



Convergence

Frequently Asked Questions (FAQ) on Common Practice
CP 3. Distinctiveness – Figurative marks containing descriptive/non-
distinctive words

A. THE COMMON PRACTICE

1. Which offices will be implementing the Common Practice?

AT, BG, BOIP, CY, CZ, DE, DK, EE, ES, FR, GR, HR, HU, IE, LT, LV, MT, NO, OHIM, PT, RO, SE, SI, SK, UK.

2. Will the Common Practice differ from the existing practice?

At the outset of the project an initial comparative study was performed, which showed divergence between the participating offices. Each of the offices had its own practice, and the variations ranged from minor to major. A single Common Practice was developed, meaning that most of the offices that implement this Common Practice will consequently adapt their previous practice, to a lesser or greater extent (depending on what their previous practice was).

In parallel to the publication of the Common Communication on ‘*Distinctiveness – Figurative marks containing descriptive/non-distinctive words*’, each implementing office may publish additional information on the impact at their national level that the Common Practice will have on previous national practice.

3. Will the Common Practice have any impact on already registered trade marks?

The Common Communication on ‘*Distinctiveness – Figurative marks containing descriptive/non-distinctive words*’ includes an overview that shows which proceedings in each of the implementing offices will be affected by the Common Practice.

Furthermore, each implementing office may provide additional detailed information on whether the Common Practice will be applicable to the applications filed before the implementation date.

4. Are there any offices that will not be implementing the Common Practice?

Participation in and implementation of the Common Practices is completely voluntary. The non-participating or non-implementing offices can always join anytime in the future with the full support of the Convergence Programme.

Two EU IP offices, namely the Finnish and the Italian offices, have not participated in the project. However, this does not mean they cannot decide to adhere to the Common Practice at any moment in time.

The Common Communication on '*Distinctiveness – Figurative marks containing descriptive/non-distinctive words*' will include the final list of implementing offices.

5. Will each case continue to be assessed on its own merits?

Distinctiveness must be assessed on a case-by-case basis, with the Common Practice serving as guidance for the users and examiners of the different offices.

In this context, the Common Practice on '*Distinctiveness – Figurative marks containing descriptive/non-distinctive words*' is aimed at covering the large majority of the cases, always respecting the principle that each case must be analysed on its own merits, taking into account the arguments of the trade mark applicants/owners.

6. What is a 'figurative mark' for the purposes of the Common Practice?

The Common Practice applies to figurative or composite marks, that is, trade marks that are not plain word marks. In order to fall within the scope of the Common Practice, the mark must combine descriptive/non-distinctive word elements with the specific graphical features analysed therein, such as a particular typeface, colour, independent figurative elements etc.

7. Descriptive marks are by definition non-distinctive, so why does the Common Practice keep the distinction and refer to both non-distinctive and descriptive word elements?

While descriptive marks are by definition non-distinctive, a mark may still lack distinctiveness for reasons other than descriptiveness, and therefore the differentiation between the two grounds helps to make clear that the Common Practice covers both cases. The distinction between the two grounds is kept due to the difference in the underlying general interest; the lack of capability to perform the essential function of the trade mark is common to both grounds, while the need for the sign to be kept free for use by all is related only to descriptiveness.

8. Can these principles be applied to figurative marks containing weak word elements?

A minimum degree of distinctive character suffices to pass the absolute grounds examination. If the word elements contained in the figurative mark are weak, it means that the mark as a whole still possesses the minimum degree of distinctiveness. It is therefore out of the scope of the Common Practice, which exclusively relates to non-distinctive/descriptive words.

9. Are language issues out of scope?

Yes. The reason behind that is purely practical - to allow drawing conclusions among all participants of the project, irrespective of their native language. The word elements in the examples of the Common Practice document are deemed to be descriptive/non-distinctive, and it would not be possible to create and include examples with word elements that are descriptive/non-distinctive in all languages.

10. Are disclaimers out of scope?

Yes. Disclaimers were not included in the scope of the project because not all the EU IP offices use them or foresee them in their legal provisions.

11. Can acquired distinctiveness through use still be claimed?

Yes. The Common Practice does not affect the possibility of proving acquired distinctiveness in the proceedings of the IP offices, as it only deals with inherent distinctiveness.

B. METHODOLOGY

12. How will figurative marks containing descriptive/non-distinctive words which pass the absolute grounds examination be assessed in the context of relative grounds for refusal?

The impact of descriptive/non-distinctive elements on the examination of relative grounds for refusal and in particular likelihood of confusion is addressed by the Common Practice of '*Relative Grounds for Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components)*'. This Common Practice document can be accessed by pasting the following URL in your web browser:

https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/about_ohim/who_we_are/common_communication/common_communication5_en.pdf

13. A figurative trade mark containing descriptive/non-distinctive words was applied for and passed the absolute grounds examination. Does the applicant obtain exclusive rights in these words?

No. The distinctive character lies in the sign as a whole and therefore the scope of protection is limited to the overall composition of the mark, and not to the descriptive/non-distinctive word element on its own. Therefore the applicant will not obtain exclusive rights to descriptive/non-distinctive words on their own right.

The impact of descriptive/non-distinctive elements on the examination of likelihood of confusion is addressed by the Common Practice of *‘Relative Grounds for Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components)’*.

14. Why does the Common Practice lack distinctive examples for some of the criteria?

The examples included in the Common Practice, whether registrable or not, aim at providing guidance to examiners and users. For one of the criteria, namely combination with colour, it was not possible to agree on distinctive examples. Regarding punctuation marks, other symbols commonly used in trade and figurative elements that are commonly used or are customary in trade in relation to the goods and/or services claimed, the Working Group decided that, in general, they do not endow a mark as a whole with sufficient distinctive character.

15. Why are there no real applications/trade marks used in the Common Practice?

The Working Group avoided adding real applications/trade marks to the Common Practice document since it could be either beneficial or harmful to their owners or applicants. Instead they were used as inspiration to create clear-cut examples that can serve to illustrate the principles.

16. Has the Common Practice taken into account national and/or European Union case-law?

Throughout the process of both the preliminary analysis and drafting of the Common Practice, national and European Union case-law was taken into careful consideration and used as inspiration for shaping the principles and creating the examples in the document. The cases considered include Case C-39/97, *Canon*, EU:C:1998:442, Case C-265/00, *Campina Melkunie*, (BIOMILD), EU:C:2004:87, Case C-104/01, *Libertel*, EU:C:2003:244 and Case C-37/03P, *BioID AG / OHIM*, (BioID), EU:C:2005:547.

17. What user involvement has there been in the project?

Representatives of three User Associations (AIM, ECTA, EFPIA) took part in the Working Group as observers from the very beginning of the project, having access to all the documents at all times. Moreover, they were always invited to provide their feedback.

The conclusions were published at several stages encouraging anyone to review the document, pass it to whomever they considered would have an opinion on it, and submit their feedback, with a view to guaranteeing that any concerns expressed could be considered and analysed by the Working Group.

All international User Associations were invited to participate in a special meeting held in March 2015 in Brussels. The Common Practice was presented to them and they gave their direct feedback on the principles. The meeting was attended by representatives from AIM, BUSINESSEUROPE, ECTA, FICPI, INTA, MARQUES and UNION.

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