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GUIDELINES FOR TRADEMARK EXAMINATION

International Trademark Association

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GUIDELINES FOR TRADEMARK EXAMINATION

Examination Guidelines Subcommittee
Trademark Office Practices Committee
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INTA GUIDELINES FOR TRADEMARK EXAMINATION

1. INTRODUCTION

1.1 Purpose

The purpose of this document is to provide general guidelines on a full range of issues related to the examination of applications for trademark registration. These Guidelines are not intended to be limited to the trademark law of any specific territory; rather, they follow generalized conceptual lines. These Guidelines are meant to reflect various international systems in an effort to harmonize trademark law. INTA supports all efforts at harmonizing trademark rules and practices and encourages Trademark Offices to follow such projects closely (*See*: work of TM5 as an example). These Guidelines are intended to serve as a reference document for trademark examination and registration, particularly for Trademark Offices.

1.2 Referenced Legislation, Agreements and Treaties

These Guidelines have been prepared taking into consideration the concepts and best practices of the legislation of relevant jurisdictions as well as appropriate international treaties and agreements (*See*: Footnote 1 below for referenced laws and treaties¹). INTA encourages the organization of examination proceedings to accord with the referenced legislation, agreements, and treaties, and in jurisdictions where applicable, relevant requirements of the Madrid Agreement and/or Protocol.

2. PRE-APPLICATION

2.1 Third Party Searching

¹ Referenced laws and treaties:

- The Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994, as amended on 23 January 2017 (TRIPs)
- The Model Law for Developing Countries on Marks, Trade Names and Acts of Unfair Competition of 1967 (produced by the World Intellectual Property Organization)
- The Trademark Law Treaty of 1994
- The Singapore Treaty on the Law of Trademarks, adopted by WIPO in March 2006
- Directive (EU) 2015/2436 of the European Parliament and of the Council of 26 December 2015 to approximate the laws of the Member States relating to trademarks
- The United States Trademark Act of 1946 (the Lanham Act)
- The Madrid Agreement concerning the International Registration of Marks, as amended on 28 September 1979 (Madrid Agreement)
- The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as amended on 12 November 2007 (Madrid Protocol)
- Paris Union and WIPO Joint Recommendation Concerning Provisions of Well Known Marks, adopted in 1999
- Canadian Trade-Marks Act, 1985, as amended on 28 June 2021

Trademark Offices should provide access to current records of existing marks so applicants and the general public may search the records to identify existing marks that may pose a conflict to a proposed mark. These records should be made available online or using generally acceptable technologies and should be organized to allow for ease in discovering potential conflicting marks including at least:

- Trademark as claimed by the applicant and/or registrant;
- Classes covered in the application or registration as well as the goods and/or services protected;
- Full name of the applicant and/or registrant;
- Application filing date and date of registration; and
- Status of the application or registration.

2.2 Classification Systems

For providing harmonization across jurisdictions, generally accepted classification systems, such as the International Classification of Goods and Services for the Purposes of the Registration of Marks (“Nice Classification”) should be used to classify goods and services, and the International Classification of the Figurative Elements of Marks (Vienna Classification), should be used to classify marks containing figurative elements (device (design) marks).

Trademark Offices may wish to use and make available to their users the WIPO’s Goods and Services Manager database, TMClass or other classification tools for guidance on classification principles and precedents as well as for harmonization purposes.

3. APPLICATION

3.1 Communication with the Trademark Office

Trademark Offices are encouraged to be flexible in allowing communications by applicants, their representatives, and the general public by various readily available means, including telephone, e-mail or acceptable new technologies.

3.2 Filing

Trademark Offices should allow for the receipt of applications and prosecution documents by hand, by post, by e-filing, and by other means of electronic transmission, and/or other means using generally acceptable technologies. Paperless and electronic transmission is strongly encouraged. Payment of fees should be allowed by cash, check, credit card, EFT, deposit account and/or other admissible means. The Trademark Office should issue confirmation of receipt of the application and fees, regardless of the means of transmission and payment.

3.3 Response Time

Trademark Offices should examine the application and issue a notification of objections to registration, if any, within a reasonable period at the appropriate stage in the procedure according to the particular law of each country. The applicant should be provided with a time period of a minimum of ninety (90) days within which to respond to any objections issued by the Trademark Office. One reasonable extension of this term is recommended.

4. MULTI-NATIONAL APPLICATIONS

Existing mechanisms that allow for the submission of a single application resulting in registrations that provide protection in multiple jurisdictions are encouraged.

(See: Footnote 2 below for a complete list of existing mechanisms²).

4.1 National Examination

INTA supports the Madrid Protocol and harmonization efforts under multilateral treaties and can provide assistance to countries in their consideration of adherence to them.

5. SCOPE OF EXAMINATION

5.1 Determined by Trademark Office

In all cases, the scope of examination, as well as the criteria by reference to which the examination is conducted, will be determined by the substantive law under which a Trademark Office operates. Each Trademark Office should publish its jurisdiction's statutory laws and regulations, guidelines, practice notes, and requirements, and make them freely available to the public³.

5.2 INTA Recommendation on Examination

INTA supports full pre-registration examination. Examination of the application should be made on absolute grounds and, if consistent with local trademark law, on relative grounds. Concepts such as descriptiveness, lack of distinctive character, generic trademarks, and bad faith should be considered during the absolute grounds examination, which is more fully discussed in Section 7.

² Such mechanisms include:

- The Madrid System for the International Registration of Marks
- The "Organisation de la Propriété Intellectuelle" (OAPI)
- The Banjul Protocol on Marks
- The European Union Trade Mark (EUTM)
- Benelux Trademark

³ The INTA Country Guides (<https://www.inta.org/practice-guide/country-guides/>) can be accessed by members of INTA to review examination policies worldwide.

of these Guidelines. Concepts such as likelihood of confusion, similarity of marks, and similarity of goods and/or services should be considered during the relative grounds examination, which is more fully discussed in Section 8. of these Guidelines.

INTA supports the availability of low cost, accessible opposition procedures, and suggests that a period of sixty (60) days is allowed to file oppositions after publication, especially when substantive arguments are required to be included in the initial opposition documentation. INTA recommends providing for at least one reasonable extension of the opposition deadline if the initial period is less than sixty (60) days.

6. FORMALITIES EXAMINATION

Trademark Offices should examine applications to confirm that they contain the essential minimum data specified by the local trademark law. These data include:

- Applicant Details;
- Representation of the Mark; and
- Specification of Goods and/or Services, including classification.

In some cases, examination may be required of Paris Convention or other priority claims; however, applications made according to the Madrid Agreement or Madrid Protocol that claim priority should receive priority “without requiring compliance with the formalities prescribed” in Article 4D of the Paris Convention.⁴

If the applicable trademark law requires a “use” or “intent-to-use” basis for filing, examination of this formality is required.

There are also certain additional formalities requirements for special types of marks. For a discussion of requirements for Collective and Certification marks, see Sections 6.3.1 and 6.3.2.

6.1 Representation of the Mark

It is recommended that Trademark Offices require that a mark be represented in a format that is clear, precise, and easily understandable, using generally accepted technologies.

The types of marks shown below are among those that may be deemed registerable as of the date of this revision, and the suggested means of their representation is provided. This list is not exhaustive. As technological advances and marketing customs develop, additional types of marks should be considered for registration.

⁴ Madrid Agreement, Madrid Protocol Article 4(2).

6.1.1 Device (Design) Marks

A device (design) mark is a mark consisting of figurative elements or a combination of verbal, figurative or otherwise graphical elements.

A graphical representation of the device (design) should be included in the application showing all its elements and, where applicable, its color(s), if the color(s) are claimed as part of the mark. Trademark Offices may add a design classification as specified in the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (1973, as amended).

6.1.2 Three-Dimensional Marks

A three-dimensional mark is a mark consisting of, or extending to, a three-dimensional shape, including containers, modes of packaging, packaging configurations, or the product itself or its appearance as well as shapes that contain other elements, such as word elements, figurative elements, or labels.

The representation should include sufficient views for the shape to be clearly identified. Any non-distinctive portion of an otherwise distinctive three-dimensional mark should not be included in the official representation of the mark. If a non-distinctive portion must be included for reference, such as for placement or orientation, the scope of the trademark and the non-distinctive portion should be clearly indicated.

6.1.3 Color Marks

A color mark is a trademark consisting exclusively of a single color or a combination of colors. What is protected is the color and, in the case of more than one color, the systematic arrangement of the colors in a predetermined and uniform way. If the representation contains other elements, such as words or graphical depictions, it is not a color mark but a figurative mark.

It is recommended that Trademark Offices accept a representation of the color or colors without contours, filed using generally accepted technologies. In addition, Trademark Offices may accept a literal description of the color or colors, and/or, a reference to accepted color definition standards or identification systems⁵. Where there is more than one color, the reproduction must show the systematic arrangement of the color combination.

It is recommended that Trademark Offices publish a representation of the color or colors. If a Trademark Office does not publish applications in color, then a literal description of the mark should be filed. A Trademark Office may also accept a reference to accepted color definition standards or identification systems.⁵

⁵ The use of color definition standards does not affect the infringement analysis on likelihood of confusion.

Any literal description of the mark should be clear, precise, self-contained, easily accessible, and intelligible. For example, a description of the mark as “blue” is not sufficiently particular. For marks consisting of a combination of colors, the description should also detail the systematic arrangement of the colors.

6.1.4 Sound Marks

Either the musical notation or a written description of the sound should be accepted and should be required if the Trademark Office cannot include digital representations, such as sound files. Where the sound may be only partially represented by visual notation, a clarifying description in words of the sound in the application should be included. Any description should be clear, precise, self-contained, easily accessible, and intelligible.

The applicant should be required to submit the digital sound file or musical notation with the application with the sound filed preferred unless the Trademark Office does not have the necessary technology for storing and listening to the file. Whenever possible the sound file or other acceptable representation for the mark should be available to any interested party.

The following are suggested representation forms for sound marks to be included with or as an alternative to a digital sound file:

- Musical notation and/or description of the sound in words;
- The instrument(s) on which the music is played should be included if it forms part of the mark (the title of the piece of music is not precise enough);
- Graphic (electronic) measurement of the volume and character of the sound; and
- A combination of any of the above, provided they are consistent.

6.1.5 Scent Marks

Representation should consist of a written description that conveys the identity of the scent clearly and unambiguously and permits its differentiation from other scents. The description should be clear, precise, self-contained, easily accessible, and intelligible.

6.1.6 Flavor Marks

Representation should consist of a written description that conveys the identity of the flavor clearly and unambiguously and permits its differentiation from other flavors. The description should be clear, precise, self-contained, easily accessible, and intelligible.

6.1.7 Touch Marks

Representation should consist of a written description that conveys the identity of the touch characteristic clearly and unambiguously and permits its differentiation from other touch

characteristics. The description should be clear, precise, self-contained, easily accessible, and intelligible.

6.1.8 Moving Image Marks

Representation should consist of a video file of the moving images in digital or physical format. It is also recommended that the applicant provide a series of images that represent the motion with a written description of the movement, which should be clear, precise, self-contained, easily accessible, and intelligible, for publication purposes and to provide a permanent depiction of the mark in the event of technology changes. If a Trademark Office cannot accept a video file, then representation of the mark should include a series of images and a written description of the movement.

6.1.9 Gesture Marks

Gesture marks are moving image marks but sometimes are identified separately. Representation should consist of a video file of the moving images in digital or physical format. It is also recommended that the applicant provide a series of images that represent the motion with a written description of the movement, which should be clear, precise, self-contained, easily accessible, and intelligible, for publication purposes and to provide a permanent depiction of the mark in the event of technology changes. If a Trademark Office cannot accept a video file, then representation of the mark should include a series of images and a written description of the motion.

6.1.10 Hologram Marks

Holograms are moving 3D holographic image marks that appear to change when viewed from different angles.

Representation should consist of a video file of the moving images in digital or physical format. It is also recommended that the applicant provide a graphic or photographic reproduction containing the views necessary to identify sufficiently the holographic effect in its entirety, for publication purposes and to provide a permanent depiction of the mark in the event of technology changes. If a Trademark Office cannot accept a video file, then a graphic or photographic reproduction containing the views necessary to identify sufficiently the holographic effect in its entirety should be filed.

6.1.11 Position Marks

These marks are specified by the position in which they appear or are fixed on a particular product⁶. Graphic representation could include a picture or drawing showing the specific position of the

⁶ The most typical examples being those that take the form of a fabric tag or decorative top stitching on the back pocket of jeans.

mark with regard to the product, as well as its size and proportion with respect to the relevant product, and a description in words, which should be clear, precise, self-contained, easily accessible and intelligible. If a non-distinctive portion must be included for reference, such as for placement or orientation, the scope of the trademark and the non-distinctive portion should be clearly indicated.

6.1.12 Pattern Marks

Pattern marks are marks consisting exclusively of a set of elements that are repeated regularly. The representation should show both the elements and the pattern of repetition. This may be accompanied by a description detailing how the elements are repeated regularly, which must be consistent with the representation. Color(s), may be indicated to the extent they form an integral part of the pattern.

6.2 Classification

INTA recommends adoption of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957, as amended), which provides a generally accepted system of classification of goods and services (“Nice Classification”).

6.2.1 Description of the Goods or Services

The goods and/or services in an application should be described clearly, with specificity, so it can be readily discerned the goods/services sought to be protected. The description of goods/services selected and utilized by the applicant should be accepted unless:

- It would be unclear to the public what the goods/services in the registration protects; or
- Goods or services clearly are misclassified according to the applicable governing classification system, in which case a proper reclassification should be permitted and proposed by the Examiner.

6.2.2 Use of Class Headings or Prescribed Lists of Goods and Services Discouraged

While some Trademark Offices accept the “class heading” of the Nice Classification as an acceptable listing of goods and services, INTA discourages the use of class headings or other general formulas which are not clear and specific as indicated in Section 6.2.1. INTA also discourages the use of prescribed lists of goods and services, because, among other things, such lists may force applicants to include goods and/or services in applications that are unrelated to the applicants’ actual goods and/or services and may also prevent the inclusion of relevant goods and/or services in applications. In addition, prescribed lists are discouraged because applicants should be able to use the same description in multiple jurisdictions provided such descriptions are clear and specific.

6.2.3 Use of “All Goods/Services in the Class” Discouraged

The specific goods or services should be clearly identified in an application for registration. INTA discourages use of the phrase “all goods/services in the class” as a permitted definition of goods or services in applications, because, among other things, a class may include a wide range of disparate goods/services many of which may be unrelated to the applicant’s actual goods or services. In addition, classifications may change over time, thereby creating ambiguity as to the scope of the protected goods/services if they are merely identified as “all goods/services in the class.”

6.2.4 Retailing of Goods

INTA recommends that Trademark Offices permit registration of the service of retailing goods (identified as “retail services” or “retail store services”) and that such services be classified consistently in class 35 according to the Nice Classification.

6.2.5 Family Marks

A family of marks should be recognized. In order to constitute a family of marks, a group of marks must have a recognizable common characteristic and be used in such a way that the public associates not only the individual marks, but also the common characteristic of the family of marks, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family; there must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

A family of marks should be recognized when the pattern of usage of the common element is sufficient to be indicative of the origin of the family.

In order to claim a family of marks, an owner must demonstrate that the mark(s) asserted to comprise the family has been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark.

6.3 Other Types of Marks

6.3.1 Collective Marks

INTA encourages the registration of collective marks which are used or intended to be used by members of a cooperative, an association, or other collective group or organization. The mark must be owned by the collective entity even though the members use it individually. The collective entity itself may advertise or promote under the mark the goods or services of its members and may use it itself if it is used at the same time by the members in accordance with the regulations governing the use of the collective mark.

An applicant should include the following information in an application to register a collective mark:

- A statement that the application is for a collective mark;
- A statement of the class of persons entitled to use the mark, their relationship to the applicant, and the requirements of membership of the applicant association; and
- If proof of use is required, the applicant should indicate first use dates of the mark and whether the first use was by a member of the applicant.

A Trademark Office may require a statement that the applicant is exercising or will exercise legitimate control over use of the mark by its members and a description of the regulations and standards governing the collective mark's use, which set forth the precise manner in which the applicant intends to control use of the mark by its members.

If proof of use is required, specimens of use of the collective mark should show use of the mark by a member on the member's goods or in the sale or advertising of the member's services. Specimens must be examined to ensure that the mark functions in a way such that it is clear the mark is a symbol of membership in the applicable cooperative, collective, group or organization.

6.3.2 Certification Marks

A certification mark is any word, name, symbol, or device, or any combination thereof owned by one person and used by others in connection with their goods or services to certify one or more characteristics of their goods or services. Such characteristics may include geographic origin, materials, mode of manufacture, quality, accuracy, or that the work or labor on the goods or services was performed by members of a union or other organization. INTA encourages the registration of certification marks.

Because a certification mark serves to certify characteristics rather than identify the individual source of the goods or services, an owner should not be permitted to use a certification mark in the course of trade.

When filing an application to register a certification mark in addition to the filing particulars, the applicant should include statements that support the issuance of a mark to act as symbol of guarantee or certification and not as an indicator of source or origin of goods and services. For example, the U.S. requires the following:

- A statement that the mark will be used by a party other than the applicant and that the applicant does not or will not engage in the marketing or production or any goods/services to which the mark is applied except to advertise or promote recognition of the certification program or of the goods or services that meet the certification standards of the applicant;
- A statement that the mark will certify the qualities or characteristics of the goods/services and not indicate the individual source of the goods/services;

- Documentation setting forth the standards or criteria used by the applicant to control use of the mark and to demonstrate that the applicant is engaged in a certified program;
- A certification statement that identifies the characteristics of the goods/services certified or to be certified; and
- A statement that the applicant does not and will not engage in discriminatory practices which would bar use of the mark by third parties who meet the standards established by the owner.

If proof of use is required, the applicant should provide the dates of the applicant's authorized user's first use of the mark and a statement that the first use was by the applicant's authorized user.). Specimens should be examined to ensure that the mark certifies a region or other origin, materials, mode of manufacture, quality, accuracy, or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization. Specimens must be examined to ensure that the mark functions in a way such that the buyers are likely to recognize the mark as a symbol of guarantee or certification.

6.4 Amendment to Application

Applicants should be permitted to amend the formalities data, which may be administrative or substantive in nature, and may be in the form of a change, an addition, a deletion, or a correction of small typographical errors. Examples include a change or correction of address, a change of ownership or, a restriction to the specification of goods or services. An amendment may be requested in writing, by telephone, or electronically, such as online or by email.

In some instances, a Declaration or Affidavit to support the written amendment might be required, for example, if registration is being allowed on an amended basis relating to acquired distinctiveness. However, formalities such as notarization and legalization should not be required.

Generally, if an amendment is required to correct an administrative error made by the Trademark Office, it should be allowed at any time and at no extra expense. Examples include amendment to the applicant's address, amendment to the classification or specification of goods, or correction of the filing date.

6.4.1 Amendments to the Mark

An amendment to the mark in an application should not be allowed at any time if it would materially alter the character of the mark as originally filed. The general test of whether an amendment is a material alteration is whether the mark would have to be re-advertised in order to fairly give notice to the public for purposes of opposition or cancellation, or whether the mark would require an additional search in countries where searches are conducted. Examples of amendments that should be allowed are the correction of small typographical errors or the deletion from the drawing page of informational matter, which is not a component of the mark itself, such as the size, contents, volume, or weight of the product.

7. ABSOLUTE GROUNDS EXAMINATION

7.1 Principles for Assessing Trademarks on Absolute Grounds

7.1.1 The Mark Must be Examined as a Whole

The mark should not be dissected and the elements of which it consists should not be examined separately.

Certain elements of the mark may be disclaimed (where allowed), but it is the overall impression of the mark that should be examined.

7.1.1 Examination of Goods or Services

A mark should not be examined in the abstract but in light of the goods and services applied-for.

7.2 Distinctiveness

A mark is distinctive if it is capable of distinguishing the goods or services of the owner from the goods and services of others.

Distinctiveness is needed for registration of any sign as a trademark. Distinctiveness may be inherent or acquired.

7.2.1 Inherent Distinctiveness

7.2.1.1 Descriptive Terms

7.2.1.1-1 Definition.

Descriptive terms are those that describe the kind or nature of an ingredient, quality, characteristic, feature, purpose, function or use of the specified goods or services. The reason for assessing whether a term is descriptive for purposes of registration is that, in the course of trade, anyone should be able to use words which describe a product or service.

7.2.1.1-2 Imagination.

A trademark is not descriptive when applied to the goods and services at issue if it requires imagination to determine an ingredient, quality, characteristic, feature, purpose, function or use of the specified goods or services.

7.2.1.1-3 Test.

The test to be applied is: Does the average consumer of the goods and services at issue understand the term to clearly describe an ingredient, quality, characteristic, feature, purpose, function or use of those goods or services?

7.2.1.1-4 Word Marks.

7.2.1.1-4.1 Letters, Numerals and Combinations Thereof.

Signs consisting of letters and/or numerals should be registerable, and the above principles should be applied. Irrespective of the total number of letters/numerals in the sign at issue, it will not be registerable if it is descriptive (as defined above), unless there is a showing of acquired distinctiveness. Alphanumeric marks do not have to be pronounceable to be protected.

7.2.1.1-4.2 Laudatory Marks.

Laudatory marks contain an expression about the sole quality of the product or service. Laudatory marks are considered descriptive, but may be registerable if there is a showing of acquired distinctiveness.

7.2.1.1-4.3 Names of Colors.

Word marks that consist of the name of a color are registerable unless such color is descriptive of an ingredient, quality, characteristic, feature, purpose, function or use of the goods and services at issue.

7.2.1.1-4.4 Phonetic Equivalents.

A deviant spelling of a descriptive term can under certain circumstances render the term distinctive.

7.2.1.1-4.5 Combination of Words.

A descriptive term can be registerable when combined with an additional element if the overall impression produced by the combination of such elements is distinctive.

7.2.1.1-4.6 Slogans.

As a combination of words, a slogan is registerable and registration of a mark should not be refused solely on the grounds that it is a slogan. Stricter examination criteria should not be applied to slogans. If a slogan is descriptive, it can be registered with a showing of acquired distinctiveness.

7.2.1.1-5 Device (Design) Marks.

The above principles also apply to device (design) marks.

7.2.1.2 Generic Terms

Generic terms consist of the common name of a product or service. Terms which are generic should not be considered a trademark and should never be registered. Such generic terms can include former trademarks (such as ESCALATOR or ELEVATOR) that are in common use as the name

of a type of product by multiple sources. Such terms do not function as source identifiers, and should be left free for use by all traders. Examiners should not consider marks to be generic if an applicant can prove that the mark covers merely the preferred “brand” of a particular type of product or service, i.e., there is still recognition by consumers of the mark as a particular source of goods or services. This will allow for preservation of well-known marks, which are in danger of becoming generic. Where an applied-for mark is well known through extensive use, but has never been registered, consideration can be given to policing efforts by the applicant as relevant in an evaluation of whether the mark is presently generic, or is still functioning as a trademark to identify source.

7.2.1.3 Surnames

In some territories, a surname is capable of registration as a trademark without condition as it is considered inherently distinctive. Registration of a mark should not be refused solely on the grounds that it consists of a surname. If the mark meets the distinctiveness criteria, it should be allowed registration despite it may also be a surname.

In other territories (e.g., US, Canada...), a surname is capable of registration as a trademark only if it is not considered primarily merely a surname. If a surname also has another meaning that is equally or more dominant in the applicable language, the mark is not merely a surname and thus a surname objection should not be raised by the Examiner.

7.2.1.3-1 The Surname Alone.

In evaluating whether the primary significance of a term is a surname, rather than a source indicator, reference resources such as telephone directories, census data, Internet searches, etc., should be taken into account.

The same considerations should be applied when the mark under consideration appears with grammatical elements, such as plurals or possessives. Once evidence of surname significance is produced by the Examiner, the applicant should be able to demonstrate that the word has another significance which is more or equally prominent.

7.2.1.4 Marks Consisting of, or Containing, Geographical Terms

In evaluating whether to register a term demonstrably having geographical significance, the Examiner must initially evaluate whether the average consumer in the jurisdiction where protection is sought would connect the term with the geographical origin of the goods/services claimed in the application. In this evaluation, the Examiner should consult appropriate geographical dictionaries, atlases, and databases related to the goods or services to determine if there is an association between the goods or services and the geographical location.

Registerability of a mark consisting of, or containing, a geographical term should not be assessed in the abstract but in light of the goods and services for which protection is sought. Additionally, registerability should be determined in respect of the jurisdiction where protection is sought.

EXAMPLE: CORONDA may not be registerable for strawberries in Argentina (because Coronda is a geographical area in Argentina having a reputation for growing higher quality strawberries) but it would be registerable for clothing, and might also be registerable for fruits or even strawberries in other jurisdictions (where the average consumer is not aware of the existence of Coronda, Argentina, and its reputation related to strawberries).

7.2.1.4-1 Geographical Terms that do not Indicate Geographical Origin of Goods or Services and are Arbitrary in Relation to the Claimed Goods/Services.

Many marks are geographical terms but do not serve as an indication of the geographical origin of the goods/services or relate to the goods/services in any way. In such cases, registration should be allowed without proof of acquired distinctiveness.

EXAMPLE: NORTH POLE for bananas

Here the mark, although it is widely known as a geographical location does not serve to relate the goods to the location in the mind of the consumer, and therefore does not serve as an indication of geographical origin of the goods. In this type of situation, the mark should be treated as an arbitrary designation, which should be registered without proof of acquired distinctiveness, because any geographical meaning is clearly not related to the goods.

7.2.1.4-2 Geographical Terms that do not Primarily Indicate Geographical Origin, but Suggest a Desirable Quality of the Claimed Goods/Services.

When the geographical term suggests, for example, that the product is stylish or of high quality, but do not serve primarily to indicate the geographical origin of the goods/services for which protection is claimed. In such cases, registration should be allowed without proof of acquired distinctiveness.

EXAMPLE: HYDE PARK for men's suits

7.2.1.4-3 Geographical Terms that Primarily Describe the Geographical Origin of the Claimed Goods/Services.

Where a mark serves primarily to indicate geographical origin of the goods/services, and in any case where the term is needed by multiple producers/providers of goods/services in the region to indicate origin due to a reputation in the region for producing/rendering goods/services of a particular character or quality, registration should not be allowed.

Particular care in this regard should be taken where the goods claimed in the application are natural produce or other food products.

EXAMPLE: FLORIDA for oranges

7.2.1.4-4 Geographical indications.

Marks consisting of, or containing, geographical indications, or their translation(s) into the official language(s) of the jurisdiction where the application is filed, are not registerable provided that the following conditions are met:

- The geographical indication is protected in the country of origin;
- The geographical indication has not become the usual designation of the product in the country where protection is sought by the time the application is filed; and
- The geographical indication does not conflict with other existing property rights, including trademarks.

Conflicts between geographical indications and trademarks should be resolved by applying the principles of territoriality, exclusivity, and priority. A validly registered prior mark should prevail against a later geographical indication and vice versa.

7.2.1.4-4.1 Additional Protection for Geographical Indications for Wines and Spirits

In the case of marks claiming protection for wines and spirits which consist of, or contain, a geographical indication, registration should be refused even if the trademark does not deceive the public as to the origin of the goods.

However, trademarks for wines and spirits should not be refused registration solely on the grounds that they consist of, or contain, a geographical name, except if such geographical name is a geographical indication and the conditions set out in section 7.2.1.4.4. are met.

7.2.2 Modification by Disclaimer

7.2.2.1 The Purpose of Disclaimer

In territories where disclaimers are permitted or required, disclaimers may serve as a means of highlighting that no exclusive rights are granted over certain nondistinctive components of a mark that otherwise would be distinctive and registerable as a whole. Examples of such nondistinctive components that may be incorporated in an otherwise distinctive mark include descriptive or generic matter, terms common to the trade, geographical terms, and surnames not having trademark significance.

7.2.2.2 Voluntary and Mandatory Disclaimers

In territories where disclaimers are permitted, the disclaimer may be voluntary or mandatory, depending on the situation and the territory. Where voluntary disclaimers are permitted, the applicant may disclaim components of the mark, provided the mark, as a whole, is not disclaimed. Where mandatory disclaimers are required, Examiners may ask for the disclaimer of any component of a trademark which is not independently registerable, for example, due to its

descriptiveness or its being generic (see Section 7.2.11 and 7.2.12). If disclaimers are mandatory under the applicable law, the authority should have clear rules on what is required (e.g., what happens in cases of compound words, etc.) and those rules should be applied consistently.

7.2.2.3 The Effect of Disclaimers

The addition of a disclaimer should not, on its own, be sufficient to overcome substantive objections to the registration of the trademark, e.g. (i) the whole of a mark is descriptive or generic; or (ii) the mark is scandalous, deceptive, or confusingly similar to a third-party mark.

Disclaimers should not prejudice or affect the right of a registrant (a) to defend its mark through passing off or other common law remedies or unfair competition or (b) to seek registration, without disclaimer, of a previously disclaimed component.

A disclaimer is a concession that the disclaimed component is not per se inherently distinctive, and is one factor to be weighed in determining confusion. However, in an infringement analysis, it is the totality of the components of a mark that must be considered, including any disclaimed components.

7.2.2.4 Disclaimer of Descriptive or Generic Terms

Where permitted or required, disclaimers should be entered in the following or a similar form:

“No claim is made to the exclusive right to use " _____ " apart from the mark as shown.”

Each individual descriptive or generic component (words or designs) should be separately disclaimed.

7.2.3 Assessment of Acquired Distinctiveness

Distinctiveness is required for registration of any sign as a trademark. If the mark is not inherently distinctive, it can be registered upon a showing of acquired distinctiveness (except for generic terms). A claim of acquired distinctiveness may apply to a portion of a mark. The standards for establishing acquired distinctiveness are the same whether the claim of distinctiveness pertains to the entire mark or to a portion thereof.

A mark is deemed to have acquired distinctiveness (or secondary meaning) when the relevant public perceives the mark as one which distinguishes the goods and services of the applicant from those of others. When that happens, the secondary meaning dominates any descriptive, geographic or surname significance.

Examiners may consider the following as criteria when assessing a claim of acquired distinctiveness:

- Specimens of the mark as used;

- Sales volume or revenue;
- Market share data;
- Length and scope of use prior to filing date;
- Geographic area of sales of goods or provision of services;
- Extent of advertising (value and volume);
- Degree of awareness among the consuming public that the mark indicates the applicant as the source (e.g., surveys, third-party media references, awards, statements by customers and retailers, statements from professional associations or others in the industry); and
- Relevant case law precedents confirming the acquired distinctiveness of the mark.

Together with a potential objection, the Examiner should issue guidance as to the specific requirements to overcome the alleged lack of distinctiveness.

7.3 Scandalous Marks

If applicable and not unconstitutional (e.g., under a Free Speech clause), trademarks that are contrary to morality or public order can be excluded from registration. The test for registerability should be whether a substantial body of the population in the applicable territory would understand the mark applied-for as going directly against the basic moral norms of society or contravene the state of law. A refusal on that ground should carefully balance the right of traders to freely employ words and/or images in the signs they wish to register as trademarks against the right of the public not to encounter scandalous, disparaging, or immoral trademarks.

Where the Examiner believes that the mark falls within the above definition, the Examiner should issue an objection and provide reasons for deeming a term immoral or against the public order and the applicant should be permitted to submit arguments and/or supporting evidence to the contrary to overcome the objection.

7.4 Deceptive and Misdescriptive Marks

A “deceptive mark” is one that misdescribes something about the applied-for product or service such that the purchaser is likely to believe the misdescription actually describes the product/service and such misdescription is likely to affect the consumer’s decision to purchase the product/service.

An important criterion is whether there is any real potential for deception of the public. The test is whether there is a real prospect of a purchaser of the goods/user of the service would be misled as to the characteristics and or nature of the goods/services.

In order to determine whether a trademark is deceptive, it is first necessary to determine whether the term is descriptive of some goods/services. The test may be whether the trademark (or a term within the trademark) conveys an immediate idea of, for example, an ingredient, quality, characteristic, function or feature of the goods or services. If the term immediately conveys such an idea, but the idea is false, although plausible, then the trademark is deceptive and is unregistrable.

It is important to consider whether the idea is plausible. Arbitrary or fanciful trademarks should not be excluded from registrability by the application of this test.

A trademark may be misdescriptive without being deceptive. The trademark will only be considered deceptive if purchasers of the goods/users of the services are likely to be deceived into purchasing the product/services by the misdescription.

A more detailed test may involve establishing:

- Whether the trademark misdescribes the goods; and if so,
- Whether a reasonable prospective purchaser is likely to take literally the misdescription and base his purchase decision on it.

A deceptive mark should not be registered. A misdescriptive mark may be registrable with a showing of acquired distinctiveness (secondary meaning).

7.5 Flags, Coats of Arms, Emblems, Official Signs, Abbreviations, and Names of International Intergovernmental Organizations

There are provisions in the Paris Convention Article 6ter regarding the registrability of flags, coats of arms, emblems, and official signs, etc. as trademarks or elements of trademarks. Art. 6ter Paris Convention is a provision of public interest; it aims at protecting national public signs and signs of IGOs (including their reputation) against their misuse by traders. The member states of the Paris Convention are free to apply these provisions also to service marks.

A trademark may not be registered if it includes, or imitates from a heraldic point of view, armorial bearings, flags, and other State emblems, official signs and hallmarks indicating control and warranty adopted by countries member of the Paris Convention. The provision applies equally to armorial bearings, flags, other emblems, abbreviations, and names of international intergovernmental organizations. The country, state or IGO whose emblems, official signs and hallmarks are involved may be allowed to register such signs in their own name or permit registration in the name of a licensee.

7.6 Functionality

If a proposed mark consists entirely of an essential feature of a product, it should be unregistrable. A single functional element of a combination of elements, however, should not necessarily defeat

an application. The application should be denied only if the functional elements dominate the mark.

Functionality cannot be overcome by acquired distinctiveness.

7.7 Issues Specific to Non-traditional Marks

7.7.1 Three-Dimensional Marks

7.7.1.1 Distinctiveness

As any other type of mark, a three-dimensional mark must be distinctive to be registerable. The distinctiveness can be inherent, i.e., the shape is clearly capable of indicating commercial source, or acquired through use.

7.7.1.2 Functionality

3D signs which consist of the shape of a product are not registerable if such shape results from the nature of the product or is necessary to obtain a technical result (i.e., purely functional).

The mere fact that the shape may have some utilitarian purpose should not per se disqualify it from registration as a trademark.

If an objection on the basis of functionality is entered, the applicant should have the opportunity to present evidence in support registration such as evidence of multiple alternative suitable shapes in use in the marketplace, which can be produced at comparable cost.

7.7.2 Holograms

7.7.2.1 Distinctiveness

A hologram must be distinctive to be registerable. The distinctiveness can be inherent, i.e., the hologram is clearly capable of indicating commercial source, or acquired through use.

Even if a hologram (also) serves a non-trademark function, it should still be considered distinctive if consumers (also) perceive it as a source indicator.

7.7.2.2 Functionality

A hologram may not be registerable if it is purely functional in respect of the goods or services in the application.

7.7.3. Color Marks

7.7.3.1 Distinctiveness

A color or a combination of colors must be distinctive to be registerable. The distinctiveness can be inherent, i.e., the color as such is clearly capable of indicating commercial source, or acquired through use.

In jurisdictions where a single color or a combination of colors is deemed to lack inherent distinctiveness, registration should be permitted upon a showing of acquired distinctiveness.

A color will typically not be inherently distinctive, if it is the "natural" color of the goods applied-for (e.g., yellow for bananas).

7.7.3.2 Functionality

A color may not be registerable if it is purely functional in respect of the products in question.

7.7.4 Sound Marks

7.7.4.1 Distinctiveness

A sound must be distinctive to be registerable. The distinctiveness can be inherent, i.e., the sound as such is clearly capable of indicating commercial source, or acquired through use.

The sound may lack inherent distinctiveness particularly if it is the typical sound the general category of goods applied-for makes/creates (e.g., sound of a running motor for cars).

7.7.4.2 Functionality

A sound may not be registerable if it is purely functional in respect of the products in question.

7.7.5 Scent and Flavor Marks

7.7.5.1 Distinctiveness

A scent or flavor must be distinctive to be registerable. The distinctiveness can be inherent, i.e., the scent/flavor as such is clearly capable of indicating commercial source, or acquired through use.

This assumes that the scent/flavor can be represented properly.

7.7.5.2 Functionality

A scent/flavor may not be registerable if it is purely functional in respect of the products in question. Products can have scents/flavors intended to enhance their attractiveness. Such goods

include cleaning products or perfumes. If the scent/flavor purely functions as an odor/taste eliminator/enhancer, it may have a purely functional purpose.

7.7.6 Touch or Texture Marks

7.7.6.1 Distinctiveness

A touch or texture mark must be distinctive to be registerable. A touch or texture mark may be considered inherently distinctive if it is unusual and unexpected in the context of the goods or services in the application.

That said, it is more likely that evidence of acquired distinctiveness would have to be provided to support registration.

7.7.6.2 Functionality

Where a texture is purely functional, it will not be registerable. This may be the case where the texture is of primary importance for the use or purpose of the claimed goods.

7.7.7 Moving Image Marks

7.7.7.1 Distinctiveness

A moving image mark must be distinctive to be registerable. The distinctiveness can be inherent, i.e., the moving image as such is clearly capable of indicating commercial source, or acquired through use.

7.7.7.2 Functionality

Moving image marks that are purely functional cannot be registered.

7.7.8 Position Marks

7.7.8.1 Distinctiveness

A mark claiming protection for the specific position of a sign must be distinctive to be registerable. The distinctiveness can be inherent, i.e., the moving image as such is clearly capable of indicating commercial source, or acquired through use.

7.7.8.2 Functionality

Position marks that are purely functional cannot be registered.

8. RELATIVE GROUNDS EXAMINATION

If during prosecution of an application, a Trademark Office conducts a relative examination for similar prior marks, a determination of likelihood of confusion should not be based solely upon classification of goods/services, but rather the examination of marks should include an analysis of the actual goods/services claimed and the usual conditions or circumstances under which the purchasing public encounters the goods/services, under the respective marks in the marketplace. The same analysis should apply where a country has adopted a likelihood of association provision concerning prior marks.

8.1 Search - Compiling a Group of Similar Marks

If a mark ("claimed mark") meets registerability requirements following absolute examination, a search should be undertaken to determine the existence of (i) similar marks in respect of goods/services identical or related to those of the application of the claimed mark, or (ii) similar marks that have been granted the famous status (if available) by the Trademark Office. Similarity of marks should be assessed against a search of marks which are (i) currently registered in that jurisdiction, or (ii) the subject of prior applications for registration in that jurisdiction.

If a similar mark is located by the search ("located mark(s)"), the Examiner must, considering all marks in their entirety, evaluate whether the goods or services to be provided under the claimed mark are likely to be confused as authorized by the owner of the located mark(s) or originating from the same source as the goods sold or services provided under the located mark(s). If in the Examiner's judgment, confusion of the relevant segment of the purchasing public is likely to occur according to the standards listed below, the located mark(s) should be cited to the applicant in a written statement as a bar to the registration of the claimed mark. The same analysis should apply where a jurisdiction has adopted a likelihood of association provision concerning prior marks.

This search is also recommended when the Trademark Office does not examine relative grounds ex officio. In this case, the search results should be sent to the applicant for informational purposes only to give the applicant the option of withdrawing the application before it is published.

8.2 Examination - Factors Involved in Assessing Likelihood of Confusion

The suggested factors to be included in an evaluation of likelihood of confusion are as follows:

8.2.1 Comparison of the Appearance, Sound, Connotation and Commercial Impression of the Marks

Marks should be compared in their entirety, and not dissected into elements unless these elements are likely to cause confusion as to the source of the goods/services associated with the respective marks. For example, similarities in the beginnings of the marks, and differences of only one or two letters between the marks should be taken into account.

The comparison should take into consideration the relative strength of the components of a prior mark in assessing whether registration of a later applied-for mark is likely to cause confusion with

the prior mark. The existence of an identical or closely similar distinctive mark should normally bar registration of a subsequently applied-for mark, unless other factors, such as, but not limited to, the nature of the pertinent goods or services, channels of trade, and sophistication of the consumer, are such that confusion would be unlikely.

If a located mark shows additional matter, including but not limited to a house mark, or matter which is descriptive or suggestive of the goods or services, it should not automatically lead to a finding of non-confusion. The same thoughtful analysis should apply where a jurisdiction has adopted a likelihood of association provision concerning prior marks.

When comparing composite marks composed of both words and devices (designs), either portion may generally be considered to be dominant and/or strong, and there should be no definite rule on this issue. The strength or attractiveness (i.e., comparative size of the device (design) element and meanings) of the word(s) and the device portions of the particular mark(s) in relation to the goods or services must be evaluated. In some cases, a distinctive design may clearly function as the dominant portion of a mark.

8.2.2 Fame of the Earlier Mark

If a register of famous marks is provided by the national legislation, the Examiner should use this register in the examination of relative grounds and cite identical or similar famous marks as bar to the registration of marks that constitute a reproduction, imitation, or translation of a registered famous mark. A refusal should be made irrespective of whether the goods or services of both marks are similar.

If a register of famous marks is not provided by national legislation, the Examiner should refuse to register marks that constitute a reproduction, imitation, or translation of a mark considered well-known in the relevant sector of the public in the relevant territory, whether or not registered, for identical or similar goods or services as those goods or services provided by the owner of the well-known mark. The Examiner should also refuse to register marks that constitute a reproduction, imitation, or translation of a registered mark considered well-known in the relevant sector of the public in the relevant territory for goods or services which are not similar to the registered goods or services of the well-known mark if use of the applied-for mark in relation to those goods or services would indicate a connection between the applied-for goods or services and the owner of the registered well-known trademark and damage the interests of the owner of the well-known mark.

Where national legislation provides for relative review, the Examiner should exercise this authority through *ex officio* action. Irrespective of whether national legislation provides for relative review, an opposer should be able to rely on the fame of opposer's mark as a basis for the opposition of an applied-for mark.

8.2.3 Comparison of Goods and Services

An additional factor in determining whether granting the registration of similar marks is likely to lead to confusion among the relevant public is a comparison of the similarity or dissimilarity and type of goods or services described in a located mark.

However, there should be no per se refusal to register because two similar marks are to be used on or in connection with goods/services which are similar or are in the same or related classes. In a fair evaluation of all relevant confusion factors, including usual conditions or circumstances around the goods/services at issue in the marketplace, the factor of similar or related goods/services may not be dispositive.

Additionally, where the goods/services of the claimed mark and located mark(s) are dissimilar, the Examiner should consider in the confusion analysis that in some cases (e.g., soaps and fragrance), goods emanating from a single source are sold commonly to the same purchaser group in a complementary or pre-packaged way.

8.2.4 Comparison of Trade Channels

This factor should measure the likelihood of whether the same purchasers will encounter the goods/services of the claimed mark and the located mark. The relevant determination of the respective trade channels should consider the usual market conditions for the goods/services at issue of the respective marks. The facts of each case should be evaluated concerning confusion. No specific formula of products meeting in the trade, manufacturing, wholesaling, or retailing market should per se prohibit concurrent registration of the similar marks, whether or not the goods upon which the marks being used, are related. For example, in very sophisticated markets or for very expensive items where a purchaser is likely to make a careful purchase decision, goods may generally be sold under somewhat similar marks without consumer confusion, as compared with inexpensive goods, which are more likely to be purchased on impulse, without careful examination by the purchaser as to source or origin.

8.2.5 Status of the Register and Concurrent Use

If multiple marks containing a similar word or design element can and have co-existed on the Register and there is evidence they have been used in the marketplace in the name of different proprietors without apparent confusion among the relevant purchasers, this may favor the applicant for registration of an additional such mark. In countries having provisions for opposition proceedings, the owners/users having earlier rights than the applicant will have an opportunity to object to additional registrations.

8.2.6 The Variety of Goods on Which a Mark is or is not Used (House Mark, “Family” Mark, Product Mark)

The owner of a house mark used on a wide variety of products and/or services, or of a family of marks used on goods and/or services sold and advertised together, may be considered as having more latitude to exclude second comers from the registration of similar marks than the owner of

an ordinary mark which is not well known. This is especially true if the applied for mark has not already become well known through use at the time of the application.

8.2.7 Any Other Established Fact Probative on the Issue of Whether the Claimed Mark is Likely to be Confused with the Cited Mark(s)

The classifications or subclassifications, by themselves, of the goods or services of the respective marks should not be considered a fact-probative issue to determine whether a likelihood of confusion exists with the cited marks.

The mark may be examined for any other fact probative issue(s) to determine a likelihood of confusion with cited marks.

It is advisable to delineate the range of external factors that Examiners may (or may not) take into account during examination in the determination of likelihood of confusion. The permissible factors may be those which are intrinsic to the very nature of the goods/services and/or which affect the impact that the similarity of marks and goods and/or services has on the consumer. Extraneous factors that relate to the purchasing practices and degree of care paid by the consumer when acquiring goods or services can be considered, but should be assessed without reference to the details of particular differentiating steps which the trader might choose to take in relation to the goods and services.

8.2.8 Notification of Owner of Earlier Marks

A notice of the mark to be approved for registration may be made available publicly, or alternatively, forwarded to the owner(s) of earlier marks prior to approval for registration in those jurisdictions where the Trademark Office does not examine relative grounds ex officio. This will provide notice to the owner(s) of earlier marks of a potentially confusing mark, which could be opposed or otherwise objected to according to the provisions within the jurisdiction.

8.3 Trademarks with a Reputation

In jurisdictions that examine marks on relative grounds, the Examiner should decline to register marks that, without due cause, would take unfair advantage of or be detrimental to the distinctive character of the repute of a registered third-party mark that has a reputation in the relevant sector of the public in the relevant territory. The refusal should be made irrespective of whether the goods or services of both marks are similar. Regardless of whether a Trademark Office examines applications on relative grounds, an opposer should be permitted to raise a mark with a reputation as a proper ground for opposition whether or not the mark with a reputation is registered in the jurisdiction.

9. OBSERVATIONS PROCEDURE / LETTER OF PROTEST

9.1 General

It is recommended that Trademark Offices implement an observations or letter of protest process whereby third parties (“Protestors”) may bring to the applicable Trademark Office’s attention facts that would support a refusal of registration on relative and absolute grounds, through certain mechanisms, such as the observation procedure of the EUTM or letter of protest practices of the USPTO (collectively, “Observations”). The Trademark Office should consider whether to put the Observations before the Examiner for consideration. Trademark Offices may set a modest fee for the filing of Observations.

Observations are highly recommended because they create a mechanism for a more thorough and detailed examination procedure by offering the public a tool to bring facts affecting determinations of registerability to the Examiner’s attention. Through more thorough examination and submissions by Protestors, Observation procedures may reduce caseload on opposition tribunals.

Acceptable reasons on which to base Observations may include:

- Absolute grounds (see Section 7 above);
- Bad faith filing;
- Nuisance Repeat Filing (as defined under Section 12.1);
- Likelihood of confusion with a registered mark, (in instances where there is a relative-grounds examination); and
- The applied-for mark is a registered geographical indication in the relevant country.

Observations should be factually-based, and as such, contain proof and support of the information regarding the facts set forth as to non-registerability of the applied-for mark. Observation procedures should be crafted such that they cannot be used purely to delay registration or to present purely adversarial arguments. As such, Observations should not be used as a means to present arguments more appropriately presented in an opposition proceeding. Rather, the focus of the Observations should be to bring facts that are considered by Trademark Office Examiners in examining registerability on absolute grounds and if applicable, relative grounds, to the Examiner’s attention during examination.

The trademark applicant is informed of the Observation if the Observation is considered on the merits by the Trademark Office. The Protestor does not become a party to the further prosecution of the trademark application, but the Protestor should be informed of the results of the Observation.

It is recommended that Observations must be made within a specified time period (e.g., before publication, before opposition period ends, etc.). Observations should not stay the time period for filing an opposition or any other remedy.

Regardless of treatment of a filed Observation by the Trademark Office (whether allowed or denied in whole or part), the Observation should not affect remedies available to the Protestor (e.g., opposition, cancellation or, invalidation proceeding, or civil court action, etc.).

10. CONDUCT OF THE DIALOGUE BETWEEN TRADEMARK OFFICE AND APPLICANT

10.1 Applicant's Opportunity to Overcome the Examiner's Citation of Similar Marks

After the assessment of the Examiner of marks believed to be confusingly similar, the applicant for registration of the claimed mark must then be given an opportunity to rebut the Examiner's determination of the non-registerability of the claimed mark, by submitting to the Trademark Office evidence/arguments that no likelihood of confusion exists. Any such rebuttal will be taken into due account by the Examiner, who will issue a further assessment.

10.1.1 Amendment

If local law allows, there should be provision prior to publication for the applicant to limit the claimed goods/services as an attempt to overcome a likelihood of confusion.

10.1.2 Argument

The applicant should have an opportunity to submit specific written arguments that the factors and evidence considered in the evaluation of the likelihood of confusion have not been properly evaluated by the Examiner, and that, therefore, there is no likelihood of confusion. Provisions for such written arguments should include the possibility for submission of physical or documentary evidence, including statements of persons with actual knowledge of the goods/services concerned.

Also, provision should be made for a telephone or personal interview with the Examiner wherein it is possible to present oral arguments against a likelihood of confusion.

The Trademark Office should consider all arguments and information submitted by the applicant before making a final determination on registerability.

10.1.3 Consent

A Trademark Office will, if local legislation provides, accept a letter of consent for registration of a claimed mark from the owner of a cited mark to overcome a likelihood of confusion refusal.

If not expressly provided for by local laws, an applicant should be permitted to submit to the Trademark Office, and the Examiner should consider, a letter of consent for registration of an applied-for mark from the owner of a cited mark in response to a likelihood of confusion objection. In considering the letter of consent, the Examiner should assess any evidence addressing the following factors:

- That a significant period of concurrent use has passed with no evidence of actual confusion among the relevant purchasing public;
- That the applicant's goods/services are distinct from the goods/services of the cited marks;
- That the trade channels and/or the purchaser groups are different;
- That the applicant and the owners of the cited mark agree not to use the mark of the other on their own goods/services, and agree not to use their own mark on the goods/service of the other;
- That if confusion should occur, the owners of the respective marks will work together and take reasonable action(s) to promptly obviate such confusion; and
- Inclusion of any other relevant factors illustrating that in this specific case, a likelihood of confusion does not exist.

10.1.4 Provision for Appeal

Where the applicant has presented all of its arguments and evidence against likelihood of confusion, but the Examiner issues a final refusal to register the claimed mark, an appeal to a higher authority should be available to the applicant, at which appeal the evidence on likelihood of confusion is evaluated de novo, where permitted by law.

11. PUBLICATION

Once the ex-officio examination of the claimed trademark has been successfully completed, arrangements should be made for the application or registration to be published online and publicly accessible for opposition purposes.

11.1 Details to be Included in Publication Notice

The publication notice should include a full representation of the mark and details of the elements of the mark that are being claimed, including but not limited to:

- A visual presentation of the mark;
- Trademark description, translation (if applicable), and color claim;
- Type of mark;
- Full details of the applicant;
- Class numbers from Nice Classification;

- Full list of goods and/or services as approved;
- Details of any disclaimer, limitation, or condition of registration;
- The date of application;
- The application number;
- The date of first use of the mark in each class, if applicable;
- Any convention priority claim;
- Filing basis (where applicable);
- An indication, if applicable, that the application was approved on the basis of distinctiveness acquired through use; and
- Representative for service.

12. EXAMINATION OF OPPOSITIONS

In addition to the recommendation that marks can be examined for inherent registerability and likelihood of confusion with prior marks, it is also recommended that a period be provided for inter partes opposition proceedings.

Jurisdictions that do not examine trademark applications on relative grounds prior to registration should maintain or adopt pre-registration opposition proceedings to ensure that relative grounds can be considered prior to the registration of a trademark and to maintain the integrity of the Trademark Register.

12.1 Opposition Proceedings

There should be a minimum term of sixty (60) days to file oppositions on appropriate grounds after publication of the application. Reasonable extensions of this term for a limited and defined maximum period are recommended. The parties shall also be permitted to place the opposition proceedings into a “cooling off,” suspension, or similar period to facilitate settlement negotiations.

There should also be some form of summary procedure in opposition proceedings involving Nuisance Repeat Filings to allow the matter to be brought to an expedited hearing (if needed or applicable) and decision. “Nuisance Repeat Filings” cover situations in which applicants can, and sometimes do, file an application for the same mark for the same or virtually the same goods or services that was previously the subject of a successful opposition proceeding based on prior rights made under circumstances that are unchanged from a previously decided opposition between the

same parties denying registration, where the passage of time, in and of itself, is not a sufficient change.

12.2 Standing / Entitlement

Any person or entity having a genuine interest, appropriate grounds, and/or standing, including but not limited to the following should have standing to bring an opposition or other proceeding challenging registration of an applied-for mark:

- Having rights in a mark which is potentially confusing or may be damaged by registration of the published mark;
- Having rights in a mark which has already been used and is considered to have caused actual confusion with the goods or services of the opposer's mark;
- The published mark is inherently non-registerable (e.g., generic, merely functional, or descriptive), when and as permitted by local law; and/or
- Having claims based on fraud or dilution.

Payment of a uniform fee by the opposer (without discriminating between national and non-national opposers) should be required to deter frivolous oppositions.

12.3 Notice / Proceedings

Opposition proceedings and filings should be non-confidential, provided that there are also appropriate mechanisms for protecting confidential documents and/or information contained in such documents.

The notice of opposition should be filed with the Trademark Office and should disclose the name and address of the opposer, the serial number or registration number of the mark being opposed, and the ground(s) for opposition.

12.4 Service / Notification

The applicant should be promptly notified of a Notice of Opposition by the Trademark Office. Unless local law provides for the parties to notify each other, when a party makes a subsequent filing in the opposition, the Trademark Office should promptly notify the other party of that subsequent filing.

12.5 Answer

Upon receipt of the Notice of Opposition, the Trademark Office should prescribe an appropriate time period for the applicant to file an answer or seek dismissal. A reasonable extension of the time period should be available to permit the parties to attempt a settlement to the extent that the opposition cannot be suspended or halted via other mechanisms before the Trademark Office. The

first such extension should be available without consent of the other party or approval by the Trademark Office, but further extensions would depend on consent of the other party and on approval by the Trademark Office.

The answer should state the applicant's defenses to each claim asserted and admit or deny the opposer's allegations. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an allegation, the applicant should so state, which will serve as a denial. An answer should contain any affirmative defenses.

There should be a process for both the applicant and the opposer to submit evidence, arguments, and counterarguments in support of their positions.

12.6 Default

In the event that the owner of a trademark application or registration does not respond to an opposition proceeding, the Trademark Office should issue a default judgment against the owner and deny or cancel registration. However, Trademark Offices should provide adequate safeguards to protect trademark owners from having their applications or registrations refused or canceled due to inadvertent non-response or frivolous filings.

12.7 Amendment of Opposition Pleadings

There should be a procedure for amending opposition pleadings that adequately protects the parties' interest in a fair opposition proceeding. For example, early amendments in the opposition to cure good-faith mistakes should generally be allowed, as well as amendments based on discovery during the opposition proceeding, if discovery is permitted by local law. However, opposers should not be able to amend proceedings for the primary purpose of unfairly harassing applicants, such as by adding a new grounds of opposition at a late stage in the proceedings that was known or should have been known at an early phase.

Trademark Offices should establish published rules regarding the procedures and safeguards concerning amending oppositions. Each party should have the right to respond to any amended pleading filed by the other party.

12.8 Procedure

The Trademark Office should specify rules of procedure and practice in inter partes proceedings. Such rules should be published and easily accessible to the parties.

Speed in resolving oppositions should generally be favored.

12.9 Consolidation of Proceedings

Consolidation of proceedings should be permissible only where the cases to be consolidated involve the same or related parties and the issues are the same or substantially similar. For

example, consolidation may be appropriate where a word mark and a composite mark which includes the word mark of the same applicant are published at or near the same time. Consolidation of multiple party oppositions where several unrelated entities have opposed the same application is not recommended. However, it may be preferable to have oppositions against the same application heard by the same Examiner or board of examiners.

12.10 Suspension

There should be a procedure for suspension of an opposition with consent of the parties or upon good cause. Suspension should be available if (i) a party or parties to a pending case are engaged in a civil action or another trademark proceeding (e.g., cancellation proceedings of a mark on which the opposition is based) before the same Trademark Office which may have a bearing on the case; (ii) there is pending before the Trademark Office or a civil court a motion which is potentially dispositive of the case; or (iii) there is good cause, upon motion or a stipulation of the parties approved by the Trademark Office or a civil court. The Trademark Office should be able to set a maximum time limit for consented suspension that is not dependent upon a civil action or another trademark proceeding.

12.11 Evidence

The parties should have an opportunity to submit evidence supporting their position(s) in the opposition

12.11.1 Timing of Submission

The Trademark Office should prescribe a period of time for the parties to submit evidence. It is recommended that the period of time for submission of evidence in an opposition proceeding should be subject to time limits of ninety (90) days, with the possibility of obtaining an extension of time for an appropriate time period. If the opposer fails to enter evidence within the set time period or any permitted extension, the opposition should proceed with the facts on record, if any.

12.11.2 Evidence from Other Proceedings

There should be a provision for determining admissibility of, and procedures for entering applicable evidence from other related proceedings, for example, a determination of the fame of either the opposer's or the applicant's mark.

12.11.3 Forms of Evidence

The Trademark Office should establish rules for the submission and sufficiency of evidence, such as form of affidavits or declarations, legalization requirements, etc.

12.12 Sanction; Termination

Failure to respond to the Trademark Office's procedures, including with respect to evidence requests, should subject the non-compliant party to sanction by the Trademark Office. A single

failure to comply with procedures may, and a repeated failure should, result in termination of the proceedings in a manner adverse to the non-compliant party.

12.13 Motions and Briefs; Hearing

12.13.1 Interlocutory Hearings/Motions

If applicable, there should be a procedure for resolving interlocutory matters, including provision for dismissal after submission of an answer, or summary judgment after the close of evidence taking, either by way of motion or hearing. Expedious determination on the merits may be preferable unless there is a requirement to decide these procedural motions within a fixed period.

12.13.2 Final Brief and Hearing

Opposition proceedings should be resolved by written brief and/or oral hearing, and a reasoned opinion by the Trademark Office. The Trademark Office should communicate to the parties the date by which it will render a decision, and it should render its decision by that date. If the Trademark Office is unable to render a decision by the noted date, it should communicate to both parties the new date by which it intends to render its decision. The Trademark Office should not take more than one (1) year from the last substantive factual or argument submission by the parties to render a decision on an opposition.

12.14 Appeal

There should be provision for appeal for the party against whom an unfavorable decision is rendered (in whole or in part) within a given time limit (no less than sixty (60) days) of the date of notification of the written decision. Such appeals should be to either a board of examiners or judges within the Trademark Office, or to an administrative court or civil court of competent jurisdiction.

12.15 Status of Application on Termination of Proceeding

If the appeal judgment is not adverse and not appealed further, on termination of a proceeding involving an application or registration (e.g., post-grant opposition), that application or registration returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant or registrant, the application or registration stands refused in-whole or in-part based on the appeal decision without further action being required by the parties and all proceedings thereon are considered terminated.

13. CANCELLATIONS

13.1 Cancellation Procedures

A Trademark Office and/or an administrative mechanism should be offered to third parties to cancel an existing registration. As these Guidelines are for examination, please refer to other INTA documents for guidance regarding cancellation procedures.