



Convergence

**Frequently Asked Questions (FAQ) on Common Practice
CP5 Relative Grounds – Likelihood of Confusion
(Impact of non-distinctive/weak components)**

1. Is the Common Practice different to the previous existing practice?

The Common Practice does not represent any change from the previously existing practice in the implementing offices.

Before this Convergence Project the results of the first survey showed that only 12 out of the 28 implementing IP Offices had guidelines on how to deal with non-distinctive/weak components of marks in the context of examination of relative grounds for refusal. The Common Practice will change this situation, by setting out principles on which the agreed practice is based and serving as a reference document for IP offices, user associations, applicants, opponents and representatives. This will enhance legal certainty.

2. The Common Communication of CP5 states that the Common Practice will be implemented at national level within three months of publication of the Common Communication. Will the trade mark offices provide information about the impact of the Common Practice on the previous national practices?

Legal certainty depends on the clarity, quality and usability of the practice and its communication. The Common Communication will explain the agreed Common Practice with clarity to users. Via the Common Communication, users will be able to understand the Common Principles, understand them clearly with examples and review the list of participating offices.

The Common Practice does not have any impact on any of the previous national practices. However, individual offices may decide, if they think that it is appropriate, to provide further detailed information on any issue, including the revision of their guidelines in light of the agreed wording of the Common Practice.

3. Why did Italy and Finland not take part in this Common Communication?

Not all offices take part in all the Common Practices – this is very much at the heart of the Convergence Programme’s ethos. It’s completely voluntary, so if an office doesn’t want to participate in a particular project, for whatever reason, it doesn’t preclude the rest of the offices from taking part – or from joining at a later date.

4. When are the goods/services considered identical in the Common Practice?

In all the examples shown in the Common Practice, the marks at issue are considered to cover identical goods or services. Whether specific goods/services should be considered identical in a case before an office is an issue not covered by the Common Practice.

5. Can the Common Practice be applied to cases where the earlier and the later mark have similar goods / services?

Yes. The principles of the Common Practice can be applied, although the principle of interdependence (see e.g. Case C-39/97 *Canon Kabushiki Kaisha*, para. 17) may be then applied and a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the marks and vice versa, and therefore the degree of similarity between the goods and/or services would become a relevant factor, which could affect the outcome. The assessment of similarity of goods and services is out of scope of the CP5 project.

6. According to the Sabèl Judgment (C-251/95) “The global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, their distinctive and dominant components”. Why is distinctiveness separated from dominance?

Currently not all the participating IP Offices follow the same approach when assessing relative grounds of refusal, or even take into considerations the same factors or in the same way, and dominance is not part of the Common Practice. This is also the reason why it was pointed out at the beginning of the examples section that for the purpose of the Common Practice all the other factors (irrespectively of which they are) should be deemed not to affect the outcome. Otherwise, it would not have been possible to decide on any of the examples before taking into account such other factors.

7. What happens with those cases where the distinctive and non-distinctive elements of the marks cannot be so easily separated?

The principles are intended for general application, and aimed at covering the majority of cases. The principles aim to serve as guidance in order to ensure that all the offices come to similar and predictable conclusions. The Common Practice foresees an Implementation Strategy which includes the creation of training material, such as presentations, videos, publications and online webinars, including as many examples as possible to address beforehand any issues which examiners and users might face.

8. Has the Common Practice taken into account national and/or community case law?

During the project national and community case law, as well as OHIM's opposition and appeal decisions, have been analysed and were used as inspiration for the principles and examples in the document.

9. Why are no real cases used in the Common Practice?

We avoid using real cases, involving either national or Community trade marks, since it could be either beneficial or harmful for its owners or applicants. Instead we used them as inspiration to create clear cut examples that can serve to illustrate all the conclusions.

10. Why is assessment of the distinctiveness of the later mark as a whole not explicitly described?

Assessment of distinctiveness of the later mark as a whole is only described implicitly on purpose. The reason for this is that in the context of relative grounds examination the distinctiveness of the later mark as a whole is not assessed by all of the participating offices. Moreover, the assessment of the later marks as a whole is not relevant for the Common Practice, which analyses the impact of the non-distinctive/weak components of the marks for the purpose of assessing likelihood of confusion.

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