

New EUIPO Examination Guidelines on the Assessment of Acquired Distinctiveness

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Background

On 1st March 2021, an updated version of the EUIPO Guidelines for examination of EU Trade Marks entered into force. Changes can be seen in the 'track changes' version. This reveals extensive revision throughout. As these changes are, *inter alia*, intended to align the Office's procedures with recent decisions from the Court of Justice of the European Union ('CJEU'), many will come as no surprise to this Blog's readership of trade mark aficionados.

This post draws attention to three revisions to the Guidelines regarding the assessment of acquired distinctiveness contained in Chapter 14 of Section 4 in Part B (Examination). Article 7(3) EUTM, as we know, permits an otherwise non-distinctive, descriptive, or generic sign to be registered *if* the applicant can demonstrate that the sign has acquired distinctiveness through use. Potentially, the ostensibly modest revisions highlighted may, in practice, result in distinctiveness objections raised more frequently, and make acquired distinctiveness more difficult to establish.

1. Acquiring distinctiveness for marks which are descriptive in parts of

the EU

One common hurdle faced by EUTM applications arises from the many languages in use within the EU. A word or phrase may be distinctive in some Member States but inherently non-distinctive in others. Previous Guidelines indicated that where the mark applied for would be non-distinctive, descriptive, or generic only for some of the relevant public, the sign would only face a non-distinctiveness objection when that part of the public was 'significant'. The new Guidelines (§6.2 of Chapter 14) now state:

acquired distinctiveness through use must be shown, in principle, with respect to all those Member States/territories in which the EUTM applied for is objected to because: [...] it is in a language understood by a **non-negligible part of the relevant public** in at least part of the EU' (Emphasis added).

Arguably, a 'non-negligible part of the public' sets a lower threshold than the previous 'significant part of the public' (if the two thresholds are the same, then there would seem no need to change the wording). Potentially, this change could give rise to more oppositions being submitted under Article 7(1)(c) EUTMR, requiring more applicants to show acquired distinctiveness in order to gain registration

2. Acquired distinctiveness and 'simple' marks

It is well-established that acquired distinctiveness must be shown through use of the sign for which protection has been sought. However in practice, the EUIPO has also accepted evidence which demonstrates distinctiveness based upon use of an insignificant variation of the mark applied for.

The new Guidelines now limit when this practice will be permitted to instances where the mark applied for and the mark used are 'broadly equivalent'. In particular, they clarify that in the case of 'extremely simple marks, even minor alterations to that mark may constitute significant changes, so that the amended form may not be regarded as broadly equivalent to the mark as registered' (§8.5 of Chapter 14). This revision cites **Case T-307/17 (adidas)**. Here the trade mark at issue - adidas' 3-Stripe Mark - had inverted the contrast of the mark actually used, and this was held to be an impermissible variation. Following this change, EUIPO examiners may feel more empowered to reject evidence of use where, following their assessment, the mark used is not broadly equivalent to the sign depicted in

the application.

3. Clarification of the average consumer for collective and certification trade marks

The Guidelines state that the 'distinctive character of a sign, including that acquired through use, must be assessed in relation to the perception of the average consumer for the category of goods or services in question' where the identity of the relevant public 'must be arrived at by reference to the essential function of a trade mark' (§4 of Chapter 14). That is the same as before.

Citing the CJEU's Darjeeling judgments (Cases C-673/15 et al., para. 63), the Guidelines now identify that 'for collective marks, the essential function is to distinguish the goods and services of the members of the association that is the proprietor of the mark from those of other undertakings' (§4 of Chapter 14). By analogy, the updated Guidelines provide that the essential function of certification marks is their ability 'to distinguish goods or services which are certified by the proprietor of the mark from goods and services which are not so certified'. These additions arguably help to clarify who is the relevant public for the purposes of acquired distinctiveness for collective and certification trade marks.