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INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

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GROUPS FOR REFUSAL OF ALL TYPES OF MARKS

Document prepared by the Secretariat

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ANNEX

ARTICLE *6quinquies* OF THE PARIS CONVENTION FOR THE PROTECTION OF
INDUSTRIAL PROPERTY

I. INTRODUCTION

1. At the twentieth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), held in Geneva from December 1 to 5, 2008, the Committee asked the Secretariat to prepare a working document on grounds for refusal of all types of marks (see document SCT/20/4, paragraph 12). SCT Members were invited to present submissions for the working document by February 15, 2009. At the time of the publication of this document, the Secretariat had received submissions from the following SCT Members: Australia, Belarus, Czech Republic, Finland, France, Germany, Hungary, Japan, Mexico, Norway, Pakistan, Republic of Korea, Republic of Moldova, Russian Federation, Singapore, Slovenia, Sweden, United Kingdom, United States of America, Viet Nam and the European Community (21). In addition, the African Intellectual Property Organization (OAPI) presented a submission. All submissions were posted on the SCT Electronic Forum webpage.
2. For the preparation of the present document, the Secretariat consulted, in addition to the submissions mentioned in the previous paragraph, information provided in returns to the WIPO Questionnaire on Trademark Law and Practice, as presented in WIPO document WIPO/STrad/INF/1 (hereinafter referred to as “the Questionnaire”), and WIPO documents SCT/16/4, SCT/17/4, SCT/18/3 referring to trademark opposition procedures.
3. The aim of this document is to present a general view of the criteria determining whether a sign can constitute a valid trademark, but does not address the procedural framework within which those criteria apply. Examples of specific marks are of a merely illustrative nature and should not be considered as being representative of trademark law or practice of specific SCT Members.

II. PRELIMINARY CONSIDERATIONS

4. The requirements that a sign must fulfil in order to function as a trademark are reasonably standard throughout the world. However, the practical application of these requirements may differ from one country to another, depending on the specific legislation and trademark registration system. Generally speaking, two different kinds of requirements can be distinguished. The first relates to the basic function of a trademark, namely, its function to distinguish the products or services of one enterprise from the products or services of other enterprises. From that function it follows that a trademark must be distinguishable. The second kind of requirement relates to the potential negative effects of a trademark if it is misleading or if it is contrary to public order or morality.
5. These two kinds of requirements exist in practically all national trademark laws. They also appear in Article 6*quinquies* (B) of the Paris Convention for the Protection of Industrial Property (Paris Convention) (for the full text of Article 6*quinquies* see the Annex), which states that trademarks enjoying protection under Article 6*quinquies* (A) may be denied registration only if “they are devoid of any distinctive character” or if “they are contrary to morality or public order and, in particular, of such a nature as to deceive the public”.

6. Article 6*quinquies* (A) provides that a trademark which is duly registered in the country of origin must be accepted for filing and protected - *as is* or *telle quelle* - in the other member countries [of the Paris Union], subject to certain exceptions. The list of exceptions is exhaustive so that no other grounds may be invoked to refuse or invalidate the registration of the trademark.

7. This rule is often referred to as the “*telle quelle*” principle. It has been noted that this rule only concerns the individual elements of a given trademark, such as numbers, letters and surnames. In this respect, it does not affect questions relating to the nature or the function of the trademarks as conceived in the countries where protection is sought. Thus, a member country of the Paris Union would not be obliged to register and extend protection to subject matter that does not fall within the meaning of a trademark as defined in the law of that country¹.

8. The first permitted ground for refusal or invalidation of a trademark covered by Article 6*quinquies* applies in situations where a mark conflicts with rights of third parties acquired in the country where protection is sought. These rights can be either rights in trademarks already protected in the country concerned, or other rights, for example, the right to a trade name or a copyright. This ground for refusal may also be applied if a trademark would be likely to violate personality rights.

9. The second permitted ground for refusal or invalidation of a trademark covered by Article 6*quinquies* consists of three possibilities: it applies to any trademark which, in the country where protection is sought, is considered to be (1) devoid of any distinctive character, or (2) descriptive, or (3) the customary designation of the goods concerned.

10. The third permissible ground for refusal or invalidation of a trademark covered by Article 6*quinquies* concerns marks, which are contrary to morality or public order, again as considered in the country where protection is sought.

11. The following part of the document presents the most common grounds for refusal of all types of marks. This presentation is not necessarily exhaustive. Furthermore, grounds for refusal such as lack of distinctiveness, descriptiveness, genericness and deceptiveness have to be assessed in relation to the goods and services for which the registration of a trademark is sought in individual cases.

III. GROUNDS FOR REFUSAL

(a) Signs not constituting a trademark

12. A trademark is registrable only if it satisfies the criteria of registrability laid down in the applicable law. Article 15(1) of the Agreement on Trade-related Aspects of Intellectual Property Rights (the “TRIPS Agreement”) provides the following definition: “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings shall be capable of constituting a trademark”. It follows from this definition that the fundamental requirement for the registration of a trademark is that the sign in question is distinctive for the goods or services for which it is registered as a trademark.

(i) *Signs*

13. The definition provided by Article 15(1) of the TRIPS Agreement is broad with regard to the nature of signs that can constitute a trademark. In that respect, this provision stipulates that any signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs, shall be eligible for registration as trademarks.

(ii) *Visually perceptible signs*

14. Article 15(1) of the TRIPS Agreement further states that “Members [of the WTO] may require, as a condition of registration, that signs be visually perceptible”. In other words, the TRIPS Agreement does not contain a mandatory requirement for WTO Members to register and protect trademarks consisting of non-visible signs.

(iii) *Graphically represented signs*

15. In some jurisdictions², the issue of graphical representation is dealt with separately, particularly in countries where a condition for registration is that a sign be “represented graphically”. The requirement of graphic representation of trademarks has given rise to questions of interpretation in jurisdictions that apply this requirement, in particular with respect to certain non-visible marks, such as sound marks not consisting of musical sounds, or smell marks. In accordance with the jurisprudence of some countries, for example, a graphical representation of a trademark in order to be acceptable must be clear, precise, and complete by itself, easily accessible, understandable, durable and objective³. In this connection, it is worthwhile noting that the replies to the Questionnaire indicate that non-compliance with the requirements of visual perception and graphic representation frequently constitutes a ground for refusal (68 affirmative answers).

(iv) *Signs not capable as such of distinguishing goods and services*

16. A sign that has no inherent capacity to serve as a trademark is likely to be refused. This ground for refusal may be invoked if, in the abstract, a particular sign is simply incapable of performing the function of a trademark under any circumstances, for any goods or service. This may be the case for example for a complete song or a whole film⁴.

17. In order to decide whether a sign is capable of distinguishing (in the abstract) the goods or services of the applicant from those of others (“distinctive as to origin”), one submission suggested applying the concept of “inherent adaptation”⁵. This test refers to a quality of the trademark itself which cannot be acquired through use in the marketplace. The question could be expressed as – is this a sign which, hypothetically at least, could perform the function of identifying all goods marked with it as coming from the control of the same undertaking? If the answer to this question is no, the “sign” has failed to comply with this requirement.

18. It can be concluded that some of the basic criteria that determine the registrability of a trademark are that the trademark consists of eligible subject matter, i.e., the sign in question can constitute a trademark and the trademark has the abstract capacity to distinguish the goods and services of one undertaking from the goods and services of another undertaking. The issue of concrete distinctiveness is addressed below.

(b) Lack of distinctiveness

19. In general, grounds for refusal based on lack of distinctiveness, descriptiveness and genericness may overlap frequently. Objections on grounds of descriptiveness and genericness might also give rise to an objection on the ground of lack of distinctiveness. However, the scope of the ground for refusal of lacking distinctiveness may extend beyond the grounds of descriptiveness and genericness.

20. Distinctiveness could be defined as the inherent capacity of a trademark to be perceived by the market participants as a means to distinguish the goods or services of an undertaking from those of other undertakings, thus allowing the attribution of these goods or services to a particular commercial origin. Appreciation of the distinctive character of the sign takes into consideration the service or product targeted by the mark. Generally, trademark laws distinguish a series of signs which are deprived of distinctive character: signs which in current or professional language are necessary; generic or usual designation of the product or the service; signs used to indicate a characteristic of the product or the service, and in particular the species, quality, quantity, the destination, value, geographical source, time of the production of the good or provision of the service; signs consisting exclusively of the form imposed by the nature or the function of the product, or conferring its substantial value on the product.

21. Examples of non-distinctive signs would be figurative representations that are commonly used either in relation to the goods and services applied for, or in a functional or descriptive manner; pictograms and graphic symbols commonly used in a functional manner; figurative marks showing a graphic representation of a naturalistic reproduction of the goods themselves; single letters and numerals; verbal elements which are non-distinctive due to frequent usage and which have lost any capacity to distinguish goods and services, such as top-level domain endings (.com, .int), the @ symbol, or the letter e- in front of goods and services to be delivered electronically. According to the replies to the Questionnaire, the missing distinctive character of a trademark for which registration is sought is a ground for refusal under many trademarks systems (70 affirmative answers).

(c) Descriptiveness

(i) *General*

22. Trademarks which consist exclusively of signs or indications which may serve in trade to describe the respective goods and services may not be registered. The underlying reason for this provision is the public interest objective to keep descriptive indications available for use by everyone and, in particular for use by competitors. Descriptive marks are those that limit themselves to providing information on the goods and services in question. To be objectionable on this ground, the sign must consist exclusively of descriptive matter

(this is also valid for all items from (ii) to (ix)). The replies to the Questionnaire indicate that failure to comply with the requirement of non-descriptiveness constitutes a ground for refusal in many systems (68 affirmative answers).

23. In some jurisdictions, a mark will be refused registration if it consists of matter which, when used on or in connection with the goods of the applicant, is merely descriptive or deceptively misdescribes such goods⁶. A mark might be considered descriptive even if it describes a single ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. When looking at the proposed mark, if some imagination, thought or perception is required to determine the nature of the goods and/or services, the proposed mark may be considered suggestive and not be refused. Additionally, terms that attribute a certain quality to, or claim excellence for, goods and/or services, are often considered merely descriptive terms. Commonly, it is seen that a slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. Moreover, if a term has multiple meanings and at least one of those meanings is descriptive, or falsely descriptive, or generic, the term may be considered descriptive, falsely descriptive or generic.

24. The descriptiveness of a word may be determined on the basis of the ordinary understanding of the word in question. This could be corroborated by dictionary entries or it may clearly follow from the ordinary understanding of the term. In addition, terms used in a specialist terminology to designate the respective relevant characteristics of the goods and services may be considered descriptive.

25. In many jurisdictions, abbreviations are considered descriptive terms. Marks consisting of abbreviations may be refused if the abbreviation is a composition of terms which on their own are purely descriptive and this abbreviation is commonly used or at least understood by the relevant specialists in the field, as an abbreviation identifying the goods as to their characteristics.

26. Signs that are “descriptive as of law” form another category of descriptive terms. The descriptive nature of these terms is specified in domestic law or another legal instrument which is either binding or to be taken into account by the examining office. This applies, for example, to International Nonproprietary Names for Pharmaceutical Substances for the purposes of identifying medicinal substances through unique, internationally accepted terms.

27. A mark would not have to be verbal to designate a characteristic. It could also be pictorial. Phonetic equivalents or misspellings of descriptive terms might be registrable in some systems, as they are considered visually distinctive, but refused in other systems where there are not considered phonetically distinctive⁷.

(ii) Kind of goods or services

28. Signs consisting of the goods or services themselves, that is, their type or nature, may be considered descriptive and therefore non-distinctive.

(iii) *Quality of goods or services*

29. Signs consisting of both laudatory terms, referring to a superior quality of the respective goods, as well as the inherent quality of goods may be considered descriptive. This may also cover terms such as “light”, “extra”, “fresh”, “hyper light” if used for goods in a descriptive manner.

(iv) *Quantity of goods or services*

30. Signs consisting of indications of the quantity in which the goods are usually sold, commonly referring to quantity measurements relevant in trade, may be objectionable on the ground of descriptiveness.

(v) *Intended purpose of goods or services*

31. Signs consisting of indications showing the intended purpose, which can be described as the way, the means of application, or the function in which a good or service is to be used, may be considered descriptive.

(vi) *Value of goods or services*

32. Signs consisting of indications showing the (high or low) price to be paid, as well as the value in quality are considered descriptive. This may also cover expressions such as “extra” or “top”, “cheap” or “more for your money” and expressions indicating, in common parlance, goods that are superior in quality, such as “premium”.

(vii) *Geographical origin of goods or services*

33. Signs consisting of a geographical term indicating the origin of goods and services are usually refused on grounds of descriptiveness. Most submissions indicated that the descriptive character of the geographical term may pertain to the place of production of the goods, the nature of a good, the place on which the services are rendered, the place where the company rendering the services has its seat and from where the rendering of the services is managed and controlled, and the nature of the goods to which the service relates.

(viii) *Time of production of goods or of rendering of services*

34. Signs consisting of expressions concerning the time at which services are rendered, either expressly or in a usual manner, or the time at which goods are produced if that is relevant for the goods, are considered descriptive and are commonly refused for registration.

(ix) *Other characteristics*

35. In general, this possible ground for refusal may concern characteristics of the goods and services not covered by the preceding list of items. It might apply, for example, to technical characteristics of the goods not falling under the above sub-items.

(d) Genericness

36. Trademarks that consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade are regularly excluded from registration. In other words, a sign that indicates to persons in the relevant trade a product or service in general, rather than a product or service from one particular trade source, may be considered to have become generic. The replies to the Questionnaire indicate that genericness is analyzed in the context of examination proceedings, and failure to comply with the requirement of non-genericness constitutes a ground for refusal in many systems (67 affirmative answers).

37. Some submissions indicated that this ground for refusal also covers words which had originally no meaning, or another meaning⁸. Also, it was stated that it is not necessary that the sign or the indication be a term defined in the dictionaries and it is sufficient that there is evidence that such a sign is customary in the current language⁹. Abbreviations are also covered, as their meaning can only be perceived once they have become customary. Furthermore, figurative elements of trademarks may also be concerned, in case such elements are either frequent or have become the standard designation for goods and services.

(e) Functionality

38. The issue of functionality may arise in trademark systems which allow for the registration of three-dimensional shapes, product packaging, color or other trade dress for goods or services¹⁰. Where this type of subject matter is used and can serve as a mark, it may not be “capable of distinguishing”, as a public policy matter, if it covers a functional feature of the good, that is if it is essential to its use or purpose, or if it affects the cost or quality of the product. In order to determine whether the claimed feature is functional, evidence from the industry can be evaluated as well as information from the applicant, e.g., whether a utility patent covers the feature.

39. In reaching a determination as to functionality, some or all of the following factors may be considered: promotion of the utilitarian benefits of the matter for which registration is sought, the filing of any patent applications by the applicant for the matter in question, the availability of alternative designs, and the impact of the matter on the efficiency or cost of manufacturing.

40. Some submissions indicated that a sign that is functional may not be registered, even if the applicant is able to show that the sign has become distinctive¹¹. In this respect, reference may be made to the functionality doctrine, which prohibits registration of functional product features so as to encourage legitimate competition by maintaining the proper balance between trademark law and patent law. It ensures that protection for utilitarian product features is granted through a limited-duration utility patent, and not through the potentially unlimited protection of a trademark registration. Upon expiration of a utility patent, the invention covered by the patent enters the public domain and the functional features disclosed in the patent may then be copied by others.

(f) Public order and morality

41. Trademarks which are considered to be contrary to public order or morality are regularly excluded from registration. The replies to the Questionnaire indicate that failure to meet this requirement constitutes a ground for refusal in many systems (74 affirmative answers).

42. In general, and as with all other grounds for refusal, application of this particular ground is determined within the socio-cultural context of a particular jurisdiction. Some systems use the terms “public policy” and “accepted principles of morality”¹². Also, some jurisdictions apply the concept of “scandalous trademark.”¹³

43. In the context of signs that are considered to be contrary to public order or morality, one submission indicated that signs contrary to humanitarian principles cannot be registered as trademarks¹⁴. Another submission noted that signs of high symbolic value may not be registrable¹⁵. This may not refer solely to religious symbols, but also to symbols of significant charities and funds, cultural and educational associations or names of historically important personalities.

44. Some replies indicated that signs which are likely to bring damage to the image and the interests of the State will be rejected for registration¹⁶. These provisions relate to designations, identical or confusingly similar to official names and pictures of particularly valuable objects of the cultural heritage of a nation, or to objects of the world cultural or natural heritage. This may also concern cultural objects if the registration of such matter is requested by persons other than their owners, and without the consent of the owners or of persons representing them.

(g) Deceptiveness

45. In many jurisdictions, the registration of trademarks which deceive the public as to the nature, quality or geographical origin of the goods or services for which they are used is commonly refused. The replies to the Questionnaire indicate that deceptiveness is analyzed in the context of examination proceedings, and failure to comply with the requirement of non-deceptiveness constitutes a ground for refusal in many systems (73 affirmative answers).

46. Deception may also arise from an alleged characteristic of the goods or services on which the mark is used, including their composition and intended use or purpose. In addition, a perceived connection between the goods or services concerned and a person or organization may be considered deceptive.

47. The above-mentioned ground for refusal, as noted in some submissions, may also apply to cases of strictly untrue indications contained in trademarks, for instance, a reference to ecological agricultural production through the use of an indication such as “eco” or “bio”.

(h) Article 6*ter* of the Paris Convention for the Protection of Industrial Property

48. The purpose of Article 6*ter* is to protect the armorial bearings, flags and other State emblems of the States parties to the Paris Convention for the Protection of Industrial Property (Paris Convention). The protection granted by Article 6*ter* is extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations, of which one or more countries of the Paris Union are members. The purpose of Article 6*ter* is to prohibit the registration and use of trademarks which are identical to, or present a certain similarity with, the above-mentioned emblems or official signs.

49. The replies to the Questionnaire indicate that failure to comply with Article 6*ter* of the Paris Convention constitutes a ground for refusal in many systems (74 affirmative answers). The important question is whether the mark for which registration is sought is identical or is to a certain degree similar to signs protected under Article 6*ter*. The nature of the goods and services for which a mark is applied may be relevant.

(i) Specially protected emblems and symbols

50. The protection of official signs may also result from special treaties, such as the Geneva Convention for the Amelioration of the Condition of the Wounded and Sick in Armed Forces, of August 12, 1949 (protection of the Red Cross and analogous symbols), and the Nairobi Treaty on the Protection of the Olympic Symbol, of September 26, 1981. A conflict with signs enjoying protection under special international conventions may also be considered in the framework of examination proceedings (68 affirmative answers).

51. In several trademark systems, a particular ground for refusal may be based on a potential conflict with signs protected by national law, such as royal emblems (46 affirmative answers), signs of indigenous peoples and local communities (26 affirmative answers), or other signs (37 affirmative answers).

(j) Geographical indications

52. Trademarks which contain or consist of a protected geographical indication (including appellation of origin) are excluded from registration in many jurisdictions. The replies to the Questionnaire indicate that compliance with this requirement is analyzed in the context of examination proceedings, and a conflict between a protected geographical indication and a trademark constitutes a ground for refusal in many systems (59 affirmative answers).

(k) Shapes (signs consisting exclusively of shapes)

53. Signs which consist exclusively of the shape resulting from the nature of goods themselves, the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods are excluded from registration as trademarks in many jurisdictions. It should be noted that, usually, this ground for refusal cannot be overcome through acquired distinctiveness.

54. The applicability of this ground for refusal is rare and presents some difficulties; nevertheless, useful determinations are found in the case law of some jurisdictions¹⁷. The shape resulting from the nature of the goods themselves is limited to those shapes which

are identical to the goods. The shape of goods which is necessary to obtain a technical result is interpreted as applying irrespective of whether there are other shapes that can achieve the result.

(l) Bad faith

55. A number of submissions indicated that a sign should not be granted protection if its registration was applied for in bad faith. Usually, the issue of bad faith is examined with reference to the circumstances at the filing date, but it does not appear that there exists an international definition of bad faith. Generally speaking, bad faith can be considered to mean “dishonesty which would fall short of the standards of acceptable commercial behaviour” but other behaviour may also be deemed to demonstrate bad faith. For example, it could be said that there is bad faith when the trademark applicant intends, through a registration, to lay claim to a trademark of a third party with which she or he had contractual or pre-contractual relations¹⁸.

56. A relevant aspect in determining the bad faith of an applicant may be that the applicant was aware at the time of filing that the sign was linked to a third person and that the application was filed in order to prevent that third person from acquiring the rights in question. A relevant aspect may be that the parties had business dealings with each other prior to the filing of the trademark application or that the parties pursue business activities in the same market segment. Taking into account these factors, it may be possible that the trademark application qualifies as malicious only with regard to a part of the goods and services, in the relevant market in which the other person is interested.

(m) Prior trademark rights

57. The consideration of prior trademarks as a part of examination, opposition, invalidation or cancellation proceedings is standard in trademark registration systems. In particular, this applies to cases in which identical marks are registered or applied for, in respect of identical or similar goods or services. It may also be the case where similar marks are registered or applied for, in respect of identical or similar goods or services. Generally, the similarity of marks is determined in a comprehensive examination that takes into account the appearance, sound and meaning of marks.

58. In some jurisdictions, the concepts “substantially identical” and “deceptively similar” are used. According to this approach, a trademark is considered to be *deceptively similar* to another trademark if it so nearly resembles that other trademark that it is likely to deceive or cause confusion¹⁹. Trademarks are considered to be *substantially identical* if, when compared side by side, they differ only in minor, insignificant non-distinctive ways, but not in material particulars.

59. Prior well-known marks, collective, guarantee or certification marks may also constitute a ground for refusal. In many trademark systems, opposition proceedings can also be based on unregistered trademarks. The existence of unregistered trademarks (whether well known or not), or well-known trademarks which are registered for goods or services that are not similar to those of the trademark under examination may be taken up at the stage of examination, opposition or invalidation.

60. Signs that are identical or confusingly similar to the trademarks registered or filed for registration earlier may be accepted for registration on condition that the owner of the prior trademark consents to such registration²⁰. However, an office may object to the registration of a mark even in cases in which the holder of a prior right consented to such registration in order to avoid confusion among the consuming public and on the basis of a perceived role by the office to protect consumers and preserve the public interest²¹.

61. In some jurisdictions, a trademark identical or similar to a prior, expired mark is not registrable until at least one year after expiration. This provision helps to prevent the registration of trademarks when an expired trademark is renewed within one year after the expiration upon request²².

(n) Other industrial property rights

62. In addition to trademarks, other prior industrial property rights, such as appellations of origin or geographical indications, as well as trade names and business identifiers, may constitute grounds for refusal in many trademark systems. As with prior trademark rights, refusals based on those grounds may be overcome if the holder of the prior right consents to the registration.

(o) Copyright

63. The registration of a trademark that consists of or includes copyrighted material may be refused if registration is sought without permission of the copyright owner. It was also pointed out that trademark registration of well-known copyrighted material may be specifically prohibited by law²³.

64. A number of submissions indicated that titles of scientific, literary or artistic works known in a given territory or names of persons or quotations from such works, artistic works or parts of such works cannot be registered as trademarks without the authorization of the owner of the copyright or his successor in title²⁴. Also, according to some legislation, a trademark may not include anything likely to be understood as the distinguishing title of a protected artistic, literary or musical work of another person.

(p) Personality rights

65. Concerning personality rights, a conflict between a trademark and the name of a famous person may constitute a ground for refusal. Some submissions indicated that the registration of a trademark may be refused if the mark is likely to give the impression of being the name or likeness of another person, unless the name is not common, or the mark relates to a person long dead²⁵. However, registration may be granted if the person whose rights are concerned agrees to the registration of the mark.

IV. CROSS-CUTTING ISSUES

(a) Acquired distinctiveness

66. Many submissions have indicated that a refusal on the ground of lack of distinctiveness may be overcome if the trademark has become distinctive in relation to the goods and services for which registration is requested, because of the use which has been made of it. An objection based on deceptiveness, however, cannot generally be overcome in this way. The replies to the Questionnaire indicate that certain marks are registrable only with proof of acquired distinctiveness (44 affirmative answers).

67. Most replies were very general stating that marks consisting wholly of a sign ordinarily used to indicate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristic of goods or services, or the time of production of goods or rendering of services, would be registered only with proof of acquired distinctiveness. This also appears to apply to marks consisting of a single color and marks consisting only of numbers.

68. Many replies emphasized that the public should recognize the sign as a mark of an enterprise. There appear to be many ways to prove acquired distinctiveness, such as, the results of surveys or opinion polls. According to some replies, evidence would have to show that the mark distinguishes the goods or services at the date of application for registration. One reply mentions as a criterion for determining acquired distinctiveness exclusive and continuous use for five years and ownership of the registration of the same mark for related goods/services and/or evidence showing a distinctiveness perception by the public²⁶.

69. Generally, a trademark may be considered distinctive if it is recognized by a sufficiently large part of the relevant public as a mark of one single trader. The criteria for showing acquired distinctiveness of non-traditional marks are no different from those applied to all types of trademarks. In some jurisdictions, evidence of use is a factor in determining whether a mark has become distinctive. Evidence generally accepted includes opinion polls, surveys, statements from trade and consumer organizations, articles, brochures, samples, evidence of turnover and advertising, and other types of promotion and of successful prosecution of infringers. Furthermore, it is important to show examples of how the mark is used (brochures, packaging, etc.), the length of use and the amount (volume) of use, which is of particular relevance. Also, use must be of the trademark applied for and not of a significantly different variation, and the use must relate to the goods and services which are the subject of the trademark application²⁷.

70. Commonly, the evidence for an acquired distinguishing capacity is to be presented by the applicant²⁸. Such evidence may, in particular, demonstrate that a sufficiently large part of the public has the requisite knowledge that the sign constitutes the mark, even though its source may be unknown.

(b) Disclaimer

71. Where the trademark contains an element that is not distinctive, offices may request the applicant to disclaim any exclusive right to that element where its inclusion could give rise to doubts as to the scope of protection of the mark. The replies to the Questionnaire indicate that in the case of composite trademarks with non-distinctive words or elements, the applicant may be asked to disclaim such words or elements of his trademark (37 affirmative answers).

and 33 negative answers). If the applicant's statement does not overcome the ground for refusing registration or she/he does not agree with the disclaimer, then the application may be refused to the extent deemed necessary.

72. A disclaimer is seen as a means to overcome a possible ground for refusal. At the same time, a disclaimer may be considered necessary for the purpose of defining the rights of the owner of a trademark. In some jurisdictions, the applicant is given the possibility to indicate in the trademark application the elements in which she/he does not claim exclusive rights. In such cases, the disclaimer may remain even if the examiner does not deem it necessary²⁹.

73. It was indicated that in general, signs that are devoid of any distinctive character may be incorporated in the trademark as unprotected elements, insofar as they do not predominate³⁰. When defining whether a non-protectable element occupies a dominant position in a designation, its semantic meaning and/or its positioning is/are taken into account.

V. CONCLUSION

74. Based on specific submissions from SCT Members, the returns to the Questionnaire on Trademark Law and Practice, and on previous work of the SCT, this document attempts to provide an overview of the grounds for refusal most commonly found in the trademark legislation of SCT Members. At this stage of the work of the SCT, and bearing in mind that the individual application of each ground for refusal is governed by particular office practice and case law, the document had to remain general in nature. Thus, it cannot serve as a reference for addressing specific issues in particular jurisdictions.

75. *The SCT is invited to:*

(i) *take note of the present document;*

(ii) *comment on individual grounds for refusal described therein;*

(iii) *indicate which further course of action it wishes to undertake in respect of the subject of grounds for refusal.*

[Annex follows]

¹ See G. H. C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, page 111.

² See submission by the Delegation of Australia.

[Endnote continued from previous page]

- 3 See submission by the Delegation of France.
4 See submission by the Delegation of the United Kingdom.
5 See submission by the Delegation of Australia.
6 See submission by the Delegation of the United States of America.
7 See submission by the Delegation of the United Kingdom.
8 See submission by the Delegation of the European Community.
9 See submission by the Delegation of the Republic of Moldova.
10 See submission by the Delegation of the United States of America.
11 See submission by the Delegation of the United States of America.
12 See submission by the Delegation of the Czech Republic.
13 See submission by the Delegations of Australia and the United States of America.
14 See submission by the Delegation of Belarus.
15 See submission by the Delegation of the Czech Republic.
16 See submission by the Delegations of the Republic of Moldova and the Russian Federation.
17 See submission by the Delegation of the European Community.
18 See submission by the Delegation of the European Community.
19 See submission by the Delegation of Australia.
20 See submission by the Delegation of Belarus.
21 The issue of letters of consent will be the subject of an information document to be presented to the twenty-second session of the SCT.
22 See submission by the Delegation of Japan.
23 See submission by the Delegations of Australia and the Russian Federation.
24 See submission by the Delegation of Belarus.
25 See submission by the Delegations of Finland and the United States of America.
26 See submission by the Delegation of the United States of America.
27 See submission by the Delegation of the European Community.
28 See submission by the Delegation of the Russian Federation.
29 See submission by the Delegation of the European Community.
30 See submission by the Delegation of Belarus.

ANNEX

“ARTICLE *6quinquies* OF THE PARIS CONVENTION
FOR THE PROTECTION OF INDUSTRIAL PROPERTY

Marks: *Protection of Marks Registered in One Country of the Union
in the Other Countries of the Union*

A(1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

(2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.

B. Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

- (1) when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
- (2) when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;
- (3) when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

This provision is subject, however, to the application of Article 10bis.

C(1) In determining whether a mark is eligible for protection, all the factual circumstances must be taken into consideration, particularly the length of time the mark has been in use.

(2) No trademark shall be refused in the other countries of the Union for the sole reason that it differs from the mark protected in the country of origin only in respect of elements that do not alter its distinctive character and do not affect its identity in the form in which it has been registered in the said country of origin.

D. No person may benefit from the provisions of this Article if the mark for which he claims protection is not registered in the country of origin.

E. However, in no case shall the renewal of the registration of the mark in the country of origin involve an obligation to renew the registration in the other countries of the Union in which the mark has been registered.

F. The benefit of priority shall remain unaffected for applications for the registration of marks filed within the period fixed by Article 4, even if registration in the country of origin is effected after the expiration of such period.”

[End of Annex and of document]