

Acquired distinctiveness

Acquired distinctiveness - what is it?

Filing evidence of use of a trade mark can be a way of overcoming an objection from the EUIPO that the mark is either devoid of distinctive character or descriptive. This presents a very high legal hurdle though as evidence of use would be needed in most, if not all, of the national EU member states.

What types of evidence are needed?

To obtain a registration for a trade mark which is not considered, on the face of it, to be registrable, we have to show that the trade mark has acquired a distinctive character prior to the date of EU application in most, if not all, of the individual member states.

It is not just about proving use of the trade mark. It is about proving to the examiner that as a result of the use of the trade mark (whether directly by the applicant or under licence), a secondary meaning has been established that a significant proportion of the consumers of the goods/services in respect of which registration is sought, view the trade mark as indicating origin of those said goods/services. We generally advise that we need to provide the examiner with five years' worth of evidence prior to the date of the application however, this will depend on a number of circumstances.

The types of evidence we would look to gather include:

- Market share – information as to the market share and if possible, the applicant's position within the market, i.e. market leader etc. A small market share in a large industry is unlikely to be sufficient but a low number of sales in a highly specialised industry could be. This will depend on the circumstances.
- Annual turnover figures – evidence of supporting invoices should also be filed. The cost of the goods/services will also be taken into account and higher sales figures are likely to be needed for everyday goods/services whereas, such high sales figures will not be expected for expensive, luxury or specialised goods/services.
- Evidence of widespread geographic use throughout the EU is essential – a list of all regions/territories where the mark has been used should be supplied along with evidence to substantiate such use including invoices and details of suppliers in the respective areas.
- Evidence of length of use in each EU member state – the date of first use should be specified and any gaps in use in that country which may have a negative impact on the assessment should be explained.

- Amount invested in promotion and advertising of the mark – examples of advertising on television/radio or in magazines/trade publications are valuable including details of any relevant sponsorship deals and awards won.
- Sample advertising for your products/services– preferably dated.
- Information regarding the money spent on advertising campaigns broken down on a year by year basis.
- If available, newspaper and magazine articles referring to the trade marks. If possible, we need the whole publication (and not just the article) or if the information is on the Internet, we need a print with details which also include a date.
- Information as to any trade shows/exhibitions where the goods/services have been exhibited. It would also be useful to have photographs of the stand and a copy of the brochure which lists details of your stand. Also, if available, can you or the organiser provide statistics relating to the number of people who attended the exhibition?
- Customer feedback and spontaneous consumer reaction – for example on blogs and social media sites; remembering that it must be dated before the date of filing.
- GOOGLE ® analytical data – GOOGLE® reports make it easy to measure and understand engagement on your website and is a relatively simple way to gather customised information on visitor segments and data. This information is invaluable but is not always available.
- Information as to any accolades for the goods/services.
- Copies of catalogues which lists the goods/services. If possible, these should be dated.
- Proportion of the relevant public that identify the goods/services as originating from the applicant. Please note that use of survey evidence is not recommended due to the limitations involved with the same and the high level of costs that will be incurred.
- Witness statements from within the relevant industry, from trade professionals and associations. Statements from independent witnesses are likely to carry more weight than those from within the applicant’s own company.



Presentation of evidence

The evidence must be presented as an affidavit or witness statement depending on the legal entity of the applicant. Any evidence in which is not in the language of the proceedings with need to be translated.

The above outlines our standard approach to showing secondary meaning. If it becomes apparent based on our experience that the applicant is unlikely to have sufficient evidence to meet the acquired distinctiveness hurdle, we have a number of creative strategies which could be explored and have been used successfully in the past, which could assist the client in securing protection for the mark in Europe.