

# General Introduction to Convergence of Practices in Trade Marks

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21 February 2022  
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## TOPICS

- **Examination Practices**
  - **EUIPO Guidelines**
  - **EUIPN Common Practices**
- **International Cooperation Practices' related Initiative**

# Examination Practices

## EUIPO Guidelines

A unique source of reference on the EUIPO's practice

# EUTM

European Union Trade Marks

# RCD

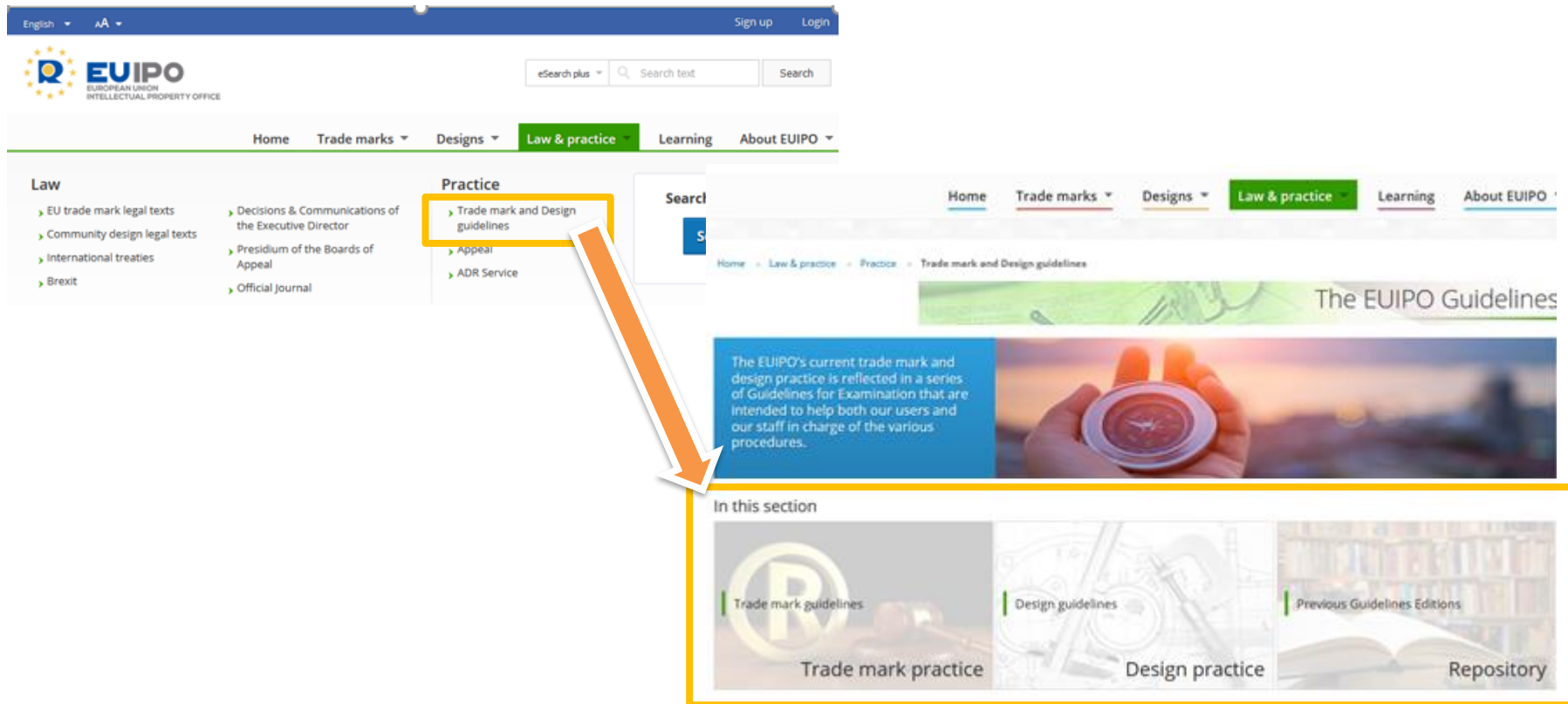
Registered Community Designs

1500 pages

# EUIPO Guidelines



# EUIPO Guidelines



The screenshot displays the EUIPO website interface. At the top, there is a navigation bar with 'English' and 'AA' dropdowns, and 'Sign up' and 'Login' links. Below this is a search bar with 'eSearch plus' and 'Search text' input fields. The main navigation menu includes 'Home', 'Trade marks', 'Designs', 'Law & practice', 'Learning', and 'About EUIPO'. The 'Law & practice' menu is expanded, showing 'Law' and 'Practice' sub-menus. The 'Practice' sub-menu is highlighted with a yellow box, and an orange arrow points from it to the 'Trade mark and Design guidelines' page. The page content includes a search bar, a breadcrumb trail 'Home > Law & practice > Practice > Trade mark and Design guidelines', and a main heading 'The EUIPO Guidelines'. A blue text box explains that the EUIPO's current trade mark and design practice is reflected in a series of Guidelines for Examination. Below this, a section titled 'In this section' features three tiles: 'Trade mark guidelines' (Trade mark practice), 'Design guidelines' (Design practice), and 'Previous Guidelines Editions' (Repository).

English AA Sign up Login

eSearch plus Search text Search

Home Trade marks Designs Law & practice Learning About EUIPO

**Law**

- › EU trade mark legal texts
- › Community design legal texts
- › International treaties
- › Brexit

**Practice**

- › Trade mark and Design guidelines
- › Appeal
- › ADR Service

Search

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Home Law & practice Practice Trade mark and Design guidelines

## The EUIPO Guidelines

The EUIPO's current trade mark and design practice is reflected in a series of Guidelines for Examination that are intended to help both our users and our staff in charge of the various procedures.

**In this section**

- Trade mark guidelines  
Trade mark practice
- Design guidelines  
Design practice
- Previous Guidelines Editions  
Repository

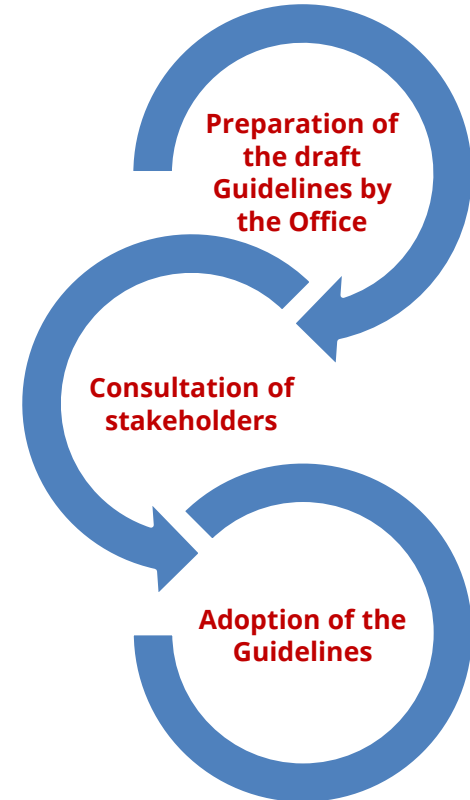
# EUIPO Guidelines

**-Cyclic**

Annual review

**-Open**

Involvement of  
stakeholders



## EUIPN Common Practices – Starting Point

### Internal dimension

- Setting up the Office and its internal processes
- Achieve internal efficiency.



### External dimension

User oriented





## The EUIPN and the Convergence Programme



# EUIPN

EUROPEAN UNION

INTELLECTUAL PROPERTY NETWORK

**Colaborative Network**

connecting

IP Offices, user associations and other IP  
organisations

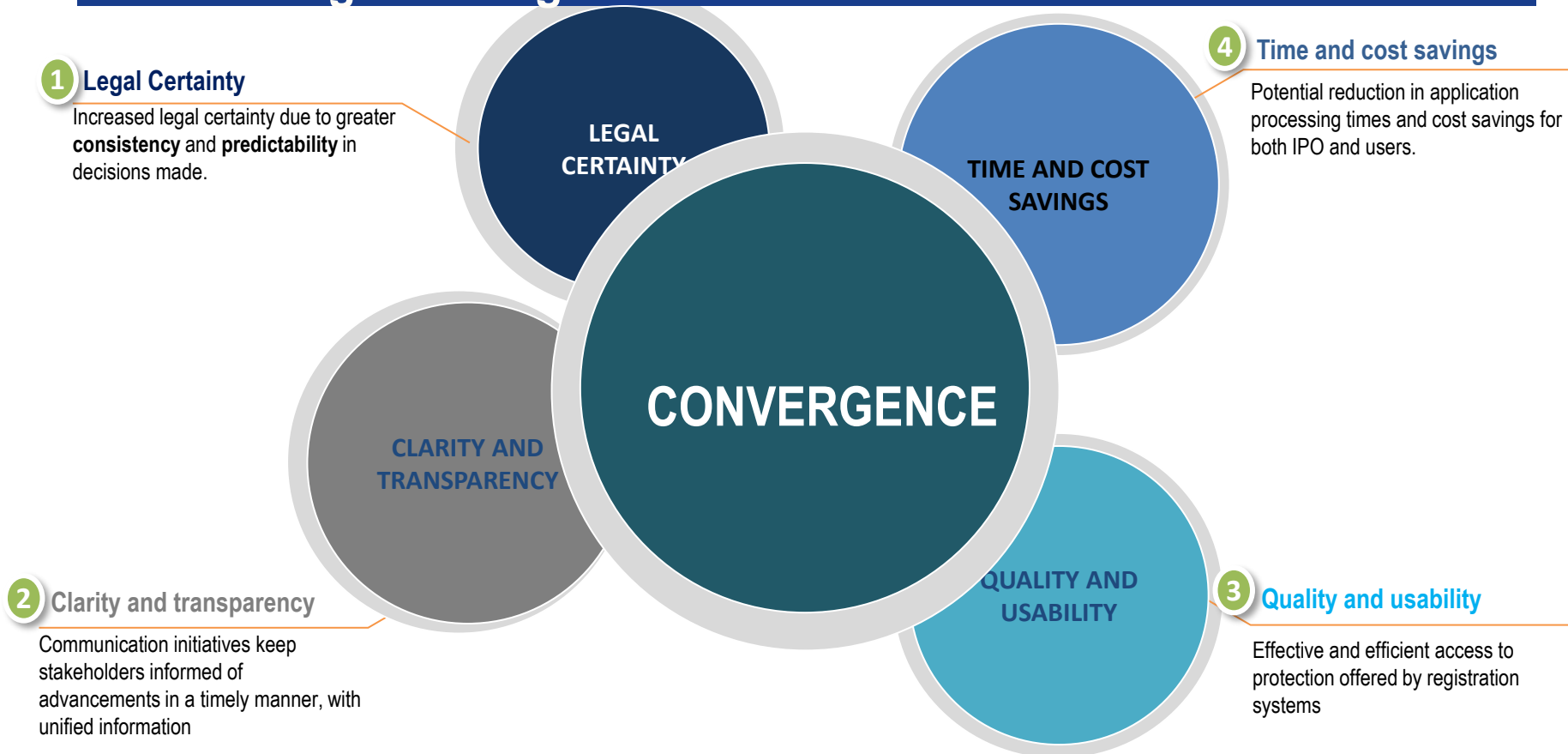
[EUIPN Website](#)

## The EUIPN – How does it work

- Project-based approach
- Objectives and priorities set up by the Members of the Network
- EUIPO provides infrastructure and resources



## The Convergence Programme - Aim



## The Convergence Programme - Principles

Jointly developed by IP offices and Users



- ❖ Focus on Practices → **No legislative amendments required**
- ❖ Commitment of implementation by the **Participating National IP Offices**

## EUIPN Convergence Projects – Trade Marks examination

CP3: Distinctiveness - Figurative Marks containing descriptive/non-distinctive words

CP4: Scope of Protection Black and White Marks

CP5: Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)

CP8: Use of a Trade 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

CP11: New Types of Marks

CP12: Proof of Use in Appeal Proceedings

# The Convergence Projects - Results

## 'Common Communications'

published

ONLINE



**Principles of the Common Practice Convergence Programme**

**CP 3. Distinctiveness – Figurative marks containing descriptive / non-distinctive words**

**Principles of the Common Practice Convergence Programme**

**CP 6. Graphic Representation of Designs**

**WITH RESPECT TO THE NEUTRAL BACKGROUND**

In order to assess if the background is neutral, the following aspects should be taken into consideration:

- A single or predominant colour in a background is always acceptable if it stands out against the colours of the design.
- Contrasting colour and more than one colour in a background is acceptable if the design is clearly distinguishable.

**Examples:**

- Italian registered design No. 1171386 (1) (1) (see also) Design 30/04/2016 (see also) (SAGI) 11.0.102
- French registered design No. 259205 (1) (1) (see also) Design 30/04/2016 (see also) (SAGI) 11.0.102
- CP Example (1) (1) (see also)

## The Convergence Projects - Results

### Inclusion in EUIPO Guidelines

Motivos de denegación absolutos — Marcas descriptivas

**DIRECTRICES RELATIVAS AL EXAMEN DE LAS MARCAS DE LA UNIÓN EUROPEA**

**OFICINA DE PROPIEDAD INTELECTUAL DE LA UNIÓN EUROPEA (EUIPO)**

**PARTE B**

**EXAMEN**

**SECCIÓN 4**

**MOTIVOS DE DENEGACIÓN ABSOLUTOS**

**CAPÍTULO 4**

**MARCAS DESCRIPTIVAS**

**Artículo 7, apartado 1, letra c), del RMUE**

#### 4.2 Apreciación del umbral figurativo

La presencia de elementos figurativos puede otorgar carácter distintivo a un elemento verbal descriptivo y/o no distintivo, de modo que se registre como marca de la Unión Europea. Por consiguiente, se otorga el carácter distintivo a un signo si la estilización y/o los elementos gráficos de un signo son lo suficiente para que este pueda servir como indicación de origen.

En el marco de la Red Europea de Marcas, Dibujos y Modelos (ETM) varias oficinas de marcas de la Unión Europea acordaron una práctica común cuando una marca figurativa, que únicamente contiene elementos descriptivos o no distintivos, debería superar el examen de motivos absolutos. El uso de colores es habitual en el comercio y no se consideraría una indicación de procedencia. Sin embargo, no puede excluirse la posibilidad de que una composición especial de colores poco habitual y que el consumidor interesado pueda recordar fácilmente otorgue carácter distintivo a la marca.

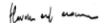

La Práctica Común establece criterios para determinar si se cumple el requisito de carácter distintivo debido a los elementos figurativos de la marca, con


- **Elementos verbales**, como el tipo y fuente del texto, la combinación de los signos de puntuación y otros símbolos, o cómo se sitúan (arriba, abajo, etc.).
- **Elementos figurativos**, como el uso de formas geométricas simples y proporción (tamaño) de los elementos figurativos en relación con los verbales, o si el elemento figurativo es una representación de un producto o servicio, o está directamente relacionado con ellos, y si el elemento figurativo utiliza habitualmente en el comercio de los productos o servicios.

<sup>2</sup>Véase la Comunicación Común sobre la Práctica Común del carácter distintivo - Marcas figurativas que contienen palabras descriptivas o no descriptivas, disponible en <https://www.tmdn.org/network/documents/10181/278891cf-6e4a-41ad-b8d8-1e0795c47cb1>

Motivos de denegación absolutos — Marcas descriptivas

Ejemplos de carácter distintivo:

Signo	Ejemplo
	Ejemplo CP3
FLAVOUR AND AROMA	Ejemplo CP3
	Ejemplo CP3





Signo	Asunto	Productos y servicios
	MUE n.º 13 448 097	Clases 5,9,11,37,42,45

ii Combinación con colores

La mera «adición» de un solo color a un elemento denominativo descriptivo carente de carácter distintivo, ya sea a las letras o en forma de fondo, no será suficiente para otorgar carácter distintivo a la marca.

El uso de colores es habitual en el comercio y no se consideraría una indicación de procedencia. Sin embargo, no puede excluirse la posibilidad de que una composición especial de colores poco habitual y que el consumidor interesado pueda recordar fácilmente otorgue carácter distintivo a la marca.

Ejemplos de ausencia de carácter distintivo:

Ejemplos CP3





## CP3: Distinctiveness - Figurative Marks containing descriptive/non-distinctive words

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*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.”*

FLAVOUR AND AROMA



**Fresh Sardine**

flavour and aroma



**Fresh Sardine**

(Class 30: Coffee)

(Class 29: Sardines)





## CP4: Scope of Protection black and white Marks

*“Common Practice that harmonises the different interpretations of the scope of protection of trade marks exclusively in black, white and/or shades of grey (whether they cover any/all colours or not)”*

B&W covers  
all colours



**LEGAL UNCERTAINTY**

‘What you see is  
what you get’

# CP5: Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)

*Common Practice that provides a set of principles regarding **non-distinctive/weak components** of trade marks for the purpose of assessing likelihood of confusion, assuming that the goods and/or services are identical*

NO LOC	LOC
 <p>(Class 32: Fruit juices)</p>	 <p>(Class 43: Holiday accommodation services)</p>

# CP8: Use of a Trade Mark in a form differing from the one registered

*Common Practice that aims to identify general principles for assessing when the use of a trade mark in a form differing from the one registered alters its distinctive character and provides guidance in this respect*

ADDITIONS

Alteration of the distinctive character of the sign as registered

Sign as registered

Sign as used



Class 25: Clothing, footwear and headgear



No alteration of the distinctive character of the sign as registered

Sign as registered

Sign as used

GERIVAN



GERIVAN

Class 25: Clothing, footwear and headgear



# CP9: Distinctiveness of 3D Marks (Shape Marks) containing Verbal and/or Figurative Elements when the Shape is not Distinctive in Itself

*Common Practice that aims establish a minimum threshold for distinctiveness of shape marks when the shape itself is non-distinctive*

**Non-distinctive**



Class 16 Packaging/Class 25 Shoes



**Distinctive**



Class 32 Bottled drinking water

# CP 11: Representation of New Types of Trade Marks

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*Common Practice that aims to identify the general principles on the examination of formal requirements and grounds for refusal and invalidity of new types of marks, namely sound, motion, multimedia and hologram marks and the new ways of representing them*

# CP12: Evidence in Trade Mark Appeal Proceedings

*Common Practice that delivers a set of guiding, non-binding principles regarding evidence in trade mark appeal proceedings*

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- Types of evidence and recommended criteria for its acceptance
- Means and sources of evidence
- Relevant date of evidence
- Ways to present evidence
- Confidentiality of evidence

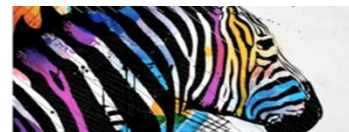
## INTERNATIONAL COOPERATION PRACTICES' RELATED INITIATIVE

## Pilot Project - Convergence of Practices - First Cycle

**CP3: Distinctiveness -  
Figurative Marks  
containing  
descriptive/non-  
distinctive words**



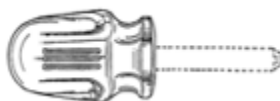
**CP4: Scope of  
Protection Black and  
White Marks**



**CP5: Relative Grounds  
– Likelihood of  
Confusion (Impact of  
non-distinctive/weak  
components)**



**CP6: Graphic  
Representation of  
Designs**





## Recent Developments

Извештај

CP5  
SERBIA

Вероватноћа довођења у забуну  
(утицај непрепознатљивих/слабих  
компоненти)

Стварне основе за одбијање

ЗАВОД ЗА ИНТЕЛЕКТУАЛНУ СВОЈИНУ  
РЕПУБЛИКЕ СРБИЈЕ

CP3  
URUGUAY

Documento de Práctica

CARÁCTER DISTINTIVO:  
Marcas mixtas que contienen términos  
descriptivos/carentes de carácter distintivo

Dirección Nacional de la Propiedad Industrial  
Ministerio de Industria, Energía y Minería  
Uruguay

პრაქტიკის დოკუმენტი

CP6  
GEORGIA

დიზაინების გრაფიკული გამოსახულება

საქართველოს ინტელექტუალური  
საკუთრების ეროვნული ცენტრი - საქპატენტ

## 2021 Broaden Project - Convergence of Practices -Second Cycle

**CP8: Use of a Trade 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**



**CP10: Criteria for Assessing Disclosure of Designs on the Internet**

**CP11: New Types of Marks**

**CP12: Proof of use in appeal proceedings**

## 2021 Broaden Project - Convergence of Practices -Second Cycle



**CP8: Use of a Trade 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**



**CP10: Criteria for Assessing Disclosure of Designs on the Internet**

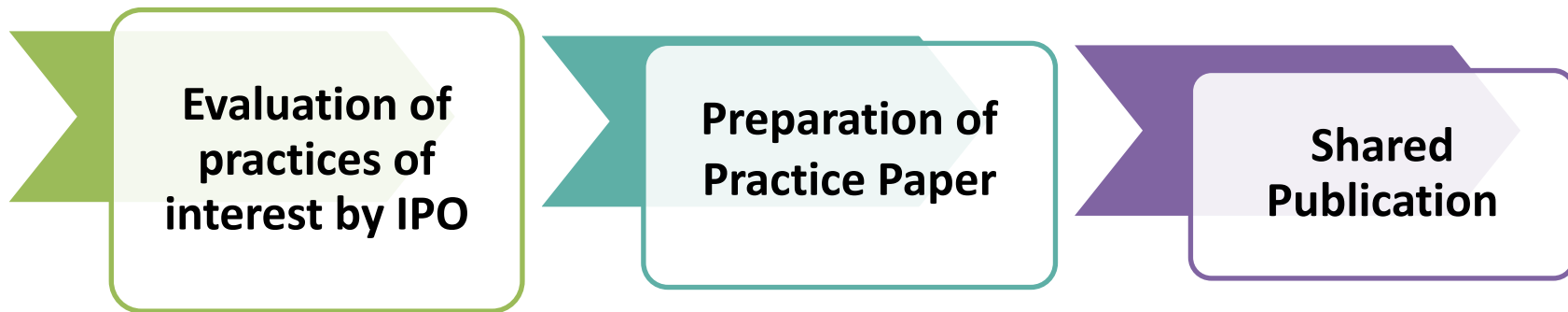


**CP11: New Types of Marks**

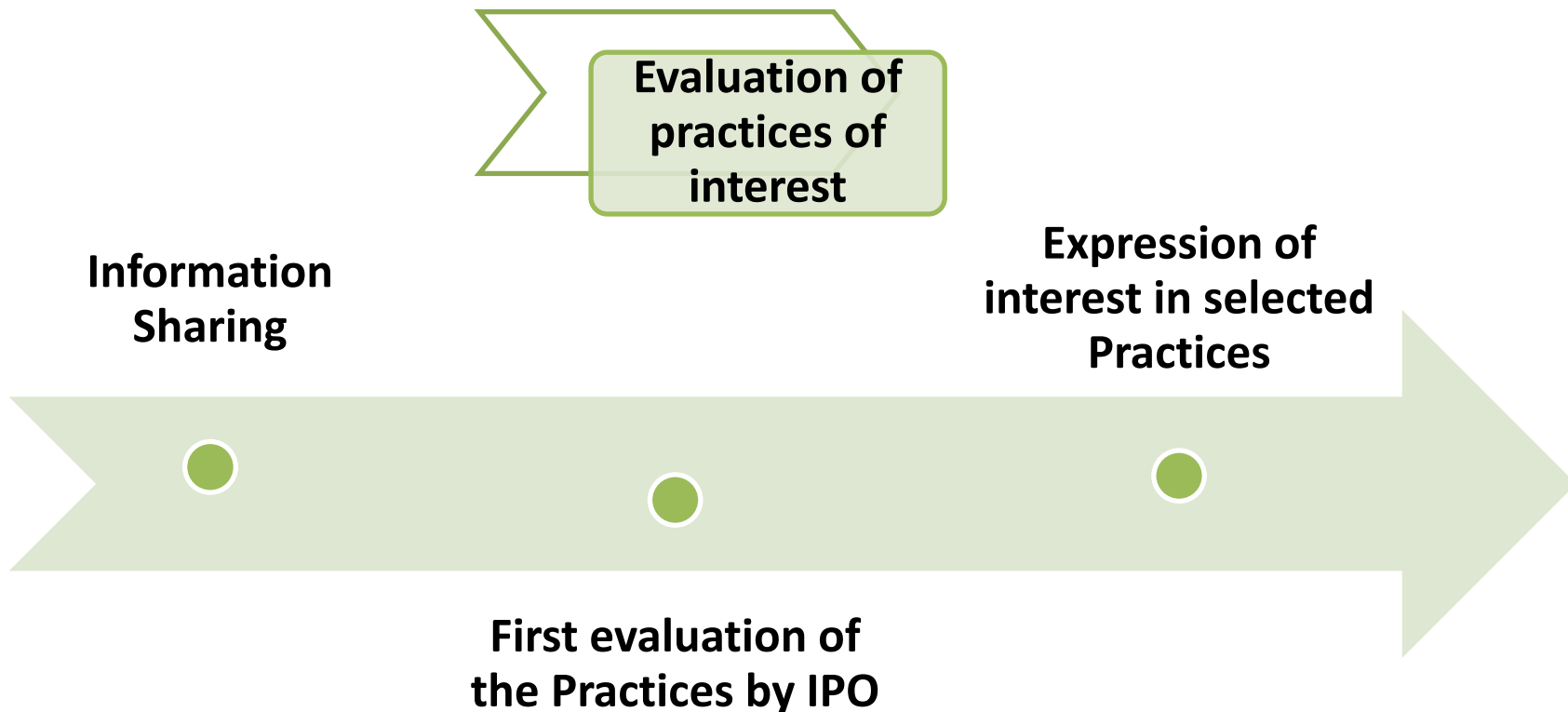


**CP12: Proof of Use in Appeal Proceedings**

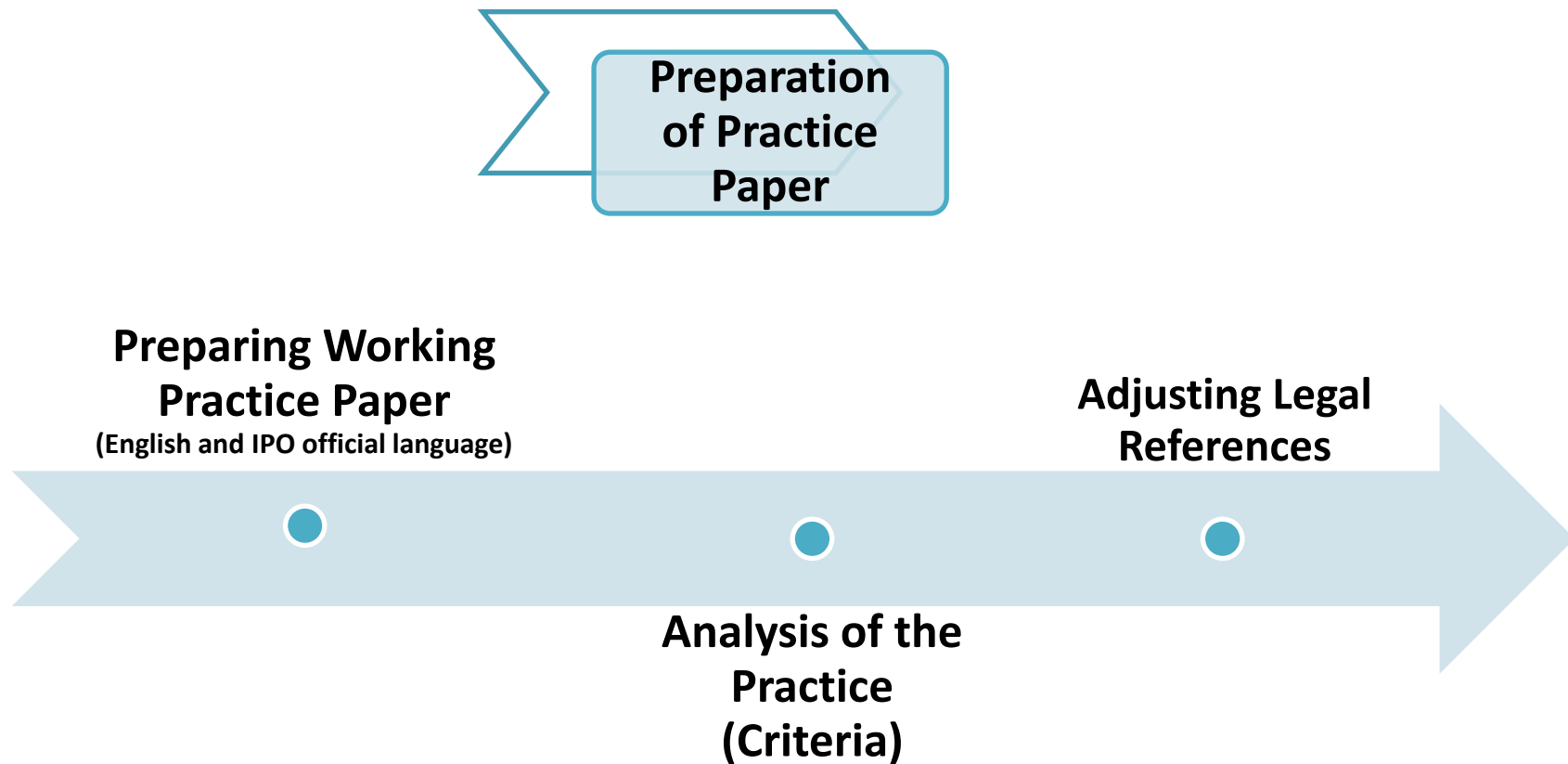
## Working Methodology



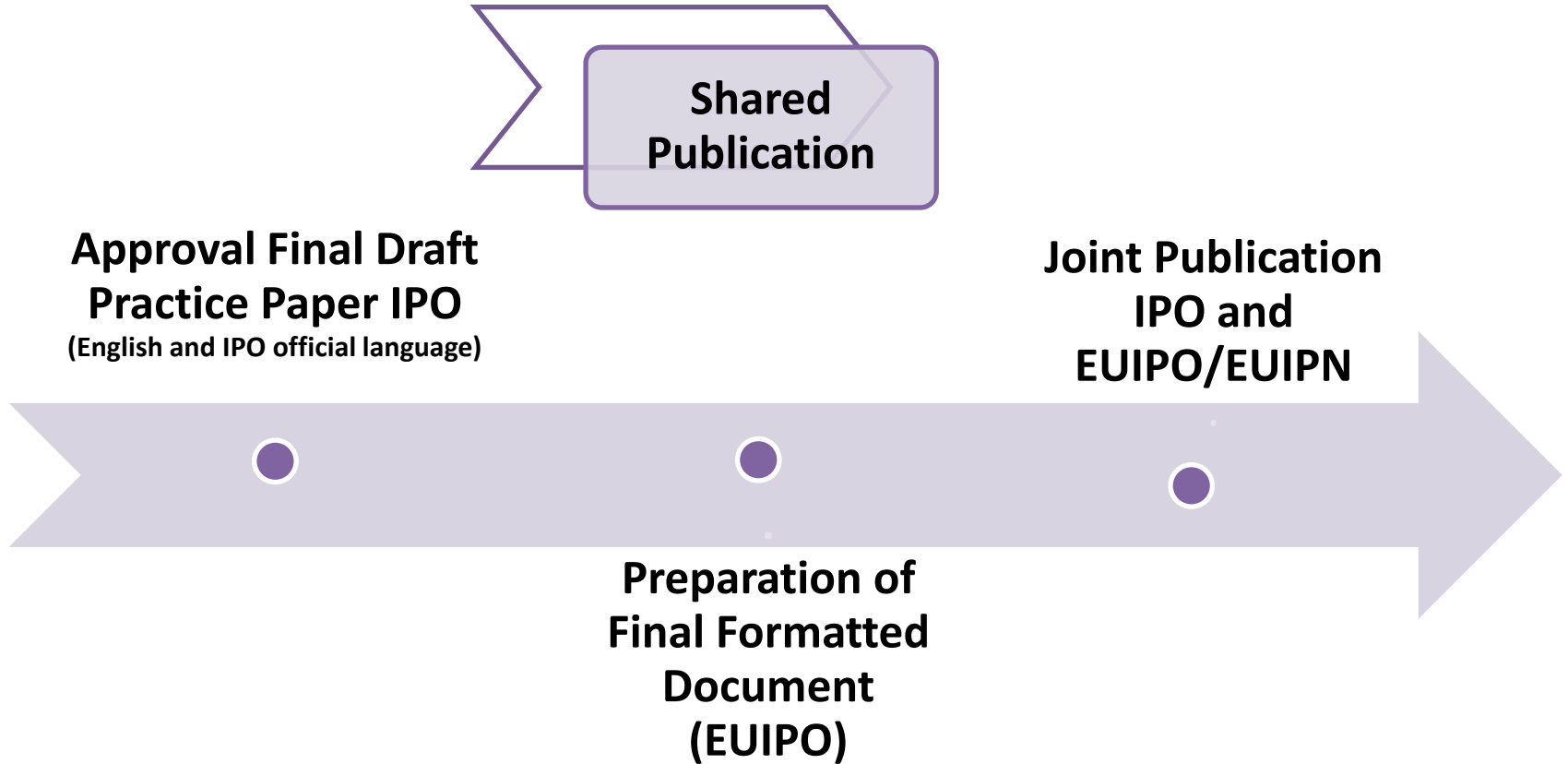
## Working Methodology



## Working Methodology



## Working Methodology



← → ↻ 🔒 tmdn.org/#/practices

🔍 AA English Sign in Register

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## Practices

### Trade Marks

<p>CP1. Harmonisation on Trade Marks Classification Practice of G&amp;D</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>CP2. Convergence of Class Headings</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>CP3. Distinctiveness - Figurative Marks containing descriptive/non-distinctive words</p> <p><a href="#">Download</a> <a href="#">More info</a></p>
<p>CP4. Scope of Protection of Black and White Marks</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>CP5. Grounds - Likelihood of Confusion (impact of non-distinctive/leak components)</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>CP8. Use of a Trade Mark in a Form Differing from the one Registered</p> <p><a href="#">Download</a> <a href="#">More info</a></p>
<p>CP9. Distinctiveness of three-dimensional marks (shape marks) containing verbal and/or figurative elements when the shape is not distinctive in itself</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>CP11. New Types of Marks: examination of Formal Requirements and Grounds for Refusal</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>Collaborative Network</p> <p><a href="#">More info</a></p>
<p>CP12. Evidence in Trade Mark Appeal Proceedings: filing, structure and presentation of evidence, and the treatment of confidential evidence</p> <p><a href="#">Download</a> <a href="#">More info</a></p>		

### Designs

<p>CP6. Convergence on graphic representations of Designs</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>CP7. Harmonisation of Product Indications</p> <p><a href="#">Download</a> <a href="#">More info</a></p>	<p>CP10. Criteria for Assessing Disclosure of Designs on the Internet</p> <p><a href="#">Download</a> <a href="#">More info</a></p>
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## CP3. Distinctiveness - Figurative Marks containing descriptive/non-distinctive words

IPO of Jordan	<a href="#">English</a>	<a href="#">Arabic</a>	
IPO of Tunisia	<a href="#">English</a>	<a href="#">French</a>	<a href="#">Arabic</a>
IPO of Georgia	<a href="#">English</a>	<a href="#">Georgian</a>	
IPO of Uruguay	<a href="#">English</a>	<a href="#">Spanish</a>	
IPO of Monaco	<a href="#">English</a>	<a href="#">French</a>	
IPO of Albania	<a href="#">English</a>	<a href="#">Albanian</a>	
IPO of Montenegro	<a href="#">English</a>	<a href="#">Montenegrin</a>	



## Questions / Comments





[www.euipo.europa.eu](http://www.euipo.europa.eu)



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Thank you