



Acquired distinctiveness

Acquired Distinctiveness – What is it?

A trade mark which is:

- a) descriptive of the goods/services for which the mark is used, or is going to be used;
- b) devoid of distinctive character; and/or
- c) customary in current language or trade,

may still be registrable if it can be shown that as a result of the use made of the trade mark, it has become well known to the extent that on hearing that trade mark, the consumer automatically associates it with the trade mark proprietor. In such cases, the trade mark is considered to have “acquired distinctiveness”.

What do I need to do?

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 application.

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 by you, or by a third party with your consent, 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:

- 1) Market share – Information as to the market share enjoyed by your goods/services and if possible, your position within the market, i.e. market leader etc. A small market share in a large industry is unlikely to be sufficient but again, this will depend on the circumstances;
- 2) 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;

- 3) Evidence of widespread geographic use – 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;
- 4) Evidence of length of use – the date of first use should be specified and any gaps in use may have a negative impact on the assessment;
- 5) 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;
- 6) Sample advertising for your products/services– preferably dated;
- 7) Information regarding the money spent on advertising campaigns broken down on a year by year basis;
- 8) If available, newspaper and magazine articles referring to your 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;
- 9) Information as to any trade shows/exhibitions where your 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;
- 10) Customer feedback and spontaneous consumer reaction – for example on blogs and social media sites;
- 11) GOOGLE ® analytical data – GOOGLE® reports make it easy to measure and understand engagement on your website and is a relatively simple way to gather customized information on visitor segments and data. This information is invaluable but is not always available;
- 12) Information as to any accolades you have won for your goods/services
- 13) Copies of catalogues which lists your company’s goods/services. If possible, these should be dated;
- 14) 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; or
- 15) 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.



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Why do I need Barker Brettell's help?

Gathering evidence of use in this manner can be a complicated task and a lot of factors have to be taken into account. There is no hard and fast rule as to what evidence you should file to show a trade mark has acquired distinctiveness as each case has to be decided on its merit and the evidence needed, will depend on the circumstances.

Our attorneys have vast experience preparing and filing evidence of use of a trade mark for their clients to show their mark has acquired distinctiveness. Our attorneys will provide you with guidance from the outset as to what evidence will be needed to try and make your life easier. They will assess and review the evidence you provide and let you know if anything is missing. They will collate the evidence into a suitable format for filing in support of your application. Our attorneys are here to make your life easier.