QUESTIONS 92 C AND 96

Absolute grounds of refusal of registration of trademarks

What may constitute a registrable trademark?

Yearbook 1989/II, pages 309 - 317  Q92 C, Q96
Executive Committee of Amsterdam, June 4 - 10, 1989

Question Q92 C and Q96

Q92: Absolute grounds of refusal of registration of trademarks
Q96: What may constitute a registrable trademark?

Resolution

AIPPI
- having studied the question of which signs may be registered as trademarks,
- observing that national law and practice show a number of differences in respect to this question,
- observing that national laws, which are similar or even identical, and international conventions have in practice been subjected to differing interpretations,
- observing that the national groups of a number of countries consider future development of law and practice as desirable;
- observing that very recently an effort towards harmonisation has been made by the twelve countries of the European Community having different laws and practice, in the form of the so-called „Council Directive of December 21, 1988 to approximate certain aspects of the law of the member states relating to trademarks“(Official Journal of the European Community, February 11, 1989), and that there exists a draft Council Regulation on the Community Trademark of 1988 and that consequently such important documents should be taken into account;
- observing that the registrability of trademarks is a subject of continuing evolution;
- believing that the rules concerning absolute grounds of refusal listed in Article 6 quinquies of the Paris Convention could constitute a model for the international harmonisation of trademark law.

takes the following position:
A. Absolute Grounds for refusal of registration of trademarks

AIPPI believes that:

1. whilst great attention should be given to eliminating undue restrictions upon trademark owners as to the absolute grounds of refusal of registration of trademarks, there is a need for the public and undertakings in general to use signs which are common to a specific trade, industry, product or service, that the public should not be misled by the trademark, and that under specific conditions (immoral marks, public order, „flags“, etc.) the registration of certain signs should be forbidden.

2. countries which have strict rules as to absolute grounds of refusal of registration of trademarks should look at those countries where the rules are more relaxed to see whether problems have in practice arisen in those countries due to their being more relaxed.

3. legal terminology can have a different significance from one country to another and consequently such terminology should be defined and examples be given to illustrate such definitions as far as possible.

4. for word marks most of the criteria of registrability are closely linked with the language, national or foreign, and that as language and its knowledge can evolve, so can these criteria.

I. Absence of distinctive character

AIPPI observes that:

5. most countries agree that the main function of the trademark is to distinguish goods and services of one undertaking from the goods and services of another undertaking, and that the distinctive character is relative in the sense that it must be evaluated in relation to the goods and services to which the trademark is applied.

AIPPI believes that:

6. a sign is distinctive when, to those to whom it is addressed, it is recognised as identifying goods or services from a particular trade source, or is capable of being so recognised.

7. the distinctive character can evolve and, consequently, that by taking appropriate measures it can be acquired or increased and that by inappropriate conduct it can diminish and possibly disappear.
8. a trademark which has little distinctive character enjoys a narrower scope of protection than a trademark which has a strong distinctive character.

9. different categories of trademarks and registers should not be created depending on degrees of distinctiveness.

10. when a composite trademark contains non-distinctive words, or elements in the case of a device trademark, the applicant may be asked to disclaim such words or elements of his trademark.

1. Absence of requirement of novelty and originality.

AIPPI believes that:

11. the distinctive character of a trademark is not to be confused with its novelty and originality, neither of which is a condition of distinctiveness.

12. simple signs, which are commonplace or lack originality, should not be excluded per se from registration.

13. distinctiveness can result from the presentation of a sign that otherwise lacks it.

2. Signs that cannot be monopolised

AIPPI confirms that:

14. the trademark law cannot permit the monopolisation of certain signs that must be free in order to permit the public and undertakings, to designate a product or a service or describe its characteristics. These signs are:

a. necessary signs
b. generic signs
c. signs in common use
d. exclusively descriptive signs

a. The sign must not be necessary

AIPPI observes that:

15. a sign is necessary when the use thereof is required to identify the designated goods or services or when the use thereof is imposed by nature or function;

16. when the sign is a word it is necessary when its use is required by the rules of the language;

17. when the sign is a device it is necessary when it exactly represents the goods or services identified thereby.
AIPPI believes that:

18. a sign which is necessary cannot enjoy a distinctive character and consequently cannot function as a trademark;

19. if such a sign is a word, however, it can have or acquire distinctive character if it is a deformation of an existing word such as a misspelling or abbreviation, or if the existing word is contained in the trademark;

20. if such a sign is a device it can have or acquire distinctive character by its manner of presentation.

b. The sign must not be generic:

AIPPI observes that:

21. a sign is generic when it defines a category or a type to which the goods or services belong.

AIPPI believes that:

22. the criteria which have been laid down for necessary signs should be applied to generic signs.

c. The sign must not be in common use

AIPPI observes that:

23. a sign in common use is one which is not imposed by the requirements of the language but is generally and habitually used to identify the goods or services (for instance colloquial words);

24. the terms „in common use“ and „generic“ are often used one for another, but in reality their significance is different.

AIPPI believes that:

25. a sign can be considered as being in common use if it is used generally and habitually by the public, and the public can either be, taking into consideration the kind of goods or services involved:
   - the general public
   - a substantial part of the public
   - the consumers involved
   - the undertakings involved

26. the criteria which determine whether and from which moment a word has become commonly used are purely factual;

27. a sign in common use may cease to have that character and become registrable.
d. The sign must not be exclusively descriptive:

AIPPI believes that:

28. a term is descriptive if it consists 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 services, or other characteristics of the goods or services;

29. a sign consisting exclusively of a descriptive element should not be registrable as a trade mark;

30. a sign consisting exclusively of descriptive elements should be registrable if the combination is distinctive;

31. a sign consisting of a distinctive element combined with one or more descriptive elements is registrable;

32. evocative signs should be capable of registration.

3. Acquisition and loss of distinctive character

AIPPI observes that:

33. a great diversity exists in the different countries with respect to the causes by which a trademark may become a commonly used sign (in many jurisdictions called genericness), such as:

- the fault of the trademark owner, his acts or his inactivity;
- the enormous reputation of the trademark, and the use by the public of the trademark as a common one; though by a correct policy of use and policing of the mark this can be avoided;
- when it is the only way to identify a patented product at the end of the life of the patent;
- under the law in some countries a trademark can never become „in common use“.

AIPPI believes that:

34. when the owner of a trademark uses it as a common name or tolerates the general use of it as such for a considerable period, then the right to that trademark may be lost;

35. a sign which was non-distinctive when adopted may acquire distinctiveness by use and that distinctiveness is a purely factual matter, depending upon factors such as extent of use, length of use, etc.
4. Date of Evaluation of Distinctive Character in the Registration Procedure

AIPPI observes that:

36. the date of evaluation of distinctive character can vary from country to country, depending on the national law, as to what is the event which gives right to a trade mark: first use, application, either of them, or registration;

37. there are even some countries where there is no provision for refusal of an application for registration but rather, only cancellation proceedings.

AIPPI believes that:

38. the evaluation of distinctive character should be made at the date of the application for registration, whether the distinctive character is examined by the trademark office or only subsequently by the court;

39. nevertheless, such date need not be applied if, subsequent to the application date, use of the trademark has caused either the loss or acquisition of distinctiveness.

5. Neologism

AIPPI observes that:

40. a neologism is a verbal expression that is newly formed:

41. it may consist of a totally new invented word which does not have any meaning in its totality or its parts;

42. it may consist of a word which has been deformed by suppression, addition, contraction or misspelling, in such a way that it still retains a certain meaning.

AIPPI believes that:

43. a neologism which consists of a totally new invented word is by nature distinctive;

44. nevertheless, the neologism is not distinctive by nature if it has been constructed according to the usual rules of the language involved and the meaning appears evident to the public involved.

6. Words from foreign languages

AIPPI observes that:

45. international trade is being encouraged, consumers travel more and more in foreign countries, publicity from television and other media is being spread internationally and knowledge of foreign languages is increasing;

46. knowledge of foreign languages can be different from one part of a country to another;
47. knowledge of language can differ according to the kind of public concerned and can also differ from undertaking to undertaking;

48. foreign language can also have an impact on the question as to whether a trade mark is misleading or prohibited.

AIPPI believes that:

49. a word in a foreign language which has passed into the general language in the country concerned, or whose meaning is clearly understood by the relevant public or undertakings, should be subject to the same rules as those which govern words in the national language(s).

50. a foreign word which has not passed into the general language or whose meaning is not clearly understood by the relevant public or undertakings, can have or acquire a distinctive character;

51. the admission as trade marks of foreign words of languages known or likely to be known to a significant section of the public which designate the product or service in the country of origin, should be discouraged;

52. registration in one country of a trademark which is the designation of the product or a service in a foreign country should not serve to prevent the entrance into the one country of such goods, if on those imported goods the designation is not used as a trade mark.

II. Marks must not be misleading

AIPPI believes that:

53. trademarks should not be misleading to the relevant public;

54. the misleading effect can relate to the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the services, or other characteristics of the goods or services;

55. the mere possibility of the trademark being misleading can suffice as a bar to registration;

56. the misleading character of the trademark may result from the presence of one significant misleading element;

57. evocative trademarks may be misleading;

58. a trademark is not misleading if it is clear to the relevant public that the indication conveyed is false, since it cannot induce error.
Date of evaluation of the deceptive character

AIPPI believes that:

59. the time at which the misleading character of a trademark must be evaluated should be the same as for the evaluation of the distinctive character.

III. Signs for which registration is prohibited

AIPPI observes that:

60. most national laws correspond to the principle of Article 61 of the Paris Convention.

AIPPI believes that:

61. in order to protect public interest or morality, certain signs should not be registrable, notwithstanding their distinctive character. It should be left to each country to decide which signs are subject to this prohibition, but the criteria to be applied should be restricted in order not to add prohibitions that are irrelevant to the public.

B. What may constitute a registrable trademark?

62. The question of which signs should be legally admitted for registration has already been the subject of a full study and a resolution of AIPPI in the Berlin Congress in 1963. In this resolution AIPPI affirmed that the following signs are capable of constituting trade marks provided only that they are distinctive or have become distinctive in respect of the designated goods or services:

1. Words or assemblies of words, whether invented or not, including the titles of daily or periodic publications, the titles of collections of works and slogans.
2. Letters.
3. Digits.
4. Device marks including for example signatures, portraits, drawings, insignia, images, emblems and monograms.
5. Proper nouns including surnames, forenames and pseudonyms, as well as characteristic components or abbreviations of trade names.
6. The shape or any other presentation of the articles or their contents and wrappings provided that it is not exclusively functional in nature.
7. Colours, in combination with the signs.
8. Combinations of colours.
9. Any combinations of the signs listed above.

1. Definition

AIPPI observes that:

63. the majority of national laws provide for a general definition of a trademark and that also the majority of national laws enumerate signs which are capable of constituting a registered trademark, usually by way of illustration.
AIPPI believes that:

64. it is desirable that national laws should give a general definition of registrable trademarks and that the decisive criteria for being registrable should be their distinctiveness;

65. it is convenient if national laws provide for examples of registrable signs which should however by no means be exhaustive.

2. Distinctive signs listed in the Berlin Resolution

AIPPI observes that:

66. although a great number of national laws correspond to a large extent with the requirements of the Berlin Resolution, some national laws still do not allow registration of some types of signs.

AIPPI firmly believes that:

67. the Berlin Resolution is excellent and that it should be a basis for future harmonisation. All signs should indeed be capable of being registered as trademarks, provided that they are inherently distinctive or have become distinctive in respect of the designated goods or services. Particularly letters, digits and surnames must not per se be excluded from registration.

3. Other distinctive signs

AIPPI observes that:

68. in a number of countries colours, three-dimensional marks other than shapes of goods and their packaging as well as sound trade marks are also registrable.

AIPPI believes that:

69. colour per se should be registrable when it is or has become distinctive;

70. three-dimensional signs, irrespective of their nature, are registrable; national offices should require from the applicant a sufficient two-dimensional presentation (drawing, picture or any other presentation capable of being printed) and a declaration that it represents a three-dimensional mark; national offices should publish the two-dimensional presentation with an explanation that it represents a three-dimensional mark; a deposit of the three-dimensional mark as such should not be required, but if national offices allow also the deposit of a three-dimensional specimen of the mark, it should be made accessible to interested parties; the three-dimensional mark registered in a two-dimensional presentation is protected in its three-dimensional form with the consequence that use of such form is use of the registered mark.
4. The shape of goods and their packaging

AIPPI observes that:

71. a great number of national laws exclude the shape of goods or their packaging from registration in certain cases, such as:

72. the shape is imposed by the very nature of the article or its packaging;

73. the shape is necessary to produce an industrial result;

74. the shape imparts substantial value to the article.

AIPPI believes that:

75. the shape of goods or their packaging should not be excluded from registration except if the shape is imposed by the very nature of the article or is technically necessary.

5. Sound trademarks

AIPPI observes that:

76. a great number of countries permit the registration of sound trademarks;

77. in general sound trademarks are registrable; however, only to the extent that they can be and are represented by symbols;

78. it is not clear whether in those countries the sound is protected or only the registered symbols;

AIPPI believes that:

79. sound trademarks should be registrable, at least if they can be represented by symbols;

80. the registration should protect the sound thereby represented.

6. Olfactory trade marks

AIPPI observes that:

81. no national legislation provides for the registration of olfactory trademarks;

82. the national groups have in their majority not expressed a need for such registration.

AIPPI believes that:

83. the rather restricted interest in the registration of olfactory trademarks does not justify the complicated administrative and legal problems involved in such registrations.

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