

# REGISTERING NON-TRADITIONAL MARKS AND PROVING ACQUIRED DISTINGUISHINGNESS - EU PERSPECTIVE

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# DISTINCTIVE CHARACTER

- origin indication is the essential function of the trademark
- trade mark must be capable of distinguishing goods and services of one undertaking from another
- trade marks that lack distinctive character cannot be registered
- absolute ground of refusal

# DISTINCTIVE CHARACTER ACQUIRED THROUGH USE

- RULE - registration must be refused for trade marks that are *per se* devoid of any distinctive character,
- EXCEPTION – if the trade mark acquired distinctive character through use it may be registered as a trade mark.
- It means that although the sign *ab initio* lacks inherent distinctiveness with regard to the goods and services claimed, due to the use made of it on the market, at least a significant proportion of the relevant public has come to see it as identifying the goods and services claimed in the EUTM application as originating from a particular undertaking.

# REQUEST

- the acquired distinctive character will be examined only on **applicant's request**
- a principal claim or subsidiary claim
- filed **together with the application** or at latest, in **reply to the examiner's first objection**
- not possible to raise the claim for the first time in the appeal proceeding

# POINT IN TIME TO ESTABLISH ACQUIRED DISTINCTIVENESS

- **In examination proceeding** applicant must prove that distinctive character was acquired through use of the trade mark **prior to the date of application for registration.**
- **In cancelation proceeding**, the registration can be kept in consequence of the use that has been made **after registration**

# CONSUMER

- perception of the **average consumer** for the category of **goods** or services in question.
- consumers are deemed to be **reasonably, well informed, and reasonably observant** and circumspect
- not only **persons who have actually purchased** the goods and services but also any **potentially interested person** in the strict sense of prospective purchasers

# GOODS AND SERVICES

- acquired distinctiveness must be assessed in respect of the goods and services covered with the trade mark application
- evidence must prove a link between the sign and the goods and services for which the sign is applied for

# TERRITORY

- acquired distinctiveness must be established throughout the territory in which the trade mark did not *ab initio* have distinctive character
- problematic for 3D marks, colours per se and figurative trade marks consisting exclusively of the depiction of the goods in question
- the ECJ has held that, despite the fact that acquired distinctiveness must be shown throughout the European Union, it would be unreasonable to require proof of acquired distinctiveness for each individual Member State (judgment of 24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 62).
- it is possible to extrapolate from selective evidence to draw broader conclusions under the condition that
  - the market is comparable and
  - at least some evidence of use is submitted for the area where the evidence is extrapolated.

# PROOF

- it is necessary to prove qualified use, such that the relevant public perceives as distinctive a sign that per se is devoid of distinctive character,
- submit evidence that enables to find that at least a significant proportion of the relevant section of the public identifies the products or services concerned as originating from a particular undertaking because of the trade mark
- evidence must be clear and convincing

# RELEVANT FACTORS

In establishing acquired distinctiveness, account may be taken of, inter alia, the following factors:

**the market share held by the mark with regard to the relevant goods or services;**

**how intensive, geographically widespread and long-standing use of the mark has been;**

**the amount invested by the undertaking in promoting the mark for the relevant goods or services;**

**the proportion of the relevant public who, because of the mark, identifies the goods or services as originating from a particular undertaking.**

# EVIDENCES

Examples of evidence that may help to show acquired distinctiveness include, inter alia:

- sales brochures
- catalogues
- price lists
- invoices
- annual reports
- turnover figures
- advertising investment figures and reports
- advertisements (press cuttings, billboard posters, TV adverts), together with evidence of their intensity and reach
- customer and/or market surveys
- affidavits.

# EVIDENCES

The evidences shall:

- shows use of **the mark applied for**
- be sufficient to **identify the dates** of such use
- be sufficient to **identify a specific geographical territory** of use within the EU

The evidence must show that, prior to the filing date, the trade mark had acquired distinctive character through use.

Evidence that, although subsequent to the filing date, enables conclusions to be drawn regarding the situation as it was on the filing date shall be taken into account

Overall assessment of all the evidence submitted.

# CONSEQUENCES

- If the acquired distinctiveness is proven, the trade mark shall be registered.
- Trade mark registered due to the acquired distinctiveness enjoys the same protection as any other trade mark.

# THANK YOU FOR YOUR ATTENTION



# CONTACT



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