

# Protecting GUI's and icons the EUIPO's perspective

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5th Board member  
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- **The Office (and the General Court) has mainly refused the GUI's, icons, emoticons and emojis ( first part) filed as EUTM's.**
  
- **But there are significant exceptions to these refusals.  
(2<sup>nd</sup> part)**
  
- **What about the future? ( conclusion)**

# Refusals

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R1883/2015-5

25/4/2016

1



N° 13 578 125

R1882/2015-5

26/4/2016

2



N° 13 578 133

- G. and S.:  
Class 39 Airport service kiosk providing passengers an option to throw belongings into a waste bin or into a collecting container to mail to their destination
- Description: The mark consists of a white bag with a white arrow positioned above the bag pointing away from the bag, both on a blue square background. Colour: Blue; White.
- Mark is a basic square-shaped figurative device containing both a white suitcase and an arrow on a blue background. The examiner correctly found that such iconography is commonplace at airports and that the consumer will understand the sign as indicating a specific service rather than a commercial origin, for example, that the consumer can leave suitcases for transportation elsewhere, hence the arrow.
- Neither the colours nor the figurative elements are distinctive.



**Marks refused for lack of distinctive character.**

R2256/2015-2,  
5/4/2016



IR N° 1 251 555

- G and S:  
Class 9: Downloadable computer software for providing electronic mail services, calendaring and scheduling services, task management, and personal information management.
- Class 38: Electronic mail services for data and voice; instant messaging services; text messaging services.
- “the IR holder’s envelope and- tick icon cannot serve as a badge of trade origin for email software and services, since consumers will not, on the basis of this mark alone, be able to distinguish the IR holder’s goods and services from those of competitors whose goods and services also feature the same or a similar icon. It means that the mark will not be recalled to mind by the consumer on a subsequent occasion when desiring to repeat—or avoid—the experience of a previous purchase.”

R2985/2014-5,

6/8/2015



IR N° 1 183 785

- G and S :

Class 9: Computer software for video calling; computer software for video telephony; computer software for the transmission of voice, audio and video content; cameras.

Class 38: Communication and telecommunication services, namely, transmission of voice, data, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet.

*The sign depicts a simplistic version of a video camera regardless of whether it is a modern or an old-fashioned type. It is common knowledge that typical features of any video camera include a body, a lens, a viewfinder and basic buttons (power or record buttons). The sign at issue depicts all the aforementioned elements. It is indisputable that consumers will understand this device as a simplistic depiction of a video camera.*

*No acquired distinctiveness shown*

R1616/2015-5,  
25/1/2016



*N° 13 463 914*

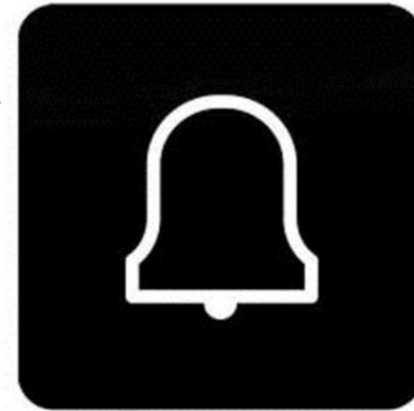
R2934/2014-5,  
22/9/2015



*IR N° 1 176 654*

- G and S:  
Classes 9 y 28 (rechazado únicamente para la clase 9).
- the sign does not go beyond the simple message 'contact information management software' (§23 and § 26).

## T-240/19, 7/11/2019



Class 9 – *Software applications*

***Application refused*** :

EUTM N° 17 868 712

- Consumers would perceive the sign as providing information that the goods in question can have a sound or alarm. The bell icon is a commonly used symbol for the indication of alarms and other alerts functions, which the goods may have. The public would perceive the sign as an indication of the intended purpose of the goods, their possible functionality and characteristics, namely to alarm, to alert or to indicate sound.

The mark applied for does not depart significantly from the norms and customs of the relevant market sector. The sign presents a bell with a white contour on a black background. The bell, and the sign as whole, will be seen by the relevant consumers only as an icon signifying a reminder, an alarm, ringtones or a sound icon and all the goods applied for may integrate or.



# R489/2016-2

23/9/2016



Classes 9 – *Software applications, 35, 38, 41, 42, 45 colours red, white and grey.*


*Application refused :*

*Applicant compared with previous marks registered*

EUTM N° 14286157

		
EUTM No 5 806 757	EUTM No 7 529 092	EUTM No 11 001 195

34 Reference is made, by analogy, to the Second Board's decision 10/01/2014,

R 435/2013-2, (fig.), § 19 *et seq.*, with respect to the sign , where this Board considered that the sign consists of the customary representation of a 'play key' and that the use of the colours orange and white do not give the sign any distinctive character.

*But*

*The features of the shape of the mark applied for, taken alone or combined with each other, are not distinctive: the contested sign consists of the graphic representation of a red and white 'play button', which does not diverge sufficiently from a standard representation of a play symbol for it to merit registration as a trade mark. Indeed, the relevant consumer will be extremely familiar with seeing such representations in relation to the contested goods and services.*

R1666/2012-1

16/8/2013

Classes 9 – *Software applications, 38, 42,*  
*Application refused :*

*A representation of a cloud such as applied for will be associated with the Internet and it will be perceived by consumers as a clear indication of a command that gives the possibility to have access to the cloud network. Such a perception of the cloud (both the term and the image) was developed in the early nineties by IT specialists and by 2008-2009 (therefore clearly before the filing date) became commonplace among average computer and Internet users.*

*Therefore, in relation to computers and software and telecommunication services, the mark applied for will be clearly seen as indicating to the consumers that the devices, software and the services offered enable the user to connect to the cloud.*

*Insofar as the services in Class 42 are concerned the consumers will perceive the image of a cloud as assuring them that these services can help, improve, fix or speed up their connection to the cloud network. Therefore, the mark will not be seen as a badge of origin but simply as an indication of the nature and purpose of the goods and services applied for.*



EUTM N° 1 111 497

R-2162/2018-5  
11/1/2019

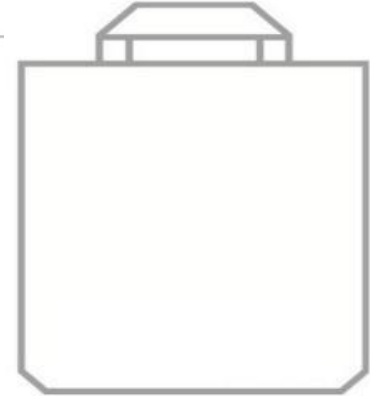
Classes 38 and 41

*Application refused :*

- Mark devoid of distinctive character
- Appeal withdrawn



EUTM N° 11 305 828



R-1237/2015-5,  
12/4/2016

- Class 9: software Class 35: online commerce; Class 36 financial services  
The trade mark applied for consists of a representation of a carrier bag and will be perceived by the relevant public as an icon and can establish a link between this icon and an e-commerce environment.

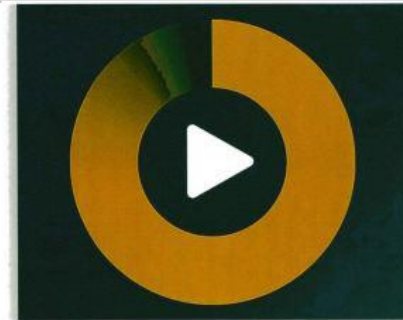
- Market is

- H&M:  (depending the country)  
[http://www2.hm.com/en\\_gb/index.html](http://www2.hm.com/en_gb/index.html)
- FNAC:  **Mi cesta** ( <http://www.fnac.com/> )
- Promod:  ( <http://www.promod.co.uk/> )
- Apple:  ( <http://www.apple.com/> )
- Adidas:  ( <http://www.adidas.es/> )
- Zalando:  **Cesta** ( <https://www.zalando.es/> )

N° 13 584 776

## R-0334/2018-2

25/7/2018



IR W1355688

Classes 9, 16, 38,41

*Application refused :*

The sign is a mere pictogram consisting of a combination of a 'play' button combined with a 'loading' sign that would be immediately recognised by both average consumers and professionals in the field of telecommunication and audio-visual typical of the goods and services in question. This depiction of a 'play' button is not markedly different from various basic presentational features, as it is merely represented on a plain black square background encircled with orange combined with the sign of loading, commonly used in trade for the goods and services at issue. Ample evidence was provided by the examiner in this respect. It is merely a combination of two basic signs. Even in combination, as in the sign applied for, these signs just reflect on simple functions on electronic devices, data (audio/video) loading and reproducing, 'playing' said data. These symbols normally appear on devices' screens, which can record or download the aforementioned data, on buttons of the remote controllers of such devices.

## R-1137/2017-1

4/4/2018



Class 9, The applicant claimed the colours: Light blue;  
Dark grey; Light grey; White.

Eutm nº 15 587 975

*Application refused :*

the mark represents a pictogram featuring a running figure placed inside a half-filled grey and blue circle that resembles a progress indicator.

The sign has everything that typically characterises an app icon: an external square border with rounded corners and an emblem that symbolises the content of the app.

*The fact that the mark has been found distinctive in other jurisdictions may not be considered as a decisive factor. The IP Offices of these jurisdictions (Turkey, Singapore and the Philippines)*

# R1489/2017-1

17/1/2018



Eutm nº 15 956 841

Classes 9, 25, sunglasses clothing, colours blue and white

*Application refused :*

- Mark is not different from classic emojis

Harvey Ball



Franklin Lufrani



Mark applied for



- Not diverging from other smiley faces
- Smiley faces are generally used both in advertising and in private communication to express positive feelings such as joy, agreement, enthusiasm or happiness. On account of this versatile use for any type of positive message, the consumer targeted will perceive a smiley in combination with any desired category of product or service as a purely decorative element or a general advertising message.
- Average consumers are accustomed to depictions of a round face in not yellow but other colours with differences in the lines or shape of the eyes or the mouth as well as the presence of other elements (sweat, tears, frown marks, teeth, goggles), to convey a message an emotion or an idea. These variations can be seen in the chart in Annex 4 containing the list of the Unicode Emoji characters: Variations that exist in the shape of the eyes are not only black dots and black vertical ovals but dollar symbols, closed eyes as well as eyes that resemble a 'kidney shape' comparable to those in the mark applied for (see the kidney shape types in items 2, 3, 6 and 10 of the Unicode list).

# Grants







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## Other envelopes icons



IR N° 1 251 555

 <p>1)</p>	 <p>2)</p>	 <p>3)</p>
<p>EUTM No 6 750 764</p>	<p>EUTM No 5 949 301</p>	<p>EUTM No 11 560 067</p>
 <p>4)</p>	 <p>5)</p>	 <p>6)</p>
<p>EUTM No 1 248 095 (expired)</p>	<p>EUTM No 2 442 358 (expired)</p>	<p>EUTM No 3 815 644</p>

[R2434/2015-2](#), Mark accepted  
8/4/2016



*N° 13 734 777*

- G and S:  
Classes 9, 10, 14 y 28 (link with the pictograms)
- Application refused by the examiner
- “the Board cannot find any convincing reason for supporting the examiner’s view that the mark applied for is devoid of any distinctive character. Although the mark may not be particularly imaginative, and taken in isolation some of the elements within it may not be highly distinctive, the Board nevertheless agrees with the applicant when it claims that, as a whole, the mark is distinctive and that typical users of tablets and mobile phones are particularly ‘savvy’ when it comes to identifying an icon and its function. They are accustomed to distinguishing between two more software applications, performing the same or similar operation, simply on the particular get-up of the icon. In this instance, the complexity of the icon makes it even more credible that it can be used to distinguish the applicant’s goods from the same or similar goods of competitors. Therefore, it cannot be deemed devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR. As a consequence, the contested decision must be annulled and the mark allowed to proceed.

R1483/2018-4 Mark accepted  
19/12/2018



*17 842 006*

- G and S:  
Classes 9, 16, 24 and 35
- Mark refused by the examiner.
  
- The sign is complex and does not inform straightforward about the goods and services.

R1666/2012-1

16/8/2013

Classes 9 – *Software applications, 38, 42,*  
*Application refused :*

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EUTM N° 1 111 497

## Icons accepted

- 0 EUTM registration No 13 735 162  (the fact that this sign is coloured does not have an impact on its degree of distinctiveness. Consumers are not used to making assumptions about the origin of goods based on the coloured presentation of a sign);
- 0 EUTM registration No 13 118 906  ;
- 0 EUTM registration No 10 737 765  .

# R1489/2017-1

17/1/2018



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# Future?

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