



CONVERGENCE OF TRADE MARK AND DESIGN PRACTICES: PAST, PRESENT AND FUTURE

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MARCH 2022

PROGRAMME

50'
Presentation

1. Overview of Convergence
2. Convergence in action
 - 2.1 Trade Marks
 - 2.2 Designs
3. The legacy of Convergence

10'
Questions and answers



1

OVERVIEW OF CONVERGENCE



LEGAL BASIS

Art. 151 • EUTMR

The EUIPO shall promote convergence of practices in the fields of trade marks and designs, in cooperation with the MS IPOs

Art. 152 • EUTMR

1. Cooperation with the MS IPOs shall cover, among others, the development of common examination standards and common practices.
2. The EUIPO shall consult with user representatives in particular in the phases of definition of the projects

Art. 51 • TMD

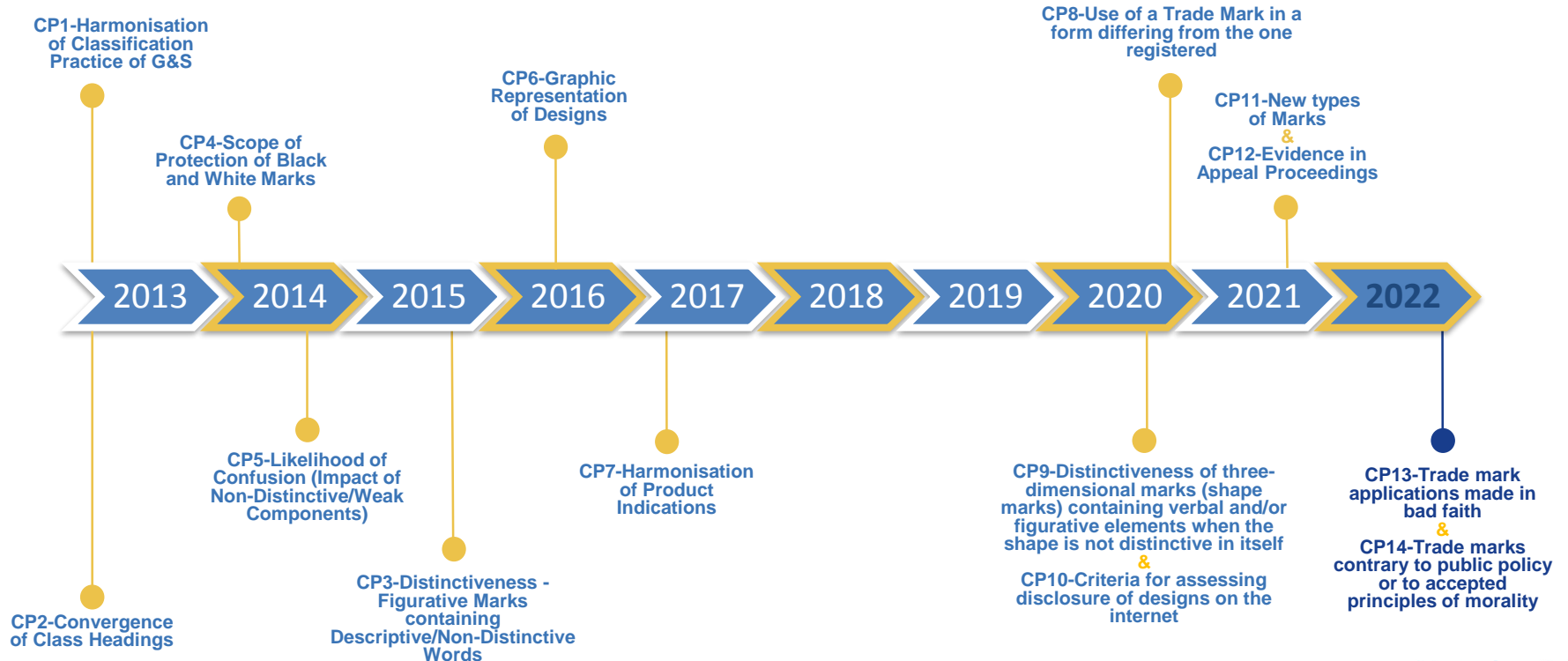
The offices shall be free to cooperate effectively with each other and with the EUIPO in order to promote convergence of practices in relation to the examination and registration of trade marks.

EUROPEAN UNION IP NETWORK

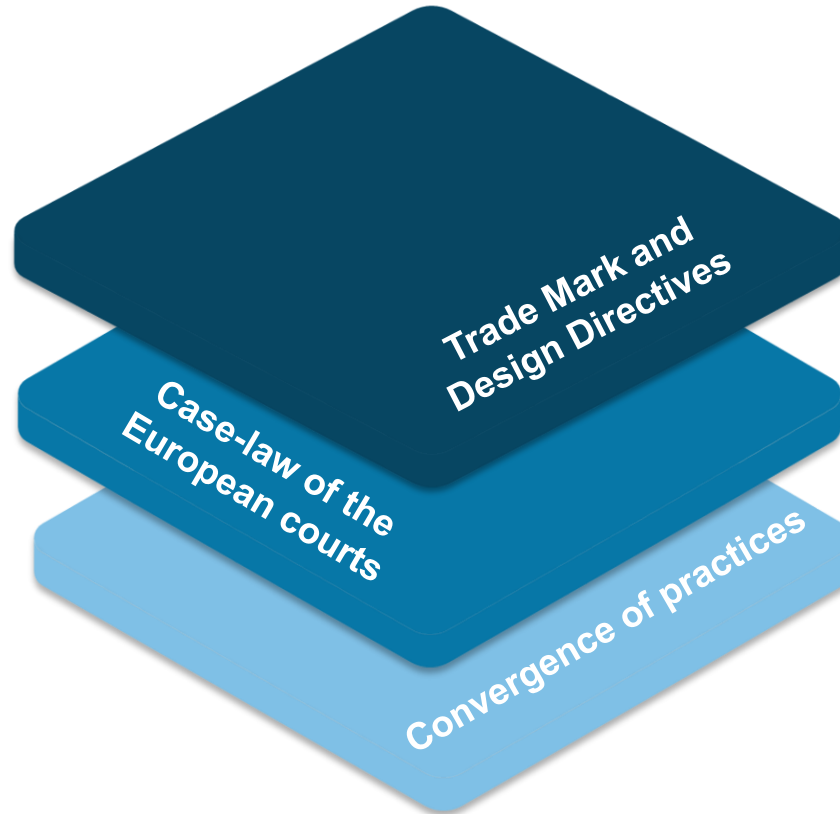
Intellectual Property Offices and User Associations



ACHIEVEMENTS OF THE EUROPEAN UNION IP NETWORK



LAYERS OF HARMONISATION IN EUROPE



CONVERGENCE OF PRACTICES: VISION AND OBJECTIVES

“To establish and communicate
clarity, legal certainty,

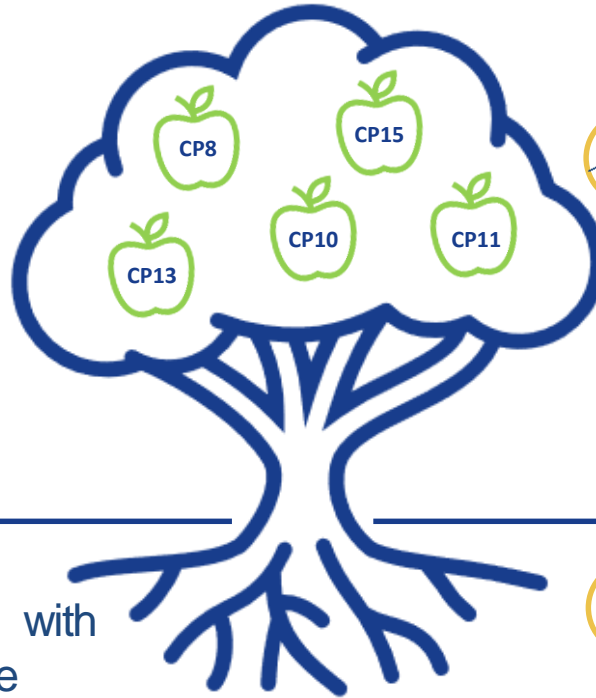


quality and usability for both
applicant and office.”

CONVERGENCE ANALYSIS

Objective

Identify areas of trade mark and design practice where convergence of practices may bring the greatest benefits to users of the European IP system



New convergence projects selected for launch



In-depth analysis of areas with the potential for convergence



Consultation with EUIPN stakeholders

MAINTENANCE OF COMMON PRACTICES

Objective

To establish and utilise a more developed and systematic maintenance system to ensure the sustainability of EUIPN convergence the effective management of Common Practices (CPs).



Monitoring and reporting on CP implementation by IPOs



Review of relevant case-law



Knowledge exchange on the real-life application of CPs within IPO decisions



Training materials, promotion and awareness building

BRINGING A COMMON PRACTICE TO FRUITION



- Working Groups consist of IPOs and UAs
- Share views, experience, expertise



- Working Group meetings & drafting workshops
- Total time required: approx. 2 years



- Numerous drafts and revisions circulated
- Supported via extensive research



- Requires Liaison Meeting acknowledgement and Management Board adoption (all 26 IPOs)

Common Practice Development



BRINGING A COMMON PRACTICE TO FRUITION



- Common Practice translated into 23 official EU languages
- Published on EUIPN website (TMDN.org)

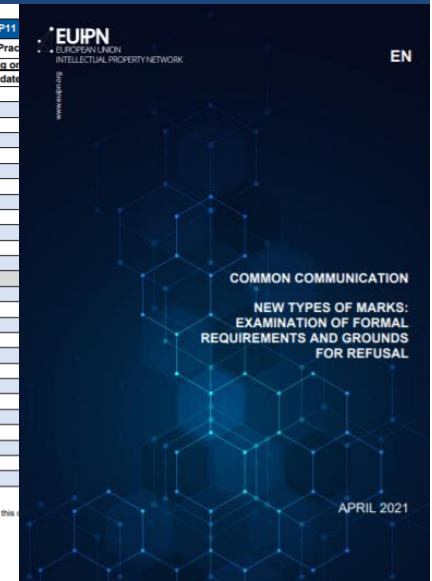


- Training material developed, e.g. webinars and PPTs
- Common Practice availability promoted across EUIPN

Common Practice Implementation

Overview of Implementations of the CP11		
Office	Implementation date	The Common Practice
		Proceedings <u>pending</u> on the implementation date
AT	1 July 2021	
BG	14 April 2021	x
BX	14 April 2021	x
CY	14 July 2021	
CZ	14 July 2021	
DE	1 June 2021	x
DK	14 July 2021	x
EE	1 May 2021	
ES	14 April 2021	
EUIPO	14 April 2021	x
FI	14 April 2021	x
FR	14 April 2021	x
GR ⁽¹⁾		
HR	14 April 2021	
HU	1 May 2021	
IE	14 April 2021	
IT	14 July 2021	
LT	1 June 2021	x
LV	14 April 2021	
MT	14 July 2021	
PL	14 July 2021	x
PT	14 April 2021	
RO	14 April 2021	
SE	1 July 2021	x
SI	14 April 2021	
SK	14 April 2021	x

No implementation of the Common Practice in the IP Office to this date



⁽¹⁾ The IP Office acknowledged the Common Practice and implementation is delayed for technical reasons.



2

CONVERGENCE IN ACTION



2.1

CONVERGENCE IN ACTION: TRADE MARKS

CONVERGENCE IN ACTION: TRADE MARKS

Classification of goods and services

CP1-CP2

CP1 AND CP2: TRADE MARK CLASSIFICATION PRACTICE

CP1:
**Harmonisation on
Trade Marks Classification
Practice of G&S**



CP2:
**Convergence
of Class Headings**

***CP1** supplies a common harmonised database of goods and services, as well as guidelines on clear and precise terms. **CP2** compiles IPOs' interpretations of the scope of protection of trade marks containing entire Nice class headings.*

CP1 AND CP2: EVOLUTION

1 IDENTIFY NEEDS

- Potential impact of Trade Mark legal reform on CP1 and CP2

2 ANALYSE

- Expert analysis carried out by IPOs and UAs
- Proposals published for public consultation

3 UPDATE

- Updated CP1 and CP2 Common Communications



CONVERGENCE IN ACTION: TRADE MARKS

Absolute Grounds

**CP3, CP9,
CP11, CP13, CP14**

CP3: DISTINCTIVENESS

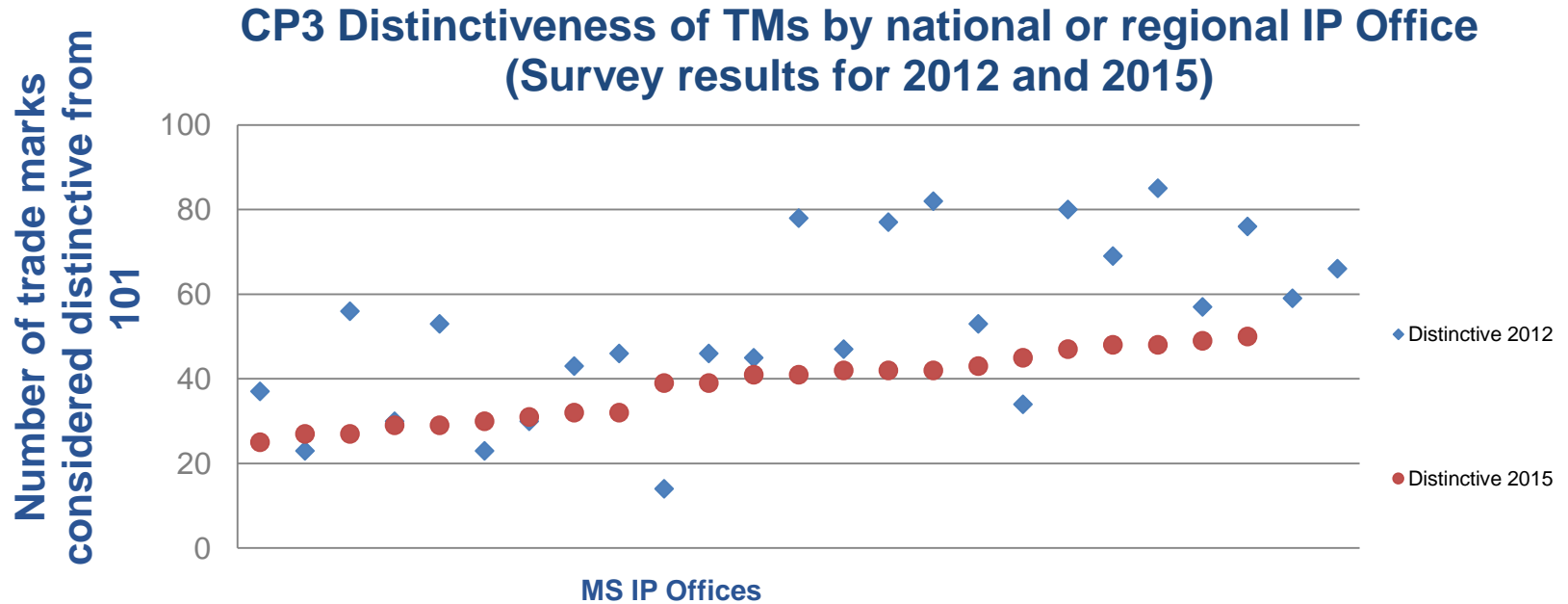
CP3: Distinctiveness - figurative marks containing descriptive/non-distinctive words

FLAVOUR AND AROMA

(Class 30: Coffee)

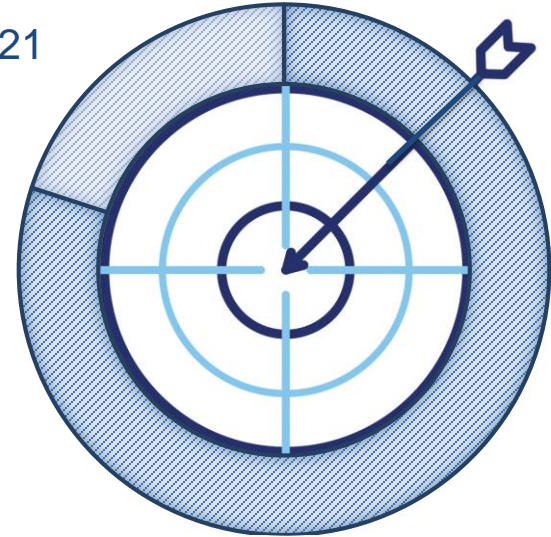
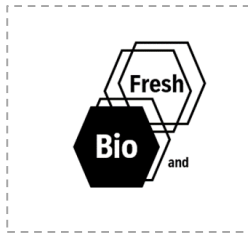
CP3 provides harmonised guidelines on when a figurative mark, containing purely descriptive/non-distinctive words, passes absolute grounds examination because the figurative element renders sufficient distinctive character.

CP3: BEFORE AND AFTER



CP3: SIX YEARS LATER

- New questionnaire sent to IPOs and UAs in 2021
- Including both real and fictitious examples
- **81%** alignment among IPOs and UAs



81%

CP3: KNOWLEDGE EXCHANGE ON COMMON PRACTICES WITH USERS



15 users
represented
8 UAs



8 IPOs
volunteered
decisions



23
decisions
discussed



**PRO
ESCAPE**

Classic

KIDMARKET

BARISTA
COFFEE TRAINING POINT

CP3: TRAINING MATERIALS




• CP3 Principles



• Case studies



• CP3 Case-law overview


CP3: Distinctiveness of figurative marks containing descriptive/non-distinctive words


Case-law related to CP3

General Court

Case T-686/18, 3 October 2019

Appeal dismissed
Trade mark found non-distinctive

(43) The figurative elements of the mark applied for, **taking into account, in substance, their shape and position, are not capable of diverting the relevant public from the descriptive message conveyed by the verbal elements** so that the mark is not distinctive.


CP3: Distinctiveness of figurative marks containing descriptive/non-distinctive words

With respect to the word elements of the mark

[A1] **Typeface and font.** In general, descriptive/non-distinctive word elements appearing in basic/standard typeface, lettering or handwritten style typefaces – with or without font effects (bold, italics) – are not registrable.

CP3 example	IPO example
<div style="border: 1px solid gray; padding: 10px; margin: 0 auto; width: 80%;"> <p style="font-family: cursive; font-size: 1.2em; color: #003366;"><i>Fresh Sardine</i></p> <p style="font-size: 0.8em; color: #003366;">Class 29: Sardines</p> <p style="color: red; font-weight: bold; font-size: 0.8em;">Non-distinctive</p> </div>	<div style="border: 1px dashed gray; padding: 10px; margin: 0 auto; width: 80%;"> <p style="font-family: cursive; font-size: 1.2em; color: #003366;"><i>Classic</i></p> <p style="font-size: 0.8em; color: #003366;">Class 9: Glasses, sunglasses and accessories thereof</p> <p style="color: red; font-weight: bold; font-size: 0.8em;">Non-distinctive</p> </div>

CP9: DISTINCTIVENESS OF THREE-DIMENSIONAL MARKS

CP9: Distinctiveness of three-dimensional marks (shape marks) containing verbal and/or figurative elements when the shape is not distinctive in itself



CP9 establishes a minimum threshold for the distinctiveness of shape marks containing other elements when the shape itself is non-distinctive.

LEGAL REFORM AND NEW TYPES OF MARKS

Elimination of the graphic representation requirement from the definition of a trade mark

Common Communication on the representation of new types of trade marks

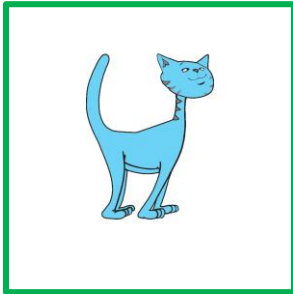
Laid the groundwork for CP11



CP11: NEW TYPES OF MARKS

CP11: New types of marks – examination of formal requirements and grounds for refusal

MOTION MARK



Class 25: Clothing

MULTIMEDIA MARK



Class 25: Clothing

CP11 provides general principles for the examination of formal requirements and absolute and relative grounds for refusal of the new types of trade marks, namely sound, motion, multimedia and hologram marks.

CP13: BAD FAITH

CP13: Trade mark applications made in bad faith



CP13 aims to provide a harmonised understanding of the notion of bad faith and of other concepts, including terminology, related to its assessment as well as to the factors that may prove relevant in the assessment

CP14: PUBLIC POLICY AND MORALITY

CP14 - Trade marks contrary to public policy or to accepted principles of morality



BLACK LIVES MATTER

CP14 aims to reach a common understanding of the concepts of public policy and accepted principles of morality as well as common criteria for assessing if a sign is contrary to public policy and/or to accepted principles of morality’.

CONVERGENCE IN ACTION: TRADE MARKS

Relative Grounds

**CP4, CP5,
CP8, CP11**

CP4: SCOPE OF PROTECTION OF B&W MARKS

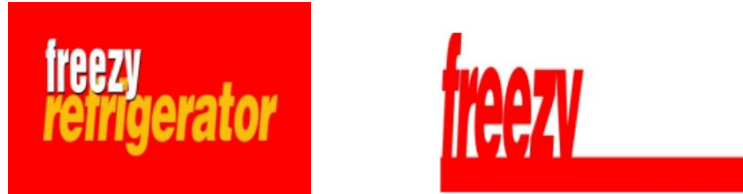
CP4: Scope of protection of black and white (B&W) marks



CP4 delivers a common interpretation of the scope of protection of trade marks exclusively in black, white and/or shades of grey (and whether they cover any/all colours or not).

CP5: RG – LIKELIHOOD OF CONFUSION

CP5: Relative grounds – likelihood of confusion (impact of non-distinctive/weak components)

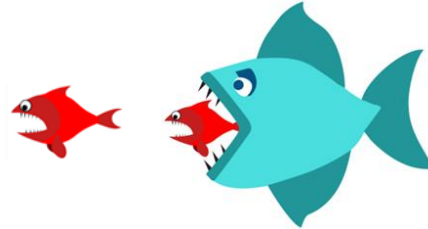


(Class 11: Refrigerators) LOC

CP5 provides harmonised principles regarding the impact of non-distinctive/weak components of trade marks when assessing likelihood of confusion between trade marks with identical goods and/or services.

CP8: USE OF A MARK IN A FORM DIFFERING FROM THE ONE REGISTERED

CP8: Use of a trade mark in a form differing from the one registered



CP8 delivers general principles for assessing when the use of a trade mark in a form differing from the one registered alters its distinctive character.

CP11: NEW TYPES OF MARKS

CP11: New types of marks – examination of formal requirements and grounds for refusal

Earlier motion mark



Contested hologram mark



CP11 provides general principles for the examination of formal requirements and absolute and relative grounds for refusal of the new types of trade marks, namely sound, motion, multimedia and hologram marks.

CP11: BEFORE AND AFTER

IPOs with guidelines for examiners on how to assess formal requirements and grounds for refusal on new types of trade mark

June 2018



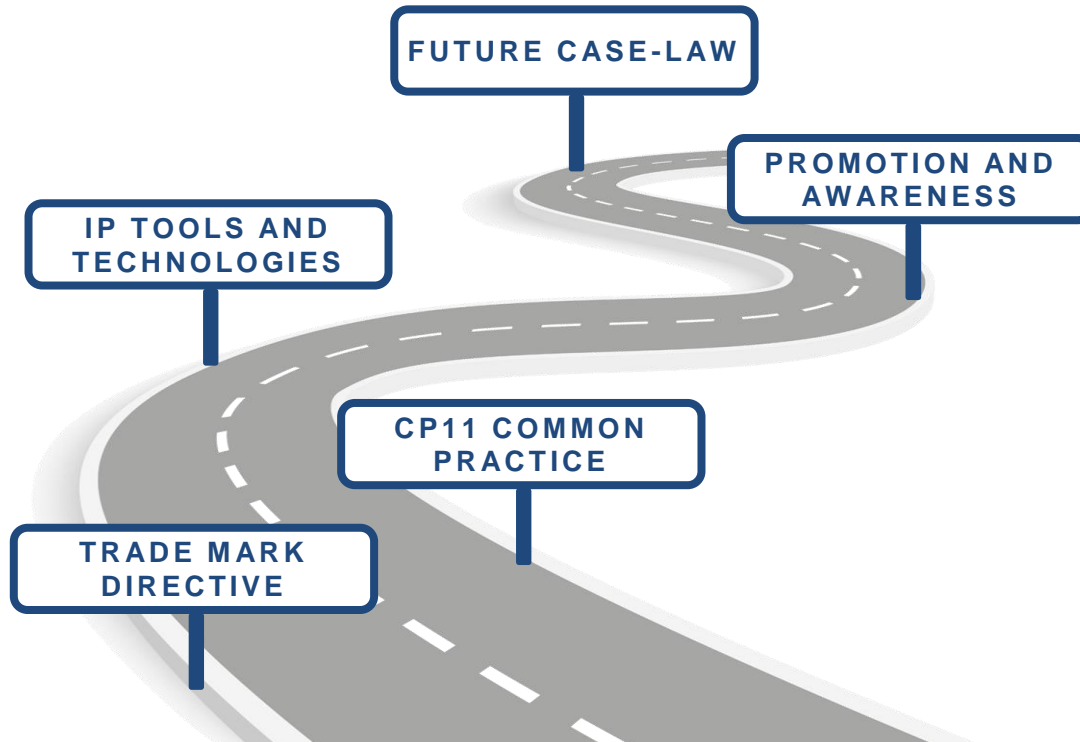
 0 Offices

July 2021



 25 Offices

NEW TYPES OF MARKS: AN ONGOING JOURNEY



CONVERGENCE IN ACTION: TRADE MARKS

Appeal proceedings

CP12

CP12: EVIDENCE IN APPEAL PROCEEDINGS

CP12 - Evidence in trade mark appeal proceedings: filing, structure, and presentation of evidence, and treatment of confidential evidence

Basic Image Information

Target file: Alicante_EUIPO6.JPG

Camera:	Olympus VG170
Lens:	4.7 mm (Max aperture f2.8) (shot wide open)
Exposure:	Auto exposure, Creative (Slow speed), 1/1,000 sec, f2.8, ISO 80
Flash:	Auto, Did not fire
Date:	December 1, 2018 11:41:04AM (timezone not specified) (3 months, 10 days, 20 hours, 14 minutes, 12 seconds ago, assuming image timezone of US Pacific) A
File:	4,288 x 3,216 JPEG (13.6 megapixels) 3,192,982 bytes (3.0 megabytes)
Color Encoding:	WARNING: Color space tagged as sRGB, without an embedded color profile. Windows and Mac browsers and apps treat the colors randomly. <small>Images for the web are most widely viewable when in the sRGB color space and with an embedded color profile. See my Introduction to Digital-Image Color Spaces for more information.</small>



CP12 provides recommendations in the area of evidence, in relation to filing, structure and presentation of evidence within trade mark appeal proceedings, as well as the treatment of confidential evidence in appeal decisions.



2.2

CONVERGENCE IN ACTION: DESIGNS

CP6: GRAPHIC REPRESENTATIONS OF DESIGNS

CP6: Graphic representations of designs



RCD No. 000910146-0004 (12.08) (Automobiles (part of-))
Owner: TOYOTA MOTOR CORPORATION

Example 8 - Colour shading correctly applied

CP6 provides guidance related to design examinations, in particular on how appropriate visual disclaimers should be used, acceptable types of views, and what constitutes a neutral background when representing a design.

CP7: HARMONISATION OF PRODUCT INDICATIONS

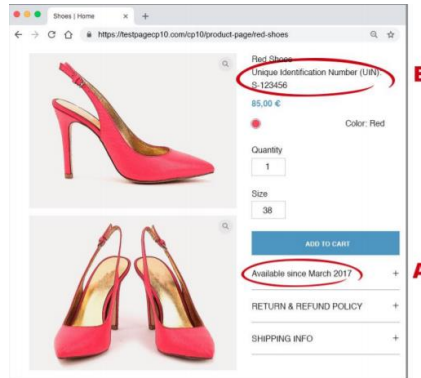
CP7: Harmonisation of Product Indications



CP7 established a harmonised database of around 15,000 product indications for designs.

CP10: CRITERIA FOR ASSESSING DISCLOSURE OF DESIGNS ON THE INTERNET

CP10: Criteria for assessing disclosure of designs on the internet



CP10 delivers criteria for assessing disclosure of designs on the internet and related recommendations

DESIGNS: A NEW ERA OF CONVERGENCE

Designs legal reform and a new era of CONVERGENCE

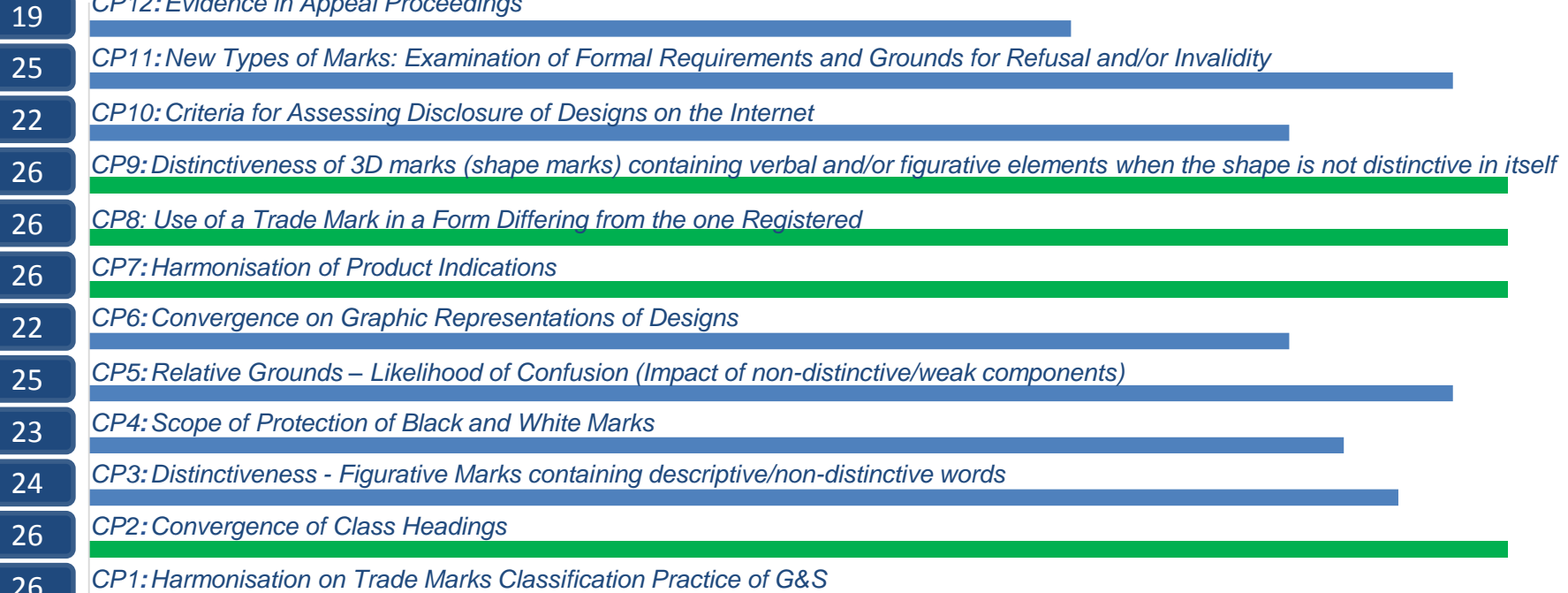




3

THE LEGACY OF CONVERGENCE

EUIPN IMPLEMENTATIONS PER COMMON PRACTICE



SUPPORT ACROSS THE EU



“...The harmonisation of the practices of IPOs have considerably facilitated the examination practice in the design and trade mark proceedings...”



“The convergence of practices has contributed to better predictability of IPO's decisions, transparency and legal certainty for IP users.”



“They have ensured more consistency in decision making and consequently increased legal certainty.”



“The Common Practices have been appreciated by the Office's examiners, as well as our users.”



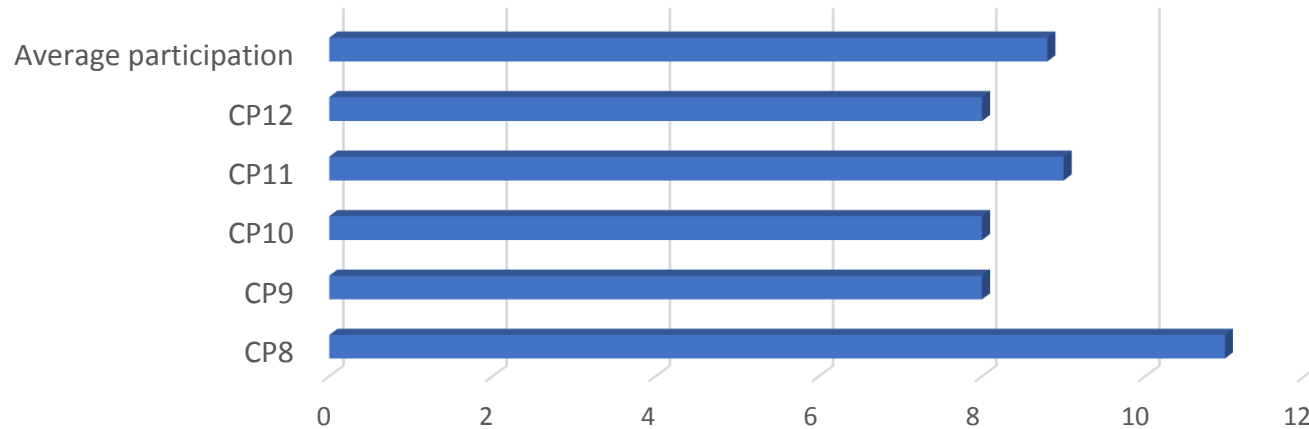
“...it's beyond any doubt that all of them have proved to be extremely helpful in the context of the examination activities of our Office.”



“They act as a good reference point for both Examiners and Applicants in the event of any uncertainty.”

UAs' PARTICIPATION IN CONSULTATIONS (CP8-CP12)

UAs' participation in consultations (CP8-CP12)



	CP8	CP9	CP10	CP11	CP12	Average participation
■ UA participants	11	8	8	9	8	8.8

BENEFITS OF CONVERGENCE



Increased legal certainty

More predictable outcomes of the examination



Clarity and transparency

CPs available publicly in all EU Languages



Quality and usability

Clear and detailed criteria, user-friendly and reflect market realities



Time and cost savings

Reduction in application processing

COMMON PRACTICES UPHELD BY THE COURTS

*Splendid**

Classes: 18, 21

*Decision of the General Court T-203/14,
Splendid, EU:T:2015:301, on the distinctiveness
of figurative marks containing descriptive/non-
distinctive words*



*The German Federal Court of Justice
(Bundesgerichtshof, BGH) I ZR 153/14,
'BMW', on the scope of protection of black
and white marks*

GLOBAL REACH

Practice Papers adopted by non-EU IPOs



TO THE WORD ELEMENTS

Word based

- In general, descriptive/non-distinctive word elements associated to specific, lettering or handwritten styles/types/ font effects (bold, italic) – are not registrable.

Non-distinctive examples:

Fresh Sardine **Fresh Sardine** **Fresh Sardine** **Fresh Sardine**

Flavour of sardine **Flavour of sardine** **Flavour of sardine** **Flavour of sardine**

- Where standard typobases incorporate elements of graphic design as part of the lettering, those elements need to have sufficient impact on the mark as a whole to render it distinctive. When these elements are sufficient to attract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark, the mark is registrable.

Distinctive examples:

Flavour of sardine **FLAVOUR OF SARDINE** **DIV**

Criterion **Combination with colour**

Common practice

- The mere 'addition' of a single colour to a descriptive/non-distinctive word element, either to the letters themselves or as a background, will not be sufficient to give the mark distinctive character.
- Use of colours is common in trade and would not be seen as a badge of origin. However, it cannot be excluded that a particular arrangement of colours is unusual and can be easily remembered by the relevant consumers to render a mark distinctive.

Non-distinctive examples:

Flavour of sardine **Flavour of sardine** **Flavour of sardine**

عنصر الكلمة في العلامات

عندما تكون العلامات الحروف العادية مستمدة من عناصر ذات معنى بمرادف الكلمة من الكتابة العادية، ولا تملك العناصر معنى إلى أن يكون لها تأثير كاف على المستهلك لكيانها لتصبح مميزة، عندما تكون تلك العناصر كلمة مشتقة هذه المشتقات من المعنى الواسع للمصطلح المشتق أو بحيث أن تكون العلامة ذاتها من العلامات ذات المعنى الصحيح فإذ لا تستحق.

أحدًا على العلامات غير المسجلة:

Flavour of sardine **Flavour of sardine** **Flavour of sardine** **Flavour of sardine**

Fresh Sardine **Fresh Sardine** **Fresh Sardine** **Fresh Sardine**

Flavour of sardine **FLAVOUR OF SARDINE** **DIV**

المعيار **الجمع مع اللون**

الممارسة الشائعة

- إضافة لون واحد إلى عنصر حروف معنوية أو صورة العلامات الحروف العادية، سواء كانت خلفية العلامات، لن يكون كافياً لتجعل العلامات مميزة.
- استخدام الألوان في التجارة أمر شائع ولن يُنظر إليه كعلامة مميزة، إلا إذا كان ترتيب الألوان بشكل غير عادي، بحيث يمكن للمستهلكين التعرف على المشتقات من المعنى الواسع للمصطلح المشتق أو بحيث أن تكون العلامة ذاتها من العلامات ذات المعنى الصحيح فإذ لا تستحق.

أمثلة على العلامات غير المسجلة:

Flavour of sardine **Flavour of sardine** **Flavour of sardine**

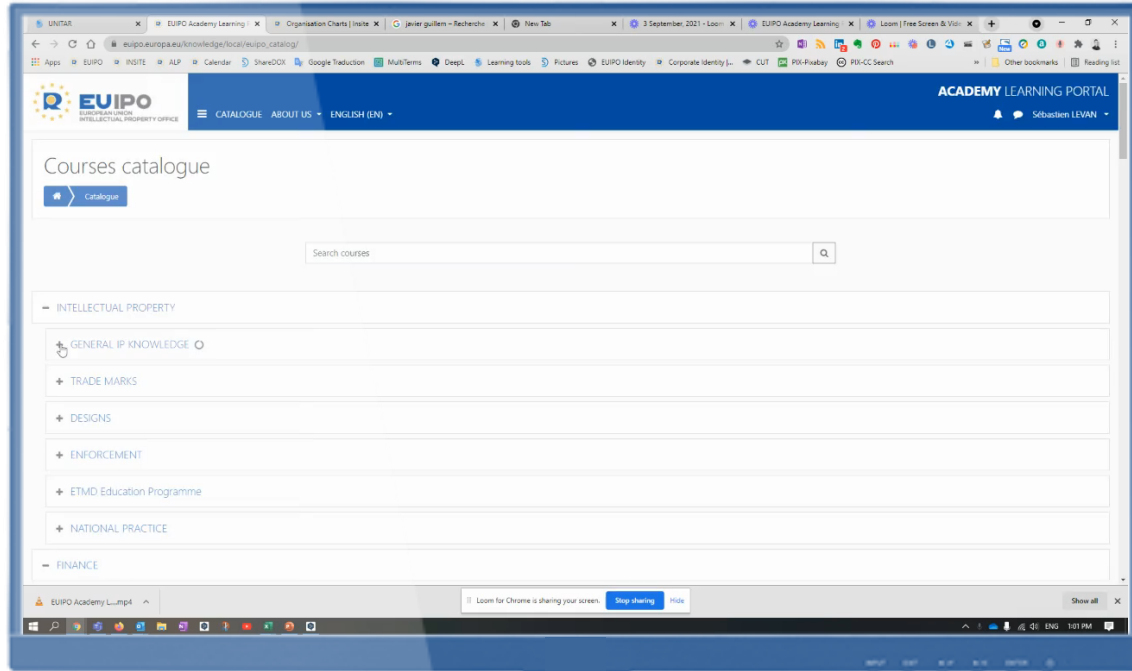
FURTHER INFORMATION

Further information available on [TMDN.org](https://www.tmdn.org) & Webinars

	Common Communications, FAQs and Training Materials	Webinars
CP1	Harmonisation on Trade Marks Classification Practice of G&S	
CP2	Convergence of Class Headings	
CP3	Distinctiveness - Figurative Marks containing descriptive/non-distinctive words	Distinctiveness - Figurative marks containing descriptive/non-distinctive words
CP4	Scope of Protection of Black and White Marks	Scope of Protection of Black and White Marks
CP5	Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components)	Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components)
CP6	Graphic representation of Designs	Graphic representation of designs
CP7	Harmonisation of Product Indications	Harmonisation of Product Indications (Phase 1) Harmonisation of Product Indications (Phase 2)
CP8	Use of a trade mark in a form differing from the one registered	Use of a mark in a form differing from the one registered
CP9	Distinctiveness of three-dimensional marks (shape marks) containing verbal and/or figurative elements when the shape is not distinctive in itself	Distinctiveness of shape marks
CP10	Criteria for assessing disclosure of designs on the internet	Disclosure of design on the Internet
CP11	New types of Marks: Examination of Formal Requirements and grounds for refusal	New Common Practices 2021: new types of trade marks and appeal proceedings
CP12	Evidence in Trade Mark Appeal Proceedings: Filing, structure and presentation of evidence, and the treatment of confidential evidence	New Common Practices 2021: new types of trade marks and appeal proceedings



Keep in touch with EUIPO Academy



THANK YOU



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THANK YOU