

Common Communication on the Common Practice of Distinctiveness – Figurative Marks containing descriptive/non-distinctive words

2 October 2015

1. BACKGROUND

The IP offices of the European Trade Mark and Design Network continue to collaborate in the context of the Convergence Programme. They have now agreed on a Common Practice in relation to when a figurative mark, containing purely descriptive/non-distinctive words, passes the absolute grounds examination because the figurative element renders sufficient distinctive character.

This Common Practice is made public through this Common Communication with the purpose of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

The following issues are out of the scope of the project:

- Language issues: consider for the sake of the project that the word elements are totally descriptive/non-distinctive in your language.
- Interpretation of disclaimers: the common practice does not affect the acceptance or interpretation of disclaimers by the IP offices.
- Use of the trade mark (including acquired distinctiveness and how the mark is actually used in trade).

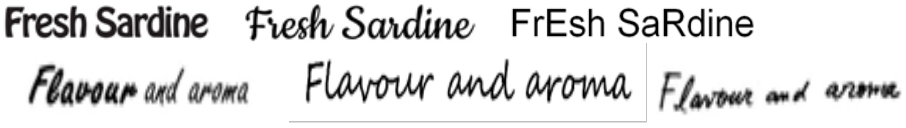
2. THE COMMON PRACTICE

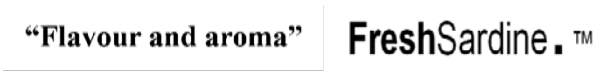
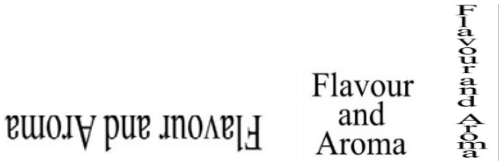
The following text summarizes the key messages and main statements of the principles of the Common Practice. The complete text can be found at the end of this Communication.

In order to determine if the threshold of distinctiveness is met due to the figurative features in the mark the following criteria are considered:

Note: 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.*

WITH RESPECT TO THE WORD ELEMENTS IN THE MARK

Criterion	*Typeface and font*
Common Practice	• 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: 

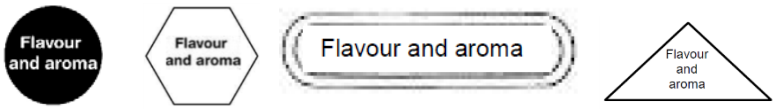
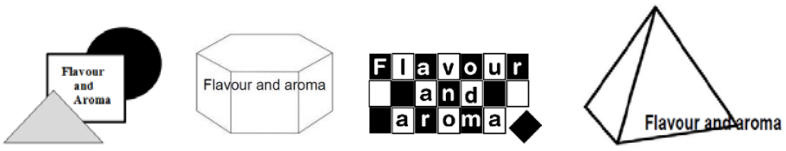
	• Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable. Distinctive examples: 
Criterion	*Combination with colour*
Common Practice	• 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, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive. Non-distinctive examples: 
Criterion	*Combination with punctuation marks and other symbols*
Common Practice	• 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: 
Criterion	*Position of the word elements (sideways, upside-down, etc.)*
Common Practice	• In general, the fact that the word elements are arranged in vertical, 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:  • 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:





WITH RESPECT TO THE FIGURATIVE ELEMENTS IN THE MARK

Criterion	*Use of simple geometric shapes*
Common Practice	• 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 above mentioned shapes are used as a frame or border. Non-distinctive examples:  • On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive. Distinctive examples: 
Criterion	*The position and proportion (size) of the figurative element in relation to the word element*
Common Practice	• 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 recognizable in the sign. Non-distinctive examples:  Distinctive example: 
Criterion	*Whether the figurative element is a representation of, or has direct link with, the goods and/or services*
Common Practice	➢ 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 consists of 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:



Distinctive examples:

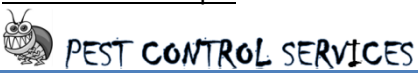


➢ A figurative element which does not represent the goods and services but has a direct link with the characteristics of the goods and services will not render the sign distinctive, unless it is sufficiently stylised.

Non-distinctive example:



Distinctive example:

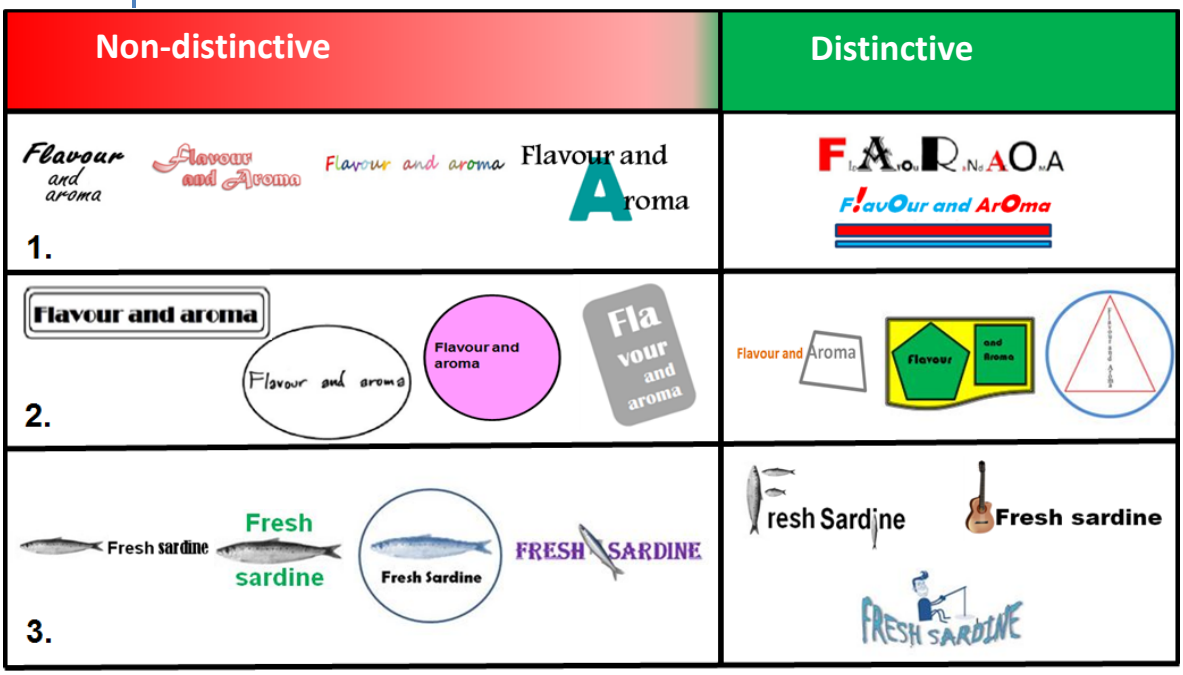


Criterion	*Whether the figurative element is commonly used in trade in relation to the goods and/or services applied for*
Common Practice	• In general, figurative elements that are commonly used or customary in trade in relation to the goods and/or services claimed do not add distinctive character to the mark as a whole. Non-distinctive examples: 

WITH RESPECT TO BOTH THE WORD AND FIGURATIVE ELEMENTS IN THE MARK

	How combinations of the criteria affect distinctiveness
Common Practice	• In general, a combination of figurative elements 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 which 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 which are either non-distinctive in their totality (red column) or distinctive in their totality (green column).



It should be noted that an applicant will not obtain exclusive rights on descriptive/non-distinctive words, when it is the figurative element that renders the mark distinctive as a whole. The scope of protection is limited to the overall composition of the mark. For the impact on the scope of protection when a mark consists of non-distinctive/weak elements please see the Principles of the Common Practice on CP5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components).

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3. IMPLEMENTATION

As has been the case with previous common practices, the Common Practice will take effect within three months of the date of publication of this Common Communication.
Further details on the implementation of this Common Practice are available in the table below.

Implementing offices may choose to publish additional information on their websites.

At the time of writing, the following offices will implement the common practice: AT, BG, BOIP, CY, CZ, DE, DK, EE, ES, FR, GR, HR, HU, IE, LT, LV, MT, NO, OHIM, PT, RO, SE, SI, SK, UK.

The following EU offices support the common practice, but will not implement it at this moment in time: FI, IT, PL.

3.1 IMPLEMENTING OFFICES

LIST OF IMPLEMENTING OFFICES, IMPLEMENTATION DATE AND IMPLEMENTATION PRACTICE

Overview of implementation of the Common Practice						
Office	Implementation date	The Common Practice will be applicable to:				
		Applications pending on the implementation date	Applications filed after the implementation date	Invalidity proceedings pending on the implementation date	Invalidity proceedings filed after the implementation date	Requests for invalidity of TMs which were examined under this common practice
AT	02.01.2016		X			
BG	02.01.2016	X	X	X	X	X
BOIP	02.10.2015	X	X	N/A	N/A	N/A
CY	02.10.2015		X		X	X
CZ	02.01.2016		X			X
DE	02.10.2015	X	X			X
DK	01.01.2016		X			X
EE	01.01.2016		X	N/A	N/A	N/A

ES	02.01.2016		X	N/A	N/A	N/A
FR	02.10.2015	X	X	N/A	N/A	N/A
GR	02.10.2015		X			X
HR	01.01.2016	X	X		X	
HU	01.12.2015		X		X	
IE	02.01.2016		X			X
LT	01.01.2016		X	N/A	N/A	N/A
LV	02.01.2016		X			X
MT	02.10.2015	X	X	N/A	N/A	N/A
NO	02.10.2015	X	X	X	X	X
OHIM	02.01.2016	X	X	X	X	X
PT	03.10.2015	X	X	N/A	N/A	N/A
RO	02.01.2016	X	X	N/A	N/A	N/A
SE	02.10.2015	X	X	N/A	N/A	N/A
SI	02.01.2016		X	N/A	N/A	N/A
SK	01.12.2015	X	X	X	X	X
UK	02.10.2015		X		X	

N/A: NOT APPLICABLE

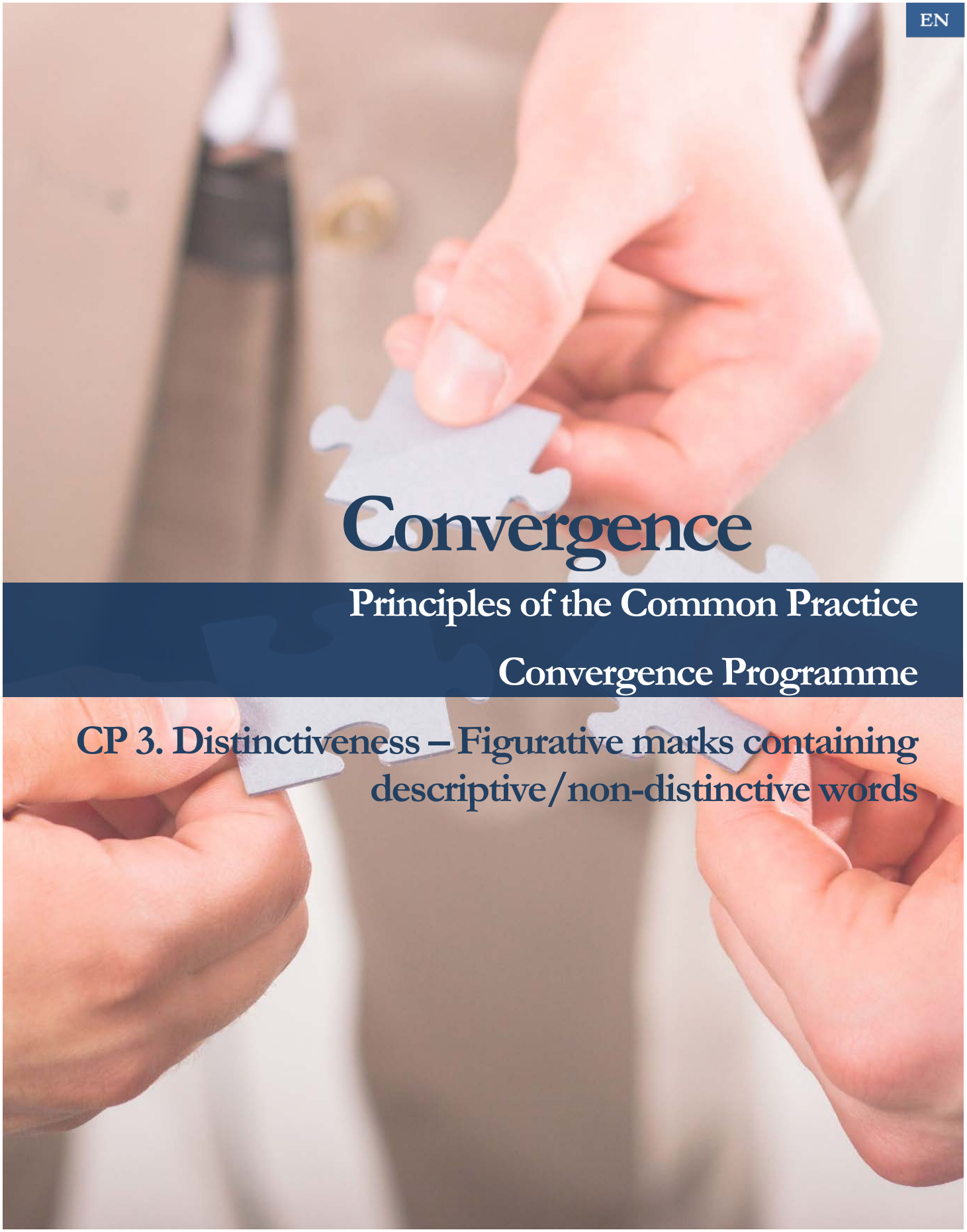
ANNEX:

PRINCIPLES OF THE COMMON PRACTICE

European Trade Mark and Design Network

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (TRADE MARKS AND DESIGNS)

EN



Convergence

Principles of the Common Practice

Convergence Programme

CP 3. Distinctiveness – Figurative marks containing descriptive/non-distinctive words

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1. PROGRAMME BACKGROUND

Despite the growth in world-wide trade mark and design activity in recent years, efforts to achieve convergence in the way offices around the world operate have only yielded modest results. Within Europe there is still a long way to go to iron out the inconsistencies among the EU IP offices. The OHIM Strategic Plan identifies this as one of the main challenges to address.

With this in mind the Convergence Programme was established in June 2011. It reflects the shared determination of national offices, BOIP, the OHIM and users, to move towards a new era among EU IP offices with the progressive creation of a European interoperable and collaborative network contributing to a stronger IP environment in Europe.

The vision of this Programme is ***"To establish and communicate clarity, legal certainty, quality and usability for both applicant and office".*** This goal will be achieved by working together to harmonise practices and will bring considerable benefits to both users and IP offices.

In the first wave the following five projects were launched under the umbrella of the Convergence Programme:

- **CP 1. Harmonisation of Classification**
- **CP 2. Convergence of Class Headings**
- **CP 3. Distinctiveness – Figurative Marks containing descriptive/non-distinctive words.**
- **CP 4. Scope of Protection of B&W Marks**
- **CP 5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)**

This document focuses on the new Common Practice of the third project: CP 3. Distinctiveness – Figurative Marks containing descriptive/non-distinctive words.

2. PROJECT BACKGROUND

At the outset of the project, there was notable **divergence** amongst EU IP offices in respect of assessing composite marks containing figurative elements and purely descriptive/non-distinctive words. These different practices and interpretations lead to different outcomes, thus undermining legal certainty and predictability on when the figurative features render the mark sufficiently distinctive, enabling it to pass the absolute grounds examination.

Consequently, the offices have seen the need for harmonisation and have considered that a Common Practice would be beneficial for both users and offices.

The aim of the project is to **converge the approach where a figurative mark, containing purely descriptive/non distinctive words, passes the absolute grounds examination because the figurative element renders sufficient distinctive character.**

There are four key deliverables in this project each of which addresses a different issue:

1) A **Common Practice including a common approach** to be set out in a document and translated into all EU languages.

2) A common **communication strategy** for this practice.

3) An **action plan to implement** the Common Practice.

4) An analysis of the needs to address the **past practice.**

The present document is the first of the four deliverables.

These project deliverables are created and agreed upon by the participating IP offices taking into consideration the comments of the user associations.

The first working group meeting took place in February 2012 in Alicante to determine the general lines of action, the project scope and the project methodology. Subsequent meetings were held in October 2012, June and October 2013, further in February, April, June, December 2014 and February 2015. During these meetings the objectives of the project were thoroughly discussed by the Work Package Group, responsible for creating the Common Practice, and agreement on the principles of the Common Practice was reached.

3. OBJECTIVE OF THIS DOCUMENT

This document is the reference for IP offices, user associations, applicants and representatives on the Common Practice determining when a figurative mark containing purely descriptive/non-distinctive words passes the absolute grounds examination because the figurative element renders the mark as a whole with sufficient distinctive character. It will be made widely available and will be easily accessible, providing a **clear and comprehensive explanation of the principles on which the new Common Practice is based**. These principles will be generally applied, and aimed at covering the large majority of the cases. Distinctiveness must be assessed on a case-by-case basis, with the common principles serving as guidance in order to ensure that different offices on the same grounds come to a similar, predictable outcome.

4. THE PROJECT SCOPE

According to the ruling of the Court in its Judgment C-104/01, 'Libertel', para. 48-50:

"It is settled case-law that trade mark rights constitute an essential element in the system of undistorted competition which the EC Treaty seeks to establish and maintain.

Furthermore, under Article 5(1) of the Directive, a trade mark confers on its proprietor an exclusive right, in relation to certain goods and services, that allows him to monopolise the sign registered as a trade mark for an unlimited period.

The possibility of registering a trade mark may be ***limited*** *for reasons relating to the* ***public interest.***"

The Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008, to approximate the laws of the Member States relating to trade marks (the 'Directive'), states in its Article 3(1)(b) and (c)[1] that **trade marks which are devoid of any distinctive character**, and **descriptive trade marks**, that is, those 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, **shall not be registered, or if registered shall be liable to be declared invalid**.

[1] Any reference to Articles of the 'Directive' can be understood as a reference to the corresponding Articles of the Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark.

The various grounds for refusal must be interpreted in the light of the **public interest** underlying each of them (see Joined Cases C-456/01 P and C-457/01 P, *Henkel,* para. 45-46, Case C-329/02 P, *SAT.1*, para. 25).

It is in the public interest to prevent the registration of a mark which is incapable of distinguishing the goods and/or services for which registration is sought from those of other undertakings.

The **scope** of the project reads:

> *"The objective of this project is to find a common practice in relation to when a* ***figurative mark****, containing* ***purely descriptive/non-distinctive words****, passes the* ***absolute grounds*** *examination because the figurative element renders* ***sufficient distinctive character****."*

The following issues are out of the scope of the project:

- *Language issues: consider for the sake of the project that the word elements are fully descriptive/non-distinctive in your language.*
- *Interpretation of disclaimers.*
- *Use of the trade mark (including acquired distinctiveness and how the mark is actually used in trade).*

In order to determine if the threshold of distinctiveness is met due to the figurative features in the mark the following criteria are considered:

- With respect to the **word** elements in the mark:
  - Typeface and font
  - Combination with colour
  - Combination with punctuation marks and other symbols
  - Position of the word elements (sideways, upside-down, etc.)
- With respect to the **figurative** elements in the mark:
  - Use of simple geometric shapes
  - The position and proportion (size) of the figurative element in relation to the word element
  - Whether the figurative element is a representation of, or has a direct link with, the goods and/or services

- Whether the figurative element is commonly used in trade in relation to the goods and/or services applied for.

➢ With respect to **both** the word and figurative elements in the mark:

- How combinations of the criteria affect distinctiveness.

5. THE COMMON PRACTICE

5.1. Descriptive/non-distinctive words.

For the purpose of the project the word elements in the mark are deemed to be fully descriptive/non-distinctive, as the main purpose is to converge the approach on when the addition of a figurative element renders the mark as a whole sufficiently distinctive, thus enabling the mark to perform its essential function and pass the absolute grounds examination.

According to the settled case-law, for a trade mark to possess **distinctive character** for the purpose of Article 3(1)(b) of the Directive it must be capable of fulfilling its **essential function**, namely to **guarantee the identity of the commercial origin** of the marked goods and/or services **to the consumer or end-user** by enabling him, without any possibility of confusion, to **distinguish the goods or services from others which have another origin**, thus to repeat the experience, if proved to be positive, or to avoid it, if proved to be negative (see C-39/97, *Canon*, para. 28 and T-79/00, *LITE*, para. 26).

Indissociable from the capability of a trade mark to **perform its essential function**, as held by the Court the general interest underlying Article 3(1)(c) of the Directive is that of ensuring that **descriptive** signs or **indications relating to the characteristics** of goods or services in respect of which registration is sought may be **freely used by all** traders offering such goods and/or services, preventing such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see Cases C-299/99 *Philips,* para. 30, C-329/02 P, SAT.1, para. 30, Joined Cases C-90/11 and C-91/11, *Alfred Strigl,* para. 31, C-53/01 P*, Linde*, para. 73, and C-104/01, *Libertel*, para. 52*,* C-363/99 *Koninklijke KPN Nederland NV,* para. 54, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee,* para. 25).

Distinctiveness must be assessed, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the perception of the relevant public (see C-

53/01 P, *Linde*, para. 41, C-363/99, *Koninklijke KPN Nederland NV,* para. 34, Joined Cases C-468/01 P to C-472/01 P, *Procter & Gamble,* para. 33).

Although each of the grounds for refusal listed in Article 3(1) is independent of the others and calls for separate examination, there is nonetheless a clear **overlap** between the scope of each of the grounds for refusal set out in Article 3(1)(b) and (c) (see Joined Cases C-90/11 and C-91/11, *Alfred Strigl,* para. 20, C-53/01 P, *Linde*, para. 67, Case C-363/99 *Koninklijke KPN Nederland NV,* para. 85, Case C-392/02 P, *SAT.1*, para 25).

It is settled case-law that a sign which is **descriptive** of the characteristics of the goods or services for the purpose of Article 3(1)(c) of the Directive is, on that account, necessarily **devoid of any distinctive character** in relation to those goods or services within the meaning of Article 3(1)(b) of the Directive. A mark **may nonetheless be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive** (see C-265/00, *Biomild*, para. 19, Case C-363/99 *Koninklijke KPN Nederland NV,* para. 86, and Case C-51/10 P, *Agencja Wydawnicza Technopol v OHIM*, para. 33).

Thus, a descriptive trade mark is necessarily devoid of any distinctive character, although a trade mark may lack distinctiveness due to reasons other than descriptiveness.

5.2. What are the figurative thresholds for passing the absolute grounds examination?

Despite containing purely descriptive/non-distinctive words, a figurative mark can still pass the absolute grounds examination if there are other elements in the mark which render the mark distinctive as a whole[2].

[2] For the impact on the scope of protection when a mark consists of non-distinctive/weak elements please see the Principles of Common Practice on CP5 – Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components).

https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/who_we_are/common_communication/common_communication5_en.pdf

However, the distinctiveness of a trade mark which contains descriptive/non-distinctive word elements cannot rely on figurative elements which have no distinctive character in their own right or are minimal in nature, unless the resulting combination is distinctive as a whole.

This principle is confirmed by the CJEU in its Judgment C-37/03 P, *BioID*. In this judgment, the Court states that graphic elements in the mark may "do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin", and therefore "those graphic elements are not capable of fulfilling the essential function of a trade mark in relation to the relevant goods and services" (para. 72). As a way of example, in that particular case "the figurative and graphic elements are so minimal in nature that they do not endow the trade mark applied for as a whole with any distinctive character. Those elements do not possess any feature, in particular in terms of fancifulness or as regards the way in which they are combined, allowing that mark to fulfil its essential function in relation to the goods and services covered by the trade mark application" (para. 74).

For the purpose of determining the distinctive character endowed by the figurative elements in the sign, the following criteria were agreed:

A. With respect to the word elements of the mark.

A.1. Typeface 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.

- 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.

Examples

Non-distinctive		
Reasoning	Sign	Goods/services
Basic typefaces, with or without font effects (bold, Italics)	Flavour and aroma **Flavour and aroma** *Flavour and aroma* Flavour and aroma Flavour and aroma FLAVOUR AND AROMA Flavour and aroma	Class 30: Coffee.
Slight font variations (i.e. word in bold)	Flavour **and aroma** ***Flavour*** *and aroma*	Class 30: Coffee.
Handwritten and handwriting style typefaces	Flavour and aroma Flavour and aroma Flavour and aroma Flavour and Aroma Fresh Sardine Flavour and Aroma	Class 30: Coffee. Class 30: Coffee. Class 29: Sardines. Based on the 'Bollywood macht glücklich!' case, Bundespatentgericht 27 W (pat) 36/09. Class 30: Coffee.

	Fresh Sardine	Class 29: Sardines. Based on Case T-464/08, *Superleggera* (see para. 33-34).
Lower case + capital letters	FreshSARDINE	Class 29: Sardines.
Standard typeface + italics	Freshsardine	Class 29: Sardines.
Internal capitalization of letters which does not affect the meaning of the word element	FrEsh SaRdine	Class 29: Sardines.
Typeface with a certain peculiarity, but remaining largely normal	Flavour and Aroma Fresh Sardine	Class 30: Coffee. Class 29: Sardines. Based on the 'jogosonline' case, Portuguese trade mark application Nº 406731, refused by INPI.

Distinctive		
Reasoning	Sign	Goods/services

Handwritten lettering which is stylized to the extent that it is illegible, i.e., no descriptive meaning can be extracted.		Class 30: Coffee.
Typeface with sufficient degree of stylization, with the possibility of interpreting the individual characters in different ways. ** 'DIY' stands for 'do-it-yourself', and is considered a non-distinctive word element in relation to the goods for which protection is sought.*		Class 20: Kits of parts for assembly into furniture.
Graphically designed typeface, Some letters are harder to recognize.		Class 30: Coffee.

A.2. Combination with colour

- According to what has been stated by the Court of Justice in its Judgment C-104/01, 'Libertel', "it must be borne in mind that, whilst colours are capable of conveying certain associations of ideas, and arousing of feelings, they possess little inherent capacity for communicating specific information, especially since they are common and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message" (para. 40).

- The Court of Justice in the preliminary ruling C-49/02, 'Heidelberger', furthermore states that "Save in exceptional cases, colours do not initially have a distinctive character" (para. 39).

- 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, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

Examples

Non-distinctive		
Reasoning	Sign	Goods/services
Addition of one single colour to a basic/normal typeface (Coloured letters).	Flavour and aroma	Class 30: Coffee.
Addition of one single colour to a basic/normal typeface (Coloured background or frame).	Flavour and aroma	Class 30: Coffee.
	Flavour and aroma	Class 30: Coffee.
Addition of one single colour to a basic/normal typeface (Coloured outline).	Flavour and aroma	Class 30: Coffee.
Addition of one single colour to a basic/normal typeface (Gradient colour).	FLAVOUR AND AROMA	Class 30: Coffee.
In this example, the application of many different colours to the lettering may catch the eye of the consumer, but it will do	Flavour and aroma	Class 30: Coffee.

nothing to help the consumer to distinguish the goods and/or services of one undertaking from those of others, as the particular arrangement of colours will neither be perceived nor remembered by the consumers.		

A.3. 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.

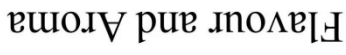
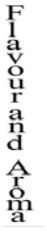
Examples

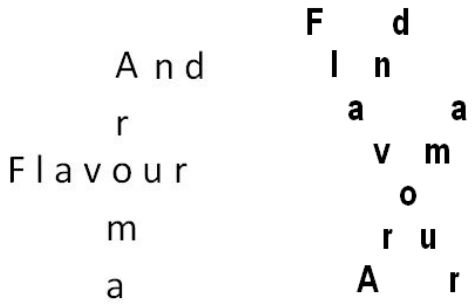
Non-distinctive		
Reasoning	Sign	Goods/services
Addition of a full stop or a trade mark sign does not add distinctive character to the sign.	FreshSardine. ™	Class 29: Sardines. Based on Case C-37/03 P, *BioID.* (see para. 72-74).
Addition of quotation marks does not add distinctive character to the sign.	"Flavour and aroma"	Class 30: Coffee.

A.4. Position of the word elements (side-ways, upside-down, etc.)

- The way in which the word elements are positioned can add distinctive character to a sign when it is capable of affecting the consumer's perception of the meaning of said word elements. In other words, the arrangement must be of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message. In general, the fact that the word elements are arranged in vertical, upside-down or in one, two or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.

Examples

Non-distinctive		
Reasoning	Sign	Goods/services
Text in two or more lines read from left to right.	Flavour and Aroma	Class 30: Coffee.
All the text is upside-down.		Class 30: Coffee.
All the text is vertical.		Class 30: Coffee.

Distinctive		
Reasoning	Sign	Goods/services
The text is presented in an original manner The particular configuration is capable of affecting the consumer's perception of the word elements.		Class 30: Coffee.

B. With respect to the figurative elements in the mark.

B.1. Use of simple geometric shapes

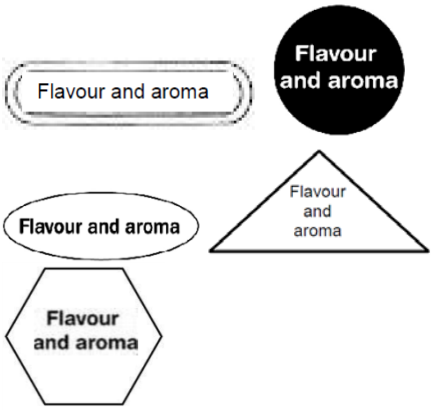
- Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses[3] are unlikely to be acceptable, in particular when the above mentioned shapes are used as a frame or border.

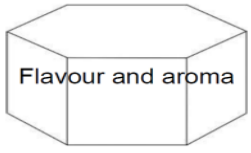
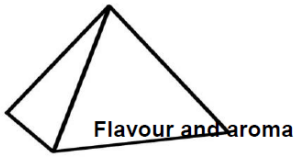
- This is because a geometric shape which merely serves to underline, highlight or surround the word element will not have sufficient impact on the mark as a whole to render it distinctive.

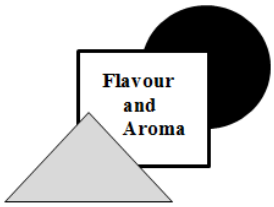
- On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive.

[3] The list of simple geometric shapes is not exhaustive.

Examples

Non-distinctive		
Reasoning	Sign	Goods/Services
Examples of simple geometric shapes which are used as a frame or border, not considered to be acceptable.		Class 30: Coffee.

Distinctive		
Reasoning	Sign	Goods/Services
Examples of a particular configuration of non-distinctive word elements with a simple geometric shape which renders the mark acceptable in its totality because of the special arrangement of how the words are overlapping the simple geometric shapes as well as the relatively large size of the shapes as compared to the words so that the shape is not merely seen as underlining, highlighting or surrounding the words, but a global impression is being created that is sufficiently distinctive. It is assumed that the figurative elements are not representations of packaging.	 	Class 30: Coffee.

Examples of particular combinations of geometric shapes with descriptive words, which render each of the marks distinctive as a whole.	 	Class 30: Coffee.

B.2. The 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 recognizable in the sign.

Examples

Non-distinctive		
Reasoning	Sign	Goods/Services
The red device appearing on the letter 'i' is hardly recognizable.	Fresh Sardine	Class 29: Sardines.
Figurative element is so small that is not recognizable.	Flavour and aroma	Class 30: Coffee.

Distinctive		
Reasoning	Sign	Goods/Services
Figurative element is distinctive in itself and large enough to be recognized in the mark as a whole.		Class 30: Coffee.

B.3. The figurative element is a representation of, or has a direct link with, the goods and/or services.

As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods and services in respect of which registration is sought, without introducing any unusual variations, itself remains descriptive and cannot result in anything other than a mark consisting exclusively of signs and indications which may serve, in trade, to designate characteristics of the goods and services concerned (see by analogy C-265/00 Biomild, para. 39 and C408/08 P, Color Edition, para. 61).

However, such a combination may not be descriptive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements with the result that it is more than the sum of its parts (C-265/00 Biomild, para. 40).

- In some cases the figurative element consists of a representation of the goods and services claimed. In principle, 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
  - It consists of a symbolic/stylised portrayal of the goods and services that does not depart significantly from the common representation of said goods and services;

In other cases the figurative element may not represent the goods and services but may 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.

Examples

In the following examples, the marks resulting from the combination of a non-distinctive/descriptive figurative element and a non-distinctive/descriptive word element do not create an impression which is more than the sum of its parts.

Whether the figurative and/or the word elements are considered descriptive or non-distinctive the outcome will be the same.

Non-distinctive		
Reasoning	Sign	Goods/Services
Descriptive figurative element + descriptive word element. *The figurative element shows the picture of a sardine, and therefore a true-to-life portrayal of the goods. Neither the typeface (basic/standard), the position of the word elements, the overall composition of the mark, nor any other elements endow the mark with the required minimum degree of distinctive character.*	 Fresh Sardine	Class29: Sardines.
Descriptive figurative element + non-distinctive word element. *The figurative element shows the picture of a sardine, and therefore a true-to-life portrayal of the goods. Neither the typeface (basic/standard), the position of the word*	 From the sea to your plate	Class 29: Sardines.

elements, the overall composition of the mark, nor any other elements endow the mark with the required minimum degree of distinctive character.		
Non-distinctive figurative element + non-distinctive word element. *The figurative element shows a typical sardine tin, which is commonly used in trade as a packaging for sardines, and therefore consists of a symbolic/stylised portrayal of the goods that does not depart significantly from a common representation of said goods. Neither the typeface (basic/standard), the position of the word elements, the overall composition of the mark, nor any other elements endow the mark with the required minimum degree of distinctive character.*		Class 29: Sardines.
Non-distinctive figurative element + descriptive word element. *The figurative element shows a typical sardine tin, which is commonly used in trade as a packaging for sardines, and therefore consists of a symbolic/stylised portrayal of the goods that does not depart significantly from a common representation of said goods. Neither the typeface (basic/standard), the position of the word elements, the overall composition of the mark, nor any other elements endow the mark with required minimum degree of distinctive character.*		Class 29: Sardines.

The figurative element does not represent the services but still has a direct link with the characteristics of the services. The sign is not sufficiently stylised.		Class 37: Pest control services.

Distinctive		
Reasoning	Sign	Goods/Services
Exception: a special combination/com-position (overall distinctiveness of two descriptive/non-distinctive elements together). *By using sardines as the letters 'F' and 'i' this sign creates an impression which is sufficiently far removed from that produced by the mere combination of non-distinctive/descriptive figurative and word elements, being more than the sum of its parts.*		Class 29: Sardines.
Distinctive figurative element + descriptive word element. *The figurative element consists of a walking fishbone, and therefore a symbolic/stylised portrayal of the goods that departs significantly from a common representation of said goods.*		Class 29: Sardines.
The figurative element has a direct link with the characteristics of the services, but the sign is sufficiently		Class 37: Pest control services.

stylised.		

B.4. 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.

Examples

Non-distinctive		
Reasoning	Sign	Goods/Services
The claimed mark would be understood by the relevant public as a clear and direct indication of quality and not as an indication of the origin of the goods. *The figurative elements are devoid of any striking, unusual or original features and will simply be seen as a common label which will not be retained by the average consumer as distinctive.*		Class 30: Coffee.
Coloured price tags are commonly used in trade for all kinds of goods, and the combination with the descriptive word elements is not sufficient to render the mark distinctive.		Class 29: Sardines. Based on Case T-122/01, *Best Buy* (see para. 33).

Price tags are commonly used in trade for all kinds of goods.		Class 30: Coffee.
The 'scales of justice' are commonly used in trade for legal services.		Class 45: Legal services.

C. How do combinations of the above criteria affect distinctiveness?

- In general, a combination of figurative elements and word elements, which are – considered individually – devoid of distinctive character, does not give rise to a distinctive mark.

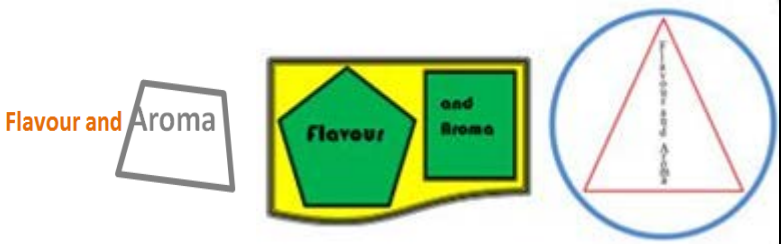
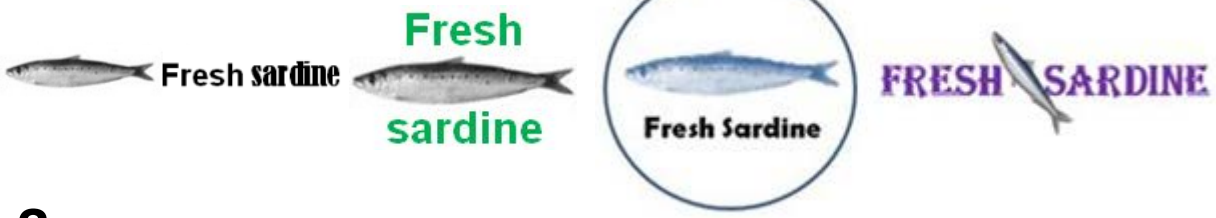
- Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case where the combination results in an overall impression which is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.

The following table contains a selection of examples all of which contain combinations of the individual criteria assessed in the previous sections of the Common Practice document. The combinations presented under the red column are those which, in view of their simplicity and/or common nature, do not lead to a finding of distinctiveness. In contrast, the combinations presented under the green column are considered to be distinctive.

Examples:

In order for a sign to be registrable, it has to 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 which are either non-distinctive in their totality (red column) or distinctive in their totality (green column)[4].

[4] The signs containing 'Flavour and aroma' seek protection for **coffee** in Class 30 and the signs containing 'Fresh sardine' seek protection for **sardines** in Class 29.

Non-distinctive	Distinctive
1. 	
2. 	
3. 	

Row 1:

From left to right, the first example combines basic/standard typeface with a word in bold and positioning of the word elements. In the following case adding the colour red might take it a step further, but the combination (i.e. standard typeface, positioning of word elements and one colour) still does not give rise to a distinctive mark. In the third example the addition of a number of colours adds something extra but still its presentation and composition does not create an overall impression which is sufficiently far removed from that produced by the simple combination of those elements, besides consumers are unable to remember too many colours and their sequence. The fourth example combines basic/standard typeface, positioning/size of word elements and two colours, which still remains non-distinctive.

The combination of figurative elements in the two distinctive examples on the right side when considered as a whole can be perceived as a badge of origin due to the presentation and composition of the sign, creating a visual impression that is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word elements.

Row 2:

From left to right, the first two examples in this set combine simple geometric shapes used as frames (rectangular and oval shape respectively) with basic/standard typeface, followed by basic/standard typeface combined with circular shape, colour and positioning of word elements. The following example combines the irregular arrangement of basic/standard typeface word elements with an angled rectangle and colour. None of these three examples create an overall impression which is sufficiently far removed from that produced by the simple combination of those elements.

On the right-side column, non-arbitrary combinations of shapes in combination with colour and position of the word elements create a visual impression which is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element. This enables the mark in totality to be perceived as a badge of origin due to the presentation and composition of the sign.

Row 3:

From left to right, this set of examples begins with a true to life portrayal of the goods combined with two basic typefaces and font effects, followed by the addition of positioning of the word elements and colour, and subsequent addition of geometrical shape to the combination, and ending with typeface slightly stylized but still remaining largely normal. None of these examples create a visual impression that is sufficiently far removed from the descriptive/non-distinctive message conveyed. As a result, these marks will not be perceived as badges of origin.

On the right side of the line, the presentation and composition of the marks, and on the far right the presence of a recognizable figurative element which is distinctive on its own right, endows the marks with the required minimum degree of distinctive character.

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Convergence

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