

Convergence of Practices in Trade Marks

11 July 2022
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TOPICS

- **Introduction and recap of previous activities**
- **CP4: Scope of Protection black and white Marks**
- **CP5: Relative Grounds – Likelihood of Confusion (Impact of non-distinctive/weak components)**
- **Define next steps**

Examination Practices

EUIPO Guidelines

A unique source of reference on the EUIPO's practice

EUTM

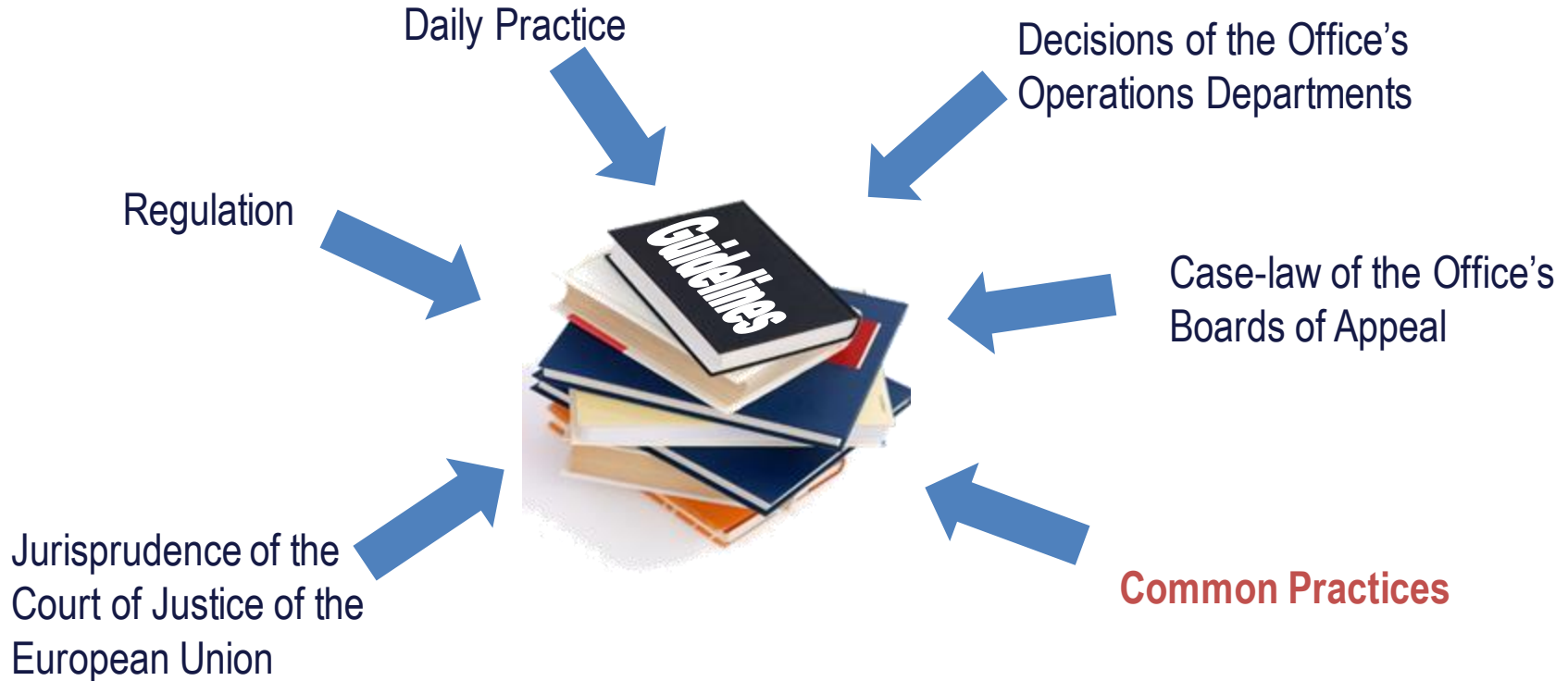
European Union Trade Marks

RCD

Registered Community Designs

1500 pages

EUIPO Guidelines



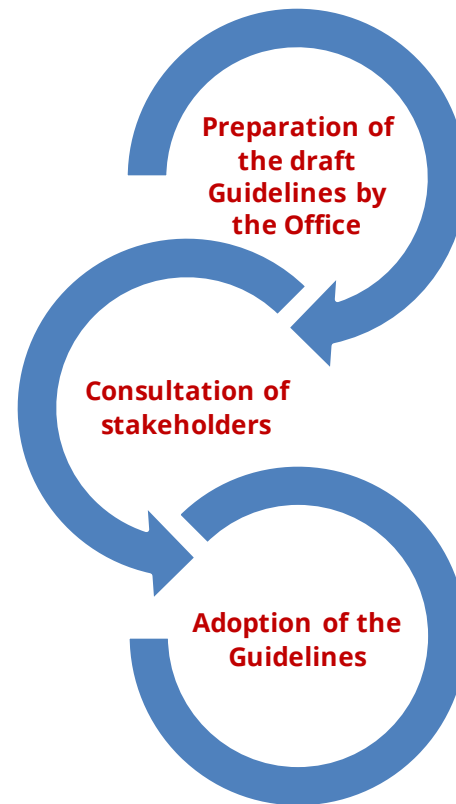
EUIPO Guidelines

-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.

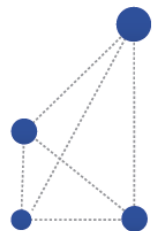


External dimension

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

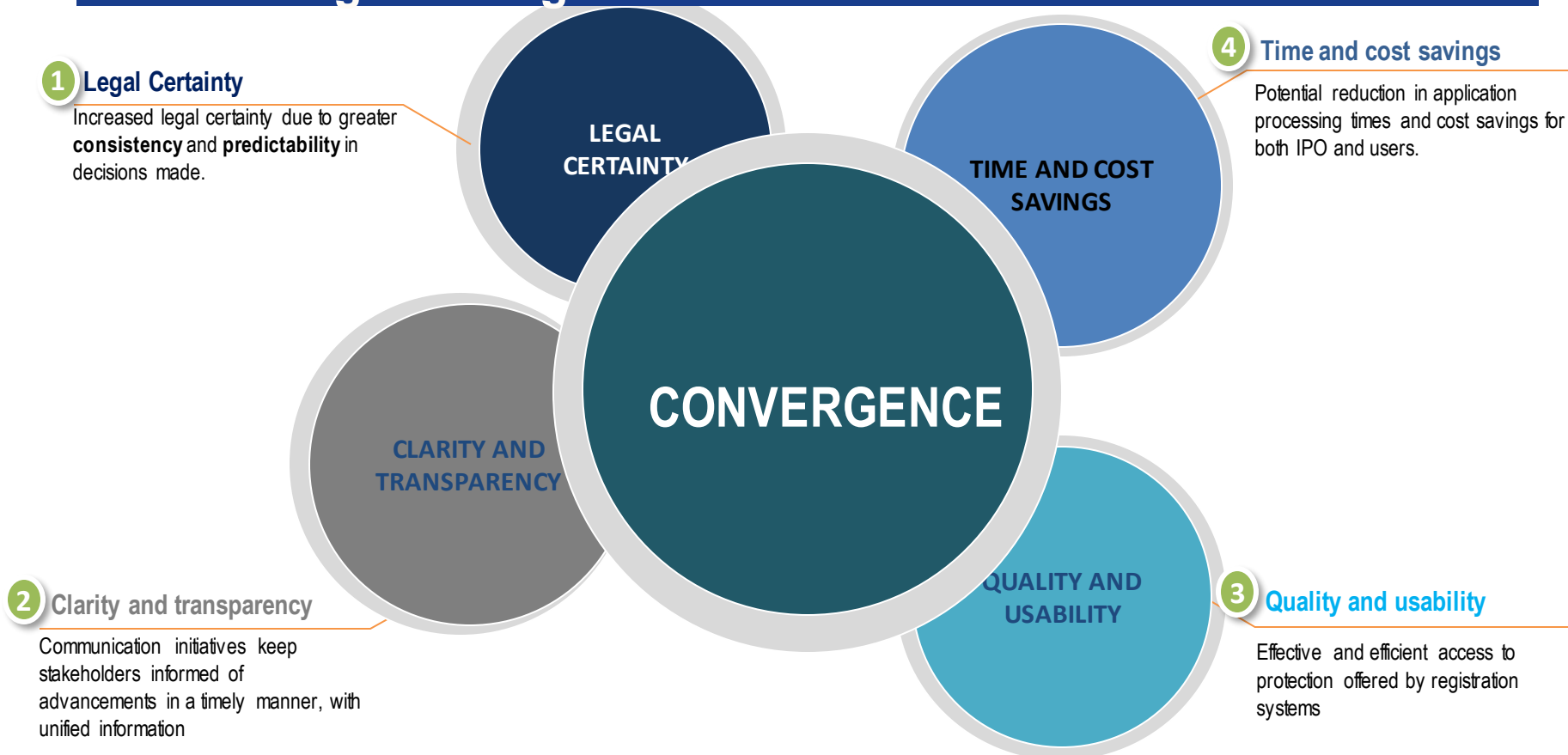
[EUIPN Website](#)

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



- ❖ 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



The image shows a screenshot of a document titled "Principles of the Common Practice Convergence Programme". It features a background image of hands holding puzzle pieces. The document is divided into sections for "CP 3. Distinctiveness – Figurative marks containing descriptive / non-distinctive words" and "CP 6. Graphic Representation of Designs".

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

CP 6. Graphic Representation of Designs

WITH RESPECT TO THE NEUTRAL BACKGROUND

In order to assess if a 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.

The document also includes several small images and diagrams illustrating these principles, such as a sequence of views for a design and examples of background colors.

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 si el signo está formado por un elemento verbal descriptivo y/o no distintivo, de modo que sea susceptible de ser registrado como marca de la Unión Europea. Por consiguiente, se otorga carácter distintivo 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.

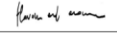

La Práctica Común establece criterios para determinar si se cumple el requisito de carácter distintivo debido a los elementos figurativos de la marca, con


- **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.

²Véase 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/10181/278891cf5e4a-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.

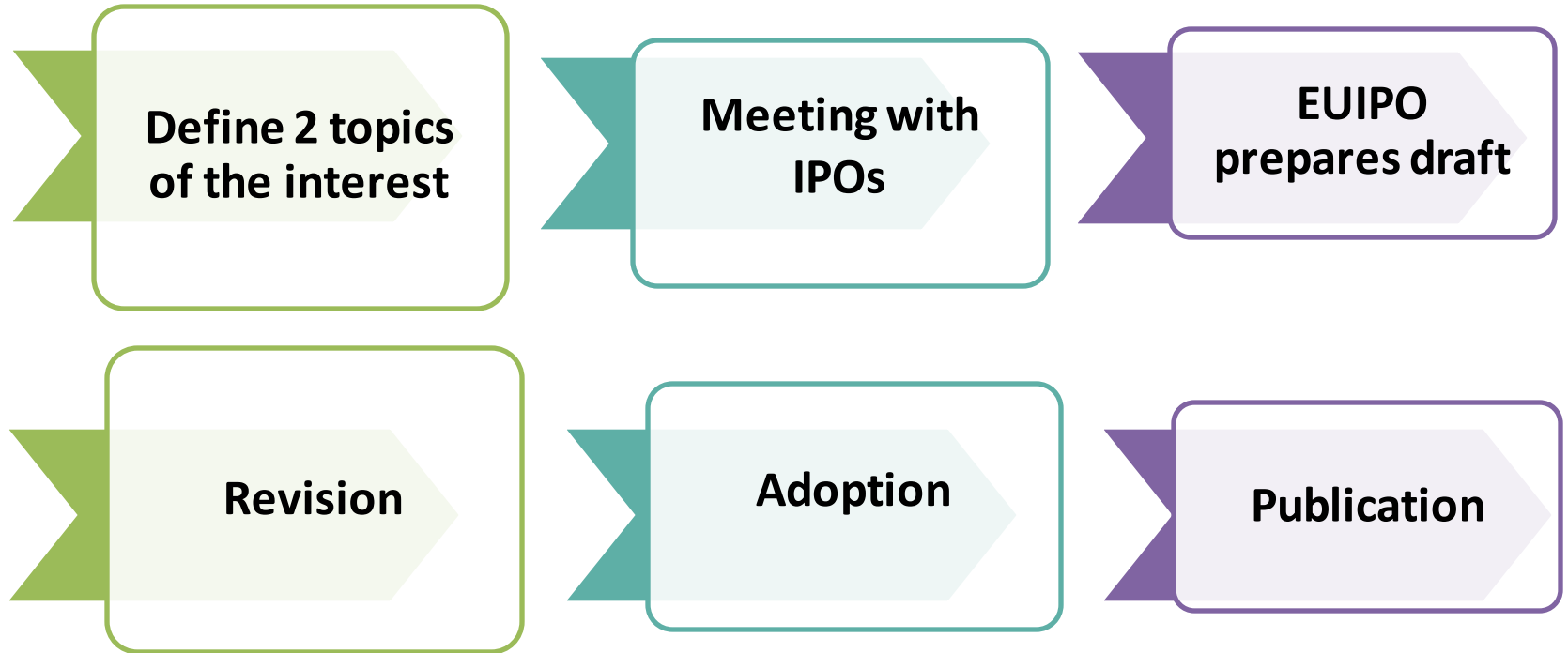
El uso de colores es habitual en el comercio y no se consideraría una indicación de procedencia. Sin embargo, no puede excluirse la posibilidad de que una composición especial de colores poco habitual y que el consumidor interesado pueda recordar fácilmente otorgue carácter distintivo a la marca.

Ejemplos de ausencia de carácter distintivo:

Ejemplos CP3





Working Methodology – Update of Caribbean Trade Mark Manual





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’

CP4 Common Practice – Starting point

Two extremes:

01

B&W covers **all** colours



02

What you see is what you get

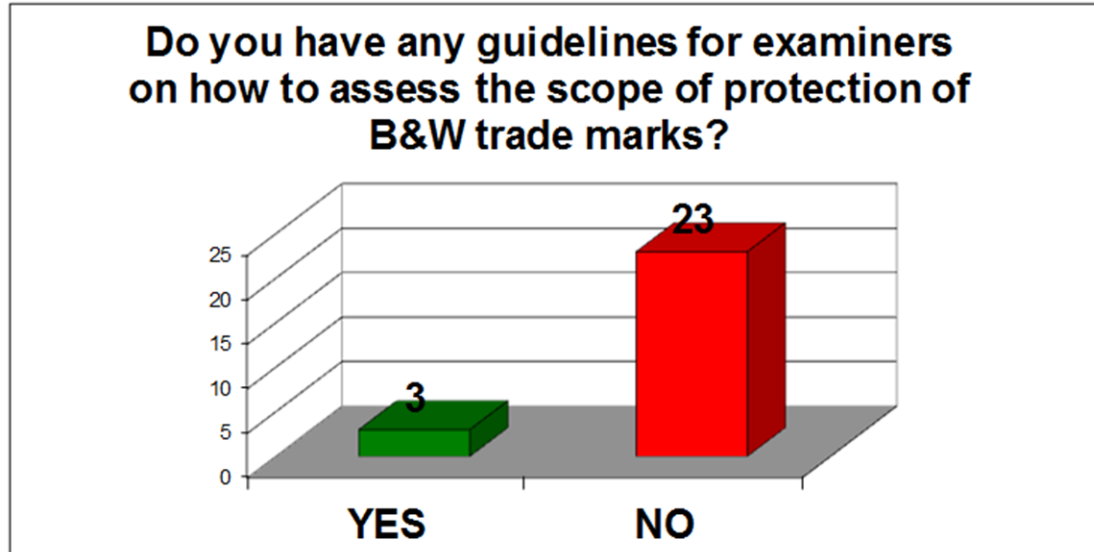


It was not totally clear which offices followed which approach and in which cases.

LEGAL UNCERTAINTY

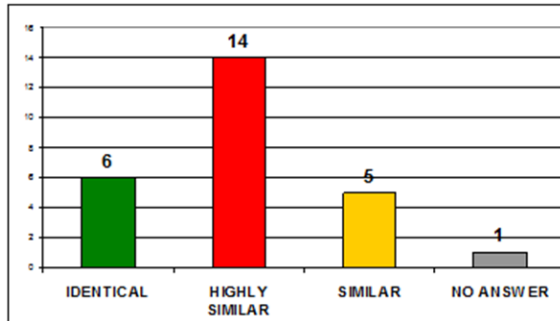
Scope of Protection B&W marks

RESULTS OF INITIAL SURVEY (February 2012)

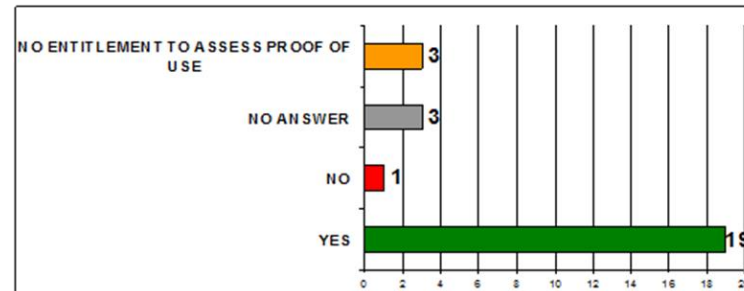
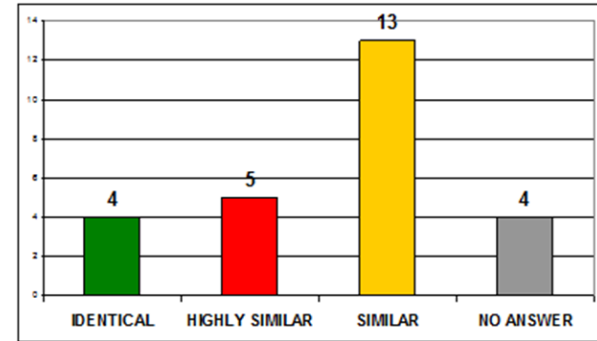


Scope of Protection B&W marks

RESULTS OF INITIAL SURVEY (February 2012)



Priorities



Scope of Protection B&W marks

To converge the practice on whether:

- a trade mark registered in B&W and/or greyscale is considered identical to the same mark in colour as regards priority claims
- a trade mark registered in B&W and/or greyscale is considered identical to the same mark in colour as regards relative grounds for refusal
- use of a mark in colour is considered use of the same trade mark registered in B&W
- use of a mark in B&W is considered use of the same trade mark registered in colour

Definition of identity of signs

Defining identity of signs for **priorities** and **relative grounds**

For reasons of coherence and legal certainty “identity” must be interpreted in the same way irrespective of the provision in which it appears
(Judgement T 378/11 ‘MEDINET’).



Definition of identity of signs

- 01 **Judgment C-291/00 ‘LTJ Diffusion’** “a sign is identical with a trade mark only where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.” (para. 54)
- 02 The Court gives the same definition of identity as in LTJ Diffusion in its **Judgement T103/11 ‘JUSTING’**, (para. 16)

Scope of Protection B&W marks

Insignificant differences

If the differences in colour are so insignificant that they may go unnoticed by the average consumer, the signs will be considered “identical”



IDENTICAL



NOT IDENTICAL

Priority and Relative Grounds

Insignificant differences



earlier mark



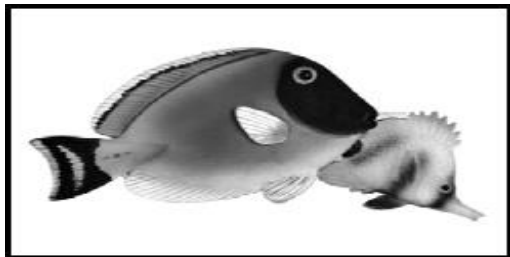
identity



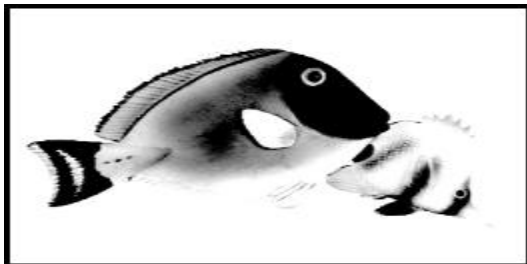
non-identity

Priority and Relative Grounds

Insignificant differences



Earlier mark



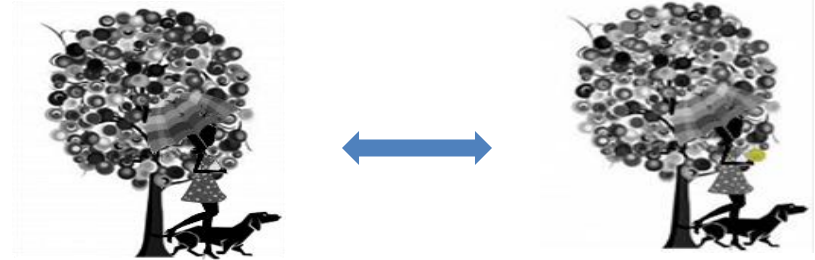
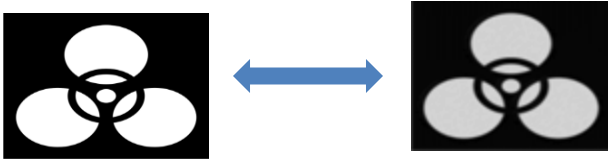
identity



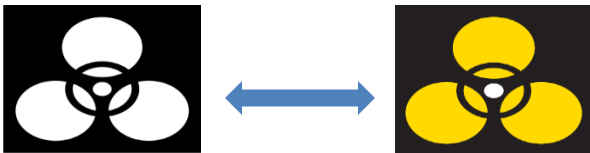
non-identity

Significant and Insignificant differences

What are 'insignificant' differences?



What are 'significant' differences?



Common Practice – Relative Grounds

Common practice: Relative grounds

If the signs are not identical they could still be similar.

Similarity, however, is outside the scope of this project.

Common Practice – Genuine use

A change only in colour does not alter the distinctive character of the trade mark

T-152/11 “MAD” - CTM on the left genuinely used by signs on the right



When a colour is not claimed in the application, the use of different colour combinations must be admitted as long as the letters **contrast against the background**

*The letter D is represented in red colour does not alter the distinctive character of the mark, since both the arrangement of the letters of the **contrast against the background** of the earlier mark are maintained*

Common Practice – Genuine use

Is use of a sign in colour is considered use of the same trade mark registered in B&W?

Is use of a sign in B&W is considered use of the same trade mark registered in colour?

Proof of use

For the purposes of use, a change only in colour does not alter the distinctive character of the trade mark as long as:

- 01 The word/figurative elements coincide and are the main distinctive elements
- 02 The contrast of shades is respected
- 03 Colour or combination of colours does not have distinctive character in itself
- 04 Colour is not one of the main contributors to the overall distinctiveness of the sign

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>FRESH JUICE</p> <p>vs.</p>  <p>JUICE SUN</p> <p>(Class 32: Fruit juices)</p>	 <p>vs.</p>  <p>(Class 43: Holiday accommodation services)</p>

CP5 Common Practice – Scope

Objective 1

Define what marks are subject to assessment of distinctiveness

- The earlier mark and/or parts thereof?
- The later mark and/or parts thereof?

Objective 2

Determine the criteria to assess the distinctiveness of the mark (and/or parts thereof)

Objective 3

Determine the impact on LOC when the common components have a low degree of distinctiveness

Objective 4

Determine the impact on LOC when the common components have no distinctiveness

CP5 Common Practice – Scope

Out of Scope

- **Assessment of enhanced distinctiveness and/or acquired distinctiveness through use and/or reputation.**
- **Other factors that are considered when assessing the likelihood of confusion.**
- **Interdependencies between assessment of distinctiveness and other factors considered when assessing LOC.**
- **Language issues assume that words in English are understood by the national offices.**

CP5 Common Practice - Objectives

OBJECTIVE 1

Define what marks are subject to assessment of distinctiveness

- *The earlier mark and/or parts thereof?*
- *The later mark and/or parts thereof?*

When evaluating likelihood of confusion:

- ✓ The distinctiveness of the earlier mark as a whole is assessed.
- ✓ The distinctiveness of all elements of the earlier mark and of the later mark is also assessed, prioritising the coinciding elements.

CP5 Common Practice - Objectives

OBJECTIVE 2

*Determine the criteria to assess the distinctiveness of the mark
(and/or parts thereof)*

When assessing the distinctiveness of the components of the marks:

- ✓ Same criteria that are used in absolute grounds are used:
 - a) to determine a minimum threshold of distinctiveness
 - b) to consider the varying degrees of distinctiveness.

CP5 Common Practice - Objectives

OBJECTIVE 3

*Determine the criteria to assess the distinctiveness of the mark
(and/or parts thereof)*

A coincidence in an element with a low degree of distinctiveness, on its own, will not lead to LOC

However, there may be LOC if:

There are other elements that are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression of the marks is similar



The overall impression of the marks is highly similar or identical

CP5 Common Practice - Objectives

OBJECTIVE 3

Example – when components have a low degree of distinctiveness

NO LOC

DURALUX

VS

VITALUX

Earlier mark

Contested mark

(Class 44: Beauty Treatment)

The marks coincide in the weak element “LUX”. The other elements in the marks “DURA” and “VITA” are not of lower or equally low degree of distinctiveness, neither are of insignificant visual impact, nor the overall impression of the marks is similar

CP5 Common Practice - Objectives

OBJECTIVE 3

Example – when components have a low degree of distinctiveness

LOC

COSMEGLOW

vs.

COSMESHOW

Earlier mark

Contested mark

(Class 3: Cosmetics)

The marks coincide in the weak element “COSME” but the elements “GLOW” and “SHOW” are of equally low degree of distinctiveness and the overall impression of the marks is similar

CP5 Common Practice - Objectives

OBJECTIVE 3

Example – when components have a low degree of distinctiveness

NO LOC



Earlier mark

VS



Contested mark

(Class 32: Fruit juices)

The marks coincide in the weak figurative elements (the sun and the drinks); the other elements in the mark (“JUICE”, “FRESH” and “SUN”) are of lower degree of distinctiveness, but the overall impression of the marks is dissimilar

CP5 Common Practice - Objectives

OBJECTIVE 3

Example – when components have a low degree of distinctiveness

LOC



Earlier mark

vs.



Contested mark

(Class 43: Holiday accommodation services)

The marks coincide in the weak figurative element (the sun); the umbrella and the beach ball are of equally low degree of distinctiveness and the overall impression of the marks is similar

CP5 Common Practice - Objectives

OBJECTIVE 4

Determine the impact on LOC when the common components have no distinctiveness

A coincidence only in a non-distinctive element will not lead to LOC

However, there **may be LOC** if:

*When marks also contain other figurative and/or word elements which are similar, **there will be LOC**, if the overall impression of the marks is highly similar or identical.*

CP5 Common Practice - Objectives

OBJECTIVE 4

NO LOC

BUILDGRO

BUILDFLUX

VS

Earlier mark

Contested mark

(Class 19: Building materials, Class 37: Constructions services)

The marks only coincide in non-distinctive element “BUILD”, the marks do not contain other elements which are similar (“GRO” is not similar to “FLUX”), neither the overall impression of the marks is highly similar

CP5 Common Practice - Objectives

OBJECTIVE 4

LOC

TRADENERGY

TRACENERGY

VS

Earlier mark

Contested mark

(Class 9: Solar energy collectors for electricity generation)

The marks coincide in non-distinctive element “ENERGY” but contain other elements which are similar (“TRADE” is aurally and visually similar to “TRACE”), and the overall impression of the marks is highly similar

CP5 Common Practice - Objectives

OBJECTIVE 4

NO LOC



Earlier mark

vs



Contested mark

(Class 36: Financial services)

The marks coincide in the non-distinctive elements “BANCO INVEST”, the marks do not contain other elements which are similar (the figurative elements are not similar), neither the overall impression of the marks is highly similar

CP5 Common Practice - Objectives

OBJECTIVE 4

LOC



Earlier mark

vs



Contested mark

(Class 9: Solar energy collectors for electricity generation)

The marks coincide in non-distinctive elements “ECO” and “ENERGY” but contain other elements which are similar (figurative elements are similar), and the overall impression of the marks is highly similar

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*

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Questions / Comments





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Thank you