



Intellectual Property Office

Serving the Bailiwick of Guernsey

Formal Notice of Amendment to Practice Office of the Registrar of Intellectual Property, Bailiwick of Guernsey

Acquired Distinctiveness – Evidence

This notice sets out guidance to clients about the information and evidence that may be considered relevant by the Office of the Registrar of Intellectual Property in demonstrating acquired distinctiveness of signs/marks as applied for in the Bailiwick.

The sections of this Notice below are indicative and not exhaustive. They are provided as a guide to clients, however, additional relevant material will also be considered if provided and may support representations to the Registrar in a case for acquired distinctiveness.

Section 1 – Distinctiveness Acquired through Use

Section 3 of the Trade Marks (Bailiwick of Guernsey) Ordinance, 2006 states:

'a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it'.

A mark may still be registered provided it can be satisfactorily shown by the client that by the date of application filed at the Intellectual Property Office the mark has in fact, through the use made of it, acquired distinctive character.

Section 2 – Geographical Area

Acquired distinctiveness through use demonstrated in evidence provided to the Office of the Registrar, shall be considered in relation to the geographical area of the use and the relevance of that use to the Bailiwick of Guernsey

Direct evidence of distribution, sales and turnover within this jurisdiction will be strongly persuasive.

Evidence that the services may be accessed from this jurisdiction will be weaker but relevant.

Access to advertising in this jurisdiction, but not direct availability of distribution or services, is considered the weakest evidence.

If the only use of the sign as a trade mark is outside the Bailiwick, the mark may not be accepted. It will be necessary to provide persuasive evidence that the mark or sign has acquired distinctiveness in fact in the minds of the relevant public in the Bailiwick of Guernsey.

Section 3 – Distinctive use as a trade mark

The mark will have been used distinctively in relation to the goods/services by one undertaking and that use will be use as a *trade mark*

Views of an average consumer will be taken into account rather than sole reference to general abstract data (eg. percentages of recognition by the relevant class of persons. That consumer will have come to recognise the trade source of the goods as a result of the proprietor educating them on that perception.

A mark that is less likely than another to be perceived to perform the function of a trade mark will have a higher requirement for evidence of acquired distinctiveness than an mark that may be more easily recognised as an indicator of trade origin.

Section 4 – Colour as signs or marks

Persuasive evidence will be required in order to demonstrate satisfactorily that a pure colour mark/sign is capable of performing the function of a trade mark having the ability in the mind of the correct class of consumer to identify the colour with one undertaking. There is more likelihood of demonstrating factual distinctiveness for a colour mark where the goods or services are very restricted and the relevant market very specific. This is a complex issue.

Section 5 – Market Share

Evidence of market share held by the applicant will be relevant. The reach of the produce in relation to the proportion of the relevant public will be relevant in considering the evidence provided in such representations.

Section 6 – Turnover & Period of Use

Turnover and period of use relating directly to the Bailiwick will be the strongest evidence.

Turnover and period of use in areas other than the Bailiwick of Guernsey will be considered as weaker evidence.

There is not requirement for the trade or turnover to be uninterrupted but the length of the period of use will be relevant to the assessment.

Evidence of first use must relate to use before the date of filing. Use of the sign/mark after the date of filing will not be considered acceptable evidence in relation to the question of acquired distinctiveness.