

CP3 Common Practice

Distinctiveness – Figurative marks containing descriptive/non-distinctive words

Supplementary training materials

Background

Maintenance of Common Practices: Sub-project of the EUIPO's European Cooperation Service launched in November 2019.

*“The **objective** of this sub-project is to establish and utilise a more developed and systematic maintenance system to ensure the **sustainability of EUIPN convergence** and ensure the **effective management of Common Practices.**”*

CP3 questionnaire



Distributed in April 2021 to understand application of CP3 among EUIPN



Invited IP Offices (IPOs) and User Associations (UAs) to select relevant CP3 principles and outcome for 43 examples



Questionnaire comprised both fictitious cases and real-life signs from IPOs

Selection criteria to include examples in training materials:

minimum **80%** consensus on outcome (finding of distinctiveness/non-distinctiveness)

CP3 Training Materials

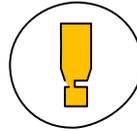


These training materials have been created with the purpose of complementing the CP3 training materials, published in 2015 and available [here](#), with real IPO cases and further fictitious examples.

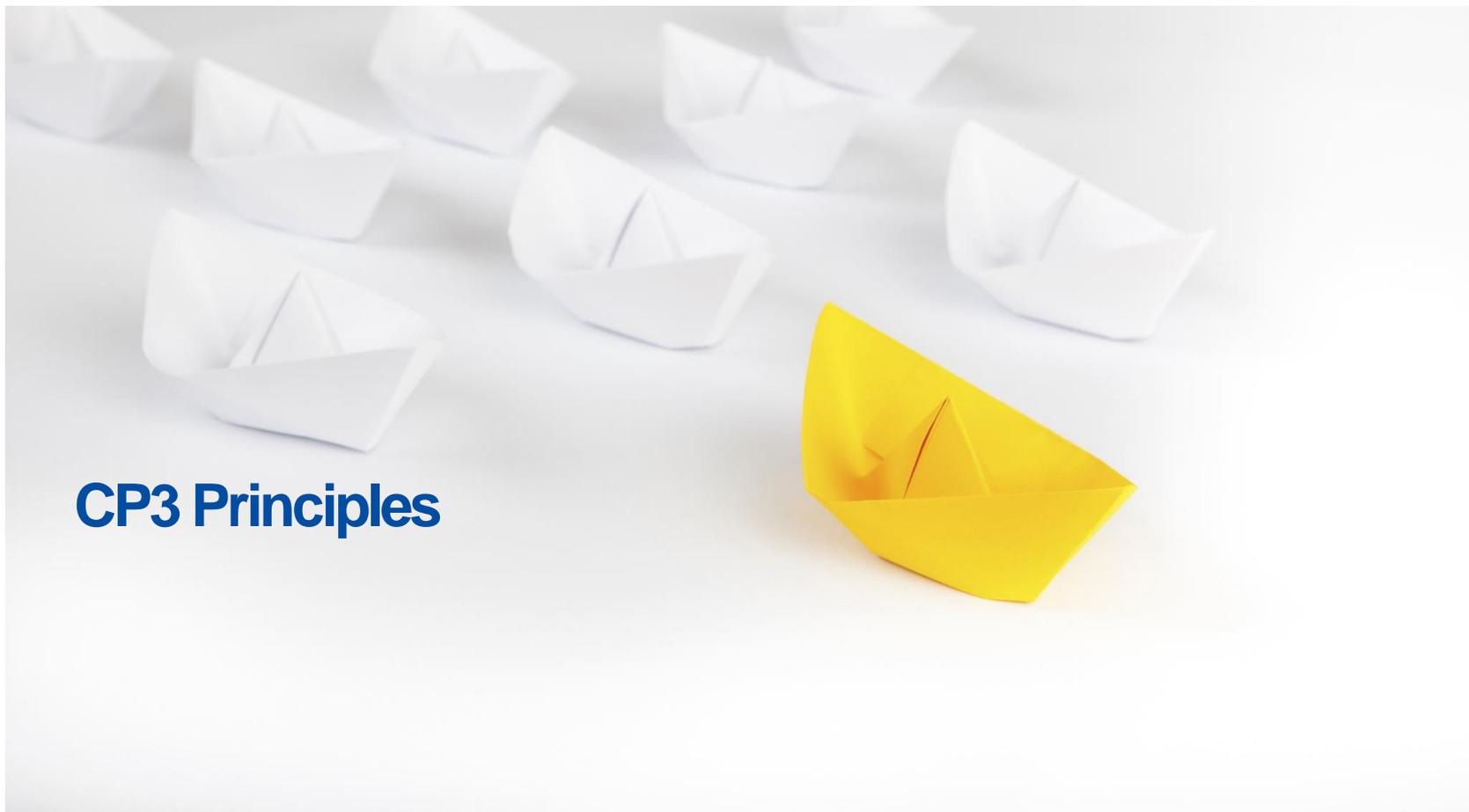
*They include the following **three** sections:*

- **CP3 Principles**: *An overview of each of the CP3 principles, including real and fictitious examples found to be converged in the CP3 questionnaire, to illustrate how the principles are applied in practice.*
- **Case Studies**: *A step-by-step guide on how to apply the CP3 principles, using real IPO cases extracted from the CP3 questionnaire.*
- **CP3 Case-law Overview**: *A non-exhaustive list of decisions relevant to CP3, collected from various courts within the EU.*

Disclaimer



*These training materials have been compiled for **guidance purposes** and should be considered as **indicative only**.*



CP3 Principles

CP3 Principles



*This section of the training materials aims to **illustrate** the principles of the CP3 Common Practice.*

*It includes examples from CP3 alongside **new** fictitious cases, and real cases provided by the IPOs, extracted from the CP3 questionnaire (see [slide 2](#)). The inclusion of these real IPO cases, as requested by IPOs and UAs, enhances the training materials and demonstrates the successful, practical application of CP3 principles across the EUIPN.*

With respect to the word elements of the mark

[A1] Typeface and font. In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable.

CP3 example

Fresh Sardine

Class 29: Sardines

Non-distinctive

IPO example

Classic

Class 9: Glasses, sunglasses and accessories thereof

Non-distinctive

With respect to the word elements of the mark

[A1] Typeface and font. Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

CP3 example

The logo consists of the letters 'DIY' in a bold, black, sans-serif font. The 'D' is significantly larger and more prominent than the 'I' and 'Y', which are smaller and positioned to the right of the 'D'. The 'I' and 'Y' are also stylized with a slight curve at the top.

Class 20: Kits of parts for assembly into furniture

Distinctive

Fictitious example

The logo consists of the letters 'Fi' in a stylized, black, sans-serif font. The 'F' is significantly larger and more prominent than the 'i', which is smaller and positioned to the right of the 'F'. The 'F' has a unique, slightly curved top edge.

Class 41: Providing information in the field of education; providing information in the field of entertainment; providing information in the field of recreational activities.

Distinctive

With respect to the word elements of the mark

[A2] Combination with colour. The mere ‘addition’ of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, will not be sufficient to give the mark distinctive character.

CP3 example

Flavour and aroma

Class 30: Coffee

Non-distinctive

IPO example

AGROTOOLS

Class 7: Tools activated by electricity; tools mechanically activated; electric tools; hydraulic power tools; manual power tools; hydraulic tools; electrical hand tools; mechanical tools; pneumatic tools; machines agricultural tools.

Class 8: Agricultural, gardening and landscaping tools; manual tools and instruments (operated manually); manual tools activated manually; tools for fixing and connection.

Non-distinctive

With respect to the word elements of the mark

[A2] Combination with colour.

Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

With respect to the word elements of the mark

[A3] Combination with punctuation marks and other symbols. In general, the addition of punctuation marks or other symbols commonly used in trade does not add distinctive character to a sign consisting of descriptive/non-distinctive word elements.

CP3 example

FreshSardine. TM

Class 29: Sardines

Non-distinctive

Fictitious example

Bjo and Fresh!

Class 30: Coffee

Non-distinctive

With respect to the word elements of the mark

[A4] Position of the word elements. In general, the fact that the word elements are arranged in vertical, upside-down or in one, two or more lines is not sufficient to endow the sign with the minimum degree of distinctive character that is necessary for registration.

CP3 example



Fictitious example



With respect to the word elements of the mark

[A4] Position of the word elements. The way in which the word elements are positioned can add distinctive character to a sign when it is capable of affecting the consumer's perception of the meaning of said word elements. In other words, the arrangement must be of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message.

CP3 example

A n d
r
F l a v o u r
m
a

Class 30: Coffee

Distinctive

Fictitious example

B^{II} O^{AA} N^{DD}
B_{II} O_{AA} N_{DD}
F^{RR} E^{SS} C^{HH}
F_{RR} E_{SS} C_{HH}

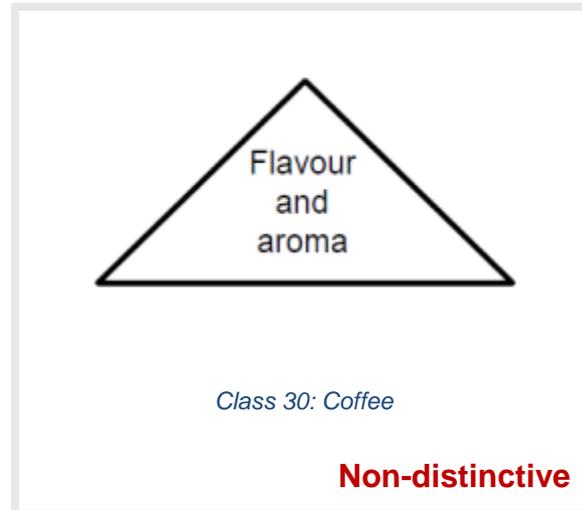
Class 30: Coffee

Distinctive

With respect to the figurative elements in the mark

[B1] Use of simple geometric shapes. Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, in particular when the above-mentioned shapes are used as a frame or border. This is because a geometric shape which merely serves to underline, highlight or surround the word element will not have sufficient impact on the mark as a whole to render it distinctive.

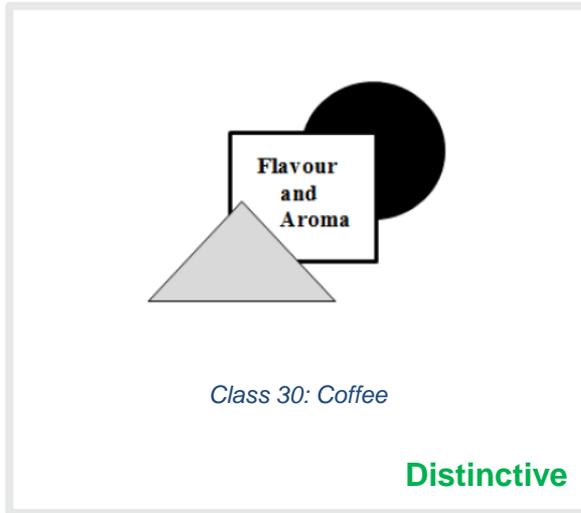
CP3 example



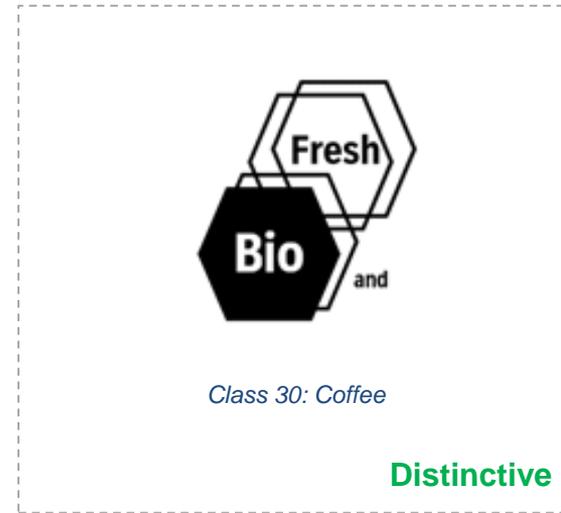
With respect to the figurative elements in the mark

[B1] Use of simple geometric shapes. On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive.

CP3 example



Fictitious example



With respect to the figurative elements in the mark

[B2] The position and proportion (size) of the figurative element in relation to the word element. In general, when a figurative element that is distinctive on its own is added to a descriptive and/or non-distinctive word element, then the mark is registrable, provided that said figurative element is, due to its size and position, clearly recognisable in the sign.

CP3 example

Fresh Sardine

Class 29: Sardines

Non-distinctive

Fictitious example

TM
BIO AND FRESH

Class 30: Coffee

Non-distinctive

With respect to the figurative elements in the mark

[B2] The position and proportion (size) of the figurative element in relation to the word element. In general, when a figurative element that is distinctive on its own is added to a descriptive and/or non-distinctive word element, then the mark is registrable, provided that said figurative element is, due to its size and position, clearly recognisable in the sign.

CP3 example



Class 30: Coffee

Distinctive

Fictitious example



Class 30: Coffee

Distinctive

With respect to the figurative elements in the mark

[B3] The figurative element is a representation of, or has a direct link with, the goods and/or services.

In some cases the figurative element consists of a representation of the goods and services claimed. In principle, said representation is considered to be descriptive and/or devoid of distinctive character whenever:

- It is a true-to-life portrayal of the goods and services.
- It consists of a symbolic/stylised portrayal of the goods and services that does not depart significantly from the common representation of said goods and services.

CP3 example



Class 29: Sardines

Non-distinctive

IPO example

BARISTA
COFFEE TRAINING POINT

*Class 30: Coffee, coffee-based beverages;
artificial coffee.*

Class 41: Education; providing of training

*Class 43: Café services; services for
providing food and drink.*

Non-distinctive

With respect to the figurative elements in the mark

[B3] The figurative element is a representation of, or has a direct link with, the goods and/or services.

In other cases, the figurative element may not represent the goods and services but may still have a direct link with the characteristics of the goods and/or services. In such cases the sign will be considered non-distinctive, unless it is sufficiently stylised.

CP3 example



Class 29: Sardines

Distinctive

Fictitious example



*Class 39: Transport of travellers;
booking of seats for travel; travel
reservation.*

Distinctive

With respect to the figurative elements in the mark

[B4] The figurative element is commonly used in trade in relation to the goods and/or services applied for. In general, figurative elements that are commonly used or customary in trade in relation to the goods and/or services claimed do not add distinctive character to the mark as a whole.

CP3 examples



Class 29: Sardines



Class 30: Coffee



Class 45: Legal services

Non-distinctive

Combinations of criteria

[C] In general, a combination of figurative elements and word elements which are – considered individually – devoid of distinctive character, does not give rise to a distinctive mark.

CP3 example



Flavour and aroma

Class 30: Coffee

Non-distinctive

IPO example*



Adult school
EDUCATION BY ADULT EDUCATION ASSOCIATION EUROPE

Class 41: Teaching

Non-distinctive

Principles involved: **[A1]** Typeface and font; **[B1]** Use of simple geometric shapes

* For the purposes of the questionnaire, the sign was translated into English. Original sign:

Combinations of criteria

[C] In general, a combination of figurative elements and word elements which are – considered individually – devoid of distinctive character, does not give rise to a distinctive mark.

CP3 example



IPO example



Principles involved: **[A2]** Combination with colour; **[B1]** Use of simple geometric shapes; **[A4]** Position of the word elements

Combinations of criteria

[C] In general, a combination of figurative elements and word elements which are – considered individually – devoid of distinctive character, does not give rise to a distinctive mark.

CP3 example



Flavour
and Aroma

Class 30: Coffee

Non-distinctive

IPO example



EXTRA

Class 29: Edible oils; pates; vegetable preparations (soups); canned fish; canned meat (preserves); seafood products; non-living molluscs; anchovy fillets; fruit preserves; edible nuts (processed); (...)

Class 32: Beer; fruit drinks and fruit juices; vegetable juices [beverages]; syrups and other preparations to make beverages.

Class 33: Wines; alcoholic beverages (except beers).

Non-distinctive

Principles involved: [A1] Typeface and font; [A2] Combination with colour

Combinations of criteria

[C] Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case where the combination results in an overall impression which is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.

CP3 example



IPO example



Principles involved: **[A1]** Typeface and font; **[A2]** Combination with colour

CP3 Case studies



Case studies



*The case studies in this section have been developed to **illustrate** how certain CP3 principles may be applied in practice. While it may be **possible to apply additional principles** to those indicated in each case study, those that have been used:*

- were chosen by the majority of the IPOs and UAs in the 2021 questionnaire; and*
- are considered as the most relevant to justify whether the mark is distinctive or non-distinctive.*

Similarly, the finding of distinctive/non-distinctive is also based on the outcome of the questionnaire (i.e. the requirement that a minimum of 80% of the IPOs found the mark to be distinctive/non-distinctive).

Case studies

Recommendations

1

Identify and assess all the individual criteria applicable based on the elements of the mark. This is important as **certain CP3 criteria** apply exclusively to either verbal or figurative elements.

2

In case several apply, the examiner can use **Section C: Combinations of criteria** to conclude the case, while still highlighting the most relevant individual criteria.

3

If CP3 criteria are used in a decision, **please cite them!**

Case studies: Typeface and font

CASE STUDY I

Trade mark application

Application

Classic

Goods/Services

Class 9: Glasses, sunglasses and accessories thereof

Case studies: Typeface and font



Step 1: Identify elements of the mark

Classic

- Sign comprised of a descriptive/non-distinctive word element (“Classic”) appearing in a black, handwritten style typeface
- No figurative elements identified

- Applicable CP3 criteria

Section A: With respect to the word elements of the mark



Should the assessment of the applicable criteria in Section A confirm that several individual criteria can be invoked at the same time, Section C: Combinations of criteria can also apply.

Case studies: Typeface and font



Step 2: Define (most relevant) applicable CP3 criteria

Classic

Section A With respect to the word elements of the mark

[A1] Typeface and font

In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable.

Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

Case studies: Typeface and font



Conclusion/Finding

Classic

- ✓ Sign comprised of a descriptive/non-distinctive word element, “Classic”
 - ✓ Appearing in black, basic/standard handwritten style typeface
 - ✓ Without any font effects
- According to Principle A1 of CP3, the **typeface** does not have sufficient impact on the sign as a whole to **distract the consumer’s attention** from the descriptive meaning of the word Classic. The sign is, therefore, non-distinctive.

Reflects Principle A1

Non-distinctive

Case studies: Typeface and font

CASE STUDY II

Trade mark application

Application



Goods/Services

Class 39: Chauffeur services

Case studies: Typeface and font



Step 1: Identify elements of the mark



DRIVER

- Descriptive/non-distinctive word element (“DRIVER”) appearing in a (blue) graphically designed typeface
- Some letters (in particular D, R and E) are harder to recognise
- A blue frame surrounds the word element
 - Applicable CP3 criteria
 - Section A: With respect to the word elements of the mark***
 - Section B: With respect to the figurative elements in the mark***
 - Section C: Combinations of criteria***

Case studies: Typeface and font



Step 2: Define (most relevant) applicable CP3 criteria



Other principles can be considered when assessing the distinctiveness of the sign, such as “*Use of simple geometric shapes*”. However, the principle “*Typeface and font*” is found to be the most relevant for the assessment of this case.

Section A With respect to the word elements of the mark

[A1] Typeface and font

In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable.

Where standard typefaces incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

Case studies: Typeface and font



Conclusion/Finding



DRIVER

- ✓ Sign is composed of a descriptive/non-distinctive word element, “DRIVER”
- ✓ **However**, the word element appears in a **graphically designed typeface where some letters are harder to recognise**
- In line with Principle A1 of CP3, when the typeface incorporates elements of graphic design as part of the lettering, and those elements are sufficient to distract the consumer’s attention from the descriptive meaning of the word or are likely to create a lasting impression on the consumer, the sign can be registrable. In this case, the sign is considered to be distinctive.

Distinctive

Reflects Principle A1

Case studies: Use of simple geometric shapes

CASE STUDY III

Trade mark application

Application



Goods/Services

Class 30: Coffee

Case studies: Use of simple geometric shapes



Step 1: Identify elements of the mark



- Descriptive/non-distinctive word elements (“Bio and Fresh”) appearing in a standard typeface
- Four hexagons (one in black, three in white with black outline): two are used as a frame for the word elements
 - Applicable CP3 criteria
 - Section A: With respect to the word elements of the mark***
 - Section B: With respect to the figurative elements in the mark***
 - Section C: Combinations of criteria***

Case studies: Use of simple geometric shapes



Step 2: Define (most relevant) applicable CP3 criteria



Other principles can be considered when assessing the distinctiveness of the sign such as “*Typeface and font*”. However, the principle “*Use of simple geometrical shapes*” is found to be the most relevant for the assessment of this case.



Section B With respect to the figurative elements of the mark

[B1] Use of simple geometric shapes

Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, in particular when the above mentioned shapes are used as a frame or border.

This is because a geometric shape which merely serves to underline, highlight or surround the word element will not have sufficient impact on the mark as a whole to render it distinctive.

On the other hand, geometric shapes can add distinctiveness to a sign when their presentation, configuration or combination with other elements creates a global impression which is sufficiently distinctive.

Case studies: Use of simple geometric shapes



Conclusion/Finding



- ✓ The sign is composed of descriptive/non-distinctive word elements, “Bio and Fresh”
 - ✓ It contains geometrical shapes, four hexagons (one in black, three in white with black outline), two of which are used as a frame for the word elements
 - ✓ **However**, the word and figurative elements are **presented in a particular arrangement**
- In this case, the **particular combination/arrangement** of the **geometric shapes** with the **word elements** creates a **global impression** which is sufficiently distinctive. Therefore, the sign is considered to be distinctive.

Distinctive

Reflects Principle B1

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services

CASE STUDY IV

Trade mark application

Application



Goods/Services

Class 39: Transport of travellers; booking of seats for travel; travel reservation.

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services



Step 1: Identify elements of the mark



- Descriptive/non-distinctive word elements (“Perfect Travel”) appearing in a handwritten style typeface
- Word elements presented within a figurative element (depiction of a mountain)
- Sign also includes depiction of hot air balloon, clouds, etc
- Applicable CP3 criteria
 - Section A: With respect to the word elements of the mark***
 - Section B: With respect to the figurative elements in the mark***
 - Section C: Combinations of criteria***

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services



Step 2: Define (most relevant) applicable CP3 criteria



Other principles could be considered relevant when assessing the distinctiveness of the sign, such as “*Typeface and font*”. However, the principle “*The figurative element is a representation of, or has a direct link with, the goods and/or services*” is found to be the most relevant for the assessment.

[B3] The figurative element is a representation of, or has a direct link with, the goods and/or services

Section B With respect to the figurative elements in the mark

In some cases, the figurative element consists of a representation of the goods and services claimed. In principle, said representation is considered to be descriptive and/or devoid of distinctive character (...)

In other cases, the figurative element may not represent the goods and services but may still have a direct link with the characteristics of the goods and/or services. In such cases the sign will be considered non-distinctive, **unless it is sufficiently stylised**.

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services



Conclusion/Finding



- ✓ Sign composed of non-distinctive word elements, “Perfect Travel”
- ✓ The figurative elements have a direct link with the characteristics of the services at hand; **however**, these elements are stylised
- In line with Principle B3 of CP3, when the figurative elements have a direct link with the characteristics of the services **but those elements are considered to be sufficiently stylised**, then the sign can be registered.

Distinctive

Reflects Principle B3

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services

CASE STUDY V

Trade mark application

Application



BARISTA
COFFEE TRAINING POINT

Goods/Services

Class 30: Coffee, coffee-based beverages;
artificial coffee.

Class 41: Education; providing of training

Class 43: Café services; services for
providing food and drink.

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services



Step 1: Identify elements of the mark



BARISTA
COFFEE TRAINING POINT

- Descriptive/non-distinctive word elements (“BARISTA COFFEE TRAINING POINT”) appearing in two lines and in different sizes
- Depiction of a coffee bean replacing the letter “o” in “coffee”
 - Applicable CP3 criteria
 - Section A: With respect to the word elements of the mark**
 - Section B: With respect to the figurative elements in the mark**
 - Section C: Combinations of criteria**

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services



Step 2: Define (most relevant) applicable CP3 criteria



BARISTA
COFFEE TRAINING POINT



Other principles can be considered when assessing the distinctiveness of the sign, such as “*Typeface and font*”. However, the principle “*The figurative element is a representation of, or has a direct link with, the goods and/or services*” is found to be the most relevant for the assessment.

Section B With respect to the figurative elements in the mark

[B3] The figurative element is a representation of, or has a direct link with, the goods and/or services

In some cases, **the figurative element consists of a representation of the goods and services claimed**. In principle, said representation is considered to be descriptive and/or devoid of distinctive character whenever:

- **It is a true-to-life portrayal of the goods and services**
- It consists of a symbolic/stylised portrayal of the goods and services (...).

Case studies: The figurative element is a representation of, or has a direct link with, the goods and/or services



Conclusion/Finding



BARISTA
COFFEE TRAINING POINT

- ✓ Sign composed of descriptive/non-distinctive word elements written in basic standard typeface
 - ✓ The figurative element is a representation of a coffee bean: it is a realistic portrayal of the goods and has a direct link with some of the relevant services
- In line with Principle **B3** of CP3, when the figurative element consists of a true-to-life **representation of the goods, or has a direct link with some of the relevant services**, that representation is considered to be devoid of distinctive character. Therefore, based on the findings above, the sign is considered to be non-distinctive.

Reflects Principle B3

Non-distinctive

Case studies: Combinations of criteria

CASE STUDY VI

Trade mark application

Applications

The image shows the word "EXTRA" in a bold, black, sans-serif font. The letters are set against a bright yellow rectangular background. The entire graphic is enclosed within a dashed black border.

The image shows the words "PRO ESCAPE" in a bold, black, sans-serif font. The letter "O" in "PRO" is replaced by a yellow gear icon. The letter "E" in "ESCAPE" is also yellow. The rest of the letters are black. The entire graphic is enclosed within a dashed black border.

Goods/Services

Class 32: Beer; fruit drinks and fruit juices; vegetable juices [beverages]; syrups and other preparations to make beverages.

Class 33: Wines; alcoholic beverages (except beers).

Class 41: Entertainment and escape room games services.

Case studies: Combinations of criteria

Step 1: Identify elements of the mark



EXTRA

- Graphically designed typeface (letter T)
- Addition of colour (yellow) as background
 - Applicable CP3 criteria
Section A: With respect to the word elements of the mark



**PRO
ESCAPE**

- Graphically designed typeface
- Particular colour arrangement (yellow/black)
 - Applicable CP3 criteria
Section A: With respect to the word elements of the mark



Should the assessment of the applicable criteria confirm that several individual criteria can be invoked at the same time, Section C: Combinations of criteria can also apply.

Case studies: Combinations of criteria



Step 2: Define (most relevant) applicable CP3 criteria



EXTRA



**PRO
ESCAPE**

Section A With respect to the word elements of the mark

[A1] Typeface and font

In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable.

[A2] Combination with colour

Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours, which is unusual and can be easily remembered by the relevant consumer, could render a mark distinctive.

Section C Combinations of criteria

Section [C] Combinations of criteria

A combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case where the combination results in an overall impression which is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.

Case studies: Combinations of criteria



Conclusion/ Finding



EXTRA

- ✓ Descriptive/non-distinctive word element with some elements of graphic design as part of letter “T” which does not have sufficient impact on the mark as a whole to render it distinctive
reflects Principle A1
- ✓ Addition of the colour yellow as a background
reflects Principle A2
- ✓ Combination of the above principles do not give the mark sufficient distinctive character
reflects Section C

Non-distinctive



**PRO
ESCAPE**

- ✓ Standard typeface incorporates elements of **graphic design as part of the lettering**
reflects Principle A1
- ✓ The **particular arrangement** of colours is **unusual** and can be **easily remembered** by the relevant consumer
reflects Principle A2
- ✓ Combination perceived as a **badge of origin** due to the **presentation** and composition of the sign
reflects Section C

Distinctive

Case studies: Combinations of criteria

CASE STUDY VII

Trade mark application

Application



Goods/Services

Class 35: Business management of hotels.

*Class 43: Accommodation bureau services;
hotel services.*

Case studies: Combinations of criteria



Step 1: Identify elements of the mark



- Sign composed of descriptive/non-distinctive word elements (“Apartment Residence”) appearing in basic standard typeface
- Word elements (brown/beige) placed within two rectangles that each contrast with the word’s colour
 - Applicable CP3 criteria
 - Section A: With respect to the word elements of the mark***
 - Section B. With respect to the figurative elements in the mark***
 - Section C: Combinations of criteria***

Case studies: Combinations of criteria



Step 2: Define (most relevant) applicable CP3 criteria



Apartment
Residence

Section A With respect to the word elements of the mark

[A1] Typeface and font

In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable.

Section B With respect to the figurative elements in the mark

[B1] Use of simple geometric shapes

Descriptive or non-distinctive verbal elements combined with simple geometric shapes such as points, lines, line segments, circles, triangles, squares, rectangles, parallelograms, pentagons, hexagons, trapezia and ellipses are unlikely to be acceptable, **in particular when the above mentioned shapes are used as a frame or border.**

Section C
Combinations of criteria

[C] Combinations of criteria

In general, a combination of figurative elements and word elements, which are – **considered individually** – **devoid of distinctive character**, does not give rise to a distinctive mark.

Case studies: Combinations of criteria



Conclusion/Finding



Apartment

Residence

- ✓ Sign composed of descriptive/non-distinctive word elements written in basic standard typeface: the typeface **does not have sufficient impact** to distract the attention of the consumer from their descriptive meaning.

Reflects Principle A1

- ✓ Two rectangles are used as a **frame** or **border**, in two different colours (brown and beige) that contrast with the colour of the respective text inside them. Their addition does not bring distinctiveness to the sign.

Reflects Principle B1

- The **combination** of word elements and figurative elements, individually **devoid of distinctive character**, does not give rise to a distinctive mark.

Reflects Section C

Non-distinctive



CP3 Case-law overview

Case-law related to CP3

General Court

Case T-152/20, 2 December 2020

Appeal dismissed
*Trade mark found **non-distinctive***
(aside from some goods in Class 9)

 **Home Connect**

Classes 9, 38

Explicit reference to CP3.

CP3 principle involved:

Principle [B3] Direct link with/representation of the G&S

(67) In the present case, (...), in paragraph 42 of the contested decision, the Board of Appeal rightly considered, without this being disputed by the applicant, that part of the figurative element consisted of a representation of a house, which constituted a **figurative representation of the meaning of the word element 'home'**.

(68) (...) With regard to the other part of the figurative element, consisting of a circular figure with a triangle or arrow extension at the bottom right, the Board of Appeal correctly noted that it would be perceived by the relevant public as a dialogue bubble referring to the idea of communication and could therefore be perceived as a **symbol of the word** 'connect'. The Court further considers, as did the Board of Appeal, that the fact that the house is included in the dialogue bubble figuratively conveys the message of communication with the house or within the house, which merely repeats, in substance, the clear meaning of the verbal elements 'home connect'.

(71) Fifth, the applicant's argument should be rejected, according to which the figurative element of the sign at issue would have a degree of originality "not only equal to, but greater than" that of the figurative elements of a few examples whose figurative elements have been considered capable of conferring distinctive or non-descriptive character on the mark, according to [CP3].

(72) Indeed [CP3] states that, in principle, the figurative element of a sign whose verbal elements are descriptive or non-distinctive is not capable of conferring distinctive or non-descriptive character on that sign where that figurative element constitutes a symbolic representation of the goods covered by the sign. In the present case, as explained in paragraphs 67 and 68 above, **the figurative element of the sign at issue constitutes a symbolic representation of the word sequence** 'home connect' and, consequently, of home automation systems. Therefore, there is no contradiction between the approach advocated in [CP3] on the one hand and the contested decision on the other.

Case-law related to CP3

General Court

Case T-686/18, 3 October 2019

Appeal dismissed
Trade mark found non-distinctive



LEGAL CAREERS

Classes 16, 35, 41 and 45

No explicit reference to CP3.

CP3 principles involved:

Principle [A1] Typeface and font

Principle [B1] Use of simple geometric shapes

Section [C] Combinations of criteria

(43) The figurative elements of the mark applied for, taking into account, in substance, **their shape and position, are not capable of diverting the relevant public from the descriptive message** conveyed by the verbal elements, so that the mark applied for is, as a whole, descriptive.

(44) Contrary to the plaintiff's argument, **the “compressed [and] sans serif” stylisation of the word elements is not particularly original**. The figurative element is also neither “eye-catching”, nor is it particularly “creative”, and it does not enable the relevant public to remember the mark applied for, or to effortlessly make the distinction required from the claimed goods and services for an operational indication of origin.

**original version in DE/FR*

Case-law related to CP3

General Court

Case T-663/18, 26 September 2019

*Action dismissed as manifestly lacking any foundation in law
Trade mark found non-distinctive for some goods (related to
noodles)*



Class 30

No explicit reference to CP3

CP3 principles involved:

Principle [A1] Typeface and font

Principle [A2] Combination with colour

Principle [B1] Use of simple geometric shapes

Section [C] Combinations of criteria

(45) It must be recalled that a graphic style, even if it has some specific feature, may be regarded as a distinctive figurative element only if it is capable of conveying an immediate and lasting impression which members of the relevant public may retain in a way that makes it possible for them to distinguish the goods of the proprietor of the figurative mark from those of the other providers on the market. That is not the case, inter alia, where the graphic style used is a **largely common one** in the eyes of the relevant public or where the figurative element is only there to **highlight the information conveyed** by the word elements (see, to that effect, judgment of 27 October 2016, Caffè Nero Group v EUIPO (CAFFÈ NERO), T-37/16, not published, EU:T:2016:634, paragraph 42 and the case-law cited).

(46) In the present case, as regards the element ‘soba’, the **stylisation** of that element is not capable of making an immediate and lasting impression on the relevant public to the point of giving it a distinctive character. On the contrary, the brushstroke-like line and the presence of the red dot are likely to be perceived by the relevant public as referring to the Japanese origin of the goods, thus reinforcing the information conveyed by the element ‘soba’. The same applies to the Asian characters, which, in addition, are **smaller** than those of the element ‘soba’ and written in a **grey colour that is less visible** against the black background of the sign. Finally, the **black rectangle** in which all the word and figurative elements of the contested mark are placed constitutes an **ordinary frame** which does not give the contested mark a distinctive character.

Case-law related to CP3

EUIPO BoA

Case R 695/2020-4, 13 October 2020

Decision partially annulled; rest of appeal dismissed

Trade mark found non-distinctive for some goods and services



Classes 9, 38, 41

(26) The figurative elements of the sign applied for are incapable of diverting the public's attention away from the descriptive message of the word elements. **The lettering of the letters and the grey colour lie within the scope of what is customary.** (...)

(27) This is also consistent with the declaration of the European trade mark offices in the context of Convergence Programme CP3 (...). **The use of colours, simple typefaces** and figurative elements which have a direct link with the goods and services in question is not sufficient to divert attention from the clearly descriptive nature of the word elements (page 3 et seq. of the Common Communication).

**original version in DE*

Explicit reference to CP3.

CP3 principles involved:

Principle [A1] Typeface and font

Principle [A2] Combination with colour

Section [C] Combinations of criteria

Case-law related to CP3

EUIPO BoA

Case R 1801/2017 G, 25 January 2019

*Appeal dismissed
Trade mark found non-distinctive*



Classes 9, 42

Explicit reference to CP3.

CP3 principles involved:

Principle [A1] Typeface and font

Principle [A2] Combination with colour

Principle [B1] Use of simple geometric shapes

Section [C] Combinations of criteria

(37) The **typeface** itself does not deviate substantially from any typeface usually found in text processing and in the media. (...) the straightforward perception of the typeface chosen will be just one of an ordinary font, representing the words in relatively bold letters. The **use of such normal and standard fonts does not render a descriptive wording distinctive.**

(38) Presenting the words in this font and size on an **orange background** is of no distinctive character in itself. (...). It is normal to use colours as a background for displaying text, and that is not a distinctive feature in any regard. Nor is it unusual to have that background in the form of a rectangle, which is nothing more than a **geometrically simple shape.**

(39) There is also no combination effect arising from the **presentation of the word elements in white letters before that orange background.** And when the background is coloured the word elements must be displayed in white or in black, depending on the colour contrast, in order to remain legible. The sign does not make use of a specific colour combination. The colour white in this scenario is not to be regarded as a colour per se that would yield a coloured effect to the sign. The overall combination is not more than the sum of its non-distinctive parts.

(72) Furthermore, this assessment is in line with the conclusions of (CP3)

**original version in EN*

Case-law related to CP3

DE National Court

Federal Patent Court decision [28 W \(pat\) 551/16](#), 4 October 2018

*Decision partially annulled; rest of appeal dismissed
Trade mark found non-distinctive for some goods
and services*



Classes 29, 35, 44

Explicit reference to CP3.

CP3 principle involved:

Principle [B4] Figurative elements commonly used in trade in relation to G&S

Contrary to the submission made by the applicant, the **tag** at issue, which has an eyelet, **is not capable of distinguishing the goods and services**. Tags are generally used as carriers of factual information (see (...) [CP3]).

(...) The representation of the tag contained in the sign applied for is perceived merely as an eye-catching presentation of the abovementioned words in the form of **factual indications**. The tag in question does not have characteristics, in terms of either form or colour scheme, which go beyond this typical visual function of a tag. In particular, the **chosen colour** in this instance is perceived as a rather reserved, pleasant presentation which is intended to **accentuate the factual indications contained on the tag**.

**original version in DE*

Case-law related to CP3

DE National Court

Federal Patent Court decision [28 W \(pat\) 60/13](#), 15 December 2015

*Appeal dismissed
Trade mark found non-distinctive*



Classes 29, 30, 32 and 33

Explicit reference to CP3.

CP3 principles involved:

Principle [A1] Typeface and font

Principle [B1] Use of simple geometric shapes

Section [C] Combinations of criteria

The graphic design chosen for the word element is not in itself so unusual that it could lead away from the descriptive meaning of the word sequence "delikat". It is a mere stylised representation of a simple label, as is often encountered by the public. However, simple graphic design elements or ornaments of the typeface, which the public has become accustomed to through frequent use in advertising, are regularly not sufficient to give the overall sign distinctive character in combination with a non-distinctive word element (BGH GRUR 2008, 710, *VISAGE*; BPatG 26 W (pat) 57/09, *Ambiente Trendlife*).

Contrary to the appellant's argument to the contrary, the "thickenings" of the border above and below the word element alone are not capable of giving it a special character. Rather, they are **simple graphic design elements without distinctive character**, which merely serve to emphasise the word element "delikat". The **label-like elliptical figurative element does not stand out from the advertising graphic standard in such a way that the public will perceive it as a distinctive element**. In particular, this does not follow from the chosen grey tones of both the word and the figurative element, as it is not a characteristic design deviating from the usual (see Ströbele/Hacker, *Markengesetz*, 11th edition, 2015, § 8 MarkenG, para. 195).

The legal opinion of the trade mark department and the senate is also supported by the convergence guidelines of the offices of the European Trade Mark and Design Network (Common Communication on the Common Practice on the distinction of trade marks and designs) Distinctiveness - word/figurative marks with descriptive/non-distinctive words of 2 October 2015). **This also states that the combination of descriptive or non-distinctive word elements with simple geometric shapes such as, inter alia, ellipses cannot confer distinctive character on a sign** (see p. 4 of the Guidelines).

Overall, the font in which the word element "delikat" is presented is a basic/standard typeface and does not include any elements of graphic design as part of the lettering which (...) would have sufficient impact on the mark as a whole to render it distinctive.

**original version in DE*



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Thank you