

# **EUIPO**

## **Absolute Grounds of Refusal**

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*Technical Training on Trademarks for Examiners and  
Engagement with IP Agents of ARIPO Member States*

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# Agenda

- I. General Remarks
  1. Area of Application
  2. Overview of A. 7(1) EUTMR
  3. Examination by the Office
  4. Languages
  5. Relevant Territory
  6. Scope of the Objection
- II. Traditional Marks
- III. Non-Traditional Marks
- IV. Acquired Distinctiveness
- V. Collective Marks
- VI. Certification Marks



# Absolute Grounds for Refusal

**I.**

**General Remarks**

# I. General Remarks

**1.**

**Area of Application**

# 1. Area of Application

- relevant provision: A. 7(1) EUTMR

# 1. Area of Application

- the assessment on absolute grounds for refusal pursuant to A. 7(1) EUTMR will apply to all kinds of EUTM applications, namely for:
  - individual marks
  - collective marks
  - certification marks

# 1. Area of Application

- individual marks: indicate the **commercial origin** of the protected goods/services

# 1. Area of Application

- collective marks: indicate that the goods/services protected by that mark originate from **members of an association**



# 1. Area of Application

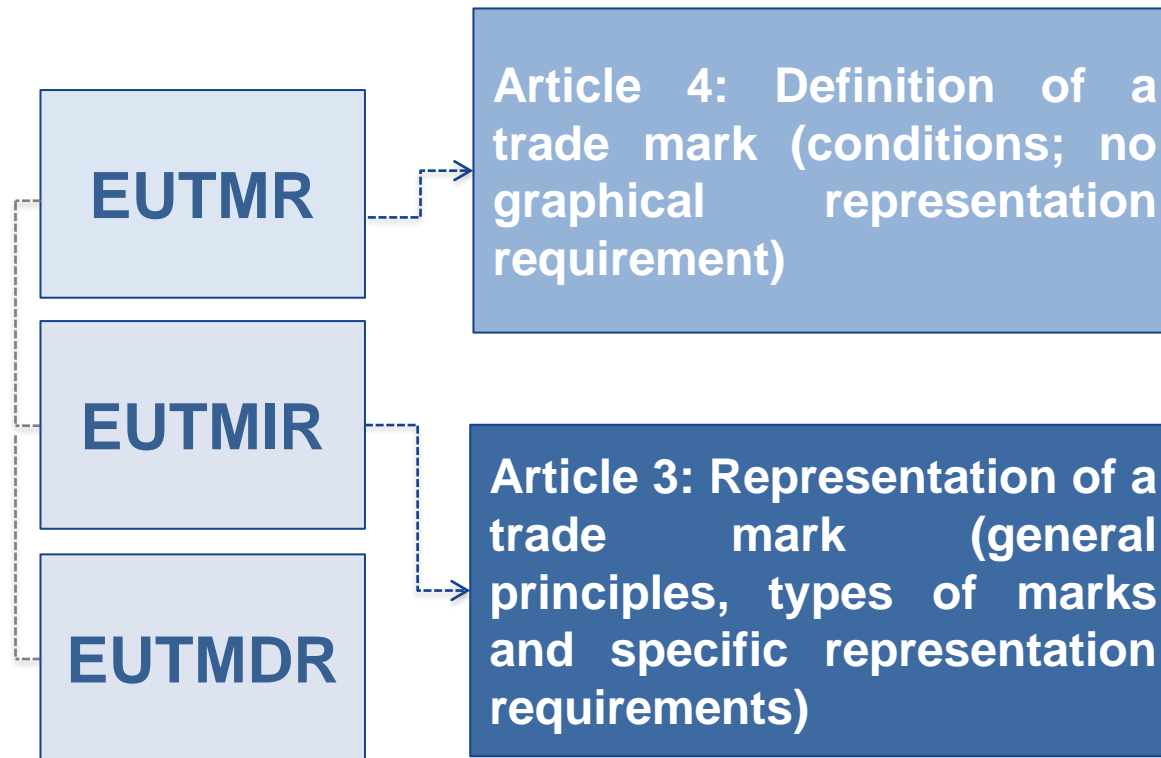
- certification marks: when the mark is applied for and capable of distinguishing **goods/services that are certified by the proprietor** in respect of certain characteristics (with the exception of the geographical origin)

# 1. Area of Application

- individual marks can be divided into:
  - ‘traditional’ marks
  - ‘non-traditional’ marks

# 1. Area of Application

## What can be a trade mark?



# 1. Area of Application

## ‘Traditional’ Marks

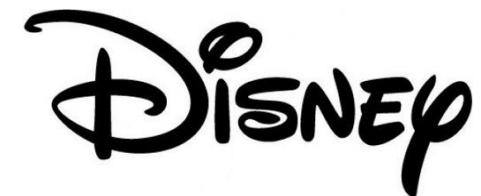
- word marks

DIOR  
GUCCI  
JUST DO IT  
GIVES YOU WINGS

# 1. Area of Application

## ‘Traditional’ Marks

- figurative marks



# 1. Area of Application

## ‘Traditional’ Marks

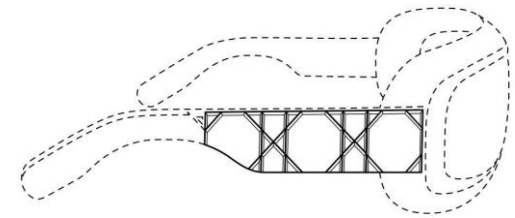
- shape marks



# 1. Area of Application

## ‘Traditional’ Marks

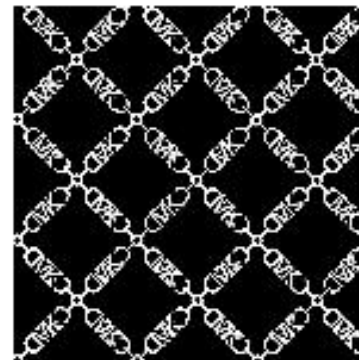
- position marks



# 1. Area of Application

## ‘Traditional’ Marks

- pattern marks





# 1. Area of Application

## ‘Traditional’ Marks

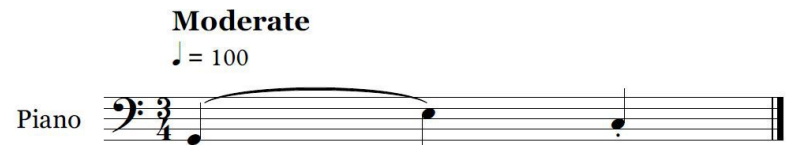
- colour marks



# 1. Area of Application

## ‘Non-Traditional’ Marks

- sound marks



# 1. Area of Application

## ‘Non-Traditional’ Marks

- motion marks

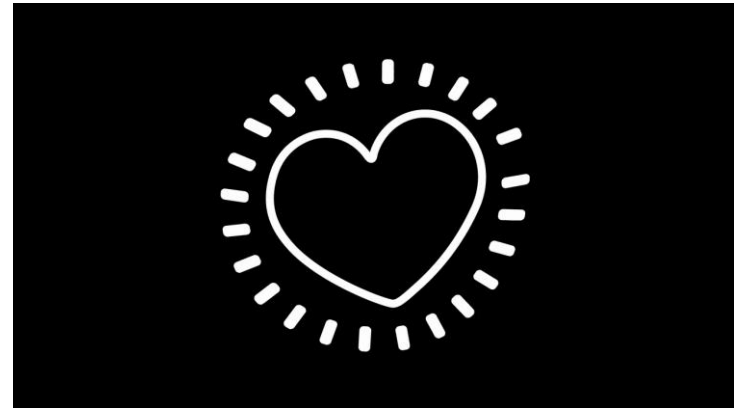


<https://euipo.europa.eu/eSearch/#details/trademarks/018895869>

# 1. Area of Application

## ‘Non-Traditional’ Marks

- multimedia marks

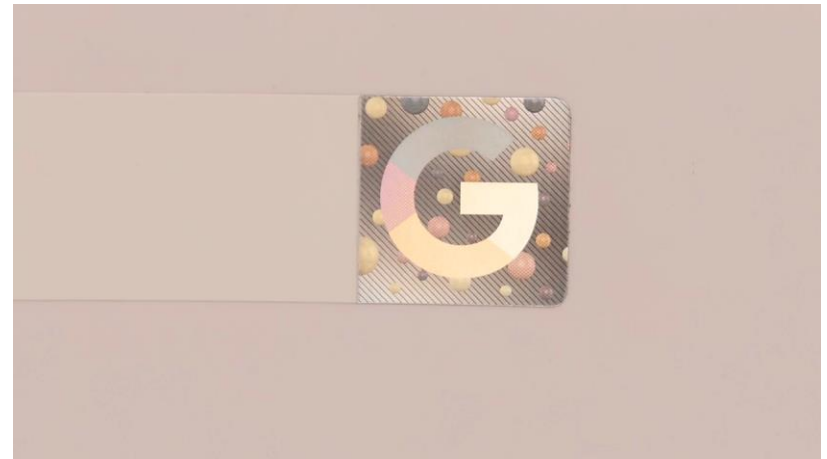


<https://euipo.europa.eu/eSearch/#details/trademarks/017868267>

# 1. Area of Application

## ‘Non-Traditional’ Marks

- hologram marks



<https://euipo.europa.eu/eSearch/#details/trademarks/017993401>

# 1. Area of Application

## ‘Non-Traditional’ Marks

- other marks



# I. General Remarks

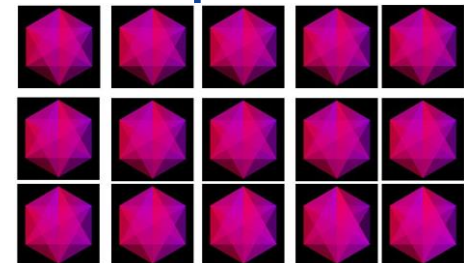
**2.**

**Overview of A. 7(1) EUTMR**

## 2. Overview of A. 7(1) EUTMR

### (a): Signs contrary to A. 4 EUTMR

- an EU trade mark should be rejected if it does not consist of a sign capable of:
  - distinguishing the goods/services of one undertaking from those of others; and
  - being represented on the Register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection





## 2. Overview of A. 7(1) EUTMR

### (a): Signs contrary to A. 4 EUTMR

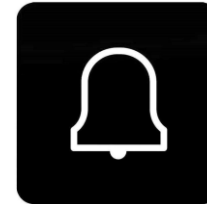
acceptable example:  
21/05/2021, T-193/18



for ‘chainsaws’ in cl. 7  
description: *‘The colour orange is applied to the top of the housing of the chain saw and the colour grey is applied to the bottom of the housing of the chain saw.’*

## 2. Overview of A. 7(1) EUTMR

### (b): Non-distinctive marks



ECO

- a sign must serve to identify the goods/services as originating from a particular undertaking, and to distinguish those goods/services from those of other undertakings



**MORE THAN JUST A CARD**

## 2. Overview of A. 7(1) EUTMR

### (b): Non-distinctive marks

acceptable example:  
15/12/2016, T-678/15  
and T-679/15



for '*pharmaceutical  
preparations*' in cl. 5

## 2. Overview of A. 7(1) EUTMR

### (c): Descriptive marks



**TRUEWHITE**

- a sign must be refused if its meaning is immediately perceived by the relevant public as providing information about e.g. the quantity, quality, characteristics, purpose, kind and/or size of the goods/services

**FRESHHH**

**YOUR DAILY  
PROTEIN**



## 2. Overview of A. 7(1) EUTMR

### (c): Descriptive marks

acceptable example:  
21/04/2021, T-323/20

**‘HELL’**

for coffee-related goods in  
and malt coffee extracts in  
cl. 30

## 2. Overview of A. 7(1) EUTMR

### (d): Customary signs or indications



- signs consisting 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 are excluded from registration



## 2. Overview of A. 7(1) EUTMR

### (d): Customary signs or indications

acceptable example:  
28/06/2021, R 2067/  
2020-1

**‘Infinity Screen’**  
for *‘televisions’* in cl. 9

## 2. Overview of A. 7(1) EUTMR

### (e): Shapes or Other Characteristics

- signs that consist exclusively of the shape or another characteristic that
- (i) results from the nature of the goods themselves;
- (ii) is necessary to obtain a technical result; or
- (iii) gives substantial value to the goods



## 2. Overview of A. 7(1) EUTMR

### (e)(i): Resulting from the nature of the goods

- this ground will apply to:
  - shapes of 'natural' products
  - shapes of 'regulated' products;
  - shapes which are inherent to the generic function(s) of the goods



## 2. Overview of A. 7(1) EUTMR

### (e)(i): Resulting from the nature of the goods

acceptable example:  
08/05/2019, T-324/18



for, among others,  
*'alcoholic beverages;  
spirits'* in cl. 33

## 2. Overview of A. 7(1) EUTMR

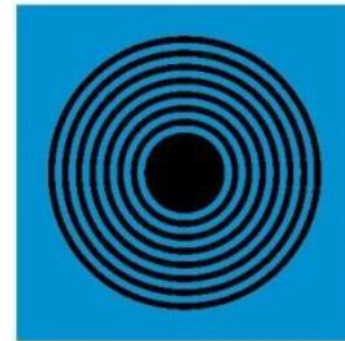
### (e)(ii): Necessary to obtain a technical result

- this provision applies when all the essential characteristics perform a technical function
- two-step assessment:
  - (1) Which are the essential characteristics of a sign?
  - (2) Are all the essential characteristics necessary for obtaining a technical result?

## 2. Overview of A. 7(1) EUTMR

### (e)(ii): Necessary to obtain a technical result

acceptable example:  
10/02/2022, R  
1093/2021-2



for cable and pipe  
penetration seals, sealing  
frames and pipes for  
building in cl. 6, 17 and 19

## 2. Overview of A. 7(1) EUTMR

### (e)(iii): Giving substantial value to the goods

- the concept of ‘value’ should be interpreted not only in commercial (economic) terms but also in terms of ‘attractiveness’
- case-by-case approach: it is important to determine whether the aesthetic value of the shape can determine the commercial value of the product and the consumer’s choice to a large extent

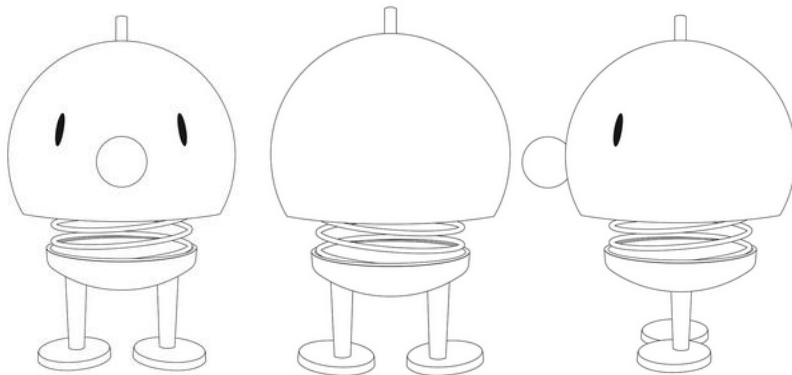
## 2. Overview of A. 7(1) EUTMR

### (e)(iii): Giving substantial value to the goods

acceptable example:

31/08/2021, R

52/2021-2



for goods in cl. 9, 20, 21  
and 28 (computer  
software, statuettes,  
household utensils,  
games, etc.)

## 2. Overview of A. 7(1) EUTMR

### (f): Marks contrary to public policy or morality

LICKWEED

- *‘public policy’*: set of fundamental norms, principles and values of societies in the EU at a given point in time
- *‘accepted principles of morality’*: the fundamental moral values and standards accepted by a society in the EU at a given time

SS

## 2. Overview of A. 7(1) EUTMR

### (f): Marks contrary to public policy or morality

acceptable example:  
27/02/2020, C-  
240/18 P ‘Fack Ju  
Göhte’

for various goods and services in cl. 3, 9, 14, 16, 18, 21, 25, 28, 30, 32, 33, 38 and 41 (perfumery, electronic publications, jewellery, stationery, suitcases, clothing, games, foodstuffs, beverages, telecommunication services, education, etc.)



## 2. Overview of A. 7(1) EUTMR

### (g): Deceptive marks

- 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/services, will not be registered

## 2. Overview of A. 7(1) EUTMR

### (g): Deceptive marks



- cumulative criteria:
  - (1) specific, clear and unambiguous message regarding the goods/services (a non-deceptive use is not possible); and
  - (2) actual deceit or sufficiently serious risk of being deceived

**LACTOFREE**

## 2. Overview of A. 7(1) EUTMR

### (g): Deceptive marks

acceptable example:  
27/06/2017, T-  
327/16

#### **‘ANTICO CASALE’**

for goods and services in  
cl. 29, 30 and 35  
(foodstuffs as well as  
wholesaling and retailing in  
relation thereto)

## 2. Overview of A. 7(1) EUTMR

### (h): Marks in conflict with flags or other symbols

- marks not authorised by the competent authorities and not complying with A. 6ter Paris Convention are to be refused
- A. 6ter PC: the registration and use of trade marks identical or notably similar to (1) state emblems, (2) official signs and hallmarks indicating control and warranty, and (3) emblems, abbreviations and names of IGOs is excluded

## 2. Overview of A. 7(1) EUTMR

### (h): Marks in conflict with flags or other symbols

- criteria: the sign must
  - (1) consist solely of the identical reproduction or 'heraldic imitation' of the symbols at issue; or
  - (2) contain the identical reproduction or 'heraldic imitation' of these symbols; and
  - (3) the competent authority must not have given its authorisation

## 2. Overview of A. 7(1) EUTMR

### (h): Marks in conflict with flags or other symbols

acceptable example:  
18/05/2018, R  
2741/2017-4



BIRMINGHAM CITY  
University  
Centre for Brexit Studies



for goods and services in  
cl. 9, 16, 35 and 41  
(computer software,  
printed matter, advertising,  
education services, etc.)

## 2. Overview of A. 7(1) EUTMR

### (i): Marks in conflict with flags or other symbols

- marks including badges, emblems or escutcheons other than those covered by A. 6ter PC and which are of particular public interest, should not be registered, unless the competent authority has consented to their registration

## 2. Overview of A. 7(1) EUTMR

### (i): Marks in conflict with flags or other symbols

acceptable example:  
02/05/2022, R  
1304/2021-1

 **MS Master Swiss**

for goods and services in  
cl. 8, 16, 21 and 41  
(kitchen knives, cookery  
books, cooking pots,  
education services, etc.)



## 2. Overview of A. 7(1) EUTMR

### (j): Marks in conflict with GIs



- marks which are in conflict with GIs (PDOs and PGIs) should be refused
- three cumulative conditions:
  - (1) the GI must be registered at EU level;
  - (2) the use of the sign must constitute one of situations provided for in the Regulations; and
  - (3) the sign must include the relevant goods

## 2. Overview of A. 7(1) EUTMR

### (j): Marks in conflict with GIs

non-acceptable  
example:  
10/06/2021, R  
2885/2019-2

**‘AMICONE’**  
for *‘wines’* in cl. 33

## 2. Overview of A. 7(1) EUTMR

### (k): Marks in conflict with TTWs

- marks which are in conflict with TTWs should be refused – TTWs convey information to consumers about particularities and quality of wines, in principle complementing information conveyed by PDOs and PGIs
- relevant goods: wine, liqueur wine, sparkling wine, semi-sparkling wine, grape must, wine from raisined grapes and alike in cl. 33

## 2. Overview of A. 7(1) EUTMR

### (k): Marks in conflict with TTWs

acceptable example:

018140956 for goods in  
cl. 29 and 31  
(vegetables)



acceptable example:

017871480 for goods in cl.  
3, 29, 31 and 32 (essential  
oils, fruit, juices, etc.)



## 2. Overview of A. 7(1) EUTMR

### (I): Marks in conflict with TSGs



- marks which are in conflict with TSGs should be refused – TSGs highlight traditional characteristics of a product either in its production process or composition

## 2. Overview of A. 7(1) EUTMR

### (I): Marks in conflict with TSGs

non-acceptable example:  
018082507 for goods in  
cl. 8, 16 and 30 (pizza  
slicers, pizza boxes,  
pizza, etc.)

**LA PIZZA È *bella***

“TRADIZIONE NAPOLETANA”

non-acceptable example:  
016057416 for goods in  
cl. 29 (milk products,  
cheese, etc.)



## 2. Overview of A. 7(1) EUTMR

### (m): Marks in conflict with PV denominations

- marks which are in conflict with earlier PVs denominations should be refused – PV denominations identify cultivated varieties or subspecies of live plants or agricultural seeds
- relevant goods: *‘live plants, agricultural seeds, fresh fruits, fresh vegetables’* or equivalent wording in cl. 31



## 2. Overview of A. 7(1) EUTMR

### (m): Marks in conflict with PV denominations

- requirements:
  - (1) registered PV denomination;
  - (2) the PV denomination was registered prior to the sign;
  - (3) the sign consists of, or reproduces in its essential elements, the earlier PV denomination;
  - (4) the list of goods for which protection is sought for includes a PV of the same species as, or of species closely related to, those protected by the registered PV denomination



## 2. Overview of A. 7(1) EUTMR

### (m): Marks in conflict with PV denominations

acceptable example:  
08/11/2019, R  
2221/2019-2



**‘Kordes Rose  
Monique’**

for *‘roses and rose plants,  
and rose-propagating  
stock’* in cl. 31

# I. General Remarks

**3.**

**Examination by the Office**

## 3. Examination by the Office

- any ground listed in A. 7(1) EUTMR is sufficient for a refusal; it is independent and must be examined separately
- possible reactions from the applicant:
  - no observations
  - observations
  - restriction of goods/services
  - proof of acquired distinctiveness

# I. General Remarks



## 4. Languages

## 4. Languages

- A. 7(1) EUTMR has to be interpreted on the basis of a common European standard
- however, A. 7(2) EUTMR excludes an application for registration if a ground for refusal pertains only to part of the EU

## 4. Languages

- relevant languages for absolute grounds:
  - EU national languages
  - EU regional languages (incl. dialects)

# I. General Remarks

**5.**

**Relevant Territory**

## 5. Relevant Territory

- basis of the objection:
  - if not based on the meaning of a word:  
normally relating to the EU as a whole
  - if based on the meaning of a word:  
generally applying to part of the EU only,  
A. 7(2) EUTMR



## 5. Relevant Territory

- EU national languages:
  - at least in MS where the language is official
  - in other MS for historic, cultural or cross-border market reasons
  - because the language is widely studied and spoken

## 5. Relevant Territory

- EU regional languages and non-EU languages:
  - constitutionally recognised and/or co-official: (at least) MS where language is recognised/official
  - without official status and non-EU languages: language and part of the relevant public have to be specified

# I. General Remarks

**6.**

**Scope of the Objection**

## 6. Scope of the Objection


- in principle, an examination of absolute grounds must be carried out in relation to each of the goods/services at issue
- it is necessary to state reasons in respect of each of those goods/services

# Absolute Grounds for Refusal


**II.**

**Traditional Marks**


# 1. Word Marks – Examples

- ‘FUCKING AWESOME’ (15/03/2023, T-178/22)
  - for goods in cl. 9, 18, 25 and 28 (mainly eyewear, bags, clothing and skateboards)
  - acceptable? 
  - consumers would perceive ‘FUCKING’ as a vulgar intensifier and ‘AWESOME’ to refer to something excellent or outstanding
  - the combination would be understood as a promotional message indicating the high quality of the goods: **not distinctive, A. 7(1)(b) EUTMR**

# 1. Word Marks – Examples

- ‘Cash4life’ (21/12/2022, T-554/21)
  - for services in cl. 35, 41 and 42 (advertising, entertainment, IT services)
  - acceptable? 
  - understood as ‘cash for all of your life’ or ‘cash for the rest of your life’
  - clear link between winning money for life and advertising, entertainment and IT services in the context of gambling or games of chance and lotteries
  - the sign is descriptive and non-distinctive, **A. 7(1)(b), (c) EUTMR**


# 1. Word Marks – Examples

- ‘It’s like milk but made for humans’  
(20/01/2021, T-253/20)
  - for goods in cl. 29, 30 and 32 (milk substitutes and related foodstuffs)
  - acceptable? 
  - the sign conveys a message which is capable of setting off a cognitive process in the minds of the relevant public making it easy to remember and which is consequently able to distinguish the applicant’s goods – it has the minimum degree of distinctive character




## 2. Figurative Marks – Examples



- 05/10/2022, T-802/21
  - for goods and services in cl. 3, 29, 30, 32, 33, 35 and 41 (cosmetics, foodstuffs, etc.)
  - acceptable? 
  - the sign describes an intrinsic characteristic inherent in the nature of the goods and is also non-distinctive, **A. 7(1)(b), (c) EUTMR**


## 2. Figurative Marks – Examples



- 12/05/2021, T-178/20
  - for Cannabis-related services in cl. 35, 39, 42 and 44
  - acceptable? 
  - the association of ‘weed’ with therapeutic services might be understood as if the consumption and production of narcotics will be tolerated or even promoted: contrary to public policy, **A. 7(1)(f)**  
**EUTMR**


## 3. Shape Marks – Examples



- 12/12/2019, C-783/18 P
  - for goods in cl. 29, 30, 32 and 33 (i.a. beverages)
  - acceptable? 
  - the form departs significantly from classical amphoras; as a whole, it presents the required minimum distinctiveness


## 3. Shape Marks – Examples



- 06/10/2011, T-508/08
    - for goods in cl. 9 and 20 (i.a. loudspeakers, music furniture)
    - acceptable? 
    - the design is an essential element of the branding and increases the product's appeal
    - the shape gives a substantial value to the goods, **A.**
- 7(1)(e)(iii) EUTMR**


## 4. Position Marks – Examples



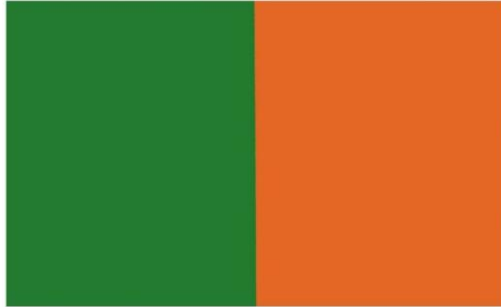
- 13/04/2021, R 2028/2020-2
  - for heat transfer presses (which apply designs) in cl. 7
  - acceptable? 
  - the features (platen pad or plate and colour blue) consist of a simple variation of the basic shapes of the goods, making the sign non-distinctive, **A. 7(1)(b) EUTMR**

## 5. Pattern Marks – Examples




- 03/10/2019, R 2368/2018-1
  - for goods in cl. 16 and 28 (books, toys, decoration, etc.)
  - acceptable? 
  - the sign does not have a ‘special level of artistic creativity or imaginativeness’, but it would be excessive to affirm that it is ‘devoid’ of distinctive character

## 6. Colour Marks – Examples



*'The trademark consists of a combination of the colours green (Pantone 7742 C) and orange (Pantone 1505 C); the frame including the nozzle support frame of the field sprayer is green; attachments to the frame, including nozzle holders, container and cover, are orange.'*

- 04/05/2023, T-618/22
  - for *'agricultural machines and implements, namely field sprayers'* in cl. 7
  - acceptable? 
  - the colours refer to ecology and warning, and are frequently used in the sector of agricultural machines: non-distinctive, **A. 7(1)(b)**  
**EUTMR**

# Absolute Grounds for Refusal



**III.**

**Non-Traditional Marks**




## 1. A. 3(1) EUTMIR

- the trade mark shall be represented in any appropriate form using generally available technology
- as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner

## 2. Sound Marks – Examples




<https://euipo.europa.eu/trademark/sound/EM500000017912475>

- 07/07/2021, T-668/19
  - for goods in cl. 6, 29, 30, 32 and 33 (i.a. beverages)
  - acceptable? 
  - this sound is a purely technical and functional element and will be associated with drinks: non-distinctive, **A. 7(1)(b) EUTMR**

## 2. Sound Marks – Examples




<https://euipo.europa.eu/trade-mark/sound/EM500000018168977>

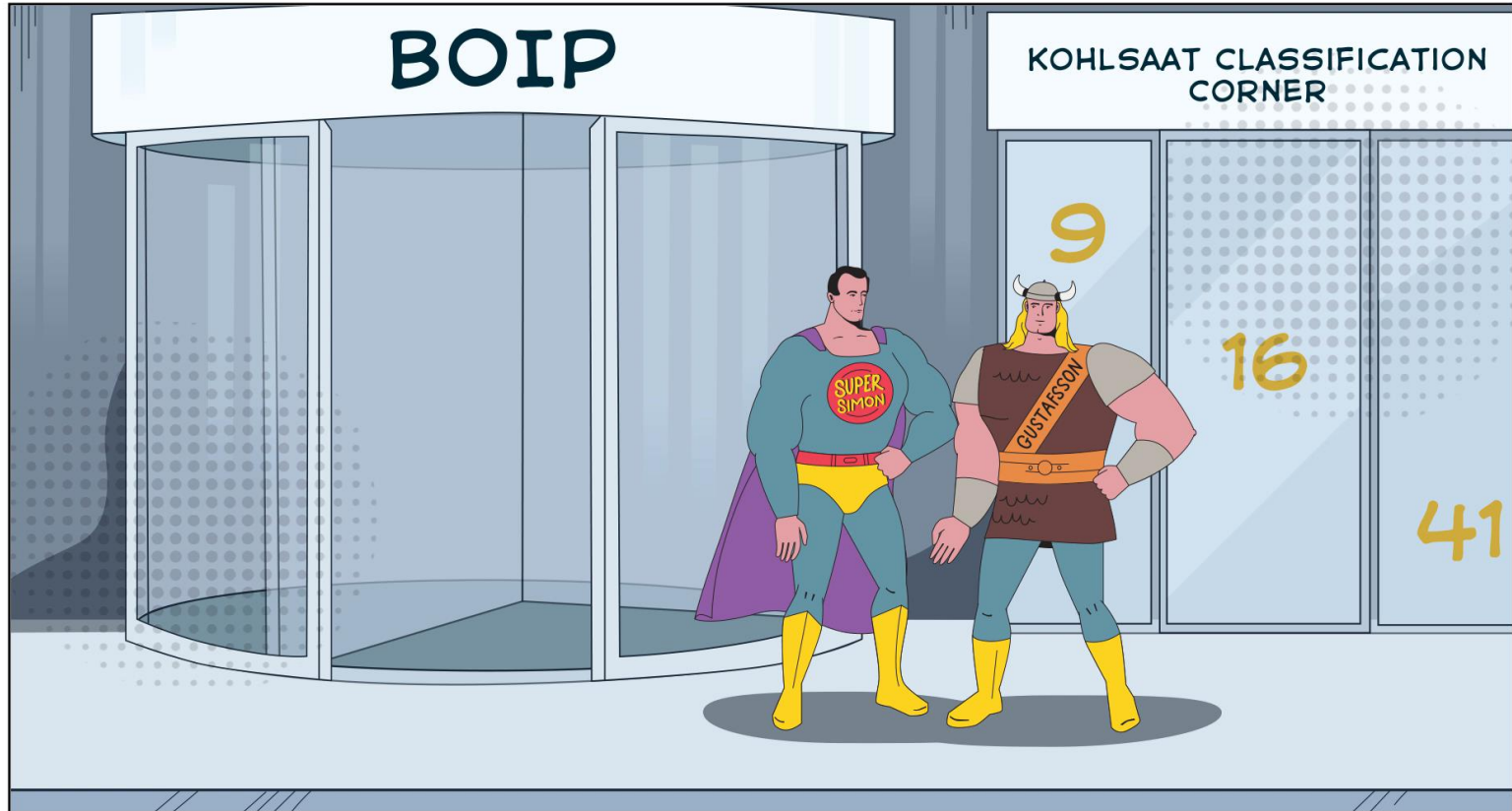
- 12/03/2021, R 1996/2020-5
  - for goods in cl. 3, 9, 14, 16, 18, 21, 25, 28, and 32-34
  - acceptable? 
  - this sound is capable of engendering a certain form of attention and of indicating the commercial origin of the goods

## 3. Motion Marks – Examples



- 08/06/2018, R 2661/2017-5
  - for goods and services in cl. 25, 30 and 43
  - acceptable? 
  - the sign will be seen as a banal and ordinary scene of a chef preparing meat with a pinch of salt: non-distinctive, **A. 7(1)(b) EUTMR**


## 4. Multimedia Marks



## 4. Multimedia Marks – Examples



<https://euipo.europa.eu/eSearch/#details/trademarks/018061546>

- 07/03/2023, R 1490/2022-5
  - for goods and services in cl. 16, 33 and 41
  - acceptable? 
  - the mark does not only have original (though not necessary) features, it also enables the relevant public to distinguish the commercial origin of the goods/services

## 5. Hologram Marks – Examples



<https://euipo.europa.eu/eSearch/#details/trademarks/017579491>

- acceptable example: 017579491 for goods and services in cl. 16, 21 and 35 (stickers, postcards, containers, tableware, etc. and retail and wholesale services in relation to these goods)

## 5. Hologram Marks – Examples





## 6. Other Marks

- types of marks not explicitly included in the non-exhaustive list in A. 3(3) EUTMIR:
  - layout of a retail store



## 6. Other Marks

- smell/olfactory marks
- taste marks
- tactile marks

## 6. Other Marks – Examples



- acceptable examples:
- 018889968 for services in cl. 35 and 43 (advertising, consultancy services, provision of food and drink, etc.)
- 018754993 for services in cl. 43 (cafeteria and restaurant services, rental of bar equipment, provision of food and drink, etc.)

# 6. Other Marks – Examples



## 6. Other Marks – Examples



# Absolute Grounds for Refusal

**IV.**

**Acquired Distinctiveness**

## IV. Acquired Distinctiveness, A. 7(3) EUTMR

- a sign may still be registered despite the fact that it does not comply with A. 7(1)(b), (c) or (d) EUTMR, provided that it has become distinctive in relation to the goods/services for which registration is requested in consequence of the use which has been made of it

## IV. Acquired Distinctiveness, A. 7(3) EUTMR

- types of claims: principal and subsidiary
- timing of request: together with the application or, at the latest, in reply to the examiner's first objection



## IV. Acquired Distinctiveness, A. 7(3) EUTMR

- factors:
  - (1) market share;
  - (2) how intensive, geographically widespread and long-standing the use has been;
  - (3) amount invested in promotion; and
  - (4) proportion of the relevant public who identifies the goods/services as originating from a particular undertaking

## IV. Acquired Distinctiveness, A. 7(3) EUTMR


- examples of evidence:
  - (1) sales brochures;
  - (2) catalogues;
  - (3) price lists;
  - (4) invoices;
  - (5) annual reports;
  - (6) turnover figures;
  - (7) advertising investment figures and reports;
  - (8) advertisements (press cuttings, billboard posters, TV adverts);
  - (9) customer and/or market surveys; and
  - (10) affidavits

# Absolute Grounds for Refusal

**V.**

**Collective Marks**

## V. Collective Marks – Examples

- ‘EMMENTALER’ (24/05/2023, T-2/21)
  - for ‘cheeses with the protected designation of origin “Emmentaler”’ in cl. 29
  - acceptable? 
  - the relevant German public will immediately understand the sign as designating a type of cheese: descriptive (and therefore also non-distinctive), **A. 7(1)(b), (c) EUTMR**
  - since the sign is not perceived as an indication of the geographical origin of that cheese, it does not enjoy protection as a collective mark


# Absolute Grounds for Refusal

**VI.**

**Certification Marks**

## VI. Certification Marks – Examples



- 05/05/2023, R 2229/2022-2
  - for goods and services in cl. 5, 29-33, 35, 39 and 44
  - acceptable? 
  - the sign informs about the material, quality or treatment of the animals/goods: descriptive, non-distinctive and deceptive, **A. 7(1)(b), (c) and (g) EUTMR**

thank you 😊



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*thank you* 😊

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