PROOF OF ACQUIRED DISTINCTIVENESS

Stefan Martin
Member of the Boards of Appeal
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Overview

Why acquired distinctiveness?

When?

Means of evidence?

Questions?
Why?

Legislative framework

Examination proceedings:

**Article 7(3) CTMR/EUTMR**

- Only in case of an objection based on Article 7(1)(b), (c) and (d).
- For example not applicable for objections based on Article 7(1)(e) [shape or another characteristic of goods] or Article 7(j) [PGI] (new) EUTMR.

Cancellation proceedings

**Article 52(2) EUTMR**
• Request by the applicant

• At any time during the examination proceedings (in general when replying to an AG-objection letter).
Relevant point in time

When?

Examination:
1. before the application was filed (IRs designating the EU: registration date by the International Bureau/designation date).
2. irrelevant that the mark may have acquired distinctiveness through use after the application was filed.

Cancellation: after registration but before the application for an invalidity request.
Relevant point in time

- Any evidence of use relating to the period subsequent to the date of filing may not be taken into account.

- Logic of the system of absolute and relative grounds for refusal with regard to the registration of Community trade marks, according to which the date of filing of the application for registration determines the priority of one mark over another (see judgment of 21/11/2012, T-338/11, PHOTOS.COM, ECLI:EU:T:2012:614, § 45).
The distinctive character, including through acquired distinctiveness must be assessed in relation to the presumed perception of an average consumer.
Consumer
Consumer

- Important: prospective consumers are defined by the precise product for which registration is sought.

- Irrelevant that the actual goods offered under the sign are extremely expensive luxury items.

- The public will include all the prospective purchasers, including non-luxury and cheaper items.
Where?

• Figurative marks with verbal elements

• Figurative marks, 3D marks, colours per se, sound marks, etc.
1) Evidence of acquired distinctiveness of the word mark ‘PHOTOS.COM’ in four Member States (DK, FI, SE and UK) sufficient?


3) Distinctive character acquired must be demonstrated in the substantial part of the European Union in which it lacked distinctiveness under Article 7(1)(b) to (d) (PHOTOS.COM, ECLI:EU:T:2012:614, § 40).
2) Product known only in Germany and Austria?
Samples

3) Evidence in BE, DE, FR, IT, NL, AT, SE and UK?
Evidence – Burden of proof?

Applicant?

Office?
What evidence?

- Proportion of the relevant public who identify G&S as originating from a particular undertaking
- Market share
- Intensive, geographically widespread and long-standing use
- Investment in promoting the mark
- Brochures, samples, press articles, evidence of turnover, advertising, examples and figures, statements from trade (chamber of commerce), consumers or professional organisations, opinion polls
Means of evidence?

- Brochures, samples, press articles, evidence of turnover, advertising, examples and figures, statements from trade (chamber of commerce), consumers or professional organisations, opinion polls
- The following could also be accepted in support of evidence:
  - Successful prosecution of infringers
  - Family of marks
What evidence? Some problematic issues

Extracts from the applicant’s website for different countries:

- Evidence that the specific website has been visited;
- Orders made through that website;
- Comments/references on other websites, …

BUT: problematic!

Do the documents refer to the website or to the trade mark?
Invoices

- Do they refer to the relevant period?
- Do they show the mark? If not, cross-reference?
- Extent?
- Mark as applied for?
Sworn or affirmed statements

• Declarations by the proprietor or its employees
• Declarations by third parties, such as surveys, experts, Chambers of Commerce.
Opinion polls and market surveys

• Independence of the entity conducting it?
• Number and profile (sex, age, occupation and background) of the interviewees (samples of 1 000 – 2 000 interviewees are considered sufficient)?
• How and in what order the questions were formulated (leading questions)?
• Percentage reflected in the survey corresponds to the total amount of persons questioned or only to those who actually replied?
• For which goods/services the mark is known?
Annual reports on economic results and company profiles

Do they refer to goods/services sold/provided under the mark in question?

By whom carried out?
Sample for proven acquired distinctiveness
(decision of 23/10/2015, R 1206/2014-4)

Trade mark applied for goods in Class 6, inter alia, *round steel chains.*

Trade mark:
Sample for proven acquired distinctiveness (decision of 23/10/2015, R 1206/2014-4)

- Sales figures alone not enough;
- It has to be specifically proved that as a result of use, consumers perceive the sign applied for as trade mark per se;
- Applicant has proven use in all Member States, though in varying intensities;
- Applicant shows market shares and turnover figures;
- Advertising budget of €750,000;
- Advertising banners: ‘Pink is beautiful’; ‘pretty pink’; product catalogue shows the slogan ‘unmistakable in pink’;
Sample for proven acquired distinctiveness (decision of 23/10/2015, R 1206/2014-4)

- Applicant makes reference to the colouring of the goods in the manner of identifying a sign;
- Number of competitors is limited;
- Colour pink is unusual for chains;

Acquired distinctiveness (+)
How to submit?

Structured…
Assessment of the evidence

- Quality of evidence: evidence provided or certified by third parties is more reliable than information generated in-house by the applicant.
- Trade evidence: independent trade associations, consumer organisations and competitors: more weight
- Suppliers and distributors evidence: less weight (degree of independence)
Assessment of the evidence

• Turnover and advertising:
  ❖ In relation to the G&S for which registration is sought
  ❖ Size of the relevant market: in order to provide a context for assessment
Assessment of the evidence: use in combination of another mark

- ECJ Decision C353/03: “Have a break”

- The slogan “Have a break...Have a Kit Kat” already registered in UK.

- UK Court of Appeal refused “Have a break” – no genuine independent use of this mark. Only use as part of a composite mark.
Assessment of the evidence: use in combination of another mark

• UK Court of Appeal referred the “Have a Break” case to the ECJ.
• Can the distinctive character of a mark be acquired in consequence of its use as part of a registered mark?
• Answer: Yes – provided that due to such use the mark alone is actually perceived as designating an origin in trade
Assessment of the evidence: 3D mark use in combination of another mark

- “Consumers are not prevented from recognising a product on the basis of its shape simply because they invariably see it with a word mark or a coloured logo.

- Example mentioned by the appellant: if an empty Coca-Cola bottle were washed up on a beach and all trace of the word mark had been eroded by the action of the waves, it is probable that consumers would recognise the bare shape instantly as a Coca-Cola bottle.
Assessment of the evidence: 3D mark use in combination of another mark

• The question to ask: would consumers, upon seeing the bare shape of the appellant’s packaging, with or without word marks, other written material or logos, regardless of the colour or colours, recognize it and associate it with a specific commercial source.
Assessment of the evidence: 3D mark use in combination of another mark

“The problem is not just that various word marks or descriptive words have been used on the packaging; but rather that the ability of the shape to transmit any message to consumers about trade origin has been obscured by a number of additional eye-catching features that affect the appearance of the product and severely lessen the visual impact of the shape itself……
Assessment of the evidence

- CFI in Case T-396/02 August Storck
Where a mark consists of the shape of the goods themselves it is not sufficient to show that a certain product shape has been used. It is also necessary to show that the circumstances of use are such that the shape in question has the character of a mark.
Assessment of the evidence

• The sweets are always sold in packets – a picture of a pile of sweets on the packet does not serve to emphasise the features of an individual 3D sweet.

• Although one sees the 3D sweet in advertising and upon consumption one does not see it clearly at the point of purchase.

• In the absence of opinion poll evidence such usage is insufficient for acquired distinctiveness.
Assessment of the evidence

- What is this?
Assessment of the evidence

- What is this?
Thank you!

Questions?
Thank you