection conferred by registration for the **goods**. It would not be appropriate to equate the protection conferred by registration for goods in any of Classes 1 to 34 with that conferred by registration for Class 35 retail services. While manufacturers may provide ancillary services (such as maintaining an outlet with shop assistants, advertising, consultancy, after-sales services, etc.) in the course of the sale of their own goods, such activities fall within the concept of a remunerated 'service' only if they do not form an integral part of the offer for sale of the goods.¹⁶³ Consequently, if a manufacturer uses a trademark in relation to activities that form an integral part of the offer for the sale of its own goods, there is no use for retail services of such goods in Class 35.

Nor would such sales activity be in line with the definition of 'retail services' as provided in the explanatory note to the Nice Classification and interpreted by the Court, because it does not entail any benefit for third-party manufacturers. Therefore, an essential characteristic of retail services is missing.

Furthermore, genuine use must be consistent with the essential function of a trademark. The trademark used in relation to an outlet for the manufacturer's own goods serves to distinguish those **goods** from goods of other manufacturers but not to distinguish the **services** provided through that outlet from those provided through other outlets. Manufacturers selling their own goods from their own shops compete on the market of the **goods** they are selling but do not compete on the **retail services** market, which targets third-party manufacturers. Operating a shop **exclusively** for the purpose of selling the manufacturer's own goods excludes offering competing goods from third-party manufacturers.

However, genuine use for retail services should not be denied if the respondent, when bringing together goods offered by third parties, includes, in addition to goods offered by other traders, goods that it itself manufactures.

2.2.5 Use by the proprietor or on its behalf

It is in general the owner who has to put the registered mark to genuine use. However, according to Article 25 of the Law, use of the mark with the consent of the proprietor is deemed to constitute use by the proprietor. This means that the owner must have given its consent **prior** to the use of the mark by the third party. Acceptance later is insufficient.

A typical case of use by third parties is use made by **licensees**. Use by companies **economically related** to the trademark proprietor, such as members of the same group of companies (affiliates, subsidiaries, etc.) is similarly to be considered as authorised use. Where

¹⁶² 10/07/2014, C-420/13, Netto Marken-Discount, EU:C:2014:2069, § 34

¹⁶³ 10/07/2014, C-421/13, Apple Store, EU:C:2014:2070, § 26

goods are produced by the trademark proprietor (or with its consent), but subsequently placed on the market by **distributors** at wholesale or retail level, this is to be considered as use of the mark.¹⁶⁴

Collective marks are generally used not by the proprietor association but rather by its members.

2.2.6 Legal use

Whether a mark has been used in a way that satisfies the use requirements of Article 24 of the Law requires a factual finding of genuine use. Use will be 'genuine' in this context even if the user violates legal provisions.

Use that is **deceptive** within the meaning of Article 4(1)(h) of the **Law** remains 'genuine' for the purpose of asserting earlier marks in revocation proceedings.

The same principle applies where use is made under an illegal licensing arrangement (for example arrangements violating the competition). Similarly, the fact that use may infringe third-party rights is also irrelevant.

2.2.7 Justification for non-use

The opponent may alternatively prove that there are justifiable reasons for non-use of its registered mark. These reasons cover, as mentioned in the second sentence of Article 19(1) of the TRIPS agreement, circumstances arising independently of the will of the owner of the trademark that constitute an obstacle to the use of the trademark.

As an exception to the obligation of use, the concept of proper reasons for non-use is to be interpreted rather narrowly.

'Bureaucratic obstacles' as such, that arise **independently of the will** of the trademark proprietor, are not sufficient, unless they have a **direct relationship** with the mark, so much so that use of the trademark depends on successful completion of the administrative action concerned. However, the criterion of a direct relationship does not necessarily imply that use of the trademark is impossible; it might suffice that use is **unreasonable**. It must be assessed on a case-by-case basis whether a change in the undertaking's strategy to circumvent the obstacle under consideration would make use of the mark unreasonable. Thus, for example, the proprietor of a mark cannot reasonably be required to change its corporate strategy and sell its goods in its competitors' sales outlets.¹⁶⁵

2.2.7.1 Business risks

The concept of proper reasons must be considered to refer to circumstances arising independently of the will of the owner that make use of the mark impossible or unreasonable, rather than to circumstances associated with commercial difficulties it is experiencing.¹⁶⁶

Thus, financial difficulties encountered by a company as a result of an economic recession or due to its own financial problems are not considered to constitute proper reasons for non-use within the meaning of Article 27(3) of the **Law**, as these kinds of difficulties constitute a natural part of running a business.

¹⁶⁴ 17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 32; 16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 73

¹⁶⁵ 14/06/2007, C-246/05, Le Chef de Cuisine, EU:C:2007:340, § 52

¹⁶⁶ 14/05/0008, R 855/2007-4, PAN AM, § 27; 09/07/2003, T-156/01, Giorgio Aire, EU:T:2003:198, § 41; 18/03/2015, T-250/13, SMART WATER, EU:T:2015:160, § 67-69

2.2.7.2 Government or court intervention

Import restrictions or other government requirements are two examples of proper reasons for non-use that are explicitly mentioned in the second sentence of Article 19(1) of the TRIPS agreement.

Import restrictions include a trade embargo affecting the goods protected by the mark.

Other **government requirements** can be a state monopoly, which impedes any kind of use, or a state prohibition of the sale of goods for reasons of health or national defence. Typical cases in this respect are regulatory procedures such as:

- clinical trials and authorisation for new medicines; or
- the authorisation of a food safety authority, which the owner has to obtain before offering the relevant goods and services on the market.

Registered TM	Case No
HEMICELL	20/09/2010, R 155/2010-2, HICELL (fig.) / HEMICELL
The evidence submitted by the opponent duly shows that use of the mark for a food additive, namely, <i>zootechnical digestibility enhancer (feed enzyme)</i> was conditional upon prior authorisation, to be issued by the European Food Safety Authority following an application filed before that body. Such a requirement is to be deemed a government requirement in the sense of Article 19(1) TRIPS.	

With regard to Court proceedings or interim injunctions, the following must be differentiated:

On the one hand, the mere threat of litigation or a pending cancellation action against the earlier mark should not exempt the opponent from the obligation to use its trademark in the course of trade. It is up to the trademark holder, to conduct an adequate risk assessment of its chances to prevail in the litigation proceedings and to draw the appropriate conclusions from this evaluation as to whether or not to continue with use of its mark.¹⁶⁷

Registered TM	Case No
HUGO BOSS	09/03/2010, R 764/2009-4, HUGO BOSS / BOSS
The national [French cancellation] proceedings brought against the opposing trademark cannot be acknowledged as a proper reason for non-use (para. 19).	
The fact remains that proper reasons for non-use are only those outside the sphere and influence of the trademark proprietor, for instance national authorisation requirements or import restrictions. These are neutral with regard to the trademark to be used; they concern not the trademark but the goods and services that the proprietor wishes to use. Such national authorisation requirements or import restrictions apply to the type or properties of the product to which the trademark is affixed and cannot be circumvented by choosing a different trademark. In the present case, conversely, the trademark proprietor could have readily manufactured cigarettes in France or imported them into France if it had chosen a different trademark (para. 25).	

On the other hand, for example, an interim injunction or a restraining court order in insolvency proceedings, imposing a general prohibition of transfers or disposals on the trademark owner,

¹⁶⁷ 18/02/2013, R 1101/2011-2, SMART WATER, § 40; 18/03/2015, T-250/13, SMART WATER, EU:T:2015:160

can be a proper reason for non-use because it obliges the opponent to refrain from using its mark in the course of trade.

2.2.7.3 Force majeure

Further justifiable reasons for non-use are cases of *force majeure* that hinder the normal functioning of the owner's enterprise.

2.2.7.4 Consequences of justification of non-use

The existence of justified reasons does not mean that non-use during the period concerned is treated as equivalent to actual use, which would result in a new grace period beginning after the end of the period of justified non-use.

Rather, non-use during such period merely stops the 5-year period from running. This means that the period of justified non-use is not taken into account in calculating the grace period of 5 years.

In addition, the length of time during which justified reasons existed may be significant. Reasons for non-use existing during only part of the relevant 5-year-period may not always be considered justification for setting the proof-of-use requirement aside. In this context, the period of time during which these reasons were pertinent and the elapse of time since they no longer applied are of particular importance.

2.2.8 Overall assessment of the evidence presented

The Court evaluates the evidence submitted with regard to place, time, extent and nature of use in an **overall assessment**. A separate assessment of the various relevant factors, each considered in isolation, is not suitable.¹⁶⁸

The **principle of interdependence** applies, meaning that weak evidence with regard to one relevant factor (e.g. low sales volume) might be compensated by solid evidence with regard to another factor (e.g. continuous use over a long period of time).

All the circumstances of the specific case have to be taken into account **in conjunction with each other** in order to determine whether the mark in question has been genuinely used. The particular circumstances can include, for example, the specific features of the goods/services in question (e.g. low- or high-priced; mass products versus special products) or the particular market or business area.

Indirect/circumstantial evidence, under certain conditions even on its own, can also be suitable for proving genuine use.

As the Court does not assess commercial success, even minimal use (but not mere token or internal use) can be sufficient to be deemed 'genuine', as long as it is viewed as warranted in the economic sector concerned to maintain or acquire a share in the market.

2.2.8.1 Examples

The following cases present some of the decisions of EUIPO and European Court (with different outcomes) where the overall assessment of the submitted evidence was important.

Genuine use accepted

¹⁶⁸ 17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 31

Case No	Comment
17/02/2011, T-324/09, Friboi, EU:T:2011:47	The respondent (Fribo Foods Ltd.) submitted several invoices relating to large quantities of goods, addressed to its distribution company (Plusfood Ltd.), which belongs to the same group (Plusfood Group). It is not disputed that the distribution company put the products on the market later. Furthermore, the opponent presented undated brochures, a press clip and three price lists. With regard to the 'internal' invoices, the Court held that the producer-distributor-market chain was a common method of business organisation, which could not be regarded as purely internal use. The undated brochures had to be seen in conjunction with other dated evidence such as invoices and price lists and, therefore, might still be taken into consideration. The Court accepted genuine use and stressed that an overall assessment implied that all the relevant factors be viewed as a whole and not in isolation.
02/05/2011, R 872/2010-4, CERASIL / CERATOSIL	The respondent submitted inter alia about 50 invoices, not in the language of proceedings. The names of the addressees as well as the quantities sold were blacked out. The Boards held that standard invoices containing the usual information (date, indication of seller's and buyer's name/ address, product concerned, price paid) did not require a translation. Even though the names of the addressees and the quantities sold were blacked out, the invoices nevertheless confirmed the sale of 'CERATOSIL' products, measured in kilograms, to companies throughout the relevant territory during the relevant period. Together with the remaining evidence (brochures, affidavit, articles, photographs), this was considered sufficient to prove genuine use.
29/11/2010, B 1 477 670	The respondent, which was active in the field of vehicle maintenance and the management of businesses associated with buying and selling vehicles, provided several Annual Reports giving a general overview of its overall commercial and financial activities. The OD found that these reports, by themselves, did not provide sufficient information on actual use for the majority of services claimed. However, in conjunction with advertisements and publicity displaying the mark in question for particular services, the OD concluded that the evidence as a whole provided sufficient indications as to the scope, nature, period and place of use for these services.
29/11/2010, R 919/2009-4, GELITE / GEHOLIT	The documents submitted by the appellant showed use of the trademark for 'coating materials based on artificial resin (base, intermediate and top coatings) and industrial lacquers'. The attached labels showed use of the trademark for various base, primer and top coatings. This information coincided with the attached price lists. The associated technical information sheets described the goods as corrosion coatings based on artificial resin, which are offered for sale in various colours. The attached invoices showed that these goods were supplied to various customers in Germany. Although the turnover figures stated in the written declaration in relation to the period from 2002 to 2007 did not expressly refer to Germany, it had to be concluded that they were obtained at least in part also in Germany. Consequently, the earlier mark was deemed to be used for the goods <i>lacquer, lacquer paints, varnishes, paints; dispersions and emulsions to coat and repair surfaces</i> because it was not possible to create any further subcategories for these goods.
20/04/2010, R 878/2009-2, SOLEA / Balea	The solemn declaration refers to high sales figures (over EUR 100 million) for marked products from 2004 to 2006 and attaches internet extracts of pictures of the products sold during the relevant period (<i>soap, shampoo, deodorant (for feet and body), lotions, and cleaning items</i>). Although the internet extracts bear a copyright date of 2008, the credibility of what the declaration affirms is reinforced by the judgment of the State Court of Mannheim, a copy of which had been adduced previously by the opponent in order to demonstrate the enhanced distinctiveness of the earlier mark and which referred to the market share enjoyed by products bearing the opponent's mark for ladies' face care products (6.2 %), caring lotions (6.3 %), shower soaps and shampoos (6.1 %) and men's face care and shaving products (7.9 %). Moreover, the judgment states that, according to a GfK study, one fifth of German citizens purchase at least one BALEA product per annum. Reference is also made to two further studies that demonstrate that the brand is well known in Germany. Thus, proof of use for the mark has been demonstrated sufficiently for the products on which the opposition is based.

<p>25/03/2010, R 1752/2008-1, ULUDAG / BURSA uludağ (fig.)</p>	<p>The evidence provided to substantiate use of the earlier Danish trademark appears to be sufficient. The Board is satisfied that the invoice provided shows place and time of use, as it proves the sale to a Danish company of 2 200 cartons of products within the relevant date. The labels submitted show use on soft drinks bearing the mark as represented on the registration certificate. As to the question whether proof consisting of one single invoice is sufficient in terms of extent of use, the content of that invoice, in the context of the remaining pieces of evidence, serves, in the Board's view, to conclude that the use made of the mark in Denmark is sufficient and genuine in connection with <i>aerated water, aerated water with fruit taste and soda water</i>.</p>
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Genuine use not accepted

Case No	Comment
<p>18/01/2011, T-382/08, Vogue, EU:T:2011:9</p>	<p>The opponent submitted a declaration from the opponent's managing partner and 15 footwear manufacturers that footwear had been produced for the opponent under the trademark VOGUE over a number of years, 35 photographs of VOGUE footwear models, photographs of stores and 670 invoices issued to the opponent by footwear manufacturers. The Court held that the declarations did not provide sufficient evidence concerning the extent, place and time of use. The invoices concerned the sale of footwear to the opponent, not the sale of footwear to end consumers and, therefore, were not suitable for proving external use. Mere presumptions and suppositions ('highly unlikely', 'unreasonable to think', '... which probably explains the absence of invoices ...', 'reasonable to assume', etc.) cannot replace solid evidence. Therefore, genuine use was denied.</p>
<p>19/09/2007, 1359 C; confirmed 09/09/2008, R 1764/2007-4, PAN AM II</p>	<p>The owner of the mark owned a US-based airline, operating solely in the US. The fact that flights could also be booked via internet from the European Union could not alter the fact that the actual services of transportation (Class 39) were rendered exclusively outside the relevant territory. Furthermore, the lists submitted of passengers with addresses in the European Union could not prove that the flights had actually been booked from Europe. Finally, the website was exclusively written in English, the prices were in US dollars and the relevant telephone and fax numbers were from within the US. Therefore, genuine use in the relevant territory was denied.</p>
<p>08/06/2010, R 1076/2009-2, EURO CERT (fig.)/ EUROCERT</p>	<p>It is well established in the case-law that a declaration, even if sworn or affirmed in accordance with the law under which it is rendered, must be corroborated by independent evidence. The declaration in this case, drawn up by an employee of the opponent's company, contains an outline of the nature of the relevant services, but only general statements concerning trade activities. It contains no detailed sales or advertising figures or other data that might show the extent and use of the mark. Furthermore, a mere three invoices with important financial data blanked out and a list of clients can hardly be considered corroborative evidence. Therefore, no genuine use of the earlier mark has been demonstrated.</p>
<p>01/09/2010, R 1525/2009-4, OFFICEMATE / OFFICEMATE (fig.)</p>	<p>The spreadsheets with turnover figures and the Analysis and Review reports concerning sales figures are documents drawn up by or commissioned by the appellant itself and, therefore, have less probative value. None of the evidence submitted contains any clear indication concerning the place of use of the earlier mark. The spreadsheets and the Analysis and Review Reports, which contain data compiled on the total value of estimated sales (in SEK) between the years 2003 to 2007, contain no information on where the sales took place. There is no reference to the territory of the European Union, where the earlier trademark is registered. The invoices do not cover any sales of goods made by the appellant. Therefore, the evidence submitted is clearly insufficient to prove genuine use of the earlier mark.</p>
<p>12/12/2002, T-39/01, HIWATT, EU:T:2002:316</p>	<p>A catalogue showing the mark on three different models of amplifiers (but not indicating place, time or extent), a catalogue of the Frankfurt International trade fair showing that a company called HIWATT Amplification International exhibited at that fair (but not indicating any use of the trademark) and a copy of the 1997 HIWATT Amplification Catalogue showing the mark on different models of amplifiers (but not indicating place or extent of use) were not considered sufficient to prove genuine use, principally because of lack of extent of use.</p>

2.3 Trademark becoming a common name (generic term) — Article 27(2)(b) of the **Law**

A trademark will be revoked if, ~~as a result of action or inaction on the part of the proprietor~~, it has become the common name in the trade for a product or service for which it was registered.

2.3.1 Burden of proof

The burden is on the claimant to prove that the term has become the common name in the trade.

The Court will examine the facts within the scope of factual submissions made by the claimant. In doing so, it may take into consideration obvious and well-known facts. However, it will not go beyond the legal arguments submitted by the claimant.

2.3.2 Point in time to be considered

The claimant must prove that the trademark has become the common name in the trade for the product or service in question after the date of registration of the trademark, although facts or circumstances that took place between application and registration can be taken into account. The fact that the sign was, at the date of application, the common name used in the trade for the goods or services in respect of which registration was sought would only be relevant in the context of an invalidity action.

2.3.3 Relevant public

A trademark is liable to be revoked in accordance with Article 27(2)(b) of the **Law** if it has become the common name for the product or service not just among some but among the vast majority of the relevant public, including those involved in the trade for the product or service in question. Whether a trademark has become the common name in the trade for a product or service in respect of which it is registered must be assessed not only in the light of the perception of consumers or end users but also depending on the features of the market concerned, in the light of the perception of those in the trade, such as sellers. However, in some specific circumstances, it might be sufficient that the sellers of the finished product do not inform their customers that the sign has been registered as a trademark and do not offer their customers assistance at the time of sale, which includes an indication of the origin of the goods for sale.¹⁶⁹

2.3.4 Common name

A sign is regarded as the 'common name in the trade' if it is established practice in the trade to use the term in question to designate the goods or services for which it is registered (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 5, Customary Signs or Indications). It is not necessary to prove that the term directly describes a quality or characteristic of the goods or services, but merely that it is actually used in the trade to refer to those goods or services. The distinctive force of a trademark is always more likely to degenerate when a sign is suggestive or apt in some way, especially if it has positive connotations that lead others to latch on to its suitability for designating not just a particular producer's product or service but a particular type of product or service.

The fact that a trademark is being used as the common name to refer to a specific product or service is an indication that it has lost its ability to differentiate the goods or services in question

¹⁶⁹ 06/03/2014, C-409/12, Kornspitz, EU:C:2014:130, § 23-25, 30

from those of other undertakings. One indication that a trademark has become generic is when it is commonly used verbally to refer to a particular type or characteristic of the goods or services. However, this is not in itself decisive: it must be established whether the trademark is still capable of differentiating the goods or services in question from those of other undertakings.

The absence of any alternative term or the existence of only one long, complicated term may also be an indication that a sign has become the common name in the trade for a specific product or service.

2.3.5 Defense for the proprietor

Where the proprietor of the trademark has done what could reasonably have been expected in the particular case (e.g. organised a TV campaign or placed advertisements in newspapers and relevant magazines), the trademark cannot be revoked. The proprietor must then check whether its trademark appears in dictionaries as a generic term; if it does, the proprietor can request from the publisher that in future editions the trademark will be accompanied by an indication that it is a registered trademark (Article 8 of the **Law**).

2.4 Trademark becoming misleading — Article 27(2)(c) of the **Law**

If, as a result of use made of the mark by the proprietor or with its consent, the mark is liable to mislead the public, particularly concerning the nature, quality or geographical origin of the goods or services for which it is registered, the trademark can be revoked. In this context, quality refers to a characteristic or attribute rather than a degree or standard of excellence.

2.4.1 Burden of proof

The Court will examine the facts within the scope of factual submissions made by the claimant. In doing so, it may take into consideration obvious and well-known facts. However, it will not go beyond the legal arguments submitted by the applicant for revocation.

The burden of proof that the mark has become misleading rests on the claimant, who must further prove that it is the use made by the proprietor that causes the misleading effect. If the use is made by a third party, the burden is on the claimant to prove that the proprietor has consented to that use, unless the third party is a licensee or official distributor/dealer of the proprietor.

2.4.2 Point in time to be considered

The claimant must prove that the trademark has become liable to mislead the public, particularly concerning the nature, quality or geographical origin of the goods or services in question, after the date of registration of the trademark. If the sign was already deceptive or liable to deceive the public at the date of application, this would be relevant in the context of an invalidity action.

2.4.3 Standards to be applied

The Guidelines contain details of the criteria to be applied when assessing whether a trademark application complies with Article 4(1)(h) of the **Law** (see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 8, Deceptive Trademarks (Article 4(1)(h) of the **Law**). The criteria are comparable to those applied in revocation proceedings under Article 27(2)(c) of the **Law**.

2.4.4 Examples

A trademark composed of, or containing, a geographical indication will, as a rule, be perceived by the relevant public as a reference to the place from where the goods originate. The only exception to this rule is where the relationship between the geographical name and the products is manifestly so fanciful (e.g. because the place is not known, and unlikely to become known, to the public as the place of origin of the goods in question) that consumers will not make such a connection.

In this regard, the trademark MÖVENPICK OF SWITZERLAND was revoked because the goods in question were produced (according to the facts) solely in Germany, not in Switzerland.

Moreover, where a trademark containing the word elements 'goats' and 'cheese' and a figurative element clearly depicting a goat is registered for 'goats' cheese', and use is proven for cheese not made from goats' milk, the trademark will be revoked.

Where a trademark containing the word elements 'pure new wool' is registered for 'clothing' and use is proven for clothing manufactured from artificial fibres, the trademark will be revoked.

Where a trademark containing the words 'genuine leather' or the corresponding pictogram is registered for 'shoe wear' and use is proven for shoes not made of leather, the trademark will be revoked.

By the Decision of Tbilisi City Court (27.11.2019, N2/21348-18) trademarks consisting of the verbal element 'Stolichnaya' were revoked as they were considered to be misleading as to the geographical origin of the product due to the particular manner of the use of contested sign and the history of the trademark itself. The Court held that, trademark may not contain direct indication to the geographical origin of the product but still mislead the consumer as to the origin of the product. Accordingly, the Court found that trademark 'Stolichnaya' was misleading for Georgian relevant public (general consumer) as it was perceived as a product originating from Russian Federation due to the following reasons:

- The trademark 'Stolichnaya' has been used for decades in Soviet times for the alcoholic beverages produced in Russian federation.
- On several contested trademarks additional verbal element – 'Russian vodka' was indicated.
- The holder of the trademark registrations did not take any reasonable action to inform the consumer about the true geographical origin of the product (Latvia).
- According to the survey results, vast majority of the public still believes that the vodka under the trademark Stolichnaya is produced in Russia.

3 Grounds for Invalidity

3.1 Introduction

According to Article 28 of the **Law**, trademark registration may be invalidated by the court if:

- a) the trademark is registered in violation of requirements of Articles 4 (absolute grounds for refusal) or 5 (relative grounds for refusal) of the **Law**;
- b) the trademark has been registered in bad faith;
- c) the trademark has been registered in a member state of the Paris Convention by a representative or agent of the trademark holder in his/her own name, without the consent of the trademark holder;
- d) the trademark contains the company name for which the rights are obtained before the filing of the application for the trademark registration, as a result of which a likelihood of confusion arises; e) trademark registration violates the copyright of a third party, obtained before the priority date established for the contested trademark.

3.1.1 Standards to be applied

3.1.1.1 Absolute grounds for refusal (Article 4 of the **Law**)

The Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, contain details of the criteria to be applied when assessing whether a trademark application complies with Article 4 of the **Law**. The criteria are identical to those applied in invalidity proceedings under Article 28(1)(a) of the **Law**.

Defence against a claim of lack of distinctiveness or misleading of consumer

~~A trademark that falls foul of Articles 4(1)(c), 4(1)(d), 4(1)(e), 4(1)(f) and 4(1)(h) will not be declared invalid where it has acquired distinctiveness through use (Article 4(3)).~~

~~The proprietor of the contested mark is best placed to adduce evidence in support of the assertion that its mark has acquired a distinctive character following the use which has been made of it (e.g. concerning the intensity, geographical extent, duration of use, promotional investment). Consequently, where the proprietor of the contested mark invokes the distinctive character acquired through use, but fails to adduce evidence thereof, the mark must be declared invalid (19/06/2014, joined cases C-217/13 & C-218/13, Oberbank e.a, EU:C:2014:2012, § 68-71).~~

~~The Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 14, Acquired Distinctiveness Through Use (Article 4(3) of the Law), contain details of the criteria to be applied when assessing whether contested TM has acquired distinctiveness through use.~~

~~The proprietor must prove that the trademark has acquired distinctive character at the latest by the date of filing lawsuit of invalidity.~~

~~Therefore, evidence of acquired distinctiveness (i) by the application date of the TM (or the date of priority where applicable), (ii) between the application date of the TM (or the date of priority where applicable) and the date of registration, and (iii) between the date of registration and the date of filing lawsuit of invalidity are all relevant.~~

3.1.1.2 Relative grounds for invalidation (article 5 and paragraphs (b)—(e) of article 28(1) of the **Law**)

The substantive conditions for considering an earlier right as a relative ground for a declaration of invalidity are the same as in opposition proceedings. The practice rules in the Guidelines, Part B, Examination, in particular Section 5, Double Identity and Likelihood of Confusion; Section 3, Rights under Article 5(e) of the **Law**; and Section 5, Trademarks with Reputation (Article 5(g) of the **Law**) should be applied accordingly.

3.1.2 Points in time to be considered

3.1.2.1 Absolute grounds for refusal (article 4 of the **Law**)

Whether a trademark should be registered or should be declared invalid must be assessed on the basis of the situation at the date of its application, not of its registration.¹⁷⁰

Generally speaking, any developments or events after the date of application or priority date will not be taken into consideration. For example, the fact that a sign has after the date of

¹⁷⁰ 03/06/2009, T-189/07, Flugbörse, EU:T:2009:172; confirmed by 23/04/2010, C-332/09 P, Flugbörse, EU:C:2010:225

application, become the common term used in the trade for the goods or services for which registration was sought is in principle irrelevant for the purposes of examining an invalidity action (it would only be relevant in the context of a revocation action). However, such facts subsequent to the date of application can nevertheless be taken into account where and to the extent that they allow conclusions to be drawn regarding the situation at the date of application for the trademark. This might be the case, for example, with dictionary extracts that post-date the application date. Unless rapid development of linguistic usage or living conditions (in the sense of social or technical 'trends') has taken place after the date of application, words will usually only be listed in dictionaries if their actual use and meaning has been established over a considerable period of time.¹⁷¹

~~Exception to the mentioned rule is shown in paragraph 3.3.1.1 above~~

3.1.2.2 For the assessment of enhanced distinctiveness or reputation

In opposition or invalidity proceedings a claimant relying on enhanced distinctiveness or reputation must prove that its earlier right has acquired **enhanced distinctiveness or reputation** by the **filing** date of the contested trademark, taking account, where appropriate, of any priority claimed. In addition, the reputation or the enhanced distinctive character of the earlier mark must still exist when the **decision on invalidity is taken**.

In opposition proceedings, due to the short time span between the filing of the trademark application and the opposition decision, it is normally presumed that the enhanced distinctiveness or reputation of the earlier trademark still exists at the time of the decision (see the Guidelines, Part B, Examination, Section 5, Sub-section 3, Trademarks with Reputation). In invalidity proceedings, however, the time span can be considerable. In this case, the claimant must show that its earlier right continues to enjoy enhanced distinctive character or reputation at the time the decision on invalidity is taken.

3.1.2.3 Relative grounds for invalidation (article 5 and paragraphs (b)—(e) of article 28(1) of the **Law**)

In the event of a lawsuit for invalidity based on Article 5 and paragraphs (b)—(e) of article 28(1) of the **Law**, the claimant must show that registration of earlier sign or where appropriate the earlier sign's **use in the course of trade of more than local significance** took place by the **filing date** of the contested trademark (or the priority date if relevant). In **invalidity proceedings**, the applicant also has to prove that the sign was used in the course of trade of more than local significance at another point in time, namely **at the time of filing of the invalidity request**.

3.2 Trademark registered contrary to Article 4 and 5 of the **Law**

In invalidation proceedings based on violation of requirements of articles 4 and 5 of the **Law** principles laid down in Guidelines, Part B, Examination, Section 4 Absolute grounds for refusal and Section 5 Relative grounds for refusal apply.

3.2.1 ~~Non-use of the earlier mark~~

~~According to Article 00 of the Law, where the **earlier mark has been registered for 5 years or more** when the claim for declaration of invalidity is filed, the proprietor of the TM may request that the proprietor of the earlier mark submit proof that the earlier mark has been put to genuine use in Georgia in connection with the goods or services for which it is registered or that proper reasons for non-use exist.~~

¹⁷¹ 25/11/2015, T-223/14, VENT ROLL, EU:T:2015:879, § 39

~~The indications and evidence of use must establish the place, time, extent and nature of use of the earlier trademark for the goods and services for which it is registered and on which the lawsuit for a declaration of invalidity is based.~~

~~The practice rules applicable to the **substantive assessment** of proof of use of earlier rights in opposition proceedings are applicable to the assessment of proof of use in invalidity proceedings (see the Guidelines, Part D, Cancellation, Section 6, Proof of Use, paragraph 2). In particular, when the TM proprietor requests proof of use of the earlier rights, court will examine whether, and to what extent, use has been proved for the earlier marks, provided this is relevant for the outcome of the decision.~~

~~Finally, there is a particularity to be taken into account in the assessment of proof of use in the context of invalidity proceedings. It regards the **relevant time of use**. There are two relevant periods during which use has to be established.~~

- ~~• The first relevant period applies in all cases where the earlier trademark had been registered for more than 5 years prior to the lawsuit for invalidity: the period of 5 years preceding the date of filing of the lawsuit for a declaration of invalidity (first relevant period).~~
- ~~• Additionally, in cases where the earlier trademark had been registered for at least 5 years, in the case of a contested TM, on the date of filing or, where applicable, priority, and, in the case of a contested international registration designating Georgia, on the date of international registration (INID code 151) or subsequent designation (INID code 891), or, as the case may be, the date of priority (INID code 300) of the contested international registration: the period of 5 years preceding that date (second relevant period).~~

~~These two relevant periods do not necessarily overlap: they may totally or partially overlap or follow on from each other (with or without a gap). In the event of an overlap in the periods, proof of use of the earlier mark relating to the period of overlap can be taken into account for each of the two relevant periods (29/11/2018, C-340/17 P, Alcolock, EU:C:2018:965, § 84).~~

3.3 *Bad faith* — Article 28(1)(b) of the **Law**

The bad faith is the ground for the **invalidity** of a trademark registration according to article 28(1)(b) of the **Law**. Invalidation of registration of trademark based on mentioned ground may be considered only by civil court of Georgia. Respondent in the invalidation proceedings is the owner of the TM registration.

3.3.1 Relevant point in time

The relevant point in time for determining whether there was bad faith on the part of the trademark owner is the **time of filing of the application for registration**. However, the following must be noted:

- Facts and evidence dated prior to filing can be taken into account for interpreting the owner's intention at the time of filing the trademark. These facts may include, inter alia, whether there is already a registration of the mark in another jurisdiction, the circumstances under which that mark was created and the use made of it since its creation.
- Facts and evidence dated subsequent to filing can sometimes be used for interpreting the owner's intention at the time of filing the trademark, in particular whether the owner has used the mark since registration.

3.3.2 Concept of bad faith

The concept of bad faith, it is not defined, delimited or even described in any way in the legislation.

It can be defined as a 'conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices'.¹⁷²

Article 28(1)(b) of the **Law** meets the general interest objective of preventing trademark registrations that are abusive or contrary to honest commercial and business practices.

The ground of bad faith applies where it is apparent from relevant and consistent indicia that the proprietor of a trademark filed its application for registration not with the aim of engaging fairly in competition, but with the intention of undermining the interests of third parties, in a manner inconsistent with honest practices, or with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trademark, in particular the essential function of indicating origin.¹⁷³

In order to find out whether the owner had been acting in bad faith at the time of filing the application, an **overall assessment** must be made in which all the relevant factors of the individual case must be taken into account.¹⁷⁴ A **non-exhaustive** list of these factors is given below.

3.3.2.1 Factors likely to indicate the existence of bad faith

According to the practice three factors below are relevant to indicate the existence of bad faith:

1. Identity or similarity of the signs: the fact that the trademark allegedly registered in bad faith is identical or similar to a sign to which the claimant refers may be significant for finding bad faith. Although there is identity or similarity with an earlier sign in many cases where bad faith is found, likelihood of confusion is not a prerequisite of bad faith.¹⁷⁵ Finally, identity or similarity of the signs is not in itself sufficient to show bad faith.

2. Knowledge of the use of an identical or similar sign: the fact that the trademark owner knew or should have known about the use of an identical or similar sign by a third party for identical or similar products or services may also be significant. There is knowledge, for example, where the parties have been in a business relationship with each other and, as a result thereof, 'could not ignore, and was probably aware that the claimant had been using the sign for a long time', when the reputation of the sign, even as a 'historical' trademark, is a well-known fact, or when the identity or quasi-identity between the contested mark and the earlier signs 'manifestly cannot be fortuitous'. Knowledge **may be presumed to exist** ('must have known') on the basis, inter alia, of general knowledge in the economic sector concerned or of the duration of use. The longer the use of a sign, the more likely it is that the trademark owner had knowledge of it.¹⁷⁶ Depending on the circumstances of the case, this presumption may apply even if the sign was registered outside Georgia.

However, knowledge of an identical or similar earlier sign for identical or similar goods or services is **not sufficient in itself** to support a finding of bad faith¹⁷⁷. It always depends on the circumstances of the case.

Similarly, the fact that the holder of the contested trademark knows or should know that, at the time of filing of its application, a third party is **using a mark abroad** that is liable to be confused with the mark whose registration has been applied for is not sufficient, **in itself**, to permit the conclusion that the applicant is acting in bad faith.

¹⁷² Opinion of Advocate General Sharpston of 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:148, § 60

¹⁷³ 12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, § 46

¹⁷⁴ Preliminary ruling of 27/06/2013, C-320/12, Malaysia Dairy, EU:C:2013:435, § 37

¹⁷⁵ 12/09/2019, C-104/18 P, STYLO & KOTON (fig.), EU:C:2019:724, § 51

¹⁷⁶ 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 39

¹⁷⁷ 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 40, 48-49

Knowledge or presumption of knowledge of an existing sign is not required where the trademark owner misuses the system with the intention of preventing **any** similar sign from entering the market (see, for example, the artificial extension of the grace period for non-use in paragraph 3(e) below).

3. Dishonest intention on the part of the trademark owner: this is a subjective factor that has to be determined by reference to objective circumstances. Again, several factors can be relevant. See, for example, the following case scenarios:

a. Bad faith exists where applications for trademarks are diverted from their initial purpose and filed speculatively or solely with a view to obtaining financial compensation.

b. Bad faith is found when it can be inferred that the purpose of the trademark applicant is to 'free-ride' on the reputation of the invalidity applicant or on its registered marks and to take advantage of that reputation, even if those marks have lapsed

c. The absence of any intention to use a trademark for some or all of the goods and services applied for constitutes bad faith in respect thereof if the Trademark holder acted with the intention of undermining the interest of third parties in a manner inconsistent with honest practices or — without even targeting a specific third party — of obtaining an exclusive right for purposes other than those falling within the functions of a trademark. When the absence of any intention to use a trademark in accordance with the essential functions of a trademark concerns only certain goods or services referred to in the application for registration, that application constitutes bad faith only insofar as it relates to those goods or services.¹⁷⁸ However, if there is some commercial logic to the filing of the trademark and it can be assumed that the trademark owner did intend to use the sign as a trademark for the goods for which protection was sought, this would tend to indicate that there was no dishonest intention. For example, this could be the case if the trademark owner had a commercial incentive to protect the mark more widely, for example an increase in the number countries in which the owner generates turnover from goods marketed under the mark.¹⁷⁹

d. The existence of a direct or indirect relationship between the parties prior to the filing of the trademark, for example a pre-contractual, contractual or post-contractual (residual) relationship, can also be an indicator of bad faith on the part of the trademark owner.¹⁸⁰ The trademark owner's registration of the sign in its own name in such cases can depending on the circumstances, be considered a breach of honest commercial and business practices.

e. Bad faith can be found where a trademark owner tries to artificially extend the grace period for non-use, for example by filing a repeat application of an earlier trademark in order to avoid the loss of a right as a result of non-use. This case needs to be distinguished from the situation in which the trademark owner, in accordance with normal business practice, seeks to protect variations of its sign, for example, where a logo has evolved.

f. Bad faith has also been found where the trademark owner makes a successive chain of applications for registration of trademarks, designed to grant it a blocking position for a period exceeding the 6-month period of reflection provided for by Article 11 of the **Law** and even the 5-year grace period provided for by Article 27(2)(a) of the **Law**.

¹⁷⁸ 29/01/2020, C-371/18, SKY, EU:C:2020:45, § 81; 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 44; 07/07/2016, T-82/14, LUCEO, EU:T:2016:396, § 126

¹⁷⁹ 14/02/2012, T-33/11, Bigab, EU:T:2012:77, § 20, 23

¹⁸⁰ 01/02/2012, T-291/09, Pollo Tropical chicken on the grill, EU:T:2012:39, § 85-87; 11/07/2013, T-321/10, Gruppo Salini, EU:T:2013:372, § 25-32

g. A request for financial compensation made by the trademark owner to the claimant may lead to a finding of bad faith if there is evidence that the trademark owner knew of the existence of the earlier identical or similar sign and expected to receive a proposal for financial compensation from the claimant.

In addition to the abovementioned factors, **other potentially relevant factors** identified are listed here:

1. The circumstances under which the contested sign was created, the use made of it since its creation, the commercial logic underlying the filing of the application for registration of that sign as a trademark and the chronology of events leading up to that filing.¹⁸¹
2. The nature of the mark registered. Where registered sign consists of the entire shape and presentation of a product, the fact that the trademark owner was acting in bad faith at the time of filing might more readily be established where the competitor's freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, with the result that the trademark owner is able to prevent its competitors not merely from using an identical or similar sign, but also from marketing comparable products.¹⁸²
3. The degree of inherent or acquired distinctiveness enjoyed by the claimants sign and the trademark owner's sign, as well as its degree of reputation, even if this is only residual.¹⁸³
4. The fact that the national mark on which the trademark owner has based a priority claim has been declared invalid due to bad faith.

Finally, there are number of factors that, considered in isolation, are not enough to find bad faith but that, in combination with other relevant factors (to be identified on a case-by-case basis), might indicate the existence of bad faith:

- The fact that an earlier, very similar, trademark was revoked for goods or services in a number of classes is not, in itself, sufficient to allow any conclusions to be drawn as to the trademark owner's intentions at the time of filing the trademark application for the same goods or services.
- The fact that the application for registration of the contested trademark is filed 3 months before expiry of the period of grace for the earlier trademarks is not sufficient to counteract factors that show that the trademark owner's intention was to file a modernised trademark covering an updated list of services.¹⁸⁴
- The fact that, after successfully registering the trademark at issue, the trademark owner serves formal notice on other parties to cease using a similar sign in their commercial relations is not in itself an indication of bad faith. Such a request falls within the scope of the rights attaching to the registration of a trademark; However, in circumstances where this request is connected with other factors (e.g. the mark is not being used), it might be an indication of the intention to prevent another party from entering the market.
- In cases where the trademark proprietor owns more than one trademark, the mere fact that the differences between the trademark at issue and the previous trademark registered by the same proprietor are so insignificant as not to be noticeable to the average consumer cannot establish by itself that the contested trademark is a mere repeat application made in bad faith.

3.3.2.2 Factors unlikely to indicate the existence of bad faith

Below is identified several factors that, in general, are unlikely to prove bad faith:

- Bad faith cannot be found on the basis of the length of the list of goods and services set out in the application for registration. As a rule, it is legitimate for an undertaking to seek registration of a mark not only for the categories of goods and services that it markets at the time of filing the application but also for other categories of goods and services that it intends

¹⁸¹ 14/02/2012, T-33/11, Bigab, EU:T:2012:77, § 21 et seq.; 08/05/2014, T-327/12, Simca, EU:T:2014:240, § 39; 26/02/2015, T-257/11, COLOURBLIND, EU:T:2015:115, § 68

¹⁸² 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 50

¹⁸³ 08/05/2014, T-327/12, Simca, EU:T:2014:240, § 40, 46 and 49

¹⁸⁴ 13/12/2012, T-136/11, Pelikan, EU:T:2012:689, § 50 and 51

to market in the future. Nevertheless, as explained under point 3(c) in paragraph 3.3.2.1 (Factors likely to indicate the existence of bad faith), the registration of a trademark by an applicant without any intention to use it for the goods and services covered by that registration may constitute bad faith where there is no rationale for the application for registration.

- The act of filing of a lawsuit for cancellation of the earlier trademark while invalidation proceedings brought on the basis of that earlier trademark are still pending is not evidence of bad faith.¹⁸⁵

3.3.3 Proof of bad faith

In invalidity proceedings the Court will limit its examination to the grounds and arguments submitted by the parties.

The claimant must establish the circumstances that make it possible to conclude that the trademark was registered in bad faith. The good faith of the trademark applicant is presumed until proven otherwise.¹⁸⁶

Where the Court finds that the objective circumstances of the case may lead to the rebuttal of the presumption of good faith, it is for the trademark proprietor to provide plausible explanations on the objectives and commercial logic pursued by the application for registration of that mark.¹⁸⁷

3.3.4 Extent of invalidity

The grounds for invalidity referred to in Article 28(1) of the **Law** may, depending on the circumstances, exist in respect of only some of the goods and services for which the contested mark has been registered.

The claimant can determine the extent of the invalidity action. If it challenges only some of the goods and services covered by the contested trademark, the Court will limit its assessment to those goods and services.

The **extent of a declaration of invalidity** based on a finding of bad faith will be determined on the basis of the evidence and arguments provided by the claimant and will depend on the nature of the specific behaviour constituting bad faith.

For example:

- where bad faith is found because the contested trademark was filed with the deliberate purpose of creating an association with the claimant, the trademark will normally be declared invalid in its entirety;
- where bad faith is found because of the absence of any intention to use the trademark, the trademark may be declared only partially invalid if the claimant cannot adequately establish that such bad faith applies to all the goods and services.

3.4 Grounds under Article 28 of the **Law** — other earlier rights

3.4.1 A right to a name/right of personal portrayal

3.4.2 Copyright

According to Article 28(1)(e) of the **Law**, a trademark will be declared invalid where such registration infringes the copyright of a third party, that has been acquired before the filing date of contested trademark or if priority is claimed before that date.







¹⁸⁵ 25/11/2014, T-556/12, KAISERHOFF (fig.) / KAISERHOFF, EU:T:2014:985, § 12



¹⁸⁶ 23/05/2019, T-3/18 & T-4/18, ANN TAYLOR / ANNTAYLOR et al., EU:T:2019:357, § 34 and case-law quoted therein

¹⁸⁷ 23/05/2019, T-3/18 & T-4/18, ANN TAYLOR / ANNTAYLOR et al., EU:T:2019:357, § 36-37

The claimant will have to provide the necessary **provision from the Law on Copyright and Neighboring rights of Georgia** and put forward a **cogent line of argument** as to why it would succeed under the specific law in preventing the use of the contested mark.

The notion of copyright protection is applicable irrespective of the goods and services the contested mark covers. It merely requires an unauthorised reproduction or adaptation of the protected work or a part thereof in the contested mark. It follows, that similarity for the purposes of the assessment of likelihood of confusion is not the relevant test to be applied.

Earlier right	Contested sign	Case No
		09/09/2010, R 1235/2009-1
<p>This ground for invalidity is relative and, therefore, only holders of earlier rights — or other parties, if allowed by the law governing those rights — are entitled to invoke it. The right relied upon here is copyright. Therefore, the party entitled to act is the holder of the copyright in the flower design or another party authorised by the law governing copyright. The invalidity claimant acknowledges that ownership of the copyright in the design ‘belongs to third parties’ (in fact to one third party: Corel Corporation, the graphic design company). The invalidity applicant does not own the right it seeks to rely upon. It solely has the right to use clip art with the flower shape and use it for purely private purposes. The ground was rejected (para. 32 et seq.).</p>		
		30/06/2009, R 1757/2007-2
<p>‘... the mere fact that the stylisation of the letter ‘G’ is ‘simple’, does not exclude its protection under copyright law ... Indeed, for a work of the mind to be protected, it is sufficient for it to be “original” ... While it is true that the contested TM is not an exact copy of the earlier work, it must be borne in mind that the partial reproduction and adaptation without the consent of the owner of the copyright is also prohibited. The Board considers this to be the case here. The contested TM has taken all the essential characteristic features of the prior work: a stand-alone capital ‘G’ in straight, thick, black lines, in a perfectly square flattened shape ... the ‘G’ of the contested TM is drawn in a thick, black line of equal width and its inner part reaches further inside, that is the case in the prior work. However, the difference in these minor details constitute minimal modifications which do not affect the overlap in the essential characteristic features of the earlier work, namely, a stand-alone capital ‘G’ with a perfectly rectangular form, a flattened shape and thick, black lines ... As the partial reproduction or adaptation of the prior work has been done without the owner’s consent, it is unlawful. Therefore, the contested decision must be annulled and the request for a declaration of invalidity ... must be upheld’ (para. 33 et seq.).</p>		
		16/05/2012, R 1925/2011-4
<p>‘Under the assumption that the claimed subject-matter constituted a “work”, the cancellation applicant failed to demonstrate and to prove who was its author, and, how the cancellation applicant (a legal person with its seat in Japan) acquired the exclusive rights from the author’ (paras 12-13). The Board examined each of these aspects. Moreover, it describes the differences between trademark similarity and copying for the purposes of copyright infringement. The cancellation applicant had mixed up both concepts (paras 22-24).</p>		
Earlier right	Contested sign	Case No

		<p>05/03/2012, 5377 C</p>
<p>Section 1(1)(a) of UK Copyright Designs Patents Act 1988 (CDPA) provides that a copyright subsists in original artistic works; Section 4(1) CDPA defines an 'artistic work' as 'a graphic work, photograph, sculpture or collage irrespective of artistic quality'. Section 4(2) CDPA defines a 'graphic work' as including any 'painting, drawing, diagram, map, chart ... plan ... engraving, etching, lithograph, woodcut or similar work'. The Cancellation Division held, at the outset, that the applicants have established that both logos were created by their authors at a time prior to the filing of the EUTM. The designs at issue can be considered to meet also the substantive standards of the protection in the UK. The similarities are 'original and so marked as to warrant a finding that the one has been copied from the other', or expressed in other words, similarities are 'sufficiently numerous or extensive to justify an inference of copying'. Accordingly, the similarities between the copyrights and the contested EUTM are such that they are sufficiently close, numerous and extensive to be rather the result of copying than of coincidence. For the above reasons, the contested EUTM must be declared invalid since its use may be prohibited under Section 16(3) CDPA, which applies by virtue of Article 53(2)(c) of Regulation No 207/2009 [now Article 60(2)(c) EUTMR] (paras 36-49).</p>		

3.4.3 Company names

A company name is the official designation of an undertaking registered in the Business Register.

Article 28(1)(d) of the **Law** requires that earlier company name is contained in a contested trademark. Furthermore, the Law applies when the actual use of earlier company name in the course of trade causes likelihood of confusion with the contested sign. Mentioned provision of invalidation may be invoked if following conditions are met:

- Company name is registered before filing date, or if the priority is claimed, before priority date of the contested trademark;
- Contested trademark contains sign identical to the company name or the sign which is immaterially different from company name (for example trademark "Reka" and company name "Rekka" are immaterially different from each other);
- Company name is used in the course of trade before filing date or if priority is claimed, before priority date of the contested trademark in relation to identical or similar goods for which contested trademark is registered;
- There is a likelihood of confusion.

3.4.3.1 Use in the course of trade

The requirement under Article 28(1)(d) of the **Law** is that the company name must be used in the course of trade in order to prove confusion between company name and trademark. Otherwise, if company does not operate with its name in the field which is identical or similar to the goods or services for which contested trademark is registered, it is not possible to prove likelihood of confusion between the signs.

The claimant might have to prove not only that the sign relied on is used in the course of trade but also that it has been **registered in the Business registry**.

The notion of '**use in the course of trade**' is not the same as '**genuine use**'. The aims and conditions connected with proof of genuine use of trademark is different from those relating to proof of use in the course of trade of the sign referred to in Article 28(1)(d) of the **Law**. Therefore, use must be interpreted according to the particular type of right at issue.

'Use of the company name in the course of trade' refers to the use 'in the course of a commercial activity with a view to economic advantage and not as a private matter'¹⁸⁸

Deliveries made without charge may be taken into account in order to ascertain whether the requirement for use of the company name in the course of trade has been met, since those deliveries could have been made in the context of a commercial activity with a view to economic advantage, namely to acquire new outlets.¹⁸⁹

As far as the **time of use** of the company name is concerned, claimant must prove that use took place before the filing of the trademark application or the priority date if relevant.¹⁹⁰

Moreover, it must be clear from the evidence that the use continues on the date of the filing of the invalidation lawsuit.

~~3.4.3.2 Defenses against an invalidity application based on relative grounds~~

~~3.4.3.2.1 Consent to registration~~

~~3.4.3.2.2 Examples rejecting the claim of consent to registration~~

~~3.4.3.2.3 Examples accepting the claim of consent to registration~~

~~3.4.3.2 Earlier applications for declaration of invalidity or counterclaims~~

~~3.4.3.3 Acquiescence~~

~~4.3.3.3.1 Examples rejecting the acquiescence claim~~

~~4.3.3.3.2 Examples (partially) accepting the acquiescence claim~~

3.5 Unauthorized filing by agents of the trademark proprietor

3.5.1 Preliminary Remarks

According to Article 28(1)(c) of the **Law**, the court shall declare a trademark registration invalid at the request of a third party where an agent or representative of the proprietor of the trademark applies for registration thereof in his own name without the proprietor's consent, ~~unless the agent or representative justifies his action~~

3.5.2 Origin of Article 28(1)(c) of the **Law**

Article 28(1)(c) of the **Law** has its origin in Article 6~~septies~~ of the Paris Convention (PC), which was introduced into the convention by the Revision Conference of Lisbon in 1958. The protection it affords to trademark proprietors consists of the right to prevent, cancel, or claim as their own unauthorised registrations of their marks by their agents or representatives, and to prohibit use thereof, where the agent or representative cannot justify its acts. Article 6~~septies~~ PC reads as follows:

(1) If the agent or representative of the person who is the proprietor of the mark in one of the countries of the Union applies, without such proprietor's authorization, for the registration of the mark in his own name, in one or more countries of the Union, the proprietor shall be entitled to oppose the registration applied for, or demand its cancellation or, if the law of the country so allows, the assignment in his favour of the said registration, unless such agent or representative justifies his action.

(2) The proprietor of the mark shall, subject to the provisions of paragraph (1), above, be entitled to oppose the use of his mark by his agent or representative if he has not authorized such use.

¹⁸⁸ 12/11/2002, C-206/01, Arsenal, EU:C:2002:651, § 40; 25/01/2007, C-48/05, Opel, EU:C:2007:55, § 18; 11/09/2007, C-17/06, Céline, EU:C:2007:497, § 17

¹⁸⁹ 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 152

¹⁹⁰ 29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 152

(3) Domestic legislation may provide an equitable time limit within which the proprietor of a mark must exercise the rights provided for in this Article.

Article 28(1)(c) of the **Law** implements this provision only to the extent it gives the rightful proprietor the right to request invalidation of the registration filed without its authorisation.

3.5.3 Purpose of Article 28(1)(c) of the **Law**

The unauthorised filing of the proprietor's trademark by its agent or representative is contrary to the general obligation of trust underlying commercial cooperation agreements of this type. Such a misappropriation of the proprietor's mark is particularly harmful to its commercial interests, as the applicant may exploit the knowledge and experience acquired during its business relationship with the proprietor and, thus, improperly benefit from the proprietor's effort and investment.

Therefore, the purpose of Article 28(1)(c) of the **Law** is to safeguard the legitimate interests of trademark proprietors against the arbitrary appropriation of their trademarks, by granting them the right to prohibit registrations by agents or representatives that are applied for without their consent.

Article 28(1)(c) of the **Law** is a manifestation of the principle that commercial transactions must be conducted in good faith. Article 28(1)(b) of the **Law**, which allows for the declaration of invalidity of a trademark on the ground that the holder of trademark was acting in bad faith, is the general expression of this principle.

However, the protection granted by Article 28(1)(c) of the **Law** is narrower than that afforded by Article 28(1)(b) of the **Law**, because the applicability of Article 28(1)(c) is subject to the fulfilment of a number of additional conditions laid down in this provision.

3.5.4 Entitlement of the claimant

The right to file an action for invalidation is reserved only for the proprietors of earlier trademarks.

It follows that an action for invalidation filed in the name of third persons, be their licensees or otherwise authorised will be dismissed as inadmissible due to lack of entitlement.

Likewise, if the claimant fails to prove that it was the rightful proprietor of the mark when the lawsuit was filed, the claim will be dismissed without any examination of its merits due to lack of substantiation. The evidence required in each case will depend on the kind of right relied upon. The current proprietor may also invoke the rights of its predecessor in title if the agency/representation agreement was concluded between the previous proprietor and the claimant, but this needs to be duly substantiated by evidence.

3.5.5 Scope of Application

Kinds of mark covered

Article 28(1)(c) of the **Law** applies to 'trademarks' that have been applied for as trademarks without their proprietor's consent. Therefore, the kinds of rights on which an action for invalidity based on Article 28(1)(c) of the **Law** may be filed needs to be determined in more detail, both as regards their nature and their geographical origin.

~~In the absence of any restriction in Article 28(1)(c) of the Law and in view of the need to provide the legitimate interests of the real proprietor with effective protection, the term "trademarks" should be interpreted broadly and must be understood as including **pending applications**,~~

~~since there is nothing in this provision restricting its scope exclusively to registered trademarks.~~

well-known marks within the meaning of Article 6*bis* PC fall within the term ‘trademarks’ within the sense of Article 28(1)(c) of the **Law**. Consequently, both registered and unregistered trademarks are covered by this provision, to the extent that the law of the country of origin recognises rights of the latter kind. In contrast, the express reference to ‘trademarks’ means that Article 28(1)(c) of the **Law does not apply to mere signs used in the course of trade, other** than unregistered trademarks. Likewise, **other kinds of intellectual property rights** that could be used as a basis for an invalidity action cannot be invoked in the context of Article 28(1)(c) of the Law either.

It is clear from the wording of Article 28(1)(c) of the **Law** that the trademark on which the invalidity action is based must be **earlier** than the trademark registration. Hence, the **relevant point in time** that should be taken into account is the **filing or priority date** of the contested registration. The rules according to which the priority should be determined depend on the kind of trademark relied upon. If the earlier mark has been acquired by registration, it is its filing or priority date that should be taken into account for assessing whether it precedes the contested trademark registration, whereas if it is a use-based right, the relevant conditions for protection through use must have been fulfilled before the filing date (or if appropriate, the priority date) of the contested trademark registration. In the case of earlier well-known marks, the mark must have become well known before the filing or priority date of the contested trademark registration.

3.5.6 Origin of the earlier mark

In the absence of any other reference in Article 28(1)(c) of the **Law** to a ‘relevant territory’, it is **immaterial whether the earlier trademark rights reside in Georgia or not**.

The practical importance of this provision lies precisely in the legal capacity it confers on holders of trademark rights **outside Georgia (only in Paris Convention member countries)** to defend these rights against fraudulent filings.

3.5.7 Conditions of Application

Article 28(1)(c) of the **Law** entitles trademark proprietors to invalidate the registration of their marks as trademarks, provided the following substantive cumulative requirements are met.

1. The holder of the registration is or was an agent or representative of the proprietor of the mark.
2. The registration is in the name of the agent or representative.
3. The application was filed without the proprietor’s consent.
4. ~~The agent or representative fails to justify its acts.~~
5. The signs and the goods and services are identical or closely related.

3.5.8 Agent or representative relationship

3.5.8.1 Nature of the relationship

In view of the purpose of this provision, which is to safeguard the legal interests of trademark proprietors against the misappropriation of their trademarks by their commercial associates, the terms ‘agent’ and ‘representative’ should be **interpreted broadly** to cover all kinds of relationships based on any business arrangement (governed by a written or oral contract) where one party is representing the interests of another, regardless of the *nomen juris* of the contractual relationship between the principal-proprietor and the trademark holder.¹⁹¹

¹⁹¹ 11/11/2020, C-809/18 P, MINERAL MAGIC, EU:C:2020:902, § 84-85

Therefore, it is sufficient for the purposes of Article 28(1)(c) of the **Law** that there is some agreement of commercial cooperation between the parties of a kind that gives rise to a **fiduciary relationship** by imposing on the applicant, whether expressly or implicitly, a general duty of **trust and loyalty** as regards the interests of the trademark proprietor. It follows that Article 28(1)(c) of the **Law** may also extend, for example, to licensees of the proprietor, or to authorised distributors of the goods for which the mark in question is used.

09/07/2014, T-184/12, Heatstrip	The Court concluded that, although there was no written cooperation agreement between the parties, their relationship on the date of the application for the EUTM was, in view of the business correspondence between them, more than that of merely buyer and seller. There was, rather, a tacit cooperation agreement that led to a fiduciary obligation on the part of the EUTM applicant (para. 67).
11/11/2020, C-809/18 P, MINERAL MAGIC	The applicant could be regarded as an 'agent' of the proprietor of the earlier mark in light of the distribution agreement between the parties. According to the agreement, the proprietor would supply the goods under the earlier mark to the applicant and the latter would be responsible for distributing the proprietor's goods within the EU and worldwide. The agreement also indicated the applicant as a preferred distributor of the proprietor's goods and included a non-competition clause and provisions relating to the proprietor's intellectual property rights with respect to those goods (paras 86-87).
21/11/2014, R 1958/2013-1, СЛОБОДА (fig.)	The Board found that the contents of the exchanged information lead to the conclusion that 'the CTM proprietor was, in effect, acting as an agent or distributor of the invalidity applicant. Even if the relationship was not explicitly defined as such, the parties appeared to be business partners, which would require a certain level of trust. The CTM proprietor was regularly reporting and consulting the marketing strategy with the invalidity applicant, which on its part, allowed a certain level of control, to the CTM proprietor (para. 46).'

Given the variety of forms that commercial relationships may acquire in practice, a **case-by-case approach** is applied, focusing on whether the contractual link between the proprietor-claimant and the applicant is only limited to a series of occasional transactions, or if, conversely, it is of such a duration and content to justify the application of Article 28(1)(c) of the **Law**. The material question should be whether it was the cooperation with the proprietor that gave the applicant the possibility to get to know and appreciate the value of the mark and incited the applicant to subsequently try to register the mark in its own name.

Nevertheless, some kind of cooperation agreement has to exist between the parties. If the applicant acts completely **independently**, without having entered into any kind of fiduciary relationship with the proprietor, it cannot be considered an agent within the meaning of Article 28(1)(c) of the **Law**.¹⁹²

Case No	Comment
16/06/2011, 4 103 C, RETROFIT	The Cancellation Division found that rather than an agent or representative relationship, at the time of filing the EUTM, the parties held parallel and independent rights to the marks in the USA and Japan.

¹⁹² Confirmed 13/04/2011, T-262/09, First Defense Aerosol Pepper Projector, EU:T:2011:171, § 64

Case No	Comment
17/03/2000, B 26 759, EAST SIDE MARIO'S	A mere desire to establish a commercial relationship with the opponent cannot be considered as a concluded agreement between the parties regarding the use of the contested trademark.

Therefore, **a mere customer or a client** of the proprietor cannot amount to an 'agent or representative' for the purposes of Article 28(1)(c) of the Law, since such persons are under no special obligation of trust to the trademark proprietor.

Case No	Comment
13/04/2011, T-262/09, First Defense Aerosol Pepper Projector	The opponent did not submit any evidence showing the existence of an agent-principal relationship with the applicant. The opponent provided invoices and order forms addressed to itself, on the basis of which the existence of a business agreement between the parties could, in other circumstances, be assumed. However, in the present case, the General Court concluded that the evidence does not show that the applicant acted on behalf of the opponent, but merely that there was a seller- customer relationship that could have been established without a prior agreement between them. Such a relationship is not sufficient for Article 8(3) EUTMR to be applicable (para. 67).
26/06/2009, B 955 528, Iber Fusion (fig.)	The Office considered that the evidence on the kind of commercial link between the opponent and the applicant was inconclusive, that is, it could not be established whether the applicant was really an agent or representative or a mere purchaser of the opponent's goods. Accordingly, the Office was unable to hold that Article 8(3) EUTMR applied.

It is irrelevant for the purposes of Article 28(1)(c) of the **Law** whether an **exclusive** agreement exists between the parties, or just a simple, non-exclusive commercial relationship. Indeed, a commercial cooperation agreement entailing an obligation of loyalty can exist even in the absence of an exclusivity clause.¹⁹³

Article 28(1)(c) of the **Law** also applies to **analogous** forms of business relationships that give rise to an obligation of trust and confidentiality between the trademark proprietor and the professional, as is the case with legal practitioners and attorneys, consultants, trademark agents, etc. However, the legal representative or manager of the claimant's company cannot be considered as an agent or representative within the meaning of Article 28(1)(c) of the **Law**, given that such persons are not business associates of the claimant. The purpose of this provision is not to protect the proprietor from infringing acts coming from within its company. It may well be that such acts can be sanctioned under the general bad faith provision in Article 28(1)(b) of the **Law**.

The **burden of proof** regarding the existence of a cooperation relationship lies with the claimant.

3.5.8.2 Form of the agreement

It is not necessary for the agreement between the parties to assume the form of a written contract. Of course, the existence of a formal agreement between the parties will be of great value in determining exactly what kind of relationship exists between them. As mentioned above, the title of such an agreement and the terminology chosen by the parties should not be taken as conclusive. What counts is the kind of commercial cooperation established in substance and not its formal description.

Even in cases where a written contract does not exist, it may still be possible to infer the existence of a commercial agreement of the kind required by Article 28(1)(c) of the **Law** by reference to indirect indications and evidence, such as the commercial correspondence

¹⁹³ 09/07/2014, T-184/12, Heatstrip, EU:T:2014:621, § 69

between the parties, invoices and purchase orders for goods sold to the agent, or credit notes and other banking instruments (always bearing in mind that a mere customer relationship is insufficient for Article 28(1)(c) of the **Law**). Even dispute resolution agreements may be relevant to the extent that they give sufficient information about the past relationship between the parties.

Case No	Comment
07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH	The Opposition Division was correct to conclude that there was an agency relationship between the applicant and the opponents, on the basis of correspondence indicating that the two parties had a long and close commercial relationship. The applicant company acted as a distributor of the opponents' goods (para. 18).

Furthermore, circumstances such as sales targets imposed on the applicant, or payment of royalties, or production of the goods covered by the mark under licence or help in the setting up of a local distribution network, will be strong indications of a commercial relationship of the type covered by Article 28(1)(c) of the **Law**.

The active cooperation between a trademark holder and a claimant in the advertising of the product, in order to optimise the marketing thereof, could give rise to the fiduciary relationship required under Article 28(1)(c) of the **Law**.

However, the mere desire of the trademark holder to enter into a commercial relationship with the claimant cannot be considered as a concluded agreement between the parties. Prospective agents or representatives are not covered by Article 28(1)(c) of the **Law**.

3.5.8.3 Territorial scope of the agreement

Neither Article 28(1)(c) of the **Law** nor Article 6septies of the Paris Convention explicitly refer to the territorial scope of the agreement between the principal and its agent. As the purpose of the provision is to guard against the breach of trust that the original proprietor has put in its agent, it would appear that the territorial scope of their agreement should not limit the application of that provision. The agent's general duty of trust and loyalty as regards the interests of the legitimate proprietor of the mark cannot be limited territorially. In the context of a globalised and integrated economy, the proprietor should reasonably expect to be able to expand into new markets without running into registrations made by the agents it has in its existing markets.

Therefore, even if the agreement between the agent and the principal concerned only a territory outside Georgia, Article 28(1)(c) may still apply.

3.5.8.4 Relevant points in time

The agent-representative relationship must have been established **prior to the filing date** of the trademark application. Therefore, it is immaterial whether after that time the trademark holder entered negotiations with the claimant or made unilateral proposals with the purpose of becoming a representative or agent of the latter.

Case No	Comment
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<p>19/05/2011, R 85/2010-4, LINGHAMS'S (fig.) / LINGHAMS'S (fig.)</p>	<p>The opponent granted the applicant a special power of attorney (PoA), consenting to the applicant's filing of trademark applications. Subsequent to this PoA, the applicant filed an EUTM. After the filing, the opponent revoked the PoA and filed the opposition.</p> <p>The Board considered that the relevant point in time is the filing date. At that moment, the owner's consent was present. The revocation had effects <i>ex nunc</i> (and does not affect the validity of actions performed under the PoA) and not <i>ex tunc</i> (as if the PoA had never existed) (para. 24).</p>
<p>06/09/2006, T-6/05, First Defense Aerosol Pepper Projector</p>	<p>The Board of Appeal ought to have examined whether, on the day of the application for registration of the mark, the intervener was still bound by the consent (para. 50).</p>

However, even if the agreement between the parties was formally concluded **after the filing date** of the application, it may still be possible to deduce from the evidence that the parties were already in some form of commercial cooperation before the signature of the relevant contract and that the applicant was already acting as the opponent's agent, representative, distributor or licensee.

However, the agreement between the parties **does not have to be still in force technically** when the application is filed. The reference to a filing made by an 'agent or representative' should not be understood as a formal requirement that must be present at the time the trademark application is filed. Article 28(1) of the **Law** also applies to **agreements that expired before the filing date of the trademark application**, provided that the time that has lapsed is of such duration that it can be reasonably assumed that the obligation of trust and confidentiality was still present when the trademark application was filed.

Article 28(1)(c) of the **Law** and Article 6*septies* PC do not protect a trademark proprietor that is careless and makes no efforts to secure trademark protection on its own. Post- contractual fiduciary obligations mean that none of the parties may use the termination of an agreement as a pretext for getting rid of its obligations, for example, by terminating an agreement and immediately afterwards filing a trademark. The rationale of Article 28(1)(c) of the **Law** and Article 6*septies* PC is to prevent a situation where a representative in country A of a principal who owns trademarks in country B, and who is meant to market the trade-marked goods and observe the interests of the latter in country A, uses the filing of a trademark application in country A as a weapon against the principal, for example to force the principal to continue with the representative and to prevent the principal from entering the market in country A. This rationale likewise applies if an agreement exists but the representative terminates it to take advantage and file a trademark for the same reasons. However, this does not create absolute rights for the principal to obtain trademark protection in other countries. The mere fact that the principal holds a trademark in country B does not give the principal an absolute right to obtain trademarks in all other countries; the trademarks registered in different countries are in principle independent from each other and may have different proprietors, in accordance with Article 6(3) PC. Article 6*septies* PC is an exception to this principle and only to the extent that the contractual or de facto obligations of the parties involved justify this. ~~Only to that extent is it justified that the ensuing TM would 'belong' to the principal.~~

This should be assessed on a case-by-case basis, and the decisive factor should be whether it is still possible for the applicant to take commercial advantage of its expired relationship with the trademark proprietor by exploiting the know-how and contacts it acquired because of its position.

Case No	Comment
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<p>19/11/2007, R 73/2006-4, PORTER (fig.) / PORTER (fig.) et al</p>	<p>The contested application was not filed during the validity of the agreements between the parties, which allowed the applicant to file an EUTM, but nearly 1 year after the termination of the last agreement (para. 25). Post-contractual fiduciary obligations are not meant to last forever but for a certain transitional period after the termination of the agreement in which the parties may redefine their commercial strategies. Any post-contractual relationship between the parties was phased out by the time of the filing of the contested mark (para. 27).</p>
<p>21/02/2002, B 167 926, AZONIC</p>	<p>In this case, it was considered that less than 3 months after the expiry of a contract relationship such as a licence agreement, the fiduciary relationship between the parties still exists imposing on the applicant a duty of loyalty and confidence.</p>

3.5.8.5 Application in the agent's name

According to Article 28(1)(c) of the **Law**, the trademark registration will be invalidated where the agent or representative applies for registration thereof in its own name. It will usually be easy to assess whether this requirement has been fulfilled, by comparing the name of the applicant with that of the person appearing in the evidence as the agent or representative of the proprietor.

However, there may be cases where the agent or representative will try to **circumvent** this provision by arranging for the application to be filed by a third person, whom it either controls, or with whom it has entered into some form of understanding to that effect. In such cases adopting a more flexible approach is justified. Therefore, if it is clear that because of the nature of the relationship between the person filing the application and the agent, the situation is effectively the same as if the application had been filed by the agent personally, it is still possible to apply Article 28(1)(c) of the **Law**, notwithstanding the apparent discrepancy between the applicant's name and the name of the proprietor's agent.

Such a case could arise if the application is filed not in the name of the agent's company, but in the name of a natural person that **shares the same economic interests** as the agent, as for example its president, vice-president or legal representative. Given that in this case the agent or representative could still benefit from such a filing, it should be considered that the natural person is bound by the same limitations as the company.

Case No	Comment
<p>21/02/2002, B 167 926, AZONIC</p>	<p>The Opposition Division considered that, even though the EUTM application was applied for in the name of the natural person Mr Costahaude instead of directly in the name of the legal person STYLE'N USA, INC., the situation was effectively the same as if it had been filed in the name of the legal person.</p>
<p>28/05/2003, B 413 890, CELLFOOD</p>	<p>If it is clear that because of the nature of the relationship between the person filing the application and the agent, the situation is effectively the same as if the application had been filed by the agent personally, it is still possible to apply Article 8(3) EUTMR, notwithstanding the apparent discrepancy between the applicant's name and the name of the owner's agent.</p>

Moreover, if the person filing the contested application had also signed the agency agreement on behalf of the company, this would have to be considered a strong argument in favour of the application of Article 28(1)(c) of the **Law**, since in such a case the applicant cannot possibly deny direct knowledge of the relevant prohibitions. Similarly, if an agency agreement contained a clause holding the management of the company personally responsible for the observance of the contractual obligations undertaken by the agent, this would also have to be considered a further indication that the filing of the application is covered by the prohibition of Article 28(1)(c) of the **Law**.

A similar case arises where the agent or the representative and the applicant are distinct legal entities, but the evidence shows that they are controlled, managed or run by the same natural person. For the reasons given above it is appropriate to 'lift the corporate veil' and apply Article 28(1)(c) of the **Law** also to these cases.

3.5.8.6 Application without the proprietor's consent

Even though the absence of the proprietor's consent is a **necessary condition** for the application of Article 28(1)(c) of the **Law**, the **claimant does not have to submit evidence that shows that the agent was not permitted** to file the trademark application. A mere **statement** that the filing was made without its consent is generally **sufficient**. This is because the claimant cannot be expected to prove a 'negative' fact, such as the **absence** of consent. In these cases the **burden of proof is reversed** and it is up to the applicant to prove that the filing was authorised, or to give some other justification for its acts.

In view of the need to provide effective protection to the legitimate proprietor from unauthorised acts of its agents, the action based on Article 28(1)(c) of the **Law** should be denied only where the proprietor's consent is sufficiently **clear, specific and unconditional**.¹⁹⁴

Therefore, even if the proprietor has expressly authorised the filing of the trademark application, its consent cannot be considered sufficiently clear if it has not also explicitly specified that the application may be in the name of the agent.

Case No	Comment
07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH	'In view of its serious effect in extinguishing the exclusive rights of the proprietors of the trademarks in issue in the main proceedings (rights which enable them to control the initial marketing in the EEA), consent must be so expressed that an intention to renounce those rights is unequivocally demonstrated' (para. 18).

Likewise, even if the proprietor has expressly authorised the filing of a trademark application, its consent cannot be considered sufficiently specific for the purposes of Article 28(1)(c) of the **Law** if there is no indication of the specific signs for which the applicant has permission to file as a trademark.

It will be generally easier to assess whether the filing was authorised by the proprietor where the conditions under which an agent or representative may apply for a trademark application are adequately regulated by **contract** or are given by other kinds of **direct evidence** (letters, written representations, etc.). In most cases, such evidence will be sufficient to demonstrate whether the proprietor has given its express consent, or if the applicant has exceeded the limits of its authorisation.

In other cases, a contract will either not exist, or it will be inadequate on the subject. Although the wording of Article 28(1)(c) of the Law is in principle broad enough to include cases of **tacit or implied consent**, such consent should only be inferred if the evidence is sufficiently clear as to the intentions of the proprietor. If the **evidence is completely silent** as to the existence of an express or implied authorisation, **lack of consent should be generally presumed**.

Notwithstanding **indirect indications** and evidence pointing to implied consent, any **ambiguity or doubt** should be **interpreted in favour of the claimant**, as it will usually be quite difficult to assess whether such consent is sufficiently clear and unequivocal.

¹⁹⁴ 06/09/2006, T-6/05, First Defense Aerosol Pepper Projector, EU:T:2006:241, § 40

For example, the mere fact that the proprietor tolerated unauthorised applications in the name of the agent in third jurisdictions cannot alone create legitimate expectations on the part of the applicant that the proprietor will not object to the filing of a trademark application either.

Case No	Comment
31/01/2001, B 140 006, GORDON SMITH (fig.); confirmed 07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH	The mere fact that the opponents failed to immediately oppose the applicant's action to register the trademark after they received notice of the fact did not constitute consent

The fact that the proprietor tolerates conduct outside the boundaries of a contract (such as use of the sign) cannot lead to the conclusion that filing the trademark did not breach the established fiduciary duty if consent is not clear, specific and unconditional.

Case No	Comment
T-537/10 & T-538/10, Fagumit, EU:T:2012:2952,	<p>The applicant (the EUTM owner in cancellation proceedings) focused her line of argument on the consent allegedly granted by the proprietor of the mark. The Court held (like the Board of Appeal) that the consent for the purposes of the registration of the mark in the name of the representative or agent must be clear, specific and unconditional (paras 20-23).</p> <p>The document relied upon by the EUTM owner does not show consent within the meaning of Article 8(3) EUTMR (para. 28). The EUTM owner was not mentioned in the document and it did not refer to the possibility of registration of the sign as a trademark. The EUTM owner cannot rely on the fact that the cancellation applicant did not object to the use of the sign by companies other than those referred to in the document. Use of the marks occurred during the course of marketing the goods produced by the cancellation applicant. However, such use is the logical consequence of the cooperation between the cancellation applicant and the distributors of its goods and does not show any abandonment of the sign, which would enable anyone to make an application for the registration of that sign — or its dominant element — as an EUTM (para. 27)</p>

Even where consent of the proprietor has been deemed to be clear, specific and unconditional, it will be a question of fact to determine if such consent survives a **change of proprietor** by way of an asset sale.

Case No	Comment
06/09/2006, T-6/05, First Defense Aerosol Pepper Projector	<p>The General Court remitted a case of this nature back to the Boards of Appeal in order to determine whether the consent obtained by the EUTM applicant had survived the purchase of the assets of the former trademark holder and whether, on the day of the application for registration of the mark, the new holder of the trademark in the USA (the opponent) was still bound by that consent.</p> <p>If the opponent was no longer bound by the consent, the General Court indicated that the Board ought then to determine whether the applicant had a valid justification which could offset the lack of such consent.</p>

3.5.8.7 Absence of justification on the part of the trademark holder

As mentioned above, since it is not possible for the claimant to prove the absence of consent, the burden of proof is reversed and it is up to the trademark holder to show that the filing of the application was authorised by the proprietor. Although Article 28(1)(c) of the **Law** treats the lack of the proprietor's consent and the absence of a valid justification on the part of the

applicant as two separate conditions, these requirements largely overlap to the extent that if the applicant establishes that the filing of the application was based on some agreement or understanding to this effect, then it will also have provided a valid justification for its acts.

In addition, the trademark holder may invoke any other kind of circumstance showing that it had a justification for filing the trademark application in its own name. However, in the absence of evidence of direct consent, only exceptional reasons are accepted as valid justifications, in view of the need to avoid a violation of the proprietor's legitimate interests without sufficient indications that its intention was to allow the agent to file the application in its own name.

For example, it could be possible to infer that the proprietor has tacitly consented to the filing of the application if it does not react within a reasonable period of time after having been informed by the applicant that it intends to apply for a trademark in its own name. However, even in such a case it will not be possible to assume that the application has been authorised by the proprietor if the agent had not made it sufficiently clear to the proprietor in advance in whose name it would file the application.

Another case of valid justification could be if the proprietor causes its agent to believe that it has abandoned the mark, or that it is not interested in obtaining or maintaining any rights in the territory concerned, for example, by suspending the use of the mark over a relatively long period of time.

The fact that the proprietor does not want to spend money on registering its trademark does not give the agent a right to act on its own initiative, as the proprietor might still have an interest in using its trademark in the territory although it is not registered. Such a business decision cannot be taken in itself as a sign that the proprietor has given up the rights in its mark.

Justifications exclusively linked to an applicant's economic interests, such as the need to protect its investment in setting up a local distribution network and promoting the mark in the territory, cannot be considered valid for the purposes of Article 28(1)(c) of the **Law**.

Nor can the applicant successfully argue in its defence that it is entitled to some financial remuneration for its efforts and expenditure in building up goodwill for the mark. Even if such remuneration were well deserved or is expressly stipulated in the agency agreement, the applicant cannot use the registration of the mark in its own name as a means of extracting money from the opponent or in lieu of financial compensation but should try to settle its dispute with the proprietor either by way of agreement or by suing for damages.

Finally, if the trademark holder does not provide any justification for its actions, it is not for the Court to make any speculations in that regard.¹⁹⁵

Case No	Comment
04/10/2011, 4 443 C, CELLO	As to the justificatory argument that the EUTM application was filed in order to protect the goodwill of the mark in the EU, which had been established solely as a result of its trading activities, the Cancellation Division considered that the fact that a distributor, exclusive or otherwise, develops the goodwill of the trademark of the owner in its allocated territory forms part of the usual duties of a distributor and cannot constitute, in itself and in the absence of other circumstances, a valid justification for the appropriation of the owner's mark by the distributor.

¹⁹⁵ 09/07/2014, T-184/12, Heatstrip, EU:T:2014:621, § 73-74

<p>10/01/2011, 3 253 C, MUSASHI (fig.)</p>	<p>As regards justification concerning economic claims of the party filing the EUTM and its arguments that it is entitled to some financial remuneration for permitting the sign to enjoy protection at EU level, and that it could be transferred to the cancellation applicant, it was held that this could not be valid justification within the meaning of Article 8(3) EUTMR. 'Even if remuneration were well deserved, the EUTM proprietor cannot use the registration of a mark in its own name as a means of receiving payment' (from the cancellation applicant) (para. 47).</p>
<p>07/07/2003, R 336/2001-2, GORDON SMITH (fig.) / GORDON & SMITH</p>	<p>An act which compromises the interests of the trademark proprietor, such as the filing of a trademark application in the agent's or a representative's name without the proprietor's consent and is driven solely by an intention to safeguard the agent's or a representative's own interests, is not considered justifiable for the purposes of Article 8(3) EUTMR. The same applies to the applicant's second argument, that is, that it was justified in doing so because it bore the registration costs. The interests of the trademark proprietor cannot be subordinate to an agent's or a representative's financial expenses. The fact that an opponent might be unwilling to incur any financial expenses to register a trademark does not automatically grant a right to the agent or representative to proceed with the registration of the trademark in its own name. This would constitute a violation of the agent's or representative's duty of trust and loyalty towards the trademark proprietor (para. 24).</p>

3.5.8.8 Applicability beyond identical signs — goods and services

Article 28(1)(c) of the **Law** provides that a trademark will be invalidated where 'an agent or representative of the proprietor of the mark applies for **registration thereof** in his own name'. Such an explicit reference to the principal's trademark gives the prima facie impression that the trademark applied for must be the same as the earlier mark.

Hence, a literal interpretation of Article 28(1)(c) of the **Law** would lead to the conclusion that its application is only possible where the agent or representative intends to register a mark identical to that of the proprietor.

Moreover, the text of Article 28(1)(c) of the **Law** does not refer to the goods and services for which the application has been filed and for which the earlier mark is protected and, thus, gives no guidance as to what the exact relationship between the respective goods and services should be for the Article to apply.





However, applying Article 28(1)(c) of the **Law** exclusively to identical signs for identical goods or services would render this provision largely ineffective, as it would allow the applicant to escape its consequences by merely making slight modifications either to the earlier mark or to the specification of goods and services. In such a case, the proprietor's interests would be seriously prejudiced, especially if the earlier mark were already in use and the variations made by the applicant were not significant enough to rule out confusion. What is more, if the application were allowed to proceed to registration despite its similarity to the earlier mark, the applicant would be in a position to prevent any subsequent registration and/or use of the earlier mark by the original proprietor within Georgia, by relying on Article 5 or 6 of the **Law**.

To sum up, in view of the need to effectively protect the legitimate proprietor against unfair practices by its representatives, a restrictive interpretation of Article 28(1)(c) of the **Law** must be avoided.

Therefore, the scope of application of Article 28(1)(c) of the **Law** should not be limited to identical marks but should also extend to **similar marks**. Likewise, its application cannot be precluded just because the **goods or services are similar**, and not identical. However, the assessment of similarity for the purposes of Article 28(1)(c) of the **Law** must be made in due consideration of the objective pursued by that provision, which is to prevent the misappropriation of the earlier mark by the agent or representative of the proprietor of that mark.



Moreover, not just any degree of similarity between the marks and the goods or services at issue may entail a misappropriation of the earlier mark. In particular, **likelihood of confusion is not a condition** for the application of Article 28(1)(c) of the **Law**. The **degree of similarity** between the marks and the goods or services should be such so as to guarantee that the purpose of Article 28(1)(c) of the **Law** is met, namely to prevent the misappropriation of the mark by the proprietor's agent.

The following are examples of conflicting signs where it will be considered that Article 28(1)(c) of the **Law** is applicable.

Earlier sign	TM application	Case No
		03/05/2012, R 1642/2011-2, MARITIME ACOPAFI (fig.) / MARITIME MONTERING AS (fig.) et al.
BERIK (word mark) (2 earlier rights)		03/08/2010, R 1367/2009-2, BERIK- DESIGN (fig.) / BERIK et al.
BERIK (word mark) (2 earlier rights)		03/08/2010, R 1231/2009-2, BERIK (fig.) / BERIK et al.

The following are examples of **goods and services** in conflict where Article 28(1)(c) of the **Law** is applicable.

Earlier mark	Contested mark	Case No
SpectraLayers	SpectraLayers	25/05/2020, R 2139/2019-5
<p>G&S: Classes 9, 42</p> <p><i>Territory of protection of earlier mark:</i> United States of America</p> <p><i>Assessment:</i> The contested services in Class 42 (providing software updates via the internet; providing information, advice and consultancy services in the field of computer software; hosting services and software as a service and rental of software) comprise a range of ancillary services to software which are usually rendered in connection with the earlier audio editing software in Class 9. There is a close functional relationship between the goods and services at issue, which must be considered highly similar (para. 48).</p>		

Earlier mark	Contested mark	Case No
		27/03/2017, R 673/2016-2
<p>G&S: Classes 1, 2, 3, 7, 37</p> <p><i>Territory of protection of earlier mark:</i> Japan</p> <p><i>Assessment:</i> Article 8(3) EUTMR applies when the goods and services in conflict are closely related (e.g. complementary), essentially the same or largely equivalent in commercial terms. It must be verified whether the contested goods or services may be perceived by the public as 'authorised' products, the quality of which is somehow 'guaranteed' by the opponent, and which it would have been reasonable for the opponent to market itself in view of the goods and services protected under the earlier mark (para. 52). Although the contested goods in Class 2 are not included in the earlier Japanese mark, they are similar, closely related or commercially equivalent to several of the earlier goods and services in Classes 3, 7 and 37 (para. 75).</p>		

In the following example, the **goods and services** in conflict were not considered equivalent in commercial terms.

Case No	Comment
15/09/2015, R 2406/2014-5 STUDIOLINE / STUDIOLINE et al.	The Board held that the connection between <i>photographer services</i> , including in the sense of 'organisation of photo-shoot parties', and <i>sporting and cultural activities</i> is too imprecise and vague to be regarded as 'equivalent in commercial terms'. It can be concluded from this that the decision concerned correctly ruled that the opposition was to be refused in relation to <i>sporting and cultural activities</i> (para 18).
03/08/2010, R 1231/2009-2, BERIK (fig.) / BERIK et al.	The items of clothing in Class 25 of the earlier marks cannot be considered to be closely related or equivalent in commercial terms to the contested printed matter; instructional and teaching materials (except apparatus) in Class 16 (paras 26-29).

Part E Register Operations

Section 1 Changes in a registration

1. Surrender

1.1 General principles

At any time after registration, trademark may be surrendered by its proprietor in respect of some or all of the goods and services. The surrender must be declared to Sakpatenti in writing (For information on the withdrawal of trademark applications, that is, prior to registration, see the Guidelines, Part B, Examination, Section 1, Proceedings, paragraph 5.1.).

Sakpatenti also revokes trademark registration in case of death (if the holder is natural person) or dissolve (if the holder is legal entity) of the trademark holder where corresponding documents are submitted proving that no successor in title are left.

1.2 Legal effect

Surrenders only become legally effective on the date of entry in the trademark Register. The registration procedure for the surrender may be suspended during ongoing proceedings.

The proprietor's rights in the registered trademark, as well as those of its licensees and any other holders of rights in the mark, lapse with an *ex nunc* effect on the date of the registration of the surrender in the trademark Register. Therefore, the surrender has no retroactive effect.

The surrender has procedural and substantive effects.

In procedural terms, when the surrender is entered in the trademark Register, the trademark ceases to exist and any proceedings (with the exception of invalidity or revocation proceedings) involving the mark before Sakpatenti terminate.

The substantive effects of surrender vis-à-vis third parties comprise the trademark proprietor renouncing any rights arising from its mark in the future.

The trademark proprietor is bound by the declaration of surrender during its registration procedure, provided that the following circumstances are present:

1. No revocation of the declaration reaches Sakpatenti on the same day as the receipt of the declaration of surrender. That means that if a declaration of surrender and a communication revoking that declaration reach Sakpatenti on the same day (regardless of the hour and minute of their receipt), they cancel each other out. Once it becomes effective, the declaration may not be revoked.
2. The declaration meets all the formal requirements, in particular those identified in paragraph 1.3. below.

1.3 Formal requirements

1.3.1 Form and language

The proprietor must declare the surrender to Sakpatenti in writing. The general rules for communication with the Sakpatenti apply (see the Guidelines, Part A, Section 1, Means of Communication).

The declaration of surrender must be submitted in writing in Georgian.

Where there is an application for revocation or for a declaration of invalidity pending against a trademark, and the proprietor wishes to surrender the contested trademark, it must do so by way of a separate document.

The declaration of surrender is void where it contains conditions or time limitations. For example, it may not be made under the condition that Sakpatenti takes a particular decision or, in *inter partes* proceedings, that the other party makes a procedural declaration. For instance, during cancellation proceedings the mark may not be (partially) surrendered on the condition that the cancellation applicant withdraws its cancellation action. However, this does not exclude the possibility of an agreement between the parties or prevent both parties from requesting successive actions (for example, surrender of the trademark and withdrawal of the cancellation action) in the same communication to Sakpatenti.

1.3.2 Fees

There is no fee for a declaration of surrender.

1.3.3 Necessary particulars

The declaration of surrender must contain the following particulars:

- the trademark registration number;
- the trademark proprietor's name and address and the proprietor's ID number (if available) together with the proprietor's name;

- where the surrender is only for some of the goods or services for which the mark is registered, either the goods and services for which the surrender is declared or an indication of the goods and services for which the mark is to remain registered or both (see paragraph 1.3.4 below).

1.3.4 Partial surrender

A trademark may be surrendered in part, that is, for some of the goods and services for which it is registered. A partial surrender only becomes effective on the date it is entered in the trademark Register.

For a partial surrender to be accepted, the following two conditions relating to the goods and services must be met:

1. the new wording must not constitute an extension of the list of goods and services.
2. the partial surrender must constitute a valid description of goods and services.

For further details on acceptable restrictions and for the practice regarding the declaration referred see the Guidelines, Part B, Examination, Section 3, Classification.

1.3.5 Signature

The declaration of surrender must be signed by the trademark proprietor or its duly appointed representative.

1.3.6 Representation

The general rules apply (see the Guidelines, Part A, Section 2, Formal examination, paragraph 7).

~~1.3.7 Requirements where a licence or other right in the trademark has been registered.~~

~~2 Alteration of a Trademark~~

~~2.1 General principles~~

~~There is a difference between an amendment of an TM application and an alteration of a registered TM.~~

~~This section does not apply to corrections of obvious errors by Sakpatenti in its publications or in the TM Register; such corrections are made *ex officio*, or at the proprietor's request.~~

~~The alteration of a mark enables the representation of a mark to be altered, providing the alteration relates to the proprietor's name and/or address **and** does not substantially affect the identity of the trademark as originally registered.~~

~~The Regulations do not provide for the possibility of altering other elements of the TM registration.~~

~~2.2 Formal requirements~~

~~2.2.1 Form and language~~

~~The application to alter the mark, that is, the representation of the mark, must be submitted in writing in Georgian~~

~~2.2.2 Fees~~

~~The application to alter the mark is considered not to have been filed until the fee has been paid. The amount of this fee is USD 60 (see the Guidelines, Part A, General Rules, Section 3, Payment of Fees, Costs and Charges).~~

~~Fee shall be paid in Georgian Law according to official exchange rate set by NBG for payment date.~~

2.2.3 Mandatory indications

The application for alteration must contain:

- the TM registration number;
- the TM proprietor's name and address;
- an indication of the element in the representation of the mark to be altered and the altered version of the element;
- a representation of the mark as altered that complies with the formal requirements laid down in the Instruction.

2.3 Substantive conditions for alteration



Article 00 of the Instruction allows the alteration of the representation of the mark only under very limited conditions, namely only when:

- the TM includes the TM proprietor's name and/or address, and
- these are the elements for which alteration is sought, and
- the alteration would not substantially affect the identity of the trademark as originally registered.

Strict rules apply: where the proprietor's name or address is part of the distinctive elements of the mark, for example, part of a word mark, an alteration is in principle excluded since the identity of the mark would be substantially affected. A mark may be altered if the TM proprietor's name or address appears on a figurative mark, for example, the label of a bottle, as a subordinate element in small letters. Such elements would normally not be taken into account in determining the scope of protection or the fulfilment of the use requirement. The rationale of Article 54(2) TMR is precisely to exclude any alteration of the registered TM that could affect its scope of protection or the assessment of the use requirement, so that rights of third parties cannot be affected.

No other element of the mark may be altered, not even if it is only a subordinate element in small letters of a descriptive nature, such as the indication of the percentage of alcohol on a label of a bottle of wine.

2.3.1 Example of acceptable alterations

Mark as registered	Proposed alteration
<p>TM No 4 988 556</p> 	

2.3.2 Examples of unacceptable alterations

Mark as registered	Proposed alteration

<p>TM No 11-058-823 ROTAM — INNOVATION IN POST PATENT TECHNOLOGY:</p>	<p>ROTAM — INNOVATION IN POST-PATENT TECHNOLOGY</p>
<p>TM No 9-755-307 MINADI-MINADI-Occhiali</p>	<p>MINADI</p>
<p>TM No 10-009-595 CHATEAU DE LA TOUR SAINT-ANNE</p>	<p>CHATEAU DE LA TOUR SAINTE-ANNE</p>
<p>TM No 9-436-072 SLITONE ULTRA</p>	<p>SLITONEULTRA</p>
<p>TM No 2-701-845</p> 	
<p>TM No 3-115-532</p> 	
<p>TM No 7-087-943</p> 	
<p>TM No 8-588-329</p> 	

2.4 Publication

~~Where the alteration of the registration is allowable, it will be registered and published. The publication will contain a representation of the TM as altered.~~

~~Within 3 months of the publication of the alteration, third parties whose rights may be affected by the alteration may challenge the registration thereof. For this procedure, the provisions on the opposition procedure apply *mutatis mutandis*. However, no opposition fee needs to be paid.~~

3 Changes of Name or Address

Both registered trademarks and trademark applications may be the subject of changes of name and address. Unless otherwise provided, the practice applicable to trademarks is also applicable to trademark applications.

It is possible to change the name and/or address of the proprietor of a registered trademark or its representative. The application to register the change must be submitted in Georgian. The change will be entered in the trademark Register and published.

The name, including the indication of the legal form, and address of the proprietor or representative may be amended upon payment of prescribed fee of USD 60 provided that as regards the proprietor's name, the change is not the consequence of a transfer.

A change of the proprietor's name is a change that does not affect the ownership, whereas a transfer is a change from one proprietor to another. In case of doubt as to whether the change is resulted in change of ownership or not see the Guidelines, Part E, Register Operations, Section 2, Trademarks as Objects of Property, Chapter 1, Transfer, for details and the applicable procedure.

To register a change of name and address, the proprietor must submit an application to Sakpatenti. The application must contain the trademark number as well as the name and address of the proprietor or of the representative, both as registered in the file and as amended.

Application on change of name and address must be accompanied by respective documents (extract form the business register, articles of incorporation etc.) showing consecutive chain (if any) of changes from the information recorded in the trademark register to the final name and address. Sakpatenti will accept declaration of trademark holder as a proof of change of name and address if all information in the declaration is presented in a clear and precise manner.

Legal persons may only have one official address. In case of doubt, the examiner may ask for evidence of the legal form or of the address in particular. The official name and address are also used as the address for service by default. A proprietor should have only one address for service. In order to ensure the veracity and correctness of the Register, a change in the proprietor's official name or official address will be registered for all trademarks, designs and pending proceedings of this entity in the name of that proprietor. Unlike the address for service, a change in the official name or address cannot be registered solely for specific portfolios of rights. These rules apply to representatives by analogy.

4 Changes in Collective Mark Regulations

The amendment of the regulations governing the use of a collective trademark will not be entered in the trademark Register if the amended regulations do not satisfy the requirements of Articles 31 and 32 of the **Law**.

Where the registration of the amendment of the regulations is accepted, it will be registered and published.

The applicant for the amendment will specify the part of the amended regulations to be entered in the trademark Register, which can be as follows:

- the trademark proprietor's name and address;
- the purpose of the association or the purpose for which the legal person governed by public law is constituted;
- the bodies authorised to represent the association or the legal person;
- the conditions for membership;
- the persons authorised to use the mark;
- where appropriate, the conditions governing use of the mark, including sanctions;
- if the mark designates the geographical origin of goods or services, authorisation for any person whose goods or services originate in the geographical area concerned to become a member of the association.

~~Within 3 months of the publication of the amended regulations, third parties whose rights may be affected by the amendment may challenge the registration thereof. For this procedure, the provisions on third party observations apply mutatis mutandis.~~

Section 2. Trademarks as objects of property

Chapter 1 - Transfer

1. Introduction

A transfer is the change in ownership of the property rights in a trademark or a trademark application from one entity to another. Trademarks and trademark applications may be transferred from the current proprietor to a new proprietor, primarily by way of assignment or legal succession. Unless otherwise provided, the practice applicable to trademarks is also applicable to trademark applications.

The transfer may be limited to some of the goods or services for which the mark is registered or applied for (partial transfer). In contrast to a licence the transfer of a trademark cannot affect the unitary character of the trademark. Therefore, trademark cannot be 'partially' transferred for **some** regions of Georgia.

Both registered designs and applications for a design may also be the subject of a transfer.

Transfers of trademarks are entered in the trademark Register.

The registration of a transfer is not a condition for its validity. However, if a transfer is not registered by Sakpatenti, the successor may not invoke the rights arising from the trademark. Moreover, the new proprietor will not receive communications from Sakpatenti, in particular, during *inter partes* proceedings, nor the notification of the renewal period of the mark.

1.1 Transfers

A transfer of a trademark involves two aspects, namely the validity of the transfer between the parties and the impact of a transfer on proceedings before Sakpatenti, which will only be triggered after the entry of the transfer in the trademark Register (see paragraph 1.2 below).

Regarding the validity of the transfer between the parties, the **Law** allows a trademark to be transferred independently of any transfer of the undertaking to which it belongs.

1.1.1 Assignment

When a transfer is made by an assignment, it is only valid where the assignment is made in writing and is signed by both parties, except where the assignment is the result of a court decision.

1.1.2 Inheritance

When the proprietor of a trademark dies, the heirs will become proprietors of the trademark by way of individual or universal succession. This is also covered by the rules on transfers.

1.1.3 Merger

A universal succession also exists when there is a merger between two companies that leads to the formation of a new company, or an acquisition by one company taking over another. Where the whole of the undertaking to which the mark belongs is transferred, there is a presumption that the transfer includes the trademark unless, in accordance with the law governing the transfer, an agreement to the contrary was made or unless circumstances clearly dictate otherwise.

1.2 Application to register a transfer

A transfer becomes relevant in proceedings before the Sakpatenti if an application to register a transfer has been made and the transfer has been entered in the Register.

However, in the period between the date when Sakpatenti receives the application to register a transfer and the date of registering the transfer, the new proprietor may already make submissions to Sakpatenti with a view to observing time limits. For example, if a party has applied to register the transfer of a trademark application against which Sakpatenti has raised objections on absolute grounds, the new proprietor may reply to those objections (see paragraph 5 below).

In an application for registration of a transfer, Sakpatenti will only examine whether sufficient evidence of the transfer has been submitted.

2. Transfers v Changes of Name

A transfer must be distinguished from a change of name of the proprietor.

A change in the name of the proprietor is a change that does not affect the identity of the proprietor, whereas a transfer is a change in the identity of the proprietor.

In particular, no transfer is involved when a natural person changes his/her name due to marriage, or following an official procedure for changing a name, or when a pseudonym is used instead of the proper name, etc. In all these cases, the identity of the proprietor is not affected.

Where the name or the corporate status of a legal person changes, the criterion for distinguishing a transfer from a mere change of name is whether or not the identity of the legal person remains the same. If the identity remains the same, it will be registered as a change of name. In other words, where there is no termination of the legal entity (such as would occur in the case of a merger by acquisition, where one company is completely absorbed by the other and ceases to exist) and no start-up of a new legal entity (e.g. as would be the case following the merger of two companies leading to the creation of a new legal entity), there is only a change in the formal corporate organization that already existed, and not in the actual identity itself. Therefore, the change will be registered as a change of name, where appropriate.

For example, if a trademark is in the name of Company A and, as the result of a merger, this company is absorbed by Company B, there is a transfer of assets from Company A to Company B.

Likewise, during a division of Company A into two separate entities, one being the original Company A and the other being a new Company B, if the trademark in the name of Company A becomes the property of Company B, there is a transfer of assets.

Normally, there is no transfer if the company registration number in the national register of companies remains the same.

If Sakpatenti has any doubt about the national law applicable to the legal person concerned, it may require appropriate information from the applicant for registration of the change of name.

Therefore, unless ruled to the contrary under the applicable national law, the change of company type, provided that it is not accompanied by a transfer of assets carried out by means of a merger or an acquisition, will be treated as a change of name and not as a transfer.

However, if the change of company type is the result of a merger, a division or a transfer of assets, depending on which company absorbs or is separated from the other, or on which company transfers which assets to the other, it may be a case of transfer.

2.1 Erroneous application to register a change of name

When a request is made to register a change of name, but the evidence shows that it is actually a transfer of a trademark, Sakpatenti informs the applicant accordingly and invites it to file an application for registration of a transfer within a specified period and to pay difference in the fee. If the applicant agrees and files the corresponding application to register a transfer and pays respective fee, the transfer will be registered. If the applicant does not modify its request and insists on registering the change as a change of name, or if it does not respond, the request to register a change of name will be rejected.

A new application for the registration of the transfer may be filed at any time.

2.2 Erroneous application for the registration of a transfer

When an application is made to register a transfer, but what is involved is actually a change of name of a trademark, Sakpatenti informs the applicant accordingly and invites it to give, within a specified period, its consent to register the indications concerning the proprietor in the trademark Register. If the applicant agrees, the change of name will be registered and difference in fee will be returned to the applicant. If the applicant does not agree and insists on registering the change as a transfer, or if it does not respond, the application for the registration of a transfer will be rejected.

3. Formal and Substantive Requirements for an Application for Registration of a Transfer

It is strongly recommended that the application for registration of a transfer for a trademark be submitted electronically via Sakpatenti's website. Using electronic filing system has advantages, such as the automatic receipt of electronic confirmation of the application.

3.1 Languages

The application for the registration of a transfer for a trademark application must be made in Georgian language.

Any supporting documents may be filed in foreign language. This applies to any document submitted as proof of the transfer, such as a countersigned transfer document or a transfer certificate, a deed of assignment or an extract from a trade register or a declaration agreeing to register the successor in title as the new proprietor.

When the supporting documents are submitted in foreign language Sakpatenti requires its certified translation in Georgian. Sakpatenti will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

3.2 Application for registration of a transfer filed for more than one mark

A single application for the registration of a transfer for two or more trademarks may be submitted only if the registered proprietor and beneficiary, or assignee, are the same in each case. However, transfer fee will be calculated per trademark assigned and not per application.

Separate applications are necessary when the original proprietor and the new one are not identical for each mark. For example, this is the case where there is one successor in title for the first mark and there are multiple successors in title for another mark, even if the successor in title for the first mark is among the successors in title for the other mark. It is immaterial whether the representative is the same in each case.

When a single application is filed in such cases, Sakpatenti will issue a deficiency letter. The applicant may overcome the objection either by limiting the application for the registration of the transfer to those trademarks or trade ark applications for which there is only one and the same original proprietor and only one and the same new proprietor, or by declaring its agreement that the application should be dealt with in two or more separate proceedings. Otherwise, the application for registration of a transfer will be rejected in its entirety.

3.3 Parties to the proceedings

The application for registration of a transfer may be requested at Sakpatenti by:

1. Trademark proprietor(s), or
2. Trademark proprietor(s) jointly with the assignee(s), or
3. Assignee(s).

The formal conditions with which the application must comply depend on who submits the application.

3.4 Formal requirements

3.4.1 Indications concerning the trademark and the new proprietor

The application for registration of a transfer must contain the following information:

1. The registration number of the trademark concerned. If the application relates to several Trademarks, each of the registration numbers must be indicated.
2. The details of the new proprietor. In the case of a natural person, the name, address and ID number must be indicated. In the case of a legal entity, the application must indicate the official designation and the legal form of the entity, which may be abbreviated in a customary manner (for example, LLC, JSC etc). The company's national identification number may also be specified, if available.
3. If the new proprietor designates a representative, the representative's name and ID number.

For additional requirements in cases of partial transfer, see paragraph 4 below.

3.4.2 Signatures

The requirements concerning the person entitled to file the application for registration of the transfer and the signatures must be considered together with the requirement to submit proof of the transfer. The principle is that the signatures of the original proprietor and the new proprietor must appear together or separately on the application for registration of the transfer or in an accompanying document. In the case of co- ownership, and where the transfer

concerns the ownership as a whole, all co-owners must sign or appoint a common representative.

When the original proprietor and the new proprietor both sign the application for registration of the transfer, this is sufficient and no additional proof of the transfer is necessary.

When the original proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration signed by the successor in title stating that it agrees to the registration of the transfer, this is sufficient and no additional proof is necessary.

When the new proprietor is the applicant for registration of the transfer and where the application is accompanied by a declaration, signed by the original proprietor, stating that it agrees to the registration of the successor in title as the new proprietor, this is also sufficient and no additional proof is necessary.

When the original proprietor's representative is also appointed as the new proprietor's representative, the representative may sign the application for registration of the transfer on behalf of both the original and the new proprietor, and no additional proof is necessary. However, when the representative signing on behalf of both the original and the new proprietor is not the representative on file (i.e. in an application simultaneously appointing the representative and transferring the trademark), Sakpatenti will contact the applicant for registration of the transfer to request evidence of the transfer (authorisation signed by the original proprietor, proof of transfer, confirmation of the transfer by the original proprietor or its representative on file).

3.5 Proof of transfer

A transfer may be registered only when it is proven by documents duly establishing the transfer, such as a copy of the deed of transfer. However, as already highlighted above, a copy of the deed of transfer is not necessary when:

- the new proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the original proprietor (or its representative) stating that it agrees to the registration of the transfer to the successor in title; or
- the original proprietor or its representative submits the application for registration of the transfer on its own together with a written declaration signed by the new proprietor (or its representative) stating that it agrees to the registration of the transfer; or
- the application for registration of the transfer is signed by both the original proprietor (or its representative) and by the new proprietor (or its representative); or
- when the application for registration of the transfer is accompanied by a completed transfer form or document signed by both the original proprietor (or its representative) and by the new proprietor (or its representative).

Parties to the proceedings may also use the forms established under the Trademark Law Treaty available on WIPO's website (<http://www.wipo.int/treaties/en/ip/tlt/forms.html>). The relevant forms are the 'Transfer Document' — a document conceived as constituting the transfer (assignment) itself — and the 'Certificate of Transfer' — a document in which the parties to a transfer declare that a transfer has taken place. Either of these documents, duly completed, constitutes sufficient proof of transfer.

However, other means of proof are not excluded. Therefore, the agreement (deed) itself or any other document proving the transfer may be submitted.

When the mark has been subject to multiple successive transfers and/or changes of the proprietor's name that have not been previously registered in the register, it is sufficient to submit the chain of evidence showing the events leading to the relationship between the

original proprietor and the new proprietor without the need to file separate individual applications for each change. However, the applicant shall pay the prescribed fee per each assignment.

When the transfer is due to a merger or another universal succession, the original proprietor will not be available to sign the application for registration of transfer. In this case, the application must be accompanied by supporting documents that prove the merger or universal succession, such as extracts from the trade register.

When the transfer of the mark is a consequence of a right *in rem*, a levy of execution or insolvency proceedings, the original proprietor will not be able to sign the application for registration of transfer. In these cases, the application must be accompanied by a final decision issued by a competent national authority transferring the ownership of the mark to the beneficiary.

It is not necessary to legalise supporting documents.

If Sakpatenti has reason to doubt the accuracy or veracity of the document, it may require additional proof.

Sakpatenti will examine the documents only to the extent that they actually confirm what is indicated in the application, namely the identity of the marks concerned and the identity of the parties, and whether a transfer is involved. Sakpatenti does not consider or rule on contractual or legal questions.

3.5.1 Translation of proof

The evidence must be in Georgian language. Where the supporting documents are submitted in foreign language Sakpatenti requires their certified translation into Georgian. Sakpatenti will set a time limit to submit the translation. If the translation is not submitted within the time limit, the document will not be taken into account and will be considered not to have been submitted.

3.6 Procedure to remedy deficiencies

Sakpatenti will inform the applicant for registration of the transfer in writing of any deficiencies in the application. If the deficiencies are not remedied within the time limit established in that communication, Sakpatenti will reject the application for registration of the transfer. The party concerned may file an appeal against the decision through administrative procedure.

3.7 Collective marks

According to Article 30 of the **Law** transfer of collective mark is prohibited.

4 Partial Transfers

A partial transfer concerns only some of the goods and services in the trademark and is only applicable to trademarks.

It involves the distribution of the original list of goods and services between the remaining trademark and a new one. When partial transfers are involved, Sakpatenti uses particular terminology to identify the marks. At the beginning of the proceedings there is the 'original' mark. This is the mark for which a partial transfer has been applied. After the registration of the transfer, there are two marks: one is a mark that now has fewer goods and services, and is called the 'remaining' mark, and one is a 'new' mark that has some of the goods and services from the original mark. The 'remaining' mark retains the trademark registration or IR number of the 'original' mark while the 'new' mark has a same number plus letter P in case of national registrations or letter A, B or C in case of international registration.

When there are doubts as to whether the transfer is partial or not, Sakpatenti will inform the applicant for registration of the transfer and invite it to make the necessary clarifications.

Partial transfers may also be involved when the application for registration of the transfer concerns more than one trademark. The following rules apply for each trademark included in the application.

4.1 Rules on the distribution of the lists of goods and services

In the application for registration of a partial transfer, the goods and services to which the partial transfer relates must be indicated (the list of goods and services for the 'new' registration). The goods and services must be distributed between the original trademark and the new trademark so that the goods and services in the original trademark and the new one do not overlap. The two specifications taken together must not be broader than the original specification.

Therefore, the indications must be clear, precise and unequivocal. For example, when a trademark for goods or services in several classes is involved, and the 'split' between the original and new registration concerns entire classes, it is sufficient to indicate the respective classes for the new registration or for the remaining one.

When the application to register a partial transfer indicates goods and services that are explicitly mentioned in the original list of goods and services, the Sakpatenti will automatically retain, in the original trademark, the goods and services that are not mentioned in the application to register the partial transfer. For example, the original list contains goods A, B and C, and the transfer application relates to C; Sakpatenti will keep goods A and B in the original registration and create a new registration for C.

In all cases, it is highly recommended to file a clear and precise list of goods and services to be transferred together with a clear and precise list of goods and services to remain in the original registration. Furthermore, the original list must be clarified. For example, if the original list related to *alcoholic beverages* and the transfer relates to *whisky* and *gin*, the original list must be amended by restricting it to *alcoholic beverages, except whisky and gin*.

4.2 Objections

When the application for registration of a partial transfer does not comply with the rules explained above, Sakpatenti will invite the applicant to remedy the deficiency. If the deficiencies are not remedied, Sakpatenti will reject the application for registration of a partial transfer. The party concerned may file an appeal against the decision through administrative procedure.

4.3 Creation of a new trademark

A partial transfer leads to the creation of a new trademark. For this new trademark, Sakpatenti will establish a separate file, which will consist of a complete copy of the electronic file of the original trademark, the application for registration of a transfer, and all the correspondence related to the application for registration of the partial transfer. The new trademark will be given a new file number which will repeat registration number of original trademark with addition of Latin letter "P". It will have the same filing date and, where applicable, date of priority as the original trademark.

As far as the original trademark is concerned, Sakpatenti will include a copy of the application for registration of a transfer in its files but will not normally include copies of the further correspondence relating to the transfer application.

5 Entry in the Register, Notification and Publication

5.1 Publication and Entry in the Register

Sakpatenti will enter the transfer in the trademark Register and publish it in the trademark Bulletin. The entry will be published once the trademark application has been published pursuant to Article 19(2) of the **Law**.

The entry in the trademark Register will mention the following data:

- the date of registration of the transfer,
- the new proprietor's name and address,
- the name and address of the new proprietor's representative, if any.

For partial transfers, the entry will also contain the following data:

- the number of the original registration and the number of the new registration,
- the list of goods and services remaining in the original registration, and
- the list of goods and services of the new registration.

Chapter 2 Licences

1 Introduction

Registered trademarks may be the subject of licensing contracts (licences).

1.1 Definition of licence contracts

A trademark licence is a contract by virtue of which the proprietor of a trademark (the licensor), whilst retaining ownership, authorises a third person (the licensee) to use the trademark in the course of trade, under the terms and conditions set out in the contract.

A licence refers to a situation where the rights of the licensee to use the trademark arise from a contractual relationship with the proprietor. The proprietor's consent to, or tolerance of, a third party using the trademark does not amount to a licence.

2 Requirements for an Application for Registration of a Licence

The application for registration of a licence must comply with the following conditions.

2.1 Application form

It is strongly recommended that the application for registration of a licence for a trademark be submitted electronically via Sakpatenti's website. Using e-filing system has advantages, such as the automatic receipt of electronic confirmation of the application and to monitor process of registration of licence agreement.

A single application for the registration of a licence for two or more trademarks may be made only if the registered proprietor and the licensee are the same and the contracts have the same conditions, limitations and terms in each case.

2.2 Languages

The application for the registration of a licence for a trademark must be made in Georgian.

2.3 Fees

The application for the registration of a licence is considered not to have been made until the fee is paid. The amount of this fee is USD 90 per each trademark or design which shall be paid in Georgian Lari according to exchange rate set by NBG on the day of payment.

2.4 Parties to the proceedings

2.4.1 Applicants

An application for the registration of a licence may be filed by:

1. the trademark proprietor(s); or
2. the trademark proprietor(s) jointly with the licensee(s) or
3. the licensee(s)

2.4.2 Mandatory indications concerning the trademark and the licensee

The application for registration of a licence must contain the following information:

1. The registration number of the trademark concerned. If the application relates to several trademarks, each of the registration numbers must be indicated.
2. The licensee's name, address and ID number (where possible)
3. Term of licence which shall not exceed remaining term of trademark registration
4. Territory of licence.
5. Type of licence
6. List of licensed goods and services.

2.4.3 Signatures

The general rules on signatures apply (see the Guidelines, Part A, General Rules, Section 1, Means of Communication, Time Limits).

2.4.4 Proof

For the special provisions and specific requirements with regard to proof, see the paragraphs below.

2.5 Examination of the application for registration

2.5.1 Fees

Where the required fee has not been received, within one month from filing date of application, Sakpatenti will notify the applicant and invite to pay fee for recordal of licence. If applicant fails to pay prescribed fee in due time determined by Sakpatenti, application will be rejected.

New application may be filed any time.

2.5.2 Examination of the mandatory formalities

Sakpatenti will check whether the application for registration of the **licence** has been duly signed.

Sakpatenti will inform the applicant in writing of any deficiencies in the application. If the deficiencies are not remedied within the period established in that communication, Sakpatenti will reject the application for registration of the right. The party concerned may file an appeal against this decision.

Section 3 Renewal

1. Terms of Registration of Trademarks

The term of registration of a trademark is 10 years from the **registration date of a trademark**. For example, trademark with registration date of 16/03/2021 will expire on 16/03/2031.

A registration may be renewed indefinitely for further periods of 10 years.

2. Notification of Expiry of Registration

At least 6 months before the expiry of the registration, Sakpatenti will inform the registered proprietor/holder of the trademark that the registration is approaching expiry.

Failure to give such information does not affect the expiry of the registration and does not involve the responsibility of Sakpatenti.

3. Fees and Other Formal Requirements for the Request for Renewal

The general rules concerning communications to Sakpatenti apply (see the Guidelines, Part A, Section 1, Means of Communication,), which means that the request may be submitted in the following ways:

- By electronic means available on Sakpatenti website or by email: info@sakpatenti.gov.ge
- By transmitting a signed original application directly

A single application for renewal may be submitted for two or more trademarks upon payment of the required fees for each trademark.

4. Persons who may submit a request for renewal

The request for renewal may be submitted by the registered proprietor/holder of the trademark or his/her representative.

5. Content of the request for renewal

The request for renewal must contain the following: name and address of the person requesting renewal and the registration number of the trademark to be renewed. In the case of a trademark renewal, the extent of the renewal is deemed to cover the full specification by default.

6 Languages

The request for renewal shall be filed in Georgian language.

7. Time limits

7.1 Six-month period for renewal before expiry (basic period)

For trademarks, the request for renewal and the renewal fee must be submitted in the 6- month period prior to the expiry of the registration.

For example, where the trademark has a registration date of 10/06/2010, the day on which protection ends will be 10/06/2020. Therefore, a request for renewal must be introduced and the renewal fee paid as from 11/12/2019 until 10/06/2020 or, where this is a Saturday, Sunday or other day on which Sakpatenti is closed, or does not receive ordinary mail, the first following working day on which Sakpatenti is open to the public and receives ordinary mail.

7.2 Six-month grace period following expiry (grace period)

Where the trademark is not renewed within the basic period, the request may still be submitted and the renewal fee may still be paid, upon payment of an additional fee within a further period of 6 months.

For example, where the trademark has a registration date of 10/06/2010, the day on which protection ends will be 10/06/2020. Therefore, the grace period during which a request for renewal may still be introduced upon payment of the renewal fee plus the additional fee is counted from the day after 10/06/2020, namely from 11/06/2020, and ends on 10/12/2020 or, if 10/12/2020 is a Saturday, Sunday or other day on which Sakpatenti is closed, or does not receive ordinary mail the first following working day on which Sakpatenti is open to the public and receives ordinary mail. This also applies if the above example 11/06/2020 was a Saturday or Sunday; the rule that a time limit to be observed vis-à-vis Sakpatenti is extended until the next working day applies only once and to the end of the basic period, and not to the starting date of the grace period.

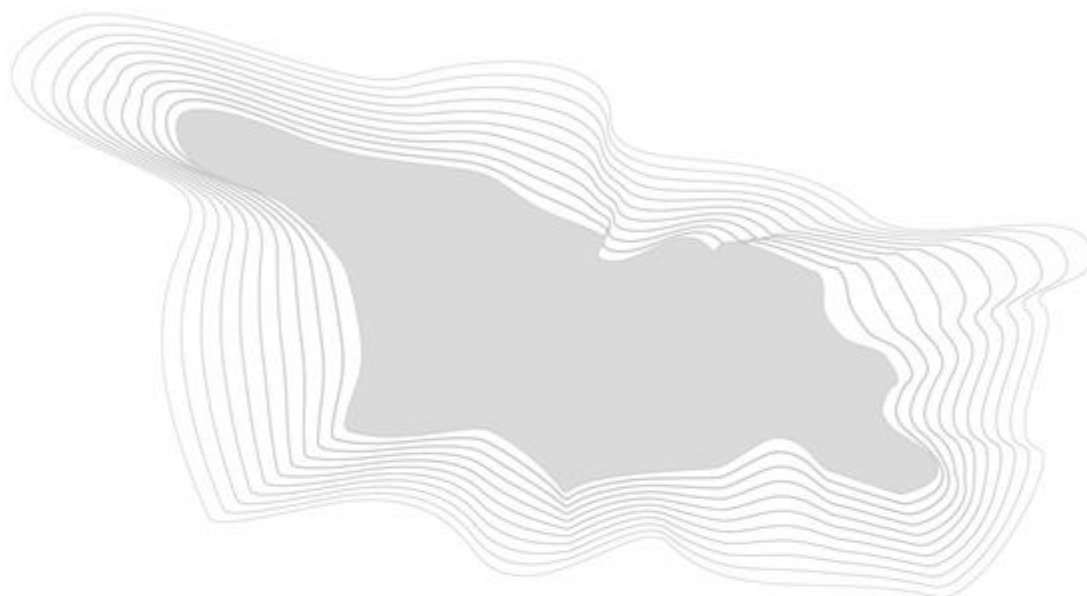
During the 6-month grace period, the only action that may be carried out in a trademark is the payment of the renewal fee. In the event Sakpatenti receives any other request during the grace period, such as a transfer, registration of a licence surrender, change of name, etc. or any other request for entry into the Registers, Sakpatenti will put the request on hold until the renewal fee is paid. Only once the renewal fee is paid in full, and the trademark is officially renewed, will Sakpatenti examine any requests that had been placed on hold.

8 Renewal Fees

Object	Renewal Fee
Trademark for one class	USD 300
Trademark for each additional Class	USD 50



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