



HELLENIC REPUBLIC
MINISTRY OF
ECONOMY & DEVELOPMENT



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CP3: Distinctiveness – Figurative Marks containing descriptive/non-distinctive words

COMMON PRACTICE IN ISSUE FROM
2 October 2015

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HELLENIC REPUBLIC
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ECONOMY & DEVELOPMENT



Figurative TM with Descriptive Elements

Change title to

Descriptive TM with Figurative Elements

CP3: Distinctiveness – Figurative Marks containing descriptive/non-distinctive words

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.”

- Language issues are out of the scope of the project : consider for the sake of the project that the word elements are totally descriptive/non-distinctive in your language



The scope of the Common Practice, which is made public through the Common Communication, is of further increasing transparency, legal certainty, and predictability for the benefit of examiners and users alike.

Legal text:

Art. 7 par.1(c)EUTMR 207/2009

» 123 par. 1 (c) L.4072/2012

- 1. The following shall not be registered:
- (c) trade marks 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 service;

Legal text

trade marks which consist **exclusively** of **signs or indications** which may serve, in trade, to designate the kind, quality, etc .., of the goods and services‘

exclusively‘: of what the mark consists, not, exclusively to describe‘

- may not consist of other matter

signs or indications: not limited to words

CP3: Descriptiveness-Figurative marks containing descriptive/non distinctive words

General rule:

A mark still ‘exclusively’ consists of descriptive indications if the **rest** is non-distinctive, neither alone nor in combination.

The **rest** can be *entirely generic*

(domain .com, company structure Ltd.)

Or *figurative*

Or the addition of *colour*

Or a complex ‘combination’ of other ‘things’

- CP3: Descriptiveness-Figurative marks containing descriptive/non distinctive words

Sub-types of cases:

- (1) Non-standard font
- (2) Typographic variations
- (3) Letters in colour
- (4) Coloured background or label
- (5) Simple graphic strokes or brushes
- (6) Devices, pictures

(very often these sub-types overlap)

CP3: typeface & 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.



Typeface and font



Distinctive



(kl. 20)

Distinctive



(kl. 39)



CP3: Typeface and font

Non Distinctive

SPAGHETTI COMPANY

(kl.43)

IR 112096 : GR, RS, RU, RO, GE **refused**
AT, CZ, IT, MK, UA, TR **accepted**

YOUR
insurance

(kl. 36)

CP3: 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, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

CP3: combination with colour

Distinctive



KI. 29,30



CP3: combination with colour

Non Distinctive



Junior



Συνδυασμός με χρώμα

CP3: position and proportion of figurative elements

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.

CP3: position and proportion of the figurative element

Distinctive



(kl 1)

Distinctive



(kl 45)

CP3: position and proportion of the figurative element

Distinctive



KI. 44

Distinctive



KI.16

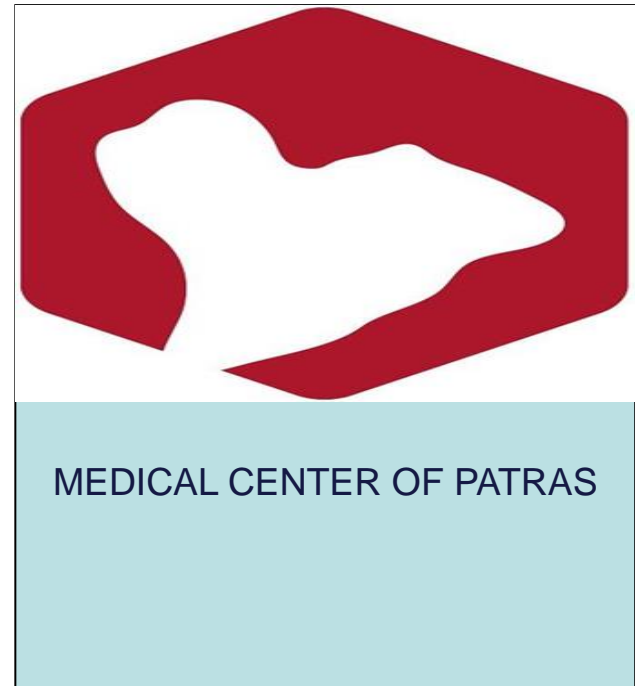


CP3: position and proportion of figurative element

Distinctive



KI 10



KI 44

CP3: figurative element represents the G&S

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 & services.

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.



CP3: figurative element represents the G&S or has a link with G&S

Non Distinctive



(kl 29)

Non Distinctive



(kl 28)

PCP3: figurative element represents the G&S or has a link with G&S

Non Distinctive



kl. 44

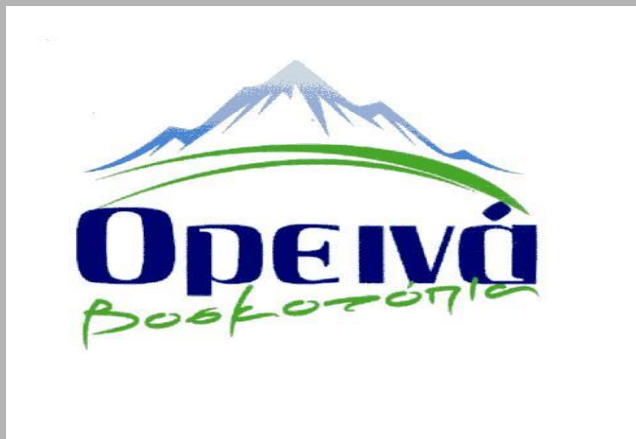
Non Distinctive



kl. 41

CP3: figurative element represents the G&S or has a link with G&S

Non Distinctive



kl.29

ΟΡΕΙΝΑ ΒΟΣΚΟΤΟΠΙΑ=
MOUNTAIN PASTURES

Distinctive



(kl 5)



CP3: the figurative element is commonly used 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, ex labels

CP3: figurative element is commonly used in trade

Non Distinctive



(kl 7)

Non Distinctive

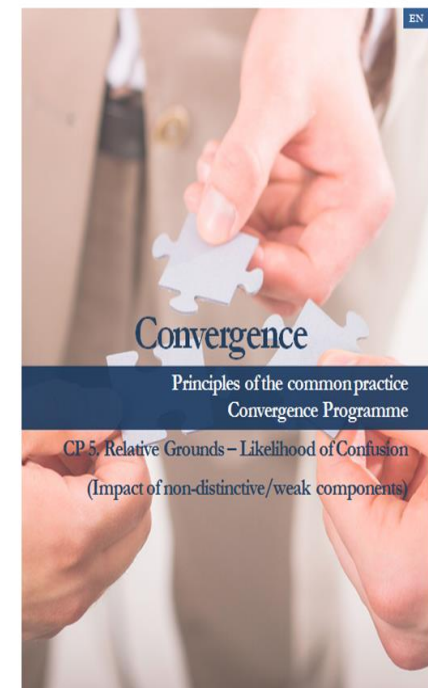


(kl 30)

ΚΑΛΟ ΠΑΓΩΤΟ=FINE ICE CREAMS

CP5: Relative Grounds-LoC (Impact of non distinctive/weak components)

COMMON PRACTICE PUBLISHED
2 October 2014 AND IS IN ISSUE
FROM 2 January 2015



CP5: Relative Grounds-LoC (Impact of non distinctive/weak components)

Objective: Determine the impact on LoC when the common components have a low degree of distinctiveness

A coincidence in an element with a low degree of distinctiveness will not on its own lead to LoC

However, there may be LoC if:

- 1) There are other elements that 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.
- 2) The overall impression of the marks is highly similar or identical.



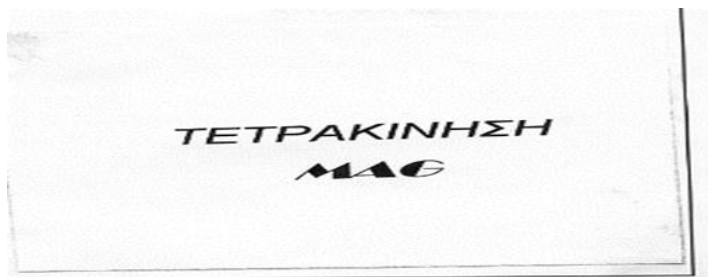
Objective: Determine the impact on LoC when the common components have a low degree of distinctiveness

No LoC
A.T.A.1st Instance
1442/2014

ΤΕΤΡΑΚΙΝΗΣΗ

Περιοδικό για αυτοκίνητα εκτός
δρόμου

Vs.



kl 16:
Magazine
for cars

LoC
A.T.C.
10480/2006

ΤΕΤΡΑΚΙΝΗΣΗ

Περιοδικό για αυτοκίνητα
εκτός δρόμου

Vs



CP5: Relative Grounds-LoC (Impact of non distinctive/weak components)

Objective: Determine the impact on LoC when the common components have a low degree of distinctiveness

- When marks share an element with no distinctiveness, the assessment of LOC will focus on the impact of the non-coinciding components on the overall impression of the marks. It 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 LOC.

Objective: Determine the impact on LoC when the common components have degree of distinctiveness

E-PHARMA
U 3– Pharma

VS

1 A Pharma

E-PHARMA
U 3– Pharma

VS

1 A Pharma

(kl. 5)



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Thanks for your attention

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