

Webinar

CP3 - Experience on implementation and latest case law

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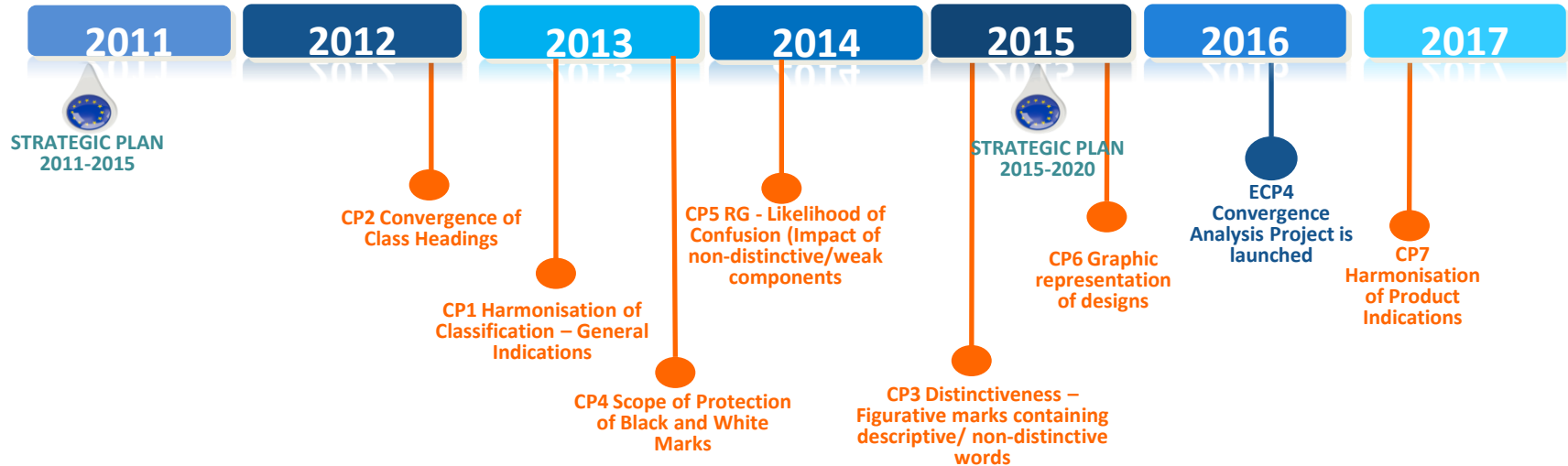
CONTENTS

Table of contents

- **ENDORSEMENT OF CONVERGENCE PROJECTS AND FUTURE**
- **IMPLEMENTATION OF THE CP3 COMMON PRACTICE**
- **PRINCIPLES & ILLUSTRATIVE CASES**
 - **WORD ELEMENTS**
 - **FIGURATIVE ELEMENTS**
 - **BOTH WORD & FIGURATIVE ELEMENTS**
- **CONCLUDING REMARKS**



Convergence Projects: endorsements



SP 2015-2020 ECP4: Convergence Analysis Project

LoA4: Intensify
network
engagement

ECP4: Shared
Services and
Practices

Subproject ECP4:
Convergence
Analysis Project

VISION

“Progressively map the main areas of EU IP Offices trade mark and design practices and analyse them to identify those areas where convergence of practices can be achieved for the benefit of both EU IP Offices and users.”

IMPLEMENTATION OF THE CP3 COMMON PRACTICE

“Establish a common practice in relation to when a figurative mark, containing purely descriptive /non- distinctive words, passes the absolute grounds examination because the figurative element renders sufficient distinctive character”

The Common Communication was published in October 2015 and implemented by 25 Offices



OVERVIEW OF THE CRITERIA

With respect to the **word** elements in the mark:

- Typeface and font
- Combination with colour
- Combination with punctuation marks and other symbols
- Position (sideways, upside-down, etc.)

With respect to the **figurative** elements in the mark:

- Use of simple geometric shapes
- The position and proportion (size) of the figurative element in relation to the word
- Whether the figurative element is a representation of the goods and/or services
- Whether the figurative element is commonly used in trade in relation to the goods and/or services applied for

With respect to **both** the word and the figurative elements in the mark:

- How combinations of the criteria affect distinctiveness

OVERVIEW OF THE CRITERIA

With respect to the **word** elements in the mark:

- Typeface and font
- Combination with colour
- Combination with punctuation marks and other symbols
- Position (sideways, upside-down, etc.)

A. With respect to the word elements in the mark

Typeface and font

COMMON PRACTICE

FLAVOUR AND AROMA



(Class 30: Coffee)

Basic typeface

flavour and aroma



(Class 30: Coffee)

Stylised handwritten
lettering

A. With respect to the word elements in the mark

Typeface and font

EUIPO BOA R503/2016-1



COSY
CASHMERE
(Class 42)

SPANISH Office



*Médecin
Expert*

(Classes 38, 41 & 42)

LITHUANIAN Office



Yentas

(Classes 1, 5, 8, 17, 21, 22)

EUIPO BOA R0450/2014-4



AirTram

(Class 12)

A. With respect to the word elements in the mark

Combination with colour

COMMON PRACTICE

Flavour and aroma



(Class 30: Coffee)

Addition of one single colour
to a basic typeface

Flavour and aroma



(Class 30: Coffee)

Coloured background or frame

A. With respect to the word elements in the mark



Combination with colour

General Court T-663/14



×

**BIG
BINGO**

(Classes 9, 28 & 41)

BENELUX Office



×

PRO-Tape

(Class 17)

General Court T-494/14



×

watt

(Classes 35, 39 & 42)

FRENCH Office



×

**PETIT
ROSE
TOUT
SIMPLE**
+ CÔTES DE PROVENCE B

(Class 33)

A. With respect to the word elements in the mark

Combination with colour

General Court T-237/15



NANO

(Class 28)

General Court T-04/15



Q10

(Class 3)

LITHUANIAN Office



creme.lt

(Class 35)

BULGARIAN Office



PROMO

(Class 5, 29 & 30)

A. With respect to the word elements in the mark

Combination with punctuation marks and other symbols

COMMON PRACTICE

FreshSardine.™



(Class 29: Sardine)

Addition of a full stop

“Flavour and aroma”



(Class 30: Coffee)

Addition of quotation marks

A. With respect to the word elements in the mark

Combination with punctuation marks and other symbols

CJEU C-37/03



Biold.[®]

(Classes 9, 38 & 42)

General Court T-366/12



**Yoghurt-
Gums[®]**

(Class 30)

A. With respect to the word elements in the mark

Position of the word elements

COMMON PRACTICE



Flavour and Aroma

(Class 30: Coffee)

All the text upside-down



F d
l n
a a
v m
o
r u
A r

(Class 30: Coffee)

A. With respect to the word elements in the mark

Position of the word elements

EUIPO BOA R0374/2014-2



 Building
Tomorrow's Enterprise

Classes 35, 36, 37, 38, &42

LITHUANIAN Office



 **TECH**^{TOP}

Class 35

General Court T-504/12



 **NOTFALL**
CREME

Classes 3 & 5

BENELUX Office



 **BETALIN**
GSACHT
ERSTAN
DEN.nl

OVERVIEW OF THE CRITERIA

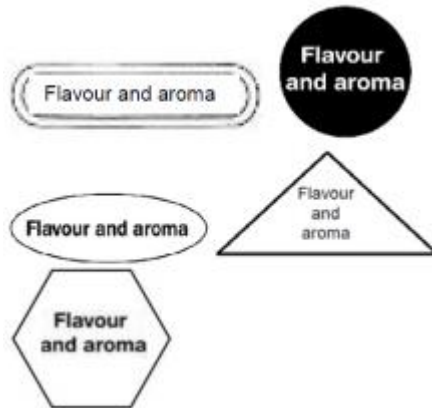
With respect to the **figurative** elements in the mark:

- Use of simple geometric shapes
- The position and proportion (size) of the figurative element in relation to the word
- Whether the figurative element is a representation of the goods and/or services
- Whether the figurative element is commonly used in trade in relation to the goods and/or services applied for

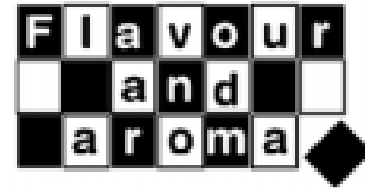
B. With respect to the figurative elements in the mark

Use of simple geometric shapes

COMMON PRACTICE



(Class 30: Coffee)



(Class 30: Coffee)

B. With respect to the figurative elements in the mark

Use of simple geometric shapes

General Court T-360/15



(Class 10)

EUIPO BOA R 2063/2014-4



(Classes 35, 36, 39, 42 & 45)

BENELUX Office



(Classes 3 & 5)

LITHUANIAN Office



(Class38)

B. With respect to the figurative elements in the mark

The position and proportion (size) of the fig. element in relation to the word element

COMMON PRACTICE

 *Fresh Sardine*

(Class 29: Sardines)




Flavour and aroma


(Class 30: Coffee)

B. With respect to the figurative elements in the mark

The position and proportion (size) of the fig. element in relation to the word element

EUIPO BOA R2516/2013-2 



EUIPO BOA R0781/2014-4 



General Court T-203/14 



LITHUANIAN Office 



B. With respect to the figurative elements in the mark

The figurative element is a representation of, or has a direct link with the G&S

COMMON PRACTICE



Fresh Sardine

(Class 29: Sardines)



Fresh Sardine

(Class 29: Sardines)

B. With respect to the figurative elements in the mark

The figurative element is a representation of, or has a direct link with the G&S

EUIPO BOA R0955/2016-5



Classes 29, 30 & 31

PORTUGUESE Office



Cereja do Fundão

Class 31

EUIPO BOA R2931/2014-5



Classes 39

FRENCH Office



KAWA

Class 32

B. With respect to the figurative elements in the mark

The figurative element is a representation of, or has a direct link with the G&S

ESTONIAN Office



Class 35

CROATIAN Office



Class 44

BENELUX Office



EUIPO BOA R1655/2016-5



BēGreen!
ORGANIC JUICE

Classes 29, 30 & 32

B. With respect to the figurative elements in the mark

The figurative element is commonly used in trade in relation to the goods and services applied for

COMMON PRACTICE

×



(Class 30: Coffee)

×



(Class 29: Sardines)

B. With respect to the figurative elements in the mark

The figurative element is commonly used in trade in relation to the goods and services applied for

General Court T-608/14



(Classes 3 & 5)

BULGARIAN Office



(Class 10)

BENELUX Office






















SPANISH Office



(Classes 4, 35, 39)

How do combinations of the individual criteria affect distinctiveness?

<p>1.</p> <p>     </p>	<p>  </p>
<p>2.</p> <p>     </p>	<p>    </p>
<p>3.</p> <p>     </p>	<p>   </p> <p>  </p>

Converging Practices

The EUIPO **Convergence Programme**, launched in 2011, links EUIPO with National Offices and User Associations in an effort to reach common ground in areas where IP offices have different practices. It complements the work being done to create common IT tools taking place under the Cooperation Fund.

The Convergence Programme encompasses the following projects within its portfolio :

- CP1. Harmonisation of trade mark classification practice of goods and services.
- CP2. Convergence of Class Headings
- CP3. Absolute grounds for refusal for figurative trade marks with purely descriptive words or expressions.
- CP4. Scope of protection of trade marks exclusively in black, white and/or shades of grey.
- CP5. Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)
- CP6. Convergence on graphic representations of Designs.
- CP7. Harmonisation of Product Indications.
- Implementation and continuity of Common Practices

The main **benefits** for users are:

- **Clarity and transparency:** Shared communication initiatives keep stakeholders informed of advancements in a timely manner, with unified information.
- **Quality and usability:** effective and efficient access to protection offered by registration systems both at the national and EU level.
- **Legal certainty:** increased legal certainty due to greater consistency in decisions made at national and EU level.
- **Time and cost savings:** potential reductions in application processing times and cost savings for both IP offices and applicants

Please send all questions, comments and suggestions regarding the Convergence Programme to the following e-mail address: ConvergenceProgramme@euipo.europa.eu

Thank you for your attention



www.euipo.europa.eu



@EU_IPO



EUIPO

Thank you