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GROUNDINGS FOR REFUSAL OF ALL TYPES OF MARKS

Document prepared by the Secretariat

I. INTRODUCTION

1. In accordance with a request made by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its twentieth session (see document SCT/20/4, paragraph 12), the Secretariat prepared document SCT/21/2 entitled “Grounds for Refusal for all Types of Marks” and presented it to the twenty-first session of the SCT. Document SCT/21/2 is based on submissions from the following SCT Members: Australia, Belarus, Czech Republic, Finland, France, Germany, Hungary, Japan, Mexico, Norway, Pakistan, Republic of Korea, Republic of Moldova, Russian Federation, Singapore, Slovenia, Sweden, United Kingdom, United States of America, Viet Nam and the European Community (21). In addition, the African Intellectual Property Organization (OAPI) presented a submission. All submissions were posted on the SCT Electronic Forum webpage. In addition to the submissions mentioned, information provided in returns to the WIPO Questionnaire on Trademark Law and Practice, as presented in WIPO document WIPO/STrad/INF/1 (hereinafter referred to as “the Questionnaire”), and WIPO documents SCT/16/4, SCT/17/4, SCT/18/3 referring to trademark opposition procedures were taken into consideration.

2. As indicated in the introduction to document SCT/21/2, the aim of that document was to present a general view of the criteria determining whether a sign can constitute a valid trademark, without addressing the procedural framework within which those criteria apply. Examples of specific marks are of a merely illustrative nature and should not be considered as being representative of trademark law or practice of specific SCT Members.

3. At its twenty-first session the SCT requested the Secretariat to prepare a revised working document on grounds for refusal of all types of marks to be considered by the SCT at its twenty-second session, taking into consideration the comments made by the delegations during the twenty-first session. Moreover, SCT Members were invited to present submissions on individual items of document SCT/21/2 concerning in particular technical office practice in specific cases and, when available, specific graphic examples. At the time of drafting document SCT/22/2, the Secretariat had received submissions from the following SCT Members: Brazil, Czech Republic, Denmark, Estonia, Germany, Guatemala, Republic of Korea, Russian Federation, The former Yugoslav Republic of Macedonia and the United States of America. All submissions were posted on the SCT Electronic Forum webpage.

4. At its twenty-second session the SCT requested the Secretariat to revise document SCT/22/2, taking into consideration all comments made by the Delegations at the twenty-second session and any additional comments to be submitted to the Secretariat. Additional submissions were received from the following SCT Members: Brazil, Guatemala, Japan, Latvia, Mexico, Republic of Moldova, Russian Federation, Slovenia, Sweden and the United States of America. All additional submissions have been posted on the SCT Electronic Forum webpage.

5. The main body of the revised working document is presented in Annex I to this document, taking into account the comments made by Delegations at the twenty-first and twenty-second sessions and the submissions sent to the Secretariat after each session.

6. The SCT is invited to review Annex I of the present document with a view to its publication as a SCT reference document.

[Annexes follow]

GROUNDS FOR REFUSAL FOR ALL TYPES OF MARKS

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ANNEX I

I. PRELIMINARY CONSIDERATIONS

1. The requirements that a sign must fulfill in order to function as a trademark are reasonably standard throughout the world. However, the practical application of these requirements may differ from one country to another, depending on the specific legislation and trademark registration system. Generally speaking, two different kinds of requirements can be distinguished. The first relates to the basic function of a trademark, namely, its function to distinguish the products or services of one enterprise from the products or services of other enterprises. From that function it follows that a trademark must be distinguishable. The second kind of requirement relates to the potential negative effects of a trademark if it is misleading or if it is contrary to public order or morality.
2. These two kinds of requirements exist in practically all national trademark laws. They also appear in Article 6*quinquies* (B) of the Paris Convention for the Protection of Industrial Property (Paris Convention) (for the full text of Article 6*quinquies* see the Annex II), which states that trademarks enjoying protection under Article 6*quinquies* (A) may be denied registration only if “they are devoid of any distinctive character” or if “they are contrary to morality or public order and, in particular, of such a nature as to deceive the public”.
3. Article 6*quinquies* (A) provides that a trademark which is duly registered in the country of origin must be accepted for filing and protected - *as is* or *telle quelle* - in the other member countries [of the Paris Union], subject to certain exceptions. The list of exceptions is exhaustive so that no other grounds may be invoked to refuse or invalidate the registration of the trademark.
4. This rule is often referred to as the “*telle quelle*” principle. It has been noted that this rule only concerns the individual elements of a given trademark, such as numbers, letters and surnames. In this respect, it does not affect questions relating to the nature or the function of the trademarks as conceived in the countries where protection is sought. Thus, a member country of the Paris Union would not be obliged to register and extend protection to subject matter that does not fall within the meaning of a trademark as defined in the law of that country¹.
5. The first permitted ground for refusal or invalidation of a trademark covered by Article 6*quinquies* applies in situations where a mark conflicts with rights of third parties acquired in the country where protection is sought. These rights can be either rights in trademarks already protected in the country concerned, or other rights, for example, the right to a trade name or a copyright. This ground for refusal may also be applied if a trademark would be likely to violate personality rights.
6. The second permitted ground for refusal or invalidation of a trademark covered by Article 6*quinquies* consists of three possibilities: it applies to any trademark which, in the country where protection is sought, is considered to be (1) devoid of any distinctive character, or (2) descriptive, or (3) the customary designation of the goods concerned.

7. The third permissible ground for refusal or invalidation of a trademark covered by Article 6*quinquies* concerns marks, which are contrary to morality or public order, again as considered in the country where protection is sought.

8. The following part of the document presents the most common grounds for refusal of all types of marks. This presentation is not necessarily exhaustive. Furthermore, grounds for refusal such as lack of distinctiveness, descriptiveness, genericness and deceptiveness have to be assessed in relation to the goods and services for which the registration of a trademark is sought in individual cases.

II. GROUNDS FOR REFUSAL

(a) Signs not constituting a trademark

9. A trademark is registrable only if it satisfies the criteria of registrability laid down in the applicable law. Article 15(1) of the Agreement on Trade-related Aspects of Intellectual Property Rights (the “TRIPS Agreement”) provides the following definition: “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings shall be capable of constituting a trademark”. It follows from this definition that the fundamental requirement for the registration of a trademark is that the sign in question be capable to distinguish the goods or services for which it is registered as a trademark.

(i) *Signs*

10. The definition provided by Article 15(1) of the TRIPS Agreement is broad with regard to the nature of signs that can constitute a trademark. In that respect, this provision stipulates that any signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks. Very often, trademark laws provide a non-exhaustive list of signs which can perform the function of a trademark.

(ii) *Visually perceptible signs*

11. Article 15(1) of the TRIPS Agreement further states that “Members [of the WTO] may require, as a condition of registration, that signs be visually perceptible”. In other words, the TRIPS Agreement does not contain a mandatory requirement for WTO Members to register and protect trademarks consisting of non-visible signs. Nevertheless, many countries do allow the registration of certain non-visible signs and protect them. The following examples of registered non-visible trademarks are being taken from the SCT’s work in this area (see document SCT/16/2).

EXAMPLES OF REGISTERED SOUND MARKS:

United States of America (Reg. No. 2,827,972). “The mark consists of a series of five chirps similar to the chirping sound of a cricket”.

Switzerland (Registration No. 525027 = IR 838231), classes 5 and 30:



EXAMPLE OF REGISTERED OLFACTORY MARK

United States of America (Reg. Nr. 2,560,618), for oil-based metal cutting fluid and oil-based metal removing fluid for industrial metal working in class 4: “The scent of bubble gum”.

EXAMPLE OF REFUSED SOUND MARK:

United States of America: U.S. Trademark Application Serial No. 76,681,788. Applicant sought to register the following sound mark for use in connection with pet toys: “an audio wave form of a nominal square wave of 6.1 KHz that increases to 11.4KHz over a period of approximately 140 msec.” Upon reviewing the accompanying sound file (containing the sound of a mouse squeak) which serves to clarify the description of the mark and which is made part of the application, the USPTO Trademark Examining Attorney refused registration under the Trademark Act because the realistic and authentic nature of the mouse squeak sound serves a utilitarian or functional advantage for applicant.

EXAMPLE OF REFUSED OLFACTORY MARK

United States of America: U.S. Trademark Application Serial No. 78,483,234. Applicant sought to register the scent of mint for use in connection for face masks for medical use. The USPTO Trademark Examining Attorney refused registration because the particular features of this proposed mark, namely, a mint scent, are functional for the goods as it makes the use of a face mask more pleasing to use and/or compliance with use of such a mask is more likely.

(iii) *Graphically represented signs*

12. In some jurisdictions², the issue of graphical representation is dealt with separately, particularly in countries where a condition for registration is that a sign be “represented graphically”. The requirement of graphic representation of trademarks has given rise to questions of interpretation in jurisdictions that apply this requirement, in particular with respect to certain non-visible marks, such as sound marks not consisting of musical sounds, or smell marks. In accordance with the jurisprudence of some countries, for example, a graphical representation of a trademark in order to be acceptable must be clear, precise, and complete by itself, easily accessible, understandable, durable and objective³. In this connection, it is worthwhile noting that the replies to the Questionnaire indicate that non-compliance with the requirements of visual perception and graphic representation frequently constitutes a ground for refusal (68 affirmative answers). In application of this criterion, the graphical representation of a sound might be considered acceptable, whereas the description of a scent in words might not be deemed capable of graphical representation.

EXAMPLE

France: The trademark consisting of the taste “artificial flavor of strawberry” was refused based on the ground of non-complying with the requirement of graphical representation. The application related to a “taste mark” with description “the mark consists of the following taste: artificial flavor of strawberry”.

(iv) Signs not capable as such of distinguishing goods and services

13. A sign that has no inherent capacity to serve as a trademark is likely to be refused. This ground for refusal may be invoked if, in the abstract, a particular sign is simply incapable of performing the function of a trademark under any circumstances, for any goods or service. This may be the case for example for a complete song or a whole film⁴.

14. In order to decide whether a sign is capable of distinguishing (in the abstract) the goods or services of the applicant from those of others (“distinctive as to origin”), one submission suggested applying the concept of “inherent adaptation”⁵. This test refers to a quality of the trademark itself which cannot be acquired through use in the marketplace. The question could be expressed as – is this a sign which, hypothetically at least, could perform the function of identifying all goods marked with it as coming from the control of the same undertaking? If the answer to this question is no, the “sign” has failed to comply with this requirement.

15. It can be concluded that some of the basic criteria that determine the registrability of a trademark are that the trademark consists of eligible subject matter, i.e., the sign in question can constitute a trademark and the trademark has the abstract capacity to distinguish the goods and services of one undertaking from the goods and services of another undertaking. The issue of concrete distinctiveness is addressed below.

(b) Lack of distinctiveness

16. In general, grounds for refusal based on lack of distinctiveness, on descriptiveness and genericness may overlap frequently. Objections on grounds of descriptiveness and genericness might also give rise to an objection on the ground of lack of distinctiveness. However, the scope of the ground for refusal of lacking distinctiveness may extend beyond the grounds of descriptiveness and genericness.

17. Distinctiveness could be defined as the inherent capacity of a trademark to be perceived by the market participants as a means to distinguish the goods or services of an undertaking from those of other undertakings, thus allowing the attribution of these goods or services to a particular commercial origin. Appreciation of the distinctive character of the sign takes into consideration the service or product targeted by the mark. Generally, trademark laws distinguish a series of signs which are deprived of distinctive character: signs which in current or professional language are necessary; generic or usual designation of the product or the service; signs used to indicate a characteristic of the product or the service, and in particular the species, quality, quantity, the destination, value, geographical source, time of the production of the good or provision of the service; signs consisting exclusively of the form imposed by the nature or the function of the product, or conferring its substantial value on the product.

18. The question as to whether the single color or a shade of colors can validly constitute trademark is often raised. The work of the SCT suggests that single colors are generally considered lacking inherent distinctiveness. Many legislations recognize that only in exceptional circumstances, a color *per se* can be regarded as being distinctive without any prior use. Such exceptional circumstances may arise where registration is sought for very limited goods or services in a very specific market segment. Generally, a single color cannot readily be registered without a showing of distinctiveness acquired through use. In assessing the potential distinctiveness of a given color, the Registrar has to have regard to the general interest in not unduly restricting the availability of colors for other traders offering goods or services in the area of trade concerned. The same rules might apply to combinations of colors which are designated in the abstract and without contours⁶.

EXAMPLE

The former Yugoslav Republic of Macedonia: This color mark (violet) has been filed in respect of class 30, for: cocoa, chocolate, chocolate-based beverages. The application has been refused on the ground of lack of distinctiveness*.



EXAMPLES OF REGISTERED COLOR MARKS:

Norway (Reg. No. 226920), class 34[†]:

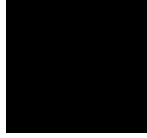


* The sample in the square shows the color violet, which can be viewed in the PDF format of the document at http://www.wipo.int/meetings/en/details.jsp?meeting_id=17465.

† The sample in the square shows the color red, which can be viewed in the PDF format of the document at http://www.wipo.int/meetings/en/details.jsp?meeting_id=17465. The trademark was registered on the basis of evidence of distinctiveness acquired through use.

United Kingdom (Reg. No. 2360815A), class 33:

Mark Description: The mark consists of vodka colored black, in the color “PANTONE black”.



Mark Claim/Limit: The applicant claims the color black (“PANTONE black”) as an element of the mark.

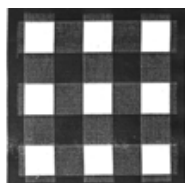
19. Other examples of non-distinctive signs would be figurative representations that are commonly used either in relation to the goods and services applied for, or in a functional or descriptive manner; pictograms and graphic symbols commonly used in a functional manner; figurative marks showing a graphic representation of a naturalistic reproduction of the goods themselves; single letters and numerals; verbal elements which are non-distinctive due to frequent usage and which have lost any capacity to distinguish goods and services, such as top-level domain endings (.com, .int), the @ symbol, or the letter e- in front of goods and services to be delivered electronically. According to the replies to the Questionnaire, the missing distinctive character of a trademark for which registration is sought is a ground for refusal under many trademarks systems (70 affirmative answers).

EXAMPLES

Republic of Moldova: The following trademark applied for goods in class 21 has been refused registration because the mark consists exclusively of a single letter and lacks distinctiveness.



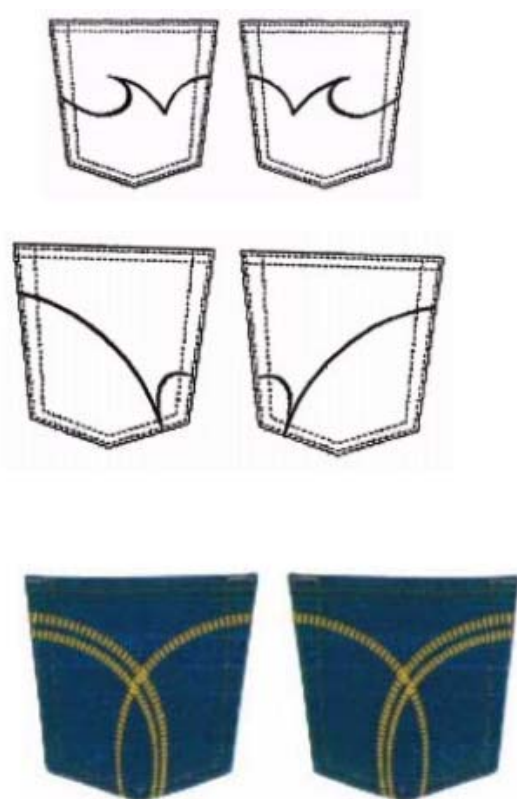
Norway: The following figurative mark applied for the goods in classes 20 and 24 (*inter alia* furniture, mattresses, woven textiles) was refused because it was not seen as being able to indicate a commercial origin (not capable to distinguish the goods of the holder from those of others). The relevant consumers would only see this as an example of the fabric used on the furniture or the textile, and not as someone’s trademark.



Slovenia: The following sign showing a graphic representation of a naturalistic reproduction of the goods themselves (live animals – class 31) was refused because it was not seen as being able to indicate a commercial origin.



United States of America: *In re Right-On Co., Ltd*, 87 USPQ2d 1152 (TTAB 2008)
The Board affirmed the ornamentation-based refusals to register the pocket-stitching designs shown below for various articles of clothing, including jeans, shirts, footwear and headgear.



With arguments and evidence focusing exclusively on the jeans, the Board applied the *Seabrook* factors to conclude that the marks are not inherently distinctive. Given the evidence that pocket-stitching is a prevalent form of ornamentation in the jeans industry, the Board found that a “mere refinement” in this common basic design cannot be inherently distinctive.

(c) Descriptiveness

(i) *General*

20. Trademarks which consist exclusively of signs or indications which may serve in trade to describe the respective goods and services generally may not be registered. The underlying reason for this provision is the public interest objective to keep descriptive indications available for use by everyone and, in particular for use by competitors. Descriptive marks are those that limit themselves to providing information on the goods and services in question. To be objectionable on this ground, the sign must consist exclusively of descriptive matter (this is also valid for all items from (ii) to (ix)). The replies to the Questionnaire indicate that failure to comply with the requirement of non-descriptiveness constitutes a ground for refusal in many systems (68 affirmative answers).

21. In some jurisdictions, a mark will be refused registration if it consists of matter which, when used on or in connection with the goods of the applicant, is merely descriptive or deceptively misdescribes such goods⁷. A mark might be considered descriptive even if it describes a single ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. When looking at the proposed mark, if some imagination, thought or perception is required to determine the nature of the goods and/or services, the proposed mark may be considered suggestive and not be refused. Additionally, terms that attribute a certain quality to, or claim excellence for, goods and/or services, are often considered merely descriptive terms. Commonly, it is seen that a slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. Moreover, if a term has multiple meanings and at least one of those meanings is descriptive, or falsely descriptive, or generic, the term may be considered descriptive, falsely descriptive or generic.

22. The descriptiveness of a word may be determined on the basis of the ordinary understanding of the word in question. This could be corroborated by dictionary entries or it may clearly follow from the ordinary understanding of the term. In addition, terms used in a specialist terminology to designate the respective relevant characteristics of the goods and services may be considered descriptive.

EXAMPLES

France: The trademark “POLLUTIOMETRE” applied for “utensils for pollution measurement” was refused on the ground that this term, even if it did not appear in the dictionary, was understood immediately as necessary designation for applied products (Court of appeal of Paris, March 19, 1999).

France: Word trademark “E-SERVICE” was refused on the ground that the term designated the services themselves as “supporting assistance services provided through Internet”, refusal confirmed by a decision of the Court of Appeal of Paris from April 28, 2004).

Germany: The following advertising slogans were considered not eligible for protection as trademarks on the ground of lack of distinctiveness: “BÜCHER FÜR EINE BESSERE WELT” (BOOKS FOR A BETTER WORLD) applied for “books” and “LOCAL PRESENCE, GLOBAL POWER” applied for services of a travel agent.

Germany: The following signs were considered not eligible for protection as trademarks on the ground of lack of distinctiveness: “K” applied for building material as “K” was also the symbol for 'Kelvin' which, in building physics, represented the heat transfer coefficient, and “@” for miscellaneous goods and services. The sign was a general symbol of modernity which might signal that goods (e.g. print products) were available online or those goods can be ordered online.

Guatemala: The trademarks “PULPIFRUTA” applied for class 32 and “NUTRITORTILLAS” applied for class 30 were refused on the ground that the signs consisted of common designations “PULPA” and “FRUTA”; “NUTRI” and “TORTILLAS” respectively, being understood immediately as the necessary designation for the goods covered, and therefore lacking distinctiveness.

United States of America: *In re Tokutake Industry Co., Inc.*, 87 USPQ2d 1697, Serial No. 79018656 (TTAB 2008). The Board affirmed §2(e)(1) refusal to register the mark shown below for “footwear”.

あゆみ
A Y U M I

The Western and Japanese characters represent the same term, AYUMI, which applicant translated as “walking, a step.” Thus the Board found the term to be merely descriptive since footwear would include all types of footwear including walking shoes. In determining whether the doctrine of foreign equivalents applied, the Board found that Japanese is a modern language spoken by hundreds of thousands of people in the United States and that no evidence was provided that the relevant American purchaser who speaks Japanese would not stop and translate the mark. Since the mark is translated into “walking,” the descriptiveness refusal was proper.

23. In many jurisdictions, abbreviations are considered descriptive terms. Marks consisting of abbreviations may be refused if the abbreviation is a composition of terms which on their own are purely descriptive and this abbreviation is commonly used or at least understood by the relevant specialists in the field, as an abbreviation identifying the goods as to their characteristics.

24. Signs that are “descriptive as of law” form another category of descriptive terms. The descriptive nature of these terms is specified in domestic law or another legal instrument which is either binding or to be taken into account by the examining office. This applies, for example, to International Nonproprietary Names for Pharmaceutical Substances for the purposes of identifying medicinal substances through unique, internationally accepted terms.

25. A mark would not have to be verbal to designate a characteristic. It could also be pictorial. Phonetic equivalents or misspellings of descriptive terms might be registrable in some systems, as they are considered visually distinctive, but refused in other systems where they are not considered phonetically distinctive⁸.

EXAMPLE

Brazil: The slight misspelling of a descriptive word or expression does not turn it into a distinctive mark. In the following example “BANKO”, although the word “banco” (“bank”) is misspelled as “banko”, it is phonetically identical to the original word. Consequently, it can not be registered for banking services and factoring.

26. One submission indicated that the requirements for protection of event marks were not lower than for other marks⁹. In most cases, the respective signs are descriptive, for example “CHAMPIONSHIP”, “GRAND PRIX”, “FESTIVAL”, “FAIR”. Consequently, they are devoid of the required distinctiveness, if the market participants only perceive a descriptive connection of the claimed goods and services with the event, or if they merely associate the goods and services with the event as such. This is the case, in particular, where services relating to the organization and running of the event are concerned, or where goods and services are concerned that have a direct relation to the event (such as sports gear, musical instruments, print publications or other data media, clothing, games). In that case, the trademark will be perceived as identifying the contents or purpose of the event.

EXAMPLES

Germany: The following event trademarks were considered descriptive and therefore lacking distinctiveness: “FUSSBALL WM 2006” (2006 FIFA WORLD CUP); “Deutschland 2006” (GERMANY 2006); “ÖSTERREICH – SCHWEIZ 2008” (AUSTRIA - SWITZERLAND 2008); “SÜDAFRIKA 2010” (SOUTH AFRICA 2010); and a combined word and figurative mark “CLASSIC OPEN AIR GENDARMENMARKT”



Slovenia: The following event marks applied for services in class 41 were refused. In most cases, events marks, if applied as word marks, are descriptive identifying the contents or purpose of the event. If combined with sufficiently distinctive figurative elements such signs could be accepted.

MEDNARODNI POLKA FESTIVAL S KMEČKO OHCETJO (International Polka Festival with the farmer's wedding)
FESTIVAL RADIJSKIH POSTAJ-RADIO FESTIVAL (Broadcasting festival)
POLETNA HOKEJSKA LIGA BLEJ (Summer Hockey League of Bled)

(ii) *Kind of goods or services*

27. Signs consisting of the goods or services themselves, that is, their type or nature, may be considered descriptive and therefore non-distinctive.

EXAMPLES

Japan: The following trademark comprised of the words TOURMALINE SOAP in English and Japanese in an application designating “soap containing tourmaline” was refused on the ground of descriptiveness. The appeal court concluded that ordinary consumers and traders would merely recognize that a component of the designated goods was tourmaline, as the court’s findings indicated that the positive effect of tourmaline had been promoted in advertisements for various other products.

TOURMALINE SOAP
トルマリンソープ

Mexico: The following mark “WODKA” was refused for alcoholic beverages, as it describes the good it sought to protect, due to the fact that the mark is a word of Polish origin that translates into Spanish as the name VODKA, which clearly describes the good for which protection was sought, since this is the exact word for the typical Russian and Polish alcoholic beverage VODKA, known throughout the world.

WODKA

Norway: The sign “CAFÉ COOKIES” for cookies in class 30 was refused registration on the ground that the sign was not capable to distinguish the goods of the holder from those of others. The words in English were seen as equal to the words in Norwegian, and descriptive of the goods even if it was argued to be an innovation/new formation of words. The word mark indicates that the goods (cookies) are to be served in a café.

(iii) *Quality of goods or services*

28. Signs consisting of both laudatory terms, referring to a superior quality of the respective goods, as well as the inherent quality of goods may be considered descriptive. This may also cover terms such as “light”, “extra”, “fresh”, “hyper light” if used for goods in a descriptive manner.

EXAMPLES

The former Yugoslav Republic of Macedonia: The mark “No 1 in Air Conditioning” filed in respect of classes 11 (air conditioning apparatus) and 37 (installation services) has been refused on the ground of lack of distinctiveness because it indicates exclusively the kind of goods or services and their purpose. Moreover, the expressions “No1” might be perceived by the public as an indicator of the quality of products and services, more specifically that they are of top quality.

No 1 in Air Conditioning

Japan: The following trademark which comprised of the word JUMBO in Japanese in an application designating “meat, processed meat products, and seafood” was refused on the ground of descriptiveness. The appeal court concluded that the word JUMBO in the trademark would be understood to show the size of the designated goods, as the court’s findings indicated that the word “jumbo” had not only been listed in ordinary dictionaries but had also been used to show the size of objects including food products.

The image shows the word 'JUMBO' rendered in a stylized, bold, black Japanese font. The characters are thick and blocky, with a slightly irregular, hand-drawn appearance.

Brazil: The following trademarks were refused on the ground that the signs indicate the quality/quantity or value of products or services to be distinguished: “BEST FOOD” for fruits and vegetables, “MAIS BARATO” (CHEAPER) for meat, poultry and fruits, “PIZZA LIGHT” for pizza, pasta, bread and cake; “DIET COOKIE” for cookies, cream crackers, bread, sandwiches and biscuits.

Mexico: The mark “GARANTIA DE CALIDAD TOTAL” was refused for all stationery goods as it is indicative of the quality of the goods.



(iv) *Quantity of goods or services*

29. Signs consisting of indications of the quantity in which the goods are usually sold, commonly referring to quantity measurements relevant in trade, may be objectionable on the ground of descriptiveness.

EXAMPLE

Mexico: Registration of the mark “1Kg” was refused for confectionery and sweets as such a mark indicates the quantity of the good for which protection was sought. Since the indication is used in trade to denote the quantity of a good, which is considered a descriptive mark under law.



(v) *Intended purpose of goods or services*

30. Signs consisting of indications showing the intended purpose, which can be described as the way, the means of application, or the function in which a good or service is to be used, may be considered descriptive.

EXAMPLE

Germany: The trademark “antiKALK” (anti-lime) applied for “water softening preparations for washing machines and dishwashers, descaling detergents, decalcifying preparations for cooking utensils and beverage preparation machines” and the trademark “beauty24.de” applied for “cosmetics” were refused based on the ground of lack of distinctiveness, considering that simple graphical presentations or ornamental lettering of a term commonly used in trade can not remove the descriptive character of the term.

Japan: A trademark that comprised the word EXPERT in English in an application designating “sports equipment” was refused on the grounds of descriptiveness. The appeal court concluded that ordinary consumers and traders would merely recognize the trademark to be a reference to the quality and intended purpose of the designated goods. The court noted that the word “expert” was widely recognized to mean a skilled and trained person and used to indicate that certain sporting goods were for experts, especially ski equipment.

(vi) *Value of goods or services*

31. Signs consisting of indications showing the (high or low) price to be paid, as well as the value in quality are considered descriptive. This may also cover expressions such as “extra” or “top”, “cheap” or “more for your money” and expressions indicating, in common parlance, goods that are superior in quality, such as “premium”.

EXAMPLES

Japan: The following trademark consisting of the combination of numbers and words “250 yen box lunch” in Japanese in an application designating a “box lunch” was refused on the ground of descriptiveness, as ordinary consumers and traders would merely recognize that the designated product was a box lunch priced at 250 Japanese yen.

250円弁当

Mexico: The mark “100 PESOS”, which sought protection for alcoholic beverages, was refused as the name itself indicates a value, given that the PESO is the currency of Mexico and that preceding this word with the quantity 100 automatically indicates the price of the good, and as a consequence, it might mislead or deceive consumers into thinking that this is the price of the good.

(vii) Geographical origin of goods or services

32. Signs consisting of a geographical term indicating the origin of goods and services are usually refused on grounds of descriptiveness. Most submissions indicated that the descriptive character of the geographical term may pertain to the place of production of the goods, the nature of a good, the place on which the services are rendered, the place where the company rendering the services has its seat and from where the rendering of the services is managed and controlled, and the nature of the goods to which the service relates.

EXAMPLES

Latvia: Trademark application M-99-699 (applied for beer in class 32; the applicant is from Finland). This trademark was considered geographically deceptive regarding the origin of the beer (i.e. Finland). The character is known as soldier Švejk from well-known Czech satirical novel "The Fateful adventures of Good Soldier Švejk during the World War" by Jaroslav Hašek. Illustrations by Josef Lada (1887-1957) are as charismatic as the novel itself; therefore the Patent Office looks at this trademark as an indirect geographical indication that could mislead the public on the actual geographic origin of this beer. Since Czech beer is more popular and appreciated in Latvia, the Office refused to register this mark.



Republic of Moldova: The following trademark ТОРЧИИ (TORCHIIN) was refused registration because consists exclusively of an indication which may serve in trade to describe the geographical origin of the applied goods (TORCHIIN is a city in Ukraine).

Japan: The trademark comprised of the word “GEORGIA” written in English at standard character in an application designating “tea, coffee” was refused on the ground of descriptiveness. The appeal court concluded that ordinary consumers and traders would perceive and recognize the goods to have been made in Georgia (United States of America). The court further noted that sufficient ground for refusing registration of a geographical term is that the general public recognizes the term to be a production region or a selling area, regardless of whether that is the actual case..

United States of America: In re Beaverton Foods, Inc., 84 USPQ2d 1253 (TTAB 2007) “NAPA VALLEY MUSTARD CO” in standard characters was considered geographically deceptive for “condiments, namely mustard. Applicant admitted that the goods did not come from Napa Valley, and for the most part, conceded that the mark was at least primarily geographically misdescriptive. The evidence of record demonstrated that Napa Valley is used by third parties as a geographic location and in connection with mustard. In fact, it was shown that Napa Valley hosts a well publicized mustard festival. The Board concluded that Napa Valley is a well known geographic location; that purchasers were likely to believe that the mustard originates from there; and that the misrepresentation is a material factor in the consumer’s decision to purchase these goods.

(viii) Time of production of goods or of rendering of services

33. Signs consisting of expressions concerning the time at which services are rendered, either expressly or in a usual manner, or the time at which goods are produced if that is relevant for the goods, are considered descriptive and are commonly refused for registration.

Mexico: The mark “COSECHA 54” for alcoholic beverages was refused as it was indicative of the time of production, that is, the mark suggested that the alcoholic beverage is a good made in the vintage year 1954, and it was therefore an unjustified privilege to grant exclusivity to this mark.



(ix) Other characteristics

34. In general, this possible ground for refusal may concern characteristics of the goods and services not covered by the preceding list of items. It might apply, for example, to technical characteristics of the goods not falling under the above sub-items.

(d) Genericness

35. Trademarks that consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade are regularly excluded from registration. In other words, a sign that indicates to persons in the relevant trade a product or service in general, rather than a product or service from one particular trade source, may be considered to have become generic. The replies to the Questionnaire indicate that genericness is analyzed in the context of examination proceedings, and failure to comply with the requirement of non-genericness constitutes a ground for refusal in many systems (67 affirmative answers).

36. Some submissions indicated that this ground for refusal also covers words which had originally no meaning, or another meaning¹⁰. Also, it was stated that it is not necessary that the sign or the indication be a term defined in the dictionaries and it is sufficient that there is evidence that such a sign is customary in the current language¹¹. Abbreviations are also covered, as their meaning can only be perceived once they have become customary. Furthermore, figurative elements of trademarks may also be concerned, in case such elements are either frequent or have become the standard designation for goods and services.

EXAMPLES

France: Trademark “LES SARMENTS” applied for “chocolates, chocolate and confectionery products” was refused based on the ground of genericness of the term “sarments” which designates a traditional type of chocolates with the shape of vine branches. (The Court of Appeal upheld this decision, Lyon, 29 January 2004).

Slovenia: The following word marks TELEKOM, GELBE SEITEN, GOLDEN PAGES applied for classes 9, 16, 38 were refused. Trademarks that consist exclusively of signs or indications which have been become customary in the current language are excluded from registration.

United States of America: In re Noon Hour Food Products, Inc., 88 USPQ2d 1172, (TTAB 2008). The Board affirmed the refusal to register BOND-OST as generic for “cheese.” The Board determined that the genus of goods was aptly described by the identification of goods, and that the relevant class of consumers is ordinary consumers of cheese, including consumers of specialized ethnic cheese. The record included: references to the term “Bond-Ost” (as well as “bondost,” “Bondost,” and “Bond Ost”) in books on cheese, cooking, or ethnic foods; evidence relating to use of the term in government and dairy publications, on the Internet, and in newspapers and magazines available to the purchasing public; and evidence of use of the term in the marketplace by cheese vendors, including online suppliers and deli or cheese counters of supermarkets and specialty shops. The Board concluded the term was generic, finding that others frequently used Bondost and Bond Ost as generic designations and that members of the relevant public understood the mark to refer to a type of cheese, rather than to a particular source of cheese.

(e) Functionality

37. The issue of functionality may arise in trademark systems which allow for the registration of three-dimensional shapes, product packaging, color or other trade dress for goods or services¹². Where this type of subject matter is used and can serve as a mark, it may not be “capable of distinguishing”, as a public policy matter, if it covers a functional feature

of the good, that is if it is essential to its use or purpose, or if it affects the cost or quality of the product. In order to determine whether the claimed feature is functional, evidence from the industry can be evaluated as well as information from the applicant, e.g., whether a utility patent covers the feature.

38. In reaching a determination as to functionality, some or all of the following factors may be considered: promotion of the utilitarian benefits of the matter for which registration is sought, the filing of any patent applications by the applicant for the matter in question, the availability of alternative designs, and the impact of the matter on the efficiency or cost of manufacturing.

39. Some submissions indicated that a sign that is functional may not be registered, even if the applicant is able to show that the sign has become distinctive¹³. In this respect, reference may be made to the functionality doctrine, which prohibits registration of functional product features so as to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. It ensures that protection for utilitarian product features is granted through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain and the functional features disclosed in the patent may then be copied by others.

EXAMPLE

United States of America: *Saint-Gobain Corporation v. 3M Company*, 90 USPQ2d 1425, (TTAB 2007). Applicant sought registration of a mark consisting of a shade of purple as applied to the entirety of the rough side of “sandpaper, namely, coated abrasives with either paper or cloth backing.” As marks consisting of a particular color are not inherently distinctive, applicant claimed acquired distinctiveness. The applicant failed to establish that its mark had acquired distinctiveness. In the alternative, the Board considered the issue of whether the applicant’s mark was functional, an absolute bar to registration.

(f) Public order and morality

40. Trademarks which are considered to be contrary to public order or morality are regularly excluded from registration. The replies to the Questionnaire indicate that failure to meet this requirement constitutes a ground for refusal in many systems (74 affirmative answers).

41. In general, and as with all other grounds for refusal, application of this particular ground is determined within the socio-cultural context of a particular jurisdiction. Some systems use the terms “public policy” and “accepted principles of morality”¹⁴. Also, some jurisdictions apply the concept of “scandalous trademark”¹⁵.

EXAMPLES

France: Trademark “EXTASY IF YOU TASTE IT, YOU ' LL BE ADDICT” applied for “alcoholic beverages, beer” was refused on the ground that the expression led to the consumption of illegal, toxic and harmful product for human beings. The refusal was confirmed by the decision of the Court of Appeal which stated that the trademark was suggesting that it applied to products containing a substance which use was legally prohibited (Court of Appeal of Paris, 26 September 2008).

United States of America: The mark shown below was held immoral or scandalous based on vulgarity designations of the word “ROD” in mainstream dictionaries and the context of use in the applicant’s mark SEX ROD, which the applicant admitted had a sexual connotation.

The image shows the words "SEX ROD" written in a hand-drawn, outlined font. The letters are thick and have a slightly irregular, sketchy appearance. The word "SEX" is on the left and "ROD" is on the right, with a small gap between them. The overall style is informal and graphic.

42. In the context of signs that are considered to be contrary to public order or morality, one submission indicated that signs contrary to humanitarian principles cannot be registered as trademarks¹⁶. Another submission noted that signs of high symbolic value may not be registrable¹⁷. This may not refer solely to religious symbols, but also to symbols of significant charities and funds, cultural and educational associations or names of historically important personalities.

EXAMPLES

Germany: The purely commercial use of a religious term or of names and titles of the leaders of the big churches as trademarks and the grant of a statutory exclusive right to such trademarks would be perceived as offensive by a considerable part of the public concerned. Since the offensiveness, as a general rule, resulted from the commercial use, such applications might be refused irrespectively of the goods or services in respect of which registration was sought. Thus, signs such as “CORAN”, “MESSIAS”, “DALAILAMA”, “URBI ET ORBI”, “BUDDHA”, “PONTIFEX” were refused on the ground of being contrary to public policy and accepted principles of morality.

Latvia: Trademark application M-99-87 “LIVE LIGHT” (applied for tobacco in class 34 and services in class 35) was refused as it contradicts with public policy and the socially accepted principles of morality regarding tobacco [and smoking] but was accepted for advertising in class 35. The decision of the Office was based on the fact that the slogan could be perceived by the public as an encouragement to smoke.

Norway: The word mark “MEKKA” (Norwegian for “Mecca”) applied for goods in the classes 29 and 30 (pork meat etc), was refused registration as it would be seen as liable to cause offence to Muslims.

Russian Federation: The following designation “ВИНОКУРЕННАЯ МАНУФАКТУРА” (Distilling Manufactory) in relation to the “kindergarten services” was considered as against of public interests, principles of humanity and morality.



43. Some replies indicated that signs which are likely to bring damage to the image and the interests of the State will be rejected for registration¹⁸. These provisions relate to designations, identical or confusingly similar to official names and pictures of particularly valuable objects of the cultural heritage of a nation, or to objects of the world cultural or natural heritage. This may also concern cultural objects if the registration of such matter is requested by persons other than their owners, and without the consent of the owners or of persons representing them.

EXAMPLE

Russian Federation: The following trademark consisting of the verbal element "КИЖСКИЙ БАЛЬЗАМ" (KIZHKI BALSAM) and the image of the architectural structure of the pogost of Kizhi (i.e. the Kizhi enclosure), a Russian cultural and natural site, included in the UNESCO World Heritage List was refused registration because of the lack of the consent of the competent authority.



(g) Deceptiveness

44. In many jurisdictions, the registration of trademarks which deceive the public as to the nature, quality or geographical origin of the goods or services for which they are used is commonly refused. The replies to the Questionnaire indicate that deceptiveness is analyzed in the context of examination proceedings, and failure to comply with the requirement of non-deceptiveness constitutes a ground for refusal in many systems (73 affirmative answers). Deception may also arise from an alleged characteristic of the goods or services on which the mark is used, including their composition, intended use or purpose or perceived geographical origin. In addition, a perceived connection between the goods or services concerned and a person or organization may be considered deceptive.

EXAMPLES

Sweden: Case 04-351 (Court of Patent Appeals), PATAYA. The court held that the mark PATAYA was liable to convey the impression of being a geographical indication of the goods (i.e. fruit drinks and fruit juices from Pataya, Thailand). The mark was likely to deceive the public since the applicant was from Germany.

United States of America: *Corporacion Habanos, S.A. v. Guantanamera Cigars Company*, 86 USPQ2d 1473, (TTAB 2008). The Board sustained the opposition to registration of GUANTANAMERA for cigars and smokers' articles as geographically deceptively misdescriptive, concluding that the primary significance of the term was geographic, in light of the meaning likely ascribed by Spanish-speaking U.S. consumers, "of or from Guantanamo, Cuba" or "a female from Guantanamo." The Board discounted other meanings of the term proffered by the applicant, concluding that none of them would be widely-known to relevant consumers. As to the second prong, the Board found a goods-place association, noting opposer's testimony that tobacco is grown in the providence of Guantanamo, as well as evidence of Cuba's renown for tobacco and cigars, and the fact that applicant had sought to foster a false association between its tobacco products and Cuba. And as to the final prong, the Board concluded that given Cuba's reputation for high-quality cigars, the goods-place association was material to a consumer's decision to purchase applicant's goods.

45. The above-mentioned ground for refusal, as noted in some submissions, may also apply to cases of strictly untrue indications contained in trademarks, for instance, a reference to ecological agricultural production through the use of an indication such as "eco" or "bio".

EXAMPLES

Russian Federation: The verbal element "coffee", included in the claimed designation, indicating a specific type of good, is false in relation to a part of the claimed goods, such as "tea, rice, yeast, salt, mustard, pepper, vinegar".



Denmark: The following trademark was considered liable to mislead as to the nature of some of the goods. MILKTIME indicates a specific kind of goods, namely those made of milk. Thus the mark is liable to mislead as to the goods "water ices, frozen yogurt products" in class 30.



Germany: Trademark “KOMBUCHA” was considered deceptive for beers without added Kombucha. Kombucha is a tea fungus or a probiotic natural drink. It can be proved that Kombucha is used with water kefir and in bread, soups and yoghurt. So the consumer groups concerned have reason to assume that a (beer) drink designated in this manner does at least contain Kombucha.

Norway: The following combination mark “HOLLAND HOUSE” (figurative and a text element) applied for goods in the classes 32 and 33, was refused registration by the Board of Appeals. The applicant was from the United Kingdom, and a significant part of the Norwegian public would be deceived to believe that the goods originate from the Netherlands. The applicant did not specify that the goods in question did come from the Netherlands.



Slovenia: Under Slovenian practice a deceptiveness objection would be raised if, due to some connotation contained in the mark, the registration of the trademark in relation to the goods and services applied for would be likely to deceive the public. The applicant was required to limit the list of goods to those produced in line with specific indications.



(h) Article 6*ter* of the Paris Convention for the Protection of Industrial Property

46. The purpose of Article 6*ter* is to protect the armorial bearings, flags and other State emblems of the States party to the Paris Convention for the Protection of Industrial Property (Paris Convention). The protection granted by Article 6*ter* is extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations, of which one or more countries of the Paris Union are members. The purpose of Article 6*ter* is to prohibit the registration and use of trademarks which are identical to, or present a certain similarity with, the above-mentioned emblems or official signs.

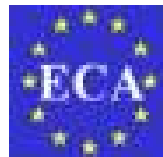
47. The replies to the Questionnaire indicate that failure to comply with Article 6*ter* of the Paris Convention constitutes a ground for refusal in many systems (74 affirmative answers). The important question is whether the mark for which registration is sought is identical or is to a certain degree similar to signs protected under Article 6*ter*. The nature of the goods and services for which a mark is applied may be relevant.

EXAMPLES

France: Trademark “GALILEO” with a graphic design was refused on the ground that a part of the trademark was an imitation of the Italian flag. The refusal was confirmed by the Court of appeal of Paris which held that the fact that the angles in both quadrilaterals are truncated constituted a minor difference, hardly perceptible by the average consumer (Court of Appeal of Paris, 9 February 2001).



Germany: Trademark “ECA” applied for “hardware, software, arranging and conducting of colloquiums, providing of tuition, instruction, training” was considered not eligible for protection, because it was seen as an imitation, from a heraldic point of view, of the circle of stars of the European emblem. The word element 'ECA' reinforced the impression that a connection existed between the applicant and the European Union.



Norway: The following combination mark “NORWEGIAN DIVER” (figurative plus text element) applied for goods in class 9, was refused registration because it consisted of the Norwegian flag.



Norway: The following combination mark “IN-WATER BOOT KIEL” (figurative plus text element) applied for services in the classes 35 and 41, was refused because it was seen as consisting of the European Union flag.



Russian Federation: The following trademarks contain the State Coat of Arms of the Russian Federation. The registration was possible only with a disclaimer for the non-protectable element and with the consent of the corresponding competent authority.



Slovenia: The registration of the following trademarks was refused pursuant to Article 6ter of the Paris Convention. The decision may be influenced by a consideration of whether the sign suggests to the public that a connection exists between the applicant and the organization, and the type of the goods and services for which a mark is applied.



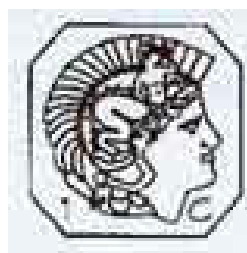
(i) Specially protected emblems and symbols

48. The protection of official signs may also result from special treaties, such as the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces, of August 12, 1949 (protection of the Red Cross and analogous symbols), and the Nairobi Treaty on the Protection of the Olympic Symbol, of September 26, 1981. A conflict with signs enjoying protection under special international conventions may also be considered in the framework of examination proceedings (68 affirmative answers).

49. In several trademark systems, a particular ground for refusal may be based on a potential conflict with signs protected by national law, such as royal emblems (46 affirmative answers), signs of indigenous peoples and local communities (26 affirmative answers), or other signs (37 affirmative answers).

EXAMPLES

Brazil: The following signs have been refused as constituting the reproduction or imitation of official seals adopted as a guarantee of standard for the product or service to be distinguished. The first sign is a reproduction of the seal of Brazilian Federal Inspection Service, used to certify compliance with Brazilian food sanitary standards. The second sign is a reproduction of a hallmark used to certify the purity of gold in France.



The Industrial Property Law of Brazil specifically forbids the registration of reproductions or imitations of names, prizes or symbols of sporting, artistic, cultural, social, political, economical or technical events, official or officially recognized, except when authorized by the competent authority or entity promoting the event. Moreover, the reproduction or imitation of titles, bonds, coins and bank notes of the Union, the States, the Federal District, the Territories, the Municipalities or of any country constitutes a ground for refusal. However, this prohibition may only be applied if the title, bond, coin or bank note is still in circulation. The word "OLIMPIADAS" ("Olympics") was refused for following services: organization of sporting competitions, organization of exhibitions for cultural or entertainment purposes. The sign which reproduces a side of the € 1 coin was refused for life insurance underwriting.



Mexico: Registration of the following mark was refused given that, taken as a whole, it imitates the coat of arms of Mexico. Although the sign is not an exact reproduction, it is nevertheless an imitation and falls under the provision established in Mexican law which stipulates that no reproduction or imitation of coats of arms, banners or emblems of any country shall be the subject of a trademark registration without permission.

Mark refused



Mexican coat of arms



Russian Federation: The following designation includes a graphic element, coinciding with the official emblem of the International Federation of Red Cross Societies. Registration as a trademark is impossible without the consent of the International Federation of Red Cross Societies.



(j) Geographical indications

50. Trademarks which contain or consist of a protected geographical indication (including an appellation of origin) are excluded from registration in many jurisdictions. The replies to the Questionnaire indicate that compliance with this requirement is analyzed in the context of examination proceedings, and a conflict between a protected geographical indication and a trademark constitutes a ground for refusal in many systems (59 affirmative answers).

EXAMPLES

Brazil: The denomination “CA’del SACRAMENTO FRANCIACORTA” applied for beverages was refused from trademark registration on the ground that the sign consists of a wine appellation of origin from Italy.

Brazil: The denomination “VAL DEL VIÑEDOS” applied for sparkling wine was refused from trademark registration on the ground that the sign consists of an imitation of the Brazilian geographical indication for wines “VALE DOS VINHEDOS”.

Republic of Moldova: The following trademarks were refused registration because the marks contained protected appellations of origin (TEQUILA, JAFFA) and the applicants were not the authorized users of those appellations of origin.

SALITOS flavoured with TEQUILA



World Juice Collection JAFFA GOLD



Russian Federation: The following designation “ВОЛОГОДСКИЙ ЛЁН” (FLAX OF VOLOGDA) was considered similar with a protected appellation of origin from the Russian Federation “ВОЛОГОДСКОЕ КРУЖЕВО” (LACE OF VOLOGDA) and it was refused registration based on that prior right.

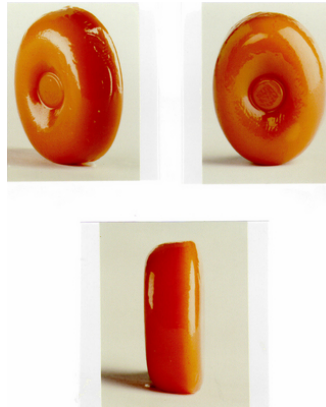


(k) Shapes (signs consisting exclusively of shapes)

51. Signs which consist exclusively of the shape resulting from the nature of goods themselves, the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods are excluded from registration as trademarks in many jurisdictions. It should be noted that, usually, this ground for refusal cannot be overcome through acquired distinctiveness.

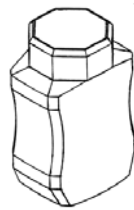
EXAMPLES

Germany: The shape of a sweet was considered not eligible for protection for “confectionery” and, therefore, the sign was refused registration as a trademark. The shape of the sweet consisted of a combination of presentational features which came naturally to mind and which were typical of the goods in question. It seemed like a variation of certain basic shapes commonly used in the confectionery sector and was not markedly different from other shapes for the goods in question which were commonly used for sweets.



Germany: The shape of washing machine and dishwasher tablets was considered not eligible for protection. As regards everyday consumer products, the level of attention paid by the average consumer was not high. The shape of a round tablet was one of the basic geometrical shapes and was an obvious one for a product intended for use in washing machines or dishwashers. Furthermore, the public concerned was used to seeing different color features in detergent preparations (combination of various ingredients).

Norway: The following three-dimensional mark applied for coffee in class 30 was refused registration as it was seen as consisting exclusively of the packaging of the goods.



Norway: The following three-dimensional mark applied for goods in the classes 3, 5 and 21, was refused as it was seen as consisting exclusively of the packaging of the goods.



Russian Federation: Following designations were refused registration on the ground of lack of distinctiveness. The signs constitute a realistic image of goods for which registration was claimed.



Denmark: The mark consists of a representation of the goods, namely a waffle covered with chocolate. Waffles for ice cream will typically come in a large variety of sizes and shapes, among these both with and without chocolate covering. Consumers are therefore used to waffles in all sorts of shapes and thus the consumers are not likely to perceive the shape of the waffle as a trademark for the goods. Consequently the shape of the goods will not enable the consumer to differentiate the applicant's goods from those of other manufactures.



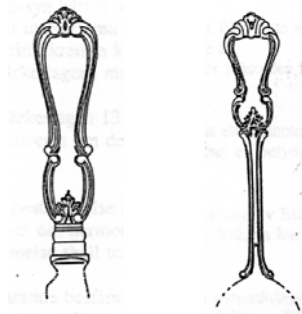
52. The applicability of this ground for refusal is rare and presents some difficulties; nevertheless, useful determinations are found in the case law of some jurisdictions¹⁹. The shape resulting from the nature of the goods themselves is limited to those shapes which are identical to the goods. Therefore, in those jurisdictions, a three-dimensional mark is considered distinctive only if the shape departs substantially from the shapes normally used in the business practice of the sector concerned. When applying the aforementioned provision to goods that do not have a shape themselves, the shape of the packaging is assimilated to the shape of the goods. In the case of liquids, for instance, the relevant shape to consider would be the shape of the packaging²⁰. The shape of goods which is necessary to obtain a technical result is interpreted as applying irrespective of whether there are other shapes that can achieve the result.

EXAMPLES

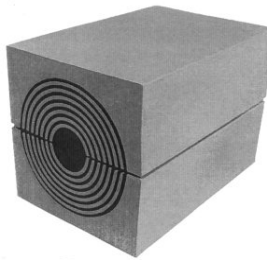
Estonia: The following three-dimensional trademark applied for goods in class 14 was refused by the Office and by the Board of Appeals as it consists exclusively of the shape which results from the nature of the goods.



Sweden: The following three-dimensional mark representing cutlery was rejected in accordance with Article 13 paragraph 2 of the Sweden Trademarks Act – “a shape which gives substantial value to the goods”. The court held that the sign consisted exclusively of a shape giving substantial value to the product (joined cases 94-525 and 94-526, Court of Patent Appeals).



Sweden: The following mark was refused because the essential features of the shape are attributable only to a technical result. The court noted that the ground for refusal under Article 13 paragraph 2 of the Sweden Trademarks Act cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained. (Case 06-168, Court of Patent Appeals).



(1) Bad faith

53. Some submissions indicated that a sign should not be granted protection if its registration was applied for in bad faith. Usually, the issue of bad faith is examined with reference to the circumstances at the filing date, but it does not appear that there exists an international definition of bad faith. Generally speaking, bad faith can be considered to mean “dishonesty which would fall short of the standards of acceptable commercial behavior” but

other behavior may also be deemed to demonstrate bad faith. For example, it could be said that there is bad faith when the trademark applicant intends, through a registration, to lay claim to a trademark of a third party with which she or he had contractual or pre-contractual relations²¹.

54. Other submissions indicated that bad faith objections to trademark applications are mainly raised if an observation is filed by a third party²². Usually, in those systems, any person may submit an observation, and in some countries there is no need to show legal interest in the case. But, in order to apply this ground for refusal, the bad faith must either be shown by the Office, or in the case of an observation, by the person submitting the observation. In some systems a trademark may not be registered if it is liable to be confused with a trademark which someone else has started to use before the applicant, and the applicant was aware of this use when he filed his application for registration²³.

55. A relevant aspect in determining the bad faith of an applicant may be that the applicant was aware at the time of filing that the sign was linked to a third person and that the application was filed in order to prevent that third person from acquiring the rights in question. The fact that the parties had business dealings with each other prior to the filing of the trademark application or that the parties pursue business activities in the same market segment may be relevant. Taking into account these factors, it may be possible that the trademark application qualifies as malicious only with regard to a part of the goods and services, in the relevant market in which the other person is interested.

EXAMPLES

Germany: The trademark “Lady Di” was considered as filed with the intention to interfere with the economic exploitation of the popularity of Diana, Princess of Wales, by the persons entitled or to receive remuneration from these persons. The fact that the application was filed one day after the death of the bearer of the name was a clear indication of the intention to use the trademark as a “blocking device” due to the higher merchandising value after her death. The German Patent and Trademark Office examined *ex officio* whether the applicant acted in bad faith at the time of filing the application.

Mexico: The mark “SEVILLA 92” for clothing was refused on the grounds of bad faith on the part of the applicant in applying for registration in 1992, when this indicated the Universal Exposition sevilla92 in an attempt to benefit from this event.

Russian Federation: The following combined trademarks that contain verbal designations “Янтарь” (Yantar) and “Дружба” (Druzhiba) were invalidated. The verbal designations were used for the labeling of the same product by many independent producers for a long time and, as result, those terms have become customary in the current language, referring to goods of a particular type, namely "melted cheese" of a certain taste.



Sweden: Case 01-117 (Court of Patent Appeals). The applicant's mark is confusingly similar to the mark “WORD OF LIFE” which, at the time of the application, was used by the opponent. The applicant had knowledge about that use and had not used the mark before the opponent's mark was first used.

Applicant's mark



LIVETS ORD—WORD OF LIFE

Opponent's mark

WORD OF LIFE

(m) Prior trademark rights

56. The consideration of prior trademarks as a part of examination, opposition, invalidation or cancellation proceedings is standard in trademark registration systems. In particular, this applies to cases in which identical marks are registered or applied for, in respect of identical or similar goods or services. It may also be the case where similar marks are registered or applied for, in respect of identical or similar goods or services. Generally, the similarity of marks is determined in a comprehensive examination that takes into account the appearance, sound and meaning of marks.

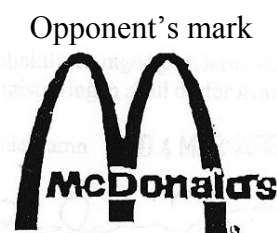
57. In some jurisdictions, the concepts “substantially identical” and “deceptively similar” are used. According to this approach, a trademark is considered to be *deceptively similar* to another trademark if it so nearly resembles that other trademark that it is likely to deceive or cause confusion²⁴. Trademarks are considered to be *substantially identical* if, when compared side by side, they differ only in minor, insignificant non-distinctive ways, but not in material particulars.

58. Prior well-known marks, collective, guarantee or certification marks may also constitute a ground for refusal. In many trademark systems, opposition proceedings can also be based on unregistered trademarks. The existence of unregistered trademarks (whether well known

or not), or well-known trademarks which are registered for goods or services that are not similar to those of the trademark under examination may be taken up at the stage of examination, opposition or invalidation.

EXAMPLE

Sweden: Case 02-218 (Court of Patent Appeals). The applied mark is confusingly similar to the opponent's well-known unregistered trademark, which was established on the market when the application for registration was filed.



59. Signs that are identical or confusingly similar to the trademarks registered or filed for registration earlier may be accepted for registration on condition that the owner of the prior trademark consents to such registration²⁵. However, an office may object to the registration of a mark even in cases in which the holder of a prior right consented to such registration in order to avoid confusion among the consuming public and on the basis of a perceived role by the office to protect consumers and preserve the public interest²⁶.

60. In some jurisdictions, a trademark identical or similar to a prior, expired mark is not registrable until at least one year after expiration. This provision helps to prevent the registration of trademarks when an expired trademark is renewed within one year after the expiration and upon request²⁷.

EXAMPLES

United States of America: *Tea Board of India v. Republic of Tea, Inc.* 80 USPQ2d 1880 (TTAB 2006). Board sustained opposition by Tea Board of India, owner of certification mark featuring the term "DARJEELING" and design for "tea" against the mark "DARJEELING NOUVEAU," with "DARJEELING" disclaimed, for "tea," based upon a likelihood of confusion between the marks.

Brazil: The trademark "SHARK" was refused because it constitutes the English translation of the Portuguese word "TUBARÃO", which was an earlier registered trademark. Both marks were applied for identical goods in class 21.

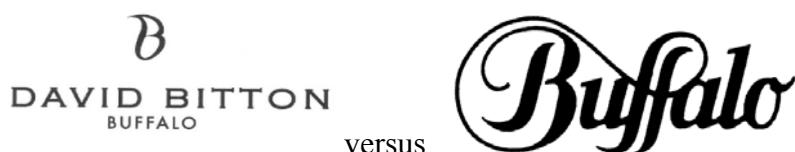
Applying sign

SHARK

Prior registration

TUBARÃO

Norway: The word mark “NORDIC COOL” was refused because of a prior trademark registration for the word mark “COOL”. The combination mark “DAVID BITTON BUFFALO” was refused because of a prior trademark registration for the combination mark “BUFFALO”. Both marks were applied for identical goods in the classes 14, 18 and 25.



Russian Federation: The trademark “ORWELL” was refused because of a prior registration of trademarks “ORWIL” and “ORWELL”. The trademark “VAZ” was refused because of a prior registration of two trademarks “AVTOVAZ”.

The former Yugoslav Republic of Macedonia: The application for a figurative trademark containing a verbal part ”LIVIA” filed for products of the class 3 has been refused on the basis of a prior registered trademark “NIVEA” for the same goods. Examining the marks presented, the Office concluded that considerable visual and conceptual similarity exists, i.e. similarity in the arrangement of the elements, as well as similarity in color.



(n) Other industrial property rights

61. In addition to trademarks, other prior industrial property rights, such as industrial designs, appellations of origin or geographical indications, as well as trade names and business identifiers, may constitute grounds for refusal in many trademark systems. As with prior trademark rights, refusals based on those grounds may be overcome if the holder of the prior right consents to the registration.

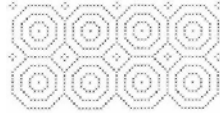
EXAMPLES

Brazil: The following sign was refused on the ground of prior rights based on a registered industrial design. The law provides that a trademark application shall be refused if the sign consists of an industrial design already registered by someone, regardless of the applied goods or services, except if the applicant is the owner of the industrial design itself.

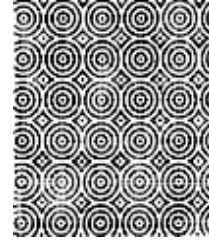


Sweden: Case 02-367 (Court of Patent Appeals). The following applicant's mark was held to be noticeably similar to the opponent's design. Consequently, the mark was cancelled.

Applicant's mark



Opponent's design



(o) Copyright

62. The registration of a trademark that consists of or includes copyrighted material may be refused if registration is sought without permission of the copyright owner. It was also pointed out that trademark registration of well-known copyrighted material may be specifically prohibited by law²⁸.

63. A number of submissions indicated that titles of scientific, literary or artistic works known in a given territory or names of persons or quotations from such works, artistic works or parts of such works cannot be registered as trademarks without the authorization of the owner of the copyright or his successor in title²⁹. Also, according to some legislation, a trademark may not include anything likely to be understood as the distinguishing title of a protected artistic, literary or musical work of another person.

EXAMPLE

Brazil: The following signs were refused trademark registration on the grounds of prior rights based on copyright. National legislation in Brazil states that literary, artistic or scientific works, as well as titles protected by copyright and likely to cause confusion or association, except with the consent of the author or owner, cannot be registered as trademarks. The copyright law does not provide for mandatory registration of copyright and trademark examiners do not undertake a search on this ground. Nevertheless, the examiner can require from the applicant evidence of ownership of the copyright or an authorization of the owner which shall be presented in order to allow the registration of the copyrighted sign as a trademark.



Latvia: The following trademark (applied for meal and cereal preparations, macaroni in class 30) has been declared invalid by the Board of Appeal as a mark which includes copyrighted material. The trademark contains a male character, known as Super Mario that has been created by Japanese designer Shigeru Miyamoto for a series of video games by Nintendo, and this character, i.e. Super Mario, has been protected by copyright.



Mexico: The mark “THE ADDAMS FAMILY” applied for restaurant, bar, canteen, soda fountain and cafeteria services was refused as the name is a generic comedy or work of art protected by the laws of its country of origin, a form of protection which Mexico also recognizes, in accordance with the laws and treaties.



(p) Personality rights

64. Concerning personality rights, a conflict between a trademark and the name of a famous person may constitute a ground for refusal. Some submissions indicated that the registration of a trademark may be refused if the mark is likely to give the impression of being the name or likeness of another person, unless the name is not common, or the mark relates to a person long dead³⁰. However, registration may be granted if the person whose rights are concerned agrees to the registration of the mark.

EXAMPLES

Brazil: The following signs were refused trademark registration on the ground of personality rights. National legislation of Brazil states that personal names or signatures thereof, family names or patronymic and images of third parties, except with the consent of the owner, his heirs or his successors are not eligible to be registered as trademarks. The examiner will ask the applicant to fulfill the requirement of authorization to use names, signatures or images of people (famous or not), except if the applicant is the holder of the personality right. The same requirement refers to well-known pseudonyms or nicknames and singular or collective artistic names, except with the consent of the owner, his heirs or his successors.

Name

JOSÉ GOMES MACHADO

Goods & Services: Accounting

Signature

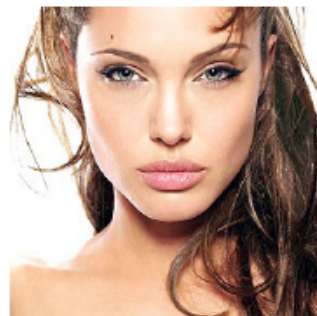


Famous name

GIORGIO ARMANI

Goods & Services: Clothes

Image of third parties



Well-known pseudonym



WOODY ALLEN
Pseudonym of Allan
Stewart Konigsberg

Well-known nickname



PELÉ
Nickname of the famous
Brazilian soccer player
Edson Arantes do
Nascimento

Artistic name



MADONNA
Artistic name of Madonna
Louise Veronica Ciccone

United States of America: In re Steak and Ale Restaurants of America, Inc., 185 USPQ 447 (TTAB 1975). Trademark “PRINCE CHARLES” was found to identify a particular living individual whose consent was not on record.

Mexico: Registration of the mark “REYNA SOFIA” was refused for bread, cakes and biscuits in as much as the law of Mexico establishes that names, pseudonyms, signatures and portraits shall not be registered as marks without the consent of those concerned.

Republic of Moldova: The following trademarks were refused registration because the signs identified family names of famous persons whose consent was not on record.

PUTIN
ПУТИН

МЕДВЕДЕВ
MEDVEDEV

III. CROSS-CUTTING ISSUES

(a) Acquired distinctiveness

65. Many submissions have indicated that a refusal on the ground of lack of distinctiveness may be overcome if the trademark has become distinctive in relation to the goods and services for which registration is requested, because of the use which has been made of it. An objection based on deceptiveness, however, cannot generally be overcome in this way. The replies to the Questionnaire indicate that certain marks are registrable only with proof of acquired distinctiveness (44 affirmative answers).

66. Most replies were very general stating that marks consisting wholly of a sign ordinarily used to indicate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services, or the time of production of goods or rendering of services, would be registered only with proof of acquired distinctiveness. This also appears to apply to marks consisting of a single color and marks consisting only of numbers.

67. Many replies emphasized that the public should recognize the sign as a mark of an enterprise. There appear to be many ways to prove acquired distinctiveness, such as, the results of surveys or opinion polls. According to some replies, evidence would have to show that the mark distinguishes the goods or services at the date of application for registration. One reply mentions as a criterion for determining acquired distinctiveness exclusive and continuous use for five years and ownership of the registration of the same mark for related goods/services and/or evidence showing a distinctiveness perception by the public³¹.

68. Generally, a trademark may be considered distinctive if it is recognized by a sufficiently large part of the relevant public as a mark of one single trader. The criteria for showing acquired distinctiveness of non-traditional marks are no different from those applied to all types of trademarks. In some jurisdictions, evidence of use is a factor in determining whether a mark has become distinctive. Evidence generally accepted includes opinion polls, surveys, statements from trade and consumer organizations, articles, brochures, samples, evidence of turnover and advertising, and other types of promotion and of successful prosecution of infringers. Furthermore, it is important to show examples of how the mark is used (brochures, packaging, etc.), the length of use and the amount (volume) of use, which is of particular relevance. Also, use must be of the trademark applied for and not of a significantly different variation, and the use must relate to the goods and services which are the subject of the trademark application³².

69. Commonly, the evidence for an acquired distinguishing capacity is to be presented by the applicant³³. Such evidence may, in particular, demonstrate that a sufficiently large part of the public has the requisite knowledge that the sign constitutes the mark, even though its source may be unknown.

(b) Disclaimer

70. Where the trademark contains an element that is not distinctive, offices may request the applicant to disclaim any exclusive right to that element where its inclusion could give rise to doubts as to the scope of protection of the mark. The replies to the Questionnaire indicate that in the case of composite trademarks with non-distinctive words or elements, the applicant

may be asked to disclaim such words or elements of his trademark (37 affirmative answers and 33 negative answers). If the applicant's statement does not overcome the ground for refusing registration or she/he does not agree with the disclaimer, then the application may be refused to the extent deemed necessary.

71. A disclaimer is seen as a means to overcome a possible ground for refusal. At the same time, a disclaimer may be considered necessary for the purpose of defining the rights of the owner of a trademark. In some jurisdictions, the applicant is given the possibility to indicate in the trademark application the elements in which she/he does not claim exclusive rights. In such cases, the disclaimer may remain even if the examiner does not deem it necessary³⁴.

72. It was indicated that in general, signs that are devoid of any distinctive character may be incorporated in the trademark as unprotected elements, insofar as they do not predominate³⁵. When defining whether a non-protectable element occupies a dominant position in a designation, its semantic meaning and/or its positioning is/are taken into account.

IV. CONCLUSION

73. Based on specific submissions from SCT Members, the returns to the Questionnaire on Trademark Law and Practice, and on previous work of the SCT, this document attempts to provide an overview of the grounds for refusal most commonly found in the trademark legislation of SCT Members. At this stage of the work of the SCT, and bearing in mind that the individual application of each ground for refusal is governed by particular office practice and case law, the document had to remain general in nature. Thus, it cannot serve as a reference for addressing specific issues in particular jurisdictions.

¹ See G. H. C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, page 111.

² See submission by the Delegation of Australia.

³ See submission by the Delegation of France.

⁴ See submission by the Delegation of the United Kingdom.

⁵ See submission by the Delegation of Australia.

⁶ See submission by the Delegation of Germany.

⁷ See submission by the Delegation of the United States of America.

⁸ See submission by the Delegation of the United Kingdom.

⁹ See submission by the Delegation of Germany.

¹⁰ See submission by the Delegation of the European Community.

¹¹ See submission by the Delegation of the Republic of Moldova.

¹² See submission by the Delegation of the United States of America.

¹³ See submission by the Delegation of the United States of America.

¹⁴ See submission by the Delegation of the Czech Republic.

¹⁵ See submission by the Delegations of Australia and the United States of America.

¹⁶ See submission by the Delegation of Belarus.

¹⁷ See submission by the Delegation of the Czech Republic.

¹⁸ See submission by the Delegations of the Republic of Moldova and the Russian Federation.

¹⁹ See submission by the Delegation of the European Community.

²⁰ See submission by the Delegation of Germany.

[Endnote continued from previous page]

- 21 See submission by the Delegation of the European Community.
22 See submission by the Delegation of Hungary.
23 See submission by the Delegation of Norway.
24 See submission by the Delegation of Australia.
25 See submission by the Delegation of Belarus.
26 The issue of letters of consent will be the subject of an information document to be presented to the twenty-second session of the SCT.
27 See submission by the Delegation of Japan.
28 See submission by the Delegations of Australia and the Russian Federation.
29 See submission by the Delegation of Belarus.
30 See submission by the Delegations of Finland and the United States of America.
31 See submission by the Delegation of the United States of America.
32 See submission by the Delegation of the European Community.
33 See submission by the Delegation of the Russian Federation.
34 See submission by the Delegation of the European Community.
35 See submission by the Delegation of Belarus.

[Annex II follows]

ANNEX II

“ARTICLE *6quinquies* OF THE PARIS CONVENTION
FOR THE PROTECTION OF INDUSTRIAL PROPERTY

Marks: *Protection of Marks Registered in One Country of the Union
in the Other Countries of the Union*

A(1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

(2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.

B. Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

(1) when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;

(2) when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;

(3) when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article *10bis*.

C(1) In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.

(2) No trademark shall be refused in the other countries of the Union for the sole reason that it differs from the mark protected in the country of origin only in respect of elements that do not alter its distinctive character and do not affect its identity in the form in which it has been registered in the said country of origin.

D. No person may benefit from the provisions of this Article if the mark for which he claims protection is not registered in the country of origin.

E. However, in no case shall the renewal of the registration of the mark in the country of origin involve an obligation to renew the registration in the other countries of the Union in which the mark has been registered.

F. The benefit of priority shall remain unaffected for applications for the registration of marks filed within the period fixed by Article 4, even if registration in the country of origin is effected after the expiration of such period.”

[End of Annex II and of document]