



Manual on Descriptiveness of Marks in Absolute Grounds in (selected) CARIFORUM IP Offices



CARIFORUM



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Manual on Descriptiveness of Trade Marks in Absolute Grounds

 <p>BELIPO BELIZE INTELLECTUAL PROPERTY OFFICE</p>	Belize Intellectual Property Office	BZ
	Corporate Affairs and Intellectual Property Office of Barbados	BB
 <p>OCPI OFICINA CUBANA DE LA PROPIEDAD INDUSTRIAL</p>	Cuban Industrial Property Office	CU
 <p>ONAPI</p>	The Dominican Republic National Office of Industrial Property (Oficina Nacional de la Propiedad Industrial)	DO
	The Deeds and Commercial Registries Authority of Guyana	GY
 <p>JIPO Jamaica Intellectual Property Office</p>	Jamaica Intellectual Property Office	JM
 <p>IPOSKN THE INTELLECTUAL PROPERTY OFFICE OF ST. KITTS & NEVIS</p>	Intellectual Property Office of St. Kitts and Nevis	KN
 <p>REGISTRY OF COMPANIES AND INTELLECTUAL PROPERTY Saint Lucia</p>	Registry of Companies & Intellectual Property of Saint Lucia	LC
 <p>Commerce & Intellectual Property Office</p>	Commerce & Intellectual Property Office of St. Vincent and the Grenadines	VC
 <p>BIE BUREAU INTELLECTUELE EIGENDOM</p>	Intellectual Property Office of Suriname (Bureau Intellectuele Eigendom)	SR
	Trinidad and Tobago Intellectual Property Office	TT

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1. BACKGROUND

This Manual has been prepared in the framework of the CARIFORUM Intellectual Property and Innovation Project, and is aimed to provide guidance for trade mark applicants and examiners, on descriptiveness of trade marks in examination of absolute grounds.

IP Registries/Offices (hereinafter referred to as Offices) of the following countries subscribe to this practice:

- Belize
- Barbados
- Cuba
- The Dominican Republic
- Guyana
- Jamaica
- St Kitts and Nevis
- Saint Lucia
- St. Vincent and Grenadines
- Suriname
- Trinidad and Tobago

The information contained in this document relates to practical aspects of examination procedures only and is NOT intended to give advice on the scope of protection of a trade mark under national law.

The document constitutes a reference to guide applicants and examiners, and the use of it results in increased transparency, certainty, and predictability of trade mark application procedures.

It will be made widely available and will be easily accessible, providing a **clear and comprehensive explanation of the principles on which the manual is based.**

These principles will be generally applied and aimed at covering the large majority of the cases. Descriptiveness must be assessed on a case-by-case basis, with the common principles serving as guidance in order to ensure that different offices on the same grounds come to a similar, predictable outcome.

2. SCOPE

A trade mark registration provides the exclusive right to its right holder to prevent others from using a trade mark for the goods and services applied for, for an unlimited period of time.

Marks with certain characteristics will be refused registration. One of the grounds of refusal is related to descriptiveness of the mark. A mark will be refused as descriptive when its meaning is immediately perceived by the relevant public as providing information about the goods and services applied for.

The public interest is that no exclusive rights should be created in purely descriptive terms which other traders might wish to use as well.

It is also in the interest of the public that terms which have a purely informational value should not be reserved for one single trader.

The scope of this manual is to provide a practical guidance concerning descriptiveness of trade marks in absolute grounds of examination.

3. DESCRIPTIVENESS OF TRADE MARKS IN ABSOLUTE GROUNDS FOR REFUSAL

3.1. General remarks

3.1.1. The notion of descriptiveness

Where the sign provides information about, inter alia, the quantity, quality, characteristics, purpose, kind and/or size of the goods or services it will be refused registration as a descriptive sign. There should be sufficiently direct and specific as well as concrete link between the term and the goods and services applied for and the relevant public should perceive it as descriptive immediately, without further reflection. Descriptive marks are at the same time non-distinctive.

It is irrelevant to show that there is already a descriptive use of the mark by applicant or competitors and that competitors are already affected using the mark. Therefore, if a mark applied for is considered as descriptive, it will be refused registration even if the applicant is the only producer or potential producer of the applied for goods and services.

3.1.2. Characteristics

The term 'characteristic' applies to a property, which is immediately perceived by the relevant public in connection to applied for goods and services. A sign will be refused registration only if it is recognised by the relevant public as a description of one of those characteristics.

Kind of goods and services

This applies to the type and nature of the goods and services.

For example:

- 'bank' for financial services¹,
- 'semi-sweet' for wines and sparkling wines
- 'dictionary' for dictionaries

Quality

This applies to both laudatory terms, referring to a superior quality of the applied for goods and services, as well as the inherent quality of the goods or services.

For example:

- 'super light', 'premium', 'fresh', 'extra slim' for goods that can be extremely light, high quality, fresh or extremely slim
- '365' for availability of the services for the whole year
- '4x4' for a four-wheel drive vehicles

Quantity

This includes references to the quantity in which the goods could be sold.

For example:

- '12' for eggs

¹ VC is not aligned with this example

- 'one litre' for drinks,
- '1000' (grams) for sugar and rice

In this regard only quantity measurements that are used in trade will be considered. For example, 555 777 for chocolates would be acceptable.

Intended purpose

The intended purpose refers to the function of a product and service. Namely, intended use of the goods and services applied for.

For example:

- 'silky hair' for shampoos and hair products,
- 'fit body' for fitness training apparatus, sport activities
- 'trustedlink' for IT services

Value

This applied both the (high or low) price of the applied for goods and services, as well as the value in quality.

For example: 'extra', 'top', 'cheap', 'more for your money'.

Geographical origin

See paragraph 3.2.7 below.

Time of production of the goods or of rendering of the service

This covers expressions concerning the time at which services are rendered.

For example:

- 'morning news', '24 hours', '24/7',
- '1998', 'late vintage' for wine (time at which goods are produced if relevant for the goods)².

Other characteristics

Generally any characteristic of the goods and services should be considered as a ground for a refusal.

For example:

- the subject matter contained within the goods and services applied for;
- the identification of the targeted consumer: 'adults' for medicines or 'she' for clothing.

3.1.3. Irrelevant arguments

Arguments used by applicants that are not relevant for the case should not be considered and taken into consideration during the registration procedure of the mark.

² LC and SR are not aligned with these examples

3.1.3.1. Term not used

It is irrelevant whether the term applied for is already used in a descriptive manner. For the assessment of the descriptiveness, possible use of the sign in respect of the applied for goods and services should be taken into consideration.

3.1.3.2. Need to keep free

Arguments that the term applied for is not used by competitors or they can use other synonyms and more direct and straightforward indications to describe the respective characteristics of the goods are quite common and should not be taken into consideration.

3.1.3.3. Factual monopoly

The fact that the applicant is the only person offering the goods and services for which the mark is descriptive is irrelevant.

3.1.3.4. Double meaning

Applicants argument that the terms applied for have more than one meaning, one of them not being descriptive for applied for goods and services is irrelevant. If at least one of the possible meanings of the term is descriptive in relation to the goods and services applied for the term will be considered descriptive.

For example:

- 'Date' is descriptive for Dating Services (Class 45) even though it refers as well to a specific day.

3.2. Word Marks

3.2.1. One word

As mentioned above descriptive terms merely consist of information about the characteristics of the goods and services and they cannot fulfil the function of a trade mark. Consequently, the ground for refusal applies irrespective of whether a term is already used by other competitors in a descriptive manner for the goods and services at issue.

In particular a sign is descriptive if the public (general or specialised) considers that the word has a descriptive meaning for the goods and services in question.

- The term 'RESTORE', is descriptive for surgical and medical instruments and apparatus;

However, it is important to distinguish laudatory terms that describe desirable characteristics of goods and services as being cheap, convenient, of high quality, etc. and that are excluded from registration, from those terms that are laudatory in a broader sense and refer to vague positive connotations or to the person of the purchaser or producer of the goods without specifically referring to the goods and services themselves.

- 'BRAVO', will not be considered as descriptive, as it is unclear who says 'BRAVO' to whom, and what is being praised.

3.2.2. Combinations of words³

As a general rule, several descriptive terms combined do not necessarily render the sign distinctive.

However, if due to the **unusual nature of the combination** in relation to the goods or services, a combination creates an **impression that is sufficiently far removed** from that produced by the mere combination of meanings lent by the elements of which it is composed, that combination will be considered **more than the sum of its parts**. When the way in which the two descriptive elements are combined is in itself fanciful, the sign is not descriptive.

The following examples will be considered as descriptive:

- ‘CLEARWIFI’ is descriptive for Telecommunication services
- ‘Biomild’ for yoghurt being mild and organic
- ‘Companyline’ for insurance and financial affairs
- ‘Trustedlink’ for software for e-commerce, business consulting services, software integration services and education services for e-commerce technologies and services
- ‘GREENWORLD’ for, inter alia, gas fuels, fuels, electric power, gas for lighting, retail services in the areas of fuels, transmission and transport of electrical energy, heat, gas or water
- ‘ecoDOOR’ for products on which doors have a significant impact, such as dishwashers, washing machines, vending machines, apparatus for cooking

The following example has been **accepted for** registration:

- ‘GREENSEA’ is not descriptive for bleaching preparations

Combinations not following grammatical rules

A combination of words will be considered as descriptive even if it does not follow the usual grammatical rules. If, however, the combination is unusual and is not the mere sum of its parts, it may be accepted.

- ‘HIPERDRIVE’ is considered descriptive of the intended purpose of setting devices for tools, despite the misspelling of the adjective ‘hyper’ as ‘hiper’
- ‘CARBON GREEN’ is descriptive for reclaimed rubber, namely, recycled carbonaceous materials, namely plastic, elastomeric, or rubber filled materials obtained from pyrolysed tire char and plastic, elastomeric, or rubber compounds formulated using such filler material, even though adjectives precede nouns in English

Omission of definite articles and pronouns (the, it, etc.), conjunctions (or, and, etc.) or prepositions (of, for, etc will sometimes not be sufficient to make the mark distinctive.

Combinations of adjectives + nouns or verbs

For combinations consisting of **nouns and adjectives**, it should be assessed whether the meaning of the combination changes if its elements are inverted. For example, ‘Vacations direct’ is tantamount to ‘direct vacations’, whereas ‘BestPartner’, is not the same thing as ‘PartnerBest’.

³ GY and TT are not aligned with the examples in this section

The same reasoning applies to words consisting of the **combination of an adjective and a verb**. Therefore, the word 'ULTRAPROTECT' must be considered descriptive for sterilising and sanitary preparations, even though it consists of the combination (grammatically incorrect) of an adjective (ULTRA) with a verb (PROTECT), since its meaning remains clearly understandable.

3.2.3. Misspellings and omissions

The misspelling of a descriptive term does not necessarily render a sign distinctive.

It is quite common that the consumers misspell the words in slang.

The following examples will be considered as descriptive⁴:

- 'Xtra' for detergents⁵
- 'Rely-able' for banking services⁶

Furthermore, consumers will, without further mental steps, understand the '@' as the letter 'a' or the word 'at' and the '€' as the letter 'e'. Consumers will replace specific numerals by words, for example, '2' as 'to' or '4' as 'for'.

However, if the misspelling is fanciful and/or striking or changes the meaning of the word the sign is acceptable.

As a rule, misspellings endow the sign with a sufficient degree of distinctive character when:

- they are striking, surprising, unusual, arbitrary and/or;
- they are capable of changing the meaning of the word element or require some mental effort from the consumer in order to make an immediate and direct link with the term that they supposedly refer to.

The following examples will be considered as distinctive:

- 'LINQ' for mobile communication services
- 'LIQID' for parfums

3.2.4. Abbreviations and acronyms

Abbreviations of descriptive terms are descriptive if the public recognises them as identical to the full descriptive term:

The following examples will be considered as descriptive:

- 'TDI' as an acronym of turbo diesel intercooler
- 'LIMO' as an abbreviation of limousine

⁴ JM is not aligned with the examples

⁵ CU, KN and LC are not aligned with this example

⁶ KN, LC, TT and VC are not aligned with this example

Internet database 'AcronymFinder.com' should be used carefully as a reference base. It is advisable to use technical reference books or scientific literature, for example, in the field of computing. Alternatively, use of the abbreviation by a number of traders in the appropriate field on the internet is sufficient to substantiate actual use of the abbreviation.

3.2.5. Terms describing subject matter in goods and services

Where a sign consists of a word that describes the subject matter or content of the goods or services, it is descriptive.

The following examples will be considered as descriptive:

- 'History' is descriptive for education⁷
- 'CAR' is descriptive for magazines

3.2.6. Slogans

A slogan will be considered descriptive when it immediately conveys the kind, quality, intended purpose or other characteristics of the goods or services.

The descriptiveness of slogans should be assessed in the same way as for the other types of word marks.

The following examples will be considered as descriptive:

- 'FIND YOUR WAY' for satellite navigation systems, as the expression it is clearly intended to inform the relevant consumer that the appellant's goods help consumers to identify geographical locations in order to find their way⁸.
- 'BUILT TO RESIST' for footwear could have only one possible meaning namely that the goods are manufactured to last and are, therefore, tough and resistant to wear and tear.

3.2.7. Geographical terms⁹

A geographical term is every existing name of a place, for example a country, region, city, lake or river etc. List of geographical terms is not exhaustive, and it could be any place that conveys a connotation of geographical location or of geographical provenance. Adjectival forms are not sufficiently different from the original geographical term. For example, 'German' will still be perceived as referring to Germany, and 'French' will still be perceived as referring to France. The same applies to the outdated terms such as 'Ceylon', 'Bombay' and 'Burma' if they are generally understood by consumers as a designation of origin.

⁷ LC is not aligned with this example

⁸ SR is not aligned with this example

⁹ GY, KN, LX are not aligned with the practice of this subparagraph

The registration of geographical names as trade marks is not possible where such a geographical name is either already famous, or is known for the category of goods concerned, and is therefore associated with those goods or services in the mind of the relevant class of persons, or it is reasonable to assume that the term may, in view of the relevant public, designate the geographical origin of the category of goods and/or services concerned.

As with all other descriptive terms, it should be assessed whether the geographical term describes objective characteristics of the goods and services applied for.

The descriptive character of the geographical term may relate to:

- the place of production of the goods;
- the place where the goods were conceived and designed;
- the place where the services are rendered;
- the place that influences consumer preferences (e.g. lifestyle) by eliciting a favourable response.

The following two-step assessment must be carried out when assessing geographical names as trade marks.

First step: term is understood by the relevant public as a geographical name.

The first step in assessing the descriptiveness of a geographical term is to determine whether it is understood as such by the relevant public.

Second step: determine whether the term either (a) designates a place that is currently associated with the goods and services or (b) may be reasonable to assume that it will be associated with those goods or services in the future or whether such a name may, in the mind of the relevant public, designate the geographical origin of that category of goods or services.

The following factors should be taken into consideration while determining if such association exists:

- the degree of familiarity with the geographical term;
- the characteristics of the place designated by the term;
- the category of goods or services.

Geographical names that designate specified geographical locations that are already famous or are known for the category of goods or services concerned, and associated with that category in the mind of the relevant public should be refused registration as trade marks.

For example:

- 'Paris' should be refused for clothing
- 'Frankfurt' for financial services

- 'Islas Canarias' for sightseeing, tour guide and excursion services and
- 'Switzerland' for banking services, cosmetic products, chocolate and watches

It is not necessary to establish that the name actually designates the true geographical origin of the goods. It is enough to demonstrate that the connection between the name of the place and the goods may enable the relevant public to perceive that the contested sign is an indication of the origin of those goods.

3.2.8. Descriptive Single letters¹⁰

Single letters will be considered as descriptive if they convey sufficiently precise information about the goods and services applied for.

For example, the letters 'S', 'M' or 'L' for clothing would give rise to an objection as these letters are used to describe a particular size of clothing, namely as abbreviations for 'Small', 'Medium' or 'Large'.

However, if it cannot be established that a given single letter is descriptive for the goods and services applied for, the sign should be registered.

3.2.9. Numerals¹¹

A numeral may be registered as a trade mark only if it is distinctive for the goods and services applied for and is not merely descriptive or otherwise non-distinctive for those goods and services.

The following examples will be considered as descriptive:

- '1000' is descriptive for Puzzles
- '20' for cigarettes

However, where the numeral does not appear to have any possible meaning for the goods and services, it is acceptable.

The following examples will be considered as distinctive:

- '212' is not descriptive for Perfumes
- '555' for financial services
- '333' for clothing

¹⁰ BB, BZ, LC, VC, SR are not aligned with the examples in this section

¹¹ GY, LC, SR are not aligned with examples in this section

3.2.10. Names of colours¹²

Name of colours can be single colour names (e.g. red, green), compound colour names (e.g. navy blue, blood red) or more unusual colour names such as names of flowers, or gemstones (e.g. magnolia, emerald, amethyst, alabaster) and combination of colour associated with another noun (e.g. flamenco red, crystal pink, vintage rose, Bermuda blue).

A sign consisting of a name of a colour is descriptive when the colour constitutes an objective, intrinsic and permanent characteristic of the goods/services or is inherent to their nature.

The following examples will be considered as descriptive:

- 'BLUE' in relation to cheese, as it describes a specific kind of cheese.
- 'GREEN' in relation to tea, describes a specific kind of tea
- 'BROWN' in relation to sugar describes the colour and kind of sugar.

The following examples will be considered as distinctive:

- 'BLUE' is relation to Oranges as it does not describe a specific kind of oranges

When the goods for which protection is sought concern colourants such as paint, ink, dyes or cosmetics (e.g. lipsticks or make-up), the name of a colour may describe the actual colour of the goods, and signs consisting exclusively of a colour name should be objected as descriptive, as the names of colours would not be seen as trade marks but merely as indications of the principal characteristic of the goods.

3.2.11. Names of banks, newspapers/magazines, and airports¹³

In some fields (e.g. banks, newspapers, magazines, airports), consumers are used to recognise descriptive combinations of terms as marks. It is the case for example of a sign that describes a single entity that is the only one to offer the respective goods and services.

- 'BANK OF ENGLAND' is not descriptive for banking services

3.2.12. INN codes¹⁴

International non-proprietary names (INNs) are assigned to pharmaceutical substances by the World Health Organisation (WHO), so that each substance can be recognised by a unique name. These names are needed for the clear identification, safe prescription and dispensing of medicines, and for communication and exchange of information among health professionals. INNs can be used freely because they are in the public domain, for example: alfalcaldio, calcifediol, calcipotriol.

¹² LC is not aligned with this section

¹³ BB, BZ, CU, VC, SR, TT are not aligned with this section

¹⁴ KN is not aligned with the practice of this section

Stems define the pharmacologically related group to which the INN belongs. INN stems serve to indicate the mode of action of groups of drugs. These stems and their definitions have been selected by WHO experts and are used when selecting new international non-proprietary names, for example: 'calci'.

International non-proprietary names (INNs) and stems will be considered descriptive as they are in the public and should be used freely.

Considering the descriptive nature of INN codes and stems, an objection should be raised for class 5 goods in the following scenarios:

- where the trade mark application is an INN (the general rules on misspellings also apply);
- where an INN appears within a trade mark application and the other elements of the application are descriptive/non-distinctive too (for instance 'BIO', 'PHARMA', 'CARDIO', 'MED', 'DERMA');
- where the trade mark application consists only of a stem

A list of INN codes can be accessed after online registration on MedNet (<https://mednet-communities.net>). A list of common stems is available at the following link: http://www.who.int/medicines/services/inn/StemBook_2011_Final.pdf.

3.3. Figurative Marks¹⁵

3.3.1. Assessment of the figurative threshold

Where a figurative mark consists exclusively of a basic natural form that is not significantly different from a true-to-life portrayal that serves to indicate the kind, intended purpose or other characteristic of the goods or services, it should be considered as descriptive of a characteristic of the goods and services applied.

Figurative element may give distinctive character to a sign consisting of a descriptive/non-distinctive word element. Therefore, the question to be considered is whether the stylisation and/or the graphical features of a sign are sufficiently distinctive for the sign to act as a badge of origin.

When a figurative mark contains purely descriptive/ non-distinctive words, it must be observed if the figurative element renders sufficient distinctive character. In order to determine if the threshold of distinctiveness is met due to the figurative features in the mark, the following criteria should be taken into consideration:

- word elements such as typeface and font, combination with colour, punctuation marks and/or other symbols, or how the words are placed (sideways, upside-down, etc.);

¹⁵ The criteria and examples in this section are taken from [EUIPN Common Practice 3: Common Communication on Distinctiveness – Figurative Marks Containing Descriptive/Non-Distinctive Words](#)

- figurative elements such as the use of simple geometric shapes, the position and proportion (size) of the figurative element(s) in relation to the word elements, or whether the figurative element is a representation of, or has direct link with, the goods and/or services, and whether the figurative element is commonly used in trade for the goods and/or services applied for;
- both word and figurative elements and how combinations of the criteria affect distinctiveness.

3.3.1.1. Word elements in a mark

3.3.1.1.1. Typeface and font

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

Non-distinctive examples:

SIGN	CASE	GOODS AND SERVICES
Fresh Sardine	CP3 example	Class 29: Sardines
<i>Fresh Sardine</i>	CP3 example	Class 29: Sardines
FrEsh SaRdine	CP3 example	Class 29: Sardines
<u>Flavour and aroma</u>	CP3 example	Class 30: Coffee

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

Distinctive examples¹⁶:

SIGN	CASE	GOODS AND SERVICES
<i>flavour and aroma</i>	CP3 examples	Class 30: coffee

¹⁶ CU and VC are not aligned this the examples

SIGN	CASE	GOODS AND SERVICES
	CP3 example	Class 20: Kits of parts for assembly into furniture

3.3.1.1.2. Combination with colour

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

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



Non-distinctive examples:

SIGN	CASE	GOODS AND SERVICES
 ¹⁷	CP3 examples	lass 30: coffee
	CP3 examples	lass 30: coffee

3.3.1.1.3. Combination with punctuation marks and other symbols

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

Non-distinctive examples:

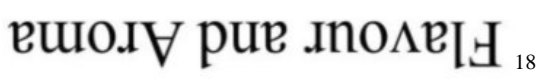
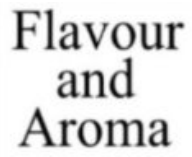
SIGN	CASE	GOODS AND SERVICES
	CP3 example	Class 29: sardines
	CP3 example	Class 30: coffee

3.3.1.1.4. Position of the word elements (sideways, upside-down, etc.)

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

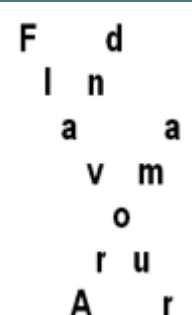
¹⁷ LC is not aligned with this example

Non-distinctive examples:

SIGN	CASE	GOODS AND SERVICES
	CP3 examples	Class 30: coffee
	CP3 examples	Class 30: coffee

However, the way in which the word elements are positioned can add distinctive character to a sign when the arrangement is of such a nature that the average consumer focuses on it rather than immediately perceiving the descriptive message.

Distinctive example:

SIGN	CASE/EUTM N°	GOODS AND SERVICES
	CP3 examples	Class 30: coffee

3.3.1.2. Figurative elements (word element(s) and additional figurative element(s))

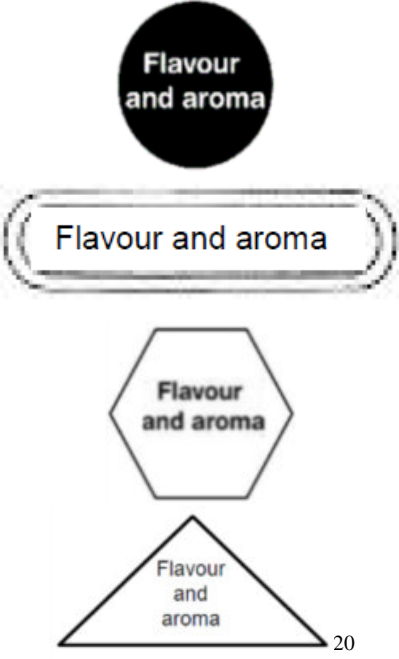
3.3.1.2.1. Use of simple geometric shapes

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

¹⁸ SR is not aligned with this example


¹⁹ SR and VC are not aligned with this example

Non-distinctive examples:

SIGN	CASE	GOODS AND SERVICES
 <p>20</p>	CP3 examples	Class 30: coffee

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

Distinctive example:

SIGN	CASE/EUTM N°	GOODS AND SERVICES
 <p>21</p>	CP3 examples	Class 30: coffee



3.3.1.2.2. Position and proportion (size) of the figurative element in relation to the word element

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


²⁰ JM is not aligned with the examples

²¹ LC is not aligned with this example

Non-distinctive examples:

SIGN	CASE	GOODS AND SERVICES
	CP3 example	Class 29: sardines
	CP3 example	Class 30: coffee

Distinctive example:



SIGN	CASE/EUTM N°	GOODS AND SERVICES
 Flavour and aroma	CP3 example	Class 30: coffee

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


A figurative element is considered to be descriptive and/or devoid of distinctive character whenever:

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


Non-distinctive examples²²:

SIGN	CASE	GOODS AND SERVICES
 From the sea to your plate	CP3 example	Class 29: sardines
 Fresh Sardine	CP3 example	Class 29: sardines

Distinctive examples:



SIGN	CASE	GOODS AND SERVICES
 Fresh Sardine	CP3 example	Class 29: sardines

²² LC is not aligned with the examples

SIGN	CASE	GOODS AND SERVICES
 <p>23</p>	CP3 example	Class 29: sardines

A figurative element that does not represent the goods and services but has a direct link with the characteristics of the goods and services will not render the sign distinctive unless it is sufficiently stylised.


Non-distinctive examples:

SIGN	CASE	GOODS AND SERVICES
 <p>24</p>	CP3 example	Class 37: Pest control services
	CP3 example	Class 37: Pest control services

3.3.1.2.4. The figurative element is commonly used in trade in relation to the goods and/or services applied for

In general, figurative elements that are commonly used or customary in trade in relation to the goods and/or services claimed do not add distinctive character to the mark as a whole.


Non-distinctive examples:

SIGN	CASE	GOODS AND SERVICES
 <p>25</p>	CP3 example	Class 30: coffee

²³ DO, LC and VC are not aligned with the example

²⁴ TT is not aligned with the example

²⁵ SR is not aligned with this example

SIGN	CASE	GOODS AND SERVICES
<p>LEGAL ADVICE SERVICES</p> 	CP3 example	Class 45: Legal services

3.3.1.3. Word and figurative elements (stylised word elements and additional figurative element(s))

In general, a combination of figurative and word elements, which if considered individually are devoid of distinctive character, does not give rise to a distinctive mark. Nevertheless, a combination of such elements when considered as a whole could be perceived as a badge of origin due to the presentation and composition of the sign. This will be the case when the combination results in an overall impression that is sufficiently far removed from the descriptive/non-distinctive message conveyed by the word element.

3.4. Descriptiveness for other types of marks²⁶

In this section, it will be discussed descriptiveness for other types of marks, particularly sound marks, motion marks, multimedia marks and hologram marks.

As a general principle, 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.


3.4.1. Sound marks²⁷

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. To the contrary, 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.

Descriptive examples:

²⁶ The criteria and examples in this section are taken from [EUIPN Common Practice 11: Common Communication on the Common Practice on New Types of Marks: Examination of Formal Requirements and Grounds for Refusal](#)

²⁷ This section does not apply to BB, BZ, CU, GY, KN, LC, SR, VC, as sound marks are not protected in these jurisdictions.


SIGN	GOODS AND SERVICES	REASONING
 Click on the image to reproduce Sound of barking dog CP11 example	Class 31: Foodstuffs and fodder for animals	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

3.4.2. Motion marks²⁸

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.

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.

Descriptive example:

SIGN	GOODS AND SERVICES	REASONING
 Click on the image to reproduce CP11 example	Class 31: Fresh bananas	The movement does not add distinctiveness to the descriptive verbal element

3.4.3. Multimedia marks²⁹


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.

²⁸ This section does not apply to BB, BZ, CU, GY, KN, LC, SR, VC, as motion marks are not protected in these jurisdictions.

²⁹ This section does not apply to BB, BZ, CU, GY, KN, LC, SR, VC, as multimedia marks are not protected in these jurisdictions.

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.

Non-descriptive examples:

SIGN	GOODS AND SERVICES	REASONING
 <p>Click on the image to reproduce CP11 example</p>	<p>Class 29: Tinned sardines</p>	<p>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.</p>

3.4.4. Hologram marks³⁰

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.

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.

³⁰ This section does not apply to BB, BZ, CU, GY, KN, LC, VC, as hologram marks are not protected in these jurisdictions.

ANNEX I – LEGAL REFERENCES

COUNTRY	TM LAW	Article(s) related to descriptiveness
Belize	Trade Marks Acts	35 (a) (b)
Barbados	Trade Marks Act	Sections 6, 8, 9 and 48
Cuba	Trade Mark Law	16.1 (c)
Dominican Republic	Industrial Property Law of the Dominical Republic	73 (1)(c)
Guyana	Trade Marks Act	11 (1) (e)
Jamaica	The Trade Marks Act	11 (1) (c)
St Kitts and Nevis	Marks, Collective Marks and Trade Names Act	4 (a)
St Lucia	Trade Marks Act	25
St. Vincent and the Grenadines		
Suriname	Regulations of Industrial Property	2.1
Trinidad and Tobago	The Trade Marks Act No. 8 of 2015	8 (1) (c)