

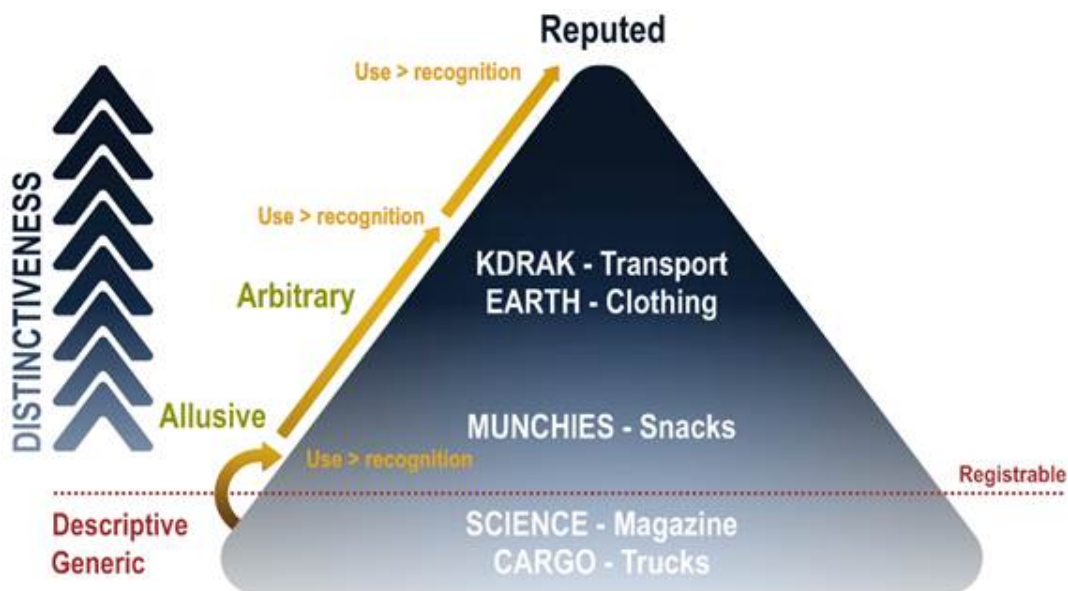
2.1.1 Distinctiveness

The Court has defined distinctiveness in the following manner:

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the **greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings** (emphasis added).

(22/06/1999, C-342/97 (https://euipo.europa.eu/eSearchCLW/#basic/*/number/342%2F97), Lloyd Schuhfabrik, EU:C:1999:323, § 22).

Importantly, distinctive character is a matter of degree and, when analysing distinctiveness, a sliding scale applies, whereby a sign can lack distinctiveness entirely, be highly distinctive or be at any point in between.



A sign is **not distinctive** if it is descriptive of the goods and services themselves or of the characteristics of those goods and services (such as their quality, value, purpose, provenance, etc.), laudatory and/or if its use in trade is common for those goods and services. Similarly, a sign that is generic (such as a common shape of a container or a common colour) will also lack distinctiveness. The rules for the assessment of distinctive character follow those established by examination on absolute grounds.

A sign may be **distinctive to a low degree** if it alludes to (but is not exclusively descriptive of) characteristics of the goods and services. If the allusion to the goods and services is sufficiently imaginative or clever, the mere fact that there is an allusion to characteristics of the goods and/or services might not materially affect distinctiveness. For example:

- 'Billionaire' for *gaming services* is allusive in a manner that would affect distinctiveness because it implies, for instance, that you may become a billionaire.
- 'Billy O'Naire', which sounds identical to 'billionaire' in English, would be allusive for *gaming services* as a clever wordplay on Irish names, in a manner that would not affect distinctiveness in a material way; it would be considered to have a 'normal' degree of distinctiveness.

A sign is deemed to possess a **'normal' degree of inherent** distinctiveness if there is no indication for a limitation thereof (e.g. due to a descriptive character, laudatory meaning, etc.). This means that the sign in question is fully distinctive, in the sense that its capacity to identify the goods and services for which it has been registered as coming from a particular undertaking is not in any way diminished or impaired.

Any **higher degree of distinctiveness** acquired by the earlier mark, which is often claimed by the opponent in order to broaden its scope of protection, has to be proven by its proprietor by submitting appropriate evidence (see paragraph 2.3 (/1935303/1982677/trade-mark-guidelines/2-3-examination-of-enhanced-distinctiveness) below). A mark will not necessarily have a higher degree of distinctive character just because there is no conceptual link to the relevant goods and services (16/05/2013, C-379/12 P