

COMMON COMMUNICATION

**NEW TYPES OF MARKS:
EXAMINATION OF FORMAL
REQUIREMENTS AND GROUNDS
FOR REFUSAL**

APRIL 2021

1 BACKGROUND

The Intellectual Property Offices of the European Union Intellectual Property Network continue to collaborate in the context of converging trade mark and design practices. They have now agreed on an additional Common Practice on trade marks with the aim of providing guidance with regard to the examination of formal requirements and grounds for refusal and/or invalidity of new types of trade mark, namely, sound, motion, multimedia and hologram marks, and the new ways of representing them.

This Common Practice is made public through this Common Communication with the purpose of further increasing transparency, legal certainty and predictability for the benefit of examiners and users alike.

The scope of this Common Practice is the examination of the formal requirements and grounds for refusal and/or invalidity of new types of trade mark, by taking into account the impact of the elimination of the graphic representation requirement in Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (TMD).

Issues that are not specific to new types of trade mark and/or the new way of representing them, are **out of the scope** of this Common Practice. These out-of-scope issues are detailed in Section 1.3 of the Common Practice document.

2 THE COMMON PRACTICE

The following text summarises the key messages and the main statements of the principles of this Common Practice. **The complete text and all the examples used to illustrate the common criteria can be found in the Common Practice in Annex 1 to this Common Communication.** Additionally, the definitions, the means of representation for the different types of trade mark and the acceptable electronic file formats, as agreed by all the MS IPOs, can be found in the ‘*Common Communication on the representation of new types of trade marks*’⁽¹⁾, (hereinafter, CCNTM).

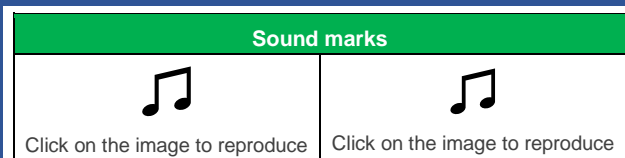
PRINCIPLES OF THE COMMON PRACTICE:

PART A – Examination of formal requirements⁽²⁾

THE SIGN AND ITS ELEMENTS AS DEFINED BY THE COMMON COMMUNICATION ON THE REPRESENTATION OF NEW TYPES OF TRADE MARKS






















When a sign clearly complies with one of the definitions and the representation requirements established in the CCNTM, it should be classified as that specific type of trade mark.

Sound marks: Any sign containing one or more sounds, regardless of the kind of sound contained therein (e.g. verbal elements perceived in the sound, a sound in nature, sound of animals, a melody, etc.) should be classified as a sound mark.



⁽¹⁾ https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euiipo/who_we_are/common_communication/common_communication_8/common_communication8_en.pdf

⁽²⁾ The examples provided in Part A of the Common Practice are shown for formalities purposes only. They do not necessarily fulfil the requirements for absolute grounds.

<p>When the sound mark is represented in musical notation, this representation must include a staff divided into measures (bars) and showing, in particular, a clef and all the musical notes that are necessary to reproduce the melody. The tempo or speed of the melody and the instrument(s) are optional elements to be indicated.</p>	<table border="1"> <tr> <td data-bbox="805 329 1117 436">  Click on the image to reproduce </td> <td data-bbox="1125 329 1415 436">  Click on the image to reproduce </td> </tr> </table>	 Click on the image to reproduce	 Click on the image to reproduce				
 Click on the image to reproduce	 Click on the image to reproduce						
<p>Motion marks: Motion marks are not restricted to signs depicting movement. A sign may also be qualified as a motion mark if is capable of showing a change in the position of the elements (for instance, a sequence of stills), a change of colour or a change of elements understood as the replacement of one image by another.</p> <p>When the motion mark is represented by a series of sequential still images showing the movement or change of position, the duration, repetitions and the speed of the motion/movement may be required to be indicated in the description.</p>	<table border="1"> <thead> <tr> <th colspan="2" data-bbox="805 577 1415 616">Motion marks</th> </tr> </thead> <tbody> <tr> <td data-bbox="805 622 1117 761"> <p>GERIVAN</p> <p>Click on the image to reproduce</p> </td> <td data-bbox="1125 622 1415 761">  Click on the image to reproduce </td> </tr> <tr> <td data-bbox="805 768 1117 907">  Click on the image to reproduce </td> <td data-bbox="1125 768 1415 907">  Click on the image to reproduce </td> </tr> </tbody> </table>	Motion marks		<p>GERIVAN</p> <p>Click on the image to reproduce</p>	 Click on the image to reproduce	 Click on the image to reproduce	 Click on the image to reproduce
Motion marks							
<p>GERIVAN</p> <p>Click on the image to reproduce</p>	 Click on the image to reproduce						
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<p>Multimedia marks: Any sign consisting of a combination of visual and audio elements should be classified as a multimedia mark.</p>	<table border="1"> <thead> <tr> <th data-bbox="805 1014 1415 1052">Multimedia mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="805 1059 1415 1153">  Click on the image to reproduce </td> </tr> </tbody> </table>	Multimedia mark	 Click on the image to reproduce				
Multimedia mark							
 Click on the image to reproduce							
<p>Hologram marks: Any sign consisting of elements with holographic characteristics should be classified as a hologram mark. In this regard, a hologram is an image that changes its appearance when looked at from different angles.</p>	<table border="1"> <thead> <tr> <th data-bbox="805 1193 1415 1232">Hologram mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="805 1238 1415 1355">  Click on the image to reproduce </td> </tr> </tbody> </table>	Hologram mark	 Click on the image to reproduce				
Hologram mark							
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DESCRIPTIONS

Where the representation of a new type of trade mark is accompanied by a description, the description has to be in accordance with the representation of the trade mark and must not contradict the representation or extend its scope.

INDICATION OF VERBAL ELEMENTS

Any existing field requiring the indication of verbal elements in the trade mark will serve only for search purposes and will never extend the scope of protection of the trade mark as defined by its representation.

PREVALENCE OF THE REPRESENTATION OVER THE TYPE AND DESCRIPTION

When there is a conflict or discrepancy between the representation and the type and/or description of the trade mark, the representation of the trade mark will always prevail.

VALID MEANS OF REPRESENTING MORE THAN ONE TYPE OF TRADE MARK



Trade mark applications will be accepted according to the type of trade mark selected by the applicant, provided that the representation complies with the legal requirements for the specific type. The scope of protection and the subject matter of the trade mark will vary according to the type of mark accepted.

EXAMINATION OF PRIORITY CLAIMS

A sign will be considered identical to a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.



IDENTICAL SUBJECT MATTER

Two trade marks will be considered as identical for the purpose of examination of priority claims if the subject matter of protection and the trade mark are the same, regardless of the format. Additionally, priority may be accepted when the second filing is of a different type of trade mark but has identical subject matter.

First filing	Second filing
 Click on the image to reproduce	 Click on the image to reproduce
Other mark	Multimedia mark

DIFFERENT SUBJECT MATTER



When a priority claim involves two trade marks with different subject matter, regardless of their format or the type of trade mark selected, the trade marks will be considered different and consequently, the priority claim will be rejected.

First filing	Second filing
 Click on the image to reproduce	 Click on the image to reproduce
Multimedia mark	Sound mark



SAME TYPE OF TRADE MARKS REPRESENTED DIFFERENTLY

SOUND MARKS

Priority claims in which one of the filings is represented in musical notation (e.g. JPEG) and the other is represented in an audio file (e.g. MP3), will only be accepted if all the elements⁽³⁾ contained in the audio file are indicated in the musical notation.

First filing	Second filing
 Click on the image to reproduce	 Click on the image to reproduce
Sound mark	Sound mark

If any of those elements is missing, the trade marks are not identical and the priority claim will be rejected.



First filing	Second filing
 Click on the image to reproduce	 Click on the image to reproduce
Sound mark	Sound mark

⁽³⁾ See Common Practice – Part A – Section 1.1 – Sound marks – Elements for a graphically represented sound mark to be clear and precise.

MOTION MARKS

Priority claims in which one of the filings is represented in a sequence of still images (e.g. jpeg) and the other in a video file (e.g. MP4) will only be accepted if all the elements of the video file and their complete movement are clearly identifiable in the sequence of still images.

If the second filing is represented in a sequence of still images, a description can be required to ensure that the subject matter is identical (e.g. duration, speed, repetitions).

First filing	Second filing
 Click on the image to reproduce	
Motion mark	Motion mark



Description: this motion consists of the content of the still images appearing at intervals of half a second.

If any of those elements is missing and the complete movement cannot be clearly identified, the marks are non-identical and the priority claim will be rejected.


First filing	Second filing
 Click on the image to reproduce	
Motion mark	Motion mark

HOLOGRAM MARKS

Priority claims in which one of the filings is a hologram represented in a series of graphic or photographic images (image files, e.g. JPEG), and the other is represented in a video file (e.g. MP4), will only be accepted if all the elements of the video file and the different stages of the holographic effect are clearly identified in the series of graphic or photographic images.

First filing	Second filing
 Click on the image to reproduce	
Hologram mark	Hologram mark

If any of those elements and the different stages of the holographic effect cannot be clearly identified, the marks are non-identical and the priority claim will be rejected.

First filing	Second filing
 Click on the image to reproduce	
Hologram mark	Hologram mark

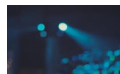
PART B – Examination of absolute grounds for refusal and/or invalidity

THE ASSESSMENT OF CLARITY AND PRECISION OF NEW TYPES OF TRADE MARK – ARTICLE 4(1)(a) TMD

The mark will be considered clear and precise as long as it is represented in any appropriate form using generally available technologies, provided that the sign is also capable of being represented in a self-contained, easily accessible, intelligible, durable and objective manner, irrespective of whether it has a concept. This approach is aligned with the principle according to which there is no need for a word or a figurative mark to have a meaning or to contain identifiable images as long as it is capable of fulfilling the function of a trade mark, and thus to serve as an indication of origin ⁽⁴⁾.



Click on the image to reproduce



Click on the image to reproduce



Click on the image to reproduce

THE REQUIRED DEGREE OF DISTINCTIVENESS OF NEW TYPES OF TRADE MARK – ARTICLE 4(1)(b) TMD

SOUND MARKS

CONSUMER PERCEPTION

As sounds are increasingly being used in trade as part of a branding strategy, consumers are also more likely to perceive them as indications of commercial origin. For the sake of analysis of consumer perception, sound marks can be grouped in at least the following ways: 1) sounds produced by or connected to the goods or services; 2) notes, combination of notes, tunes or melodies; 3) sounds which are the audible equivalent of verbal elements. There are also sounds which are not included in the previous groups and have no connection to the goods and/or services.

INHERENTLY DISTINCTIVE SOUND MARKS

When the sound perceived in a sound mark consists of **one note, a combination of notes or a melody**, it will be considered inherently distinctive if it is capable of being perceived by the relevant public as an indication of commercial origin.

Sound mark



Click on the image to reproduce

Goods and services

Class 41: Providing films for entertainment purposes

When the sound perceived in a sound mark consists of a **verbal element**, which is considered distinctive in itself, and if pronounced in a clear manner, even if pronounced in a neutral or a robotic voice, the sound mark will be considered distinctive.

Sound mark



Click on the image to reproduce

Goods and services

Class 12: Cars

If the **element of speech perceived in a sound mark cannot be understood or is not identifiable as a word**, it will be considered distinctive, as long as the sound is capable of being recognised as an indication of commercial origin by the consumer.

Sound mark





















Click on the image to reproduce

Goods and services

Class 12: Cars

⁽⁴⁾ These examples are seen as being clear and precise; that does not mean that they will not be objected to under other grounds for refusal.

<p>When the sound perceived in a sound mark contains a sound disassociated from the goods and/or services applied for, it will, in principle, be considered distinctive as long as it is capable of being recognised by the consumer as an indication of commercial origin.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 324 1173 369">Sound mark</th> <th data-bbox="1177 324 1415 369">Goods and services</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 376 1173 470">  Click on the image to reproduce </td> <td data-bbox="1177 376 1415 470">Class 11: Toilets</td> </tr> </tbody> </table>	Sound mark	Goods and services	 Click on the image to reproduce	Class 11: Toilets		
Sound mark	Goods and services						
 Click on the image to reproduce	Class 11: Toilets						
<p>NON-DISTINCTIVE SOUND MARKS</p>							
<p>In principle, when the sound mark consists of a sound produced by or connected to the goods and/or services, or to other relevant features thereof, it will be perceived by the consumer merely as a functional attribute, and therefore the sound mark will be considered non-distinctive.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 629 1173 674">Sound mark</th> <th data-bbox="1177 629 1415 674">Goods and services</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 680 1173 775">  Click on the image to reproduce </td> <td data-bbox="1177 680 1415 775">Class 33: Wine</td> </tr> </tbody> </table>	Sound mark	Goods and services	 Click on the image to reproduce	Class 33: Wine		
Sound mark	Goods and services						
 Click on the image to reproduce	Class 33: Wine						
<p>When the sound mark consists of notes, a combination of notes, tunes or melodies, it will be considered non-distinctive if the sound lacks resonance and would not be recognised as an indication of commercial origin by the consumer, even if no link can be established with the goods and/or services.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 875 1173 920">Sound mark</th> <th data-bbox="1177 875 1415 920">Goods and services</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 927 1173 1021">  Click on the image to reproduce </td> <td data-bbox="1177 927 1415 1021">Class 12: Cars</td> </tr> </tbody> </table>	Sound mark	Goods and services	 Click on the image to reproduce	Class 12: Cars		
Sound mark	Goods and services						
 Click on the image to reproduce	Class 12: Cars						
<p>When a sound mark consists of non-distinctive/descriptive/generic verbal elements pronounced in a clear manner and without any striking or unusual sound elements, the sound mark will be considered non-distinctive.</p> <p>In principle, when the non-distinctive/descriptive/generic verbal element perceived in a sound mark is accompanied by other elements of sound, such as lyrics, a specific melody, intonation and/or a specific way of singing, which are also considered non-distinctive in themselves, the sound mark will most likely be considered non-distinctive as a whole as well.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 1144 1173 1189">Sound mark</th> <th data-bbox="1177 1144 1415 1189">Goods and services</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 1196 1173 1290">  Click on the image to reproduce </td> <td data-bbox="1177 1196 1415 1290">Class 3: Washing powder</td> </tr> <tr> <td data-bbox="810 1397 1173 1536">  Click on the image to reproduce </td> <td data-bbox="1177 1397 1415 1536">Class 3: Washing powder</td> </tr> </tbody> </table>	Sound mark	Goods and services	 Click on the image to reproduce	Class 3: Washing powder	 Click on the image to reproduce	Class 3: Washing powder
Sound mark	Goods and services						
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<p>Exception: It cannot be excluded that a particular arrangement of different elements of sounds, which is unusual and can be easily recognised as an indication of commercial origin by the consumer, could be sufficient to render a sound mark distinctive as a whole ⁽⁵⁾.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 1682 1173 1727">Sound mark</th> <th data-bbox="1177 1682 1415 1727">Goods and services</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 1733 1173 1827">  Click on the image to reproduce </td> <td data-bbox="1177 1733 1415 1827">Class 31: Fresh bananas</td> </tr> </tbody> </table>	Sound mark	Goods and services	 Click on the image to reproduce	Class 31: Fresh bananas		
Sound mark	Goods and services						
 Click on the image to reproduce	Class 31: Fresh bananas						

⁽⁵⁾ It should be noted that the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal elements; the scope of protection will be limited to the overall impression of the sound mark.


MOTION MARKS

CONSUMER PERCEPTION


With regard to motion marks, there is an increase in the number of signs containing motions and moving images used as part of branding strategies, therefore consumers are also more likely to perceive them as indications of commercial origin. For the sake of analysis of consumer perception, motion marks can be grouped in at least the following ways: 1) motions that may be perceived as an intrinsically functional element of the goods or services themselves, or are used to control those goods; 2) motions that contain verbal elements and/or figurative elements.

INHERENTLY DISTINCTIVE MOTION MARKS

Motion marks will generally be considered distinctive if they contain a **distinctive verbal and/or figurative element** moving or changing its position, colour and/or elements, even though the movement or change of position itself may not be distinctive.

Motion mark	Goods and services
 Click on the image to reproduce	Class 9: Computers

When the motion mark shows an **element which cannot be understood or is non-identifiable**, in that it does not attribute a meaning or create a link to the goods and/or services, as long as it is capable of being recognised as an indication of commercial origin by the consumer, it will be considered distinctive.

Motion mark	Goods and services
 Click on the image to reproduce	Class 3: Washing powder

NON-DISTINCTIVE MOTION MARKS ⁽⁶⁾


In principle, when the motion mark consists of a **movement produced by or connected to the goods and/or services, or to other relevant features thereof**, it will be perceived by the consumer merely as a functional element of, or for, the goods and/or services. Therefore, the motion mark will be considered non-distinctive.

Motion mark	Goods and services
 Click on the image to reproduce	Class 7: Chainsaws

When the motion mark consists of a **non-distinctive/descriptive/generic verbal and/or figurative element** moving or changing its position, colour and/or elements, it will be considered non-distinctive unless the movement itself is sufficient to distract the attention from the message conveyed by the non-distinctive/descriptive verbal or figurative element.


Motion mark	Goods and services
ORGANIC Click on the image to reproduce	Class 3: Washing powder

Exception: It cannot be excluded that a particular movement, which in itself is unusual and striking or creates an unusual and striking visual impact, could be sufficient to render a motion mark distinctive in its overall impression ⁽⁷⁾.

Motion mark	Goods and services
 Click on the image to reproduce	Class 3: Washing powder

⁽⁶⁾ The CP3 Common Principles should be taken into account, bearing in mind that those principles will not be applicable either to the movement or to the change of position, colour and/or elements.

⁽⁷⁾ In such cases, the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal elements; the scope of protection will be limited to the overall impression of the motion mark.



<p>The consumer would not perceive motion marks as indicators of commercial origin if they do not create a lasting impression on the consumer. Therefore, these would be considered as non-distinctive.</p>	Motion mark	Goods and services
	 Click on the image to reproduce	Class 39: Travel services

MULTIMEDIA MARKS




CONSUMER PERCEPTION

With regard to multimedia marks, there is an increase in the number of signs combining image and sound used as part of branding strategies, therefore consumers are more likely to perceive them as indications of commercial origin.

INHERENTLY DISTINCTIVE MULTIMEDIA MARKS

<p>In general, when at least one of the elements of a multimedia mark, either the sound or the image, is considered distinctive in itself, the trade mark as a whole will be considered distinctive.</p>	Multimedia mark	Goods and services
	 Click on the image to reproduce	Class 31: Foodstuffs for animals
<p>When the multimedia mark contains an element which cannot be understood or is non-identifiable, in that it does not convey a meaning, as long as it can be recognised by the consumer, it will be considered distinctive.</p>	Multimedia mark	Goods and services
	 Click on the image to reproduce	Class 12: Cars

NON-DISTINCTIVE MULTIMEDIA MARKS ⁽⁸⁾

<p>A multimedia mark combining non-distinctive/descriptive/generic image(s) with non-distinctive sound(s) and motion(s), will, in general, be considered non-distinctive.</p>	Multimedia mark	Goods and services
	 Click on the image to reproduce	Class 31: Fresh bananas
<p>The consumer would not perceive multimedia marks as indicators of commercial origin if they do not create a lasting impression on the consumer. Therefore, these would be considered as non-distinctive.</p>	Multimedia mark	Goods and services
	 Click on the image to reproduce	Class 9: Computer hardware
<p>Exception: It could be possible that a combination of a non-distinctive/descriptive/generic image(s) and sound(s) would allow the multimedia mark to fulfil its essential function when applied for certain goods and services, and thus render the multimedia mark distinctive as a whole ⁽⁹⁾.</p>	Multimedia mark	Goods and services
	 Click on the image to reproduce	Class 31: Foodstuffs for animals

⁽⁸⁾ When assessing the distinctiveness of multimedia marks, the CP3 Common Principles should be taken into account.

⁽⁹⁾ In such cases, the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal elements; the scope of protection of the mark will be limited to the overall impression of the multimedia mark.


HOLOGRAM MARKS

CONSUMER PERCEPTION

Hologram marks that consist exclusively of verbal and figurative elements will generally not be perceived as indications of commercial origin if a link can be established between the mark and the goods and services. Moreover, the assessment will depend on the holographic effect and on whether the verbal or figurative element is, due to its size and position, clearly recognisable in the sign.

INHERENTLY DISTINCTIVE HOLOGRAM MARKS

When the hologram mark consists of a **verbal and/or a figurative element which is distinctive in itself**, even if the holographic characteristics added to those elements are non-distinctive, the hologram mark will be considered distinctive as a whole.

Hologram mark	Goods and services
 <p>Click on the image to reproduce</p>	Class 12: Cars

When the hologram mark shows **an element which cannot be understood or is non-identifiable**, in that it does not convey a meaning, or create a connection to the goods and/or services, as long as it is capable of being recognised as an indication of commercial origin by the consumer, it will be considered distinctive.

NON-DISTINCTIVE HOLOGRAM MARKS⁽¹⁰⁾


When the hologram mark consists of a **non-distinctive/descriptive/generic verbal and/or figurative element**, it will be considered non-distinctive.

In general, **the addition of a holographic effect to a non-distinctive verbal and/or figurative element will not necessarily be sufficient to give the mark distinctive character**, since it will be perceived by the consumer merely as a banal or decorative element, regardless of whether it relates to the goods and/or services applied for.

NEW TYPES OF TRADE MARK WHICH MAY SERVE TO DESCRIBE THE GOODS OR SERVICES, OR THEIR CHARACTERISTICS – ARTICLE 4(1)(c) TMD

DESCRIPTIVE

In general, **if a link** between the elements in the sound, motion, multimedia or hologram mark and the goods and/or services or their characteristics can be easily established, the mark will be considered descriptive.

Sound mark	Goods and services
 <p>Click on the image to reproduce</p>	Class 31: Foodstuffs and fodder for animals

NOT DESCRIPTIVE



In general, **if no link** can be established between the elements in the sound, motion, multimedia or hologram mark and the goods and/or services applied for, **or if the mark shows an unconventional depiction that differs significantly from a true-to-life portrayal** of the representation of those goods and/or services, the mark will not be considered descriptive.

Motion mark	Goods and services
 <p>Click on the image to reproduce</p>	Class 29: Tinned sardines

⁽¹⁰⁾ The Common Principles of CP3 should be taken into account when assessing the distinctiveness of the figurative and/or verbal elements of a hologram mark.

**SIGNS THAT CONSIST EXCLUSIVELY OF SOUND, MOVEMENT AND A COMBINATION OF IMAGE AND SOUND, WHICH RESULTS FROM THE NATURE OF THE GOODS, CAN BE NECESSARY TO OBTAIN A TECHNICAL RESULT, OR CAN GIVE SUBSTANTIAL VALUE TO THE GOODS –
ARTICLE 4(1)(e) TMD**

When assessing Article 4(1)(e)(i), (ii) and (iii) TMD, the public's perception is not a decisive element to be considered, however, it may be a useful criterion of assessment, especially when identifying, under Article 4(1)(e)(ii) and (iii), the essential characteristics of the sign in question.

Sound mark	Goods and services	Motion mark	Goods and services
 Click on the image to reproduce	Class 7: Chainsaws	 Click on the image to reproduce	Class 28: Three-dimensional puzzles

PART C – Examination of relative grounds for refusal and/or invalidity⁽¹¹⁾

IDENTITY

A sign will be considered identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.

COMPARISON OF SOUND MARKS: VISUAL, AURAL AND CONCEPTUAL COMPARISON

Sound marks encompass different elements that can be classified as follows: 1) sounds consisting of sung or spoken verbal elements; 2) sounds consisting of musical elements (such as melody, harmony, rhythm); 3) true-to-life sounds (such as the sound of a dog barking, thunder, ice cubes, etc); and 4) other sounds that are not covered by any of the previous categories.



VISUAL COMPARISON

Visual comparison of a sound mark is not possible, even if the sound mark is represented 'visually' by means of musical notation or when the musical notation contains verbal elements.































AURAL COMPARISON

Aural comparison is decisive for sound marks. Sound marks can always be aurally compared to other sound marks and to multimedia marks. Sound marks can be aurally compared to other types of marks provided that those marks consist of or contain a verbal element.

Verbal elements: The coincidence in, or similarity between, distinctive verbal elements, if identified as such by a significant part of the relevant public, will, in principle, lead to a finding of aural similarity. In this regard, while the pronunciation of a word mark is determined by the rules of pronunciation of the relevant public, this is not so in the case of a sound mark, where the aural perception is determined by how the mark sounds.

Earlier sound mark	Contested sound mark
 Click on the image to reproduce	 Click on the image to reproduce

⁽¹¹⁾ Unless specified otherwise, the examples included in Part C of the Common Practice should be assessed in line with the assumptions included as 'Preliminary remarks'.

<p>With this in mind, the degree of similarity between the coinciding verbal element in a sound mark and a different type of mark (e.g. word or figurative mark) will depend on how exactly the common element sounds in the sound mark.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 329 1114 371">Earlier figurative mark</th> <th data-bbox="1121 329 1428 371">Contested sound mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 371 1114 477">  </td> <td data-bbox="1121 371 1428 477">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier figurative mark	Contested sound mark		 Click on the image to reproduce
Earlier figurative mark	Contested sound mark				
	 Click on the image to reproduce				
<p>Musical elements: The presence of a distinctive melody in a sound mark has a considerable impact on the way the mark is perceived by the relevant public and, therefore, considerably influences the aural comparison of such a mark. As a general rule, a different instrument, tempo or rhythm will not prevent two marks from being found similar, provided that the melody itself is identical or can be identified as being the same melody.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 544 1114 586">Earlier sound mark</th> <th data-bbox="1121 544 1428 586">Contested sound mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 586 1114 692">  Click on the image to reproduce </td> <td data-bbox="1121 586 1428 692">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier sound mark	Contested sound mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier sound mark	Contested sound mark				
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<p>The coincidence or similarity in a distinctive melody usually has a considerable impact on the result of the aural comparison of the trade marks, even if one of the marks also contains a verbal element or both of them contain a different verbal element.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 891 1114 934">Earlier sound mark</th> <th data-bbox="1121 891 1428 934">Contested sound mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 934 1114 1039">  Click on the image to reproduce </td> <td data-bbox="1121 934 1428 1039">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier sound mark	Contested sound mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier sound mark	Contested sound mark				
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<p>True-to-life: Coincidence in, or similarity of, distinctive true-to-life sounds in sound or multimedia marks, generally leads to a finding of aural similarity.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 1104 1114 1146">Earlier sound mark</th> <th data-bbox="1121 1104 1428 1146">Contested sound mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 1146 1114 1252">  Click on the image to reproduce </td> <td data-bbox="1121 1146 1428 1252">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier sound mark	Contested sound mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier sound mark	Contested sound mark				
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<p>Other aspects: The mere coincidence in other aspects, such as the intonation, voice, etc. in two trade marks usually has a lower impact on the aural comparison of the trade marks.</p>	<table border="1"> <thead> <tr> <th data-bbox="810 1283 1114 1326">Earlier sound mark</th> <th data-bbox="1121 1283 1428 1326">Contested sound mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="810 1326 1114 1431">  Click on the image to reproduce </td> <td data-bbox="1121 1326 1428 1431">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier sound mark	Contested sound mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier sound mark	Contested sound mark				
 Click on the image to reproduce	 Click on the image to reproduce				

CONCEPTUAL COMPARISON


































A conceptual comparison between two sound marks and between sound marks and other types of mark can be made in cases where a concept (either in the verbal element or in the true-to-life sound) can be identified. Sound marks merely containing melodies are unlikely to have a concept.



COMPARISON OF MOTION MARKS: VISUAL, AURAL AND CONCEPTUAL COMPARISON

A motion mark encompasses combinations of different elements that can be classified as follows: 1) verbal elements; 2) figurative elements; and 3) the movement or transformation of the verbal and/or figurative elements.

VISUAL COMPARISON



When visually comparing two motion marks or a motion mark with another type of mark, the coincidence in, or similarity between, the elements present in the trade marks (the verbal and/or figurative elements, and the movement or transformation of those elements) has to be considered.

<p>Verbal elements: Motion marks containing distinctive verbal element(s) are likely to be visually similar to another motion mark which contains the same or a similar distinctive verbal element(s).</p> <p>Distinctive verbal element(s) contained in a motion mark can have a stronger impact on the consumer than other visual elements (i.e. figurative elements, movement or other change itself), although, the comparison has to consider the entirety of the signs.</p>	<table border="1"> <thead> <tr> <th data-bbox="807 329 1117 371">Earlier motion mark</th> <th data-bbox="1123 329 1433 371">Contested motion mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="807 371 1117 495">  Click on the image to reproduce </td> <td data-bbox="1123 371 1433 495">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier motion mark	Contested motion mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier motion mark	Contested motion mark				
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<p>Figurative elements: A coincidence or similarity in a distinctive figurative element can lead to a finding of a degree of visual similarity. This similarity is likely to be found, in particular, when on account of its size, position within the mark and/or colour, the figurative element can be perceived by the consumer to a sufficient extent, considering, in particular, that it is subject to movement/transformation.</p>	<table border="1"> <thead> <tr> <th data-bbox="807 676 1117 719">Earlier motion mark</th> <th data-bbox="1123 676 1433 719">Contested motion mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="807 719 1117 842">  Click on the image to reproduce </td> <td data-bbox="1123 719 1433 842">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier motion mark	Contested motion mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier motion mark	Contested motion mark				
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<p>Movement of elements: The mere coincidence in a banal motion/movement in itself will not lead to visual similarity.</p>	<table border="1"> <thead> <tr> <th data-bbox="807 945 1117 987">Earlier motion mark</th> <th data-bbox="1123 945 1433 987">Contested motion mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="807 987 1117 1088">  Click on the image to reproduce </td> <td data-bbox="1123 987 1433 1088">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier motion mark	Contested motion mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier motion mark	Contested motion mark				
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<p>However, it cannot be excluded that a particular movement which is striking and distinctive could be sufficient to render motion marks visually similar to some extent, despite them having other differing elements, such as verbal elements.</p>	<table border="1"> <thead> <tr> <th data-bbox="807 1124 1117 1167">Earlier motion mark</th> <th data-bbox="1123 1124 1433 1167">Contested motion mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="807 1167 1117 1290">  Click on the image to reproduce </td> <td data-bbox="1123 1167 1433 1290">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier motion mark	Contested motion mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier motion mark	Contested motion mark				
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<p>Transformation of elements: The mere coincidence in the change of position or change of colours in itself will usually have a lower impact on the comparison of trade marks, and will not, in principle, lead to a finding of visual similarity.</p>	<table border="1"> <thead> <tr> <th data-bbox="807 1348 1117 1391">Earlier motion mark</th> <th data-bbox="1123 1348 1433 1391">Contested motion mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="807 1391 1117 1514">  Click on the image to reproduce </td> <td data-bbox="1123 1391 1433 1514">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier motion mark	Contested motion mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier motion mark	Contested motion mark				
 Click on the image to reproduce	 Click on the image to reproduce				
<p>AURAL COMPARISON</p>					
<p><i>Motion marks which do not contain any verbal elements cannot be aurally compared. In the same way, motion marks cannot be aurally compared to other types of trade mark which do not contain verbal elements, either in the image or pronounced.</i></p>					
<p>The presence of a distinctive verbal element in a motion mark usually has a significant influence on the way the relevant public aurally perceives the motion mark.</p>	<table border="1"> <thead> <tr> <th data-bbox="807 1729 1117 1771">Earlier motion mark</th> <th data-bbox="1123 1729 1433 1771">Contested motion mark</th> </tr> </thead> <tbody> <tr> <td data-bbox="807 1771 1117 1895">  Click on the image to reproduce </td> <td data-bbox="1123 1771 1433 1895">  Click on the image to reproduce </td> </tr> </tbody> </table>	Earlier motion mark	Contested motion mark	 Click on the image to reproduce	 Click on the image to reproduce
Earlier motion mark	Contested motion mark				
 Click on the image to reproduce	 Click on the image to reproduce				

<p>The coincidence in or the similarity in a distinctive verbal element usually will have an impact on the result of the aural comparison of motion marks with other motion marks or with other types of marks, making it more likely to lead to a finding of aural similarity to a certain extent.</p>	Earlier sound mark	Contested motion mark
	 Click on the image to reproduce	 Click on the image to reproduce

CONCEPTUAL COMPARISON

A conceptual comparison between two motion marks and between motion marks and other types of mark can be made in cases where a concept can be identified.





<p>The movement or transformation of the elements of a motion mark, in itself, is unlikely to have a concept. However, the movement could reinforce, add or, in some cases, alter the concept of the element subject to movement.</p> <p>For instance, in the example, the combination of the element with the motion reinforces the initial concept of 'basketball player throwing a ball'. Therefore, the marks are conceptually identical.</p>	Earlier figurative mark	Contested motion mark
	 Click on the image to reproduce	 Click on the image to reproduce

COMPARISON OF MULTIMEDIA MARKS: VISUAL, AURAL AND CONCEPTUAL COMPARISON

Multimedia marks encompass two categories of elements: 1) visual elements (graphically depicted verbal elements, figurative elements and the movement or transformation of the verbal and/or figurative elements); and 2) sound elements (sung or spoken verbal elements, musical elements, true-to-life sounds and other sounds).

























VISUAL COMPARISON

Multimedia marks can always be compared visually to other multimedia marks as well as other types of trade mark except sound marks. The principles for the visual comparison of motion marks generally apply.

<p>Graphically depicted verbal elements: In principle, there is a degree of visual similarity between two multimedia marks or between a multimedia mark and another type of mark if they share the same or similar distinctive graphically depicted verbal elements.</p>	Earlier multimedia mark	Contested multimedia mark
	 Click on the image to reproduce	 Click on the image to reproduce
<p>Figurative elements: In principle, there is a degree of visual similarity between two multimedia marks or between a multimedia mark and another type of mark that share the same or similar distinctive figurative elements.</p>	Earlier figurative mark	Contested multimedia mark
	 Click on the image to reproduce	 Click on the image to reproduce

AURAL COMPARISON

Multimedia marks can always be compared aurally to other multimedia marks and sound marks. Aural comparison can also be performed with other types of marks that consist of or contain a verbal element.

<p>Graphically depicted verbal elements: In principle, there is a degree of aural similarity if a multimedia mark contains a distinctive graphically depicted verbal element (static or subject to motion), which coincides in, or is similar to, a verbal element of another mark (both sung or spoken or graphically depicted, where applicable).</p> <p>Sung or spoken verbal elements: In principle, there is also a degree of aural similarity if the sung or spoken verbal element of the multimedia mark coincides in, or is similar to, another verbal element perceived in another mark (both sung or spoken or graphically depicted, where applicable).</p> <p>Combination of graphically depicted and sung or spoken verbal elements: Where a graphically depicted verbal element is accompanied by a sung or spoken verbal element, the latter could affect the pronunciation of the graphically depicted verbal element.⁽¹²⁾</p> <p>Musical elements and true-to-life sounds: The possibility of coincidence in the melody or true-to-life sounds only exists with multimedia and sound marks, as they are the only types of trade mark that may contain such sounds.</p>	<table border="1"> <tr> <th>Earlier multimedia mark</th> <th>Contested multimedia mark</th> </tr> <tr> <td></td> <td></td> </tr> <tr> <td>Click on the image to reproduce</td> <td>Click on the image to reproduce</td> </tr> </table>	Earlier multimedia mark	Contested multimedia mark			Click on the image to reproduce	Click on the image to reproduce						
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	<table border="1"> <tr> <th>Earlier motion mark</th> <th>Contested multimedia mark</th> </tr> <tr> <td></td> <td></td> </tr> <tr> <td>Click on the image to reproduce</td> <td>Click on the image to reproduce</td> </tr> </table>	Earlier motion mark	Contested multimedia mark			Click on the image to reproduce	Click on the image to reproduce	<table border="1"> <tr> <th>Earlier word mark</th> <th>Contested multimedia mark</th> </tr> <tr> <td></td> <td></td> </tr> <tr> <td></td> <td>Click on the image to reproduce</td> </tr> </table>	Earlier word mark	Contested multimedia mark			
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Earlier sound mark	Contested multimedia mark												
													
Click on the image to reproduce	Click on the image to reproduce												

CONCEPTUAL COMPARISON

Multimedia marks can be compared conceptually as long as a concept is conveyed.


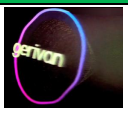
COMPARISON OF HOLOGRAM MARKS: VISUAL, AURAL AND CONCEPTUAL COMPARISON

Three categories of elements can be identified in hologram marks: 1) verbal elements; 2) figurative elements; and 3) the holographic effect.

VISUAL COMPARISON

In a hologram mark, movement or transformation in the representation of the mark only serves to show the holographic effect, and only the latter has to be taken into account in the visual comparison.

Holographic effect: An identical or similar holographic effect in itself will not, in principle, lead to a finding of visual similarity, unless similarity can be found in the verbal or figurative elements of the signs under comparison. Two signs can be visually similar because of coinciding or similar distinctive verbal or figurative elements, even though there is a different holographic effect.



Earlier motion mark	Contested hologram mark
	
Click on the image to reproduce	Click on the image to reproduce

⁽¹²⁾ However, depending on the particular case, it cannot be excluded that the graphically depicted verbal element in a multimedia mark will still be pronounced according to the pronunciation rules of the corresponding relevant public.

AURAL COMPARISON

Hologram marks which do not contain any verbal elements cannot be aurally compared.

When hologram marks contain verbal elements, they can be aurally compared with the same or other types of mark that can be subject to a phonetic assessment.

Earlier figurative mark	Contested hologram mark
	 <p data-bbox="1133 571 1428 607">Click on the image to reproduce</p>

CONCEPTUAL COMPARISON

A conceptual comparison between two hologram marks and between a hologram mark and other type of marks can be performed in cases where a concept can be identified.

3 IMPLEMENTATION

As in previous cases, this Common Practice will take effect within three months of the date of publication of this Common Communication. Further details on the implementation of this Common Practice are available in the table below. Implementing Offices may choose to publish additional information on their websites.

3.1 IMPLEMENTING OFFICES

List of implementing offices, implementation date and implementation practice: [Link to table](#)

(*) If there is a discrepancy between the translation of the Common Communication and the Common Practice documents in any of the official languages of the European Union and the English version, the latter will prevail.



COMMON PRACTICE

**NEW TYPES OF MARKS:
EXAMINATION OF FORMAL
REQUIREMENTS AND GROUNDS
FOR REFUSAL**

APRIL 2021

CP11 – NEW TYPES OF MARKS: EXAMINATION OF FORMAL REQUIREMENTS AND GROUNDS FOR REFUSAL AND/OR INVALIDITY

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1 INTRODUCTION

1.1 Objective of this document

This Common Practice document aims to identify general principles on the examination of formal requirements and grounds for refusal and invalidity of new types of trade mark, namely sound, motion, multimedia and hologram marks and the new ways of representing them. It serves as a reference for the EUIPO, the Benelux, and Member States' Intellectual Property the Offices (hereinafter collectively referred as 'MS IPOs'), User Associations (hereinafter referred as 'UAs'), applicants and representatives on the CP11 Common Practice.

It will be made widely available and will be easily accessible, providing a clear and comprehensive explanation of the principles on which the new Common Practice is based. These principles are designed to be generally applied, and aim to cover the large majority of cases. **Although the examination of formal requirements and grounds for refusal of new types of trade mark will always be assessed on a case-by-case basis**, the principles serve as guidance in order to ensure that different MS IPOs come to a similar and predictable outcome.

Furthermore, the examples in this document aim to illustrate the principles of the Common Practice. These examples should be looked at in connection with the respective ground for refusal/principle and based on the assumptions on which they rest.

1.2 Background

In December 2015, the European Parliament and the Council adopted the EU trade mark reform package. The package contained two legislative instruments, namely Regulation (EU) No 2017/1001 (EUTMR) and Directive (EU) No 2015/2436 (TMD), which aims to further approximate the laws of the Member States relating to trade marks. Alongside new provisions on substantive and procedural matters, the texts established a stronger legal basis for cooperative work. Under the terms of Article 151 EUTMR, cooperation with the MS IPOs to promote convergence of practices and tools in the fields of trade marks and designs became a core task for the EUIPO; Article 152 EUTMR explicitly indicates that this cooperation should include the development of common examination standards and the establishment of common practices.

Based on this legislative framework, in June 2016, the Management Board of the EUIPO agreed the adoption of the European Cooperation Projects. Reflecting the different activities provided for in the EUTMR, the projects were designed to build on past successes while at the same time improving processes and extending the reach of collaboration.

In the area of convergence, it included a project dedicated specifically to the identification and analysis of potential new harmonisation initiatives. The project analysed the trade mark and design practices of the MS IPOs in order to detect areas where divergence existed, and, through an evaluation of likely impact, feasibility of possible scope, existing legal constraints, levels of interest among users and practicality for IPOs, determine those areas where a common practice would be most beneficial for network stakeholders. The analysis was carried out in cycles, with each cycle resulting in the recommendation for the launch of a new convergence project.

The Common Practice outlined in this document relates to the fourth convergence project launched by the Management Board and the eleventh overall. CP11 was one of the two projects recommended for launch as a result of the third cycle of convergence analysis, which centred on the Legal Reform and the impact of the new provisions introduced by the EUTMD.

CP11: New types of marks: examination of formal requirements and grounds for refusal and/or invalidity

The project dates back to the context of the Support to the Transposition of the Directive initiative, launched with the aim of providing technical and legal support with the transposition process in MS IPOs and to facilitate a harmonised implementation of the new provisions.

As a result of the Support to the Transposition of the Directive project, and as a common starting point to prevent misalignments and enhance legal certainty, predictability and accessibility for users, the MS IPOs agreed the Common Communication on the representation of new types of trade mark ⁽¹⁾ in June 2017. This document reflects the agreement between MS IPOs on 1) the types of trade mark the Offices plan to accept; 2) the definitions and means of representation of new types of trade mark; and 3) the acceptable electronic file formats for sound, motion, multimedia and hologram marks.

In addition, a recommendation was made to develop a project on the harmonisation of the examination of formal requirements and grounds for refusal or invalidity that affect sound, motion, multimedia and hologram marks. This proposal was subsequently approved by the Convergence Analysis Working Group in October 2017, being finally adopted by the Management Board in June 2018.

The project Working Group was divided into two different work streams:

- a) A first work stream focused on the examination of formal requirements and absolute grounds for refusal or invalidity.
- b) A second work stream focused on the examination of relative grounds for refusal or invalidity.

Both work streams comprised representatives of MS IPOs, the EUIPO and UAs, who have worked closely to elaborate and agree on a set of principles based on the limited amount of settled case-law with regard to the new types of trade mark and the expected post-transposition practices.

1.3 Practice scope

This Common Practice delivers a set of principles and illustrative examples on the examination of formal requirements and grounds for refusal or invalidity of new types of trade mark, by taking into account the impact of the elimination of the graphic representation in the new TMD.

According to the general principle established by the Court of Justice of the European Union, the criteria for examining grounds for refusal or invalidity should be the same for all types of trade mark. While fully respecting this principle, the following issues that are specific to sound, motion, multimedia and hologram marks, are in the scope of the CP11 project work streams:

- a) The following issues are in scope of the CP11-WS1 Common Practice related to the examination of formal requirements and absolute grounds for refusal or invalidity (Parts A and B). In particular with regard to:
 - the application of Sieckmann criteria to new types of trade mark ⁽²⁾;
 - discrepancies between the representation, type and description of the mark;
 - examination of priority claims when at least one of the marks belongs to a new type;
 - inherent distinctiveness of new types of trade mark;
 - descriptiveness of new types of trade mark;
 - characteristics which result from the nature of the goods, or are necessary to obtain a technical result, or give substantial value to the goods.

⁽¹⁾ https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euipo/who_we_are/common_communication/common_communication_8/common_communication8_en.pdf

⁽²⁾ See 12/12/2002, C 273/00, Sieckmann, EU:C:2002:748, § 55.

The following issues, which are not specific to new types of trade mark and/or the new way of representing them, are out of scope of the CP11-WS1 Common Practice.

- The conventional ways of representing sound and motion marks.
 - Procedural matters and internal administrative procedures with regard to how and by what means the applicant is requested to clarify doubts or to remedy deficiencies.
 - Absolute grounds specified in (d), (f), (g), (h), (i), (j), (k), and (l) of Article 4 TMD have not been found specifically relevant to the new types of trade mark as they may apply regardless of the type of trade mark under examination.
 - The assessment of marks contrary to public policy or accepted principles of morality, deceptiveness, containing national flags and emblems, or conflicts with other protected rights (PDO, PGI, TSG - TTW, PVR) should, in principle, be unaffected by the new ways of representing sound, motion, multimedia or hologram marks.
 - With regard to Article 4(1)(d) TMD, it was agreed that this would be left out of the scope of the Common Practice because to conclude that a sign has become 'customary' requires a prior process of becoming accustomed to, which implies that once it becomes customary it also becomes descriptive. Therefore, as the rules applied to descriptiveness are also applicable to this ground, there is no need to specifically address this topic in relation to sound, motion, multimedia and hologram marks.
 - Language issues: It is considered for the sake of the Common Practice that marks which contain word elements, which are fully descriptive or non-distinctive in English, will be considered as being descriptive or having no distinctiveness in all languages and are understood by the national Offices.
- b) The following issues are in scope of the CP11-WS2 Common Practice related to the examination of relative grounds for refusal or invalidity (Part C), and in particular, the criteria for comparing signs where sound, motion, multimedia and hologram marks are involved, with specific regard to:
- comparison between new types of trade mark themselves;
 - comparison between other types of trade mark and new types of trade mark.

The following issues, which are not specific to new types of trade mark, are out of scope of the CP11-WS2 Common Practice.

- The assessment of enhanced distinctiveness and/or acquired distinctiveness through use and/or reputation: for the purpose of this Common Practice, it is assumed that there is no evidence and/or claim and/or previous knowledge that any of the marks are reputed or have an enhanced distinctiveness acquired through use.
- Determination or definition of the relevant public and the degree of attention in the assessment of relative grounds.
- The methodology for assessment of likelihood of confusion.
- Agreement on the factors that are considered when assessing the likelihood of confusion. Although there are many factors that may have an impact on the global appreciation of likelihood of confusion, such as the degree of attention of the relevant public, interdependency, coexistence, market situation, family of marks, etc., it is not the objective of the Common Practice to determine which are these factors.
- Agreement on the interdependencies between the assessment of distinctiveness and all the other factors that are considered when assessing the likelihood of confusion.
- Likewise, the Common Practice does not aim to define or harmonise the concepts of 'distinctive and dominant elements of the mark', although those concepts may be referred to in the document, where necessary, for the correct assessment of visual, aural or conceptual similarity from the perspective of the relevant public.

2 THE COMMON PRACTICE

A. EXAMINATION OF FORMAL REQUIREMENTS: COMMON PRINCIPLES

This part of the Common Practice delivers a set of principles and provides some recommendations on the following topics:

- the sign and its elements as defined by the Common Communication on the representation of new types of trade mark;
- general aspects: description, indication of verbal elements, discrepancies between the representation, the type of trade mark and description, and valid means of representing more than one type of trade mark;
- examination of priority claims when at least one of the marks belongs to a new type.

1 The sign and its elements as defined by the Common Communication on the representation of new types of trade mark

The Common Communication on the representation of new types of trade mark facilitates the classification of marks by summarising the definitions and means of representation for each of the different types of trade mark ⁽³⁾, using as a point of reference the definitions and means of representation laid out in Article 3 of the Implementing Regulation ⁽⁴⁾. The last four types are the new types of trade mark, and subject of the CP11 project (sound, motion, multimedia and hologram).

Furthermore, according to Article 3 of the Trade Mark Directive 2015/2436, a trade mark may be represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. In this regard, it is essential for the sign to be registered in any appropriate form using generally available technologies, provided that the sign is capable of being represented in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner.

When a sign clearly complies with one of the definitions and the representation requirements established in the Common Communication on the representation of new types of trade mark, it should be classified as that specific type of trade mark. Therefore, a sign will be classified as sound, motion, multimedia or hologram mark, when its representation is in line with the definition and characteristics explained in the following sections and the format submitted is the appropriate one for each specific trade mark.

It should be noted that the examples proposed are merely illustrative of what a sound, motion, multimedia and hologram mark filing may be. These are shown for formalities purposes, but do not necessarily fulfil the requirements for absolute grounds.

1.1 Sound marks

According to the definition established in the Common Communication on the representation of new types of trade marks, a sound mark is a trade mark consisting exclusively of a sound or combination of sounds, and shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation.

Following the above, any sign represented in an audio file and containing one or more sounds, regardless of the kind of sound contained therein (e.g. verbal elements perceived in the sound, a sound in nature, sound of animals, a melody, etc.) should be classified as a sound mark.

⁽³⁾https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euiipo/who_we_are/common_communication/common_communication_8/Annex_1_en.pdf

⁽⁴⁾ <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017R1431&from=EN>

Examples

Sound marks				
 SOUND MARK 1 Click on the image to reproduce	 SOUND MARK 2 Click on the image to reproduce	 SOUND MARK 3 Click on the image to reproduce	 SOUND MARK 4 Click on the image to reproduce	 SOUND MARK 5 Click on the image to reproduce

The Judgment of the Court of Justice of the EU of 27/11/2003, C 283/01, Musical notation-Shield Mark, EU:C:2003:641, with regard to the accurate representation of a sound in musical notation establishes that

a staff divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where appropriate, accidentals — all of this notation determining the pitch and duration of the sounds — may constitute a faithful representation of the sequence of sounds forming the melody in respect of which registration is sought. This mode of graphical representation of the sounds meets the requirements of the case-law of the Court that such representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

Accordingly, ‘accurate musical notation’ means that the representation must include all those elements that are necessary to determine its clear and precise subject matter of protection. Those requirements are satisfied where the sign is represented by a staff divided into measures (bars) and showing, in particular, a clef and all the musical notes that are necessary to reproduce the melody.

The tempo or speed of the melody and the instrument(s) are optional elements to be indicated. However, the lack of indication of these elements will result in a refusal of a priority claim when the file formats of the filings are not identical (Section 3.3.1 of this document - Examination of priority claims). It might also impact the assessment of relative grounds for refusal and invalidity when the assessment of identity of subject matter or comparison involves graphically represented sound marks.

1.2 Motion marks

According to the definition established in the Common Communication on the representation of new types of trade marks, a motion mark is a trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark, and shall be represented by submitting a video file or by a series of sequential still images showing the movement or change of position.

This definition does not restrict motion marks to those depicting movement. A sign may also qualify as a motion mark if it is capable of showing a change in the position of the elements (for instance a sequence of stills), a change of colour or a change of elements understood as the replacement of one image by another.






Accordingly, a video file consisting of an image or images without sound where a movement, a change in the position of the elements of the mark, a change of colour or change of elements can be identified should be classified as a motion mark.

When the motion mark is represented by a series of sequential still images showing the movement or change of position, the duration, repetitions and the speed of the motion/movement may be required to be indicated within the description.

Therefore, the absence of a description explaining those elements may result in a refusal of a priority claim

when the file formats of the filings are not identical. However, if in a priority claim, the second filing is represented in a sequence of still images, a description can be required to ensure that the subject matter of both filings is identical (e.g. duration, speed, repetitions) (Section 3.3.2 of this document - Examination of priority claims). It might also impact the assessment of relative grounds for refusal and invalidity when assessment of identity of subject matter or comparison involves graphically represented motion marks.

Examples

Motion marks		
<p>GERIVAN</p> <p>MOTION MARK 1</p> <p>Click on the image to reproduce</p>	 <p>MOTION MARK 2</p> <p>Click on the image to reproduce</p>	 <p>MOTION MARK 3</p> <p>Click on the image to reproduce</p>
 <p>MOTION MARK 4</p> <p>Click on the image to reproduce</p>	 <p>MOTION MARK 5</p> <p>Click on the image to reproduce</p>	 <p>MOTION MARK 6</p> <p>Click on the image to reproduce</p>



1.3 Multimedia marks

According to the definition established in the Common Communication on the representation of new types of trade marks, a multimedia mark is a trade mark consisting of, or extending to, the combination of image and sound. Multimedia marks shall be represented by submitting an audiovisual file.

Therefore, an audiovisual file consisting of a combination of visual and audio elements should be classified as a multimedia mark.

The presence of a black or white screen in the file combined with a sound does not preclude the mark from being classified as a multimedia mark, and neither does the partial absence of sound combined with an image.

Examples

Multimedia marks	
 <p>MULTIMEDIA MARK 1</p> <p>Click on the image to reproduce</p>	 <p>MULTIMEDIA MARK 2</p> <p>Click on the image to reproduce</p>

1.4 Hologram marks

According to the definition established in the Common Communication on the representation of new types of trade marks, a hologram mark is a trade mark consisting of elements with holographic characteristics. Therefore, a hologram is an image that changes its appearance when looked at from different angles. For instance:

1. A hologram can be a physical flat structure that uses light diffraction to create visual images. Its flat

surface, under proper illumination, appears to contain a three-dimensional image or other visual effects. In this case, a three-dimensional effect is actually a two-dimensional visual effect that is perceived by human brains as three-dimensional.

2. A hologram can be a digital projection or visualisation of an object displayed via light field displays. Through them, three-dimensional objects and object compositions can be visualised and seen as such. These lifelike images can be seen but not touched.

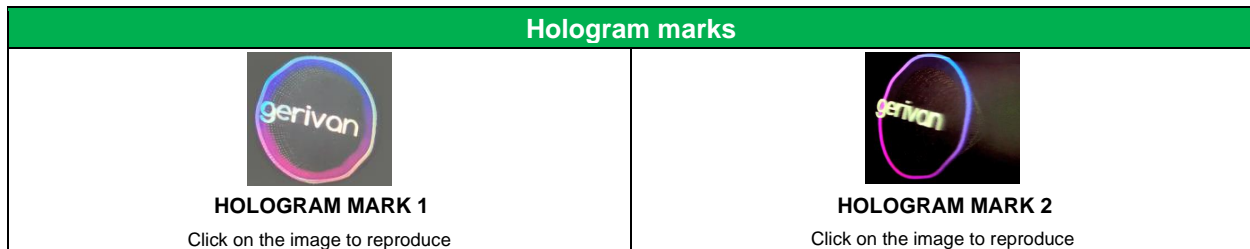
Accordingly, hologram marks show additional visual effects that other types of trade mark are not capable of. In this regard, holographic characteristics may include some of the following features:

- image swapping effect; image morphing effect;
- three-dimensional volume effect, e.g. image appears to emerge;
- three-dimensional deep effect e.g. image appears to have depth;
- rotating and/or moving three-dimensional elements in digital holograms;
- digitally visualised effects e.g. on LED display.

Hologram marks shall be represented by submitting a video file (e.g. MP4) or a series of graphic or photographic images containing all the views from different angles which serve to sufficiently identify the holographic effect.

When the hologram mark is represented in a series of sequential still graphic or photographic images, the images must display all the views from different angles that are necessary to sufficiently identify the holographic effect in its entirety, particularly height, width, depth and/or morphing effects of the three-dimensional image.

Examples



2 General aspects

2.1 Description

The representation of the trade mark may be complemented by a description of the sign in appropriate cases, which serves to clarify the subject matter and the scope of protection of the mark applied for ⁽⁵⁾. Where the representation of a new type of trade mark (sound, motion, multimedia and hologram marks) is accompanied by a description, the description has to be in accordance with the representation of the trade mark and must not contradict the representation or extend its scope.

The Common Communication on the representation of new types of trade mark indicates that the representation of motion, position, pattern, colour, and other marks may be accompanied by a description ⁽⁶⁾. Nevertheless, this does not preclude the possibility that some Offices may also accept descriptions accompanying further types of trade mark.

⁽⁵⁾ See 27/03/2019, C-578/17, Hartwall, EU:C:2019:261, § 39; 27/11/2003, C-283/01, Musical Notation-Shield Mark, EU:C:2003:641, § 59; and, as an example, judgment of 24/06/2004, C 49/02, Blau/Gelb, EU:C:2004:384, § 34.

⁽⁶⁾ See definitions and means of representation for the different types of trade marks as established in the Common Communication on the representation of new types of trade marks.

2.2 Indication of verbal elements in the trade mark

Verbal elements in motion or hologram marks can be depicted visually, or these verbal elements may be included in sound marks. For sound marks it is the aural impression of the word that counts. In multimedia marks, they may be both aural and/or visual.

Therefore, any existing field requiring the indication of verbal elements in the trade mark, will serve only for search purposes and will never extend the scope of protection of the trade mark as defined by its representation.

2.3 Prevalence of the representation over the type and description


Where the representation of the trade mark is complemented by an indication of the type and/or a description of the trade mark, these must be in line with the representation of the trade mark.

Therefore, when there is a conflict or discrepancy between the representation and the type and/or the description of the trade mark, the representation of the trade mark will always prevail.

2.3.1 Discrepancies between representation and description

Where a discrepancy exists between the description and the representation of the trade mark, the type selected by the applicant plays an important role, and if the type of trade mark is in line with the representation, the description would have to be deleted or amended and must be aligned with the representation.

Example

Selected type of trade mark: motion mark	Reasoning
<p>Representation of the mark:</p>  <p>DISCREPANCY 1 Click on the image to reproduce</p>	<p><i>There is an inconsistency between the description of the mark describing a dog barking, and the representation of the mark, consisting of a video file of a cow moving without sound. Nevertheless, the type of trade mark selected by the applicant and the representation of the mark are aligned. For this reason, the type of trade mark prevails over the description, and, therefore, the mark would be accepted as motion mark, and the incorrect description should be deleted or corrected by the applicant to be aligned with the representation of the mark.</i></p>
<p>Description: dog barking</p>	
<p>Type of mark to be accepted: motion mark</p>	

2.3.2 Discrepancies between representation and type


In situations where a discrepancy between the type and the representation of the trade mark exists, the representation of the mark will also prevail, provided that it is in an acceptable format for representing the specific type of mark.

Additionally, the judgment of 27/03/2019, C 578/17, Hartwall, EU:C:2019:261, establishes that

when the trade mark application contains an inconsistency between the sign, protection in

respect of which is sought in the form of a drawing, and the classification given to the mark by the applicant, the consequence of which is that it is impossible to determine exactly the subject matter and scope of the protection sought under trade mark law, the competent authority must refuse registration of the mark on account of the lack of clarity and precision of the trade mark application (7).


Example

Selected type of trade mark: multimedia mark	Reasoning
<p>Representation of the mark:</p>  <p>DISCREPANCY 2 Click on the image to reproduce</p>	<p><i>There is an inconsistency between the selected type of trade mark, 'Multimedia mark', and the representation consisting of the image of a dog moving. As it is an accurate representation for motion marks, the mark would be accepted as motion mark.</i></p>
<p>Type of mark to be accepted: motion mark</p>	

2.3.3 Discrepancies between description and type

In cases where there is a discrepancy between the description and the type of trade mark selected in the application, the description will prevail, as long as it accords with the representation of the trade mark.

Example

Selected type of trade mark: multimedia mark	Reasoning
<p>Representation of the mark:</p>  <p>DISCREPANCY 3 Click on the image to reproduce</p>	<p><i>There is an inconsistency between the description of the mark, describing a change of position of a grey arrow, and the type of trade mark selected, 'Multimedia mark'. Nevertheless, the description and the representation are aligned, both consisting of a grey arrow moving. For this reason, the description prevails over the type selected, and the mark would be accepted as a motion mark.</i></p>
<p>Description: the motion of a grey arrow changing its position gradually from the bottom left to the top right, where the whole movement lasts 4 seconds</p>	
<p>Type of mark to be accepted: motion mark</p>	

2.4 Valid means of representing more than one type of trade mark

New file formats (e.g. electronic audio or video files) should not be used to represent traditional marks (8) in the registry (e.g. a video file would not be an acceptable means to file a word mark, even if the file merely contained a static representation of the word itself).

However, new file formats can be acceptable for more than one of the new types of trade mark, as is the case of electronic video files, acceptable for representing motion, multimedia and hologram marks or image file as valid means to apply for sound or figurative marks. In this regard, trade mark applications will be

(7) See 27/03/2019, C 578/17, Hartwall, EU:C:2019:261, § 40.

(8) For the purpose of this document, 'traditional trade marks' refers only to word marks, purely figurative marks and composite marks (combination of verbal and figurative elements).

accepted according to the type of trade mark selected by the applicant, provided that the representation complies with the legal requirements for the specific type and the scope of protection and the subject matter of the trade mark will vary, according to the type of mark accepted.

Therefore, a sound mark graphically represented (e.g. musical notation in image file) can be accepted as a figurative mark if that is the type selected by the applicant, and no other information indicates that the intention was to apply for another type of trade mark. In this situation, the protection offered by the registration will not cover the sound itself but the figurative element(s) contained in the mark.

Examples

Selected type of trade mark: sound marks	
<p>Representation of the mark:</p>	<p>Representation of the mark:</p>
Types of mark to be accepted: sound marks	

Selected type of trade mark: figurative marks	
<p>Representation of the mark:</p>	<p>Representation of the mark:</p>
Types of mark to be accepted: figurative marks	

Similarly, a motion mark represented graphically (e.g. a sequence of still images) can be accepted as a figurative mark if the applicant has selected that type of trade mark and no other information indicates that he wanted to apply for a different type.

Examples

Selected type of trade mark: motion mark	
<p>Representation of the mark:</p>	

Type of mark to be accepted: **motion mark**

Selected type of trade mark: **figurative mark**

Representation of the mark:



Type of mark to be accepted: **figurative mark**



3 Examination of priority claims

The same principles that apply to traditional trade marks with regard to the examination of priority claims also apply to new types of trade mark, with some particularities that are addressed in the following sections. In addition, a sign will be considered identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer ⁽⁹⁾. In this regard, it should be noted that an insignificant difference between two marks is a difference that a reasonably observant consumer will perceive only upon side-by-side examination of the marks.

3.1 Identical subject matter

Two trade marks will be considered as identical for the purpose of examination of priority claims if the subject matter of protection and the trade mark are the same, regardless of the format. Additionally, priority may be accepted when the second filing is of a different type of trade mark but has identical subject matter.

Example

First filing	Second filing
 OTHER MARK 1 Click on the image to reproduce	 MULTIMEDIA MARK 3 Click on the image to reproduce
Other mark	Multimedia mark
<p>Reasoning: <i>priority claim accepted as both filings have identical subject matter, despite being of different types.</i></p>	



3.2 Different subject matter



When a priority claim involves two trade marks with different subject matter (e.g. if one of the filings includes elements that are not included in the other filing), regardless of their format or the type of trade mark selected, the trade marks will be considered different, and consequently, the priority claim will be rejected.



⁽⁹⁾ See 20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 54.



Examples per type of mark

a) Sound marks

First filing	Second filing
 SOUND MARK 6 Click on the image to reproduce	 SOUND MARK 7 Click on the image to reproduce
Sound mark	Sound mark
<p>Reasoning: priority claim rejected as the melody is played by different instruments, and therefore, the subject matter of both filings is different.</p>	



First filing	Second filing
 SOUND MARK 8 Click on the image to reproduce	 SOUND MARK 9 Click on the image to reproduce
Sound mark	Sound mark
<p>Reasoning: priority claim rejected as the tempo of the melody in the first filing is much slower than the tempo of the melody in the second filing. Therefore, the subject matter of both filings is different.</p>	



First filing	Second filing
 SOUND MARK 10 Click on the image to reproduce	 SOUND MARK 11 Click on the image to reproduce
Sound mark	Sound mark
<p>Reasoning: priority claim rejected as the rhythm of the second filing is not the same as the one in the first filing. Therefore, the subject matter of both filings is different.</p>	



First filing	Second filing
 SOUND MARK 12 Click on the image to reproduce	 SOUND MARK 13 Click on the image to reproduce
Sound mark	Sound mark
<p>Reasoning: priority claim rejected as the first filing consists of the sound of three beeps, while the second filing contains the sound of six beeps. Therefore, the subject matter of both filings is different.</p>	



b) Motion marks

First filing	Second filing
--------------	---------------



	 <p>MULTIMEDIA MARK 4 Click on the image to reproduce</p>
<p>Motion mark</p>	<p>Multimedia mark</p>
<p>Reasoning: priority claim rejected as the second filing contains sound which is not included in the first filing. In addition, the first filing does not represent the complete clapping movement of the hands in the second filing, namely the 11 repeated claps. Therefore, the subject matter of both filings is different.</p>	



<p>First filing</p>  <p>MOTION MARK 7 Click on the image to reproduce</p>	<p>Second filing</p>  <p>MOTION MARK 8 Click on the image to reproduce</p>
<p>Motion mark</p>	<p>Motion mark</p>
<p>Reasoning: priority claim rejected as the speed and the repetitions of the clapping hands of the first filing is different in the second filing. Therefore, the subject matter of both filings is different.</p>	



<p>First filing</p>  <p>MOTION MARK 9 Click on the image to reproduce</p>	<p>Second filing</p>  <p>MOTION MARK 10 Click on the image to reproduce</p>
<p>Motion mark</p>	<p>Motion mark</p>
<p>Reasoning: priority claim rejected as the first filing consists of an arrow moving from one corner and stopping in the middle of the frame, while the second filing consists of an arrow moving from one corner of the frame to the other. Therefore, the subject matter of both filings is different.</p>	

<p>First filing</p> 	<p>Second filing</p>  <p>MOTION MARK 11 Click on the image to reproduce</p>
<p>Figurative mark</p>	<p>Motion mark</p>
<p>Reasoning: priority claim rejected as both filings consist of the same image of a cow but the second filing contains the movement of the cow's mouth, which is not included in the first filing. Therefore, the subject matter of both filings is different.</p>	



c) Multimedia marks

First filing	Second filing
 MULTIMEDIA MARK 5 Click on the image to reproduce	 SOUND MARK 14 Click on the image to reproduce
Multimedia mark	Sound mark
<p>Reasoning: priority claim rejected as the first filing consists of image and sound, while the second filing contains the same sound but no image. Therefore, the subject matter of both filings is different.</p>	

First filing	Second filing
 MULTIMEDIA MARK 6 Click on the image to reproduce	 MULTIMEDIA MARK 7 Click on the image to reproduce
Multimedia mark	Multimedia mark
<p>Reasoning: priority claim rejected as both filings contain the same image, but different sound and movement. Therefore, the subject matter of both filings is different.</p>	

First filing	Second filing
 MULTIMEDIA MARK 8 Click on the image to reproduce	 MULTIMEDIA MARK 9 Click on the image to reproduce
Multimedia mark	Multimedia mark
<p>Reasoning: priority claim rejected as both filings share the same sound but the second filing does not include all the elements that appear in the first filing, namely the verbal element 'Gerivan'. Therefore, the subject matter is different.</p>	

d) Hologram marks

First filing	Second filing
 HOLOGRAM MARK 3 Click on the image to reproduce	 HOLOGRAM MARK 4 Click on the image to reproduce
Hologram mark	Hologram mark
<p>Reasoning: priority claim rejected as the depth of the holographic effect of the second filing is not the</p>	

same as the one in the first filing. Therefore, the subject matter is different.

3.3 Same type of trade marks represented differently ⁽¹⁰⁾



3.3.1 Sound marks



Priority claims will only be accepted if all the elements contained in the first filing are present in the second filing.



Therefore, priority claims in which one of the filings is represented in musical notation (e.g. JPEG) and the other is represented in an audio file (e.g. MP3), will only be accepted if all the elements ⁽¹¹⁾ contained in the audio file are indicated in the musical notation.

If any of those elements is missing, the trade marks are not identical and the priority claim will be rejected.

Examples

First filing	Second filing
	 SOUND MARK 15 Click on the image to reproduce
Sound mark	Sound mark
<p>Reasoning: priority claim accepted as the melody in the MP3 is equivalent to that in the musical notation, and all the elements indicated in the musical notation, namely bars, clef, musical notes and rests whose form indicates relative value - all of this notation determining the pitch and duration of the sounds - as well as the instrument, namely piano and tempo of the melody are contained in the audio file.</p>	



First filing	Second filing
 SOUND MARK 16 Click on the image to reproduce	
Sound mark	Sound mark
<p>Reasoning: priority claim accepted as the melody in the musical notation is equivalent to that in the MP3, and all the elements indicated in the musical notation, namely bars, clef, musical notes and rests whose form indicates relative value - all of this notation determining the pitch and duration of the sounds - as well as the instrument, namely piano and tempo of the melody are contained in the audio file.</p>	



First filing	Second filing
 SOUND MARK 17 Click on the image to reproduce	
Sound mark	Sound mark



⁽¹⁰⁾ Annex of the Common Communication on the representation of new types of trade mark, where the acceptable file formats in each IPO is indicated, should be checked when claiming a priority where both sound marks are represented differently.



⁽¹¹⁾ See Part A - Section 1.1 – Sound marks – Elements for a graphically represented sound mark to be clear and precise.



Sound mark	Sound mark
Reasoning: priority claim rejected as the second filing does not include all elements contained in the audio file, namely the instrument. Therefore, the subject matter of both filings is non-identical.	

First filing	Second filing
 <p>Piano ♩ = 90</p>	 SOUND MARK 18 Click on the image to reproduce
Sound mark	Sound mark
Reasoning: priority claim rejected as the melody in the second filing contains the sound of a dog barking which is not included in the first filing. Therefore, the subject matter of both filings is non-identical.	

First filing	Second filing
 <p>Piano ♩ = 90</p>	 SOUND MARK 19 Click on the image to reproduce
Sound mark	Sound mark
Reasoning: priority claim rejected as the melody in the second filing contains a voice saying 'Gerivan', which is not included in the first filing. Therefore, the subject matter of both filings is non-identical.	

First filing	Second filing
	 SOUND MARK 20 Click on the image to reproduce
Sound mark	Sound mark
Reasoning: priority claim rejected as not all the elements contained in the audio file are indicated in the musical notation, namely the instrument with which the melody is played, in this case, a piano and the first filing is only a partial representation of the second filing which contains additional notes. Therefore, the subject matter of both filings is different.	

First filing	Second filing
 <p>♩ = 90</p>	 SOUND MARK 21 Click on the image to reproduce
Sound mark	Sound mark
Reasoning: priority claim rejected as not all the elements contained in the audio file are indicated in the musical notation, namely the instrument with which the melody is played, in this case, a viola pizzicato. Therefore, the subject matter of both filings is different.	



First filing	Second filing
	 SOUND MARK 22 Click on the image to reproduce
Sound mark	Sound mark
<p>Reasoning: priority claim rejected as not all the elements contained in the audio file are indicated in the musical notation, namely the tempo or speed of the melody. Therefore, the subject matter of both filings is different.</p>	



3.3.2 Motion marks

Priority claims in which one of the filings is represented in a sequence of still images (e.g. JPEG) and the other in a video file (e.g. MP4), will only be accepted if all the elements of the video file and their complete movement are clearly identifiable in the sequence of still images. If the second filing is represented in a sequence of still images, a description can be required to ensure that the subject matter is identical (e.g. duration, speed, repetitions).



If any of those elements is missing and the complete movement cannot be clearly identified, the marks are non-identical and the priority claim will be rejected.

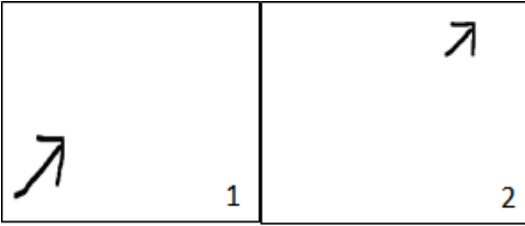

Examples

First filing	Second filing
 MOTION MARK 12 Click on the image to reproduce	
Motion mark	Motion mark
<p>Description: this motion consists of the content of the still images appearing at intervals of half a second.</p>	
<p>Reasoning: priority claim accepted as the complete movement of the motion mark contained in the video file of the first filing is clearly identified in the sequence of still images of the second filing, which shows exactly the same six images that appear in the video file.</p>	

First filing	Second filing
	 MOTION MARK 13 Click on the image to reproduce

Description: this motion consists of the content of the still images appearing at intervals of half a second.	
Motion mark	Motion mark
Reasoning: <i>priority claim accepted as the complete movement within the first filing, which consists of a sequence of six still images, is clearly identifiable in the video file.</i>	

First filing	Second filing
 <p>MOTION MARK 14 Click on the image to reproduce</p>	
Motion mark	Motion mark
Reasoning: <i>priority claim rejected as the second filing does not represent the complete movement of the hands clapping, namely the 18 repetitions of the claps, the speed of the claps and the duration of the video file are not included in the second filing, furthermore there is no description explaining the complete movement.</i>	

First filing	Second filing
	 <p>MOTION MARK 15 Click on the image to reproduce</p>
Motion mark	Motion mark
Reasoning: <i>priority claim rejected as the first filing only shows the arrow in two positions and the movement of the arrow that can be seen in the video file of the second filing is not shown in its entirety in the sequence of still images of the first filing.</i>	



3.3.3 Hologram marks



Priority claims in which one of the filings is a hologram represented in a series of graphic or photographic images (image files, e.g. JPEG), and the other is represented in a video file (e.g. MP4) will only be accepted if all the elements of the video file and the different stages of the holographic effect are clearly identified in the series of graphic or photographic images.

If any of those elements and the different stages of the holographic effect cannot be clearly identified the marks are non-identical and the priority claim will be rejected.

Examples

First filing	Second filing
--------------	---------------

 <p>HOLOGRAM MARK 5 Click on the image to reproduce</p>	
Hologram mark	Hologram mark
<p>Reasoning: priority claim accepted as all the elements and the different stages of the holographic effect, particularly the depth of the structure and the emerging verbal element contained in the video file are clearly identified in the series of photographic images of the second filing.</p>	

First filing	Second filing
 <p>HOLOGRAM MARK 6 Click on the image to reproduce</p>	
Hologram mark	Hologram mark
<p>Reasoning: priority claim rejected as the different stages of the holographic effect contained in the video file, namely, the depth of the three-dimensional structure and the emerging verbal element are not identifiable in the series of photographic images of the second filing.</p>	

B. EXAMINATION OF ABSOLUTE GROUNDS FOR REFUSAL AND/OR INVALIDITY: COMMON PRINCIPLES

This part of the Common Practice delivers a set of principles and provides some recommendations with regard to the examination of absolute grounds for refusal and/or invalidity that are specific to sound, motion, multimedia and hologram marks, and in particular:

- the assessment of clarity and precision of new types of trade mark – Article 4(1)(a) TMD;
- the required degree of distinctiveness of new types of trade mark – Article 4(1)(b) TMD;
- new types of trade mark which may serve to describe the goods or services, or their characteristics – Article 4(1)(c) TMD;
- signs that consist exclusively of sounds, movement and a combination of image and sound, which result from the nature of the goods, can be necessary to obtain a technical result, or can give substantial value to the goods – Article 4(1)(e) TMD.

1 General remarks

One of the key changes brought about by the new TMD was the elimination of the requirement of graphic representation from the definition of 'trade mark' given by Article 3 TMD.

This elimination allowed for the possibility of accepting trade marks represented in new file formats not previously provided for by national or regional systems. This also made the representation of certain already acceptable types of trade mark easier and more accurate. Accordingly, the MS IPOs, agreed on the acceptance of the mono-format approach for the new types of trade mark, not precluding the acceptance of additional formats. All of them are indicated in the Common Communication on the representation of new types of trade mark ⁽¹²⁾.

However, despite the possibility of representing these new types of trade mark in different formats, the outcome of the assessment of the absolute grounds for refusal must be the same.

2 The assessment of clarity and precision of new types of trade mark – Article 4(1)(a) TMD

According to Article 4(1)(a) TMD ‘a sign which cannot constitute a trade mark shall not be registered or, if registered, shall be liable to be declared invalid.’

This article reflects the MS IPOs’ obligation to refuse signs that do not conform to the requirements of Article 3 TMD. In this regard, to be capable of constituting a trade mark, an application must satisfy three conditions:

- it must be a sign;
- it must be capable of distinguishing the goods or services of one undertaking from those of others;
- it must be capable of being represented on the register in a way that allows the competent authorities and the public to determine the clear and precise subject matter of protection.

This article reflects the MS IPOs’ obligation to refuse signs when their representation is not clear and precise. In this regard, the representation of a new type of trade mark needs to be assessed to see if it enables the competent authorities and the public to determine the clear and precise subject matter of protection, and that it can therefore constitute a trade mark.



This means that the mark will be considered clear and precise as long as it is represented in any appropriate form using generally available technologies, provided that the sign is also capable of being represented in a self-contained, easily accessible, intelligible, durable and objective manner, irrespective of whether it has a concept. This approach is aligned with the principle according to which there is no need for a word or a figurative mark to have a meaning or to contain identifiable images as long as it is capable of fulfilling the function of a trade mark, and thus to serve as an indication of origin.

In addition, the legal consequences of rejecting a trade mark based on Article 4(1)(a) TMD must be taken into account when examining a trade mark application. Article 4(4) TMD, states that ‘a trade mark shall not be refused registration in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration, following the use, which has been made of it, it has acquired a distinctive character.’ Accordingly, if the application is refused based on the grounds of (a), there will be no examination based on the other absolute grounds for refusal, and it will not be possible to overcome the refusal through acquired distinctiveness in consequence of use of the mark.



The following examples for sound, motion and multimedia marks are provided to assess clarity and precision according to Article 4(1)(a) TMD. The same considerations apply to hologram marks. These examples may not necessarily be considered distinctive according to Article 4(1)(b) TMD.

a) Sound marks


⁽¹²⁾ https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_euiipo/who_we_are/common_communication/common_communication_8/common_communication8_en.pdf - see Table 2 and 6.

Clear and precise sound marks	
Sound marks	Reasoning
 SOUND MARK 23 Click on the image to reproduce	<i>Although the verbal element perceived in the sound has no meaning, the representation of the sound mark enables the competent authorities and the public to determine the clear and precise subject matter of protection.</i>
 SOUND MARK 24 Click on the image to reproduce	<i>Despite perceiving many different sounds together in the file, the representation of the sound mark enables the competent authorities and the public to determine the clear and precise subject matter of protection.</i>

b) Motion marks

Clear and precise motion marks	
Motion marks	Reasoning
 MOTION MARK 16 Click on the image to reproduce	<i>Despite consisting of a blurred image, the representation of this motion mark enables the competent authorities and the public to determine the clear and precise subject matter of protection.</i>
 MOTION MARK 17 Click on the image to reproduce	<i>The representation of this motion mark, despite containing non-identifiable images, enables the competent authorities and the public to determine the clear and precise subject matter of protection.</i>

c) Multimedia marks

Clear and precise multimedia mark	
Multimedia mark	Reasoning
 MULTIMEDIA MARK 10 Click on the image to reproduce	<i>Despite consisting of a blurred image and the fact that the verbal element perceived in the sound has no meaning, the representation of this multimedia mark enables the competent authorities and the public to determine the clear and precise subject matter of protection.</i>

3 The required degree of distinctiveness of new types of trade mark – Article 4(1)(b) TMD

3.1 General aspects

According to Article 4(1)(b) TMD trade marks which are devoid of any distinctive character, shall not be registered or, if registered, shall be liable to be declared invalid.

Taking into account the content of the article, the acceptability of any type of trade mark must depend upon whether they are considered distinctive per se. In this regard, it is worth highlighting that the general criteria

for assessing distinctiveness of traditional types of trade mark must also apply when assessing the required degree of distinctiveness of new types of trade mark.

According to settled case-law, distinctiveness means that a sign must be capable of fulfilling the essential function of a trade mark. Therefore, the sign must serve to identify the product and/or services in respect of which registration is applied for by enabling the consumer to distinguish that good and/or service from those of other undertakings⁽¹³⁾. Such distinctiveness can be assessed only by reference, firstly, to the goods or services for which registration is sought and, secondly, to the relevant public's perception of that sign⁽¹⁴⁾.

However, while the criteria for assessing distinctiveness are the same for the different categories of trade marks, it may become apparent, when applying those criteria, that the relevant public's perception is not necessarily the same in relation to each of those categories. Moreover, it is also settled case-law that the way in which the relevant public perceives a trade mark is influenced by its level of attention, which is likely to vary according to the category of goods or services in question.

It should be noted that new types of trade mark may not necessarily be affixed to or used with the goods and/or services in the same way as a traditional trade mark would be. The consumer could encounter new types of mark, for example, in the context of promotional activities. Such use does not necessarily diminish the distinctive potential of the mark.

Although each of the grounds for refusal in Article 4(1) TMD is independent and must be examined separately, there is a clear overlap between the grounds for refusal set out in Article 4(1)(b) and 4(1)(c) TMD. In particular, it is clear from case-law that a mark which is considered descriptive of characteristics of goods or services for the purposes of Article 4(1)(c) TMD is, on that account necessarily devoid of any distinctive character with regard to the same goods and/or services for the purposes of Article 4(1)(b) TMD. A mark can be, however, devoid of distinctive character for reasons other than its possibly descriptive character. Therefore, a descriptive mark is necessarily devoid of any distinctive character, but a mark may lack distinctiveness due to reasons other than descriptiveness⁽¹⁵⁾.

3.2 Sound marks

As already mentioned in the formalities part of this document, Part A, Section 1.1 – Sound marks any sign represented in an audio file and containing one or more sounds, regardless of the kind of sound contained therein can constitute a sound mark.

3.2.1 Consumer perception - sound marks

The public's perception of the distinctiveness of sound marks will be inextricably linked to the degree to which the mark is related to the goods and services applied for. The consumer will be more likely to see the mark as an indication of commercial origin if no link can be established between the mark and the goods and services. Consumers are accustomed to perceiving conventional types of trade mark such as word and figurative marks as indications of commercial origin. However, as sounds are increasingly being used in trade as part of a branding strategy, consumers are also more likely to perceive them as indications of commercial origin.

For the sake of analysis of consumer perception, sound marks can be grouped at least in the following three ways:

⁽¹³⁾ See 29/09/1998, C-39/97, Canon EU:C:1998:442, § 28 and 27/02/2002, T-79/00, Lite, EU:T:2002:42, § 26.

⁽¹⁴⁾ See 08/04/2003, C-53/01, C 54/01 & C 55/01 Linde, EU:C:2003:206, § 41; 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 34 and joined cases of 29/04/2004, C-468/01 P to C-472/01- P, Tabs (3D), EU:C:2004:259, § 33.

⁽¹⁵⁾ See 12/06/2007, T-190/05, Twist & Pour, EU: T:2007:171, § 39; 08/07/2004, T-289/02 Telepharmacy Solutions EU:T:2004:227, § 24.

- sounds produced by or connected to the goods or services;
- notes, combination of notes, tunes or melodies;
- sounds which are the audible equivalent of verbal elements.

There are also sounds which are not included in the previous groups and have no connection to the goods and/or services.

The first group - sounds produced by or connected to the goods or services - will often correspond to the nature or function of those goods, or be closely associated to the services. If this is the case, the public will not normally perceive the sound as being an indication of commercial origin, but, for example, merely as a functional element.

The second group - notes, combination of notes, tunes or melodies- are unlikely to have a link to the goods or services. They will generally be perceived by the public in the same way as a sequence of notes or as a promotional jingle, which may or may not be distinctive depending on its specific attributes.



The consumer's perception of the third group - sound marks composed of verbal elements – may change, depending on the meaning of the verbal element itself the language and/or the way in which it is pronounced. If the sound mark consists of a common pronunciation of a word, the assessment will generally be the same as that of a word mark containing the same verbal element.

With regard to those sounds not connected to the goods and/or services and not included in the previous groups, the consumer will only perceive these as indication of commercial origin provided that they have a certain resonance ⁽¹⁶⁾, engendering in the consumer a certain form of attention to be identifiable as a trade mark.



The way in which a consumer will perceive a mark made up of a combination of the different groups will depend on the mark itself, provided it is identifiable as a trade mark, and if no link between the sound and the goods and services can be established.

3.2.2 *Inherently distinctive sound marks*



When the sound perceived in a sound mark consists of one note, a combination of notes or a melody, it will be considered inherently distinctive if it is capable of being perceived by the relevant public as an indication of commercial origin.

Inherently distinctive melody		
Sound marks	Goods and services	Reasoning
 SOUND MARK 25 Click on the image to reproduce	<i>Class 41: Providing films for entertainment purposes</i>	<i>The sequence of notes is of a length and complexity which gives it a certain resonance enabling it to function as an indication of commercial origin. Therefore, the melody is considered distinctive for the services applied for.</i>
 SOUND MARK 26 Click on the image to reproduce	<i>Class 41: Providing films for entertainment purposes</i>	<i>The whistled sequence of notes is of a length and complexity which gives it a certain resonance enabling it to function as an</i>


⁽¹⁶⁾ See 13/09/2016, T 408/15, SON D'UN JINGLE SONORE PLIM PLIM (sound mark), EU:T:2016:468, § 45.

		<i>indication of commercial origin. Therefore, the melody is considered distinctive for the services applied for.</i>
 SOUND MARK 27 Click on the image to reproduce	Class 9: Computers	<i>The sequence of chords is of a length and complexity which gives it a certain resonance enabling it to function as an indication of commercial origin. Therefore, the melody is considered distinctive for the goods applied for.</i>
 SOUND MARK 28 Click on the image to reproduce	Class 3: Washing powder	<i>The melody contains a series of chords which give it a certain resonance, enabling it to function as an indication of commercial origin. Therefore, the melody is considered distinctive for the goods applied for.</i>



When the sound perceived in a sound mark consists of a verbal element, which is considered distinctive in itself, and if pronounced in a clear manner, even if pronounced in a neutral or a robotic voice, the sound mark will be considered distinctive.

Distinctive		
Sound marks	Goods and services	Reasoning
 SOUND MARK 29 Click on the image to reproduce	Class 12: Cars	<i>The distinctive verbal element perceived in the sound mark, 'Gerivan' is pronounced in a clear and understandable manner, and therefore the sound mark is considered distinctive.</i>
 SOUND MARK 30 Click on the image to reproduce	Class 12: Cars	<i>The distinctive verbal element perceived in the sound mark, 'Gerivan' is pronounced in a clear and understandable manner, and therefore the sound mark is considered distinctive.</i>

Further, if the element of speech perceived in a sound mark cannot be understood or is not identifiable as a word, it will be considered distinctive, as long as the sound is capable of being recognised as an indication of commercial origin by the consumer.



Distinctive		
Sound mark	Goods and services	Reasoning
 SOUND MARK 31 Click on the image to reproduce	Class 12: Cars	<i>This sound will be perceived as an invented sound with no meaning, which is memorable and therefore capable of being recognised as an indication of commercial origin.</i>

When the sound perceived in a sound mark contains a sound disassociated from the goods and/or services applied for, it will in principle, be considered distinctive as long as it is capable of being recognised by the consumer as an indication of commercial origin.


Distinctive		
Sound marks	Goods and services	Reasoning
 SOUND MARK 32 Click on the image to reproduce	Class 11: Toilets	<i>The sound perceived in the mark has no link to the goods applied for and has sufficient resonance to be recognised by the consumer as an indication of commercial origin. Therefore, it is considered distinctive.</i>
 SOUND MARK 33 Click on the image to reproduce	Class 31: Foodstuffs for animals	<i>The sound perceived in the mark has no link to the goods applied for and sufficient resonance to be recognised by the consumer as an indication of commercial origin. Therefore, it is considered distinctive.</i>

3.2.3 Non-distinctive sound marks

In principle, when the sound mark consists of a sound produced by or connected to the goods and/or services, or to other relevant features thereof, it will be perceived by the consumer merely as a functional attribute, and therefore the sound mark will be considered non-distinctive.



Non-distinctive		
Sound marks	Goods and services	Reasoning
 SOUND MARK 34 Click on the image to reproduce	Class 33: Wine	<i>The consumer will not perceive this sound as a trade mark but only as a sound connected to the goods. Therefore, it is considered non-distinctive.</i>
 SOUND MARK 35 Click on the image to reproduce	Class 9: Door bells	<i>The sound perceived in the mark can be easily connected to the goods applied for. Therefore, the mark would be considered non-distinctive.</i>

When the sound mark consists of notes, combination of notes, tunes or melodies, it will be considered non-distinctive if the sound lacks resonance and would not be recognised as an indication of commercial origin by the consumer, even if no link can be established with the goods and/or services.




Non-distinctive		
Sound marks	Goods and services	Reasoning
 SOUND MARK 36 Click on the image to reproduce	Class 12: Cars	<i>This sound consisting of one note lacks resonance and would not be recognised by the consumer as an indication of commercial origin. Therefore, the sound mark is</i>

		<i>considered non-distinctive.</i>
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When a sound mark consists of non-distinctive/descriptive/generic verbal elements pronounced in a clear manner and without any striking or unusual sound elements, the sound mark will be considered non-distinctive.


Non-distinctive		
Sound marks	Goods and services	Reasoning
 SOUND MARK 37 Click on the image to reproduce	Class 3: Washing powder	<i>The non-distinctive/descriptive verbal element perceived in the sound mark, 'Premium', is pronounced in a clear manner and without any striking or unusual sound elements. Therefore, the sound mark is considered non-distinctive.</i>
 SOUND MARK 38 Click on the image to reproduce	Class 3: Washing powder	<i>The non-distinctive/descriptive verbal element perceived in the sound mark, 'Premium Quality', is pronounced in a clear manner and without any striking or unusual sound elements. Therefore, the sound mark is considered non-distinctive.</i>

However, following the definition of a sound mark, other elements of sounds, such as lyrics, a specific melody, intonation and/or a specific way of singing may be included and perceived within the mark. In this regard, in principle, when the non-distinctive/descriptive/generic verbal element perceived in a sound mark is accompanied by other elements of sound, which are also considered non-distinctive in themselves, the sound mark will most likely be considered non-distinctive as a whole as well.

Non-distinctive		
Sound mark	Goods and services	Reasoning
 SOUND MARK 39 Click on the image to reproduce	Class 3: Washing powder	<i>The verbal elements perceived in the sound mark, 'Premium quality', are considered non-distinctive/descriptive. The addition of a singing voice is not sufficient to render the mark distinctive as a whole.</i>
 SOUND MARK 40 Click on the image to reproduce	Class 3: Washing powder	<i>The addition of a special way of intoning the verbal elements perceived in the sound, 'Premium quality', which are considered non-distinctive/descriptive in themselves, is not sufficient to render the mark distinctive as a whole.</i>
	Class 3: Washing powder	<i>The addition of a singing voice and a special jingle to the verbal</i>

<p>SOUND MARK 41</p> <p>Click on the image to reproduce</p>		<p><i>elements perceived in the sound, 'Premium quality', which are considered non-distinctive/descriptive in themselves, is not sufficient to render the mark distinctive as a whole.</i></p>
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It cannot be excluded that a particular arrangement of different elements of sounds, which is unusual and can be easily recognised as an indication of commercial origin by the consumer, could be sufficient to render a sound mark distinctive as a whole. It should be noted that the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal elements, and the scope of protection will be limited to the overall impression of the sound mark.

Distinctive		
Sound mark	Goods and services	Reasoning
<div style="text-align: center;">  <p>SOUND MARK 42</p> <p>Click on the image to reproduce</p> </div>	<p><i>Class 31: Fresh bananas</i></p>	<p><i>The verbal element, which in principle may be considered non-distinctive/descriptive in itself, is deemed not to be clearly understandable and the combination with the melody and the way in which the word is sung is sufficient to be recognised as an indication of commercial origin, and to render the sound mark distinctive as a whole.</i></p>

3.3 Motion marks

As already mentioned in the formalities part of this document, Part A, Section 1.2 – Motion marks, the definition of motion marks is not restricted to those depicting only movement. Accordingly, it is possible to qualify a sign that shows a change in the position of the elements, a change of colour or a change of elements contained in the sign as a motion mark.

3.3.1 Consumer perception - motion marks

The public's perception of the distinctiveness of motion marks will be inextricably linked to the degree to which the mark is related to the goods and services. The consumer will be more likely to see the mark as an indication of commercial origin if no link can be established between the mark and the goods and services. Consumers are accustomed to perceiving conventional types of trade mark such as word and figurative marks as indications of commercial origin. However, there is an increase in the number of signs containing motions and moving images used as part of branding strategies, therefore consumers are also more likely to perceive them as indications of commercial origin.

For the sake of analysis of consumer perception, motion marks can be grouped at least in the following ways:

- motions that may be perceived as an intrinsically functional element of the goods or services themselves, or are used to control those goods;
- motions that contain verbal elements and/or figurative elements.

Motion marks which are perceived as an intrinsically functional element of the goods or services themselves, or are used to control those goods will not generally be seen by the public as an indication of commercial origin, but merely as functional attributes.





Motions that are not associated with the goods or services could be perceived as being indications of commercial origin if the motions are not functions of, or related to, the goods or services themselves, and provided that they create a certain impression, thus engendering in the consumer a certain form of attention to be identifiable as a trade mark.

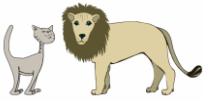
The public's perception of motion marks that contain verbal or figurative elements will depend on the addition of motion and on whether the verbal or figurative element is, due to its size and position, clearly recognisable in the sign. If no element in the sign distracts the consumer's attention from the word or the figurative element, the perception will generally be the same as that of a word mark or a figurative mark with the same element. If a link can be established between the mark and the goods and services, such marks will not be perceived as indications of commercial origin.

The way in which a consumer will perceive a mark made up of a combination of the different groups will depend on the mark itself, and any link between this and the goods and services.



3.3.2 *Inherently distinctive motion marks*

When assessing the distinctiveness of these types of trade marks, they will generally be considered distinctive if they contain a distinctive verbal and/or figurative element moving or changing its position, colour and/or elements, even though the movement or change of position itself may not be distinctive.

Distinctive		
Motion marks	Goods and services	Reasoning
 MOTION MARK 18 Click on the image to reproduce	Class 9: Computers	<i>Considering that, the motion mark contains the verbal element 'Gerivan', which is considered distinctive in itself, and although the movement itself is considered non-distinctive, the motion mark is distinctive.</i>
 MOTION MARK 19 Click on the image to reproduce	Class 9: Computers	<i>Considering that, the motion mark contains the verbal element 'Gerivan', which is considered distinctive in itself, and although the movement itself is considered non-distinctive, the motion mark is distinctive.</i>
 MOTION MARK 20 Click on the image to reproduce	Class 9: Computers	<i>The figurative element in the motion mark is considered distinctive in itself. Combined with the changing colours the consumer will perceive it as indication of commercial origin for the goods applied for.</i>
 MOTION MARK 21 Click on the image to reproduce	Class 41: Providing films for entertainment purposes	<i>The figurative element moving in the motion mark is considered distinctive in itself and the consumer will perceive it as</i>


<p>MOTION MARK 21 Click on the image to reproduce</p>		<p><i>indication of commercial origin for the services applied for.</i></p>
<p> MOTION MARK 22 Click on the image to reproduce</p>	<p><i>Class 41: Providing films for entertainment purposes</i></p>	<p><i>The different elements that appear in the mark are considered distinctive in themselves and the consumer will perceive the whole as indication of commercial origin for the services applied for.</i></p>

When the motion mark shows an element which cannot be understood or is non-identifiable, in that it does not attribute a meaning or create a link to the goods and/or services, as long as it is capable of being recognised as an indication of commercial origin by the consumer, it will be considered distinctive.

Distinctive		
Motion marks	Goods and services	Reasoning
<p> MOTION MARK 23 Click on the image to reproduce</p>	<p><i>Class 3: Washing powder</i></p>	<p><i>This motion mark contains an abstract image moving which is capable of being recognised as an indication of commercial origin by the consumer, and thus, to function as a trade mark.</i></p>
<p> MOTION MARK 24 Click on the image to reproduce</p>	<p><i>Class 36: Financial services</i></p>	<p><i>This motion mark contains an abstract image changing its form and colour which is capable of being recognised as an indication of commercial origin by the consumer, and thus, to function as a trade mark.</i></p>

3.3.3 Non-distinctive motion marks





In principle, when the motion mark consists of a movement produced by or connected to the goods and/or services, or to other relevant features thereof, it will be perceived by the consumer merely as a functional element of or for the goods and/or services. Therefore, the motion mark will be considered non-distinctive.


Non-distinctive		
Motion marks	Goods and services	Reasoning
<p> MOTION MARK 25 Click on the image to reproduce</p>	<p><i>Class 7: Chainsaws</i></p>	<p><i>The consumer will not perceive this motion as a trade mark but only a movement produced by the goods. Therefore, it is considered non-distinctive.</i></p>

When the motion mark consists of a non-distinctive/descriptive/generic verbal and/or figurative element moving or changing its position, colour and/or elements, it will be considered non-distinctive unless the movement itself is sufficient to distract the attention from the message conveyed by the non-distinctive/descriptive verbal or figurative element. In these situations, the CP3 Common Principles⁽¹⁷⁾ should be taken into account, bearing in mind that those principles will not be applicable either to the movement or to the change of position, colour and/or elements.




⁽¹⁷⁾ <https://www.tmdn.org/network/documents/10181/278891cf-6e4a-41ad-b8d8-1e0795c47cb1>

However, as in the example below marked as distinctive, it cannot be excluded that a particular movement, which in itself is unusual and striking or creates an unusual and striking visual impact, could be sufficient to render a motion mark distinctive in its overall impression. Additionally, it should be noted that the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal elements, and the scope of protection will be limited to the overall impression of the motion mark.

Non-distinctive		
Motion marks	Goods and services	Reasoning
 MOTION MARK 26 Click on the image to reproduce	Class 3: Washing powder	<i>Considering that the movement of the non-distinctive/descriptive verbal element 'Premium' is not unusual or striking, the sign is not capable of being recognised by the consumer as an indication of commercial origin. Therefore, the motion mark is considered non-distinctive.</i>
 MOTION MARK 27 Click on the image to reproduce	Class 3: Washing powder	<i>The addition of a movement is not sufficient to distract the attention from the meaning conveyed by the non-distinctive/descriptive verbal element 'Organic', therefore the motion mark is considered non-distinctive.</i>
 MOTION MARK 28 Click on the image to reproduce	Class 3: Washing powder	<i>Considering that the movement of the non-distinctive/descriptive verbal element 'Premium' is not unusual or striking, the sign is not capable of being recognised by the consumer as an indication of commercial origin. Therefore, the motion mark is considered non-distinctive.</i>
 MOTION MARK 29 Click on the image to reproduce	Class 3: Washing powder	<i>The addition of a movement is not sufficient to distract the attention from the meaning conveyed by the non-distinctive/descriptive verbal element 'Premium', therefore the motion mark is considered non-distinctive.</i>

Distinctive		
Motion mark	Goods and services	Reasoning
 MOTION MARK 30 Click on the image to reproduce	Class 3: Washing powder	<i>The addition of a particular movement to the non-distinctive/descriptive verbal element 'Eco' creates an unusual and striking visual impact, which is sufficient to render the mark distinctive as a whole.</i>

Additionally, the consumer would not perceive motion marks as indicators of commercial origin if they do not create a lasting impression on the consumer. Therefore, these would be considered as non-distinctive.

Non-distinctive		
Motion marks	Goods and services	Reasoning
 MOTION MARK 31 Click on the image to reproduce	Class 39: Travel services	<i>This motion contains too many elements to leave a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</i>
 MOTION MARK 32 Click on the image to reproduce	Class 9: Computer hardware	<i>This motion contains too many elements to leave a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</i>
 MOTION MARK 33 Click on the image to reproduce	Class 3: Washing powder	<i>The banality of the element of this motion combined with the shortness of the image that appears in the video file do not create a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</i>

3.4 Multimedia marks

As already mentioned in the formalities part of this document, Part A, Section 1.3 – Multimedia marks, a multimedia mark is a trade mark that consists of, or extends to, the combination of image and sound, any principles that are applicable to sound and motion marks will also be applicable to this type of trade mark.

3.4.1 Consumer perception - multimedia marks

The public's perception of the distinctiveness of multimedia marks will be inextricably linked to the degree to which the mark is related to the goods and services. The consumer will be more likely to see the mark as an indication of commercial origin if no link can be established between the mark and the goods and services. Consumers are accustomed to perceiving conventional types of trade mark such as word and figurative marks as indications of commercial origin. However, there is an increase in the number of signs combining image and sound used as part of branding strategies, therefore consumers are more likely to perceive them as indications of commercial origin.







Multimedia marks are composed of both sound and image elements, these can then be verbal or figurative in nature, with or without movement. The consumer would be more likely to perceive the mark as being an indication of commercial origin if neither of these elements has a link to the goods or services applied for.

If the multimedia mark contains a verbal, figurative or sound element and the consumer can establish a link between these elements and the goods and services applied for, the perception will be generally the same as for a sound mark or motion mark with the same elements. The perception of sound and image elements in a multimedia mark may vary depending on their individual components (verbal, figurative and sound).

The way in which the consumer will perceive the mark will depend on the overall combination of components and any link between these and the goods and services.



3.4.2 Inherently distinctive multimedia marks

In general, when at least one of the elements of a multimedia mark, either the sound or the image, is considered distinctive in itself, the trade mark as a whole will be considered distinctive. Additionally, it should be noted that when the multimedia mark is composed of distinctive and non-distinctive/descriptive/generic elements, the scope of protection of the mark will be limited to the overall impression of the multimedia mark and no exclusive rights will be given to the non-distinctive/descriptive elements in themselves.

Distinctive		
Multimedia marks	Goods and services	Reasoning
 MULTIMEDIA MARK 11 Click on the image to reproduce	Class 12: Cars	Both the image and the sound are considered distinctive in themselves and therefore the multimedia mark is distinctive.
 MULTIMEDIA MARK 12 Click on the image to reproduce	Class 31: Foodstuffs for animals	The combination of the stylised cat changing colours with the distinctive verbal element 'Gerivan' renders the mark distinctive.
 MULTIMEDIA MARK 13 Click on the image to reproduce	Class 31: Fresh bananas	Although the image is considered non-distinctive/descriptive in relation to the goods applied for, the combination with a distinctive verbal element, which is perceived in the multimedia mark, renders the mark distinctive.
 MULTIMEDIA MARK 14 Click on the image to reproduce	Class 12: Cars	Although the sound perceived in the multimedia mark 'Premium' will be considered non-distinctive/descriptive per se in relation to the goods applied for, its combination with a distinctive element consisting of the letters forming 'Gerivan' on the screen, renders the mark distinctive as a whole.
 MULTIMEDIA MARK 15 Click on the image to reproduce	Class 12: Cars	Although the melody perceived in the multimedia mark is considered non-distinctive in relation to the goods applied for, the combination with a distinctive image renders the mark distinctive as a whole.
 MULTIMEDIA MARK 16	Class 29: Sardines	Although the image is considered non-distinctive/descriptive in relation to the goods applied for, the combination with a distinctive

Click on the image to reproduce		<i>verbal element, renders the mark distinctive as a whole.</i>
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When the multimedia mark contains an element which cannot be understood or is non-identifiable, in that it does not convey a meaning, as long as it can be recognised by the consumer, it will be considered distinctive.

Distinctive		
Multimedia marks	Goods and services	Reasoning
 MULTIMEDIA MARK 17 Click on the image to reproduce	Class 12: Cars	<i>The combination of a melody with an abstract image changing its form and colour is capable of being recognised as an indication of commercial origin by the consumer.</i>
 MULTIMEDIA MARK 18 Click on the image to reproduce	Class 12: Cars	<i>The combination of an abstract image changing its form and position and a sound containing a verbal element which is invented, makes the mark capable of being recognised by the consumer as an indication of commercial origin.</i>

3.4.3 Non-distinctive multimedia marks



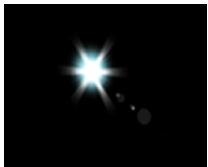
In the same manner, following the applicable principles for sound and motion marks, a multimedia mark combining non-distinctive/descriptive/generic image(s) with non-distinctive sound(s) and motion(s), will, in general, be considered non-distinctive.

In addition, when assessing distinctiveness of multimedia marks the CP3 Common Principles should be taken into account, namely when the mark contains a non-distinctive term, which includes figurative features. It should be noted that the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal elements, and the scope of protection will be limited to the overall impression of the multimedia mark.

Non- distinctive		
Multimedia marks	Goods and services	Reasoning
 MULTIMEDIA MARK 19 Click on the image to reproduce	Class 31: Fresh bananas	<i>The multimedia mark is considered non-distinctive/descriptive since it combines a non-distinctive moving image with a non-distinctive sound, which also serves to describe the quality of the goods.</i>
 MULTIMEDIA MARK 20 Click on the image to reproduce	Class 29: Sardines	<i>The multimedia mark is considered non-distinctive/descriptive since it combines a non-distinctive image with a non-distinctive sound, which also serves to describe the image itself.</i>


Additionally, the consumer would not perceive multimedia marks as indicators of commercial origin if they

do not create a lasting impression on the consumer. Therefore, these would be considered as non-distinctive.

Non-distinctive		
Multimedia marks	Goods and services	Reasoning
 MULTIMEDIA MARK 21 Click on the image to reproduce	Class 39: Travel services	<i>The visual features and the sound of this multimedia mark contain too many elements to leave a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</i>
 MULTIMEDIA MARK 22 Click on the image to reproduce	Class 9: Computer hardware	<i>The visual features and the sound of this multimedia mark contain too many elements to leave a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</i>
 MULTIMEDIA MARK 23 Click on the image to reproduce	Class 3: Washing powder	<i>The banality of the image and the sound of this sign combined with the shortness of the video do not create a lasting impression on the consumer. Therefore, it lacks inherent distinctiveness and will not be perceived as an indication of commercial origin.</i>

However, despite containing purely non-distinctive/descriptive/generic image(s) and/or sound(s), a multimedia mark can still be accepted on absolute grounds if there are other elements in the mark which contribute to render the mark distinctive as a whole.

In this regard, a multimedia mark, which contains both non-distinctive/descriptive/generic image(s) and sound(s) cannot rely solely on these elements seen in isolation. It could be possible that such a combination would allow the multimedia mark to fulfil its essential function when applied for certain goods and services, and thus render the multimedia mark distinctive as a whole. Additionally, it should be noted that the applicant will not obtain exclusive rights for the non-distinctive/descriptive verbal elements, and the scope of protection of the mark will be limited to the overall impression of the multimedia mark.

Distinctive		
Multimedia mark	Goods and services	Reasoning
 MULTIMEDIA MARK 24 Click on the image to reproduce	Class 31: Foodstuffs for animals	<i>The unusual combination of image and sound results in an overall impression, which is sufficiently distinctive as a whole.</i>

3.5 Hologram marks

As already mentioned in the formalities part of this document, Part A, Section 1.4 – Hologram marks, a hologram mark is a trade mark consisting of elements with holographic characteristics.

3.5.1 Consumer perception - hologram marks



The public's perception of the distinctiveness of hologram marks will be inextricably linked to the degree to which the mark is related to the goods and services. The consumer will be more likely to see the mark as an indication of commercial origin if no link can be established between the mark and the goods and services. However account must be taken that, consumers are more likely to be accustomed to perceiving conventional types of trade mark such as word and figurative marks as indications of commercial origin.

Hologram marks that consist exclusively of verbal and figurative elements will, generally, not be perceived as indications of commercial origin if a link can be established between the mark and the goods and services. Moreover, the assessment will depend on the holographic effect and on whether the verbal or figurative element is, due to its size and position, clearly recognisable in the sign.

The way in which the consumer will perceive the mark will depend on the overall combination of components and any link between these and the goods and services.

3.5.2 Inherently distinctive hologram marks

When the hologram mark consists of a verbal and/or a figurative element which is distinctive in itself, even if the holographic characteristics added to those elements are non-distinctive, the hologram mark will be considered distinctive as a whole, and the scope of protection of the mark will be limited to the overall impression of the hologram mark.

Distinctive		
Hologram marks	Goods and services	Reasoning
 HOLOGRAM MARK 7 Click on the image to reproduce	Class 12: Cars	<i>The combination of the distinctive verbal and figurative elements in the hologram mark makes the hologram mark distinctive as a whole.</i>
 HOLOGRAM MARK 8 Click on the image to reproduce	Class 12: Cars	<i>The combination of the distinctive verbal and figurative elements in the hologram mark makes the hologram mark distinctive as a whole.</i>

When the hologram mark shows an element which cannot be understood or is non-identifiable, in that it does not convey a meaning, or create a connection to the goods and/or services, as long as it is capable of being recognised as an indication of commercial origin by the consumer, it will be considered distinctive.

3.5.3 Non-distinctive hologram marks

When the hologram mark consists of a non-distinctive/descriptive/generic verbal and/or figurative element, it will be considered non-distinctive.

In general, the addition of a holographic effect to a non-distinctive verbal and/or figurative element will not

necessarily be sufficient to give the mark distinctive character, since it will be perceived by the consumer merely as a banal or decorative element, regardless of whether it relates to the goods and/or services applied for.

The Common Principles of CP3 should be taken into account when assessing the distinctiveness of the figurative and/or verbal elements of a hologram mark. However, those principles will not necessarily be applicable to the holographic effect itself. Therefore, in order to consider a hologram mark distinctive as a whole any non-distinctive/descriptive elements with holographic characteristics must be recognised by the consumer as an indication of commercial origin. Additionally, it should be noted that, the scope of protection of the mark will be limited to the overall impression of the hologram mark.

Non-distinctive		
Example of how a hologram would be depicted⁽¹⁸⁾	Goods and services	Reasoning
<p><i>A hologram, represented in MP4, consisting of the verbal element 'Premium' with a simple typeface, that when moved and put through proper light, appears bigger and with a different typeface.</i></p>	<p><i>Class 3: Washing powder</i></p>	<p><i>The addition of the holographic effect to the non-distinctive/descriptive verbal element 'Premium' is not sufficient to distract the attention from the meaning conveyed by the verbal element. The simple change in size and typeface will be perceived by the consumer merely as a banal and decorative element. Therefore, the hologram mark is not distinctive.</i></p>

4 New types of trade mark which may serve to describe the goods or services, or their characteristics – Article 4(1)(c) TMD

4.1 General aspects

According to Article 4(1)(c) TMD,

trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services, shall not be registered, or, if registered, shall be liable to be declared invalid.

In the same way that the general criteria for assessing distinctiveness of a traditional trade mark are applicable to new types of trade mark, the established principles to assess the descriptiveness of traditional marks or components thereof must be applied when assessing the descriptiveness of the verbal and/or figurative elements contained in a new type of trade mark.

Together with the capability of a trade mark to perform its essential function, as held by the Court, the general interest underlying Article 4(1)(c) TMD is that of ensuring that descriptive signs or indications, relating to characteristics of the goods or services in respect of which registration is sought, may be freely used by all traders offering such goods and/or services. This prevents such signs and indications from being reserved to one undertaking alone as they have been registered as trade marks. In this regard, a trade mark must offer a guarantee that all the goods or services bearing it have originated under the control

⁽¹⁸⁾ This table and the following ones in page 40, are for illustration purposes only and are presented without prejudice to the representation requirements for hologram marks as shown in the 'Common Communication on the representation of new types of trade marks'.

of a single undertaking which is responsible for their quality ⁽¹⁹⁾.

Considering the above, and according to settled case-law, any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of Article 4(1)(c) TMD must be freely available to all and is not registrable ⁽²⁰⁾.


Therefore, when assessing descriptiveness, the connection or relationship between the sign and the goods and services requested plays an important role.

Additionally, when assessing descriptiveness the public's perception as established in Part B, Section 3 of this document for each of the new types of mark has to be taken into consideration.



In the following subsections, different descriptive and non-descriptive examples in relation to the goods and/or services are shown. It should be noted that the fact that some of the examples are considered non-descriptive does not mean that an objection would not be raised to based on the other grounds of Article 4.1 TMD.

4.2 Sound marks

In general, if a link between the sound(s) perceived in the mark and the goods and services applied for or their characteristics can be easily established, the sound mark will be considered descriptive.


Descriptive		
Sound marks	Goods and services	Reasoning
 SOUND MARK 43 Click on the image to reproduce	<i>Class 31: Foodstuffs and fodder for animals</i>	<i>The link between the sound and the goods applied for can easily be made and therefore the sound mark is considered descriptive of the claimed goods.</i>

Contrary to the above, in general, when it is clear that there is no link between the sound perceived in the mark and the goods and/or services or their characteristics, the sound mark will not be considered descriptive.

Not considered descriptive		
Sound marks	Goods and services	Reasoning
 SOUND MARK 44 Click on the image to reproduce	<i>Class 11: Toilets</i>	<i>It is clear that the sound of a cow mooing does not relate in any way to the goods applied for and therefore the sound is not considered descriptive of a characteristic of the goods.</i>
 SOUND MARK 45 Click on the image to reproduce	<i>Class 25: Clothing</i>	<i>It is clear that there is no link with the goods applied for and therefore the sound is not considered descriptive of a characteristic of the goods.</i>




⁽¹⁹⁾ See 18/06/2002, C 299/99, Philips/Remington, EU:C:2002:377, § 30; 16/09/2004, C 329/02 P, SAT.2, EU:C:2004:532, § 23; joined cases of 15/03/2012, C 90/11 & C 91/11, NAI-Natur-Aktien-Index, et. al., EU:C:2012:147, § 31; 08/04/2003, C 53/01, C 54/01 & C 55/01, Linde, EU:C:2003:206, § 73, and 06/05/2003, C 104/01, Libertel, EU:C:2003:244, § 52; 12/02/2004, C 363/99, Postkantoor, EU:C:2004:86, § 54, joined cases of 04/05/1999, C 108/97 & C 109/97, Chiemsee, EU:C:1999:230, § 25.

⁽²⁰⁾ See 08/04/2003, C 53/01, C 54/01 & C 55/01, Linde, EU:C:2003:206, § 74.


 <p>SOUND MARK 46 Click on the image to reproduce</p>	<p><i>Class 39: Transportation services</i></p>	<p><i>It is clear that there is no link with the services applied for and therefore the sound is not considered descriptive of a characteristic of the services.</i></p>
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4.3 Motion marks

In general, when the element(s) in the motion mark show(s) a realistic depiction of the goods and/or services applied for, or a related process, or if a link to the goods and/or services applied for or their characteristics can be easily established, the motion mark will be considered descriptive. This is especially so when the element(s) in motion do(es) not differ from a true-to-life portrayal of the representation of those goods and/or services.

Descriptive		
Motion marks	Goods and services	Reasoning
 <p>MOTION MARK 34 Click on the image to reproduce</p>	<p><i>Class 41: DJ-services</i></p>	<p><i>Considering that the elements in the motion mark show a realistic depiction of the services applied for, it is considered descriptive of the kind of services.</i></p>
 <p>MOTION MARK 35 Click on the image to reproduce</p>	<p><i>Class 31: Fresh bananas</i></p>	<p><i>Considering that the elements in the motion mark show a realistic depiction of the goods applied for, it is considered descriptive of a characteristic of the goods.</i></p>
 <p>MOTION MARK 36 Click on the image to reproduce</p>	<p><i>Class 31: Fresh bananas</i></p>	<p><i>The movement does not add distinctiveness to the descriptive verbal element.</i></p>



However, in general, when the elements in the motion mark show an unconventional depiction of the goods and/or services applied for, or a related process differing significantly from a true-to-life portrayal of the representation of those goods and/or services, or no link with the goods and/or services can be easily established, the motion mark will not be considered descriptive.

Not considered descriptive		
Motion marks	Goods and services	Reasoning
	<p><i>Class 29: Tinned sardines</i></p>	<p><i>The motion mark is not considered descriptive of the kind of goods as, although the depiction of the sardine is banal, it is flying in space, and thus as a whole it</i></p>


<p>MOTION MARK 37 Click on the image to reproduce</p>		<p><i>differs significantly from a true-to-life representation of the goods applied for.</i></p>
<p> MOTION MARK 38 Click on the image to reproduce</p>	<p><i>Class 29: Tinned sardines</i></p>	<p><i>The motion mark is not considered descriptive of the kind of goods as the depiction of the sardine differs significantly from a true-to-life representation of the goods applied for.</i></p>


4.4 Multimedia marks

In general, when the image and sound elements of the multimedia mark, show a realistic depiction of the goods and/or services applied for, or a related process, or if a link to the goods and/or services aimed for protection or their characteristics can be easily established, the multimedia mark will be considered descriptive. This is especially so when the elements in the multimedia mark do not differ from a true-to-life portrayal of the representation of those goods and/or services.

Descriptive		
Multimedia marks	Goods and services	Reasoning
<p> MULTIMEDIA MARK 25 Click on the image to reproduce</p>	<p><i>Class 41: DJ-Services</i></p>	<p><i>The mark consists of a descriptive sound and a realistic depiction of the services in the image. Therefore, the multimedia mark is considered descriptive of the kind of services.</i></p>
<p> MULTIMEDIA MARK 26 Click on the image to reproduce</p>	<p><i>Class 31: Fresh bananas</i></p>	<p><i>The mark consists of a descriptive sound and a realistic depiction of the goods in the moving image. Therefore, the multimedia mark is considered descriptive of the kind of goods.</i></p>

Notwithstanding the above, in general, when the subject matter of the image(s) and sound(s) of the multimedia mark show an unconventional depiction of the goods and/or services applied for, or a related process, or if no link with the goods and/or services aimed for protection or their characteristics can be easily established, the multimedia mark will not be considered descriptive.

Not considered descriptive		
Multimedia marks	Goods and services	Reasoning
<p> MULTIMEDIA MARK 27 Click on the image to reproduce</p>	<p><i>Class 29: Tinned sardines</i></p>	<p><i>The multimedia mark is not considered descriptive of the kind of goods as, although the depiction of the sardine is banal, it is flying in space, and thus as a whole it differs significantly from a true-to-life representation of the goods applied for.</i></p>

 MULTIMEDIA MARK 28 Click on the image to reproduce	Class 29: Tinned sardines	<i>The multimedia mark is not considered descriptive of the kind of goods as the depiction of the sardine differs significantly from a true-to-life representation of the goods applied for.</i>
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4.5 Hologram marks

In general, when the elements in the hologram mark show a realistic depiction of the goods and/or services applied for, or if a link to the goods and/or services applied for or their characteristics can be easily established, the hologram mark will be considered descriptive.

This is especially so when the elements with holographic characteristics do not differ from a true-to-life portrayal of the representation of those goods and/or services.

Descriptive		
Example of how a hologram would be depicted	Goods and services	Reasoning
<i>A hologram, represented in MP4, displaying a regular closed wine bottle that, when moved, creates a morphed image that displays the same bottle of wine but uncorked.</i>	Class 33: Wine	<i>The mark consists of a descriptive figurative element with holographic characteristics that shows a realistic depiction of the goods applied for. Therefore, the hologram mark is considered descriptive of the kind of goods.</i>

Nevertheless, in general, when elements in the hologram mark show an unconventional depiction of the goods and/or services applied for, which differs significantly from a true-to-life portrayal of those goods and/or services, or have no connection with the goods and/or services, the hologram mark will not be considered descriptive.

Not considered descriptive		
Example of how a hologram would be depicted	Goods and services	Reasoning
<i>A hologram, represented in MP4, displaying a sardine that, when moved under proper illumination, appears moving through space.</i>	Class 29: Tinned sardines	<i>The hologram mark is not considered descriptive of the kind of goods as, although the depiction of the sardine is banal, it appears moving through space and this differs significantly from a true-to-life representation of the goods applied for.</i>

5 Signs that consist exclusively of sound, movement and a combination of image and sound, which results from the nature of the goods, can be necessary to obtain a technical result, or can give substantial value to the goods – Article 4(1)(e) TMD

According to Article 4(1)(e) TMD, ‘the following signs shall not be registered or, if registered, shall be liable

to be declared invalid: signs which consist exclusively of:

- (i) the shape, or another characteristic, which results from the nature of the goods themselves;
- (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; or
- (iii) the shape, or another characteristic, which gives substantial value to the goods.'



The main objective of this article is to prevent trade mark protection from granting an undertaking a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors ⁽²¹⁾. Accordingly, this article should prevent the exclusive and permanent rights that a trade mark confers, from serving to extend the life of other Intellectual Property rights indefinitely, such as patents or designs, which are subject to limited periods of protection ⁽²²⁾.

It cannot be excluded that a sign which consists of the shape, or other characteristics of the goods for which it is applied for, can be rejected based on Article 4(1)(b) and/or (c) TMD. However, Article 4(1)(e) TMD should be the basis of the rejection if the shape or other characteristics result from the nature of the goods, are necessary to obtain a technical result or give substantial value to the goods. This is important because if an objection to the trade mark is raised based on Article 4(1) (e) TMD, then this objection cannot be overcome by demonstrating that it has acquired distinctive character.

When assessing Article 4(1)(e)(i), (ii) and (iii) TMD, the public's perception is not a decisive element to be considered, however, it may be a useful criterion of assessment, especially when identifying, under Article 4(1)(e)(ii) and (iii), the essential characteristics of the sign in question ⁽²³⁾. Therefore, the findings regarding the consumer perception for sound, motion and multimedia marks included under Part B - Section 3 of this document may also be of relevance in the context of the examination of Article 4(1)(e)(i), (ii) and (iii) TMD. However, it is worth highlighting that in this section of the CP11 Common Practice, the interpretation and application of Article 4(1)(e) TMD will not be analysed, as this interpretation is not exclusive to new types of trade mark.

Therefore, this document will only provide some examples of sounds, movements and a combination of both, that are considered objectionable, based on different grounds of Article 4.1(e) TMD:


a) sound marks

Rejection based on Article 4(1)(e)(i) TMD		
Sound marks	Goods and services	Reasoning
 SOUND MARK 47 <small>Click on the image to reproduce</small>	Class 7: Chainsaws	<i>This sound results from the nature of the goods applied for, therefore it will be rejected based on Article 4(1)(e)(i) TMD.</i>
 SOUND MARK 48 <small>Click on the image to reproduce</small>	Class 26: Zippers	<i>This sound results from the nature of the goods applied for, therefore it will be rejected based on Article 4(1)(e)(i) TMD.</i>





⁽²¹⁾ See 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 18, 19 and 20 and 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 43 as regards Article 4.1(e)(ii) TMD.

⁽²²⁾ See 18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 18, 19 and 20 and 18/06/2002, C-299/99, Philips/Remington, EU:C:2002:377, § 30 as regards Article 4.1(e)(ii) TMD.


⁽²³⁾ See 23/04/2020, C 237/19, Gömböc Kutató, EU:C:2020:296, § 34-37 as regards Article 4.1(e)(ii) TMD and § 44-47 as regards Article 4.1(e)(iii) TMD; 18/09/2014, C 205/13, Tripp Trapp, EU:C:2014:2233, § 34; 14/09/2010, C 48/09 P, Lego brick, EU:C:2010:516, § 76; 23/04/2020, C 237/19, Gömböc Kutató, EU:C:2020:296, § 44.

Rejection based on Article 4(1)(e)(ii) TMD		
Sound mark	Goods and services	Reasoning
 SOUND MARK 49 Click on the image to reproduce	Class 9: Audio-sensitive controls for lighting apparatus	<i>This sound mark consists exclusively of the sound which is necessary to obtain a technical result and thus cannot constitute a trade mark.</i>

b) motion marks

Rejection based on Article 4(1)(e)(ii) TMD		
Motion marks	Goods and services	Reasoning
 MOTION MARK 39 Click on the image to reproduce	Class 9: Electrical switches	<i>The movement of the goods applied for is necessary to obtain a technical result, therefore it will be rejected based on Article 4(1)(e)(ii) TMD.</i>
 MOTION MARK 40 Click on the image to reproduce	Class 9: Motion-sensitive controls for lighting apparatus	<i>The movement is necessary to obtain a technical result; therefore, it will be rejected based on Article 4(1)(e)(ii) TMD.</i>
 MOTION MARK 41 Click on the image to reproduce	Class 9: Thermostats	<i>The movement of the goods applied for is necessary to obtain a technical result; therefore it will be rejected based on Article 4(1)(e)(ii) TMD.</i>
 MOTION MARK 42 Click on the image to reproduce	Class 28: Three-dimensional puzzles	<i>The movement is necessary to obtain a technical result; therefore it will be rejected based on Article 4(1)(e)(ii) TMD.</i>

c) multimedia marks

Rejection based on Article 4(1)(e)(i) TMD		
Multimedia mark	Goods and services	Reasoning
 MULTIMEDIA MARK 29 Click on the image to reproduce	Class 9: Metronomes	<i>The sound and movement are a result of the nature of the goods themselves; therefore the mark will be rejected based on Article 4(1)(e)(i) TMD.</i>

C. EXAMINATION OF RELATIVE GROUNDS FOR REFUSAL AND/OR INVALIDITY: COMMON PRINCIPLES

This part of the Common Practice delivers a set of principles and provides some criteria on the following topics:

- identity of signs;
- categories of elements for each respective new type of trade mark;
- comparison of sound marks: visual, aural and conceptual comparison between sound marks themselves and between sound marks and other types of trade mark;
- comparison of motion marks: visual, aural and conceptual comparison between motion marks themselves and between motion marks and other types of trade mark;
- comparison of multimedia marks: visual, aural and conceptual comparison between multimedia marks themselves and between multimedia marks and other types of trade mark;
- comparison of hologram marks: visual, aural and conceptual comparison between hologram marks themselves and between hologram marks and other types of trade mark.

Preliminary remarks concerning the examples

Unless specified otherwise, the following assumptions apply:

- all trade marks in the examples included below cover *clothing, footwear, headgear* in Class 25;
- the trade marks in the examples have at least a minimum level of distinctiveness;
- the earlier marks in the examples do not have an enhanced level of distinctiveness or reputation;
- where the signs contain elements that have a meaning in English, the meaning will be understood by the relevant public;
- the relevant public pronounces the written verbal elements in English.

Within each example, as a general rule, the marks at issue are found (visually/aurally/conceptually) identical, similar or dissimilar. Where in certain examples, the marks are considered to be similar to a certain extent, this means that the signs are similar, but not necessarily to a high or average degree.

1 General Aspects

The following general principles, established by the Court of Justice in respect of traditional marks, equally apply when comparing sound, motion, multimedia or hologram marks.

- ***Global appreciation of similarity based on overall impression of the signs***

A global appreciation of the visual, aural or conceptual similarity of the trade marks must be based on the overall impression given by them, bearing in mind their distinctive and dominant components⁽²⁴⁾.

The visual, aural and conceptual similarity must be assessed by evaluating the coinciding and differing elements, and their impact on the overall impression produced by the marks.

- ***Sign subject to comparison and negligible elements***

In principle, the comparison should cover the signs in their entirety.

If the only element the marks have in common is negligible in one or both of the marks in the sense that it will likely go unnoticed or be disregarded by the relevant public, the signs are dissimilar. Negligible elements must not be considered in the comparison⁽²⁵⁾.

⁽²⁴⁾ See 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23.

⁽²⁵⁾ See 12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42.

The notion of negligible elements should be strictly interpreted. Concerning the assessment as to whether an element is negligible, the test is not whether by a meticulous side-by-side examination of the signs the element concerned can be deciphered, but rather whether, in the overall impression of the sign, the element is noticeable by the average consumer who normally perceives a sign as a whole and does not proceed to analyse its various details.

- **Aspects related to the visual and aural comparison**

The visual impression of a complex sign can have an impact on the way it is pronounced, and as such on the phonetic comparison⁽²⁶⁾, due to their position, size or colour, time and moment of display, for example, certain elements in the mark will be pronounced while others will not.

- **Aspects related to the conceptual comparison**

Two signs will be considered conceptually identical or similar if they share the same or similar 'semantic content'⁽²⁷⁾. The 'semantic content' of a mark is what it means, what it evokes or, when it is an image or shape, what it represents. In this text the expressions 'semantic content' and 'concept' will be used indiscriminately.

- **Means of representation**

As previously indicated in the 'Examination of Absolute Grounds for refusal and invalidity' section, the elimination of the requirement of graphic representation from the definition of 'trade mark' given by Article 3 TMD enables representation of sound, motion and hologram marks by more than one means. Sound marks can be represented either by musical notation or by an audio file (such as an MP3 file), motion marks by a sequence of images or a video file (such as an MP4 file), and hologram marks by graphic reproduction or a video file. In such cases, the respective means of representation has no influence on the comparison of two trade marks.

2 Identity

According to established case-law, a concept which is used in different provisions of a legal measure, must, for reasons of coherence and legal certainty, and particularly if it is to be interpreted strictly, be presumed to mean the same thing, irrespective of the provision in which it appears⁽²⁸⁾.

In view of the above, the concept of identity applicable to relative grounds for refusal and to priorities must be interpreted in the same way. Therefore, a sign will be considered identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer⁽²⁹⁾. In this regard, it should be noted that an insignificant difference between two marks is defined as a difference that a reasonably observant consumer will perceive only upon side-by-side examination of the marks. Reference is therefore made to the formalities part of this document, Part A, Section 3.1 – Examination of priority claims – Identical subject matter.

3 Comparison of sound marks

3.1 Categories of elements


Sound marks consist exclusively of a sound or combination of sounds. These sounds encompass different elements that can be classified as follows:



⁽²⁶⁾ See 12/07/2011, T-374/08, TOP CRAFT, EU:T:2011:346, § 56.

⁽²⁷⁾ See 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24.



⁽²⁸⁾ See 20/02/2013, T-378/11, Medinet. EU:T:2013:83, § 41.


⁽²⁹⁾ See 20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169, § 54.

 sounds consisting of sung or spoken verbal elements;


Sound marks	
 SOUND MARK 50 Click on the image to reproduce	 SOUND MARK 51 Click on the image to reproduce

 sounds consisting of musical elements (such as melody, harmony, rhythm);

Sound marks	
 SOUND MARK 52 Click on the image to reproduce	 SOUND MARK 53 Click on the image to reproduce

 true-to-life sounds, such as the sound of a dog barking, thunder, ice cubes etc.;

Sound mark
 SOUND MARK 54 Click on the image to reproduce

 other sounds contained in a sound mark that are not covered by any of the above. Moreover, sound marks may encompass combinations of any of the above, such as:

Sound mark
 SOUND MARK 55 Click on the image to reproduce

3.2 Visual comparison

Visual comparison of a sound mark is not possible, even if the sound mark is represented 'visually' by means of musical notation, including when the musical notation contains verbal elements.

3.3 Aural comparison

Aural comparison is decisive for sound marks. Sound marks can always be aurally compared to other sound marks and to multimedia marks. Sound marks can be aurally compared to other types of marks provided that those marks consist of or contain a verbal element (e.g. word, figurative or shape marks).



Below is a non-exhaustive list of aspects, accompanied with examples, to be considered when comparing sound marks aurally, and the importance that should be usually attached to those aspects in the comparison between the signs.



- **Verbal elements**



Pronounced words may be the sole elements, or one of the elements (e.g. together with a melody), of sound marks. Sound marks may also contain no verbal elements (e.g. only a melody or only a true-to-life sound). In principle, both verbal and non-verbal elements in sound marks can produce a considerable impact on the relevant public's perception of the trade mark. However, the presence of a distinctive verbal element in a sound mark usually has a significant influence on the way the relevant public perceives the trade mark.

When comparing trade marks aurally according to established case-law of the European Courts, in the case of composite marks containing verbal and figurative elements, it is usually the verbal element that has a greater impact on the consumer's aural perception, as consumers generally refer to goods and services by their names. That case-law seems to be applicable also to sound marks containing sung or spoken words: aurally, the verbal element will generally have a greater impact on the consumer.



For this reason, the coincidence or the similarity in a distinctive verbal element usually has a greater impact on the result of the aural comparison of trade marks. Therefore, it is more likely to lead to a finding of aural similarity to a certain extent.

Earlier sound mark	Contested sound mark
 SOUND MARK 56 <small>Click on the image to reproduce</small>	 SOUND MARK 57 <small>Click on the image to reproduce</small>
<p>Reasoning: <i>despite both sound marks having different voices and intonations, the coincidence in the distinctive verbal element 'Gerivan' in both marks makes the marks aurally similar.</i></p>	



Earlier sound mark	Contested sound mark
 SOUND MARK 58 <small>Click on the image to reproduce</small>	 SOUND MARK 59 <small>Click on the image to reproduce</small>
<p>Reasoning: <i>the marks coincide in the distinctive verbal element 'Gerivan', which can be clearly heard and recognised in both marks. The marks are therefore aurally similar to a certain extent.</i></p>	

Earlier sound mark	Contested sound mark
 SOUND MARK 60 <small>Click on the image to reproduce</small>	 SOUND MARK 61 <small>Click on the image to reproduce</small>
<p>Reasoning: <i>despite the verbal elements at the beginning of both sound marks and the voices being different, and the fact that one of the marks does not contain any melody, the marks coincide in the distinctive verbal element 'Gerivan', which can be heard and recognised in both marks. The marks are therefore aurally similar to a certain extent.</i></p>	

However, similarity between two sound marks is not excluded if the verbal elements are different but the signs coincide in another distinctive aspect, especially in a melody, as in the example below:



Earlier sound mark	Contested sound mark
 SOUND MARK 62 Click on the image to reproduce	 SOUND MARK 63 Click on the image to reproduce
<p>Reasoning: <i>despite the verbal elements and voices of both marks being different, the coincidence in the same distinctive melody makes the marks aurally similar to a certain extent.</i></p>	

Furthermore, if two sound marks share a word that can be identified by a significant part of the relevant public as being the same or similar distinctive word, even if pronounced according to the rules of pronunciation of two different languages/in two different voices/in two different accents, they are in principle aurally similar to a certain extent.

Earlier sound mark	Contested sound mark
 SOUND MARK 64 Click on the image to reproduce	 SOUND MARK 65 Click on the image to reproduce
<p>Reasoning: <i>although the marks are pronounced in different voices and according to pronunciation rules of two different languages there is still an aural similarity because a significant part of the public will identify a similar distinctive word.</i></p>	

As regard the comparison of sound marks with verbal elements to other types of marks with verbal elements, the coincidence in or similarity between distinctive verbal elements, if identified as such by a significant part of the relevant public, will, in principle, lead to a finding of aural similarity. The way the verbal element is reproduced has to be taken into account. This means that while the pronunciation of a word mark is determined by the rules of pronunciation of the relevant public, this is not so in the case of a sound mark, where the aural perception is determined by how the mark sounds.



With this in mind, the degree of similarity between the coinciding verbal element in a sound mark and a different type of mark (e.g. word or figurative mark) will depend on how exactly the common element sounds in the sound mark, e.g. if the verbal element in the sound mark is sung, then the marks will be aurally similar to a certain extent, whereas if it is spoken in normal intonation following the rules of pronunciation as mentioned above, then the marks could be considered aurally at least highly similar.



Earlier figurative mark	Contested sound mark
	 SOUND MARK 66 Click on the image to reproduce
<p>Reasoning: <i>the contested mark consists of the spoken verbal element 'Gerivan'. The pronunciation of the contested sound mark does not depart from how the relevant public could pronounce the word 'Gerivan', which is at the same time the only aural element of the earlier mark. Therefore, the marks are aurally at least highly similar.</i></p>	



- **Musical elements (such as melody, harmony, rhythm)**

The presence of a distinctive melody in a sound mark has a considerable impact on the way the mark is perceived by the relevant public, and therefore considerably influences the aural comparison of such a mark.



As a general rule, a different instrument, tempo or rhythm will not prevent two marks from being found similar, provided that the melody itself, being a rhythmic succession of tones, is identical or can be identified as being the same melody, as illustrated in the below examples.



Earlier sound mark	Contested sound mark
 SOUND MARK 67 Click on the image to reproduce	 SOUND MARK 68 Click on the image to reproduce
<p>Reasoning: <i>both sound marks consist of the same distinctive melody. Therefore, they are aurally similar irrespective of the fact that they are performed on two different instruments.</i></p>	

Earlier sound mark	Contested sound mark
 SOUND MARK 69 Click on the image to reproduce	 SOUND MARK 70 Click on the image to reproduce
<p>Reasoning: <i>both sound marks consist of the same distinctive melody performed on the same instrument. Therefore, they are aurally similar irrespective of the variation in the rhythm.</i></p>	



Earlier sound mark	Contested sound mark
 SOUND MARK 71 Click on the image to reproduce	 SOUND MARK 72 Click on the image to reproduce
<p>Reasoning: <i>both sound marks consist of the same distinctive melody. Therefore, they are aurally similar irrespective of the fact that they are played in two different tempos.</i></p>	

Furthermore, two melodies are similar when they contain variations which are not capable of significantly modifying the overall phonetic impression.



Earlier sound mark	Contested sound mark
 SOUND MARK 73 Click on the image to reproduce	 SOUND MARK 74 Click on the image to reproduce
<p>Reasoning: <i>despite the slight variation in the melody in the contested mark, both marks are aurally similar.</i></p>	

Earlier sound mark	Contested sound mark
 SOUND MARK 75 Click on the image to reproduce	 SOUND MARK 76 Click on the image to reproduce
<p>Reasoning: <i>although the melody in both marks is composed of the same sequence of notes, the rhythm and harmony are different and create a different overall phonetic impression. Therefore, the marks are aurally dissimilar.</i></p>	



Nevertheless, two marks containing different melodies performed on the same instrument are normally aurally dissimilar.

Earlier sound mark	Contested sound mark
 SOUND MARK 77 Click on the image to reproduce	 SOUND MARK 78 Click on the image to reproduce
<p>Reasoning: <i>the distinctive melodies in the marks are different. The fact that they are played on the same instrument cannot make the marks aurally similar. The marks are aurally dissimilar.</i></p>	

The coincidence or similarity in a distinctive melody usually has a considerable impact on the result of the aural comparison of the trade marks, even if one of the marks also contains a verbal element or both of them contain a different verbal element. Therefore, coincidence or similarity in the melody is more likely to lead to a finding of aural similarity to a certain extent, depending, inter alia, on the degree of distinctiveness of such a melody and the degree of distinctiveness of the verbal element.

Earlier sound mark	Contested sound mark
 SOUND MARK 79 Click on the image to reproduce	 SOUND MARK 80 Click on the image to reproduce
<p>Reasoning: <i>despite the verbal elements and voices of both marks being different, the coincidence in the same distinctive melody makes the marks aurally similar to a certain extent.</i></p>	



It should be borne in mind that due to the nature of the different types of trade mark, the possibility of coincidence in the melody only exists for multimedia marks, as they are the only other type of trade mark containing sound.



Earlier sound mark	Contested multimedia mark
 SOUND MARK 81 Click on the image to reproduce	 MULTIMEDIA MARK 30 Click on the image to reproduce
<p>Reasoning: <i>both marks contain the same distinctive melody and voice. Therefore, as there are no additional sound elements, the marks are aurally identical.</i></p>	

- **True-to-life sounds**

Coincidence in or similarity of distinctive true-to-life sounds, in sound or multimedia marks, generally leads to a finding of aural similarity. The similarity will depend on, among other aspects, whether there are other distinctive elements present in one of the marks or in both marks.

Earlier sound mark	Contested sound mark
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 SOUND MARK 82 Click on the image to reproduce	 SOUND MARK 83 Click on the image to reproduce
<p>Reasoning: both sound marks consist exclusively of the sound of a dog or dogs barking. Therefore, as the barking of the dogs sounds similar, the marks are aurally similar to a certain extent.</p>	

Earlier sound mark	Contested sound mark
 SOUND MARK 84 Click on the image to reproduce	 SOUND MARK 85 Click on the image to reproduce
<p>Reasoning: both sound marks consist exclusively of the sound of birds. Nevertheless, the sounds those birds make are so different that they make the marks aurally dissimilar.</p>	

Aural similarity of true-to-life sounds is assessed by taking into account the same elements and aspects as previously discussed (tones, rhythm, or other aspects). As previously mentioned in the case of melodies, multimedia marks are the only other type of mark that may contain the same or a similar true-to-life sound as those contained in sound marks.

- **Other aspects**

The mere coincidence in other aspects such as the intonation, voice, etc. in two trade marks usually has a lower impact on the aural comparison of the trade marks, even if those aspects contribute to a certain degree to the mark's distinctive character.

Earlier sound mark	Contested sound mark
 SOUND MARK 86 Click on the image to reproduce	 SOUND MARK 87 Click on the image to reproduce
<p>Reasoning: the marks are composed of two different distinctive words pronounced in the same voice and intonation. The latter is not enough to find the marks aurally similar. The marks are aurally dissimilar.</p>	

The particularities of the comparison between sound marks and motion or multimedia marks will be further detailed in the respective sections for motion marks⁽³⁰⁾ and multimedia marks⁽³¹⁾.



3.4 Conceptual comparison



A conceptual comparison between two sound marks and between sound marks and other types of mark can be made in cases where a concept can be identified.

If a sound mark contains verbal elements, their meaning will have to be taken into account when determining the concept of the trade mark. In the example below, the conceptual comparison will be made between the (distinctive) concepts of 'banana' and 'potato'.



⁽³⁰⁾ See Part C - Section 4 – Comparison of motion marks.

⁽³¹⁾ See Part C - Section 5 – Comparison of multimedia marks.

Earlier sound mark	Contested sound mark
 SOUND MARK 88 Click on the image to reproduce	 SOUND MARK 89 Click on the image to reproduce
<p>Reasoning: <i>the verbal elements in the marks have different meanings, namely 'banana' and 'potato'. Therefore, the marks are conceptually dissimilar.</i></p>	



Earlier sound mark	Contested sound mark
 SOUND MARK 90 Click on the image to reproduce	 SOUND MARK 91 Click on the image to reproduce
<p>Reasoning: <i>both marks contain the same distinctive verbal element 'banana'. Therefore, the marks are conceptually identical.</i></p>	

Similarly, if a trade mark contains a true-to-life sound, its meaning will have to be taken into account when determining the concept of the sound mark.

Earlier sound mark	Contested sound mark
 SOUND MARK 92 Click on the image to reproduce	 SOUND MARK 93 Click on the image to reproduce
<p>Reasoning: <i>both marks consist exclusively of the reproduction of a cow mooing and although the sound is different, the concept is identical.</i></p>	

Sound marks merely containing melodies are unlikely to have a concept.

Bearing in mind the abovementioned principle that a sound mark can be conceptually compared to another type of trade mark when a concept can be identified, in the example below, the conceptual comparison made between the earlier sound mark and the contested figurative mark will consider the concept of 'bananas'.

Earlier sound mark	Contested figurative mark
 SOUND MARK 94 Click on the image to reproduce	
<p>Reasoning: <i>the earlier mark consists of the pronunciation of the verbal element 'Bananas', whereas the contested mark consists of an image of bananas. Therefore, the trade marks are conceptually identical.</i></p>	

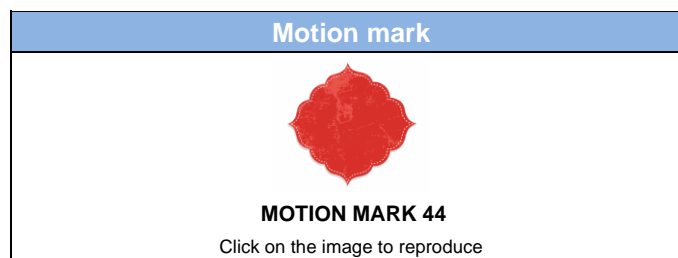
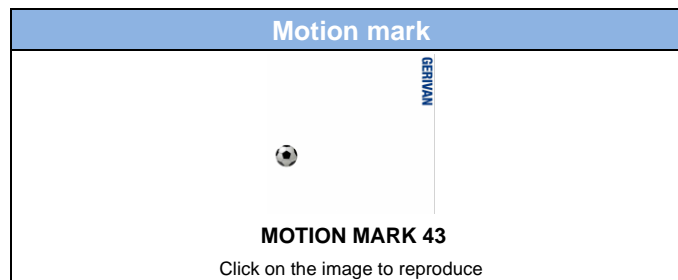
4 Comparison of motion marks

4.1 Categories of elements

A motion mark is a mark consisting of, or extending to, a movement or a change in the position (and/or

colour(s)) of the element(s) of the mark ⁽³²⁾. It encompasses combinations of different elements that can be classified as follows:

- verbal elements;
- figurative elements;
- the movement or transformation of the verbal and/or figurative elements.



4.2 Visual comparison

When comparing two motion marks visually, the coincidence in or similarity between the elements present in the trade marks (the verbal and/or figurative elements, and the movement or transformation of those elements) has to be considered.

Motion marks can also be compared visually to other types of trade mark, with the exception of sound marks.

The verbal and/or figurative elements might appear only for certain amount of time in the representation of the mark and then disappear or be transformed into another element. With this in mind, elements that lead to similarity between the signs, must appear for a sufficient amount of time to enable them to be perceived/recognised by the consumer.

Below is a non-exhaustive list of aspects, accompanied by examples, to be considered (if applicable) when comparing motion marks visually, and the importance that should be usually attached to those aspects in the comparison between the signs.



- **Verbal elements**

The general criteria for comparing word or figurative marks containing verbal elements are applicable.



Motion marks containing distinctive verbal element(s) are likely to be visually similar to another motion mark which contains the same or a similar distinctive verbal element. Distinctive verbal element(s) contained in a motion mark can have a stronger impact on the consumer than other visual elements (i.e. figurative elements, movement or other change itself), although, the comparison has to consider the entirety of the

⁽³²⁾ See Part A – Section 1.2. - Motion marks.

signs.

Earlier motion mark	Contested motion mark
 MOTION MARK 45 Click on the image to reproduce	 MOTION MARK 46 Click on the image to reproduce
<p>Reasoning: <i>the motion marks coincide in the distinctive verbal element 'Gerivan', which is clearly recognisable in both marks. Therefore, the marks are visually similar.</i></p>	



When two trade marks of different type (e.g. word, figurative, shape, multimedia marks) coincide in the same or similar distinctive verbal elements, in principle, the signs will be considered as visually similar to a certain extent, even though aural elements might also be included (e.g. in a multimedia mark).

Earlier motion mark	Contested multimedia mark
 MOTION MARK 47 Click on the image to reproduce	 MULTIMEDIA MARK 31 Click on the image to reproduce
<p>Reasoning: <i>both marks contain a visual element that consists of the verbal element 'Gerivan' following this sequence: GE-RI-VAN Gerivan, and identical colours. Although the speed in which the letters appear is different, the marks are visually similar.</i></p>	

- **Figurative elements**



Coincidence or similarity in a distinctive figurative element can also lead to a finding of a degree of visual similarity between the signs. This will be the case especially if the coinciding or similar figurative element is separately recognisable or has the same or a similar contour.

In such a case similarity is likely to be found, in particular, when on account of its size, position within the mark and/or colour, the figurative element can be perceived by the consumer to a sufficient extent, considering, in particular, that it is subject to movement/transformation. The difficulty in appreciating moving/transforming elements in a motion mark is a factor that must be considered in assessing the degree of visual similarity.

Earlier motion mark	Contested motion mark
 MOTION MARK 48 Click on the image to reproduce	 MOTION MARK 49 Click on the image to reproduce
<p>Reasoning: <i>both motion marks contain the same figurative element with a similar motion. Therefore, despite the contested motion mark containing a distinctive verbal element, the marks are visually similar.</i></p>	

The coincidence in the same distinctive figurative element in motion and other types of trade marks (e.g. word, figurative, shape, multimedia marks) may lead to a finding of a certain degree of visual similarity between the signs, depending on the presence or not of other elements that distract attention from that



distinctive figurative element in the mark.

Earlier figurative mark	Contested motion mark
	 MOTION MARK 50 Click on the image to reproduce
<p>Reasoning: both marks share the same cartoon character of a dog. Therefore, the marks are visually similar to a certain extent, despite the fact that the contested mark contains a motion.</p>	



- **The movement or transformation of elements**

o **Movement of elements**



The mere coincidence in a banal motion/movement in itself will not lead to visual similarity.

Earlier motion mark	Contested motion mark
 MOTION MARK 51 Click on the image to reproduce	 MOTION MARK 52 Click on the image to reproduce
<p>Reasoning: the marks only coincide in a banal movement, whereas the distinctive verbal elements of both signs are different. Therefore, the marks are visually dissimilar.</p>	

However, it cannot be excluded that a particular movement which is striking and distinctive could be sufficient to render motion marks visually similar to some extent despite them having other differing elements, such as verbal elements.

Earlier motion mark	Contested motion mark
 MOTION MARK 53 Click on the image to reproduce	 MOTION MARK 54 Click on the image to reproduce
<p>Reasoning: although the verbal elements are different in each mark, the marks are visually similar, given the coinciding striking movement and the similar figurative impression of the cluster of pixels.</p>	



The coincidence or difference in the sequence (order of appearance) of elements has a low impact on the comparison of the motion marks.

Earlier motion mark	Contested motion mark
 MOTION MARK 55 Click on the image to reproduce	 MOTION MARK 56 Click on the image to reproduce
<p>Reasoning: both marks consist of different verbal elements appearing from the last letter to the first one. The coincidence in the order of appearance is not sufficient to overcome the dissimilarity in the verbal elements. Therefore, the marks are visually dissimilar.</p>	

○ **Transformation of elements**

Apart from the movement of elements, motion marks may also consist of any other transformation of elements, such as a change in colours or any other transformation of an element into another. Therefore, these changes should be taken into account when assessing visual similarity of trade marks.

The mere coincidence in the change of position or change of colours in itself will usually have a lower impact on the comparison of trade marks, and will not, in principle, lead to a finding of visual similarity.



Earlier motion mark	Contested motion mark
 MOTION MARK 57 Click on the image to reproduce	 MOTION MARK 58 Click on the image to reproduce
<p>Reasoning: <i>the coinciding colour changing sequence does not outweigh the impact of the different figurative elements in the marks. Therefore, the marks are visually dissimilar.</i></p>	



4.3 Aural comparison

Motion marks which do not contain any verbal elements, cannot be aurally compared. In the same way, motion marks cannot be aurally compared to other types of trade mark which do not contain verbal elements, either in the image or pronounced.

When motion marks contain verbal elements that can be perceived, they can be aurally compared with the same or other types of marks that can be subject to a phonetic assessment. The general criteria for comparing word or figurative marks containing verbal elements are applicable.



The presence of a distinctive verbal element in a motion mark usually has a significant influence on the way the relevant public aurally perceives the motion mark. It follows that the coincidence in or the similarity in a distinctive verbal element usually will have an impact on the result of the aural comparison of motion marks with other motion marks or with other types of marks, making it more likely to lead to a finding of aural similarity to a certain extent.

Earlier motion mark	Contested motion mark
 MOTION MARK 59 Click on the image to reproduce	 MOTION MARK 60 Click on the image to reproduce
<p>Reasoning: <i>both motion marks consist of the same distinctive verbal element, namely 'Gerivan'. Therefore, the marks are aurally identical.</i></p>	

Earlier motion mark	Contested motion mark
 MOTION MARK 61 Click on the image to reproduce	 MOTION MARK 62 Click on the image to reproduce

Reasoning: both motion marks consist of different distinctive verbal elements, namely 'FRED' and 'Gerivan'. Therefore, the marks are aurally dissimilar.



When two trade marks of different types (e.g. word, figurative, shape, multimedia, and hologram marks) coincide in the same or similar distinctive verbal element, in principle, they will be considered as aurally similar to a certain extent.

Earlier figurative mark	Contested motion mark
	 MOTION MARK 63 <small>Click on the image to reproduce</small>

Reasoning: both marks contain the distinctive verbal element 'Gerivan'. Therefore, the marks are aurally identical.

Earlier sound mark	Contested motion mark
 SOUND MARK 95 <small>Click on the image to reproduce</small>	 MOTION MARK 64 <small>Click on the image to reproduce</small>

Reasoning: although the marks consist of different verbal elements, 'Gerivan' and 'Berivan', the pronunciation is similar for the English-speaking public. Therefore, the marks are aurally similar.

Earlier motion mark	Contested multimedia mark
 MOTION MARK 65 <small>Click on the image to reproduce</small>	 MULTIMEDIA MARK 32 <small>Click on the image to reproduce</small>

Reasoning: the earlier motion mark contains the distinctive verbal element 'Gerivan', and the sound of the contested multimedia mark consists of the same verbal element 'Gerivan' being pronounced. Therefore, the marks are aurally at least highly similar.


Earlier motion mark	Contested multimedia mark
 MOTION MARK 66 <small>Click on the image to reproduce</small>	 MULTIMEDIA MARK 33 <small>Click on the image to reproduce</small>

Reasoning: the earlier motion mark contains the distinctive verbal element 'GERIVAN' written, and the sound of the contested multimedia mark consists of the same verbal element 'Gerivan' being sung and repeated three times. Therefore, the marks are aurally similar to a certain extent.

4.4 Conceptual comparison



A conceptual comparison between two motion marks and between motion marks and other types of mark can be made in cases where a concept can be identified.

If a motion mark contains verbal and/or figurative elements that have a concept, their meaning will have to be taken into account when determining the concept of the trade mark. The movement or transformation of the elements of a motion mark, in itself, is unlikely to have a concept. It follows that if the elements making up the motion mark lack any concept, the movement or transformation of the elements itself is unlikely to convey any concept on that mark.



Earlier word mark	Contested motion mark
<p>BANANA</p>	 <p>MOTION MARK 67 Click on the image to reproduce</p>
<p>Reasoning: the earlier mark consists of the verbal element 'Banana'. The contested motion mark consists of the verbal element 'Banana' in motion. The concept of both marks is 'banana'. Therefore, both marks are conceptually identical.</p>	

However, the movement could reinforce, add or, in some cases, alter the concept of the element subject to movement.



In combination with the element, the movement may reinforce the concept of that element.

Earlier figurative mark	Contested motion mark
	 <p>MOTION MARK 68 Click on the image to reproduce</p>
<p>Reasoning: the figurative mark consists of a still image of a basketball player throwing a ball, whereas the motion mark consists of the same basketball player throwing the ball in motion. The combination of the element with the motion reinforces the initial concept of 'basketball player throwing a ball'. Therefore, the marks are conceptually identical.</p>	

In combination with the element, the movement may add a concept to the initial concept of the element.

Earlier figurative mark	Contested motion mark
	 <p>MOTION MARK 69 Click on the image to reproduce</p>
<p>Reasoning: the concept of the figurative mark is 'elephant' or 'cartoon of an elephant'. The combination of this cartoon with the dancing motion, adds a concept to the initial one, 'cartoon of a dancing elephant'. Therefore, the marks are conceptually similar to a certain extent.</p>	

In combination with the element, the movement may alter the concept of the element.

Earlier figurative mark	Contested motion mark
	 MOTION MARK 70 Click on the image to reproduce
<p>Reasoning: <i>the figurative mark is a depiction of a hand, whereas the motion mark is a hand making a gesture which means 'so-so' in several EU countries. Therefore, the combination of the hand with the movement alters the initial concept 'hand' and the marks are conceptually dissimilar.</i></p>	

5 Comparison of multimedia marks

5.1 Categories of elements

Multimedia marks are trade marks consisting of, or extending to, the combination of image and sound. Therefore, in this type of trade mark two categories of elements can be identified:

- visual elements (graphically depicted verbal elements, figurative elements and movement or transformation of the verbal and/or figurative elements ⁽³³⁾);
- sound elements (sung or spoken verbal elements, musical elements, true-to-life sounds and other sounds ⁽³⁴⁾).

The factor that makes multimedia marks unique is the interaction between images and sounds and the possible impact that one has on the other. This aspect may influence the comparison between these signs.

The criteria established for the comparison of sound and motion marks may serve as a basis for the comparison of multimedia marks but the possible interaction between the visual and aural aspects should also be considered.

5.2 Visual comparison

Multimedia marks can always be compared visually to other multimedia marks. With regard to visual comparison, the principles for the visual comparison of motion marks generally apply.

Similarly, multimedia marks can be compared visually to other types of trade mark except sound marks.

Below is a non-exhaustive list of aspects, accompanied with examples, to be considered (if applicable) when comparing multimedia marks visually.



- **Graphically depicted verbal elements**

In principle, there is a degree of visual similarity between two multimedia marks that share the same or similar distinctive graphically depicted verbal elements (static or subject to motion).


Earlier multimedia mark	Contested multimedia mark
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⁽³³⁾ See Part C – Section 4.1. – Categories of elements (Motion marks).

⁽³⁴⁾ See Part C – Section 3.1. – Categories of elements (Sound marks).



 MULTIMEDIA MARK 34 Click on the image to reproduce	 MULTIMEDIA MARK 35 Click on the image to reproduce
<p>Reasoning: both multimedia marks share an identical depiction of the verbal element 'Gerivan'. Although the earlier mark also contains a figurative element subject to motion, the marks are visually similar to a certain extent.</p>	

When a multimedia mark and a different type of mark (e.g. word, figurative, shape, hologram marks) coincide in the same or similar distinctive graphically depicted verbal elements, in principle, the signs will be considered as visually similar to a certain extent.

Earlier word mark	Contested multimedia mark
BANANA	 MULTIMEDIA MARK 36 Click on the image to reproduce
<p>Reasoning: the earlier word mark contains only one distinctive verbal element 'BANANA', whereas the contested multimedia mark consists of a video showing the verbal element 'banana' in motion and a sound. The coincidence in the distinctive verbal element 'banana', leads to a finding of visual similarity.</p>	



- **Figurative elements**

In principle, there is a degree of visual similarity between two multimedia marks that share the same or similar distinctive figurative elements (static or subject to motion).

Earlier multimedia mark	Contested multimedia mark
 MULTIMEDIA MARK 37 Click on the image to reproduce	 MULTIMEDIA MARK 38 Click on the image to reproduce
<p>Reasoning: both multimedia marks consist of an identical depiction of a cow's face opening its mouth, with different graphically depicted verbal elements. Therefore, the marks are visually similar to a certain extent.</p>	

If a multimedia mark and a different type of mark (e.g. word, figurative, shape, hologram marks) share the same or similar distinctive figurative elements (static or subject to motion), in principle, the signs will be considered as visually similar to a certain extent.

Earlier figurative mark	Contested multimedia mark
-------------------------	---------------------------

	 MULTIMEDIA MARK 39 Click on the image to reproduce
<p>Reasoning: <i>the earlier mark consists of an image of a stylised dog, whereas in the contested mark the same dog appears moving around, jumping and barking. The fact that the dog in the contested mark is subject to motion is not sufficient to distract the attention from the dog. Therefore, the marks are visually similar.</i></p>	

5.3 Aural comparison

The principles as established in this document for the aural comparison of sound and motion marks, will generally apply to multimedia marks.



Multimedia marks can always be compared aurally to other multimedia marks and to sound marks. Moreover, multimedia marks can be aurally compared to other types of marks provided that those marks consist of or contain a verbal element (e.g. a verbal element in a figurative or shape mark).

In principle, both sung or spoken verbal elements and graphically depicted verbal elements in a multimedia mark are subject to a phonetic assessment. The sung or spoken verbal elements may influence the phonetic perception of the graphically depicted verbal elements.

Regardless of whether there is a coincidence between the compared marks in one of their elements, the overall impression of the multimedia mark, including the graphically depicted verbal elements and the sound, will be considered when performing the aural comparison between the signs.

- **Verbal elements**
 - o **Graphically depicted verbal elements**

In principle, there is a degree of aural similarity if a multimedia mark contains a distinctive graphically depicted verbal element (static or subject to motion), which coincides in or is similar to a verbal element of another mark (both sung or spoken or graphically depicted where applicable).

Earlier multimedia mark	Contested multimedia mark
 MULTIMEDIA MARK 40 Click on the image to reproduce	 MULTIMEDIA MARK 41 Click on the image to reproduce

Reasoning: *although the musical elements of the marks are different, both marks will be referred to with the graphically depicted verbal element 'Gerivan'. Therefore, they are aurally similar to a certain extent.*

Earlier sound mark	Contested multimedia mark
 SOUND MARK 96 Click on the image to reproduce	 MULTIMEDIA MARK 42 Click on the image to reproduce


Reasoning: *the verbal element in the earlier sound mark is spoken and in the contested multimedia mark it is graphically depicted. Since the relevant English-speaking public will pronounce the graphically depicted element in the multimedia mark similarly to how the earlier trade mark sounds, the marks are aurally similar to a certain extent.*

○ **Sung or spoken verbal elements**

In principle, there is a degree of aural similarity if the sung or spoken verbal element of the multimedia mark coincides in or is similar to another verbal element perceived in another mark (both sung or spoken or graphically depicted where applicable).

Earlier multimedia mark	Contested multimedia mark
 MULTIMEDIA MARK 43 Click on the image to reproduce	 MULTIMEDIA MARK 44 Click on the image to reproduce

Reasoning: *despite the difference in the pronunciation, intonation and voice of the distinctive verbal element 'Gerivan', which is spoken in the earlier mark and sung in the contested mark, the marks are aurally similar.*

Earlier motion mark	Contested multimedia mark
 MOTION MARK 71 Click on the image to reproduce	 MULTIMEDIA MARK 45 Click on the image to reproduce

Reasoning: *in the earlier mark, the word 'Gerivan' is graphically depicted, in the contested multimedia mark it is only sung. The sound of the verbal element as heard in the contested mark is similar to the English pronunciation of the graphically depicted verbal element 'Gerivan' in the earlier mark. The marks are aurally similar to a certain extent.*

○ **Combination of graphically depicted and sung or spoken verbal elements**

As stated above, multimedia marks can also contain both sung or spoken and graphically depicted verbal elements.

In such a case, both the sung or spoken and graphically depicted verbal elements have to be taken into account in the aural comparison.



Moreover, where a graphically depicted verbal element is accompanied by a sung or spoken verbal element, the latter could affect the pronunciation of the graphically depicted verbal element. However, depending on the particular case, it cannot be excluded that the graphically depicted verbal element in a multimedia mark will still be pronounced according to the pronunciation rules of the corresponding relevant public.



Earlier word mark	Contested multimedia mark
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GERIVAN	GERIVAN MULTIMEDIA MARK 46 Click on the image to reproduce
<p>Reasoning: <i>the earlier word mark consists of the verbal element ‘Gerivan’, which will be pronounced according to the rules of pronunciation of the relevant English-speaking public, whereas the contested multimedia mark consists of a graphically depicted verbal element ‘Gerivan’ combined with the sound representation of the same verbal element pronounced in Spanish. In this case, the possibility that the English-speaking public might pronounce the verbal element in the contested mark according to the English pronunciation rules should be taken into account, despite the fact that the contested mark contains the sound of ‘Gerivan’ pronounced in Spanish. The marks are aurally similar to a certain extent.</i></p>	



- **Musical elements and true-to-life sounds**

The possibility of coincidence in the melody or true-to-life sounds only exists with multimedia and sound marks, as they are the only types of trade mark that may contain such sounds.

Earlier multimedia mark	Contested multimedia mark
 MULTIMEDIA MARK 47 Click on the image to reproduce	 MULTIMEDIA MARK 48 Click on the image to reproduce
<p>Reasoning: <i>both marks coincide in the same distinctive melody. Although both multimedia marks contain different figurative elements, they do not have an impact on the aural comparison. Therefore, the marks are aurally identical.</i></p>	



Earlier sound mark	Contested multimedia mark
 SOUND MARK 97 Click on the image to reproduce	 MULTIMEDIA MARK 49 Click on the image to reproduce
<p>Reasoning: <i>both marks coincide in the same distinctive melody. Although the contested multimedia mark also contains a graphically depicted verbal element and a figurative element, the marks are aurally similar to a certain extent.</i></p>	


Earlier multimedia mark	Contested multimedia mark
 MULTIMEDIA MARK 50 Click on the image to reproduce	 MULTIMEDIA MARK 51 Click on the image to reproduce
<p>Reasoning: <i>both marks coincide in the same distinctive melody. Although the marks also contain graphically depicted verbal elements whose phonetic perception will be different, the marks are aurally similar to certain extent.</i></p>	

Earlier sound mark	Contested multimedia mark
 SOUND MARK 98 Click on the image to reproduce	 MULTIMEDIA MARK 52 Click on the image to reproduce
Reasoning: <i>both marks coincide in the same true-to-life sound. Therefore, the marks are aurally identical.</i>	

5.4 Conceptual comparison

In principle, multimedia marks can have a concept. Therefore, in a similar approach to that applied to motion and sound marks, multimedia marks can be compared conceptually as long as a concept is conveyed. When assessing the mark conceptually, attention should also be given to the interaction of the sound and visual elements as this might influence the global impression and/or meaning of the mark. When comparing a multimedia mark, in specific circumstances, the influence of an aural element could change how a sign is perceived conceptually.

Earlier figurative mark	Contested multimedia mark
	 MULTIMEDIA MARK 53 Click on the image to reproduce
Reasoning: <i>both marks convey the concept of 'banana'. Therefore, they are conceptually identical.</i>	

Earlier word mark	Contested multimedia mark
ALARM	 MULTIMEDIA MARK 54 Click on the image to reproduce
Reasoning: <i>the earlier mark consists of the verbal element 'ALARM', and the contested mark as a whole conveys a similar concept. Therefore, the marks are conceptually at least similar.</i>	

6 Comparison of hologram marks

When performing an assessment of similarity of hologram marks, the main specificity that characterises them is the holographic effect. However, it does not have any special impact on the mark that would require particular attention when assessing similarity. Therefore, the established principles for traditional marks and motion marks should be also applicable when assessing similarity between hologram marks or between hologram marks and other types of trade mark.

6.1 Categories of elements

Hologram marks are marks consisting of elements with holographic characteristics. Three categories of elements can be identified in hologram marks:



- verbal elements;
- figurative elements;
- the holographic effect.

6.2 Visual comparison

When performing visual comparison between hologram marks, the coincidence in or similarity between the elements present in the trade marks (the verbal and/or figurative elements, and the holographic effect) has to be considered.



In a hologram mark, movement or transformation in the representation of the mark only serve to show the holographic effect and only the latter has to be taken into account in the visual comparison.

As far as the holographic effect is concerned, an identical or similar holographic effect in itself will normally not lead to a finding of visual similarity, unless similarity can be found in the verbal or figurative elements of the signs under comparison. Two signs can be visually similar because of coinciding or similar distinctive verbal or figurative elements, even though there is a different holographic effect.

Earlier hologram mark	Contested hologram mark
 HOLOGRAM MARK 9 Click on the image to reproduce	 HOLOGRAM MARK 10 Click on the image to reproduce

Reasoning: *the marks contain the same verbal element 'Gerivan' and a very similar figurative element. Therefore, the marks are visually similar.*

Hologram marks can be compared visually to other types of trade mark, with the exception of sound marks.

Earlier motion mark	Contested hologram mark
 MOTION MARK 72 Click on the image to reproduce	 HOLOGRAM MARK 11 Click on the image to reproduce

Reasoning: *both marks consist of a circle with the same colour combination and the same distinctive verbal element 'Gerivan' in the middle. Despite the earlier mark including motion, and the contested mark containing a holographic effect, the marks are visually similar.*



6.3 Aural comparison



Hologram marks which do not contain any verbal elements cannot be aurally compared.

When hologram marks contain verbal elements, they can be aurally compared with the same or other types of mark that can be subject to a phonetic assessment. The general criteria for comparing word or figurative marks containing verbal elements are applicable.

Earlier hologram mark	Contested hologram mark
 HOLOGRAM MARK 12	 HOLOGRAM MARK 13

Click on the image to reproduce	Click on the image to reproduce
Reasoning: <i>the marks contain the same verbal element 'Gerivan' and are therefore aurally identical.</i>	

Earlier figurative mark	Contested hologram mark
	 HOLOGRAM MARK 14 Click on the image to reproduce
Reasoning: <i>the marks contain the same verbal element 'Gerivan' and are therefore aurally identical.</i>	

Earlier sound mark	Contested hologram mark
 SOUND MARK 99 Click on the image to reproduce	 HOLOGRAM MARK 15 Click on the image to reproduce
Reasoning: <i>despite the possible difference in the pronunciation of the verbal element 'Gerivan' and the fact that it is sung in the earlier mark and graphically depicted in the contested mark, the marks are aurally similar to a certain extent.</i>	

6.4 Conceptual comparison

Conceptual comparison between two hologram marks and between a hologram mark and other type of marks can be performed in cases where a concept can be identified.

If a hologram mark contains verbal elements and/or figurative elements, their meaning will have to be taken into account when determining the concept of the trade mark.