

TRADEMARK LAW SEMINAR

REGISTRABILITY OF TRADEMARKS

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REGISTRABILITY DEPENDS ON:

ABSOLUTE GROUNDS:

- Distinctiveness
- Not descriptive
- Not common place
- Not deceptive

RELATIVE GROUNDS - (earlier rights):

- No likelihood of confusion
- No dilution of fame

DISTINCTIVENESS

Art. 7.1.b of Reg. 2017/1001

Distinctiveness = capable of distinguishing the goods or services of one undertaking from those of other undertakings.

- is assessed mainly in view of the **origin function**,
- is assessed in view of the **goods/services applied for**,
- is assessed in view of the **perception of the public**,
- the **test** is the **same for all types of marks**, although the **perception of the public differs for certain types of marks** and this may make it more difficult to establish distinctiveness,
- there is **no assumption or presumption** in favor of lack of distinctiveness.

(cases Borco, 2010 & Erpo Moebelwerk 2004)

WHO determines distinctiveness?

The “**public**”, i.e. the average consumer who is reasonably well informed and reasonably observant, as well as “**intermediaries**” as the case may be.

***(Philips v. Remington &
Bjoerneckulla v. Procordia)***

WHERE ?

Distinctiveness is assessed on the basis of the local practice and **local market**. Marks registered abroad can be taken into account, but they are not binding.

(Henkel)

Because of linguistic, cultural and other differences among member states, **a mark can be distinctive in one member state, but not in another.**

The fact that a term is a common vocabulary word in a member state and hence devoid of any distinctive character in that member state, does not preclude its registration in other member state where it is not understood as a common vocabulary word.

(Matratzen)

WHEN ?

The crucial moment is the **date of the application**.

However, future uses that are reasonably foreseeable should also be taken into account.

(Pure Digital)

FOR WHAT?

Distinctiveness is assessed in connection to **specific goods/services**; not in the abstract. The respective goods/services are those mentioned in the application.

The core of distinctiveness is whether the mark can distinguish the goods/services of one undertaking from those of other undertakings; hence, distinctiveness is assessed in view of the functions of the trademark, in particular the **origin function and the quality guarantee function**.

(Philips v. Remington)

SAT.2 , 2004

Registration was sought for the mark SAT.2 for tv channels.

SAT (=satellite)

OHIM considered it lacked distinctiveness but the ECJ found otherwise.

Held:

Distinctiveness does not depend on creativity or imagination; that is, originality and imagination are not prerequisites to establish distinctiveness. It suffices that the public can perceive the mark as an indication of origin.

The frequent use of mark consisting of an abbreviation and a number in the telecommunications sector indicates that such a combination is distinctive.

Babydry (ECJ, C-383/99 P, 20.9.01, accepted)

Doublemint (ECJ, C-191/01 P, 23.10.03, rejected)

Biomild (ECJ, C-256/00, 12.2.04, rejected)

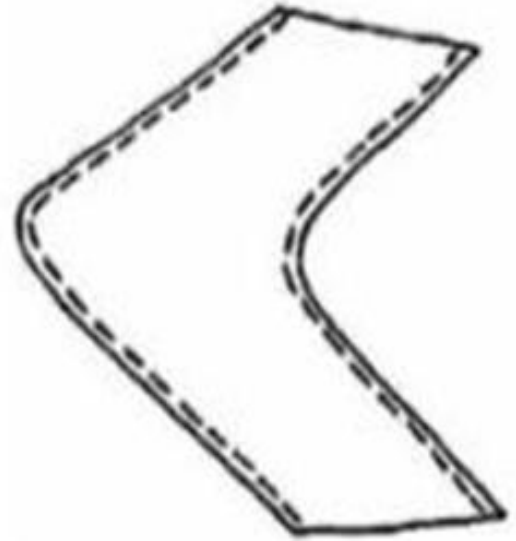
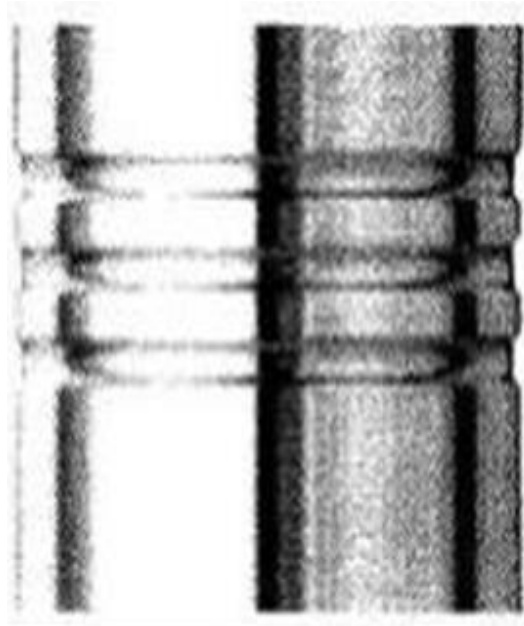
Truewhite (General Court, T-208/10, 7.7.11, rejected)

Compare:

1. Babydry *and* Doublemint, Biomild, Truewhite
2. SAT.2 *and* Doublemint, Biomild, Truewhite

are these cases consistent ?

HOW ABOUT THE FOLLOWING?



No presumption for or against registrability

Baby Dry (ECJ):

presumption in favor of registrability

Postkantoor, Libertel, Linde (ECJ):

No presumption

Third party interests: The examination is carried out in favor of third party interests (honest traders) – Euroland, Cycling is...

SHAPE MARKS (Three Dimensional Marks)

- **Functional** shape marks do not qualify as trademarks.
- If the features of a shape mark are dictated by a desired functional result, the shape is not distinctive, i.e. cannot distinguish the goods of one undertaking from those of another undertaking.
- Trademarks cannot be used to obtain perpetual exclusive rights over technical solutions.

PHILIPS v. REMINGTON 2002:



Functional Shape Marks. This case related to a shape mark consisting in a three headed shaving device.

A shape is functional and hence not registrable if its features are essential to achieve a certain technical result (**Technical Functionality**).

Such a shape cannot acquire distinctiveness through use.

A similar case:

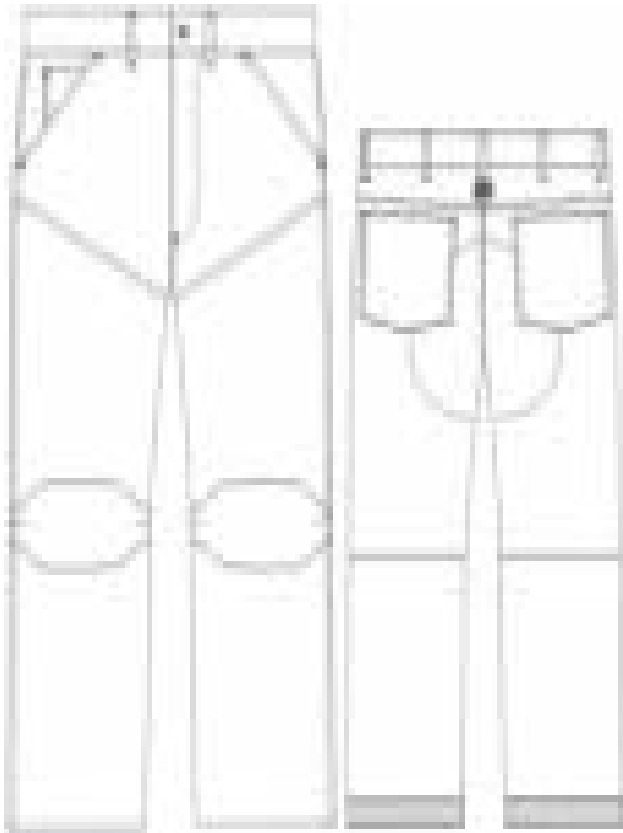
LEGO (2010)

technical functionality prevents registration.

BENETON / G-STAR (2007)

Esthetic Functionality

An attempt to register the **shape of the Elwood trousers**, arguing that this shape has acquired distinctiveness through advertising.



Esthetic functionality giving substantial value to the product.

The shape of the product which gives substantial value to that product cannot constitute a trademark; it cannot be registered, even on the grounds of acquired distinctiveness.

Such esthetic elements can be protected as **DESIGNS** only.

WERTHER'S ORIGINAL 2006:



Shape marks and acquired distinctiveness

Registration was sought for the shape of Werther's candies and their gold colored wrapper with twisted ends.

Held:

A shape mark may acquire **distinctiveness through use, if used in conjunction with another word or figurative mark.**

LINDE / WINWARD / RADO 2003:

Shape marks and distinctiveness

Registration was sought for the shapes of (a) a lift truck, (b) a watch, (c) a flashlight.

Distinctiveness of shape marks is assessed in the same way as for other marks; **no stricter test applies to shape marks.** However, it will usually be harder to prove distinctiveness due to the **perception of the public.**



HENKEL 2004: Shape marks and distinctiveness

Registration was sought for the shape of a bottle for liquid detergents.

A shape mark is distinctive if it is **significantly different from what is common in the market** in question.

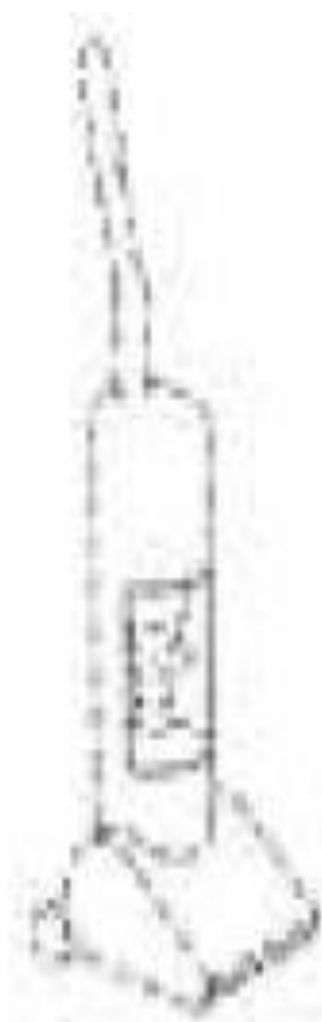
The perception of the public must be taken into account. **The perception of the public is different for shape marks, than for word and figurative marks.**



DYSON 2007: graphical representation

Registration was sought for a transparent external collecting bin of a vacuum cleaner in all conceivable forms. That is, the subject matter of the application was an exclusive right to use transparent external collecting bins in vacuum cleaners.

Although a specific and precise (i.e. in form and colors) external collecting bin could qualify as a “sign” if the requirement for acquired distinctiveness were in place, particularly since no other used transparent external collecting bins, however, in the present case the application was expressly stated to be one in “all conceivable forms” and rendered it to be “non precise”. Such an application was actually seeking to prevent other competitors from using external transparent collecting bins in vacuum cleaners and this was an abuse of trademark law to restrict free competition.



SMELL MARKS (olfactory marks)

Sieckmann 2002

Registration was sought for a smell mark represented by a chemical formula.

The signs' list of Art. 2 is not exhaustive.

Non visual marks can be registered if they can be represented graphically (i.e. to be represented in some visual form, i.e. through images, lines, other characters, etc.).

The graphic representation must be clear, precise, intelligible, durable and objective.

Such graphic representation is necessary for:

- Identifying the mark in an objective and secure way,
- Determining the subject matter of legal protection,
- Creating a registry.

A chemical formula does not comply with the above prerequisites to be able to identify a smell. It does not describe the smell, but the substance.

Words describing the smell do not qualify either, as it is not clear, precise and objective.

Depositing a sample does not qualify as it is not durable.

A combination of the above would also fail.

SOUND MARKS

Shield Mark 2003

Registration of sound mark was sought.

The graphic representation was in the form of musical notes in a musical stave with a clef.

Art. 2 does not prohibit registration of non-visual marks.

Sound marks can be distinctive.

Sound marks can be represented graphically in the form of musical notes in a musical stave with a clef.

A description of the sound with words or an onomatopoeia would not suffice.

COLOR MARKS

Libertel 2003

Registration was sought for the orange color. The graphic representation consisted in the orange color accompanied by the respective international identification code of this color.

A color alone can be distinctive.

A single color would require acquired distinctiveness; registration of a single color without prior use would be particularly difficult.

Regard must be had to the interest of other competitors not to restrict the number of colors available to them.

A graphic representation consisting only in the color as such is not sufficient; an internationally recognized color identification code is required.

Color combinations

Heidelberger Bauchemie 2004

Registration was sought for the combination of blue and yellow colors. The application mentioned that registration was sought for the combination of the two colors “in all conceivable forms”.

Color combinations are distinctive, but not in “all possible conceivable forms”; this would amount to many different combinations of the same colors and not to a single combination. Such a representation would not be precise.

PERSONAL NAMES

Common Family Names, Surnames

Nichols 2004

Personal names, even common family names, can be distinctive.

Distinctiveness of personal names, even common ones, is assessed with the same criteria as in other trademarks; **no stricter test applies.**

The limitation of rights of **art. 6.1 has no impact** on the assessment of distinctiveness.

SLOGANS

Distinctiveness

Erpo Moebelwerk 2004

The distinctiveness criteria are the same for all types of marks.

However, the public's perception differs. Hence, the level of difficulty to establish distinctiveness is different for each type of mark.

The problem with slogans is that they need to be **something more than mere proclamations**; they need to have a level of uniqueness and originality, otherwise they cannot perform the origin function.

LETTERS

Borco 2010

Registration was sought for the mark “α” (the Greek letter a) with no special logo, i.e. in common letters.

At first instance it was held that the absence of special logo resulted to an assumption of lack of distinctiveness. However, the ECJ held that:

- there can be no assumption for lack of distinctiveness,
 - D. is assessed in view of the goods/services applied for,
 - D. is assessed in view of the perception of the public,
- the test is the same for all types of marks, although the perception of the public differs for certain types of marks and this may make it more difficult to establish distinctiveness.

SPECIFICATION OF GOODS / SERVICES

RETAIL SERVICES TRADEMARKS

Praktiker 2005

Registration was sought for retail services. Retail services are the services offered by large department stores. Such services include: (a) selecting a range of similar products and presenting them to consumers, (b) informing consumers about the features of each product, (c) assisting consumers to make a choice, (d) inducing consumers to make a purchase, etc.

The legal issue was whether retail services fall within the concept of “services” under the Directive. The main concern was whether such a trademark would function as an indication of origin, since the goods do not originate from the department store itself. Another issue is how specific should the description of such services be.

Held:

- Retail services qualify as services under the Directive.
- Retail services marks function as indications of origin for the respective services, not for the goods.
- It is not necessary to indicate in details the particular activities and services for which registration is sought. A description that would suffice is: “bringing together a variety of goods, thus enabling consumers to conveniently view and purchase”.
- However, the application must also indicate the specific goods, or types of goods, for which such retail services will be offered.

JARMAN & PLATT v. BARGET

Louis chairs not distinctive

HODGKINSON & CORBY v. WARDS MOBILITY

Egg box prosthetic cushions not distinctive

P & G v. OHIM

DEVELEY v. OHIM

Functionality fist

Distinctiveness afterwards

PHILIPS V. REMINGTON

LINDE/WINWARD/RADO

No perpetual rights

BENETTON v. G STAR

No acquired distinctiveness over value adding shapes

DYSON

Transparency is a concept

Transparency is functional

A concept is not a sign

P & G v. OHIM

The shape of washing tablets

Compound marks

A combination of shape elements may be functional

WHIRPOOL v. KENWOOD

No protection against stylistic imitation

PHILIPS v. REMINGTON

Functional shapes not distinctive

BENETTON v. G. STAR

Aesthetic functionality not registrtable

LINDE/WINWARD/RADO

Same test
Perception of public differs

HENKEL

Significantly different from what is common in the market

WERTHER'S ORIGINAL

Acquired distinctiveness possible, even if shape used
in connection with word or figure

DESCRIPTIVE TERMS

Art. 7.1.c of Regulation 2017/1001:

WHAT TERMS ARE DESCRIPTIVE ?

“... trademarks which consist exclusively of signs or indications which *may* serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services...”

Public policy: freedom of competition

There is a public policy behind absolute grounds. That is to strike a balance among exclusive trademark rights and **free competition**. This means that signs that are descriptive must be “kept free for use by all” to preserve free competition. **Foreseeable future uses** should also be taken into account. Note that the phrasing of the Directive is that the signs that cannot be registered are those that are “**exclusively**” descriptive.

*(Windserfing Chiemsee
Doublemint / Wrigley by ECJ
Campina Melkunie - BIOMILD)*

Concrete examination

Descriptiveness is assessed in view of **the specific goods/services** mentioned in the application; not in the abstract.

(Linde, Winward, Rado)

Same criteria for all types of marks

Descriptiveness is assessed on the basis of the **same criteria for all types of marks**. However, the perception of the public has to be taken into account and since such **perception differs for each type of marks**, it may be more difficult to establish that certain types of marks are not descriptive.

(Linde, Winward, Rado)

Foreseeable future uses

In assessing descriptiveness foreseeable future uses that should be kept free to all to preserve free competition should also be taken into account.

(Windsurfing Chiemsee)

The word “**may**” in art. 3.3 should be construed as meaning “**reasonably likely to**” come into descriptive use in the future.

(Doublemint, i.e. Wrigley)

Descriptive word marks

Doublemint 2003 (ECJ judgment, also known as ***Wrigley***)

Registration was sought for the term **“DOUBLEMINT”** (a neologism consisting of **double + mint**) for chewing gum.

It was argued that DOUBLEMINT had **more than one different meanings**, i.e. two different flavors of mint, or a double dose of mint. Hence, the term was not *exclusively* descriptive. - The ECJ rejected this interpretation and clarified that **absolute grounds should be construed in view of the justification behind them, which was to strike a balance among exclusive rights and free competition.**

A word mark cannot be registered if it indicates the characteristics of the product in one of its possible meanings.

Neologisms

Combinations of descriptive terms

Campina Melkunie – BIOMILD, 2004

*Registration was sought for the mark **BIOMILD** (= **biological + mild**) for foodstuffs (i.e. yogurt).*

Combinations of descriptive terms are descriptive, unless there is **a perceivable difference among the combination and its parts.**

It is irrelevant whether there are, or not, synonyms that are available to describe the same characteristics.

Postkantoor (KPN), 2004

*Registration was sought for the term **POSTKANTOOR (=post office in Dutch)** in connection to paper, stationery, insurance, postage stamps, telecommunications, transport, education, etc.*

In assessing descriptiveness one should take into account all relevant facts and circumstances.

Registration in other countries is irrelevant.

Existence of synonyms is irrelevant.

A combination must have added value.

Descriptiveness for certain goods does not mean that the term is distinctive for other goods.

Baby Dry (P&G) 2001

The ECJ found the mark BABY DRY to be registrable for baby slips, on the ground that this combination consisted of an unusual syntactic juxtaposition that resulted to an unusual expression.

However, it is generally believed that this judgment has been abandoned after the judgments in DOUBLEMINT, BIOMILD and POSTKANTOOR.

GEOGRAPHICAL TERMS and descriptiveness

Windsurfing Chiemsee 1999

In determining whether a geographical term is descriptive, one should take into account if it designates to the relevant public the origin of the goods or services concerned, or whether it may reasonably assume that it may establish such an association in the future.

To determine this one must assess:

The degree of familiarity with the geographical term,

The characteristics of the designated place,

The goods concerned.

Objections to registrability can be raised if the geographical term can be used to indicate certain features of the respective goods, or the place of manufacture, etc.

Registration of geographical terms can be sought on the basis of acquired distinctiveness, i.e. if secondary meaning has been developed. To assess this, the factors are:

- Market share
- Longevity of use
- Geographical diffusion of use
- Intensity of use
- The proportion of the public understanding the term as an indication of the source of origin of the goods,
- Statements from chambers of commerce.

GEOGRAPHICAL TERMS

CONCLUSION from CHIEMSEE

A geographical term is descriptive, if it may serve to indicate the geographical origin of the products.

Acquired distinctiveness is possible.

Generic terms

never registrable

Directly Descriptive terms

registrable if acquired distinctiveness obtained

Indirectly descriptive terms

always registrable

Laudatory terms

always registrable (*controversial*)

Common terms in non common use

Always registrable

Imaginary terms

Always registrable

Generic terms

CEREALS, BEVERAGE, FOODSTUFFS

Directly descriptive terms

MARLBORO,

Indirectly descriptive terms

TYPHOON for detergents, SATEN for chocolate

Laudatory terms

PLUS, ULTRA, GOLD, SILVER

Common terms in non common use

BEAR for clothing, WHITE HORSE for whisky

Imaginary terms

ADIDAS

WHITE HORSE or BLACK & WHITE for whisky

CAMEL, for cigarettes

SANTE, for cigarettes

BEAR, for clothing

SEVENTEEN, for magazines

Common terms in non common use – Registrable

Indirectly descriptive (they only imply something – they are not directly descriptive) - Registrable

COMMON TERMS

Art. 3.1.d

Merz & Krell (BRAVO), 2001

Laudatory marks

Terms that are laudatory (i.e. an applause – usually this applies to advertising slogans) are not necessarily non distinctive or descriptive because of this. Laudatory marks are in principle registrable, because they do not describe in a direct way the respective goods/services.

The issue with laudatory marks is whether they are commonly used terms in the specific sector (art. 3.1.d).

Similar case on laudatory slogans:

***Audi v. OHIM – VORSPURNG DURCH TECHNIC
(=advancement through technology)***

Laudatory slogans are in principle registrable and slogans need not be creative or imaginary.

ACQUIRED DISTINCTIVENESS

**Distinctiveness acquired through use in the
course of trade**

Secondary (non-descriptive) meaning

Art. 3.3

ACQUIRED DISTINCTIVENESS SECONDARY MEANING

It is an argument to overcome the problem of lack of distinctiveness, descriptiveness, being a common place and sometimes deceptiveness.

Distinctiveness may be inherent or acquired.

Acquired = through use in the course of trade

WHEN? Before application, before the hearing

WHERE? Country wide, not local, not abroad

TO WHOM? To the relevant class of consumers

IN RELATION TO WHAT? Goods and services

ECJ Windsurfing Chiemsee

Use of the mark,

Exactly as applied for, or

Is use of a similar mark sufficient?

Application: **“Have a break”**

Use: **“Have a break – Have a Kit Kat”**

This was use together with another trademark.

It was found to be sufficient.

ECJ Have a break Have a Kit Kat

Use on goods/services as applied for

Use on other goods/services: Usually not sufficient, unless you can validly argue that it is possible to expand to other goods/services (Du Pont, UK)

i.e., use in chocolates, then use in ice creams

EVIDENCE OF USE

- Sales
- Advertisements
- Market surveys (not very reliable, Raffles, UK)
- Oral testimony (not always very reliable, Bach, UK)

GEOGRAFICAL TERMS and descriptiveness

Windsurfing Chiemsee 1999

In determining whether a geographical term is descriptive, one should take into account whether it designates to the relevant public the the kinds of goods or services concerned, or whether it may reasonably assume that it may establish such an association in the future.

To determine this one must assess:

The degree of familiarity with the geographical term,

The characteristics of the designated place,

The goods concerned.

Objections to registrability can be raised if the geographical term can be used to indicated certain features of the respective goods, or the place of manufacture, etc.

Windsurfing Chiemsee 1999

Registration of geographical terms can be sought on the basis of **acquired distinctiveness**, i.e. if secondary meaning has been developed. To assess this, the factors are:

- Market share
- Longevity of use
- Geographical diffusion of use
- Intensity of use
- The proportion of the public understanding the term as an indication of the source of origin of the goods,
- Statements from chambers of commerce,
- Opinion polls.

What type of use is required?

- Not only use, but **use as identifier of origin of the respective products.**
- There is a difference between use and use as identifier of origin of the respective products.
- A substantial portion of the relevant public must associate the respective mark with the respective manufacturer, that is to understand the mark as an identifier of origin from a particular undertaking, in addition to its ordinary descriptive meaning.
- In ***Philips v. Remington 1998***, the shape of a three headed electric saver was used in the course of trade, but not as an identifier of origin.

Use where ?

Throughout the territory of the respective member state; a territorially restricted use would not suffice
(EUROPOLIS)

Whose use ?

Use of the mark by the applicant is of primary importance.

Use of the mark by competitors may also be taken into account.

In all cases what must be evidenced is that consumers use the mark as an identifier of origin.

Postkantoor 2004

Acquired distinctiveness of word marks

A combination of descriptive words may acquire through use its own independent meaning, which would not be descriptive in itself and function as an indication of origin.

Have a Brake ... Have a Kit Kat, 2005

Registration was sought for the phrase “Have a Break”, which was only part of the slogan “Have a Break Have a Kit Kat”. In addition the slogan was always used in conjunction with the NESTLE trademark. Moreover, the whole slogan “Have a Break Have a Kit Kat” was a registered trademark and KIT KAT alone was a registered trademark as well.

Held:

The distinctive character of a mark may be acquired as a result of the use of that mark as part of, or in conjunction with, a registered trademark.

DECEPTIVE MARKS & BAD FAITH

ELIZABETH EMMANUEL

Elizabeth Emmanuel was the designer of garments. It had registered its personal name for such products. Later on, she assigned the business and trademark to another party. Afterwards, it claimed that later trademark applications for the mark ELIZABETH EMMANUEL by the assignee were deceptive.

Held:

- The concept of “deceptiveness” must be assessed in view of the functions of trademarks,
- Such functions include the identification of origin and quality,
- Hence, the purpose of art. 3.1.g is to protect consumers against deceptive marks,
- Deception should be addressed mainly as to the quality and features of the goods
- The risk in this case was whether consumers would be deceived in believing that Elizabeth Emmanuel was still involved with the production of the goods after the sale of the business
- The Court found that such risk would not qualify as “deceptiveness”, because the quality features of the goods remained the same even after the transfer of the business.

LINDT & SPRUENGLI, 2009 – (Chocolate Bunnies)



LINDT & SPRUENGLI, 2009 – (Chocolate Bunnies)

Several parties have been trading Christmas chocolate bunnies since 1930. Lindt & Spruengli was also trading Christmas chocolate bunnies since 1950. Lindt registered its Christmas chocolate bunny as a CTM, i.e. the shape of the product, its colors, designs and other elements accompanied by the words “Lindt Goldhase”.

A competitor was trading since 1960 his own Christmas chocolate bunny which has similar colors, designs, etc., without the words Lindt Goldhase.

It was alleged that Lindt’s registration intended to prevent competitors from using their marks.

Held:

The relevant time for bad faith is the time of filing of the application

Assessment of bad faith must be made on the basis of all available facts.

Factors to be taken into account:

- The fact that the applicant knows of or should be aware of an earlier confusingly similar mark used by another party,
- The applicant's intent to prevent third parties from using their earlier marks
- The duration of use of third parties and the respective degree of legal protection enjoyed by such third parties
- The duration of use and the degree of legal protection enjoyed by the applicant
- The reputation and fame of an earlier mark
- The reputation of the mark filed by the applicant.

Knowledge (of earlier rights) alone is not sufficient to establish bad faith; consideration must be given to the applicant's intention.

Intent to prevent third parties using their marks may establish bad faith, particularly if the applicant does not intend to use the mark for himself, but only to prevent others.

However, if there are many traders using for a long time confusingly similar marks, and one of them, who enjoys reputation, files a TRM application with the intent to prevent a newcomer from obtaining unfair advantage of the applicant's reputation, then such an application is NOT in bad faith.

MALAYSIA DIARY INDUSTRY, 2013

Malaysia Dairy had registered and used a mark (a milk bottle) in some countries, while its competitor Yakalut had registered and used the same mark in some other countries. The two companies had entered into a “settlement, use and registration” agreement through which they had settled among them such issues.

When Malaysia Dairy applied for registration in Denmark, its application was opposed by Yakalut and rejected on the ground that it was in bad faith, since Malaysia Dairy knew of Yakalut’s registrations in other member states (not in Denmark)

Held:

- Bad Faith should be interpreted on an autonomous basis according to the purposes of European law and not with reference to national laws.
- As per Lindt & Spruengli, **knowledge of earlier rights alone is NOT sufficient to establish bad faith, without reference to the intent of the applicant.**
- The Directive does not permit member states to provide in their national laws that knowledge alone (irrespective from intent) can establish bad faith.