

**Ex officio refusal of protection (Article 7, Article 42(2) EUTMR)**

Alicante, 15/08/2023

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*Your reference:* **MM202250386P**

*International registration No:* **1715386**

*Trade Mark:* **ecoPLANT**

*Name of the holder:* **ECOSPIRITS PTE. LTD.  
90 Eu Tong Sen Street, #03-02  
Singapore 059811  
Singapore**

**I. Statement of the facts**

The Office issued a provisional refusal on 28/03/2023 pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR.

The services for which the provisional refusal was issued were:

Class 39 *Containerized, semi-automated beverage alcohol processing facility, namely, filling of containers, packaging and storage of goods, packaging articles to the order and specification of others, packaging of goods, packaging of products, packaging services.*

The provisional refusal was based on the following main findings:

The relevant English-speaking consumer would understand the sign as having the following meaning: ecological factory.

The meaning of the expression 'ecoPLANT', contained in the trade mark, was supported by the dictionary references from *Collins dictionary* on 28/03/2023 at <https://www.collinsdictionary.com/dictionary/english/eco> and <https://www.collinsdictionary.com/dictionary/english/plant> . The relevant content of the links was reproduced in the provisional refusal.

The relevant consumers would perceive the sign as providing information that the services are supplied by or rendered in a place where an industrial activity (packaging, filling of containers, etc.) takes place and which respects the environment. Therefore, despite certain stylised elements consisting of the verbal element 'eco' written in small letters and the element 'PLANT' in capital, both in black colour in standard typeface, the relevant consumer would perceive the sign as providing information about the quality and rendering of the services.

Given that the sign has a clear descriptive meaning, it is also devoid of any distinctive character and therefore ineligible for registration under Article 7(1)(b) EUTMR. This means that it is incapable of performing the essential function of a trade mark, which is to distinguish the goods or services of one undertaking from those of other undertakings.

The relevant public would simply perceive the sign as providing the purely laudatory information that the services are rendered with respect for the environment. The relevant public will not tend to see in the sign any indication of commercial origin, but merely laudatory information that serves to highlight positive aspects of the services.

Although the sign contains certain stylised elements that confer upon it a degree of stylisation, these elements are so negligible that they do not endow the trade mark as a whole with any distinctive character. Nothing about the way in which they are combined allows the mark to fulfil its essential function for the services for which protection is sought.

Consequently, taken as a whole, the sign is descriptive and devoid of distinctive character. It is therefore incapable of distinguishing the services for which an objection has been raised under Article 7(1)(b) and (c) and Article 7(2) EUTMR.

In addition, the holder was requested to appoint a representative entitled to represent third parties before the Office, pursuant to Articles 119(2) and 120(1) EUTMR.

## **II. Summary of the holder's arguments**

The holder submitted its observations on **26/05/2023**, which may be summarised as follows.

1. The Office failed to consider the impact of the stylisation of the mark properly and has, therefore, failed to consider the overall impression created by the logo. The stylised mark 'ecoPLANT' meets the minimum threshold for distinctiveness to be registrable as a trade mark, and it has been established that this threshold is relatively low. As already established, there is no requirement for a trade mark to be particularly imaginative or inventive. Furthermore, the trade mark can convey an objective message and still be recognisable as being distinctive as a source identifier.
2. Where a trade mark is composed of several elements which themselves are not particularly distinctive, any evaluation of the mark must be based on the overall perception of that trade mark by the relevant public and not on the presumption that elements individually devoid of distinctive character cannot, on being combined, present such character. The mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that their combination cannot present such character (08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 41). This is true in the subject case. While each of the elements, which comprise the subject stylised mark, may be somewhat allusive to possible characteristics of the goods/services covered by this application, their combination is even less allusive and is unclear being simply a clever suggestion, hinting at possible

characteristics.

3. Ecospirits Pte. Ltd ('Ecospirits') is an innovative closed-loop distribution system that nearly eliminates packaging waste in the premium spirits supply chain. By dramatically reducing packaging and transport costs, Ecospirits provides both a powerful cost advantage and a transformative carbon footprint reduction. It eliminates about 80 % of the carbon footprint of spirit consumption. Considering the holder's mark in the context of the specific services for which registration is sought, the mere fact that the mark consists of the prefix 'ECO-' does not render the mark as a whole non-distinctive.

It is a well-established principle that marks should be assessed in their entirety rather than breaking them down into their constituent elements. The Office has separated the mark into its components and has decided to examine two components rather than considering the mark in its entirety.

4. The sign 'ecoPLANT' is an invented term. 'ecoPLANT' is not a description of a type of goods or services but rather is the brand name adopted by and associated with the holder. The enclosed dictionary extracts demonstrate that the mark 'ecoPLANT' is not a recognised English word. The word 'ecoplant' is entirely fanciful and as such must contain the requisite level of distinctiveness for the purposes of registration.
5. It is well accepted that there is no prohibition in relation to the use of trade marks which may provide an indication as to the nature of the goods and services provided. There is a long line of well-established case-law that a mark which is merely suggestive of or alludes to or hints at the goods and services to which it is to be applied is registerable. The descriptive meaning would not immediately be apparent to the consumer on encountering the 'ecoPLANT' trade mark. Where a mental effort, even a small one is required in order to ascertain a trade mark's possible meaning, the mark becomes suggestive. In this regard we would submit that the term 'ecoPLANT' cannot be considered exclusively descriptive if a consumer encountering the mark will not immediately and without further reflection detect the description of a characteristic of the services in question.
6. The Office previously registered the following trade marks No 2 340 909 'ECO-COOL', No 5 911 169 'ECOSWITCH', No 6 192 652 'ECO-POWER', No 6 960 785 'ECO TRAVELER', No 7 265 507 'ECO digi' and No 9 098 716 'ECO-TRACKS'. None of these marks were accepted for registration based on acquired distinctiveness through use. Therefore, the Office regarded such marks as inherently registerable.

### III. Reasons

Pursuant to Article 94 EUTMR, it is up to the Office to take a decision based on reasons or evidence on which the holder has had an opportunity to present its comments.

After giving due consideration to the holder's arguments, the Office has decided to maintain the objection.

Under Article 7(1)(c) EUTMR, 'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service' are not to be registered.

It is settled case-law that each of the grounds for refusal to register listed in Article 7(1) EUTMR is independent and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest underlying each of them. The general interest to be taken into consideration must reflect different considerations according to the ground for refusal in question (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532, § 25).

By prohibiting the registration as European Union trade marks of the signs and indications to which it refers, Article 7(1)(c) EUTMR

pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

(23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 31).

'The signs and indications referred to in Article 7(1)(c) [EUTMR] are those which may serve in normal usage from the point of view of the target public to designate, either directly or by reference to one of their essential characteristics, the goods or service in respect of which registration is sought' (26/11/2003, T-222/02, Robotunits, EU:T:2003:315, § 34).

Under Article 7(1)(b) EUTMR, 'trade marks which are devoid of any distinctive character' are not to be registered.

The marks referred to in Article 7(1)(b) EUTMR are, in particular, those that do not enable the relevant public 'to repeat the experience of a purchase, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned' (27/02/2002, T-79/00, Lite, EU:T:2002:42, § 26). This is the case for, inter alia, signs commonly used in connection with the marketing of the goods or services concerned (15/09/2005, T-320/03, Live richly, EU:T:2005:325, § 65).

Registration 'of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use' (04/10/2001, C-517/99, Bravo, EU:C:2001:510, § 40). 'Furthermore, it is not appropriate to apply to slogans criteria which are stricter than those applicable to other types of sign' (11/12/2001, T-138/00, Das Prinzip der Bequemlichkeit, EU:T:2001:286, § 44).

Although the criteria for assessing distinctiveness are the same for the various categories of marks, it may become apparent, in applying those criteria, that the relevant public's perception is not necessarily the same for each of those categories and that, therefore, it may prove more difficult to establish distinctiveness for some categories of mark than for others (29/04/2004, C-456/01 P & C-457/01 P, Tabs (3D), EU:C:2004:258, § 38).

Moreover, it is also settled case-law that the way in which the relevant public perceives a trade mark is influenced by its level of attention, which is likely to vary according to the category of goods or services in question (05/03/2003, T-194/01, Soap device, EU:T:2003:53, § 42; 03/12/2003, T-305/02, Bottle, EU:T:2003:328, § 34).

The Office replies to the holder's observations as follows.

1. The Office must disregard the holder's argument that the stylisation of the sign in question (black colour and stylised typeface) satisfies the 'threshold of

distinctiveness' and endows the sign as a whole with a minimum degree of distinctiveness.

The Office certainly agrees with the holder regarding the aforementioned figurative features of the sign. Notwithstanding, it does not consider that the figurative components of the sign applied for are sufficient to endow it with the minimum distinctiveness necessary – in relation to the services at issue – for the sign to function as a trade mark. In other words, the figurative components of the sign applied for do not possess any feature that would allow the mark to fulfil its essential function.

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, SELENIUM-ACE / SELENIUM SPEZIAL A-C-E (fig.), EU:T:2005:289, § 37; 19/12/2011, R 233/2011-4 Best Tone (fig.) / BETSTONE (fig.), § 24; 13/12/2011, R 53/2011-5, Jumbo(fig.) / DEVICE OF AN ELEPHANT (fig.), § 59).

It follows that, when faced with a sign consisting of verbal element(s) combined with a figurative component, consumers normally attach more trade mark significance to the verbal element(s) of the sign. This is all the more so when – as is the case here – the figurative component of the sign is limited to very simple elements (e.g. the stylised typeface and structure of the verbal elements) as all these elements are typically present in labels, where they perform a purely decorative function. Consequently, such figurative elements will be perceived as mere presentational features and embellishments of the respective label, and not as a badge of origin. In contrast, the public will normally attribute the function of indicator of commercial origin precisely to the verbal element that these decorative features embellish.

Furthermore, consumers are not in the habit of over-analysing the individual elements of trade marks, in particular where these elements convey a clear descriptive message (as in the present case) that is directly related to the essential characteristics of the services at issue. The overall arrangement of the sign at issue is not complex or striking in any way. Therefore, the whole sign will be perceived at once.

2. In the present case, the combination applied for is considered no more than the sum of its parts. The interpretation of the sign will not trigger any mental process or require any interpretation in order to grasp its meaning. On the contrary, it conveys a straightforward and meaningful message that the services for which protection is sought are supplied by or rendered in a place where an industrial activity takes place and which respects the environment.

Coupling together the banal elements 'eco' and 'PLANT', without any significant graphic or semantic modification, does not imbue them with any additional characteristic so as to render the sign, taken as a whole, capable of distinguishing the holder's services from those of other undertakings (26/10/2000, T-345/99, Trustedlink, EU:T:2000:246, § 37).

The holder did not demonstrate the existence of an imaginative, surprising or unexpected element requiring at least some interpretation or that sets off a cognitive process in the mind of the relevant public (21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 57) that might confer distinctive character on the mark for which registration is sought (17/09/2015, T-550/14, COMPETITION, EU:T:2015:640, § 28).

Moreover, the sign applied for is devoid of any element that could, apart from its promotional function, enable the average consumer concerned to easily and immediately memorise it as a trade mark for the goods and services referred to (21/01/2010, C-398/08 P, Vorsprung

durch Technik, EU:C:2010:29, § 44-45, 56-59).

The sign for which registration is sought is a composite term. The structure of this expression does not diverge from English grammar rules but rather complies with them. The mark consists of two conjoined words. The sign is simple and basic with no arbitrary, fanciful or imaginative addition, subtraction or alteration of the letters that might render the sign, as a whole, capable of distinguishing the holder's goods from those of others. It contains neither specialist terminology, which would be understood by the relevant specialised public, nor any particularly unusual terms. Neither does it have an original or striking character that would trigger a cognitive process or an interpretative effort.

Consequently, the mark does not create an overall impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word combination is no more than the mere sum of its parts (12/02/2004, C-265/00, Biomild, EU:C:2004:87, § 39, 43).

Therefore, the holder's argument that the sign applied for comprises a minimum degree of distinctive character must be disregarded.

3. Consumers do not perceive a mark in a void, but rather in relation to the goods and services for which protection is sought. Therefore, the context of the goods and services provides a significant interpretative aid as to how consumers will perceive the mark applied for.

The sign applied for does not require any mental steps on the part of the consumer when considered in relation to the services at issue and the relevant consumers.

It is reasonable to accept that the relevant consumer will make a clear link between the mark and the services and, therefore, perceive a descriptive message in the mark. Indeed, the mark not only directly conveys a clear meaning in relation to the services in question, but is also a term that might profitably be employed regarding these services. Moreover, under Article 7(1)(c) EUTMR, a mark must be refused registration where, as is the case here, the indications comprising the mark may be used to designate the goods and services in question. However, it is not necessary that the signs and indications comprising the mark are currently in use (12/01/2005, T-367/02 – T-369/02, SnTEM, SnPUR & SnMIX, EU:T:2005:3).

Additionally, the relevant consumers will instantly perceive the laudatory meaning of 'ecoPLANT' as there is nothing in the trade mark, beyond its obvious promotional meaning, that might enable them to memorise it easily and instantly as a distinctive mark for the services concerned. The relevant public cannot, in the absence of prior knowledge, perceive it other than in its promotional sense. The sign applied for does not constitute a play on words and is not imaginative, surprising or unexpected. It is an ordinary advertising message that possesses no particular resonance. It even lacks the originality and resonance that would make it easy to remember (23/06/2011, R 1967/2010-2, INNOVATION FOR THE REAL WORLD, § 26).

Therefore, the relevant consumer will read the expression 'ecoPLANT' with approval, but will not consider it as a trade mark. It does not serve any function other than that of an endorsement. When viewed in its entirety in relation to the services for which protection is sought, the sign is not open to interpretation.

It is on the basis of acquired experience that the Office submits that the relevant consumers would perceive the mark for which protection is sought as ordinary, and not as the trade mark of a particular proprietor. Since the holder claims that the trade mark applied for is distinctive, despite the Office's analysis based on its experience, it is up to the holder to

provide specific and substantiated information to show that the trade mark sought has distinctive character, either intrinsically or acquired through use, since it is much better placed to do so, given its thorough knowledge of the market (05/03/2003, T-194/01, Soap device, EU:T:2003:53, § 48).

However, the holder has not provided any specific and substantiated information showing that the trade mark applied for has any distinctive character in the relevant market sector that could disprove the Office's analysis, which is based on facts arising from practical experience generally acquired from the marketing of the goods concerned.

Considered as a whole, the Office finds that the mark applied for, in the context of the services for which protection is sought, is not more distinctive than the meaning of the verbal components that comprise it. The Office does not see any immediate strength and distinctiveness in the contested sign that would enable it to be perceived as an independent sign indicating commercial origin.

From close inspection of the notice of grounds for refusal, it can be clearly established that the mark **ecoplant** has been considered as a whole for the purposes of evaluating its descriptiveness, with a focus on the overall impression conveyed by all of its constituent elements together. Notwithstanding this broad approach, an analysis of the components of the trade mark may also be made when evaluating that overall impression (09/07/2003, T-234/01, Orange & Grau, EU:T:2003:202, § 32).

Although the sign applied for contains one verbal element, the relevant consumers, when perceiving a verbal element, will break it down into elements that suggest a concrete meaning, or that resemble words known to them (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 57; 13/02/2008, T-146/06, Aturion, EU:T:2008:33, § 58).

A sign must be refused as descriptive if it has a meaning that is immediately perceived by the relevant public as providing information about the goods and services for which protection is sought. According to the Guidelines, the reference base is the ordinary understanding of the relevant public of the word in question. This can be corroborated by dictionary entries, examples of the use of the term in a descriptive manner found on internet websites, or it may clearly follow from the ordinary understanding of the term.

The Office duly explained the meaning of the sign in the provisional refusal and supported this with dictionary definitions, which reflect how the sign will be understood in the relevant market. Moreover, it is not necessary for the Office to prove that the word is the subject of a dictionary entry in order to refuse a sign. In particular, for composite terms, dictionaries do not mention all possible combinations. What is important is the ordinary and plain meaning.

Furthermore, the Office is not obliged to prove that the signs applied for appear in dictionaries (07/10/2015, T-187/14, Flex, EU:T:2015:759, § 27), since the mere fact that an expression is not mentioned in a dictionary does not render a sign eligible for registration. In fact, dictionaries are not structured to provide every possible word combination (23/09/2015, T-633/13, INFOSECURITY, EU:T:2015:674, § 39; 19/04/2016, T-261/15, Daylong (fig.), EU:T:2016:220, § 32).

The Office reiterates, following the arguments addressed under points 3 and 4, that the sign **ecoplant** does not possess the originality and resonance in the minds of the relevant public that would confer distinctive character on it. The Office maintains its viewpoint that the expression has a straightforward, understandable

meaning. As such, the relevant public will recognise the clear link between the semantic content of the sign and the services at issue. They will clearly see and understand the expression 'ecoPLANT' as a promotional expression, encouraging the consumer to choose the services in question rather than other competing goods and services. Consequently, the relevant public will perceive the expression 'ecoPLANT' as a promotional message, the purpose of which is to highlight the fact that the services concerned are rendered with the respect to the environment. Therefore, the message acts as an incitement to purchase the services concerned.

4. The holder argues that the Office has accepted a number of similar registrations. However, established case-law states that 'decisions concerning registration of a sign as a European Union trade mark ... are adopted in the exercise of circumscribed powers and are not a matter of discretion'. Accordingly, the registrability of a sign as an EUTM must be assessed solely on the basis of the EUTMR, as interpreted by the EU judicature, and not on the basis of previous Office practice (15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 47; 09/10/2002, T-36/01, Glass Pattern, EU:T:2002:245, § 35).

'It is clear from the case-law of the Court of Justice that observance of the principle of equal treatment must be reconciled with observance of the principle of legality according to which no person may rely, in support of his claim, on unlawful acts committed in favour of another' (27/02/2002, T-106/00, Streamserve, EU:T:2002:43, § 67).

As regards the earlier registrations, the mere fact that the cited trade marks contain the verbal element 'eco' does not necessarily make them similar to the sign applied for market practices, languages and registration practices evolve over time, and a trade mark that may have been accepted on the basis that it was considered registrable at the time of its application might not be registrable nowadays. The majority of the previously registered trade marks mentioned were registered more than 13 years ago. The Office is obliged to examine trade marks based on their application date. Therefore, it is possible that, between the earlier registrations and the application date of the mark at issue, the market has developed in such a way that, although the mark was previously registrable, it no longer is.

This applies even if the sign for which registration is sought is structured in an identical / highly similar manner to a mark for which the Office has already approved registration as an EUTM, and which relates to goods or services identical or similar to those for which protection is sought (07/10/2015, T-244/14, Shape of a face in the form of a star (3D), EU:T:2015:764, § 56).

Consequently, a person who seeks registration of a sign as a trade mark cannot rely, to their own benefit, on any unlawful act committed to the benefit of someone else in order to secure an identical decision.

Therefore, the examples of registered EUTM's are not sufficient to overcome the objection.

#### **IV. Conclusion**

For the abovementioned reasons, and pursuant to Article 7(1)(b) and (c) and Article 7(2) EUTMR, protection of international registration No 1 715 386 is refused for the European Union.

According to Article 67 EUTMR, you have a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings



in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.



**Marina TOMIĆ**