

**OHIM WP1 Guidelines Draft Amendments September 2015  
Comments from INTA Trademark Office Practices Committee, OHIM Subcommittee**

<b>Contributor (name &amp; position)</b>	INTA OHIM Subcommittee
<b>Linguistic version the comments refer to</b>	EN (track changes version)

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	GENERAL REMARK regarding CJEU or ECJ decisions
<b>Page of the document</b>	
<b>Issue(s) you wish to comment on</b>	<p>OHIM proposes to re-name all the ECJ decisions it refers to by dropping the parties' names and switching to the trademark as such. For example, "Sieckmann" is to be replaced by "Methylcinnamat" and "Shield Mark" should become "Musical Notation".</p> <p>The official names of these cases as used by the courts themselves are clearly those of the parties, not the trademarks concerned. INTA does not support such change as it would create confusion: trademark practioners are used to refer to the current names of court cases. Changing the names of EJC decisions will make their identification more difficult. Moreover, the use of different languages may further complicate things. The Guidelines refer for designs to the "kind" of device in different languages (cf. Invalidity Guidelines, at page 10, barbecues; at page 25 the English Corkscrews now is translated in sacacorchos).</p>
<b>Suggestion for text</b>	Return to former practice of citing the case with the parties' names and adopt a uniform language practice for citing cases in designs.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part A, Section 3, 2.2
<b>Page of the document</b>	7
<b>Issue(s) you wish to comment on</b>	Deletion of “The following debit or credit cards may be used: Visa, Mastercard and Discover”
<b>Suggestion for text</b>	Is this being deleted because all debit/credit cards will be accepted? If this is the case, INTA recommends clarifying it in the Guidelines.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part A, Section 3, 4.2
<b>Page of the document</b>	11
<b>Issue(s) you wish to comment on</b>	Added language “Payment by credit or debit card is deemed to have been made on the date on which the relevant electronic filing or request was successfully completed.”
<b>Suggestion for text</b>	<p>This added language seems to contradict the prior paragraph that states “Payment by debit or credit card is deemed to be made on the date on which the successful electronic filing it refers to is submitted via the Office’s online tool.”</p> <p>Is payment considered made on the date of submission (as indicated by the first paragraph) or on successful completion of the electronic filing or request? It seems there could be some situations in which the date of submission is not the same as date of successful completion. Either way, the language should be uniform between the two paragraphs.</p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part A, Section 5, 1
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<b>Page of the document</b>	4
<b>Issue(s) you wish to comment on</b>	Addition of “or Community design”
<b>Suggestion for text</b>	Just a note that later this is referred to as RCD – INTA recommends using consistent terminology.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part A, Section 3, 6.2
<b>Page of the document</b>	23
<b>Issue(s) you wish to comment on</b>	“The request must indicate the number of proceedings (e.g. CTM/RCD number, opposition, etc.)”
<b>Suggestion for text</b>	While generally clarified by the examples the reference to “the number of proceedings” could also be interpreted as indicating quantity (as in, 4 total proceedings) rather than the opposition number, etc.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B, Section 2, 10.8.2
<b>Page of the document</b>	30
<b>Issue(s) you wish to comment on</b>	Deletion of “Insofar as a position mark covers...for which the positioning is doubtful/impossible.”

<b>Suggestion for text</b>	<p>Is this paragraph being deleted because it is no longer valid?</p> <p>If it remains valid, INTA would recommend retaining the language.</p>
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<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B, Section 2, 14
<b>Page of the document</b>	44
<b>Issue(s) you wish to comment on</b>	Examples of unacceptable disclaimers
<b>Suggestion for text</b>	INTA notes that reasoning behind unacceptability is provided for the second and third example but not the first example. Similar reasoning may be helpful for the first example.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B, Section 2, 15
<b>Page of the document</b>	45
<b>Issue(s) you wish to comment on</b>	Addition of “regular” to “...which is triggered by the first regular filing of a trade mark.”
<b>Suggestion for text</b>	<p>Is there a definition provided somewhere of “a regular filing”? What type of filing is irregular so as not to trigger the convention priority timing?</p> <p>The reference to regular was not made in the list of requirements on page 47 (see comment below) but was added to 15.1 on the same page. INTA recommends consistency.</p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B, Section 2, 15
<b>Page of the document</b>	47
<b>Issue(s) you wish to comment on</b>	Addition of the requirement “The previous application(s) is a first filing”
<b>Suggestion for text</b>	As noted in prior comment, the word “regular” was added to “the first regular filing of a trade mark” – if that language is retained, this should be duplicated here.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B, Section 2, 15.3
<b>Page of the document</b>	49
<b>Issue(s) you wish to comment on</b>	Deletion of “within two months” but added references to “within the time limit set.”
<b>Suggestion for text</b>	This lacks clarity. We, recommend adding the time limit that will be set by the Office for remedying the deficiencies.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B Section 4 Chapter 2
<b>Page of the document</b>	52
<b>Issue(s) you wish to com</b>	In the first paragraph, it is suggested that the acceptability of a sound mark will depend on whether the average consumer will perceive the sound "as a memorable one" that serves to indicate...origin. We agree that a sound

<b>ment on</b>	would need to be one that serves to indicate...origin, but do not think it is required to be memorable.
<b>Suggestion for text</b>	Delete the words "a memorable".

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B Section 4 Chapter 2
<b>Page of the document</b>	52
<b>Issue(s) you wish to comment on</b>	It seems that the statement in the second paragraph may not be entirely correct. Brand owners do seem to be making increasing use of sound marks, for example jingles in TV and radio advertising. We suspect that consumers will soon be in the habit of recognizing these as sounds marks, if not already. The proposed change is indeed quite dramatic in that it would seem to lead, ultimately, to allowing sound marks only upon evidence of acquired distinctiveness (as is already true for product shapes), which means, effectively, eliminating sound marks from the CTM register going forward. This is a drastic change from the almost 20 years of practice to date for which there does not appear to be any need.
<b>Suggestion for text</b>	Delete the second paragraph.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part B Section 4 Chapter 2
<b>Page of the document</b>	67
<b>Issue(s) you wish to comment on</b>	The penultimate table of cases towards the end of 2.3.2.6 Geographical terms is class-sensitive (BRASIL, THE SPIRIT OF CUBA and PORT LOUIS). The goods concerned in these cases can be gleaned from the respective commentaries. However, for ease of reference, we think it would be helpful to indicate the classes in question.
<b>Suggestion for text</b>	Add a column listing the classes that the cases concern.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	PART B EXAMINATION; SECTION 4 ABSOLUTE GROUNDS FOR REFUSAL
<b>Page of the document</b>	Pages 89 and 90
<b>Issue(s) you wish to comment on</b>	Section 2.4 of the Guidelines (Customary signs or indications Article 7(1)(d) CTMR) has been deleted in its entirety. This massive deletion is probably a mistake.
<b>Suggestion for text</b>	Reinstate section 2.4 of the Guidelines in its entirety

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	PART B EXAMINATION; SECTION 4 ABSOLUTE GROUNDS FOR REFUSAL
<b>Page of the document</b>	Pages 110 and 113
<b>Issue(s) you wish to comment on</b>	While in the list of means of giving or obtaining evidence about acquired distinctiveness, mention is done to 'affidavits' (para. 110), this expression is replaced by the word 'declarations' in the heading of point 2.6.8.3 (page 113) and in the body of the text under this heading. The guidelines quote article 78(1)(f) of CTMR and use the expression 'statements in writing'. For the sake of consistency, the expression 'affidavits' should be used as heading of point 2.6.8.3 (instead of 'declarations').
<b>Suggestion for text</b>	Point 2.6.8.3 should read Affidavits or Statements in writing instead of Declarations

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	PART B EXAMINATION; SECTION 4 ABSOLUTE GROUNDS FOR REFUSAL
<b>Page of the document</b>	Page 116
<b>Issue(s) you wish to comment on</b>	The first paragraph of page 116 lacks clarity. The sentence 'moreover, cease and desist letters against competitors or letters to newspapers complaining against the use of the sign in a generic sense have been

	considered evidence against acquired distinctiveness' (judgment of 21/05/2014 T-553/12).
<b>Suggestion for text</b>	We suggest that the Guidelines give more details about the cited Court case in order to make the statement and the quote more understandable.
<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL 2.2.4.2
<b>Page of the document</b>	24
<b>Issue(s) you wish to comment on</b>	COLOUR COMBINATIONS
<b>Suggestion for text</b>	Although no modifications of the guidelines have been proposed, we would request that the existing guidelines relating to colours and colour combinations should not be too narrowly interpreted by the examiner so that distinctive colour combinations are not automatically rejected requiring evidence of use throughout the EU.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL 2.2.12
<b>Page of the document</b>	41
<b>Issue(s) you wish to comment on</b>	NEW SECTION ON JUDGMENT NO. T-347/10
<b>Suggestion for text</b>	We suggest replacing "CREASES ON IT" with "CREASES ON THEM".

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL 2.3.2.2
<b>Page of the document</b>	53
<b>Issue(s) you wish to comment on</b>	The inclusion of the examples madridexporta, greensea and deli friends is welcome and helps to clarify the criteria.
<b>Suggestion for text</b>	



<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL – DESCRIPTIVENESS 2.3.2.2.
<b>Page of the document</b>	54
<b>Issue(s) you wish to comment on</b>	<p>The word "since" in the following paragraph may lead to confusion in the interpretation of this guideline:</p> <p>“Combinations made up of words from different languages may still be objectionable if the relevant consumers will understand the descriptive meaning of all the elements without further effort. This may be the case, in particular, when the sign contains basic terms in a language that will be understood easily by the speakers of another language, or if the terms are similar in both languages. For instance, if a mark is composed of one basic descriptive term belonging to language 'a' and another descriptive word in language 'b', the sign as a whole will remain descriptive <u>since</u> it is assumed that the speakers of language 'b' will be able to grasp the meaning of the first term.”</p>
<b>Suggestion for text</b>	<p>We recommend replacing “since” with “when”, so that the paragraph reads:</p> <p>Combinations made up of words from different languages may still be objectionable if the relevant consumers will understand the descriptive meaning of all the elements without further effort. This may be the case, in particular, when the sign contains basic terms in a language that will be understood easily by the speakers of another language, or if the terms are similar in both languages. For instance if a mark is composed of one basic descriptive term belonging to language 'a' and another descriptive word in language 'b', the sign as a whole will remain descriptive <del>since</del> <b>when</b> it assumed that the speakers of language 'b' will be able to grasp the meaning of the first term.</p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL 2.3.2.11
<b>Page of the document</b>	68
<b>Issue(s) you wish to comment on</b>	NAMES OF BANKS AND NEWSPAPERS/MAGAZINES
<b>Suggestion for text</b>	The word central should be replaced by "national/central" and the word "still" after the word "likely" should be omitted.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL 2.3.2.12
<b>Page of the document</b>	68
<b>Issue(s) you wish to comment on</b>	NAMES OF HOTELS
<b>Suggestion for text</b>	We recommend replacing the word "usually" in the second sentence with "sometimes". We agree each mark should be reviewed on a case by case basis; for example a hotel SAN SEBASTIAN would be descriptive for a hotel in San Sebastian.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL – 2.3.2.12.
<b>Page of the document</b>	69
<b>Issue(s) you wish to comment on</b>	Combinations of names of countries cities with a number indicating a year.
<b>Suggestion for text</b>	The name of a city followed by a year long past e.g. 1850 may be distinctive.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL – 2.3.4.1
<b>Page of the document</b>	71
<b>Issue(s) you wish to comment on</b>	PRELIMINARY MARKS
<b>Suggestion for text</b>	We propose replacing the wording "sufficient to make it act as a trade mark "with "sufficiently distinctive such that the sign acts as a badge of origin".


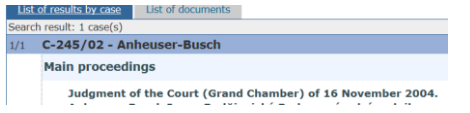
<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL – 2.3.4.2
<b>Page of the document</b>	73
<b>Issue(s) you wish to comment on</b>	STYLIZED WORD ELEMENTS
<b>Suggestion for text</b>	For the sake of clarity, we propose inserting "the following marks were objected" before "lower case + capital letters"  A case description should be added for BOLLYWOOD MACHT GLÜCKLICH and CREMA D BALSAMIO.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL – 2.3.4.3
<b>Page of the document</b>	74
<b>Issue(s) you wish to comment on</b>	The paragraph starting "the use of a colour..." could be deleted as the concept is discussed on page 73.
<b>Suggestion for text</b>	We recommend deleting the said paragraph.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	ABSOLUTE GROUNDS FOR REFUSAL – 2.3.4.3
<b>Page of the document</b>	78
<b>Issue(s) you wish to comment on</b>	"HUNDE SPORT"  We suggest including a further description of the decision.
<b>Suggestion for text</b>	

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Introduction (Section 0)
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<b>Page of the document</b>	7 et seq.
<b>Issue(s) you wish to comment on</b>	INTA agrees with the deletion of what was formerly the “ANNEX”. To the extent this covered mere structure, the comments were technical and of no interest to the general public. They are more suitable for a training document than for Guidelines. As to the methodology, this is changing in a very favourable way. To the extent the Annex covered substantive issues they were redundant.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion , Chapter 1 General Principles
<b>Page of the document</b>	3-14 (TC version) and all parts of the amended Guidelines
<b>Issue(s) you wish to comment on</b>	Different case law citation, for example “Judgment of 29/09/1998, C-39/97, Canon EU:C:1998:442 § 28”
<b>Suggestion for text</b>	<p>For all GC/CJ case law, we note that OHIM now uses the sign “§” instead of “para.” as well as the ECLI references. The relevance is not clear to us.</p> <p>However, more importantly and as already mentioned before, the <b>renaming of all the GC/CJ cases</b> is confusing and not logical. All these cases have “official” names (as can be seen on the CURIA website, examples below) and they are also known to the trademark practitioners under the respective names. No trademark practitioner has an idea e.g. about the “Louis Vuitton” case but everybody knows the “Google France and Google” case. The renaming complicates things without any reason.</p>  

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion , Chapter 1 General Principles
<b>Page of the document</b>	8 (TC version)

<b>Issue(s) you wish to comment on</b>	<p>Typo:</p> <ul style="list-style-type: none"> <li>trade marks with a highly distinctive <b>characterenjoy</b> broader protection than trade marks with a less distinctive character (see in this regard Canon, § 18)."</li> </ul>
<b>Suggestion for text</b>	<ul style="list-style-type: none"> <li>trade marks with a highly distinctive <b>character enjoy</b> broader protection than trade marks with a less distinctive character (see in this regard Canon, § 18)."</li> </ul>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion , Chapter 1 General Principles
<b>Page of the document</b>	8 (TC version)
<b>Issue(s) you wish to comment on</b>	<p>Typo:</p> <p>One consequence of these findings is that the enhanced distinctiveness of the earlier mark may be a decisive factor towards establishing a likelihood of confusion when the similarity between the signs and/or the goods and services is low (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22)</p>
<b>Suggestion for text</b>	<p>Add full stop at the end of the sentence.</p> <p>One consequence of these findings is that the enhanced distinctiveness of the earlier mark may be a decisive factor towards establishing a likelihood of confusion when the similarity between the signs and/or the goods and services is low (judgment of 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).</p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Section 2, Chapter 2, Annex II, Retail Services. In Part 7.5
<b>Page of the document</b>	55

<p><b>Issue(s) you wish to comment on</b></p>	<p>7.5 Retail services of specific goods versus retail services of other specific goods: similar</p> <p>OHIM considers that retail services relating to specific goods are considered to be similar to retail services relating to other specific goods independently of whether or not there is similarity between the goods in question.</p> <p>We fail to understand how services like retail of clothing are similar to retail of vehicles, electrical appliances, etc.</p> <p>We note that this section is not new but already existed in WP1; however it has only now come to our attention and we take the opportunity to comment on it on this occasion.</p>
<p><b>Suggestion for text</b></p>	<p>This section should be deleted, or the opposite should be stated.</p>

<p><b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b></p>	<p>Part C Opposition / Section 2 / Chapter 4/ Parts 1 and 2 – General Principles of Trade Mark Comparison and Identity of Signs</p> <p><b>METHODOLOGY – GENERAL REMARK</b></p>
<p><b>Page of the document</b></p>	<p>p. 5 et seq.</p>
<p><b>Issue(s) you wish to comment on</b></p>	<p>INTA welcomes the change in principle which is reflected in the Guidelines, namely, the abolition of the so-called “objective comparison” in favour of the “integrated approach”. While not exactly new but rather a return to the methodology applied before 2005, the integrated approach is believed to be better, to do more justice to the comparison of marks, and to trigger less errors and misunderstandings in the reading of decisions. There is little point in concluding that two marks are “similar” when they only overlap in a completely non-distinctive element and, in accordance with the principles laid down in CP5, this similarity is not as such relevant for the likelihood of confusion, i.e. for trade mark similarity in a legal sense.</p> <p>Apart from this, it is suggested that the Guidelines settle for either “phonetic” or “aural” comparison rather than using both terms.</p>
<p><b>Suggestion for text</b></p>	

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4/ Parts 1 and 2 – General Principles of Trade Mark Comparison and Identity of Signs
<b>Page of the document</b>	7
<b>Issue(s) you wish to comment on</b>	Item 1.2, point ii. refers to “the distinctiveness of the earlier mark as a whole (including the issue of enhanced distinctiveness)”. It is not clear what is meant by “enhanced distinctiveness”.
<b>Suggestion for text</b>	If this is referring to acquired distinctiveness, then this term should be used.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4/ Parts 1 and 2 – General Principles of Trade Mark Comparison and Identity of Signs
<b>Page of the document</b>	7
<b>Issue(s) you wish to comment on</b>	The use of the word “implies” in item 1.2 point iii. seems a bit indefinite.
<b>Suggestion for text</b>	“Implies” should be replaced by a more definitive term such as “requires”, “entails” or “involves”.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4/ Parts 1 and 2 – General Principles of Trade Mark Comparison and Identity of Signs
<b>Page of the document</b>	7
<b>Issue(s) you wish to comment on</b>	Item 1.4. would be clearer if the three possible outcomes (identity, similarity and dissimilarity) were dealt with separately under their own bullet points. At the moment, identity is dealt with in both the first and second bullet point.
<b>Suggestion for text</b>	<ul style="list-style-type: none"> <li>• a finding of <b>identity</b> between signs leads to absolute protection according to Article 8(1)(a) CTMR if the goods and/or services are also identical or to the opening of the examination on likelihood of confusion in accordance with Article 8(1)(b)) CTMR, if the goods and/or services are not identical.</li> <li>• a finding of <b>similarity</b> leads to the opening of the examination on likelihood of confusion in accordance with Article 8(1)(b) CTMR.</li> <li>• the finding of <b>dissimilarity</b> in all three aspects excludes the likelihood of confusion. There is no need to examine further prerequisites of Article 8(1)(b) CTMR.</li> </ul>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4/ Parts 1 and 2 – General Principles of Trade Mark Comparison and Identity of Signs
<b>Page of the document</b>	13
<b>Issue(s) you wish to comment on</b>	Item 2.3., Marks in non-Latin characters – Although implied by the preceding text, it is not clearly stated that the two Cyrillic marks in the example are identical.
<b>Suggestion for text</b>	We recommend inserting “The following Cyrillic word marks are identical.” Before the example.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4/ Parts 1 and 2 – General Principles of Trade Mark Comparison and Identity of Signs
<b>Page of the document</b>	Various – see below
<b>Issue(s) you wish to comment on</b>	<p>Typos:</p> <ul style="list-style-type: none"> <li>• Page 5, item 1.3 – extra space after visually in third line</li> <li>• Page 7, item 1.5, 3<sup>rd</sup> example – should refer to “50% vol”</li> <li>• Page 9, item 2.1, penultimate paragraph – should refer to “goods or services” and not simply “goods”</li> <li>• Page 14, item 2.6, last paragraph - should refer to “B&amp;W or greyscale” rather than just “B&amp;W”</li> <li>• Page 14, item 2.6 - the commentary on the MILANOWEK decision should begin “The Court considered that <u>the</u> fact that....”</li> </ul>
<b>Suggestion for text</b>	

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4
<b>Page of the document</b>	18 of version with track changes
<b>Issue(s) you wish to comment on</b>	<p>Item. 3.1, 1<sup>st</sup> sentence, beginning with “The similarity...”: this sentence ends with “...defined in the decision.” It is not clear what decision is referred to here.</p> <p>Item. 3.1, 2nd sentence, beginning with “In the comparison of marks...”: In this introductory section, no reference is made to the essential role</p>



	played by the overall impression of the marks in the assessment of similarity. Even though this is mentioned right at the beginning of the next section (3.2), we think it is important to refer thereto here as well, in order to avoid any misconception that this assessment should be guided only or primarily by the comparison between isolated elements of the marks.
<b>Suggestion for text</b>	We recommend the following wording: "... taking into consideration their distinctiveness and dominance (paragraph 3.4 below) <b>and if and to which degree these elements coin the overall impression produced by the marks</b> . All these considerations (...)."

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4
<b>Page of the document</b>	19 of version with track changes
<b>Issue(s) you wish to comment on</b>	Item 3.2, §5, beginning with "It is important...": sub-item (i) is very long and difficult to grasp. See proposed wording below (in italics / bold). Item 3.2, §6, beginning with "If either mark is...": the verb to be does not seem appropriate here.  See proposed wording below (in italics / bold).
<b>Suggestion for text</b>	Item 3.2, §5: "It is important to distinguish between (i) <b><i>The analysis of the distinctive character of a specific component of the marks, as this analysis determines whether the signs in conflict coincide in a distinctive and, therefore, important component or in a weak component of less importance</i></b> for the trade mark comparison and (ii) the analysis (...)."  Item 3.2, §6: "If either mark <b><i>consists of</i></b> one element only."

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition / Section 2 / Chapter 4
<b>Page of the document</b>	21 of version with track changes
<b>Issue(s) you wish to comment on</b>	§ beginning with "One of the most frequent arguments...":  While market reality and consumer experience are indeed relevant factors in the determination of the ability of a trademark component to

	be perceived as distinctive to a lower or higher degree, there are certain elements, which, for example, due to their clear meaning and <u>widespread use in the common language</u> , are per se weakly distinctive and would not require such market analysis / evidence (e.g. prefixes indicating a) quantity, such as multi- or poly-, or b) strength or size, such as super- or mini-).
<b>Suggestion for text</b>	

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	32, 34, 36 & 41
<b>Issue(s) you wish to comment on</b>	Typo: page 32 : 3.4.1.1 Word mark v word mark page 34 : 3.4.1.2 Word mark v figurative mark with word elements page 36: 3.4.1.3 Purely figurative v Purely figurative page 41: 3.4.1.5 Word/figurative sign v figurative sign
<b>Suggestion for text</b>	3.4.1.1 Word mark vs word mark 3.4.1.2 Word mark vs figurative mark with word elements 3.4.1.3 Purely figurative vs Purely figurative 3.4.1.5 Word/figurative sign vs figurative sign

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	43 & 44

<b>Issue(s) you wish to comment on</b>	In the different tables referring to case law, the level of similarity is indicated, but not in the tables pp. 43 and 44.
<b>Suggestion for text</b>	We suggest adding the level of similarity in tables pp. 43 & 44.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	32, 34, 35, 36, 41, 42, 45
<b>Issue(s) you wish to comment on</b>	There are differences in the title of each part. Sometimes there is the word comparison, i.e. p. 36: “comparison between two word/figurative marks”, sometimes it has not been indicated (or even removed), i.e.: p. 32: “word mark vs word mark”.
<b>Suggestion for text</b>	For the sake of consistency, it should be the same for all titles, the expression “comparison between” is superfluous. It should be removed on pp. 36, 45.


<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	pp. 39 - 40 & 44
<b>Issue(s) you wish to comment on</b>	The decision R 576/2010-2 (confirmed by T-593/10) appears in two parts:  “3.4.1.4 Comparison between two word/figurative marks, pp. 39 – 40”  And in  “3.4.1.6 Signs consisting of a single letter/number, p. 44”.  In this part the visual similarity is linked to the fact that the signs are comprised of single letters.
<b>Suggestion for text</b>	We suggest deleting the example in pp. 39 – 40 (which is in fact presented in a different way than in p. 44).

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	42
<b>Issue(s) you wish to comment on</b>	3.4.1.6 Signs consisting of a single letter/number :  There is no example for the single number.  Also, we note that at the end of this part, p. 45, the paragraph before last starts with “Lastly” and the last paragraph starts by “Finally”.
<b>Suggestion for text</b>	We suggest adding examples of single number and deleting the word “lastly”.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	42
<b>Issue(s) you wish to comment on</b>	There was a part on pure colour marks with an example (which can be seen deleted p. 42)
<b>Suggestion for text</b>	We recommend adding a part on comparison of pure colour marks.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	36
<b>Issue(s) you wish to comment on</b>	The title: 3.4.1.4 Comparison between two word/figurative marks: is unclear.  As mentioned above, the part “comparison between” should be deleted. The remaining part “two word/figurative marks” does not help to understand what is covered.
<b>Suggestion for text</b>	We recommend the following amendment:

	3.4.1.4 Stylized marks vs stylized marks  Or  3.4.1.4 Stylized marks
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<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	43
<b>Issue(s) you wish to comment on</b>	Decision GG vs G: the decision number is B 1220724. However this is the opposition number for the Shark case seen on p. 41    The text on top of p. 45 refers to the shark case, not the GG vs G case
<b>Suggestion for text</b>	We suggest adding the correct case number.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs  Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	45 & 46
<b>Issue(s) you wish to comment on</b>	The same example is used twice to explain a low similarity and an absence of similarity: R 806/2009-4 (the 3D rabbits).
<b>Suggestion for text</b>	We suggest deleting the Incorrect example.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs
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	Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	45
<b>Issue(s) you wish to comment on</b>	3.4.1.7. Comparison of 3D marks The first sentence is confusing, referring to 3D and 2D trademarks: “When comparing <b>three-dimensional and two-dimensional signs</b> , the same basic principles as for <b>2D marks</b> are to be applied”.
<b>Suggestion for text</b>	We suggest using the same terms 3D and 2D or three-dimensional and two-dimensional but not a mix of the two.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs Chapter 4 – 3.4 Comparison of the signs
<b>Page of the document</b>	41
<b>Issue(s) you wish to comment on</b>	In the previous version, the shark example on this page was a standalone part: Particular scenarios when comparing figurative signs.  It seems that this decision does not really fit in several chapters on visual comparison. Thus it might be useful to have it alone or use it in a sort of conclusion.  (This would also allow for a clarification of the title where it has been put, see comment above on the title: 3.4.1.4 Comparison between two word/figurative marks, which is unclear.)
<b>Suggestion for text</b>	The Shark example should be left alone or used in a conclusion on the visual comparison.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C / Section 2 / Chapter 4 / (3.4.2) Comparison of signs: Phonetic comparison
<b>Page of the document</b>	47
<b>Issue(s) you wish to comment on</b>	3.4.2. Section 2 starting with “Therefore, the key elements for determining the overall...”: This section seems repetitive and almost a circular reasoning.

	<p>3.4.2.: first example of phonetically dissimilar marks JAVA vs. AAVA MOBILE</p> <p>We wonder whether this is a good example. If the dissimilarity is because the word mobile is included in the AAVA it is understandable. However if the comparison is between the word JAVA and AAVA, a better example could be found. Indeed, in Swedish you would most probably pronounce them the same. In Finish though every letter is pronounced so it will be A-A-VA a three syllable word but JA-VA a two syllable word. All in all we think there are better examples.</p>
<b>Suggestion for text</b>	<p>“Therefore, the key elements for determining the overall phonetic impression of a trade mark are the syllables and their particular sequence and stress as a similar overall phonetic impression will be determined mostly by those common syllables and their identical or similar combination.</p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C / Section 2 / Chapter 4 / (3.4.2) Comparison of signs: Phonetic comparison
<b>Page of the document</b>	51
<b>Issue(s) you wish to comment on</b>	@home/T-Mobile@Home: In the square next to the marks it says “arrobas” in Benelux but in the text below it says “arroba” in Spanish and Portuguese.
<b>Suggestion for text</b>	We suggest changing from Benelux to Spanish and Portuguese.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C / Section 2 / Chapter 4 / (3.4.2) Comparison of signs: Phonetic comparison
<b>Page of the document</b>	51
<b>Issue(s) you wish to comment on</b>	<p>“...but it will not be pronounced when used as a hyphen (as in G-Star)”:</p> <p>We doubt this is correct.</p> <p>. In Wikipedia a dash is described as follows :” A <b>dash</b> is a <a href="#">punctuation</a> mark that is similar to a <a href="#">hyphen</a> or <a href="#">minus sign</a>, but differs from both of these symbols primarily in length and function. The most common versions of the dash are the <a href="#">en</a> dash (–) and the <a href="#">em</a> dash (—), named</p>

	for the length of a <a href="#">typeface</a> 's lower-case <i>n</i> and upper-case <i>M</i> respectively.”
<b>Suggestion for text</b>	The plus (+) and minus/hyphen/ <b><i>dash</i></b> symbols may, depending on the circumstances. The - symbol may be pronounced when used in combination with a number, e.g. -1. In some cases, depending on the surrounding letter and the context, it will not be pronounced as in G-Star. In other cases it might be pronounced as in –Board (Dashboard).

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C / Section 2 / Chapter 4 / (3.4.2) Comparison of signs: Phonetic comparison
<b>Page of the document</b>	54
<b>Issue(s) you wish to comment on</b>	Bottom of page: Pizza is an Italian word that has entered the English language.
<b>Suggestion for text</b>	“...such as the English words ‘baby’, ‘love’, ‘one’, surf’, and the Italian word “pizza” that has also entered the English language.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C - Chapters 4 Comparison of signs: Conceptual comparison (3.4.3, 3.4.4)
<b>Page of the document</b>	56-74
<b>Issue(s) you wish to comment on</b>	Apart from minor additions, the conceptual comparison part has basically remained unchanged. We also refer to the example of decisions: no additions have been considered. Since this a revision of the guidelines, it is probably the right time to do it.
<b>Suggestion for text</b>	We suggest adding more and recent jurisprudence.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C - Chapters 4 Comparison of signs: Conceptual comparison (3.4.3, 3.4.4)
<b>Page of the document</b>	56-59 The semantic content of words



<b>Issue(s) you wish to comment on</b>	There is a possibility to update the jurisprudence by using reference to more recent cases.
<b>Suggestion for text</b>	For instance, we suggest adding decision of 25/06/2015, case C-147/14 (Loutfi Management Propriété intellectuelle / Halalsupply – El BAINA).

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C - Chapters 4 Comparison of signs: Conceptual comparison (3.4.3, 3.4.4)
<b>Page of the document</b>	60
<b>Issue(s) you wish to comment on</b>	<i>“When the sign itself is broken down visually into various parts (...) as in AirPlus):</i> There is a mention of the AirPlus case but then the AirPlus case has been deleted from the list of examples.
<b>Suggestion for text</b>	There is the need to decide if the AirPlus case has to be maintained as an example or not mentioned at all.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C - Chapters 4 Comparison of signs: Conceptual comparison (3.4.3, 3.4.4)
<b>Page of the document</b>	73 (TC version)
<b>Issue(s) you wish to comment on</b>	<i>“Furthermore, even if both signs contain the same <b>object</b> (...).”</i> It is unclear what an object is (a word? A graphic rendition? An image?)
<b>Suggestion for text</b>	We recommend replacing ‘object’ with ‘the common element’ or the like.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.5. Impact of the distinctive and dominant character of the components on the similarity of signs
<b>Page of the document</b>	75 (TC version)

<b>Issue(s) you wish to comment on</b>	Typo (for better comprehension): The coincidence is clearly perceived when the commonality forms an independent word element or is separated in the way of writing
<b>Suggestion for text</b>	The coincidence is clearly perceived when the commonality forms an independent word element or <b>when it</b> is separated in the way of writing

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.5. Impact of the distinctive and dominant character of the components on the similarity of signs
<b>Page of the document</b>	75 (TC version)
<b>Issue(s) you wish to comment on</b>	<p>3.4.5.1. Identifiable common element/coincidence</p> <p>In the second para of this page it could be read that “the coincidence is <u>clearly perceived...</u>” when the commonality forms an independent word or is separated in the way of writing”.</p> <p>Therefore it could be interpreted that <u>always</u> (“is clearly perceived”) when the coincident element is separated in the way of writing, the coincidence is clearly perceived and therefore similarity arise.</p>
<b>Suggestion for text</b>	<p>We proposed to change the wording “is clearly perceived” and use:</p> <p>“the coincidence <b>could be</b> clearly perceived...”</p> <p>An example of the convenience of modifying this could be shown the decision OF 9 JULY 2015 – R 937/2013-5 – HiLink (FIG. MARK) / D-Link (FIG. MARK) where the following could be read:</p> <p><b>D-Link vs HiLink<sup>™</sup></b></p> <p><i>22 According to established case-law, the assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant.</i></p>

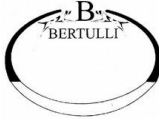
<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.5. Impact of the distinctive and dominant character of the components on the similarity of signs
<b>Page of the document</b>	75 (TC version)
<b>Issue(s) you wish to comment on</b>	Regarding the paragraph starting with “the coincidence is clearly perceived...” : the following and more recent example could also be added:  Nutriplen Smoothie vs. NUTRIplete  “40 (...) It is true that the later mark also includes the word ‘Smoothie’. Nevertheless, it is clearly separate and secondary to the initial term ‘Nutriplen’ and will be seen as an identifier of a particular subset of ‘Nutriplen’ goods, or something added on to the house mark ‘Nutriplen’.” (DECISION OF 14 JULY 2015 – R 2059/2014-2 – Nutriplen Smoothie / NUTRIplete)
<b>Suggestion for text</b>	DECISION OF 14 JULY 2015 – R 2059/2014-2 – Nutriplen Smoothie / NUTRIplete: “40 (...) It is true that the later mark also includes the word ‘Smoothie’. Nevertheless, it is clearly separate and secondary to the initial term ‘Nutriplen’ and will be seen as an identifier of a particular subset of ‘Nutriplen’ goods, or something added on to the house mark ‘Nutriplen’.”

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.5. Impact of the distinctive and dominant character of the components on the similarity of signs																
<b>Page of the document</b>	75 (TC version)																
<b>Issue(s) you wish to comment on</b>	The three examples “MARINE BLEU”, “CADENACOR” and “BLUE” in the table.  <table border="1"> <thead> <tr> <th>Earlier sign</th> <th>Contested sign</th> <th>Reason</th> <th>Case No</th> </tr> </thead> <tbody> <tr> <td><a href="#">MARINE BLEU</a></td> <td><a href="#">BLUMARINE</a></td> <td>The part ‘marine’ in the CTMA will be understood as a reference to the sea and ‘blu’ as a misspelling of ‘blue’.</td> <td>T-160/12</td> </tr> <tr> <td><a href="#">CADENACOR</a></td> <td><a href="#">COR</a></td> <td>Spanish-speaking public will identify the elements ‘cadena’ and ‘cor’ in the earlier TM (S.47) – likelihood of confusion.</td> <td>T-214/09</td> </tr> <tr> <td><a href="#">BLUE</a></td> <td><a href="#">ECOBLUE</a></td> <td>The relevant public will split the CTMA into the commonly used prefix ‘eco’ and the word ‘blue’ (S.30) – likelihood of confusion.</td> <td>T-281/07 confirmed by C-23/09 P</td> </tr> </tbody> </table>	Earlier sign	Contested sign	Reason	Case No	<a href="#">MARINE BLEU</a>	<a href="#">BLUMARINE</a>	The part ‘marine’ in the CTMA will be understood as a reference to the sea and ‘blu’ as a misspelling of ‘blue’.	T-160/12	<a href="#">CADENACOR</a>	<a href="#">COR</a>	Spanish-speaking public will identify the elements ‘cadena’ and ‘cor’ in the earlier TM (S.47) – likelihood of confusion.	T-214/09	<a href="#">BLUE</a>	<a href="#">ECOBLUE</a>	The relevant public will split the CTMA into the commonly used prefix ‘eco’ and the word ‘blue’ (S.30) – likelihood of confusion.	T-281/07 confirmed by C-23/09 P
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<b>Suggestion for text</b>	For the examples “CADENACOR” and “BLUE”, there is an indication whether likelihood of confusion was assumed – the indication should be added for “MARINE BLEU”. Moreover one could consider adding the decision issued on 14 JULY 2015 in case R 2059/2014-2 – Nutriplen Smoothie / NUTRIplete.
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<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.5. Impact of the distinctive and dominant character of the components on the similarity of signs
<b>Page of the document</b>	75
<b>Issue(s) you wish to comment on</b>	Regarding the paragraph starting with “ <u>Sometimes</u> the graphical representation allows the separation...”: only a positive example has been offered.
<b>Suggestion for text</b>	As it is said “sometimes”, it might be convenient to also offer an example of when graphical representation does not allow the separation of different elements and its identification.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.5. Impact of the distinctive and dominant character of the components on the similarity of signs
<b>Page of the document</b>	76-77
<b>Issue(s) you wish to comment on</b>	3.4.5.2. Distinctiveness and dominant character of the common elements (whole section)
<b>Suggestion for text</b>	<p>More recent examples should be included, for example:</p> <p><b>Decision</b> OF 9 JULY 2015 – R 937/2013-5 – HiLink (FIG. MARK) / D-Link (FIG. MARK) <b>where the following could be read:</b></p> <p><b>D-Link vs HiLink™</b></p> <p><i>23 Contrary to the opponent’s contention, the Board finds that in the present case the element ‘LINK’ plays a secondary role in both marks, due to its secondary position within the words and its descriptive or, at least, allusive character in relation to the goods in question.</i></p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.5. Impact of the distinctive and dominant character of the components on the similarity of signs
<b>Page of the document</b>	78
<b>Issue(s) you wish to comment on</b>	<b>3.4.5.3.</b> Further to the example provided with the “NEGRA MODELO” case, for a better comprehension of the rationale beyond that kind of decisions, it might be convenient to include the following and recent decision quoting its wording.
<b>Suggestion for text</b>	 <p>vs. MARIO BERTULLI</p> <p>DECISION OF 9 JULY 2015 – R 2485/2014-1 – Bertulli / B BERTULLI (FIG. MARK) <i>et al.</i></p> <p><i>52 While it is true that consumers will notice that the earlier mark contains the different element ‘MARIO’, which has no counterpart in the contested sign, they will still link the signs through the distinctive surname ‘BERTULLI’. In fact, the consumers will most likely believe that the identical and similar products covered by the conflicting signs are produced by the same or economically linked undertakings. They will either see the earlier mark as an extended form of the contested mark, or the contested sign as a shortened version of the earlier mark or simply as two different product lines of one undertaking. In any event, there can be no doubt that the relevant consumer will instantly link the marks through the memorable surname ‘BERTULLI’.</i></p> <p><i>53 It should also be noted that consumers tend to remember similarities rather than dissimilarities of signs.</i></p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	75
<b>Issue(s) you wish to comment on</b>	3. 4.6.1.a) Signs with an identical or very similar verbal element and different figurative elements.

	Further to the two examples provided (Pukkas and Imperia), more recent cases could be quoted.
<b>Suggestion for text</b>	<p>For example, the Decision of the Second Board of Appeal issued on 24 JULY 2015 – R 1691/2014-2 – CINEMA 3D (FIG. MARK) / CINEMA 4D <i>et al</i></p> <p style="text-align: center;">  </p> <p><b>CINEMA 4D vs.</b>  <b>says:</b></p> <p><i>“24 In respect of the figurative elements of which the sign is comprised, the Board considers that there is nothing in these elements that adds anything different to the contested sign other than some elements of decoration. The mere addition of banal figurative elements will not affect the perception of the sign by the relevant public.”</i></p>

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	80
<b>Issue(s) you wish to comment on</b>	<p>3. 4.6.1.a) Signs with an identical or very similar verbal element and different figurative elements.</p> <p>The PREMIUM case example should be excluded as it is not a very clear example. This paragraph explains that the following should be cases in which the common verbal element is weak and there are some differences in also weak figurative elements. The fact that both signs contained wheat ears may not help to understand the issue at stake. The same goes for other cases such as the LACTO FREE case.</p>
<b>Suggestion for text</b>	We suggest including other better suited examples.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	79
<b>Issue(s) you wish to comment on</b>	3.4.6.1 Impact of word elements v. figurative....

	In the paragraph starting with “more, over, in assessing the impact of the verbal element of a complex trade mark...”
<b>Suggestion for text</b>	The term “complex” should be changed for “composite”.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	79
<b>Issue(s) you wish to comment on</b>	<p>3.4.6.1 Impact of word elements v. figurative....</p> <p>This title refers to cases where there are a common verbal element and “different figurative elements”. However when going through the explanations and examples, it only relates to cases where the figurative element is weak/evocative or not so dominant.</p> <p>If that is the intention of the Office, the title should be redrafted accordingly.</p>
<b>Suggestion for text</b>	The title should be amended.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	81
<b>Issue(s) you wish to comment on</b>	<p>3.4.6.1.b) Signs with an identical or very similar figurative element ....</p> <p>The first paragraph starts with the terms “in general” so as to establish a “general rule” whereby “the identity or similarity of the figurative component of signs <b>is insufficient</b> to establish a considerable level of similarity where at least one of the signs contains a further verbal component that is not contained in the other sign”.</p> <p>It is our understanding that this paragraph should be more carefully drafted. Actually:</p> <ul style="list-style-type: none"> <li>- the examples provided are related to signs with a low degree of distinctiveness or that are really common .</li> <li>- all the examples are based on earlier signs which only contain a graphic/figurative element, while most of the contested signs contained distinctive word elements.</li> </ul>

Those examples do not support the “general rule” stated at the beginning of the paragraph.

Furthermore, the following recent decision should be included for a better comprehension of all the scenarios, including the exception to the “proposed” general rule of the Office established in the first paragraph:

DECISION OF 11 JUNE 2015 – R 761/2014-1 – pillow HOSTELS (FIG. MARK) / ibis budget HOTELS (FIG.MARK)



33 Finally, as to the figurative element of the CTM applied for, the Board notes that where a trade mark is composed of verbal and figurative elements, the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods in question by quoting their name rather than by describing the figurative element of the trade mark

(14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37; 11/01/2013, T-568/11, interdit de me gronder IDMKG, EU:T:2013:5, § 38; and 06/09/2013, T-349/12, Revaro, EU:T:2013:412, § 23).


34 The Board sees no reason to deviate from this principle in the present case, at least when comparing the figurative component with the word ‘pillow’. It is reasonable to assume that the average consumer will perceive the verbal element ‘pillow’ as the trade mark and the figurative element as a decorative element (see, by analogy, 14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 37). In


this case, the figurative element of the mark does not appear in a distinctive and original configuration allowing it to prevail over the word elements (28/11/2013, T-410/12, vitaminaqua, EU:T:2013:615, § 47 ; 11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, § 57; and 12/11/2008, T-242/07, Q2web, EU:T:2008:488, § 42).

35 In addition, part of the English-speaking public could perceive ‘a pillow’ in the figurative element, and could make a link with the word ‘pillow’, reinforcing the dominance of the word element.







	<p>36 Nonetheless, it should be noted that the figurative component is at the beginning of the mark and is of a size that will not go unnoticed. Therefore, taking into account its central position and size, as well as the fact that it is not devoid of distinctive character, the figurative component cannot be entirely neglected in the overall impression.</p> <p><b><u>37 Taking into account its intrinsic value as well as, accessorially, the position of the various components, the Board finds that the word ‘pillow’ is the dominant component of the mark applied for.”</u></b></p>
<b>Suggestion for text</b>	<p>See above proposal to avoid the expression “In general ....is insufficient”, and to provide a better explanation on when similar figurative elements are to be considered relevant or dominant for the purposes of comparison in light of the rules established in the decision above quoted as an example.</p>


<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	82
<b>Issue(s) you wish to comment on</b>	<p>3.4.6.2. Beginning of the signs in the visual and phonetic comparison</p> <p>In the first paragraph it is said that “<u>In words signs, the first part is generally the one that primarily catches the consumer’s attention...</u>”: This is not only applicable to word signs but also to, at least some, composite signs.</p> <p>Actually that would not be consistent with assertion included in first paragraph of page 83, where it is said that it applies to trade marks that contain a verbal element (but not only word elements).</p> <p>As a couple of examples see:</p> <p>a) DECISION OF 23 JULY 2015 – R 556/2014-1 – LEMON SPORTS.COM (fig.) / LEMON &amp; SODA <i>et al.</i></p> <div style="text-align: center;">  <p><b>LEMON &amp; SODA vs</b></p> </div> <p>“58 In the present case, an average visual and phonetic similarity exists between the conflicting signs. Furthermore, the signs also have a conceptual similarity in that they coincide in the element ‘LEMON’ that</p>

	<p>is placed at the beginning of both marks and is the most distinctive element of the contested mark. In this respect it must also be recalled that according to settled case-law, <u>the beginning of the mark is the part which attracts the consumer's attention more and which will be remembered more easily.</u>"</p> <p>b) DECISION OF 11 JUNE 2015 – R 761/2014-1 – pillow HOSTELS (FIG. MARK) / ibis budget HOTELS (FIG.MARK)</p> <div style="text-align: center;">  </div> <p>32 Accordingly, it must be found that the word 'pillow' is the dominant word element in the CTM applied for. That word is presented in black bold letters and because of its size and position, it stands out in the general impression of the mark applied for. That impression is due to the fact that the word 'pillow' represents over 25% of the mark applied for (and 80% of its word elements), in addition it is placed first in relation to the word element 'hostels'. Consumers normally pay more attention to the beginning of marks when perceiving them (30/11/2006, T-43/05, Brothers by Camper, EU:T:2006:370, § 63). Furthermore, the position of the word 'hostels' after and underneath the word 'pillow', together with the smaller size of the typeface used, and the descriptiveness of the word 'hostels', reinforces the dominance of the word element 'pillow'.</p>
Suggestion for text	See above

Part/Section/Chapter of the Guidelines the comment(s) refer to	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
Page of the document	82
Issue(s) you wish to comment on	<p>3.4.6.2. Beginning of the signs...</p> <p>An interesting example to the explanation given in the second paragraph ("Nevertheless...") would be the run in the following cases:</p> <p>The DECISION OF 23 JULY 2015 – R 556/2014-1 – LEMON SPORTS.COM (fig.) / LEMON &amp; SODA <i>et al.</i> issued <i>in the case</i> LEMON &amp; SODA vs</p>

	 <p>it was finally declared that “In light of the above, it is concluded that there is an average visual similarity between the marks, since they both include the same element ‘LEMON’ in the <b>initial</b> part and two additional letters in different positions.”</p> <p>However the Board of Appeal in its decision of 11/07/2014, R 2086/2013-1, LEMON SPORTS (fig.) / Lemon &amp; Soda (fig.) concerns two</p> <div style="display: flex; justify-content: space-around; align-items: center;">   </div> <p>figurative marks, namely and declared them compatible.</p>
<p><b>Suggestion for text</b></p>	<p>The above examples should be included.</p>

<p><b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b></p>	<p>Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs</p>
<p><b>Page of the document</b></p>	<p>82</p>
<p><b>Issue(s) you wish to comment on</b></p>	<p>3.4.6.1.c) “Signs with figurative elements corresponding to ...”</p> <p>Another more recent example that could be included is the following: DECISION OF 23 JULY 2015 – R 556/2014-1 – LEMON SPORTS.COM (fig.) / LEMON &amp; SODA <i>et al.</i> issued in the case <b>LEMON &amp; SODA vs</b></p>  <p>“46 As to the conceptual comparison, the common word ‘LEMON’ will be understood as referring to the fruit of the lemon tree in English and in those languages containing a similar corresponding term, e.g. Italian (<i>‘limone’</i>), Spanish (<i>‘limón’</i>). The fanciful layout of the vowel ‘O’ in the contested mark will be perceived, at least by part of the relevant public, as the graphical representation of a lemon, which will emphasise the conceptual meaning of the word ‘LEMON’.</p>

<p><b>Suggestion for text</b></p>	<p>DECISION OF 23 JULY 2015 – R 556/2014-1 – LEMON SPORTS.COM (fig.) / LEMON &amp; SODA <i>et al.</i> issued in the case <b>LEMON &amp; SODA vs</b></p>  <p>“46 As to the conceptual comparison, the common word ‘LEMON’ will be understood as referring to the fruit of the lemon tree in English and in those languages containing a similar corresponding term, e.g. Italian (<i>‘limone’</i>), Spanish (<i>‘limón’</i>). The fanciful layout of the vowel ‘O’ in the contested mark will be perceived, at least by part of the relevant public, as the graphical representation of a lemon, which will emphasise the conceptual meaning of the word ‘LEMON’.</p>
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<p><b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b></p>	<p>Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs</p>
<p><b>Page of the document</b></p>	<p>82</p>
<p><b>Issue(s) you wish to comment on</b></p>	<p>3.4.6.2. Beginning of the signs.</p> <p>The third paragraph of this Section should be moved to the second position for a better comprehension.</p> <p>Fourth paragraph (page 83) of this section (starting with “However, this is not a fixed rule”, and the current second paragraph of this section (page 82) starting with “NEVERTHELESS”, seem to be equivalent. In order to be clearer it might be better to delete the paragraph starting with “Nevertheless...” in page 82.</p>
<p><b>Suggestion for text</b></p>	<p>See above.</p>

<p><b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b></p>	<p>Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs</p>
<p><b>Page of the document</b></p>	<p>83</p>
<p><b>Issue(s) you wish to comment on</b></p>	<p>3.4.6.2. Beginning of the signs.</p> <p>The Office explains in the first paragraph of this part that this rule applies “when this verbal element is not very short”. Examples should</p>

	be provided quoting decisions for better comprehension. For instance, in the UGLI case (Decision on Cancellation No 10577 C), this was not an issue.
<b>Suggestion for text</b>	Examples should be provided.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	84
<b>Issue(s) you wish to comment on</b>	3.4.6.3. Short signs.  Paragraph “The comparison between signs consisting of single letters (or a combination of letters not recognizable as a word) follows the same rule...”  As in this section only short signs are examined and short signs have been defined as those of 3 or less letters/numbers, the above paragraph should be redrafted.
<b>Suggestion for text</b>	“The comparison between signs consisting of less a single letter or a combination of 3 or less than letters not recognizable as a word, follows the same rules...”

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	86
<b>Issue(s) you wish to comment on</b>	3.4.6.3.c) Recent examples to be included
<b>Suggestion for text</b>	A more recent case to be included among the examples is RA vs RHA (Décision d’annulation n° 10084 C)

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
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<b>Page of the document</b>	87
<b>Issue(s) you wish to comment on</b>	<p>3.4.6.3.c). It might be convenient to include a reference to those cases where the 3 letters combination corresponds to an acronym of a larger word element which is also included in the sign but at a smaller size that may clearly evoke that the dominant element is the acronym. As an example the decision of the Division of Opposition issued on case No B 2 141 169 states:</p> <p>“f) Global assessment, other arguments and conclusion</p> <p>The signs coincide in the dominant element of the earlier mark and, as far as the earlier sign is concerned, the most distinctive element. As the public tends to use the short form of a sign when it is available, especially aurally, the opposing signs will be used in the identical form “AEG” by the relevant public. Moreover, the contested mark “AEG” is included in the earlier mark’s word element “A.E.G. S.L.”, which will be pronounced without the dots by the relevant public.”</p>
<b>Suggestion for text</b>	

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	87
<b>Issue(s) you wish to comment on</b>	<p>3.4.6.3. c) In this first paragraph, the Office declares as a rule to be applied (no disclaimer of a “case by case” has been made) that if the 3 letter signs:</p> <ul style="list-style-type: none"> <li>- vary only in the first letter</li> <li>- the combination has no meaning</li> <li>- and one of the signs includes figurative element</li> </ul> <p>then this “may be sufficient to render them not similar”.</p> <p>There are two examples provided. The examples provided might not be enough equivalent to each other to create a general rule. Moreover the cases include a number of requirements and particularities that the signs in question should comply with. IF the Office’s intention is to include these very particular cases, then it might also be interesting to include other cases such as the following where the Office examined a</p>

case where the 3 letter sign differs in one letter and also includes a figurative element:

DECISION OF 13 FEBRUARY 2015 – R 945/20142 – TAD (FIGURATIVE MARK) / TAB



TAB v.

51 In the present case, the trade marks in dispute have a high degree of similarity in aural terms, such that it is quite difficult to distinguish them, even for a public exhibiting a high level of attention. The word elements of the two trade marks, which occupy a dominant position in the overall impression created by each of them, even though they are written in different fonts, are almost identical. They differ only by the presence of the last letters 'B/D', which are however not very different in visual terms. It is true that, in visual terms, the public will certainly not fail to notice the figurative element of the trade mark applied for; however, this graphical divergence does not cancel out the overall similarity between the signs when they are analysed in their entirety,

41 Firstly, it should be observed that the word elements of the trade marks in dispute are syntagms of the same length, namely of three letters. The only difference between these sets of initials relates to the last letter: 'B' in the earlier trade mark and 'D' in the trade mark applied for. It should be stated that, firstly, two of the upper-case letters which constitute them are identical, namely the 'T' and the 'A', and that, secondly, these two upper-case letters appear in the same order. As for the last letter of each of the two signs, it should be noted that, as has already been established by the Court, while the upper-case letter 'B' in one case and the upper-case letter 'D' in the other are different, these two letters are not very different from each other in visual terms. Specifically, the upper-case letters 'B' and 'D' are represented in a very similar manner since the additional horizontal stroke of the 'B' could easily escape the attention of an average consumer, notwithstanding the fact that one of the two letters has two rounded shapes and the other just one. It follows that there exists a visual similarity between the signs at issue, even if this is of an average degree (17/09/2008, T-10/07, FVB, EU:T:2008:380, § 47). According to the case-law, the fact that two of the three letters are totally identical and in the same sequence means that the difference in a single letter (at the end of the

	two signs) does not constitute a significant visual difference (23/10/2002, T-388/00, ELS, EU:T:2002:260, § 66).
<b>Suggestion for text</b>	See above.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition - Double Identity and Likelihood of Confusion – Comparison of Signs - Chapter 4 – 3.4.6 Other principles to be taken into account in the comparison of signs
<b>Page of the document</b>	84-87
<b>Issue(s) you wish to comment on</b>	3.4.6.3) This section is supposed to refer to short signs consisting in numbers also, but no examples have been provided.
<b>Suggestion for text</b>	Examples on short combinations should be provided.

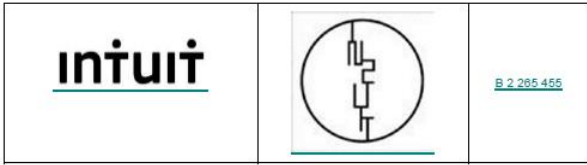
<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion , Chapter 4 Comparison of Signs
<b>Page of the document</b>	87
<b>Issue(s) you wish to comment on</b>	Each aspect of (visual, phonetic and conceptual) <b>the</b> comparison of signs leads to a decision as to whether the marks are similar and if so, to what degree.
<b>Suggestion for text</b>	Each aspect of <b>the</b> (visual, phonetic and conceptual) comparison of signs leads to a decision as to whether the marks are similar and if so, to what degree.




<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion , Chapter 4 Comparison of Signs – 3.5
<b>Page of the document</b>	87 (TC version)
<b>Issue(s) you wish to comment on</b>	The conclusion as to the degree of similarity of the signs at each of the three levels is <b>as a</b> result of an evaluation of all of the relevant factors.



	[...] It should be borne in mind that in an assessment of similarity the relevant factors [...]
<b>Suggestion for text</b>	The conclusion as to the degree of similarity of the signs at each of the three levels is <b>the</b> result of an evaluation of all of the relevant factors. [...]It should be borne in mind that in an assessment of similarity, the relevant factors [...]

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion , Chapter 4 Comparison of Signs
<b>Page of the document</b>	90 (TC version)
<b>Issue(s) you wish to comment on</b>	<p>The layout seems incorrect, with a missing indent of paragraph. Starting with “nevertheless”:</p> <p><u>Where the signs at issue are dissimilar,</u></p> <ul style="list-style-type: none"> <li><u>the general rule is that the goods and services do not need to be compared. Only the signs are compared and the examination stops upon concluding on the dissimilarity of the signs.</u></li> </ul> <p>Guidelines for Examination in the Office, Part C, Opposition <span style="float: right;">Page 89</span></p> <p><del>DRAFT/FINAL</del> <span style="margin-left: 200px;">VERSION 1.0</span> <span style="float: right;">01/02/2016<del>5</del></span></p> <hr/> <p>Double Identity and Likelihood of Confusion – Comparison of Signs</p> <p><u>Nevertheless, reasoning strategy may justify a comparison of some of the goods and services and continue the assessment of the similarity of signs for the remaining goods and services only, where the signs are otherwise dissimilar due to an overlap exclusively in a descriptive or non-distinctive element (see paragraph 4.2.5 below). For example, in the case of long lists of goods and services, it may prove more efficient to first rule on the dissimilarity of some of the goods and services, and continue to the comparison of the signs (including the assessment of distinctive components in several languages) only for the remaining, shorter list of goods and services.</u></p> <ul style="list-style-type: none"> <li><u>any claim of enhanced distinctiveness is not examined. If the signs are dissimilar, the opposition under Article 8(1)(b) CTMR must be rejected regardless of any enhanced distinctiveness of the earlier mark. Where the marks in question are not similar, there is no need to take account of the reputation of the earlier mark, since it does not fall within the scope of the test of similarity and cannot serve to increase the similarity between those marks (order of 14/03/2011, C-370/10 P, EDUCA Memory game, EU:C:2011:149, § 50-51 and the case-law cited therein).</u></li> </ul>
<b>Suggestion for text</b>	We recommend changing the layout accordingly.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion ,  Chapter 4 Comparison of Signs
<b>Page of the document</b>	92 (TC version)
<b>Issue(s) you wish to comment on</b>	The outcome of the case is unclear. Can the average consumer still perceive the word or is this one of the “rather rare cases” mentioned?  
<b>Suggestion for text</b>	We suggest inserting a respective indication whether the case is an example for “illegibility” or not.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C Opposition, Section 2 Double Identity and Likelihood of Confusion ,  Chapter 4 Comparison of Signs																		
<b>Page of the document</b>	92 (TC version)																		
<b>Issue(s) you wish to comment on</b>	<table border="1" data-bbox="609 1263 1409 1585"> <thead> <tr> <th>Earlier sign</th> <th>Contested sign</th> <th>Case No</th> </tr> </thead> <tbody> <tr> <td>AAVA MOBILE</td> <td>JAVA</td> <td>T-554/12</td> </tr> <tr> <td colspan="3"><u>The resemblances that result from the presence of the common letters 'ava' are completely offset by the significant differences between those signs (§ 45).</u></td> </tr> <tr> <th>Earlier sign</th> <th>Contested sign</th> <th>Case No</th> </tr> <tr> <td>ALDI</td> <td></td> <td>T-240/13</td> </tr> <tr> <td colspan="3"><u>The conflicting signs are visually different. The figurative elements and the additional word 'foods' must not be disregarded when comparing the signs (§ 54-55). The overall visual impression of the conflicting signs is clearly different (§ 59-60). The signs are also phonetically different bearing in mind, in particular, the additional element 'foods' of the contested mark (§ 64). Finally, the marks are also conceptually not similar (§ 73).</u></td> </tr> </tbody> </table>	Earlier sign	Contested sign	Case No	AAVA MOBILE	JAVA	T-554/12	<u>The resemblances that result from the presence of the common letters 'ava' are completely offset by the significant differences between those signs (§ 45).</u>			Earlier sign	Contested sign	Case No	ALDI		T-240/13	<u>The conflicting signs are visually different. The figurative elements and the additional word 'foods' must not be disregarded when comparing the signs (§ 54-55). The overall visual impression of the conflicting signs is clearly different (§ 59-60). The signs are also phonetically different bearing in mind, in particular, the additional element 'foods' of the contested mark (§ 64). Finally, the marks are also conceptually not similar (§ 73).</u>		
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<b>Suggestion for text</b>	The GC considered both signs dissimilar as the “overlapping” part was not perceived independently. However, due to the fact that the “non-overlapping” elements (MOBILE / FOODS) were rather descriptive for the covered goods, the average consumer might still perceive them independently and disregard the additional rather descriptive elements. Maybe these are not the best examples for this passage and they could be replaced by better ones.																		

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Part C, Opposition – Chapters 5 - 7
<b>Page of the document</b>	General observation
<b>Issue(s) you wish to comment on</b>	While at first sight the changes to these parts are significant, it appears that they are mostly triggered by moving text from here to Section 2. In this respect we reiterate that we welcome the change in methodology.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	PART D CANCELLATION SECTION 1 PROCEEDINGS
<b>Page of the document</b>	Page 9
<b>Issue(s) you wish to comment on</b>	In point 3) which starts by 'An application for cancellation...' there is a typo in line four: the current wording says 'the opponent' when it should say 'the applicant'
<b>Suggestion for text</b>	Line four of point 39 should read:  '(e.g. the <u>applicant</u> does not provide any indication regarding the applicable national law).

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Guidelines for Examination in the Office, Registered Community Designs. 3.6.2 Who may represent
<b>Page of the document</b>	10

<b>Issue(s) you wish to comment on</b>	A natural or legal person whose domicile, principal place of business, or real and effective industrial or commercial establishment is in the <u>Community</u> may be represented before the Office by an employee
<b>Suggestion for text</b>	We suggest replacing “Community” with “European Union”.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Guidelines for Examination in the Office, Registered Community Designs. 3.9.2 Facts, evidence and arguments
<b>Page of the document</b>	Pag. 13
<b>Issue(s) you wish to comment on</b>	4.2.3.2, Extracts from official databases), (3) extracts from official bulletins of the relevant national design offices and WIPO.
<b>Suggestion for text</b>	We suggest adding “national trademark offices”.

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Guidelines for Examination in the Office, Registered Community Designs. 3.15 Participation of an alleged infringer
<b>Page of the document</b>	16
<b>Issue(s) you wish to comment on</b>	<u>Any third party that proves</u> that proceedings for infringement based on the contested Community design have been instituted <u>against them</u> may join as a party in the invalidity proceedings (Article 54 CDR; Article 33 CDIR)
<b>Suggestion for text</b>	Either “any third party that proves.... against it” or

	“any third party that prove.... against them”.
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<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Guidelines for Examination in the Office, Registered Community Designs. 4.1.1.2 Request for proof of use of an earlier trade mark
<b>Page of the document</b>	17
<b>Issue(s) you wish to comment on</b>	the earlier distinctive sign is a (Community, international or national) <u>trade mark having effect in the European Union</u> which, on the date of the application for a declaration of invalidity, has been registered for not less than five years;
<b>Suggestion for text</b>	the earlier distinctive sign is a <u>Community or national trade mark, or international trademark having effect in the European Union or any country thereof</u> , which, on the date of the application for a declaration of invalidity, has been registered for not less than five years;

<b>Part/Section/Chapter of the Guidelines the comment(s) refer to</b>	Guidelines for Examination in the Office, Registered Community Designs 5.5.1.2 Official publications
<b>Page of the document</b>	29
<b>Issue(s) you wish to comment on</b>	Publication of an earlier design in the bulletin of any industrial property office worldwide constitutes disclosure and it is only ('except') where this publication cannot reasonably become known to <u>the professionals</u> of the sector concerned within the European Union .....
<b>Suggestion for text</b>	It would be better to use “the specialised circles in the sector concerned”.

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